

# COUNTERING THE “THOUGHT WE HATE” WITH REAPPROPRIATION USE UNDER TRADEMARK LAW

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*In 2017, the Supreme Court struck down the disparagement clause of § 2(a) of the Lanham Act as contravening the First Amendment. Against the backdrop of the Washington Redskins controversy, Matal v. Tam foreclosed the question of challenging federal registrations of disparaging trademarks. The case, however, opened up the opportunity to explore how disparaged groups could work within the framework of federal trademark law to restrict the right to exclusive use that owners of disparaging trademarks possess. Just as offending groups have a constitutional right to free speech, disparaged groups should be allowed to counter disparaging trademarks with “reappropriation use”—unauthorized uses of disparaging trademarks with the purpose of reclaiming “the thought that we hate”<sup>1</sup>—and still be protected under the First Amendment against infringement claims. This Note proposes a novel, three-step reappropriation use defense for courts to apply, demonstrating how federal trademark law could ensure that groups like The Slants have a platform to reclaim terms and still protect disparaged groups seeking to reappropriate disparaging trademarks.*

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<sup>1</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (quoting *United States v. Schwimmer*, 279 U.S. 644, 655 (1929) (Holmes, J., dissenting)).

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## INTRODUCTION

In 2017, the Supreme Court of the United States handed down a victory for “The Slants,” an all-Asian-American rock band that had chosen its name to reclaim a racial slur targeted at East Asians. Striking down § 2(a) of the Lanham Act,<sup>2</sup> the Court in *Matal v. Tam* found that the disparagement provision of the federal trademark statute violated the Free Speech Clause of the First Amendment.<sup>3</sup> This decision came against the backdrop of the ongoing controversy over Pro-Football Inc.’s Washington Redskins trademark, a pointed example in the debate on the constitutionality of the disparagement clause, but one for which the Court had denied the petition for certiorari.<sup>4</sup>

While the Court’s decision vindicated The Slants in their fight against the United States Patent and Trademark Office (PTO), it also opened the door for organizations like the Washington Redskins to

<sup>2</sup> Lanham Act, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051–1141 (2012)). The Lanham Act is the primary federal trademark statute in the United States.

<sup>3</sup> 137 S. Ct. at 1751 (unanimously affirming the judgment of the Court of Appeals for the Federal Circuit that the Lanham Act’s provision prohibiting the federal registration of “disparaging” trademarks with the United States Patent and Trademark Office violated the First Amendment).

<sup>4</sup> Pro-Football, Inc. v. Harjo, 565 F.3d 880 (D.C. Cir.), *cert. denied*, 558 U.S. 1025 (2009).

continue profiting from racially or culturally disparaging terms.<sup>5</sup> In light of such possibility, it is difficult to see the Supreme Court ruling as a genuine victory for Asian Americans and other marginalized groups who are the possible reference targets of disparaging trademarks. Allowing organizations like the Redskins to benefit from federal trademark registrations illustrates this double-edged sword effect.<sup>6</sup> Despite the potential of reappropriation as a means of empowerment, the ramifications of granting “the imprimatur of the federal government”<sup>7</sup> on racist expressions bring into question the adequacy of the current legal doctrine for reclaiming terms.

Much of the legal scholarship on *Matal v. Tam* concerns the opinion’s treatment of free speech and its implications at the registration stage, but neglects to explore ways to counter disparaging trademarks after registration.<sup>8</sup> In federal trademark law, registering or challenging the registration of a mark is one aspect of attaining property rights over the mark. However, *how much* exclusive use owners should be able to exercise over disparaging trademarks after registration remains an issue. That is, how much protection should be afforded to disparaging trademark owners when they claim someone is infringing (i.e., making unauthorized uses of) their trademarks? Given *Matal v. Tam*’s invalidation of the disparagement clause as a statutory bar to registration, how can disparaged groups counter disparaging trademarks that have already attained federal registration? This Note argues that a strong “reappropriation use” defense would provide a procedural solution for disparaged groups to raise in response to infringement claims brought by trademark owners.<sup>9</sup> The reappropriation use defense would be strong enough not only to allow

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<sup>5</sup> See *infra* Section I.A.

<sup>6</sup> See *infra* notes 25–27 and accompanying text (describing the benefits of federal trademark registration); see also *infra* Section I.A.

<sup>7</sup> Brief for Native American Organizations as Amici Curiae Supporting Petitioner at 27, *Matal v. Tam*, 137 S. Ct. 1744 (2017) (No. 15-1293) [hereinafter Brief for NAO].

<sup>8</sup> See, e.g., Mark Conrad, *Matal v. Tam—A Victory for the Slants, a Touchdown for the Redskins, but an Ambiguous Journey for the First Amendment and Trademark Law*, 36 CARDOZO ARTS & ENT. L.J. 83 (2018); Timothy T. Hsieh, *The Hybrid Trademark and Free Speech Right Forged from Matal v. Tam*, 7 N.Y.U. J. INTELL. PROP. & ENT. L. 1 (2018); Niki Kuckes, *Matal v. Tam: Free Speech Meets “Disparaging” Trademarks in the Supreme Court*, 23 ROGER WILLIAMS U. L. REV. 122 (2018); Tanya Behnam, Note, *Battle of the Band: Exploring the Unconstitutionality of Section 2(a) of the Lanham Act and the Fate of Disparaging, Scandalous, and Immoral Trademarks in a Consumer-Driven Market*, 38 LOY. L.A. ENT. L. REV. 1 (2017). “After registration” refers to the infringement and defense side of trademark law.

<sup>9</sup> Because disparaged groups engaging in reappropriation use would be raising a defense in response to an infringement claim, the reappropriation use defense would not pose standing problems that may be present if, for instance, the disparaged groups were levying reappropriation use as plaintiffs to raise a legal claim or challenge.

disparaged groups to make unauthorized uses of disparaging trademarks, but also to limit the scope of protection afforded to the trademark owners.

While offending groups have a constitutional right to free speech and the disparagement clause no longer prevents registration of disparaging marks, disparaged groups should be allowed to counter disparaging terms by engaging in reappropriation uses—unauthorized uses of disparaging trademarks to reclaim “the thought . . . we hate.”<sup>10</sup> Reappropriation usage should be protected against infringement claims under the First Amendment.<sup>11</sup> This Note proposes a novel, three-step test adapted from the *Rogers v. Grimaldi* expressive use defense<sup>12</sup> for courts to apply in reappropriation use cases.<sup>13</sup> Further, this Note examines the Redskins controversy as a case study, as the legal challenge seeking to cancel the Redskins trademark under § 2(a) was playing out in the backdrop of *Matal v. Tam*. Since the Supreme Court had denied certiorari for the Redskins case, but granted it for The Slants case, the legal fate of the Redskins trademark depended on the Court’s ruling in *Matal v. Tam* and the case’s implications for the disparagement clause. This Note treats the Redskins example as a litmus test for analyzing whether, under the proposed framework, American Indian<sup>14</sup> organizations could reclaim the term “Redskins” in full while restricting the Redskins’ exclusive use of the mark. With

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<sup>10</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (quoting *United States v. Schwimmer*, 279 U.S. 644, 655 (1929) (Holmes, J., dissenting)).

<sup>11</sup> See, e.g., Amy Adler, *What’s Left?: Hate Speech, Pornography, and the Problem for Artistic Expression*, 84 CALIF. L. REV. 1499, 1504 (1996) (explaining that the answer to countering hate speech does not lie in censorship given the rise of “subversion” speech, whereby “rather than creating a new language free of homophobic, racist, or sexist imagery, many activists have begun appropriating such imagery as a means of subverting and attacking it from within”). Professor Adler goes on to say that it is impossible to “devis[e] a system of leftist political censorship that could protect the subversive, activist use of hate speech” and that it is an either-or situation whereby one must choose between “a system of censorship . . . [and] offer[ing] full protection to activism,” but not both. *Id.* at 1572.

<sup>12</sup> See *Rogers v. Grimaldi*, 875 F.2d 994, 1000 (2d Cir. 1989).

<sup>13</sup> See *infra* Part III. For the purposes of this Note, I will use terms such as “reappropriation use,” “reappropriation usage,” and “reappropriation efforts” to refer to conduct in which defendant-disparaged groups and individuals seek to make unauthorized uses of disparaging trademarks in full for the purpose of reclaiming the terms.

<sup>14</sup> This Note uses the term “American Indian” rather than “Native American,” unless a quoted material uses the latter term. While the two are often used interchangeably, as Professor Stephen L. Pevar notes, “most Indian organizations and groups, including the National Congress of American Indians and the Society of American Indian Government Employees, use *Indian* in their titles. Moreover, virtually all federal Indian laws (such as the Indian Reorganization Act) and federal agencies (such as the Bureau of Indian Affairs) use *Indian*.” STEPHEN L. PEVAR, *THE RIGHTS OF INDIANS AND TRIBES* 1 n.\* (4th ed. 2012).

the invalidation of § 2(a), it may be tempting to dismiss federal trademark law as an inappropriate avenue for reappropriation efforts<sup>15</sup> and instead turn to state-level legal action<sup>16</sup> or market-based solutions to argue that consumer disapproval of culturally disparaging marks will drive trademark owners to change offensive marks.<sup>17</sup> This Note demonstrates how, post-*Matal v. Tam*, analyzing disparaging trademarks in light of an infringement and defense framework helps illustrate how federal trademark law could ensure that groups like The Slants have a platform to reclaim terms and still protect disparaged groups seeking to reappropriate disparaging trademarks. A strong reappropriation use defense would protect unauthorized uses of disparaging trademarks from infringement liability.

Part I examines the role of trademark law in reappropriation efforts. It first provides an overview of establishing property rights in trademark law, bringing infringement claims, and raising defenses. It then evaluates the impact of *Matal v. Tam* on reclamation efforts made by disparaged groups. Using the Redskins controversy as an example, this Note conceptualizes reappropriation as both a tool for self-empowerment and a free speech exercise meriting just as much protection as ownership rights in disparaging trademarks. Part II illustrates how the existing defenses—parodic use and expressive use—do not suffice. This Part first provides examples of parodic uses that have been levied against the Redskins trademark and explains how that defense does not adequately protect reappropriation uses. It then examines the policy rationale espoused in the *Rogers v. Grimaldi* expressive use defense for determining when to accord Lanham Act property protections to disparaging trademark owners when the unauthorized user’s freedom of expression is at stake. Under this balancing

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<sup>15</sup> See, e.g., Sari Shari, *The Mark of a Culture: The Efficacy and Propriety of Using Trademark Law to Deter Cultural Appropriation*, 26 FED. CIR. B.J. 407, 409 (2017) (positing that trademark law is not appropriate for dealing with cultural appropriation, due to the onerous “requirements for and limitations to trademark protection,” and arguing that “not only will it be difficult for source communities to gain trademark protection for their cultural products—trademark protection may [also] be counterproductive to source communities’ goals driving deterrence of cultural appropriation”). Shari limits the piece’s focus to whether source communities could trademark cultural products and images, and does not provide other avenues for reappropriation efforts.

<sup>16</sup> See, e.g., Robert H. Hendricks, Note, *Don’t Take Me Out to That Ballpark: State Action, Government Speech, and Chief Wahoo After Matal*, 103 CORNELL L. REV. 1589, 1590 (2018) (proposing that government speech is a subset of state action in order to apply state action tests to determine the difference between government speech and private speech).

<sup>17</sup> See, e.g., Jake MacKay, Note, *Racist Trademarks and Consumer Activism: How the Market Takes Care of Business*, 42 LAW & PSYCHOL. REV. 131, 147 (2018) (looking at consumer activism as the solution to effectively regulating racism and hate speech in the marketplace).

approach, the defendant-disparaged group's reappropriation use should be protected speech, absent explicitly misleading conduct as to source. Part II, however, concludes that even the expressive use defense does not sufficiently protect reappropriation uses. Part III lays out the new test, illustrates the tangible differences it would have for future reappropriation uses, and examines how courts would evaluate them.

## I

### THE ROLE OF TRADEMARK LAW IN FACILITATING REAPPROPRIATION

Because *Matal v. Tam* foreclosed the question of challenging registrations of disparaging trademarks, this Note uses the Redskins' mark to illustrate how disparaged groups could respond to infringement claims for registered trademarks by raising a reappropriation use defense.<sup>18</sup> Following the invalidation of the disparagement clause, the best defense to such trademarks may be the disparaged groups' ability to reappropriate terms without being found liable for infringement. The reappropriation use defense would restrict the scope of exclusive use afforded to registered trademark owners, while still protecting defendant-disparaged groups' First Amendment right to free speech. To explore how federal trademark law could facilitate reappropriating disparaging trademarks, this Part provides a brief overview of the trajectory of a trademark infringement suit, a discussion on how *Matal v. Tam* changed the legal landscape for countering disparaging trademarks beyond the registration stage, and an examination of *Matal v. Tam*'s impact on reappropriation efforts.

#### A. *An Overview of Trademark Law: Establishing Property Rights, Bringing Infringement Claims, and Raising Defenses*

With the fall of the disparagement clause, the issue of registering or owning disparaging trademarks became moot. The open question now concerns the scope of protection and the exclusive use rights that are afforded to owners of disparaging trademarks.<sup>19</sup> To qualify for federal trademark protection, a trademark<sup>20</sup> must (1) be distinctive of

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<sup>18</sup> The proposed test could apply to reappropriation use of either unregistered or registered marks.

<sup>19</sup> At the registration stage, the plaintiff tries to cancel or oppose the trademark registration of the defendant, who asserts its trademark right. At the infringement litigation stage, however, the plaintiff would be the trademark owner and the defendant the alleged infringer.

<sup>20</sup> A protectable trademark takes various forms, including words, phrases, two-dimensional still images, two-dimensional moving images, colors, sounds, scents, textures,

the goods or services to which it is affixed,<sup>21</sup> (2) not be disqualified from protection by any statutory bars, which formerly included the disparagement clause under § 2(a),<sup>22</sup> and (3) be used in commerce.<sup>23</sup> Further, to qualify for federal trademark protection, the mark need not be registered at the PTO, as § 43(a) of the Lanham Act protects unregistered trademarks from unauthorized uses likely to cause consumer confusion as to source.<sup>24</sup> Still, there are significant benefits to registration. In their legal journey, The Slants realized that federal trademark registration would confer substantive advantages, including nationwide priority in the mark as of the date of application even if the band had not used the mark throughout the nation;<sup>25</sup> prima facie presumption of the mark’s validity and the band’s ownership of the mark;<sup>26</sup> and the possibility of achieving incontestable status,<sup>27</sup> which

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motions, building exteriors, building interiors, product shapes/design/configuration, and product packaging. See BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK 30–33 (5th ed. 2018), <http://tmcasebook.org/wp-content/uploads/2018/07/BeebeTMLaw-5.0-Full-Book.pdf>.

<sup>21</sup> Section 45 of the Lanham Act provides that a protectable trademark must be distinctive of source, “identify[ing] and distinguish[ing] . . . goods . . . [and] indicat[ing] the source of the goods.” 15 U.S.C. § 1127 (2012).

<sup>22</sup> Even if a trademark is distinctive of source, it will be denied protection if it falls within one of the § 2 statutory bars, which formerly included the disparagement clause under § 2(a). See 15 U.S.C. § 1052(a) (2012). While the statutory bars apply only to challenging or cancelling trademark registrations, the Lanham Act still protects unregistered marks under § 43(a). 15 U.S.C. § 1125(a) (2012); *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017).

<sup>23</sup> Lanham Act § 45, 15 U.S.C. § 1127 (2012). The “use in commerce” requirement demands that the use of the mark be “bona fide . . . in the ordinary course of trade.” *Id.* “Commerce” refers to “all commerce which may lawfully be regulated by Congress.” *Id.* A domestic (U.S.) trademark owner must make a “use in commerce” of the mark to qualify for registration under § 1 or for protection as an unregistered mark under § 43(a) of the Lanham Act. 15 U.S.C. §§ 1051(a)(1), 1125(a) (2012).

<sup>24</sup> While there are significant benefits to registration, see *infra* notes 25–27 and accompanying text, § 43(a) of the Lanham Act protects unregistered trademarks from unauthorized uses likely to cause consumer confusion as to source. 15 U.S.C. § 1125(a)(1)(A) (2012). Protection under § 43(a) is sometimes referred to as the “common law” protection of trademarks, despite being based on statutory federal law. See *Matal*, 137 S. Ct. at 1753 (“[U]nregistered common law marks are protected by the [Lanham] Act.”) (quoting 3 J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 25A-198 (4th ed. 2017) (internal quotation marks omitted)).

<sup>25</sup> Lanham Act § 7(c), 15 U.S.C. § 1057(c) (2012).

<sup>26</sup> Lanham Act §§ 7(b), 33(a), 15 U.S.C. §§ 1057(b), 1115(a) (2012).

<sup>27</sup> A registered trademark becomes incontestable after it has been used continuously for five consecutive years. Lanham Act § 15, 15 U.S.C. § 1065 (2012). For an incontestable mark, “registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce.” Lanham Act § 33, 15 U.S.C. § 1115 (2012).

would be extremely beneficial for descriptive marks.<sup>28</sup>

Upon establishing the property right to the trademark, the owner can bring an infringement claim against individuals and entities that make unauthorized uses of its trademark. In trademark law, “likelihood of confusion” is a fundamental infringement claim by which plaintiff-trademark owners can assert their property right in the exclusive use of the marks against alleged infringers or imitators.<sup>29</sup> In response, defendants can raise various defenses, including the expressive use defense, which shields unauthorized uses of trademarks in artistic expressions under the First Amendment and the parodic use defense in response to a confusion-based infringement claim or a dilution claim.

While the two main relevant defenses are expressive use and parodic use, unauthorized uses of the Redskins trademark have so far involved parodic takes on the mark.<sup>30</sup> Thus, if litigated, such unauthorized uses would likely be examined as parodic use. This approach, however, relies heavily on consumer perception (i.e., whether consumers would see the defendant’s work as an obvious parody of the plaintiff’s trademark or instead be confused as to source). But reappropriation use would be better served by an expressive use approach, which centers less on consumer perception and more on whether the defendant explicitly misled consumers in its trademark usage.<sup>31</sup> This is because under parodic use, the more similar the defendant’s product and the plaintiff’s mark are, the more likely it is that consumers would form a false association between the two. But parodic reappropriation efforts necessarily entail using trademarks in a similar fashion as the trademark owners. Moreover, reappropriation use may not always entail parody, and disparaged groups should not be limited to only

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<sup>28</sup> A descriptive mark is a trademark that merely describes the goods to which it is affixed. Along the *Abercrombie* spectrum determining the level of protection afforded to different types of marks (generic, descriptive, suggestive, arbitrary, or fanciful), descriptive marks are not inherently distinctive and thus receive a low level of protection without a showing of secondary (i.e., acquired) meaning. *See* *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–11 (2d Cir. 1976).

<sup>29</sup> *See* *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979) (evaluating the strength of the plaintiff’s mark, the similarity of the marks, the proximity of the goods, evidence of actual confusion, market channels, the types of goods and degree of consumer care, the defendant’s intent, and the likelihood of expansion of the product line); *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961) (evaluating the strength of the plaintiff’s mark, the degree of similarity between the two marks, the proximity of the products, the likelihood the prior owner will enter the market, actual confusion, the defendant’s intent, difference in quality, and the sophistication and degree of care of consumers).

<sup>30</sup> *See infra* Section II.A.

<sup>31</sup> This Note discusses the limitations of applying the expressive use test to reappropriation uses in Section II.C.



humorous, non-commercial, or expressive uses to counter disparaging trademarks. Disparaged groups should be able to engage in full reappropriation use, with or without parody, and still be protected under the First Amendment against infringement claims. To illustrate the need for such a defense, the following Section examines the implications of *Matal v. Tam* and how it shifted the legal focus from evaluating disparaging trademarks at the registration stage to defenses brought in response to infringement claims.

### B. *How Matal v. Tam Changed the Legal Landscape*

Prior to *Matal v. Tam*, challenging disparaging trademarks meant disputing the registrations of the marks.<sup>32</sup> While *Matal v. Tam* concerned the registration of trademarks, it opened up the opportunity to explore how disparaging trademarks could continue to be countered in the infringement and defense stages. This Section analyzes how the case cemented the fate of the disparagement clause and sets up the context for examining the opinion’s impact on reappropriation efforts.<sup>33</sup>

#### 1. *Pre-Matal v. Tam: The Disparagement Clause as a Statutory Bar Against Trademark Registration*

Before the Supreme Court struck it down as facially unconstitutional, the disparagement clause had prohibited the registration of trademarks “which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.”<sup>34</sup> To determine whether a trademark was disparaging, an examining attorney would apply a two-part test. First, the examiner would consider “the likely meaning of the matter in question” based on dictionary definitions; the relationship of the matter to other elements in the mark; the nature of the goods or services; and the manner in which the mark is used in the marketplace in connection with the goods or services.<sup>35</sup> If the examiner found the meaning to “refer to identifiable persons, institutions, beliefs or national sym-

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<sup>32</sup> See, e.g., *Harjo v. Pro-Football, Inc.*, 565 F.3d 880 (D.C. Cir. 2009).

<sup>33</sup> In November 2011, Simon Tam filed an application with the PTO to register the mark, “THE SLANTS,” for “entertainment in the nature of live performances by a musical band,” only to be denied by an examining attorney under § 2(a) of the Lanham Act. *In re Tam*, 808 F.3d 1321, 1331 (Fed. Cir. 2015). Tam’s legal battle toward registering his band’s name was met with staunch opposition on the very basis that the name was racially disparaging.

<sup>34</sup> Act of July 5, 1946, Pub. L. No. 79-489, § 2(a), 60 Stat. 427, 428 (codified as amended at 15 U.S.C. § 1052(a)). This clause appeared in the original Lanham Act of 1946 and had remained the same prior to *Matal v. Tam*.

<sup>35</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1753 (2017).

bols,” the examiner would then analyze whether a substantial composite of the referenced group would find the mark disparaging.<sup>36</sup> For this second step, it would not matter whether the applicant is a member of the disparaged group or has good intentions for using the term.<sup>37</sup> Upon finding this substantial composite, the examiner would establish a prima facie case of disparagement and thus shift the burden to the applicant to show that the trademark was not disparaging.<sup>38</sup>

In *Matal v. Tam*, the Trademark Trial and Appeal Board (TTAB) affirmed the PTO examiner’s denial of registration. The TTAB found it “abundantly clear from the record not only that THE SLANTS . . . would have the ‘likely meaning’ of people of Asian descent, but also that such meaning has so been perceived” based on “significant responses by prospective attendees or hosts of the band’s performances” who had objected to the use of the term.<sup>39</sup> To establish that people of Asian descent were the mark’s referenced group, the TTAB relied on dictionary definitions; the band’s website display of the mark next to an image of an Asian woman, a rising sun, and a stylized dragon image; and a statement from Tam that he had selected the mark as a way to “own” the stereotype associated with the mark.<sup>40</sup> The TTAB justified its finding that the mark was disparaging to a substantial composite of the referenced group by way of “dictionary definitions, reference works and all other evidence [that] unanimously categorize[d] the word ‘slant,’ when meaning a person of Asian descent, as disparaging,” and based on evidence of objections to the term’s use from individuals and groups in the Asian community.<sup>41</sup>

## 2. *Matal v. Tam’s Invalidation of the Disparagement Clause as a Statutory Bar Against Trademark Registration*

It was only on en banc review by the Federal Circuit that Tam’s arguments finally held sway over the court.<sup>42</sup> Judge Moore, writing for

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<sup>36</sup> *Id.* at 1754 (“[The examiner would ask] whether that meaning may be disparaging to a substantial composite [but not necessarily a majority] of the referenced group.”).

<sup>37</sup> *Id.* (“The fact that an applicant may be a member of that group or has good intentions underlying its use of a term does not obviate the fact that a substantial composite of the referenced group would find the term objectionable.”).

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

<sup>39</sup> *In re Tam*, No. 85472044, 2013 WL 5498164, at \*5 (T.T.A.B. Sept. 26, 2013) [hereinafter Board Opinion].

<sup>40</sup> *In re Tam*, 808 F.3d 1321, 1332 (Fed. Cir. 2015).

<sup>41</sup> Board Opinion, *supra* note 39, at \*7.

<sup>42</sup> Tam first appealed to the Federal Circuit Court, where a panel affirmed the TTAB’s determination. While acknowledging the different meanings associated with the term “slants,” the panel found that substantial evidence supported the TTAB’s finding that the mark referred to people of Asian descent and was disparaging to a substantial composite of

the majority, defended the registration of “THE SLANTS” on free speech grounds: “It is a bedrock principle underlying the First Amendment that the government may not penalize private speech merely because it disapproves of the message it conveys.”<sup>43</sup> Invoking the power of words—“even a single word”<sup>44</sup>—Judge Moore noted Tam’s rationale for using his band’s name to comment on racial and cultural issues in the country.<sup>45</sup> The court also acknowledged that finding the disparagement clause to be unconstitutional could “lead to wider registration of marks that offend vulnerable communities.”<sup>46</sup> But despite recognizing that many of the marks rejected by the PTO as disparaging “convey hurtful speech that harms members of oft-stigmatized communities,”<sup>47</sup> the court justified vacating and remanding the case on the grounds that “the First Amendment protects even hurtful speech.”<sup>48</sup>

The final victory for Tam came on June 19, 2017, nearly six years after The Slants had first applied for trademark registration. The Supreme Court affirmed the Federal Circuit and struck down the disparagement clause as contravening the Free Speech Clause of the First Amendment:

The Government has an interest in preventing speech expressing ideas that offend. And, as we have explained, that strikes at the heart of the First Amendment. 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.”<sup>49</sup>

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the referenced group. *See In re Tam*, 785 F.3d 567, 571 (Fed. Cir.), *reh’g en banc granted, vacated*, 600 F. App’x 775 (Fed. Cir. 2015). The panel relied on evidence, including an article in which Tam described the origins of the band’s name; the band’s Wikipedia page and website; perceptions of the term within the Asian community; dictionary definitions; a brochure published by the Japanese American Citizens League describing the derogatory nature of the term when used in reference to people of Asian descent; and news articles and blog posts discussing the offensive nature of the band’s name. *Id.* at 571. Finding the mark to be disparaging under § 2(a), the panel held that binding precedent foreclosed Tam’s arguments challenging the constitutionality of the disparagement clause. *Id.* at 572–73.

<sup>43</sup> *In re Tam*, 808 F.3d at 1327.

<sup>44</sup> *Id.*

<sup>45</sup> *Id.* at 1327–28.

<sup>46</sup> *Id.* at 1357–58.

<sup>47</sup> *Id.* at 1328 (“The government cannot refuse to register disparaging marks because it disapproves of the expressive messages conveyed by the marks. It cannot refuse to register marks because it concludes that such marks will be disparaging to others.”).

<sup>48</sup> *Id.*

<sup>49</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (quoting *United States v. Schwimmer*, 279 U.S. 644, 655 (1929) (Holmes, J., dissenting)). While the case was decided on an 8-0 unanimous ruling, it consists of three separate opinions: Justice Alito writing for the

The government argued before the Court that all trademarks constitute commercial speech<sup>50</sup> and the disparagement clause operates to (1) protect marginalized groups from being “bombarded with demeaning messages” communicated via trademarks<sup>51</sup> and (2) promote an orderly flow of interstate commerce.<sup>52</sup> In rejecting the first argument, the Court articulated the aforementioned excerpt, framing this case as a First Amendment issue whereby hate speech merits constitutional protection. In response to the second argument, the Court reasoned that the disparagement clause failed even the *Central Hudson* test, under which a restriction on commercial speech must serve “a substantial interest” and be “narrowly drawn.”<sup>53</sup> While the Court was silent on whether protecting marginalized groups from disparaging marks or promoting the orderly flow of commerce constituted a substantial interest, the opinion expressed that the disparagement clause was “not ‘narrowly drawn’ to drive out trademarks that support invidious discrimination.”<sup>54</sup> Essentially, the clause was too broad because it applied to “any trademark that disparages any person, group, or institutions,” including trademarks that oppose discriminators.<sup>55</sup> Thus, the clause served not so much as an anti-discrimination clause, but one with a “happy-talk” requirement.<sup>56</sup> In

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majority; Justice Kennedy concurring in part and in judgment; and Justice Thomas concurring in part and in judgment. The crux of the case, however, can be distilled to the excerpt provided.

<sup>50</sup> *Id.*

<sup>51</sup> Brief for Petitioner at 48, *Matal v. Tam*, 137 S. Ct. 1744 (2017) (No. 15-1293) (quoting 808 F.3d at 1364 (Dyk, J., concurring in part and dissenting in part)).

<sup>52</sup> *Id.* at 49; *see also* 137 S. Ct. at 1764 (summarizing the petitioner’s argument that “[c]ommerce, we are told, is disrupted by trademarks that ‘involv[e] disparagement of race, gender, ethnicity, national origin, religion, sexual orientation, and similar demographic classification’” (quoting 808 F.3d at 1380–81 (Reyna, J.)) and that “[s]uch trademarks are analogized . . . to have an adverse effect on commerce” (citing 808 F.3d at 1380–81; Brief for Petitioner, *supra* note 51, at 49; Brief for NAO, *supra* note 7, at 18–20)).

<sup>53</sup> 137 S. Ct. at 1764 (quoting *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 564–65 (1980) (internal quotation marks omitted)). The Court applied the *Central Hudson* review to reject the government’s argument that the speech in question merits intermediate scrutiny under *Central Hudson* due to the inherent commercial nature of trademarks. *See In re Tam*, 808 F.3d 1321, 1355 (Fed. Cir. 2015).

<sup>54</sup> 137 S. Ct. at 1764–65.

<sup>55</sup> *Id.* at 1765 (explaining that the disparagement clause would apply to trademarks such as “Down with racists,” “Down with sexists,” and “Down with homophobes”).

<sup>56</sup> *Id.* University of Illinois College of Law Dean Vikram Amar has described the Court’s use of the term “happy-talk” as a reference to “the old adage that if you can’t say something nice about someone, don’t say anything at all.” Vikram David Amar, *Some Aspects of the Matal v. Tam Trademark Case that Would Have Benefitted from More Explanation*, VERDICT (July 14, 2017), <https://verdict.justia.com/2017/07/14/aspects-matal-v-tam-trademark-case-benefitted-explanation>; *see also* Caleb Trotter, *Symposium: The Constitution Prohibits Government’s “Happy-Talk” Requirement for Trademark Registration*, SCOTUSBLOG (June 19, 2017, 7:19 PM), <https://www.scotusblog.com/2017/06/>

light of these reasons, the Court invalidated § 2(a) and handed down a victory for The Slants.

### C. *Matal v. Tam’s Impact on Marginalized Groups and Reappropriation Efforts*

Against the backdrop of the Washington Redskins controversy, for which the Supreme Court had denied certiorari, *Matal v. Tam* came to represent a litmus test for the fate of § 2(a) of the Lanham Act. More importantly, the case raised questions about the future direction of the fight for genuine reappropriation by marginalized groups. This landmark decision signaled a clear victory for The Slants on constitutional grounds. But at what cost? While the impetus behind the band’s formation and name may certainly have been related to reclaiming a cultural identity or image, the Supreme Court decision also opened up the possibility for those outside of the referenced group to trademark or “own” racially and culturally disparaging marks. *Matal v. Tam* made it possible for individuals and organizations alike to benefit from the federal government’s—and now perhaps the judiciary’s—imprimatur on racist expressions.

#### 1. *The Power of Reappropriation*

The upshot of *Matal v. Tam* is that disparaged groups can now register disparaging marks that would have otherwise been denied under § 2(a).<sup>57</sup> Indeed, minority groups can empower themselves by reclaiming historically racist or hateful marks.<sup>58</sup> Reappropriation

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symposium-constitution-prohibits-governments-happy-talk-requirement-trademark-registration (“[B]ecause the disparagement clause is broadly written to prevent disparagement of any person or group, even trademarks that oppose discriminators would be rejected. Thus, the clause is more like a ‘happy-talk’ requirement than an anti-discrimination requirement.”).

<sup>57</sup> Registration would be granted if the proposed trademark would not be barred by other statutory bars under § 2. See *supra* note 22 and accompanying text.

<sup>58</sup> While reappropriation can be instrumental in achieving self-empowerment, not all members of marginalized communities agree that granting a governmental or judicial imprimatur on racially disparaging terms should come at the expense of marginalized groups. *Matal v. Tam* certainly created divisions within the Asian-American community. Perhaps the most prominent splinter is illustrated by the opposing stances taken by the Fred T. Korematsu Center for Law and Equality (Korematsu Center) and the National Asian Pacific American Bar Association (NAPABA), which submitted a joint amicus brief in support of the government; and the Asian American Legal Defense and Education Fund (AALDEF), which joined the American Civil Liberties Union (ACLU) in an amicus brief in support of Tam. See, e.g., Brief for the Fred T. Korematsu Center for Law and Equality et al. as Amici Curiae Supporting Petitioner, *Matal v. Tam*, 137 S. Ct. 1744 (2017) (No. 15-1293) [hereinafter Brief for Korematsu Center]; Brief for the ACLU et al. as Amici Curiae Supporting Respondent, *Matal v. Tam*, 137 S. Ct. 1744 (2017) (No. 15-1293) [hereinafter Brief for the ACLU]. Tam’s opponents expressed that the significance of the

affords a powerful tool for disparaged groups seeking to define their own identities, as “by its very nature [reappropriation] involves strategic use of a disparaging word in the hope that, over time, the word may lose its negative power, at least in certain contexts.”<sup>59</sup> The successful trademark registrations of phrases such as N.W.A. (“Niggaz Wit Attitudes”)<sup>60</sup> and “Dykes on Bikes”<sup>61</sup> have been touted as examples of disparaged communities’ embracing harmful words and celebrating otherwise disparaging views of their identities. In response to criticism that The Slants’ win enables groups like the Washington Redskins to profit from their use of disparaging trademarks, Tam has emphasized the importance of giving a voice to “marginalized groups who have been trying to get their own trademarks registered.”<sup>62</sup>

Linguists and sociologists have also long documented the importance of reappropriating slurs, viewing it as a powerful tool for “fostering . . . individual and group identity, recapturing ‘the right of self-definition and naming one’s own existence.’”<sup>63</sup> Slurs hurled by an oppressive or powerful majority not only perpetuate negative, harmful stereotypes, but also disenfranchise the target group members’ rights and ability to forge their own identities.<sup>64</sup> Reappropriation thus allows for self-defining or self-labeling by which disparaged groups can remove the sting of stigmas and “depriv[e] outgroup members of a linguistic weapon.”<sup>65</sup>

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disparagement clause lay in its role as “an important bulwark against a flood of racially discriminatory marks” and that “[p]rivate acts and expressions of racism can . . . take on a wholly different meaning and are particularly corrosive to our ideal of an integrated society when they occur with the sanction of the government.” Brief for Korematsu Center, *supra*, at 4, 22.

<sup>59</sup> Brief for the ACLU, *supra* note 58, at 11.

<sup>60</sup> Nina Totenberg, *In Battle over Band Name, Supreme Court Considers Free Speech and Trademarks*, NPR: LAW (Jan. 18, 2017, 4:50 AM), <https://www.npr.org/2017/01/18/510310945/in-battle-over-band-name-supreme-court-considers-free-speech-and-trademarks>.

<sup>61</sup> Marius Meland, *USPTO Oks “Dykes on Bikes” Trademark*, LAW360 (Dec. 11, 2005), <https://www.law360.com/articles/4741/uspto-oks-dykes-on-bikes-trademark>.

<sup>62</sup> Kat Chow, *The Slants: Fighting for the Right to Rock a Racial Slur*, NPR: CODE SWITCH (Jan. 19, 2017, 10:46 PM), <https://www.npr.org/sections/codeswitch/2017/01/19/510467679/the-slants-fighting-for-the-right-to-rock-a-racial-slur>.

<sup>63</sup> Todd Anten, Note, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388, 422 (2006) (quoting Robin Bronstema, *A Queer Revolution: Reconceptualizing the Debate over Linguistic Reclamation*, COLO. RES. LINGUISTICS, June 2004, at 1, 1) (alteration in original).

<sup>64</sup> *See id.* (drawing on scholarship to argue that “negative labels imposed upon subordinated groups by a powerful majority create perpetual stigmas,” and, through the imposition of these labels, “a powerful majority savagely defines the target group’s identity instead of allowing members to create their own identities”).

<sup>65</sup> Adam D. Galinsky et al., *The Reappropriation of Stigmatizing Labels: Implications for Social Identity*, in 5 IDENTITY ISSUES IN GROUPS: RESEARCH ON MANAGING GROUPS

## 2. *The Process of Reappropriating Disparaging Trademarks*

Notwithstanding *Matal v. Tam*, disparaged groups may want to reappropriate marks that another entity already owns. Ideally, the disparaging trademark would be cancelled, denied registration, or abandoned. However, *Matal v. Tam* foreclosed challenging registrations under the disparagement clause. That the term “Redskins” is currently trademarked and owned by the football team stands as a barrier to reappropriation efforts. This Note proposes a way for disparaged groups to reappropriate existing disparaging trademarks owned by those outside of the disparaged group and still receive protection under the First Amendment.

The critical role that reappropriation plays in promoting self-definition demands higher protection for disparaged groups using trademarks for reappropriation purposes. Just as offending groups have a constitutional right to register disparaging marks, disparaged groups have the right to exercise free speech by countering “the thought . . . we hate”<sup>66</sup> with speech that transforms the underlying hate into a point of pride for their identities. Reappropriation use thus merits as much protection as disparaging marks; such an exercise is grounded in the fundamental value of free speech and comports with the policy rationale espoused in *Rogers v. Grimaldi* that the Lanham Act should apply “only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”<sup>67</sup> As such, absent explicit misleadingness as to the source or content of the work, there is a strong presumption for protecting the exercise of free speech.<sup>68</sup>

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AND TEAMS 221, 232 (Jeffrey T. Polzer ed., 2003); *see also* Anten, *supra* note 63, at 422 (“The reappropriation of a slur is thus ideal because it not only removes a stigma, but it also cultivates self-definition in the target group—the recipients of the label actively choose to incorporate it into their identities rather than having it passively thrust upon them.”).

<sup>66</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (quoting *United States v. Schwimmer*, 279 U.S. 644, 655 (1929) (Holmes, J., dissenting)) (Alito, J., majority).

<sup>67</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); *see id.* at 998 (“Because overextension of Lanham Act restrictions in the area of titles might intrude on First Amendment values, we must construe the Act narrowly to avoid such a conflict.”).

<sup>68</sup> *See, e.g.,* *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900, 902 (9th Cir. 2002) (first citing *L.L. Bean, Inc. v. Drake Publishers, Inc.*, 811 F.2d 26, 29 (1st Cir. 1987) (“Trademark rights do not entitle the owner to quash an unauthorized use of the mark by another who is communicating ideas or expressing points of view.”); then citing *Yankee Publ’g, Inc. v. News Am. Publ’g, Inc.*, 809 F. Supp. 267, 276 (S.D.N.Y. 1992) (“[W]hen unauthorized use of another’s mark is part of a communicative message and not a source identifier, the First Amendment is implicated in opposition to the trademark right.”)) (“Trademarks . . . fill . . . gaps in our vocabulary and add . . . flavor to our expressions. Once imbued with . . . expressive value, the trademark . . . assumes a [new] role . . . . The

The need for reappropriation becomes all the more apparent in light of the reality that disparaging trademarks can have detrimental consequences for American Indians' sense of identity. The negative ramifications inflicted on marginalized groups targeted by disparaging expressions are real and concrete, for "[d]isparagement demeans, dehumanizes, and undercuts the dignity of the targeted group [and] normalizes racial discrimination and ingrains racial stereotypes in American commerce and society."<sup>69</sup> This is particularly true in the context of racially disparaging sports team mascots and marks, such as that of the Washington Redskins.<sup>70</sup> Due to the general popularity of sports and the lack of alternative representations of the target group in the media, racially disparaging mascots and team names cement a one-dimensional and denigrating characterization of how members of the target group "should look and behave."<sup>71</sup> Such trademarks injure members of the referenced groups. For example, racially disparaging sports mascots "demean and dehumanize" American Indians by entrenching racist attitudes towards the group and instilling a default impression of them as primitive or savage.<sup>72</sup> Far from empowering the target group, such caricatures perpetuate the degradation of group

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First Amendment offer[s] little protection for a competitor who labels its . . . good with a confusingly similar mark, but . . . the trademark owner [cannot] control public discourse.").

<sup>69</sup> Brief for NAO, *supra* note 7, at 23. The harms suffered can be broadly categorized into four types: (1) stereotype threat; (2) modeling function effect; (3) the spread of harmful stereotypes about the referenced group; and (4) infliction of concrete injury. *See id.* at 23–24, 28–32. These different types of harms come down to the same point: The use of disparaging slurs on a public platform normalizes racial discrimination and perpetuates and ingrains racial stereotypes in commerce and society at large. The modeling function effect refers to the way in which disparaging trademarks send a message that discrimination against targeted groups is acceptable behavior. *Id.* at 24. Given the prevalence of trademarks, those containing racially disparaging expressions "communicate societal approval of discrimination" that would have otherwise been internally suppressed due to societal pressures. *Id.* In conveying this message, such marks condone and normalize racial prejudice.

<sup>70</sup> *See* Geoffrey Nunberg, *When Slang Becomes a Slur*, ATLANTIC (June 23, 2014), <https://www.theatlantic.com/entertainment/archive/2014/06/a-linguist-on-why-redskin-is-racist-patent-overtuned/373198>. *See generally* Brief for NAO, *supra* note 7 (reporting on the racialized harm and violence American Indian youth face due to the perpetuation of slurs, racial epithets, and negative stereotypes about American Indians in sports team mascots, names, and logos).

<sup>71</sup> Brief for NAO, *supra* note 7, at 32.

<sup>72</sup> *Id.* at 29–30. In 2005, the American Psychological Association recommended the "immediate retirement of all American Indian mascots, symbols, images, and personalities by schools, colleges, universities, athletic teams and organizations." *Summary of the APA Resolution Recommending Retirement of American Indian Mascots*, AM. PSYCHOL. ASS'N, <https://www.apa.org/pi/oema/resources/indian-mascots> (last visited Aug. 16, 2019). According to documented research, "American Indian mascots are harmful not only because they are often negative, but because they remind American Indians of the limited ways in which others see them. This in turn restricts the number of ways American Indians can see themselves." *Id.* (quoting Stephanie Fryberg, Ph.D., University of Arizona).



members’ personhood. Reappropriation use would thus empower American Indian organizations and individuals to remove the sting of negative stereotypes and redefine otherwise disparaging terms in their own way.

For such reappropriation efforts to succeed, however, disparaged groups must first be willing to reclaim terms such as “Redskins.” In the case of “Redskins,” the word must be capable of being stripped of its negative connotation and embraced by American Indians as a term of empowerment. There must be some desire on the part of American Indian organizations and individuals to perceive the term in a positive light. Although the affected group may eventually embrace certain uses of disparaging terms, this acceptance depends on a number of nuanced factors, such as “the identity of the speaker, the intent of the speech, and the context in which it is made.”<sup>73</sup> American Indians appear divided regarding the appropriateness of the term and the gravity of the naming controversy.<sup>74</sup> Not all American Indians object to the term, as some scholastic American Indian teams bear nicknames consisting of “Redskins” as a “qualified form of a reclaimed epithet”<sup>75</sup> in the sense of “[i]f you want redskin savages, then we’ll give you redskin savages.”<sup>76</sup> Of course, such reappropriation efforts may appear miniscule in light of decades of resolutions signed by representatives of various tribes opposing the use of all American Indian sports mascots and nicknames.<sup>77</sup> However, meanings of words can evolve over time to become reclaimed epithets. The LGBTQ+ community has reclaimed terms such as “dyke,” “queer,” and “F.A.G.”

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<sup>73</sup> Brief for the ACLU, *supra* note 58, at 12.

<sup>74</sup> Dan Barry, *A Heated Linguistic Debate: What Makes ‘Redskins’ a Slur?*, N.Y. TIMES (May 21, 2016), <https://www.nytimes.com/2016/05/22/sports/football/redskins-poll-prompts-a-linguistic-debate.html> (noting there is “disagreement among American Indians about the seriousness of the issue” and “[t]here are a lot of people out there who have a problem with it . . . . But there are a lot of other people who really don’t care either way—who say we have bigger problems to worry about than a sports team’s mascot and a name” (quoting Debra Krol, a journalist in Arizona and an enrolled member of the Xolon Salinan Tribe on the central coast of California)).

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

<sup>76</sup> *Id.* (quoting Geoffrey Nunberg, the linguistic expert for the American Indians who petitioned to have the federal government cancel the Washington Redskins’ trademark registration).

<sup>77</sup> See Jay Rosenstein, *How Do Native Americans Really Feel About the Washington Redskins Nickname? Don’t Use the Phone*, HUFFPOST (May 31, 2016), [https://www.huffingtonpost.com/jay-rosenstein/how-do-native-americans-really-feel-about-redskins-nickname\\_b\\_10199688.html](https://www.huffingtonpost.com/jay-rosenstein/how-do-native-americans-really-feel-about-redskins-nickname_b_10199688.html) (reporting on various resolutions from 2001 to 2014 that were signed by American Indian tribes, councils, and organizations calling for the termination of sports mascots and nicknames featuring American Indians). While these resolutions do not represent the opinion of every member of the different tribes, the authority of the signers to speak on behalf of the tribes is significant and valid. *Id.*

(abbreviation for the trademarked term, “Fabulous and Gay”).<sup>78</sup> Given the malleability of words, perhaps the majority of American Indians will one day view “Redskins” as a reclaimed epithet. This Note operates on the premise that even if a substantial composite of the disparaged group is not currently willing to reclaim the term, American Indians should be able to reappropriate the federally trademarked term in full if they wish to do so in the future.

## II

### THE INADEQUACIES OF EXISTING LEGAL FRAMEWORKS

Under the existing framework, parodic use and expressive (artistic) use are two potential defenses applied to unauthorized uses of trademarks made to convey a greater point, whether that be political, comedic, or general social commentary or criticism. Part II presents examples of parodic efforts levied against the Redskins trademark and explains the inadequacies of the parodic use defense for analyzing reappropriation use. It then outlines the purpose and function of trademark law to illustrate the balancing test espoused in the expressive use defense for applying the Lanham Act when an unauthorized user’s freedom of expression is at stake. The Part concludes by explaining the limitations of the expressive use defense for protecting reappropriation use to set up the framework under which disparaged groups could fully reclaim disparaging trademarks and raise reappropriation use as a successful defense to infringement claims.

#### A. *Parodic Efforts and the Limitations of the Parodic Use Defense*

To explore how disparaged groups could use trademark law to reclaim terms trademarked by non-disparaged entities, this Note focuses on how American Indian organizations could reclaim “Redskins” in full. While parody is not necessary for reclaiming disparaging terms, several efforts have targeted the Redskins by using humor. However, these efforts either did not use the “Redskins” term in full,<sup>79</sup> or did include the full term but were orchestrated by those outside of the disparaged group.<sup>80</sup> This Section examines various

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<sup>78</sup> Anten, *supra* note 63, at 412–13; Barry, *supra* note 74.

<sup>79</sup> See *infra* notes 81–85, 90–93 and accompanying text; see also Washington Redhawks (@redhawksc), TWITTER, <https://twitter.com/redhawksc> (last visited Aug. 16, 2019).

<sup>80</sup> See *infra* notes 96–100 and accompanying text; see also New Redskins Logo (@newredskinslogo), *A New Logo for the Washington Redskins*, TUMBLR, <https://newredskinslogo.tumblr.com> (last visited Aug. 16, 2019); Hari Kondabolu (@harikondabolu), TWITTER (Oct. 16, 2014, 2:29 PM), <https://twitter.com/harikondabolu/status/522862024410144768>.

parodic uses of the Redskins trademark to explain why the parodic use defense is insufficient for reappropriation use.

In December 2017, seven months after the Department of Justice decided to forego mounting legal challenges against the Washington Redskins’ trademark, the team seemed to have a sudden change of heart. A press release from what appeared to be the team’s page announced the franchise’s switch to the “Washington Redhawks”—a new team name and logo—starting in the fall of 2018.<sup>81</sup> “The hawk was chosen to represent the strength, speed and courage of the Washington Redhawks’ players,” the announcement read.<sup>82</sup> Headlines from prominent news and sports publication sites reporting the change soon followed.<sup>83</sup> “Native Leaders Celebrate a Victory as Washington Football Changes Mascot to the Redhawks,” read one headline from a site resembling the *Washington Post*.<sup>84</sup> Between the team announcement and pieces released from sites purporting to be the *Washington Post*, ESPN, Bleacher Report, and *Sports Illustrated*, fans and the public alike momentarily believed that team owner Dan Snyder chose to honor American Indians by changing the team’s name, logo, and mascot.<sup>85</sup> But that same day, the Washington

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<sup>81</sup> *Go Washington Redhawks!*, REDHAWKS (Dec. 13, 2017), <https://web.archive.org/web/20181111024718/http://washingtonredhawks.com> (archived Nov. 11, 2018).

<sup>82</sup> Cristiano Lima, *Washington Redskins Swat Down Hoax Stories on Name Change*, POLITICO (Dec. 13, 2017), <https://www.politico.com/story/2017/12/13/washington-redskins-swat-down-hoax-story-on-name-change-294990>.

<sup>83</sup> The pieces looked like they were published by the *Washington Post*, ESPN, Bleacher Report, and *Sports Illustrated*. See *Native Leaders Celebrate a Victory as Washington Football Changes Mascot to the Redhawks*, WASH. POST (Dec. 13, 2017) [hereinafter WASH. POST HOAX], <https://web.archive.org/web/20171216201320/http://washpostsports.com/news/2017/12/13/native-leaders-celebrate-a-victory-as-washington-football-changes-mascot-to-the-redhawks> (archived Dec. 16, 2017); *Dan Snyder Honors Native Americans, Changes Team Mascot to Washington Redhawks*, ESPN (Dec. 13, 2017), [https://web.archive.org/web/20171226075429/http://espnsports.news/nfl/story/\\_/id/68393572/dan-snyder-honors-native-americans-changes-team-mascot-to-washington-redhawks](https://web.archive.org/web/20171226075429/http://espnsports.news/nfl/story/_/id/68393572/dan-snyder-honors-native-americans-changes-team-mascot-to-washington-redhawks) (archived Dec. 26, 2017); *Washington Redskins Will Change Name to Washington Redhawks*, BLEACHER REPORT (Dec. 13, 2017), <https://web.archive.org/web/20171214062131/http://bleacherreport.news/washington-redskins-will-change-name-to-washington-redhawks> (archived Dec. 14, 2017); *Washington Football Ditches Controversial Name for Redhawks*, SPORTS ILLUSTRATED (Dec. 13, 2017), <https://web.archive.org/web/20171213152939/http://sportsillustrated.news/nfl/2017/12/13/washington-football-ditches-controversial-name-for-redhawks> (archived Dec. 13, 2017).

<sup>84</sup> WASH. POST HOAX, *supra* note 83.

<sup>85</sup> See Demetrius Bell, *The Washington Redhawks Hoax Is Actually a Well-Executed Concept Design*, FORBES (Dec. 15, 2017), <https://www.forbes.com/sites/demetriusbell/2017/12/15/the-washington-redhawks-hoax-is-actually-a-well-executed-concept-design> (“For a quick second, it sure seemed like the team had made what many figured was an unthinkable move and changed its polarizing nickname and overhauling their visual identity. . . . [The] links . . . , at first glance, seemed to link back to sites like Sports Illustrated, ESPN, and Bleacher Report.”); Benjamin Freed, *How a Group of Native American Activists Used Fake News to Push for a Redskins Name Change*,

Redskins issued a statement, saying: “This morning, the Redskins organization was made aware of fraudulent websites about our team name. The name of the team is the Washington Redskins and will remain that for the future.”<sup>86</sup> The statement fell perfectly in line with Snyder’s previous rhetoric, as he had vowed to “NEVER” change the team name.<sup>87</sup>

Rising Hearts, a D.C.-based, women-led Indigenous advocacy group, soon revealed itself as the mastermind of the spoofs.<sup>88</sup> In a press release, the group stated that the phony websites were part of a “culture-jamming” effort<sup>89</sup> using political satire and parody to restart

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WASHINGTONIAN (Dec. 13, 2017), <https://www.washingtonian.com/2017/12/13/group-native-american-activists-used-fake-news-push-redskins-name-change> (“The pages, copying the looks of the *Washington Post*, *Sports Illustrated*, ESPN, and Bleacher Report, along with a WashingtonRedhawks.com site that mimics the actual team’s website, circulated on social media . . .”); Rick Maese, *American Indian Activists Seek to Rekindle Debate on Redskins Nickname*, WASH. POST (Dec. 13, 2017), [https://www.washingtonpost.com/sports/redskins/fake-online-web-pages-claim-redskins-have-changed-their-nickname/2017/12/13/07789ccc-e02f-11e7-89e8-edec16379010\\_story.html](https://www.washingtonpost.com/sports/redskins/fake-online-web-pages-claim-redskins-have-changed-their-nickname/2017/12/13/07789ccc-e02f-11e7-89e8-edec16379010_story.html) (“It was football’s spin on fake news, but the websites, created by an alliance of American Indian activists, were convincing enough to fool some and entice many others to share the links on social media, reigniting the nickname controversy.”); Travis Waldron, *Native American Activists Create Spoof Website to Call for Redskins Name Change*, HUFFPOST (Dec. 13, 2017), [https://www.huffingtonpost.com/entry/washington-redskins-redhawks-name-fake-site\\_us\\_5a318d25e4b01bdd765999d0?urc](https://www.huffingtonpost.com/entry/washington-redskins-redhawks-name-fake-site_us_5a318d25e4b01bdd765999d0?urc) (“For a few hours on Wednesday morning, a small group of Native American activists convinced the internet that Washington’s professional football franchise had finally decided to change its racist ‘Redskins’ team name.”).

<sup>86</sup> Redskins Public Relations, *Statement from the Washington Redskins*, REDSKINS (Dec. 13, 2017, 5:23 AM), <https://www.redskins.com/news/statement-from-the-washington-redskins-19973366>; see also Samantha Pell, *‘Washington Redhawks’ Organizers Claim Success, Say Articles Were Satire, Not ‘Fake News,’* WASH. POST (Dec. 15, 2017), <https://www.washingtonpost.com/news/football-insider/wp/2017/12/14/washington-redhawks-organizers-claim-success-say-articles-were-satire-not-fake-news>.

<sup>87</sup> Pell, *supra* note 86; Theresa Vargas & Annys Shin, *President Obama Says, ‘I’d Think About Changing’ Name of Washington Redskins*, WASH. POST (Oct. 5, 2013), [https://www.washingtonpost.com/local/president-obama-says-id-think-about-changing-name-of-washington-redskins/2013/10/05/e170b914-2b70-11e3-8ade-a1f23cda135e\\_story.html](https://www.washingtonpost.com/local/president-obama-says-id-think-about-changing-name-of-washington-redskins/2013/10/05/e170b914-2b70-11e3-8ade-a1f23cda135e_story.html) (quoting Washington Redskins owner Dan Snyder).

<sup>88</sup> Pell, *supra* note 86.

<sup>89</sup> “‘Culture jamming’ refers to . . . tactics deployed by activists to critique, subvert, and otherwise ‘jam’ the workings of consumer culture. Ranging from media hoaxes and advertising parodies to flash mobs and street art, [culture jamming] seek[s] to interrupt the flow of dominant, capitalistic messages that permeate our daily lives.” *Culture Jamming: Activism and the Art of Cultural Resistance*, NYU PRESS, <https://nyupress.org/9781479870967> (last visited Aug. 16, 2019); see Alexis C. Madrigal, *The New Culture Jamming: How Activists Will Respond to Online Advertising*, ATLANTIC (May 15, 2012), <https://www.theatlantic.com/technology/archive/2012/05/the-new-culture-jamming-how-activists-will-respond-to-online-advertising/257176> (explaining that culture jamming “aim[s] to disrupt consumer culture by transforming corporate advertising with subversive messages” and “use[s] the power of brands against themselves”); Hannah Rubenstein, *The Future of Culture Jamming*, WASH. POST (May 21, 2012), <https://www.washingtonpost.com/>

the conversation on the Washington Redskins’ disparaging name.<sup>90</sup> Rebecca Nagel, a Rising Hearts organizer, stated that the purpose of the site launches was “to show the NFL and the Washington Football franchise how easy, popular, and powerful changing the name could be.”<sup>91</sup> The satire and parody-based effort was a way to reignite an issue that had waned in people’s minds, despite protests, petitions, and past rallies.<sup>92</sup> It was especially after *Matal v. Tam* that Rising Hearts began working on the elaborate spoof series.<sup>93</sup> Although at least one of the sites that Rising Hearts had parodied stated they were looking into legal responses,<sup>94</sup> no known actions have been taken yet. The hoax sites have since been taken down and their archived pages are accompanied by explicit disclaimers describing them as parody for advocacy efforts and in no way affiliated with, sponsored by, or associated with Dan Snyder, the NFL, or the franchise team.<sup>95</sup>

Others not belonging to the disparaged group have also poked fun at the Washington Redskins by using the team’s mark, but this occurred prior to *Matal v. Tam* and while the Redskins’ trademark was deemed disparaging by the PTO. In 2014, comedian Hari Kondabolu sent out an open invitation to the public, soliciting new logo ideas for the Washington Redskins to be featured on his Tumblr

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blogs/innovations/post/the-future-of-culture-jamming/2012/05/21/gIQAtw3KfU\_blog.html (“[A] particular form of culture jamming known as subvertising . . . mak[es] spoofs or parodies of corporate and political advertisements with the intent to expose assumptions behind commercial culture.”). For more information on culture jamming, see generally CULTURE JAMMING: ACTIVISM AND THE ART OF CULTURAL RESISTANCE (Marilyn DeLaure & Moritz Fink eds., 2017).

<sup>90</sup> Press Release, Washington Redhawks, After Culture Jamming the Washington Football Team, Native Advocates Explain Their Reasons Behind Wednesday’s Online Action, Tell Dan Snyder to Change the Name Already (Dec. 13, 2017), [https://web.archive.org/web/20180825064003/http://washingtonredhawks.com/press\\_release.pdf](https://web.archive.org/web/20180825064003/http://washingtonredhawks.com/press_release.pdf) (archived Aug. 25, 2018); see also Pell, *supra* note 86.

<sup>91</sup> Freed, *supra* note 85; see also Press Release, Washington Redhawks, *supra* note 90; Washington Redhawks (@redhawksdc), TWITTER (Dec. 13, 2017, 10:50 AM), <https://twitter.com/redhawksdc/status/941017386651660288>.

<sup>92</sup> Pell, *supra* note 86.

<sup>93</sup> Freed, *supra* note 85.

<sup>94</sup> Lima, *supra* note 82 (“A spokesperson for ESPN said their legal team is ‘investigating’ the matter.”).

<sup>95</sup> For instance, the Washington Redhawks page included the disclaimer, “This website is a parody and is not endorsed by the Washington football team, the NFL, Dan Snyder, or any of their affiliates because, in 2017, these people think it’s still OK to use a racial slur for their mascot.” *Go Washington Redhawks!*, *supra* note 81. Each disclaimer directs readers to the press release (“See our press release for more details”) and directs readers to the December 13, 2017 version of the site. *Id.* No disclaimer is found on the *Sports Illustrated* piece but that could be because the page with the disclaimer was not archived for December 13, 2017. *Washington Football Ditches Controversial Name for Redhawks*, *supra* note 83.

page.<sup>96</sup> Among the most popular submissions were images of severely sunburned white people, including a photo of Dan Snyder with “Redskins” written below in the same font type as the Redskins trademark, parodying the team’s logo of a purported noble image of an American Indian man.<sup>97</sup> The comedy show, *South Park*, also joined in, taking on the Washington Redskins naming controversy in the first episode of its eighteenth season. Titled “Go Fund Yourself,” the episode revolves around the South Park boys’ adopting the “Washington Redskins” as the name of their startup company upon finding out about the trademark cancellation under the disparagement clause. A furious Dan Snyder storms into the company’s office full of the Washington Redskins logo and tries to stop the name use. He reasons, “Don’t you see that when you call your organization, the ‘Washington Redskins,’ it’s offensive to us?”<sup>98</sup>—only to hear, “Guys, guys! I have total respect for you. When I named my company ‘Washington Redskins,’ it was out of deep appreciation for your team and your people.”<sup>99</sup> The exchange underscores the absurdity of the Washington Redskins’ claim throughout its legal battles that it employs “Redskins” in an “honorific” way to show “reverence toward the proud legacy and traditions of Native Americans.”<sup>100</sup>

As successful as the parodies were, the Rising Hearts’ websites were organized by an American Indian advocacy group but did not use the full trademark. The other efforts used the trademark in full but were not created by members of the disparaged group. This Note argues that disparaged groups should be able to reappropriate disparaging trademarks in full and still receive First Amendment protection even if they do not engage in parody. While a parodic use defense exists in trademark law, it is not ideal for defendants engaging in reappropriation use because determining whether someone’s trademark use is a permissible parody depends on consumer perception, not the defendant’s conduct.<sup>101</sup> The more similar the defendant’s parody is to

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<sup>96</sup> Ron Dicker, *Redskins Should Change Logo to Sunburned White Person*, *Comedian Says*, HUFFPOST (Oct. 22, 2014), [https://www.huffingtonpost.com/2014/10/22/redskins-logo-sunburned-w\\_n\\_6027836.html](https://www.huffingtonpost.com/2014/10/22/redskins-logo-sunburned-w_n_6027836.html); *A New Logo for the Washington Redskins*, TUMBLR, *supra* note 80.

<sup>97</sup> *A New Logo for the Washington Redskins*, *supra* note 80.

<sup>98</sup> South Park Studios, *South Park – Season 18 Premiere*, YOUTUBE (Sept. 21, 2014), <https://www.youtube.com/watch?v=RNK-jYzaWtw>.

<sup>99</sup> *Id.*

<sup>100</sup> Nunberg, *supra* note 70 (quoting trademark attorney Robert Raskopf and Washington Redskins team president Bruce Allen).

<sup>101</sup> See *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 256 (4th Cir. 2007) (holding that “Chewy Vuiton” was “not likely to cause confusion” required to establish trademark infringement). In the parody analysis, the more similar the defendant’s work is to the plaintiff’s mark, the better it is for the plaintiff’s case, as the defendant

the plaintiff’s trademark, the more likely it is that consumers would form a false association between the two.<sup>102</sup> However, efforts to reapropriate disparaging marks by using parody would necessitate using trademarks in a similar manner as the trademark owners.

### B. *A Balancing Test for Applying the Lanham Act*

Since the 1980s, U.S. courts have relied on the economic benefits of trademarks to justify trademark protection under the Lanham Act. Based on the Chicago School’s economic analysis of law, courts and scholars have described the dual role of trademarks as minimizing consumer search costs and incentivizing companies to produce products at a consistent quality.<sup>103</sup> In *Qualitex Co. v. Jacobson Products Co.*,<sup>104</sup> the Supreme Court established the two-fold purpose and function of trademark law as seeking to prevent consumer confusion as to source,<sup>105</sup> while ensuring that legitimate, bona fide producers are rewarded with the financial and reputational benefits that accompany quality products.<sup>106</sup> Reflecting the prevalent view of trademarks by U.S. courts,<sup>107</sup> *Qualitex* underscored the idea that preventing con-

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would benefit from a more readily-recognized distinction. The proximity factor goes to how close or far away the defendant and plaintiff’s products are in the market. The stronger the plaintiff’s mark, the less protection afforded, since it is more likely that consumers would understand the defendant’s work is only a parody of the plaintiff’s mark. The intent factor is neutralized, as it focuses on the intent to create parody, not to confuse consumers as to source. For consumer sophistication, courts look to the defendant’s buyers to see whether they perceive the work as a parody. *Id.*

<sup>102</sup> See, e.g., *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 776–77 (8th Cir. 1994) (“A parody must convey two . . . messages: that it is the original, but also that it is *not* the original and is instead a parody. To the extent that it does only the former but not the latter, it is . . . vulnerable under trademark law, since the customer will be confused.” (quoting *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Grp., Inc.*, 886 F.2d 490, 494 (2d Cir. 1989))).

<sup>103</sup> See *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1429 (7th Cir. 1985) (Easterbrook, J.) (“Easily identified trademarks reduce the costs consumers incur in searching for what they desire, and the lower the costs of search the more competitive the market. A trademark also may induce the supplier of goods to make higher quality products and to adhere to a consistent level of quality.”).

<sup>104</sup> 514 U.S. 159 (1995).

<sup>105</sup> In trademark law, “likelihood of confusion” is a fundamental infringement claim by which defendant-trademark owners can assert their property right in the exclusive use of their marks against alleged infringers or imitators. See *supra* note 29 and accompanying text.

<sup>106</sup> *Qualitex*, 514 U.S. at 163–64 (explaining that trademark law, “by preventing others from copying a source-identifying mark, ‘reduces the customer’s costs of shopping and making purchasing decisions’ . . . . At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputation-related rewards associated with a desirable product”) (citations omitted).

<sup>107</sup> By the 1980s, prior to the ruling in *Qualitex*, U.S. courts had already begun adopting the idea that trademarks help consumers select goods by “identifying the source of the goods, [and] . . . convey[ing] valuable information to consumers at lower costs.” *Scandia*

sumer confusion is a fundamental goal in trademark law. Even qualifying for federal trademark protection requires that the mark be distinctive of source (i.e., that there be a single source, even if unknown or anonymous, behind the product to which the trademark is affixed).<sup>108</sup> However, this key goal of preventing consumer confusion does not appear to outweigh the fundamental First Amendment value of free speech when it comes to expressive uses of trademarks.

As illustrated in *Rogers v. Grimaldi*—the definitive case on expressive or artistic uses of trademarks—and its progeny, courts use a balancing approach to evaluate whether to apply the Lanham Act where the public interest in avoiding consumer confusion outweighs the public interest in free speech.<sup>109</sup> *Rogers* involved the Federico Fellini film, *Ginger and Fred*, that used dancer Ginger Rogers’s name in its title. Described by the producers “as a satire of contemporary television variety shows,” the film follows “the story of two fictional Italian cabaret performers, Pippo and Amelia, who . . . imitated [the dance duo Ginger] Rogers and [Fred] Astaire.”<sup>110</sup> Finding no § 43(a) violation for using Rogers’s name, the Second Circuit sought to strike a balance between two competing policy objectives: on the one hand, the public interest in avoiding consumer confusion, and on the other, free expression. The court stated that § 43(a) rights for unregistered trademarks should apply to artistic works only when the public interest in avoiding consumer confusion outweighs the public interest in free expression.<sup>111</sup>

While *Rogers* involved an unregistered trademark in the expressive use context, subsequent cases show that the balancing approach applies to registered trademarks as well.<sup>112</sup> In 2013, the Ninth Circuit echoed *Rogers*’s resounding principle of protecting free speech in *Brown v. Electronic Arts*, a case about virtual representations of pro-

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*Down Corp.*, 772 F.2d at 1429; see BEEBE, *supra* note 20, at 22 (“By the 1980s, American courts were describing trademarks and trademark law in . . . terms which still resonate today. Reflecting the rise of the Chicago School economic analysis of law, Judge Easterbrook described the economic benefits of trademarks and trademark protection in *Scandia Down Corp.* . . .”).

<sup>108</sup> See Lanham Act § 45, 15 U.S.C. § 1127 (2012). The source, however, may be anonymous as the buyer “need not know the corporate or personal name of that source. When the buyer sees any related product with that mark, she is entitled to assume that it comes from the same anonymous source . . . .” J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3.12 (2019).

<sup>109</sup> See *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989). The three-step test will be discussed more in detail below. See *infra* Section II.C.

<sup>110</sup> *Rogers*, 875 F.2d at 996–97.

<sup>111</sup> *Id.* at 999. In the context of allegedly misleading titles using a celebrity’s name, that balance will normally not support the application of the Lanham Act. *Id.* at 999–1000.

<sup>112</sup> See, e.g., *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792 (9th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002).



fessional athletes in video games.<sup>113</sup> Arguing that “[t]he language in *Rogers* is clear,” the Ninth Circuit stated the “test is applicable when First Amendment rights are at their highest—when expressive works are involved.”<sup>114</sup> The court underscored the vital need to protect defendants’ free speech, expressing that “[i]ntellectual property rights aren’t free [but are] imposed at the expense of future creators and of the public at large, . . . and [that] the *Rogers* test applies when this expense is most significant.”<sup>115</sup> The Ninth Circuit has since interpreted *Rogers* as using the First Amendment as “a rule of construction to avoid conflict between the Constitution and the Lanham Act.”<sup>116</sup>

This Note proposes a new test based on the expressive use defense due to the *Rogers* rationale for when to apply the Lanham Act where the defendant’s freedom of expression is at stake. Courts have adopted the *Rogers* approach that the Lanham Act should apply “only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”<sup>117</sup> Because reappropriation use is an exercise of free speech,<sup>118</sup> that would also be valued and weighed heavily under the balancing approach. Unless the use is explicitly misleading consumers as to the source of the expression, reappropriation use would and should bear a strong presumption of protection.

### C. *The Expressive Use Defense and Its Limitations*

In response to the plaintiff’s likelihood of confusion infringement claim, the defendant could argue that its use of the plaintiff’s mark is expressive (i.e., artistic).<sup>119</sup> This defendant-friendly test places the

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<sup>113</sup> 724 F.3d 1235 (9th Cir. 2013).

<sup>114</sup> *Id.* at 1245.

<sup>115</sup> *Id.* (quoting *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1516 (9th Cir. 1993) (Kozinski, J., dissenting from denial of rehearing en banc)).

<sup>116</sup> *Gordon v. Drape Creative, Inc.*, 909 F.3d 257, 264 (9th Cir. 2018).

<sup>117</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989); see also *Walking Mountain Prods.*, 353 F.3d at 807 (applying *Rogers* test to sustain photographer’s use of Barbie mark); *MCA Records, Inc.*, 296 F.3d at 902 (applying *Rogers* test to conclude musicians’ use of Barbie in song title was not infringement).

<sup>118</sup> See *supra* Section I.C.

<sup>119</sup> So far, the test has applied to film titles (*Rogers*, 875 F.2d at 999), greeting cards (*Gordon*, 909 F.3d at 268), videogames (*Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1243 (9th Cir. 2013); *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008)), artistic photographs (*Walking Mountain Prods.*, 353 F.3d at 796), and song lyrics (*MCA Records, Inc.*, 296 F.3d at 899). The *Rogers* court recognized that “[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection.” 875 F.2d at 997. Generally, courts treat *Rogers v. Grimaldi* as replacing the *Polaroid* factors (the typical likelihood of confusion infringement claim standard used in the Second Circuit and others) in the expressive context. See, e.g., *Walking Mountain Prods.*, 353 F.3d at 807 (“adopt[ing] the Second Circuit’s [*Rogers v. Grimaldi*] First Amendment balancing

burden of persuasion completely on the plaintiff.<sup>120</sup> The three-part test derived from *Rogers* espouses a balancing approach to applying the Lanham Act rights for trademark protection “only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”<sup>121</sup> Even the purpose of trademark law, to prevent consumer confusion, does not outweigh the need to protect the defendant’s exercise of free speech in the context of expressive works. This rationale behind the expressive use defense can and should apply to defendant-disparaged groups seeking to reappropriate disparaging trademarks as well.<sup>122</sup>

First, the *Rogers* test asks whether the defendant’s use is artistically relevant to the defendant’s work.<sup>123</sup> The basic idea is that if the speech or use in question is not purely commercial (i.e., that which merely proposes a transaction),<sup>124</sup> then it is entitled to First Amendment protection. The test is extremely defendant-friendly, as the artistic relevance need only be above “zero,” whereby the defendant’s work must then be protected under the First Amendment.<sup>125</sup> For instance, in *Mattel, Inc. v. MCA Records*, the court found that referencing “Barbies” in the defendant’s “Barbie Girl” song was relevant to the defendant’s work because the defendant was using the mark to make a social commentary on consumerism through its

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test” to hold that in determining whether a plaintiff has infringed a trademark of “cultural significance,” such as ‘Barbie,’ the court must consider the First Amendment concerns of free expression); *Elec. Arts, Inc.*, 724 F.3d at 1242 (“The only relevant legal framework for balancing the public’s right to be free from consumer confusion about Brown’s affiliation with *Madden NFL* and EA’s First Amendment rights in the context of Brown’s § 43(a) claim is the *Rogers* test.”). In light of the language in *Gordon*, 909 F.3d at 264 n.6, however, it appears that Ninth Circuit courts must first address the Ninth Circuit *Sleekcraft* multifactor likelihood of confusion text, and then proceed to the *Rogers v. Grimaldi* test.

<sup>120</sup> *Gordon*, 909 F.3d at 264–65; see also *Rogers*, 875 F.2d at 1000 (“This construction of the Lanham Act accommodates consumer and artistic interests. It insulates from restriction titles with at least minimal artistic relevance that are ambiguous or only implicitly misleading but leaves vulnerable to claims of deception titles that are explicitly misleading as to source or content . . .”). The *Rogers* court also explains that because consumers of artistic works have a “dual interest”—“an interest in not being misled and . . . an interest in enjoying the results of the author’s freedom of expression . . . [—]the expressive element of titles requires more protection than the labeling of ordinary commercial products.” *Id.* at 998.

<sup>121</sup> *Rogers*, 875 F.2d at 999.

<sup>122</sup> See *supra* Section I.C.

<sup>123</sup> *Rogers*, 875 F.2d at 999.

<sup>124</sup> See *MCA Records, Inc.*, 296 F.3d at 900 (finding that “[o]nce [a trademark is] imbued with such expressive value, [it] becomes a word in our language and assumes a role outside the bonds of trademark law,” where it is subject to greater speech protections).

<sup>125</sup> See *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008) (finding videogames to constitute expressive work and that the artistic relevance need only be merely above zero).

lyrics.<sup>126</sup> In *Mattel, Inc. v. Walking Mountain Productions*, the defendant produced a series of photographs of Barbie dolls staged in certain ways to critique the objectification of women.<sup>127</sup> The court applied *Rogers* to find that the use of the Barbie trademark was expressive.<sup>128</sup> The court in *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.* and *Brown v. Electronic Arts* applied the framework to video games, holding that the use of the trademarks in each videogame was relevant for creating realistic representations in the virtual world.<sup>129</sup>

If the defendant’s use is deemed artistically relevant to the expressive work, the *Rogers* test then asks whether the defendant’s use explicitly misled consumers. If the use did not explicitly mislead consumers, then the defendant is not liable for infringement. This step is extremely defendant-friendly, as the defendant must have taken explicit action to be held liable. The focus is on the defendant’s conduct, rather than consumer perception, as the test requires more than just association in the consumer’s mind.<sup>130</sup> Instead, the plaintiff must show the defendant explicitly created association or confusion with the plaintiff’s mark.<sup>131</sup> In *Electronic Arts*, the Ninth Circuit demanded smoking gun evidence that Electronic Arts told consumers the game was authorized by athlete Jim Brown.<sup>132</sup> It did not matter if consumers merely assumed authorization.<sup>133</sup>

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<sup>126</sup> *MCA Records, Inc.*, 296 F.3d at 902.

<sup>127</sup> 353 F.3d 792, 796 (9th Cir. 2003).

<sup>128</sup> *Id.* at 807 (“The Barbie mark in the titles of [the defendant’s] works and on his website accurately describe[s] the subject of the photographs, which in turn, depict Barbie and target the doll with [the defendant’s] parodic message.”).

<sup>129</sup> See *E.S.S. Entm’t 2000, Inc.*, 547 F.3d at 1100 (finding that if the relevance is merely above zero, then the use would be protected by the First Amendment); *Brown v. Elec. Arts, Inc.*, 724 F.3d 1235, 1244–45 (9th Cir. 2013) (finding the use of former player Jim Brown to be relevant for a realistic presentation of the game).

<sup>130</sup> See *Elec. Arts*, 724 F.3d at 1245–46 (holding that the test demands plaintiff to show defendant explicitly sought to mislead consumers, i.e., that the defendant explicitly intended to create association or confusion).

<sup>131</sup> *Id.* (“It is well established that the use of a mark alone is not enough to satisfy this prong of the *Rogers* test, . . . [which] requires that the use be *explicitly* misleading to consumers. To be relevant, evidence must relate to the nature of the behavior of the identifying material’s user, not the impact of the use.”).

<sup>132</sup> *Id.* at 1246 (“[S]tatements made in materials accompanying the game are at least the right kind of evidence to show that EA tried to explicitly mislead consumers about its relationship with Brown. Here, however, the statements . . . do not show any attempt to mislead consumers.”).

<sup>133</sup> The Ninth Circuit emphasized that “[a]dding survey evidence [showing association by consumers] changes nothing,” explaining that “[e]ven if Brown could offer a survey demonstrating that consumers of the *Madden NFL* series believed that Brown endorsed the game, that would not support the claim that the use was explicitly misleading to consumers.” *Id.* at 1245–46.

Recent developments in the Ninth Circuit, however, appear to have made the test slightly less defendant friendly. In *Gordon v. Drape Creative, Inc.*, the court tested the “outer limits” of *Rogers*.<sup>134</sup> Holding that while the defendant’s work was expressive and thus merited applying the *Rogers* test, the court remanded the case over whether the defendant’s use of the mark was explicitly misleading.<sup>135</sup> Rejecting a rigid application of the test’s second step (i.e., that the defendant must have made an affirmative statement of sponsorship or endorsement), the court stated that a more relevant consideration would be the degree to which the defendant uses the mark in the same manner as the plaintiff.<sup>136</sup> Stepping away from the idea that judges should not be the determinants of artistic value and merit,<sup>137</sup> the court in *Gordon* appeared to make such determinations by factoring in the extent to which the defendant added its own expressive content to the mark.<sup>138</sup> While the court emphasized that the mere use of a mark alone cannot explicitly mislead,<sup>139</sup> it hypothesized instances when it could constitute explicit misleading use,<sup>140</sup> such as when the mark is not a component of a larger expressive work.<sup>141</sup>

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<sup>134</sup> 909 F.3d 257, 268 (9th Cir. 2018); see *id.* at 261 (“The *Rogers* test is not an automatic safe harbor for any minimally expressive work that copies someone else’s mark.”).

<sup>135</sup> *Id.* at 268.

<sup>136</sup> *Id.* at 270 (“[T]he potential for explicitly misleading usage is especially strong when the senior user and the junior user both use the mark in similar artistic expressions.”).

<sup>137</sup> *Cf.* *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 251 (1903) (Holmes, J.) (“It would be a dangerous undertaking for persons trained only to the law to constitute themselves final judges of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”); *Elec. Arts*, 724 F.3d at 1242–43 (“As we explained in *E.S.S. [Entm’t]*, . . . ‘the level of [artistic] relevance . . . merely must be above zero’ for the trademark or other identifying material to be deemed artistically relevant. 547 F.3d at 1100. This black-and-white rule has the benefit of limiting our need to engage in artistic analysis in this context.”).

<sup>138</sup> See *Gordon*, 909 F.3d at 261 (“Defendants have not used [the plaintiff’s] mark in the creation of a song, photograph, video game, or television show, but have largely just pasted *Gordon*’s mark into their greeting cards.”); *id.* at 270 (explaining that the explicit misleadingness inquiry involves determining “the extent to which the [defendant] has added [their] own expressive content to the work beyond the mark itself”).

<sup>139</sup> *Id.* at 270.

<sup>140</sup> *Id.* (“If an artist pastes Disney’s trademark at the bottom corner of a painting that depicts Mickey Mouse, the use of Disney’s mark, while arguably relevant to the subject of the painting, could explicitly mislead consumers that Disney created or authorized the painting . . .”).

<sup>141</sup> The court distinguished Ninth Circuit precedent by explaining that the mark in those cases “served as only one ‘element of the [work] and the [junior user’s] artistic expressions.’” *Id.* at 271 (quoting *Rogers v. Grimaldi*, 875 F.2d 994, 1001 (2d Cir. 1989)). It went on to say that for “instances in which a mark was incorporated into the body of an expressive work, we made clear that the mark served as only one component of the larger expressive work.” *Id.*

Despite the qualifications made in *Gordon*, the *Rogers* test remains defendant friendly, as it is extremely difficult to prove that the defendant explicitly misled consumers as to source. Nonetheless, this qualification has important implications for whether applying the existing expressive use defense is suitable for reappropriation uses. Under the Ninth Circuit’s limitation on the explicit misleadingness standard, subtle reappropriation uses, such as the original versions of the Redhawks culture jamming works, could constitute instances of explicitly misleading use hypothesized by the *Gordon* court. Before the disclaimers appeared on the Redhawks spoof websites, the culture jamming efforts proved to be so subtle in their use of the Redskins mark that many viewers believed the press releases were genuine.<sup>142</sup> The most effective or sophisticated parodies are arguably ones that employ subtle means and take viewers a moment to realize that the trademark use is a spoof. The limitation set forth in *Gordon* could be read to suggest that those subtle reappropriation uses are explicitly misleading. For instance, the Redhawks spoof website could likely be viewed as infringing under *Gordon* because its creators did not add enough of their own expressive content to the original mark as to not explicitly mislead consumers.

While the qualification made in *Gordon* has merit, it should not apply to reappropriation uses. Unlike the defendant in *Gordon* who used the plaintiff’s mark in bad faith and simply copied it without adding the defendant’s own artistic content, defendants engaging in reappropriation use would be using disparaging trademarks to counter hate speech with more speech—reclaiming slurs found in trademarks as an exercise of free speech.<sup>143</sup> Under *Gordon*, culture jamming efforts such as the Redhawks spoof would always require disclaimers, which would effectively ruin the point of the parody or the social commentary behind the works. Given that *Gordon* appears to have weakened the *Rogers* expressive use test, there is a need to ensure that reappropriation uses can persist despite the *Gordon* limitation without incurring liability.

The current expressive use defense is also not sufficient for evaluating reappropriation uses, because reappropriation use need not be expressive or artistic. The expressive use test has been raised in defense of unauthorized trademark uses in artistic works—film titles, videogames, song lyrics, photography, art, and greeting cards. Reappropriation use, however, could entail using a disparaging trademark

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<sup>142</sup> See *supra* Section II.A.

<sup>143</sup> See *supra* Section I.C.

as the name of a business,<sup>144</sup> or as a more subtle form of parody like that found in culture jamming. There is also a general lack of cases challenging reappropriation uses, perhaps because prior to *Matal v. Tam*, disparaged groups had sought cancellation of registration under § 2(a). Given these limitations, the existing expressive use defense, though more defendant friendly than the parodic use defense, would fail to adequately protect reappropriation uses.

### III

#### A NEW TEST: THE REAPPROPRIATION USE DEFENSE

With the fall of the disparagement clause under § 2(a), the issue of registering or owning disparaging trademarks is moot. Now, the concern is over the scope of protection and the exclusive rights in use afforded to owners of disparaging trademarks. This Note proposes an adaptation of the *Rogers* expressive use test for unauthorized uses of disparaging trademarks in reappropriation efforts. The proposed test accepts the *Rogers* policy rationale for applying the Lanham Act only when the interest in preventing consumer confusion outweighs the interest in protecting free speech, its requirement that the defendant's conduct explicitly mislead consumers as to source, and its applicability to non-parody and commercial trademark uses. This Note, however, modifies the test to specifically analyze reappropriation uses. Disparaged groups should not be limited to parody or traditional expressive use but should have more flexibility to counter disparaging trademarks and even profit from their use of the marks. By adopting the explicit misleadingness standard, the new test would be defendant friendly and shift away from the consumer perception-based parody cases that make it more difficult for disparaged groups to fully reappropriate disparaging trademarks. The new test would prohibit explicit, misleading conduct by the defendant aiming to create consumer source confusion. Courts could find the defendant-disparaged group liable for infringement only upon passing all three steps of this test and finding that the defendant explicitly misled consumers as to source.

Fuller reappropriation uses would be allowed under this new test. For example, the defendant-disparaged group could create a new logo using the full trademarked term, instead of using only part of the

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<sup>144</sup> And thereby imbuing a positive meaning and creating positive connotations of the term as part of the disparaged group's self-identity. See *infra* Part III (describing the use of "Yellow Fever" as a restaurant name).

term.<sup>145</sup> Affixing the new logos to commonplace objects may also underscore the disparaged group’s reappropriation use. The National Museum of the American Indian, for instance, showcased an “Americans” exhibit displaying commonplace objects such as butter, motor oil, sunscreen, and baking powder bearing logos featuring American Indians.<sup>146</sup> The exhibit even featured a baby bib embroidered with the officially licensed Washington Redskins logo.<sup>147</sup> The display sought to “represent[ ] the co-opting of Native American culture” that seemingly begins with children.<sup>148</sup> Perhaps consumers are no longer shocked to see ordinary objects bearing images, logos, and names of American Indians, because the pervasiveness of the phenomenon has desensitized consumers so that they perceive the Redskins trademark as just another logo. By affixing the new Redskins logo to commonplace objects, however, the disparaged group may catch consumers’ attention by using the jarring images to point out the absurdity of attaching disparaging trademarks to everyday objects.

The disparaged group could also use the term “Redskins” as the name of business enterprises, akin to what the owners of the restaurant “Yellow Fever” did.<sup>149</sup> Although “Yellow Fever” is not a trademarked term, the owners of the pan-Asian chain restaurant wanted to use the “memorable,”<sup>150</sup> attention-grabbing phrase to “embrace the term and reinterpret it positively,”<sup>151</sup> “rather than narrowly associat[e] it with a deadly disease or with perpetuating racial stereotypes.”<sup>152</sup> While the name generated much criticism for its “racist

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<sup>145</sup> For example, the Rising Hearts group could employ “Redskins,” instead of “Redhawks,” though the group had its informed reasons for using the substitute term. See *supra* Section II.A.

<sup>146</sup> *Americans*, SMITHSONIAN NAT’L MUSEUM OF AM. INDIAN, <https://americanindian.si.edu/explore/exhibitions/item/?id=957> (last visited Aug. 13, 2019); Sadie Dingfelder, *Why There’s Redskins Merch at the National Museum of the American Indian*, WASH. POST (Jan. 25, 2018), <https://www.washingtonpost.com/express/wp/2018/01/25/why-theres-redskins-merch-at-the-national-museum-of-the-american-indian>. The point of the exhibit is to note the pervasiveness of “American Indian images, names, and stories infuse[d] [in] American history and contemporary life” and invite viewers to engage in conversation about what drives this phenomenon. *Id.*

<sup>147</sup> Dingfelder, *supra* note 146.

<sup>148</sup> *Id.* (quoting *Americans* curator Paul Chaat Smith).

<sup>149</sup> See 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> (describing the controversy generated by the name “Yellow Fever”).

<sup>150</sup> *Id.* (quoting owner Kelly Kim in her description of the phrase “Yellow Fever”).

<sup>151</sup> *Id.*

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

undertones” in evoking the fetishization of Asian women,<sup>153</sup> the Asian-American owners of the restaurant stood by the name they previously described as “re-appropriating a term – taking ownership of something and defining it our own way.”<sup>154</sup> By incorporating “Redskins” into the name of enterprises facilitated or owned by American Indian organizations and individuals, the defendant-disparaged group could similarly take ownership of the disparaging term, imbue it with their own meaning, and create positive connotations of the term as part of the disparaged group’s self-identity. This Section discusses each of the new test’s steps, using this last Redskins hypothetical and the Redhawks’ culture jamming example to illustrate the tangible differences the proposed test would have on the scope of permissible reappropriation uses.

### A. STEP 1: Does the Defendant’s Work Constitute Reappropriation Use?

Under this reappropriation use test, the first step asks whether the defendant’s work constitutes a reappropriation use. This entails determining whether (a) the plaintiff’s mark is disparaging, and (b) the defendant’s work is aimed at reclaiming or reappropriating the disparaging term. While this two-prong step does not have an explicit equivalent step under *Rogers*, it would be similar to asking whether the defendant’s work constitutes expressive, artistic use as to justify using the *Rogers* test. This step would determine whether the use in question constitutes reappropriation use for it to be raised as a defense.

Disparaging marks can be categorized into three groups: contextually disparaging, intrinsically (per se) disparaging, and self-disparaging.<sup>155</sup> Contextually disparaging marks include terms that would normally be acceptable to the group, but become disparaging based on the context in which the mark is used.<sup>156</sup> Per se disparaging

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<sup>153</sup> See *id.* (“[T]he phrase is also a common reference to a term associated with a white man’s sexual fascination with Asian women.”).

<sup>154</sup> Heather Johnson Yu, *Meet the Asian Woman Behind the Successful Restaurant ‘Yellow Fever,’* NEXTSHARK (Nov. 6, 2017), <https://nextshark.com/kelly-kim-yellow-fever-restaurant-california-interview>.

<sup>155</sup> See Anten, *supra* note 63, at 411–12 (defining the three and distinguishing them).

<sup>156</sup> *Id.* at 411. For example, the “mere presence of the word ‘black’” in a mark may not on its own be disparaging, but the use of “BLACK TAIL” to describe an “adult entertainment magazine” may disparage Black women because of the “alleged characterization of African American women ‘as mere female sexual objects . . . similar to the attitude of slave owners toward black women during the time of slavery.’” *Id.* (quoting *Boswell v. Mavety Media Grp. Ltd.*, 52 U.S.P.Q.2d (BNA) 1600, 1602–03 (T.T.A.B. 1999)); see also Adler, *supra* note 11, at 1521 n.94 (“The word ‘black’ (when used to refer to



marks include terms that a substantial composite of the target group would always perceive as disparaging, regardless of context, simply because it contains an offensive term.<sup>157</sup> Self-disparaging marks are perceived to be intrinsically disparaging due to the mere presence of a slur, except that the applicant is a member of the allegedly disparaged group.<sup>158</sup> In the reappropriation use context, the plaintiff-trademark owner would not be using a self-disparaging mark,<sup>159</sup> but a contextually or intrinsically disparaging mark, such as the “Redskins.”<sup>160</sup>

Determining whether a mark disparages an identifiable group is a case-specific and context-specific inquiry.<sup>161</sup> While *Matal v. Tam* invalidated § 2(a) as a statutory bar against registrations, there is still an established disparagement doctrine that courts can rely on to determine whether the defendant’s work constitutes reappropriation use. Asking the court to determine whether the plaintiff-owner’s mark is contextually or intrinsically disparaging would not render the test circular.<sup>162</sup> Rather, it would ask the court to use the already established disparagement doctrine to help classify the type of speech in question. Under parodic use, courts routinely analyze whether the use is a parody, and this determination is not constitutionally problematic. Courts also routinely analyze whether the defendant’s work is artistic in nature under the *Rogers* expressive use test. Similarly, asking the court to analyze whether the plaintiff’s mark is disparaging would simply be part of the balancing test considerations informed by the First Amendment.

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African-Americans) was considered to be a derogatory term until it was adopted by ‘blacks’ themselves.”).

<sup>157</sup> Anten, *supra* note 63, at 412.

<sup>158</sup> *Id.*

<sup>159</sup> The Slants were employing a self-disparaging mark to brand their band.

<sup>160</sup> While the American Indians who petitioned for the trademark cancellation argued that the term is intrinsically disparaging and thus never acceptable when referring to American Indians, the TTAB rejected the broad notion and applied the contextual approach to find that the term may disparage American Indians. *See Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1743 (T.T.A.B. 1999) (“Several of petitioners’ witnesses expressed their opinions that the use of Native American references or imagery by non-Native Americans is, essentially, *per se* disparaging to Native Americans . . .”), *rev’d on other grounds*, 284 F. Supp. 2d 96, 144 (D.D.C. 2003). While some American Indians have used the term as a reclaimed slur, *see Nunberg, supra* note 70 (“Indians themselves sometimes use the word in team names as a reclaimed epithet, but that dispensation doesn’t extend to whites . . .”), the plaintiffs in this context would not be employing it in a self-disparaging manner, but in a contextually or intrinsically disparaging way.

<sup>161</sup> *See Harjo*, 50 U.S.P.Q.2d (BNA) at 1739 (“Who comprises the targeted, or relevant, group must be determined on the basis of the facts in each case.”).

<sup>162</sup> One counterargument to the proposed test could be that the first step requires courts to determine whether a mark is disparaging based on the same criteria the PTO had used before *Matal v. Tam*.

Determining whether the defendant's constitutes a reappropriation use also requires examining the purpose of the defendant's action. For the defendant's use to constitute reappropriation use, the defendant must use the plaintiff's mark to remove the sting of the disparaging mark. This could include using the term "Redskins" as its enterprise name or as part of a culture jamming effort to redefine the disparaging term and embrace it as part of its self-identity. Reappropriation use would likely be found where the mark contains a term traditionally considered a disparaging slur to a particular group, and the defendant using the mark is a member of the disparaged group.<sup>163</sup> Whether the defendant belongs to the disparaged group would simply be one factor for the court to consider, not a requirement. However, such membership would support a finding for reappropriation use. While the point of reappropriation is for members of marginalized groups to reclaim slurs that have been used to disparage them, it can be difficult to determine who belongs to a given identity classification. Employing objective or empirical methods, such as assigning "percentages" to make the determinations, would be arbitrary. Instead, the determination would come down to one's subjective sense of identity. While such a self-identification process may be abused, this criticism is outweighed by the need to "respect[ ] an individual's right to self-define."<sup>164</sup> Moreover, a self-identification process would be consistent with the federal government's established attitude towards identity classifications. For purposes of the U.S. census, for instance, the federal government's position on racial classification is self-definition and respect for the self-reported identities.<sup>165</sup> While a tribal

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<sup>163</sup> See Anten, *supra* note 63, at 394 (proposing a shift in PTO policy for examining registration applications made by members of disparaged groups for trademarks considered to be self disparaging). Anten's Note was published before *Matal v. Tam*, and for his proposal, Anten outlined "circumstances where (1) the mark at issue contains what has traditionally been considered a slur that may disparage a particular group; and (2) the applicant is a member of the disparaged group." *Id.*

<sup>164</sup> *Id.* at 430. Anten anticipated the potential for abuse of the self-identification system in the context of disparaging trademark registrations. See *id.* ("A potential critique of merely allowing an applicant to sign a statement in order to prove group membership is that it will be abused—anyone can sign a statement stating that [they are] Jewish, African American, or gay, and thus receive access to the automatic deference denied to nongroup members."). But Anten countered such criticism by grounding self-identification in the long-established, still existing PTO practice of accepting "sworn statements from applicants as being reliable." *Id.*

<sup>165</sup> See Tseming Yang, *Choice and Fraud in Racial Identification: The Dilemma of Policing Race in Affirmative Action, the Census, and a Color-Blind Society*, 11 MICH. J. RACE & L. 367, 383 (2006) (explaining how the racial identification question on the U.S. census asking individuals "'to indicate what [race they] consider[ ] [themselves] to be' . . . requests the self-considered, personal views of racial identity of the respondent" and the responses are deemed "conclusive and not subject to second-guessing by contrary views or

enrollment process exists for establishing American Indian ancestry and tribal membership,<sup>166</sup> for the reappropriation use defense to apply to all disparaged groups, courts would need to evaluate an individual or group’s self-identification as one factor in determining whether the defendant’s use constitutes reappropriation use. Proof of tribal enrollment would further support a finding of membership.

*B. STEP 2: Is the Defendant’s Use Directly Relevant to the Reappropriation Purpose?*

Upon determining that the defendant’s work constitutes reappropriation use, the test then asks whether the defendant’s use of a disparaging trademark is directly relevant to the defendant’s purpose in reclaiming the term. This is akin to asking whether the use of the mark is artistically relevant to the defendant’s work under *Rogers*, and the answer would presumably be in the affirmative. Step two is different from asking whether the defendant is seeking to engage in reappropriation use, as this step broadens the spirit of the *Rogers* test to determine whether the defendant’s use directly relates to what the plaintiff’s mark stands for. The reappropriation use test would also evade the alternative avenues of communication claim the plaintiff could raise, in which the defendant would not be protected if there were other ways to attack the plaintiff’s mark where the defendant’s work was completely unrelated to the plaintiff’s product.<sup>167</sup> Unlike the

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perceptions of third parties” (quoting U.S. DEP’T OF COMMERCE, OMB No. 0607-0856, UNITED STATES CENSUS 2000, FORM D-2, at 3)).

<sup>166</sup> See, e.g., *Tribal Enrollment Process*, U.S. DEP’T OF THE INTERIOR, <https://www.doi.gov/tribes/enrollment> (last visited Aug. 13, 2019) (describing the tribal enrollment process).

<sup>167</sup> See, e.g., *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 776 (8th Cir. 1994) (“By using an obvious disclaimer, positioning the parody in a less-confusing location, altering the protected marks in a meaningful way, or doing some collection of the above, Balducci could have conveyed its message with substantially less risk of consumer confusion.”); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 402 (8th Cir. 1987) (“Other avenues for Novak to express his views . . . are unrestricted by the injunction; . . . it in no way infringes upon the constitutional protection the First Amendment would provide were Novak to present an editorial parody . . . [therefore, the injunction] deprives neither Novak nor the public of the benefits of his ideas.”). *But see Rogers*, 875 F.2d at 998–99 (rejecting *Rogers*’s alternative avenues argument and explaining that “the ‘no alternative avenues test’ does not sufficiently accommodate the public’s interest in free expression . . .” because it “provides insufficient leeway for literary expression”); Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 418 n.16 (2010) (“[T]hat any consumers were confused [in *Mutual of Omaha* and *Anheuser-Busch*] was remarkable, and perhaps a statement about the reliability of consumer confusion surveys rather than the stupidity . . . of the population.”); *id.* at 421 (noting the absurdity behind the alternative avenues cases where “courts found actionable confusion notwithstanding the fact that consumers couldn’t possibly have been confused about the actual source of the defendants’ products”).

alternative avenues of communication cases, the defendant's use of "Redskins" as the name of its enterprise or the culture jamming effort would not be random, but deliberate.

*C. STEP 3: Did the Defendant Explicitly Mislead?*

Like the expressive use defense, the reappropriation use test would also demand that the defendant have explicitly misled consumers to believe its work is associated with or authorized by the plaintiff. This heightened requirement would not be met if consumers merely formed an association between the two in their minds. Accordingly, unless the disparaged group explicitly tells consumers that their "Redskins" enterprise is associated with, affiliated with, or authorized by the Washington Redskins—essentially showing ownership by the Redskins—the disparaged group would not be found liable for infringement. The defendant could avoid even the possible limitation in *Gordon* by ensuring that their use of the Redskins mark serves as merely one component of a larger narrative.

Further, under the proposed test's explicit misleadingness standard, defendants would not need to resort to disclaimers, which would ruin the point of the parodies if the disparaged group sought to reclaim the term by creating subtle new logos or other humorous uses. As such, the Redhawks site could remain without disclaimers because its purpose would be for reappropriation use and its reference to the Redskins would not explicitly mislead consumers. Disclaimers defuse the power of effective parodies and culture jamming efforts made to reclaim disparaging terms. What could otherwise be found as explicitly misleading under the existing expressive use defense or even infringing under the parodic use defense based on consumers' perception would be protected under the proposed reappropriation use defense.

Focusing on the defendant's conduct renders the proposed test extremely defendant-friendly. The test would benefit disparaged groups trying to reappropriate disparaging terms both procedurally—by making the legal process more efficient and less expensive, perhaps even discouraging plaintiffs from filing suit due to the degree to which the test favors defendants—and substantively, by protecting their exercise of free speech. A new test focused on the defendant's explicit, misleading conduct would also avoid chilling speech in response to disparaging trademarks.<sup>168</sup>

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<sup>168</sup> By contrast, the consumer perception-oriented likelihood of confusion standard used in parody cases would make it more difficult for defendants to proceed to summary judgment, because under the parody analysis, the more similar the defendant's product is

The new test would further promote free speech and comport with the policy rationale for when to apply the Lanham Act by creating sufficient room for disparaged groups to reappropriate disparaging trademarks—countering slurs with usage and speech (humorous or not) that would remove the sting of the disparaging epithets. While the same policy rationale applies to the reappropriation use context, the existing expressive use defense is inadequate for protecting reappropriation use. Given the qualification that *Gordon* made to *Rogers*’s explicitly misleading standard, there is a need to ensure that reappropriation uses—such as culture jamming spoofs of disparaging trademarks—can still be protected under the Lanham Act without explicit disclaimers.<sup>169</sup> Moreover, the expressive use defense applies only to artistic works, but reappropriation use need not be so limited. Disparaged groups should be able to use disparaging trademarks as part of company names and subtle forms of parody found in culture jamming.

#### CONCLUSION

*Matal v. Tam* foreclosed challenges to federal registrations of disparaging trademarks. But it opened up the opportunity to explore how disparaged groups could work within the framework of federal trademark law to restrict the rights to exclusive use that owners of disparaging trademarks possess. Focusing on the infringement and defense side of the legal analysis allows us to envision how unauthorized uses of disparaging trademarks for the purpose of reclaiming the offensive terms could and should be protected under a powerful “reappropriation use” defense and as an exercise of free speech, regardless of whether the use is parodic. Given the significance of reappropriation and the need to protect speech countering “the thought . . . we hate,”<sup>170</sup> reappropriation use by disparaged groups should have a powerful defense against infringement claims under the Lanham Act. This Note proposes a new test for courts to apply when dealing specifically with unauthorized reappropriation uses. Focusing on defendants’ explicitly misleading conduct renders the test defendant-friendly and allows for procedural efficiencies while also promoting free speech. The reappropriation use test would benefit defendant-disparaged groups by allowing them to arrive at the summary judgment stage more quickly than what is typical in a parody

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to the plaintiff’s trademark, the more likely it is that consumers would form a false association between the two.

<sup>169</sup> See *supra* Section II.C (describing limitations on the expressive use defense).

<sup>170</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (quoting *United States v. Schwimmer*, 279 U.S. 644, 655 (1929) (Holmes, J., dissenting)).

defense case, thereby limiting the high legal costs of battling lawsuits. This is especially important for disparaged groups, who are almost always “already burdened and under-resourced communities” forced to use “a long, expensive process that does not allow the complexities of identity politics to be navigated properly.”<sup>171</sup> Instead, disparaged groups would be able to reappropriate disparaging trademarks without being subjected to cost-prohibitive litigation.

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<sup>171</sup> Simon Tam, *First Amendment, Trademarks, and “The Slants”*: Our Journey to the Supreme Court, 12 BUFF. INTELL. PROP. L.J. 1, 12 (2018).