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## Beyond Trademarks and Offense: *Tam* and the Justices' Evolution on Free Speech

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# Beyond Trademarks and Offense: *Tam* and the Justices' Evolution on Free Speech

Clay Calvert\*

When the Supreme Court steps up to the plate in a case like *Matal v. Tam* involving free-speech protection of offensive expression, the justices have options about just how hard to swing the judicial bat.<sup>1</sup> First Amendment advocates, of course, hope they'll swing for the fences and crush free-expression grand slams. *Cohen v. California*, protecting the display of an offensive jacket in a courthouse corridor and propelled by memorable lines like "one man's vulgarity is another's lyric," was one such home run, soaring over a dissent and past the outfield wall of censorship.<sup>2</sup> Other times, the Court merely drops a bunt and barely advances the First Amendment score, if at all.

In *Tam*, the Supreme Court threw out the "disparagement clause" of the Lanham Act, the federal trademark law, because trademarks are private speech and thus regulating them based on government determinations of offensiveness violates the First Amendment. The solid outcome here—a virtual triple, as described later—contrasts with the narrow, incremental results in some other recent First Amendment cases that reached the Court.

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<sup>1</sup> Admittedly, a baseball analogy featuring the Court batting strikes out against Chief Justice John Roberts's testimony during his confirmation hearings that "it's my job to call balls and strikes, and not to pitch or bat." Todd S. Purdum & Robin Toner, Roberts Pledges He'll Hear Cases with 'Open Mind,' N.Y. Times, Sept. 13, 2015, at A1.

<sup>2</sup> 403 U.S. 15, 25 (1971).

Consider *Federal Communications Commission v. Fox Television Stations*, a case regarding fleeting expletives and momentary nudity on broadcast television.<sup>3</sup> The Supreme Court had an opportunity to score two runs for the First Amendment—to abolish the FCC’s regulatory authority over broadcast indecency (thereby reversing the aging 1978 *Pacifica* decision arising from the George Carlin filthy-words case<sup>4</sup>) and to strike down its definition of indecency as unconstitutionally vague. But the Court waved off both pitches.

Instead, it resolved the case “on fair notice grounds under the Due Process Clause.”<sup>5</sup> The Court determined that the FCC had impermissibly changed its indecency policy to target fleeting expletives and isolated sexual images without giving networks Fox and ABC proper notice of the switch. As for the free speech issue, the Court simply reminded the FCC—perhaps with an eyebrow arched—that the commission should feel “free to modify its current indecency policy in light of its determination of the public interest and applicable legal requirements.”<sup>6</sup>

Did the FCC heed that suggestion? No. Although it put out a notice for public comment about its indecency policy shortly thereafter and said it would target only egregious indecency incidents,<sup>7</sup> it failed to take substantive action. Today, the FCC’s indecency policy remains what it was when the Court decided *Fox Television Stations* five years ago. The First Amendment issues are left waiting for another day and another case, perhaps the product of Chief Justice John Roberts’s general penchant for minimalism and avoidance.<sup>8</sup>

Or take—with more relevance, as it happens, for *Tam*—the Court’s 2015 decision in *Walker v. Texas Division, Sons of Confederate Veterans*.<sup>9</sup>

<sup>3</sup> 567 U.S. 239 (2012).

<sup>4</sup> *Federal Communications Commission v. Pacifica Foundation*, 438 U.S. 726 (1978).

<sup>5</sup> *Fox Television Stations*, 567 U.S. at 258.

<sup>6</sup> *Id.* at 259.

<sup>7</sup> See Press Release, Federal Communications Commission, FCC Reduces Backlog of Broadcast Indecency Complaints by 70% (More Than One Million Complaints); Seeks Comment on Adopting Egregious Cases Policy (Apr. 1, 2013), [https://apps.fcc.gov/edocs\\_public/attachmatch/DA-13-581A1.pdf](https://apps.fcc.gov/edocs_public/attachmatch/DA-13-581A1.pdf).

<sup>8</sup> See generally Clay Calvert & Matthew D. Bunker, *Fissures, Fractures & Doctrinal Drifts: Paying the Price in First Amendment Jurisprudence for a Half Decade of Avoidance, Minimalism & Partisanship*, 24 Wm. & Mary Bill of Rts. J. 943, 957 (2016) (analyzing “how philosophies of minimalism and avoidance have detrimentally affected First Amendment doctrines since Justice Kagan joined the Roberts Court”).

<sup>9</sup> 135 S. Ct. 2239 (2015).

The odious speech there consisted of a proposed specialty license plate bearing the Confederate battle flag. Its censor, in turn, was the Texas Department of Motor Vehicles Board, which rejected the plate because “many members of the general public find the design offensive.”<sup>10</sup> Would the Court hit a First Amendment homer and declare this a seemingly easy case of viewpoint discrimination violating core free-speech principles?

No. Instead, the five-justice majority—a bloc of four liberal-leaning justices (Stephen Breyer, Ruth Bader Ginsburg, Sonia Sotomayor and Elena Kagan) joined by Clarence Thomas—completely whiffed. Falling back on something called the government-speech doctrine, the majority held that messages on specialty license plates are speech of the government, not the private groups—in *Walker*, the Sons of Confederate Veterans—that design and sponsor them. And when the government speaks, the First Amendment has little application; the government can say what it likes, delete messages it doesn’t like, and engage in viewpoint discrimination. As Justice Breyer wrote for the majority, “government statements (and government actions and programs that take the form of speech) do not normally trigger the First Amendment rules designed to protect the marketplace of ideas.”<sup>11</sup> Labeling a mode of expression “government speech” gives the government a free pass to discriminate against viewpoints it deems noxious.

Justice Samuel Alito, joined in dissent by Chief Justice Roberts and Justices Antonin Scalia and Anthony Kennedy, bristled at applying the government speech doctrine to Texas’s specialty plates. Alito opined that the messages “proposed by private parties and placed on Texas specialty plates are private speech, not government speech. Texas cannot forbid private speech based on its viewpoint. That is what it did here.”<sup>12</sup> For him, expanding the government-speech doctrine to cover specialty plates “establishes a precedent that threatens private speech that government finds displeasing.”<sup>13</sup>

At best, *Walker* proved a fleeting, feel-good win for those who find Confederate-flag imagery racist. That’s because the script flipped soon thereafter in North Carolina. The *Walker* majority’s holding

<sup>10</sup> *Id.* at 2245.

<sup>11</sup> *Id.* at 2245–46.

<sup>12</sup> *Id.* at 2263 (Alito, J., dissenting).

<sup>13</sup> *Id.* at 2254.

that specialty plates are government speech sustained the Tar Heel State's offering a "Choose Life" specialty plate but denying a pro-choice alternative.<sup>14</sup> In the simplest of stereotypes, the political left used the government speech doctrine to thwart a Confederate flag license plate in Texas, while the political right later used it to stifle a pro-choice plate in North Carolina. It was political tit-for-tat. At worst, then, *Walker* gave government entities an elastic mechanism for sanctioning viewpoint discrimination and dodging First Amendment challenges.

Then along came *Matal v. Tam*. It brought back the arguments about government-assisted speech in a context that invited the Court to (1) roll back, or at least cabin and confine, *Walker*'s government-speech doctrine; or (2) revisit the issue of whether viewpoint discrimination (normally verboten) becomes acceptable in that setting.

The U.S. Patent and Trademark Office (PTO) has statutory power to reject registration for marks that "may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."<sup>15</sup> For example, the PTO used this power to rebuff the effort of an Oregon-based Asian-American band called The Slants to register its name as a mark, finding that the name, as a reference to slanted eyes, had been employed to disparage Asian-Americans. Slants frontman, Simon Tam, countered that the band was reappropriating the term, wresting away its power, sting, and stigma from hate mongers.

What is "reappropriation"? In academic parlance, it's "the process of taking possession of a slur previously used exclusively by dominant groups to reinforce a stigmatized group's lesser status."<sup>16</sup> The Slants explain their meaning more lyrically in "From the Heart," a tune about fighting the PTO on the aptly titled album *The Band Who Must Not Be Named*:

Sorry if we try too hard  
To take some power back for ours.  
The language of oppression

<sup>14</sup> ACLU of North Carolina v. Tennyson, 815 F.3d 183 (4th Cir. 2016).

<sup>15</sup> 15 U.S.C. § 1052(a) (2017).

<sup>16</sup> Adam D. Galinsky et al., The Reappropriation of Stigmatizing Labels: The Reciprocal Relationship between Power and Self-Labeling, 24 Psychol. Sci. 2020, 2020 (2013).

Will lose to education  
Until the words can't hurt us again.

So sorry if you take offense,  
But silence will not make amends.  
The system's all wrong  
And it won't be long  
Before the kids are singing our song.<sup>17</sup>

In December 2015, the U.S. Court of Appeals for the Federal Circuit, sitting *en banc*, ruled in *The Slants*' favor and struck down the disparagement clause, holding that "the First Amendment forbids government regulators to deny registration because they find the speech likely to offend others."<sup>18</sup> The appellate court found not only that the clause was viewpoint-based and could not pass muster under the rigorous strict-scrutiny standard of review,<sup>19</sup> but also that it failed under the more relaxed intermediate-scrutiny test governing commercial speech. The government petitioned the Supreme Court to hear the case, and *The Slants*, despite the Federal Circuit ruling in their favor, did likewise. The band argued the "issue is undeniably important. The Court is very likely to address it in the near future, in another case if not in this one. Meanwhile, respondent Simon Tam waits in limbo. His trademark rights will not be secure until the Court resolves this issue once and for all."<sup>20</sup>

In September 2016, the Supreme Court agreed to hear what was then known as *Lee v. Tam*. It framed the issue simply as whether the disparagement clause "is facially invalid under the Free Speech Clause of the First Amendment."<sup>21</sup> With *The Slants* case on its docket, the Court

<sup>17</sup> *The Slants*, *From the Heart*, on *The Band Who Must Not Be Named* (In Music We Trust Records, 2017). Take a listen and look on YouTube at <https://www.youtube.com/watch?v=pwfEgcRXjJM>.

<sup>18</sup> *In re Tam*, 808 F.3d 1321, 1358 (Fed. Cir. 2015).

<sup>19</sup> Strict scrutiny requires the government to prove that it has a compelling interest to support a statute and that the statute is narrowly tailored to serve that interest. See *Brown v. Entm't Merchs. Ass'n*, 564 U.S. 786, 799 (2011).

<sup>20</sup> Brief for Respondent at 1, On Petition for a Writ of Certiorari to the United States Court of Appeals for the Federal Circuit, *Lee v. Tam*, No. 15-1293 (June 20, 2016).

<sup>21</sup> Question Presented, *Matal v. Tam*, No. 15-1293 (Sept. 29, 2016), <https://www.supremecourt.gov/qp/15-01293qp.pdf>.

denied a petition one week later in *Pro-Football, Inc. v. Blackhorse*. That case centered on the PTO's cancellation of six registered marks involving variations of the NFL football team name Washington Redskins as disparaging to Native Americans. The outcome of the Redskins' battle thus would hinge on the result in *The Slants* case.

Saving its *Tam* decision until the penultimate week of its term, the Court on June 19, 2017 delivered what would have amounted to a First Amendment home run if not for some unfortunate four-to-four fracturing among the justices on logic and reasoning regarding viewpoint discrimination. Call it a triple.

All eight justices (newbie Neil Gorsuch played no part) agreed on the pro-free-speech outcome—that the disparagement clause, as Justice Alito wrote in announcing the Court's judgment, "offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend."<sup>22</sup> That's an extremely close paraphrase of the Court's reasoning nearly 30 years earlier protecting flag-burning as political speech.<sup>23</sup> It's also a clear winner for *The Slants*, the Redskins and other provocatively named groups seeking federal trademark registration like *Dykes on Bikes*,<sup>24</sup> as well as more generally for free-speech advocates everywhere. Indeed, shortly after the ruling, Simon Tam called it "a win for all marginalized groups. It can't be a win for free speech if some people benefit and others don't. The First Amendment protects speech even that we disagree with."<sup>25</sup>

<sup>22</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

<sup>23</sup> See *Texas v. Johnson*, 491 U.S. 397, 414 (1989) ("If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.").

<sup>24</sup> Like *The Slants*, the San Francisco *Dykes on Bikes Women's Motorcycle Contingent* had fought lengthy registration battles with the PTO, which contended that "dykes" disparages lesbians. Somewhat echoing *The Slants* argument regarding reappropriation, *Dykes on Bikes* filed a friend-of-the-court brief in *Tam* arguing that "[a] trademark allows *Dykes on Bikes* to identify as a group by using language that invokes the members' own identities. That ability to associate individual identity with group identity and communicate a message unique to that group is central to the First Amendment." Brief of Amicus Curiae San Francisco *Dykes on Bikes Women's Motorcycle Contingent*, Inc., *Matal v. Tam*, No. 15-1293, 2017 U.S. LEXIS 3872, at 10–11 (June 19, 2017).

<sup>25</sup> Joe Coscarelli, *Why the Slants Took a Fight over Their Band Name to the Supreme Court*, N.Y. Times, June 19, 2017, <https://www.nytimes.com/2017/06/19/arts/music/slants-name-supreme-court-ruling.html>.

Thus, the constitutional outcome in *Tam* is not groundbreaking. Rather, it is principles-affirming: there is no categorical carve-out from First Amendment protection for either offensive or hateful speech, and viewpoint discrimination—something Justice Kennedy took pains to reinforce in a concurrence—is anathema to the First Amendment unless the government is speaking.

A close read of the trio of opinions in *Tam* reveals, however, at least seven other points that may affect future rulings in First Amendment disputes. Before addressing those items, a quick breakdown of the three opinions provides critical context:

1. Justice Alito wrote for a unanimous Court in some parts (most significantly, regarding government speech), for seven justices in another, and—critically—on behalf of only four justices (himself, Roberts, Thomas, and Breyer) in several sections;
2. Justice Kennedy agreed with the judgment but wrote a concurrence, joined by Justices Ginsburg, Sotomayor, and Kagan, centering on viewpoint discrimination and contending that a tighter focus on that concept would have eliminated the need for the other four justices to address other issues; and
3. Justice Thomas joined Alito’s opinion in all but one rather non-crucial part and wrote separately to reiterate his prior position that commercial speech cases should be evaluated under strict, not intermediate, scrutiny.

As this breakdown suggests, the biggest rift in reasoning was between the Alito bloc on the one hand and the Kennedy bloc on the other. Although all eight justices agreed the law was viewpoint based, the former group delved into questions that the latter, by maintaining a crisper focus on viewpoint discrimination, would have jettisoned. Indeed, as argued later, Kennedy’s concurrence provides a more clear, elegant articulation of when a statute is viewpoint based and, in turn, of the power of the doctrine against viewpoint discrimination to shut down other long-shot, statute-saving arguments.

*Packingham v. North Carolina*—another First Amendment free-speech decision issued the same day as *Tam*—displayed a nearly



identical fracturing.<sup>26</sup> In *Packingham*, the Court struck down a state statute that banned registered sex offenders from using online social media services such as Facebook. Delivering the Court's opinion, Justice Kennedy once again was joined by Justices Ginsburg, Sotomayor, and Kagan, as well as Breyer. Similarly, Justice Alito was joined again by Roberts and Thomas, this time in a concurrence objecting to the Kennedy bloc's "unnecessary rhetoric" and "undisciplined dicta" about the importance of preserving the Internet and social media networks as venues for expression.

In brief, Kennedy and Alito each authored opinions in *Tam* and *Packingham* that agreed with a pro-free-speech result. Yet the Kennedy-authored opinions in both *Tam* (a concurrence) and *Packingham* (the Court's opinion) (1) were joined by all of the ostensibly liberal-leaning justices (save for Breyer in *Tam*), and (2) failed to gain traction with a three-justice bloc of ostensible conservatives (Alito, Roberts, and Thomas). Kennedy's penchant for grandiose statements about the importance of free speech—something predating *Tam* and *Packingham*<sup>27</sup>—may have driven a wedge between him and, as explained shortly below, the typically less free-speech friendly Alito.

The seven points—not necessarily in order of importance—from *Tam* that might affect future First Amendment speech cases in contexts beyond trademark law are these: (1) Justice Alito actually can pen an opinion protecting offensive expression; (2) Justice Breyer doesn't always go off into the balancing weeds of proportionality or denigrate fundamental First Amendment doctrines; (3) nary a justice

<sup>26</sup> 137 S. Ct. 1730 (2017).

<sup>27</sup> Kennedy often extols the value of free expression with rhetorical flourishes. See, e.g., *Williams-Yulee v. Fla. Bar*, 135 S. Ct. 1656, 1682 (2015) (Kennedy, J., dissenting) ("First Amendment protections are both personal and structural. Free speech begins with the right of each person to think and then to express his or her own ideas. Protecting this personal sphere of intellect and conscience, in turn, creates structural safeguards for many of the processes that define a free society."); *United States v. Alvarez*, 567 U.S. 709, 727 (2012) ("The remedy for speech that is false is speech that is true. This is the ordinary course in a free society. The response to the unreasoned is the rational; to the uninformed, the enlightened; to the straight-out lie, the simple truth."); *Ashcroft v. Free Speech Coalition*, 535 U.S. 234, 253 (2002) ("The right to think is the beginning of freedom, and speech must be protected from the government because speech is the beginning of thought."); *Int'l Soc'y for Krishna Consciousness, Inc. v. Lee*, 505 U.S. 672, 701 (1992) (Kennedy, J., concurring) ("The First Amendment is often inconvenient. But that is beside the point. Inconvenience does not absolve the government of its obligation to tolerate speech.").

fell to the pox of political correctness, even though the outcome of the Redskins case was resting in the balance and the floodgates were predicted to burst open with disparaging registered marks; (4) there was united pushback against the government-speech doctrine, stretching it beyond *Walker*; (5) the commercial-speech doctrine, premised on intermediate scrutiny review, someday may yet fall by the wayside; (6) while the whole Court agrees that viewpoint discrimination is wrong, justices conceptualize it differently and assign it differing degrees of importance; and (7) faith among the justices in the venerable marketplace-of-ideas theory remains remarkably strong in the digital age. Here's a more extended take on each item.

### **Alito Rides to the Defense of Offense**

In *Snyder v. Phelps*, the Supreme Court came to the defense of the Westboro Baptist Church and ruled for its right to engage in anti-gay, anti-family, and anti-military speech near a funeral for a U.S. soldier killed in Iraq. Only one justice dissented: Samuel Alito. "Our profound national commitment to free and open debate is not a license for the vicious verbal assault that occurred in this case," he wrote, explaining why he would have ruled for the plaintiff's tort claims against Westboro.<sup>28</sup>

One year prior, in *United States v. Stevens*, the Court nullified as overbroad a federal law targeting so-called crush videos depicting the killing and mutilation of animals. There again, only one justice dissented: Samuel Alito. "The Court strikes down in its entirety a valuable statute . . . that was enacted not to suppress speech, but to prevent horrific acts of animal cruelty—in particular, the creation and commercial exploitation of 'crush videos,' a form of depraved entertainment that has no social value," Alito opined.<sup>29</sup>

Alito also authored a dissent—this one joined by Justices Scalia and Thomas—in *United States v. Alvarez*. The Court there applied the "most exacting scrutiny" to declare unconstitutional the Stolen Valor Act, which made it a federal crime to lie about having won a Congressional Medal of Honor. "The lies covered by the Stolen Valor Act have no intrinsic value and thus merit no First Amendment protection unless their prohibition would chill other expression that falls

<sup>28</sup> *Snyder v. Phelps*, 562 U.S. 443, 463 (2011) (Alito, J., dissenting).

<sup>29</sup> *United States v. Stevens*, 559 U.S. 460, 482 (2010) (Alito, J., dissenting).

within the Amendment's scope," Alito wrote.<sup>30</sup> Foreshadowing the Alito-versus-Kennedy opinions in *Tam* and *Packingham*, Alito's *Alvarez* dissent took aim at the Kennedy-authored plurality opinion.

I asserted several years ago that it seemed Alito was "trying to change . . . First Amendment jurisprudence when it comes to offensive speech that he perceives to be of low value . . . in order to meet his own subjective standards of decency, civility, and substantive importance of expression."<sup>31</sup> Or, as Professor Mary-Rose Papandrea more recently and succinctly put it, "Alito does not have a track record as a particularly speech-protective Justice."<sup>32</sup>

But in *Tam*, he proved quite capable of writing an opinion protecting offensive speech that won over, in various parts, a majority and plurality of his fellow justices. That's excellent news from a free-speech perspective, but does it mean that Alito has changed his First Amendment stripes?

That's highly doubtful. Alito's opinion in *Tam*, I suspect, was really about thwarting political correctness, even if the disparagement clause had been on the books since 1946, decades before "PC" became a term. This anti-PC motivation is evident when Alito derisively dubs the statute "a happy-talk clause" and when he attacks the government's argument that it "has an interest in preventing speech expressing ideas that offend." Quoting Oliver Wendell Holmes Jr., Alito retorts that "[s]peech 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>33</sup> Alito's defense of Confederate flags on specialty license plates in his *Walker* dissent similarly reflects an anti-political-correctness stance; he was defending the right to display a polysemic symbol vilified by the political left.

<sup>30</sup> *United States v. Alvarez*, 567 U.S. 709, 739 (2012) (Alito, J., dissenting).

<sup>31</sup> Clay Calvert, Justice Samuel A. Alito's Lonely War against Abhorrent, Low-Value Expression: A Malleable First Amendment Philosophy Privileging Subjective Notions of Morality and Merit, 40 *Hofstra L. Rev.* 115, 169 (2011).

<sup>32</sup> Mary-Rose Papandrea, Free Speech Foundations Symposium: The Government Brand, 110 *Nw. U. L. Rev.* 1195, 1197 (2016).

<sup>33</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (quoting *United States v. Schwimmer*, 279 U. S. 644, 655 (1929) (Holmes, J., dissenting)).

For Alito, battling perceived political correctness in *Tam* and *Walker* is a far more important—and decidedly different—cause than safeguarding speech that (1) harms a grieving father—a private figure, no less—at his son’s funeral (*Snyder*); (2) depicts helpless animals victimized by humans’ sadistic sexual fetishes (*Stevens*); and (3) degrades the honor, as embodied by medals, of some of the bravest individuals who heroically fought enemy forces in the nation’s wars (*Alvarez*). Those factual differences are probably pertinent for Alito in distinguishing *Tam* and *Walker* from *Snyder*, *Stevens*, and *Alvarez*. In brief, Alito’s First Amendment stance in *Tam* may not cut across the free-speech playing field.

### **Breyer for Once Hews to Traditional Doctrinal Lines**

In multiple free-speech cases such as *Alvarez* and *Reed v. Town of Gilbert*,<sup>34</sup> Justice Breyer demonstrates aversion to adhering to traditional doctrinal rules and labels while, instead, embracing a jurisprudence of proportionality. As a recent article puts it, Breyer “appears to distrust the Court’s typical strict scrutiny framework for evaluating freedom of speech cases, including certain disputes where viewpoint discrimination is at issue. Frequently, he prefers employing a ‘proportionality’ balancing test for the vast majority of cases, refusing to place a heightened burden upon the statute at issue.”<sup>35</sup> Professor Mark Tushnet contends that Breyer is engaged in a “project of partial de-doctrinalization.”<sup>36</sup>

Breyer’s 2015 concurrence in *Reed*, which struck down a content-based sign ordinance under strict scrutiny, is illustrative. Although agreeing with the result, Breyer rejected the “mechanical use of categories” like strict scrutiny and content discrimination.<sup>37</sup> In their place, he argued for “a more basic analysis, which . . . asks whether the regulation at issue works harm to First Amendment interests that is disproportionate in light of the relevant regulatory

<sup>34</sup> 135 S. Ct. 2218 (2015).

<sup>35</sup> Benjamin Pomerance, An Elastic Amendment: Justice Stephen G. Breyer’s Fluid Conceptions of Freedom of Speech, 79 Alb. L. Rev. 403, 506 (2016).

<sup>36</sup> Mark Tushnet, Justice Breyer and the Partial De-Doctrinalization of Free Speech Law, 128 Harv. L. Rev. 508, 514 (2014).

<sup>37</sup> *Reed*, 135 S. Ct. at 2236 (Breyer, J., concurring).

objectives.”<sup>38</sup> The term content discrimination, for Breyer, sometimes merits treatment merely “as a *rule of thumb*, finding it a helpful, but not determinative legal tool, in an appropriate case, to determine the strength of a justification.”<sup>39</sup>

Such squishiness surfaced again in 2015 when Breyer concurred with a five-justice majority in *Williams-Yulee v. Florida Bar* that a rule banning judges from personally soliciting funds for their election campaigns survived strict scrutiny.<sup>40</sup> Referencing the traditional categories of constitutional review of strict scrutiny, intermediate scrutiny, and rational basis, Breyer wrote that he viewed the “Court’s doctrine referring to tiers of scrutiny as *guidelines* informing our approach to the case at hand, *not tests* to be mechanically applied.”<sup>41</sup> In fact, attacking the established doctrinal approach was the only reason Breyer wrote separately in *Williams-Yulee*: his concurrence was two sentences long and made no other points.

One thus can’t be faulted for believing that if Breyer someday has his way, he might import into free-speech cases the same balancing approach to the undue-burden standard he embraced in 2016 in the abortion-restriction case of *Whole Women’s Health v. Hellerstedt*.<sup>42</sup> Writing there for a five-justice majority, Breyer held that courts must “consider the burdens a law imposes on abortion access together with the benefits those laws confer.”<sup>43</sup> Justice Thomas derided this tack as a “free-form balancing test.”<sup>44</sup>

In the realm of free expression, Breyer’s *Hellerstedt* iteration of the undue-burden test might mean weighing the benefits of a restriction on speech against the burdens the regulation imposes on both speakers and audiences to, respectively, convey and receive the speech via other nonrestricted alternative means. In other words, it might be fairly close to a proportionality analysis.

But in *Tam*, Breyer toed traditional doctrinal lines safeguarding offensive speech and prohibiting viewpoint discrimination. He didn’t

<sup>38</sup> *Id.* at 2235–36.

<sup>39</sup> *Id.* at 2235 (emphasis added).

<sup>40</sup> 135 S. Ct. 1656 (2015).

<sup>41</sup> *Id.* at 1673 (Breyer, J., concurring) (emphasis added).

<sup>42</sup> 136 S. Ct. 2292 (2016).

<sup>43</sup> *Id.* at 2309.

<sup>44</sup> *Id.* at 2324 (Thomas, J., dissenting).

wander off to write a concurrence; in fact, he joined all parts and sections of the opinion authored by Alito. Perhaps most remarkable, he joined the section of Alito's opinion in which Alito, who had dissented in *Walker*, bluntly described the Breyer-authored majority opinion in that case as likely marking "the outer bounds of the government speech doctrine."<sup>45</sup> The only thing Breyer did not do in *Tam* was join the more decisive, case-killing approach to viewpoint discrimination adopted in Justice Kennedy's concurrence. It may be that Kennedy's more definitive doctrinal methodology to viewpoint discrimination in *Tam* is what caused Breyer—unlike fellow liberal-leaning Justices Ginsburg, Sotomayor, and Kagan—not to join Kennedy.

### **Political Correctness Loses Its Appeal**

Looming in the *Tam* courthouse, acknowledged or not, was the controversy over a half-dozen then-canceled trademarks for the Washington Redskins football team. The fate of those marks would turn on the result in *Tam*, so it was not surprising that a friend-of-the-court brief was filed in the case by several Native American organizations on behalf of the government. That brief asserted, among other things, that the "use of 'REDSKINS'—like other racially disparaging sports mascots—inflicts real injury. These mascots demean and dehumanize the target group; they foster misinformation and inappropriate stereotype; and they hinder development of self-esteem and other preconditions for social success."<sup>46</sup>

Professor Adam Epstein once contended that "if there is a current professional team name that has sparked legal controversy over the issue of politically incorrect nicknames, it is the Washington Redskins football team."<sup>47</sup> Thus, if the 1995 battle for Major League Baseball's crown between the Atlanta Braves and Cleveland Indians was the "Politically Incorrect World Series,"<sup>48</sup> then the fight in *Pro-Foot-*

<sup>45</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017).

<sup>46</sup> Brief of Amici Curiae Native American Organizations in Support of Petitioner, *Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>47</sup> Adam Epstein, Maryland Sports Law, 15 U. Denv. Sports & Ent. L.J. 49, 56 (2013).

<sup>48</sup> Michelle B. Lee, Section 2(A) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?, 4 Sports Law. J. 65, 65 (1997).

*ball, Inc. v. Blackhorse*<sup>49</sup> was shaping up as the legal Super Bowl over impolite marks.

When the Supreme Court ruled for The Slants, it therefore was not surprising one scholar claimed “the Court struck a blow against political correctness.”<sup>50</sup> But it was hardly the first time the Court had done that.

Specifically, all of the justices involved in *Tam*—save Alito—ruled in 2011 for the right of Westboro Baptist Church members to use politically incorrect statements such as “God Hates Fags,” “Thank God for Dead Soldiers,” and “Pope in Hell.”<sup>51</sup> That’s a trio of targets—the LGBTQ community, military, and Catholic church—of a combined sensitivity not far off from that of Asians or Native Americans. Sensitivity over the nation’s racial history was also in play in *Walker*, although a bare majority there squelched the offending imagery. Speech inviting offense was nothing new.

In late June 2017, the battle over registering the Redskins’ various marks concluded. The U.S. Justice Department filed a letter on June 28, 2017, with the U.S. Court of Appeals for the Fourth Circuit (where *Pro-Football, Inc. v. Blackhorse* was pending) and asked the court, in light of the Supreme Court’s decision in *Tam*, to enter judgment in favor of Pro-Football.<sup>52</sup> The next day, Amanda Blackhorse’s attorney filed a similar letter.<sup>53</sup>

Thus, in the early months of Donald J. Trump’s tenure as an oft-politically incorrect and name-calling provocateur president, the Court confirmed that under our system, there is no right to be free of offensive expression. And while political turmoil still roils the nation’s capital, its pro football team can—at least in the merchandising space—rest a tad easier after *Tam*.

<sup>49</sup> 112 F. Supp. 3d 439 (E.D. Va. 2015), cert. denied, 137 S. Ct. 44 (2016).

<sup>50</sup> Noah Feldman, Supreme Court Doesn’t Care What You Say on the Internet, Bloomberg View (June 19, 2017), <https://www.bloomberg.com/view/articles/2017-06-19/supreme-court-doesn-t-care-what-you-say-on-the-internet>.

<sup>51</sup> *Snyder v. Phelps*, 562 U.S. 443, 448 (2011).

<sup>52</sup> Letter from Mark R. Freeman, U.S. Dep’t of Justice Appellate Staff, Civil Division, to Patricia S. Connor, Clerk of the U.S. Court of Appeals for the Fourth Circuit (June 28, 2017), <http://www.politico.com/f/?id=0000015c-f0a0-d1e3-a97d-f9f436400001>.

<sup>53</sup> Letter from Jesse A. Witten, Counsel for Appellees Amanda Blackhorse et al., to Patricia S. Connor, Clerk of the U.S. Court of Appeals for the Fourth Circuit (June 29, 2017), <http://was.247sports.com/Bolt/Native-American-tribespeople-drop-case-regarding-Redskins-name-53381907>.

## Beating Back the Government-Speech Doctrine

The government-speech doctrine, Professor Mark Strasser points out, is not merely new—it dates back fewer than 30 years to the Court’s decision in *Rust v. Sullivan*, which upheld a program that denied federal funding to entities that perform abortions<sup>54</sup>—but also underdeveloped.<sup>55</sup> Indeed, Professor Papandrea asserts the doctrine is plagued by a “brief and troubled history.”<sup>56</sup>

Yet this nascent canon is simultaneously formidable and dangerous. As I recently wrote, it is “a powerful weapon in a state’s arsenal for expression—one deployable both for promoting the government’s own viewpoint and, conversely, for squelching the views of others with which it disagrees”<sup>57</sup> provided they can be identified as an extension of the government’s own expression. As the Supreme Court encapsulated it in 2009, “the Free Speech Clause restricts government regulation of private speech; it does not regulate government speech.”<sup>58</sup>

The government-speech doctrine, if applied to trademarks, would permit the PTO to blatantly discriminate against viewpoints when denying registration. The PTO could unabashedly bully marks that supposedly disparage groups by not registering them, while conversely promoting marks that laud, praise, or compliment those same groups by granting them registration.

Before the June 2017 ruling in *Tam*, but subsequent to the Court’s using the government-speech doctrine in *Walker* to censor the Confederate flag, lower courts concluded that the following constitute government speech: (1) a public school program allowing private businesses to hang self-promotional, school-partnership banners from school fences—picture outfield walls at baseball fields—in exchange for monetary donations;<sup>59</sup> (2) the words on food trucks

<sup>54</sup> 500 U.S. 173 (1991).

<sup>55</sup> Mark Strasser, Government Speech and Circumvention of the First Amendment, 44 Hastings Const. L.Q. 37, 38 (2016).

<sup>56</sup> Papandrea, *supra* note 32, at 1198.

<sup>57</sup> Clay Calvert, The Government Speech Doctrine in Walker’s Wake: Early Rifts and Reverberations on Free Speech, Viewpoint Discrimination, and Offensive Expression, 25 Wm. & Mary Bill of Rts. J. 1239, 1243 (2017).

<sup>58</sup> *Pleasant Grove City v. Summum*, 555 U.S. 460, 467 (2009).

<sup>59</sup> *Mech v. Sch. Bd. of Palm Beach Cnty.*, 806 F.3d 1070 (11th Cir. 2015), cert. denied, 137 S. Ct. 73 (2016). Classifying the banner program as government speech allowed the school district to deny banners to an individual who wanted to promote his math-



(including the names of businesses painted on them) taking part in a government-sponsored summer-lunch program held on government-owned property;<sup>60</sup> and (3) privately produced tourist guides and informational brochures distributed at rest stops and welcome centers owned by Virginia along its highways.<sup>61</sup>

It is not shocking, then, that one of the most important doctrinal issues in *Tam* was whether federally registered trademarks constitute government speech. The PTO argued that federal registration of marks transforms private expression into government speech—despite the fact that marks are not only created by private entities, but also used by those entities to identify themselves, their goods, and their services. Classifying federally registered trademarks as government speech would allow the PTO to deny registration to The Slants mark and, critically, to dodge all First Amendment-based challenges to its decision.

Under the PTO's logic in *Tam*, when you see Nike's omnipresent registered "swoosh" trademark on Nike running shorts ("Norts," as my undergrads dub them), it is the government—not the maker of athletic apparel and footwear—that is speaking. The government's argument in *Tam* thus sounded somewhat preposterous, but the Court in *Walker* opened the gate for it by holding that the messages on specialty license plates are those of the government, not those of either the private entities that design and create them or the private individuals who choose to display them.

Prior to *Walker*, the Court in 2009 held in *Pleasant Grove City v. Summum* that permanent monuments displayed in public parks constitute government speech, regardless of whether the monuments are designed, built, and donated by private entities.<sup>62</sup> In that case, a

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tutoring business but who had previously worked as a porn star. In brief, the person's prior occupation was successfully used against him and his current, decidedly non-pornographic speech without raising a First Amendment issue.

<sup>60</sup> *Wandering Dago, Inc. v. Destito*, No. 1:13-cv-1053, 2016 U.S. Dist. LEXIS 26046 (N.D.N.Y. Mar. 1, 2016). Labeling such expression government speech allowed the government to deny a permit, based on its alleged offensiveness, to the Wandering Dago food truck.

<sup>61</sup> *Vista-Graphics, Inc. v. Va. Dep't of Transport.*, No. 16-1404, 2017 U.S. App. LEXIS 5452 (Mar. 29, 2017).

<sup>62</sup> 555 U.S. 460 (2009). See Patrick M. Garry, *Pleasant Grove City v. Summum: The Supreme Court Finds a Public Display of the Ten Commandments to Be Permissible Government Speech*, 2008-2009 Cato Sup. Ct. Rev. 271 (2009).

religious entity called Summum sought to erect a stone monument bearing its “seven aphorisms” in a public park in Pleasant Grove City, Utah. When the city rejected Summum’s request, the religious order sued, claiming violation of the Free Speech Clause and pointing out that the city had previously accepted a donated monument featuring the Ten Commandments in the same park. Summum contended that public parks are traditional public fora for expression—something that the Court has long acknowledged—and that viewpoint discrimination in such venues violates the First Amendment.

Without dissent, the Court rejected Summum’s arguments. Justice Alito, penning the Court’s opinion, rebuffed the public forum argument, citing spatial concerns that “public parks can accommodate only a limited number of permanent monuments.”<sup>63</sup> While parks constitute sacred First Amendment space known as traditional public fora for some types of ephemeral expression—speeches, marches, rallies, and concerts—they don’t where permanent monuments are involved. As Alito put it, “it is hard to imagine how a public park could be opened up for the installation of permanent monuments by every person or group wishing to engage in that form of expression.”<sup>64</sup> Consider, in other words, grounds so crowded and cluttered by monuments that no space remains for bike paths, ball fields, swing sets, and the occasional amphitheater.

Beyond the spatial issue, Alito pointed to another factor—public perception—suggesting that donated, park-located monuments are government speech. “Public parks are often closely identified in the public mind with the government unit that owns the land,” he wrote, adding that:

Government decisionmakers select the monuments that portray what they view as appropriate for the place in question, taking into account such content-based factors as esthetics, history, and local culture. The monuments that are accepted, therefore, are meant to convey and have the effect of conveying a government message, and they thus constitute government speech.<sup>65</sup>

<sup>63</sup> Summum, 555 U.S. at 478.

<sup>64</sup> *Id.* at 479.

<sup>65</sup> *Id.* at 472.

But even in *Summum*, the government-speech doctrine rested on a shaky foundation. Alito, for example, openly acknowledged “there may be situations in which it is difficult to tell whether a government entity is speaking on its own behalf or is providing a forum for private speech.”<sup>66</sup> Justice Breyer, who later wrote for the majority in *Walker*, delivered a concurrence, stressing—per his propensity for doctrinal squishiness addressed earlier—his “understanding that the ‘government speech’ doctrine is a rule of thumb, not a rigid category.”<sup>67</sup> And Justice David Souter, citing the doctrine’s relative recency, cautioned that “it would do well for us to go slow in setting its bounds, which will affect existing doctrine in ways not yet explored.”<sup>68</sup>

But in *Walker*, the five-justice majority threw caution to the wind. In holding that specialty license plates are government speech, it ignored the fact that, unlike in *Summum*, there was no spatial scarcity problem. A seemingly vast number of specialty plates could coexist happily on Texas’s registered vehicles; this was not a public park with finite acreage. In fact, when *Walker* was decided, more than 350 different specialty plates were on vehicles registered in the Lone Star State.<sup>69</sup>

Instead of focusing on *Summum*’s scarcity concern, the Breyer-authored majority identified three factors—history, perception, and control—leading it to find that specialty plates are government speech. The first factor was the historical use of the medium as a means for expression. Specifically, Breyer wrote that “the history of license plates shows that, insofar as license plates have conveyed more than state names and vehicle identification numbers, they long have communicated messages from the States.”<sup>70</sup>

The second variable—this one borrowed from *Summum*—was public perception regarding who is speaking: the government or a private entity? In *Walker*, Breyer found that because Texas not only issues all specialty plates, but also emblazons each with “Texas” at the

<sup>66</sup> *Id.* at 470.

<sup>67</sup> *Id.* at 484 (Breyer, J., concurring).

<sup>68</sup> *Id.* at 485 (Souter, J., concurring).

<sup>69</sup> *Walker v. Texas Div., Sons of Confederate Veterans*, 135 S. Ct. 2239, 2255 (2015) (Alito, J., dissenting).

<sup>70</sup> *Id.* at 2248.

top, viewers likely perceive them as “government IDs.”<sup>71</sup> Citing nary a shred of evidence to support the claim, Breyer also reasoned that “a person who displays a message on a Texas license plate likely intends to convey to the public that the State has endorsed that message.”<sup>72</sup>

Finally, the *Walker* majority considered the amount of control Texas exerts over specialty plates. Breyer determined that “Texas maintains direct control over the messages conveyed on its specialty plates” because its Department of Motor Vehicles Board “must approve every specialty plate design proposal before the design can appear on a Texas plate.”<sup>73</sup>

Justice Alito, joined by the more conservative justices not named Thomas, scoffed at this approach, contending that the majority’s “capacious understanding of government speech takes a large and painful bite out of the First Amendment.”<sup>74</sup> Alito asserted that any person sitting by a Texas highway and watching cars speed by with specialty plates “bearing the name[s] of a high school, a fraternity or sorority, the Masons, the Knights of Columbus, the Daughters of the American Revolution, a realty company, a favorite soft drink, a favorite burger restaurant, and a favorite NASCAR driver” would not believe that such sentiments were those of Texas but rather the cars’ owners.<sup>75</sup>

*Tam* marked the first time since *Walker* that the Court revisited the government-speech doctrine. Significantly, all eight justices participating in *Tam* joined the part of the opinion addressing government speech, thus presenting a unified front on this malleable doctrine. And although the justices did not jettison the government-speech doctrine to the dumpster of failed First Amendment principles, they made several efforts seemingly designed to curb its use. How did they do that?

First and foremost, the Court flatly rejected the government’s contention that trademark registration converts private marks into government speech. As if channeling his snarky inner-Scalia, Alito posed twin rhetorical questions: “if trademarks represent

<sup>71</sup> *Id.* at 2249.

<sup>72</sup> *Id.*

<sup>73</sup> *Id.*

<sup>74</sup> *Id.* at 2255 (Alito, J., dissenting).

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

government speech, what does the Government have in mind when it advises Americans to ‘make.believe’ (Sony), ‘Think different’ (Apple), ‘Just do it’ (Nike), or ‘Have it your way’ (Burger King)? Was the Government warning about a coming disaster when it registered the mark ‘EndTime Ministries’?”<sup>76</sup> The queries pounded home Alito’s point that if registered marks are government speech, then the government “is unashamedly endorsing a vast array of commercial products and services.”<sup>77</sup>

Alito also engaged in some slippery-slope logic about the danger of calling registered marks government speech: “If federal registration makes a trademark government speech and thus eliminates all First Amendment protection, would the registration of the copyright for a book produce a similar transformation?”<sup>78</sup> Such an outcome would, akin to the PTO’s attack on *The Slants* for disparaging Asians, give the U.S. Copyright Office power to discriminate against original works of authorship that disparage groups. It could, for example, easily deny copyright registration to Bruce Springsteen’s lyrics for “Born in the U.S.A.” because the song’s protagonist is sent off “to a foreign land to go and kill the yellow man.”

Beyond simply ruling against the PTO, the Court also signaled that the government-speech doctrine must be reeled in. Notably, it dubbed the doctrine “susceptible to dangerous misuse,” thereby necessitating the Court to “exercise great caution before extending our government speech precedents”<sup>79</sup> such as *Summum* and *Walker*. And when it came to *Walker*—the opinion on which the PTO most heavily relied—Alito remarked that *Walker* “likely marks the outer bounds of the government speech doctrine.”<sup>80</sup> Additionally, none of the three factors deployed in *Walker*—history, perception, and control—militated in favor of classifying registered trademarks as government speech, Alito wrote.

Perhaps more subtly limiting the doctrine’s future scope was an Alito-created example suggesting it only applies and permits

<sup>76</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1759 (2017).

<sup>77</sup> *Id.*

<sup>78</sup> *Id.* at 1760.

<sup>79</sup> *Id.* at 1758.

<sup>80</sup> *Id.* at 1760.

viewpoint discrimination when, in fact, it is the government that genuinely creates and conveys a message:

During the Second World War, the Federal Government produced and distributed millions of posters to promote the war effort. There were posters urging enlistment, the purchase of war bonds, and the conservation of scarce resources. These posters expressed a viewpoint, but the First Amendment did not demand that the Government balance the message of these posters by producing and distributing posters encouraging Americans to refrain from engaging in these activities.<sup>81</sup>

Initially, this example is critical because it intimates that the government-speech doctrine is confined to scenarios in which the government itself produces and conveys a message related to its own interest. Furthermore, Alito's example smacks of gravitas—World War II, the military, national security, and urgently safeguarding the very future of the United States—whereas *Walker*, setting aside a Confederate-flag plate, involved the relative frivolity of specialized license plates supporting, among other things, multiple college sports teams and playing golf.<sup>82</sup>

Additionally, the message on wartime posters regarding army enlistment and war bonds directly ties to a specific government purpose or end that it hopes to achieve—winning a war. A specialty plate bearing the phrase “Rather Be Golfing” clearly does not seem to achieve any government purpose unless, perhaps, the government

<sup>81</sup> *Id.* at 1758.

<sup>82</sup> As Alito rhetorically asked in *Walker*:

If a car with a plate that says “Rather Be Golfing” passed by at 8:30 am on a Monday morning, would you think: “This is the official policy of the State – better to golf than to work?” If you did your viewing at the start of the college football season and you saw Texas plates with the names of the University of Texas's out-of-state competitors in upcoming games—Notre Dame, Oklahoma State, the University of Oklahoma, Kansas State, Iowa State—would you assume that the State of Texas was officially (and perhaps treasonously) rooting for the Longhorns' opponents?

*Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2255 (2015) (Alito, J., dissenting).

wants to generate revenue for itself from public courses. But that possibility is about as much of a legal stretch as was the PTO's argument in favor of government speech in *Tam*. Alito's example thus intimates that only when truly serious matters are at stake and, in turn, only when the government is the entity that actually creates and conveys the message for its own purpose, does it get a pass, via the government-speech doctrine, on the general rule against viewpoint discrimination.

Furthermore, Justice Kennedy's concurrence in *Tam* buttressed Alito's efforts to confine the government-speech doctrine. Specifically, Kennedy called it a "narrow" exception to the general rule against viewpoint discrimination, contending such narrowness is necessary "to prevent the government from claiming that every government program is exempt from the First Amendment."<sup>83</sup> Kennedy had joined Alito's dissent in *Walker*, so it is not surprising they were on the same page in this facet of *Tam*.

Ultimately, if the Court threw caution to the wind in *Walker* by unleashing the government-speech doctrine to sweep up specialty license plates that are designed, sponsored, and displayed by private entities and individuals, then in *Tam* it signaled a desire to keep the doctrine tightly tethered. Alito, who dissented against the use of the doctrine in *Walker*, thereby exacted a small measure of revenge in *Tam*.

*Walker* might turn out to be a dangerous but feel-good (at least for its liberal-bloc majority) one-off ruling to stop politically incorrect Confederate flags. Yet it remains good law today, even in the face of a unanimous effort to halt its momentum in *Tam*.

### **Putting the Commercial Speech Doctrine into Play Again**

It wasn't until the 1970s that the Supreme Court extended formal First Amendment protection to truthful advertisements for lawful goods and services. Yet, the Court consistently treats commercial speech less favorably than other types of expression such as political speech. The Court does so by measuring the validity of restrictions on commercial speech against an intermediate—rather than

<sup>83</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1768 (2017) (Kennedy, J., concurring).

strict—scrutiny test that affords greater deference to the government.<sup>84</sup> In brief, it generally is easier for the government to regulate ads for products and services than for it to regulate speech about other matters.

Justice Thomas, however, has long objected to this second-tier treatment of commercial expression. One scholar notes that Thomas has “clearly staked out his claim as a First Amendment defender in his commercial speech opinions.”<sup>85</sup> As Thomas opined in 2001, “I continue to believe that when the government seeks to restrict truthful speech in order to suppress the ideas it conveys, strict scrutiny is appropriate, whether or not the speech in question may be characterized as ‘commercial.’”<sup>86</sup>

*Tam* provided Thomas with another opportunity to make this point. That’s because the government argued that trademarks are commercial speech—basically just names by which companies promote themselves. Applying the usual intermediate-scrutiny test for commercial-speech cases, a bloc of four justices in *Tam*—Alito, Roberts, Breyer, and Thomas—held that the disparagement clause failed to meet this standard. That conclusion is unremarkable.

Thomas, however, penned a concurrence. He agreed the disparagement clause was “unconstitutional even under the less stringent test” for commercial-speech cases, but he also reiterated his position that strict scrutiny provides the appropriate test in such disputes.<sup>87</sup>

<sup>84</sup> The U.S. Supreme Court fashioned a four-part test for commercial speech that requires courts to

determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest.

*Central Hudson Gas & Electric Corp. v. Pub. Servs. Comm’n*, 447 U.S. 557, 566 (1980); see also *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 572 (2001) (Thomas, J., concurring) (describing “the intermediate scrutiny of *Central Hudson*”).

<sup>85</sup> David L. Hudson, Jr., Justice Clarence Thomas: The Emergence of a Commercial-Speech Protector, 35 *Creighton L. Rev.* 485, 486 (2002).

<sup>86</sup> *Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525, 572 (2001) (Thomas, J., concurring).

<sup>87</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1769 (2017) (Thomas, J., concurring).



Although Thomas has yet to convince his fellow justices this should be the case, Alito's plurality opinion in *Tam* provides support for that prospect in the future.

In particular, Alito observed that "the line between commercial and non-commercial speech is not always clear, as this case illustrates."<sup>88</sup> Such murkiness is unsurprising, largely because the Court has never satisfactorily defined commercial speech in the first place. As one scholar bluntly wrote last year, "No one knows exactly what commercial speech is."<sup>89</sup>

The Court even passed on the opportunity to define it 14 years ago in a case involving Nike that blended commercial speech elements with political expression.<sup>90</sup> There, the Court initially decided to hear the case, but then dismissed it, invoking the rarely used notion that its writ of certiorari had been "improvidently granted."

Despite the definitional difficulties, the commercial versus non-commercial distinction can be pivotal—even outcome-determinative—because a statute is more likely to be struck down under strict scrutiny than intermediate scrutiny. Alito's frank acknowledgement in *Tam* that the nation's high court sometimes has trouble separating commercial and noncommercial speech further opens the door for scrapping what may be a false dichotomy.

Finally, Justice Kennedy's *Tam* concurrence further chops away at the notion that commercial-speech regulations are always subject only to intermediate scrutiny. As Kennedy wrote, "discrimination based on viewpoint, including a regulation that targets speech for its offensiveness, remains of serious concern in the commercial context" and thus "necessarily invokes heightened scrutiny."<sup>91</sup> In other words, a statute restricting commercial speech is subjected to something more than just intermediate scrutiny when the regulation is viewpoint-based. Kennedy explained that neither the term nor category of commercial speech provides "a blanket exemption from the First Amendment's requirement of viewpoint neutrality."<sup>92</sup>

<sup>88</sup> *Id.* at 1765 (Alito, J., joined by Roberts, C.J., and Thomas and Breyer, JJ.).

<sup>89</sup> Tamara R. Piety, *The First Amendment and the Corporate Civil Rights Movement*, 11 J. Bus. & Tech. L. 1, 4 (2016).

<sup>90</sup> *Nike, Inc. v. Kasky*, 539 U.S. 654 (2003).

<sup>91</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1767 (2017) (Kennedy, J., concurring).

<sup>92</sup> *Id.*

This logic builds on Kennedy's 2011 majority opinion in *Sorrell v. IMS Health Inc.*<sup>93</sup> The Court there struck down a Vermont statute banning pharmacies from selling, for marketing purposes, records revealing the prescribing histories of individually identifiable doctors. Those records could be freely sold to others, but not to data-harvesting pharmaceutical marketers who, in turn, would use the information to try to sell particular drugs to specific doctors. Kennedy found this disparate treatment of pharmaceutical marketers troubling, reasoning the statute "disfavors marketing, that is, speech with a particular content. More than that, the statute disfavors specific speakers, namely pharmaceutical manufacturers."<sup>94</sup> The law thus warranted heightened scrutiny—scrutiny greater than the usual intermediate standard for commercial speech—because it targeted particular speakers (pharmaceutical salespeople) and their viewpoints in using that information. The majority, however, backed down from actually applying strict scrutiny (or something like it) in *Sorrell* because it reasoned the statute couldn't even pass muster under the lesser intermediate-scrutiny test.<sup>95</sup>

In summary, the trio of opinions in *Tam* authored by Justices Thomas, Breyer, and Kennedy collectively indicates that the future of an intermediate-scrutiny-based commercial-speech doctrine is perhaps tenuous. And when *Tam* is viewed more broadly, it illustrates different definitional difficulties—one in distinguishing government speech from private expression, the other in deciding what is commercial speech—now plaguing two relatively recent doctrines.

### **Viewpoint Discrimination: Contested Meaning and Effect**

Although all eight justices in *Tam* agreed that the disparagement clause unconstitutionally discriminated against a viewpoint, they split 4-4 on when viewpoint discrimination exists and when it is fatal to a statute. Justice Kennedy, joined by Justices Ginsburg, Sotomayor, and Kagan, provided—in my view—a sharper, more textbook-like definition and emphasized the statute-killing power of the rule against viewpoint discrimination. Justice Alito, joined by Justices

<sup>93</sup> 564 U.S. 552 (2011).

<sup>94</sup> *Id.* at 564.

<sup>95</sup> As Justice Kennedy wrote, "the outcome is the same whether a special commercial speech inquiry or a stricter form of judicial scrutiny is applied." *Id.* at 571.

Roberts, Thomas, and Breyer, took a more muddled approach. Because this rift may affect future cases, it helps to explore it in greater detail, starting with Kennedy's opinion and then Alito's take.

What is viewpoint discrimination? For Kennedy, it is a subset or subtype of a larger category of discrimination called content-based discrimination. In brief, content-based discrimination targets a specific subject matter, while viewpoint discrimination slices and dices within that subject matter and, as Kennedy wrote, singles "out a subset of messages for disfavor based on the views expressed."<sup>96</sup> Put slightly differently by Kennedy, a viewpoint-based law impermissibly attempts "to remove certain ideas or perspectives from a broader debate" about a subject.<sup>97</sup> The First Amendment mandates viewpoint neutrality by the government—the converse of viewpoint discrimination.

The classroom example I use to illustrate this point compares two hypothetical laws restricting speech about abortion. Abortion, to use Kennedy's words, is "the relevant subject" in both laws. One law restricts *all speech* about abortion and thus reflects content-based discrimination. The other law restricts only *pro-choice speech* about abortion (but not pro-life speech or other perspectives on abortion), thereby embodying viewpoint discrimination.

Applying this logic to the disparagement clause, Kennedy explained that the subjects targeted were "persons, living or dead, institutions, beliefs, or national symbols." About such subjects, however, the clause permitted registration only for "a positive or benign mark but not a derogatory one. The law thus reflects the Government's disapproval of a subset of messages it finds offensive. This is the essence of viewpoint discrimination."<sup>98</sup> As applied to *The Slants* case, the clause allowed registering marks lauding Asian-Americans, but not ones disparaging them. It was that simple.

The impact of such viewpoint discrimination was, in turn, outcome determinative for the Kennedy bloc. Viewpoint discrimination, he emphasized, is "so potent that it must be subject to rigorous constitutional scrutiny," regardless of whether the speech offends audiences or is classified as commercial. "To the extent trademarks

<sup>96</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1766 (2017) (Kennedy, J., concurring).

<sup>97</sup> *Id.* at 1767.

<sup>98</sup> *Id.* at 1766.

qualify as commercial speech, they are an example of why that term or category does not serve as a blanket exemption from the First Amendment's requirement of viewpoint neutrality," Kennedy wrote.<sup>99</sup>

That was an important point that divided the Court. Justices Kennedy, Ginsburg, Sotomayor, and Kagan believe that viewpoint-based laws targeting commercial speech are subject to "rigorous" scrutiny. Thus, they did not join in the part of Justice Alito's opinion in which he, Roberts, Thomas, and Breyer analyzed the disparagement clause under the deferential intermediate scrutiny that typically applies in commercial-speech cases.

Kennedy identified only one exception to the principle that viewpoint discrimination is verboten—namely, when the government-speech doctrine applies. As he put it, "the Court's precedents have recognized just one narrow situation in which viewpoint discrimination is permissible: where the government itself is speaking or recruiting others to communicate a message on its behalf."<sup>100</sup> Because that lone exception to the rule against viewpoint discrimination did not apply in *Tam*, The Slants prevailed and the PTO lost.

The bottom line for the Kennedy bloc in *Tam* is that the presence of viewpoint discrimination, coupled with the absence of government speech, rendered "unnecessary any extended treatment of other questions raised by the parties." The quoted part of that sentence jabs at the ink spilled by Alito, Roberts, Thomas, and Breyer in considering the government's back-up, ill-fated arguments that *Tam* should have been treated either as a government-subsidy case or under a proposed new doctrine for "government-program" cases.

Justice Alito's analysis of viewpoint discrimination is more problematic for two reasons. First, and as noted above, although Alito found that the disparagement clause discriminated on the basis of viewpoint, he nonetheless analyzed it under the intermediate-scrutiny test for commercial speech cases rather than a more rigorous standard. His choice didn't affect the outcome in *Tam* because the Alito bloc found that the clause failed even under intermediate scrutiny. It does, however, reflect a key difference between the Kennedy and Alito blocs going forward regarding the correct standard when

<sup>99</sup> *Id.* at 1767.

<sup>100</sup> *Id.* at 1768.

a law targeting commercial speech also discriminates on the basis of viewpoint.

Second, Alito failed to provide a clear formula for determining when a law is viewpoint-based. He simply wrote that “[o]ur cases use the term ‘viewpoint’ discrimination in a broad sense”; the disparagement clause was viewpoint-based because “[g]iving offense is a viewpoint.”<sup>101</sup> Alito then cited a laundry list of cases, including the Court’s flag-burning decision of *Texas v. Johnson*<sup>102</sup> and its ruling protecting pornographer Larry Flynt’s ability to luridly poke fun at Reverend Jerry Falwell in *Hustler Magazine v. Falwell*,<sup>103</sup> standing for the proposition that an idea cannot be censored simply because it offends.

My worry is that Alito muddled two distinct doctrinal strands—one generally prohibiting censorship based on offensiveness and one banning viewpoint discrimination—in finding that “giving offense is a viewpoint.” Consider *Cohen v. California*, the “Fuck the Draft” opinion noted at the start of the essay and a quintessential offensive speech case. The statute there targeted “offensive conduct,” and the Court framed the issue as whether California could “properly remove this offensive word from the public vocabulary.”

But if offense equals a viewpoint, as Alito has it in *Tam*, then it’s surprising the Court in *Cohen* failed to analyze the California statute as an instance of viewpoint discrimination. There was, most notably, no examination by the Court of whether a person could freely say pro-draft messages in a courthouse but not make anti-draft statements. That’s how a viewpoint-discrimination analysis likely would have unfolded in *Cohen*.

Instead, the Court focused on (1) the need to protect the emotive—not simply cognitive—function of speech, (2) the self-help remedy for those offended of averting their eyes from Paul Robert Cohen’s jacket-worn message, and (3) the vagueness problems with defining offensiveness. Justice John Marshall Harlan II remarked for the majority on this last point that

<sup>101</sup> *Id.* at 1763 (plurality op.).

<sup>102</sup> 491 U.S. 397 (1989).

<sup>103</sup> 485 U.S. 46 (1988).

while the particular four-letter word being litigated here is perhaps more distasteful than most others of its genre, it is nevertheless often true that one man's vulgarity is another's lyric. Indeed, we think it is largely because governmental officials cannot make principled distinctions in this area that the Constitution leaves matters of taste and style so largely to the individual.<sup>104</sup>

The Court in *Cohen*, however, did recognize that offensiveness could serve as an excuse for discriminating against a viewpoint. As Harlan pointed out, "we cannot indulge the facile assumption that one can forbid particular words without also running a substantial risk of suppressing ideas in the process. Indeed, governments might soon seize upon the censorship of particular words as a convenient guise for banning the expression of unpopular views."<sup>105</sup>

In other words, offense and viewpoint are *not* always the same. The word "fuck" is what gave offense in *Cohen*, not Paul Robert Cohen's anti-draft viewpoint. Taking offense at a word ("fuck") is not the same as discriminating against the viewpoint in which that word is used ("fuck the draft"). "Fuck," standing alone without "the draft," is not a viewpoint. Giving or taking offense therefore is not always a viewpoint.

For Alito, *Tam* was more about protecting offensiveness than it was about prohibiting viewpoint discrimination. Alito's discussion of viewpoint discrimination in Part III, Section C—a section the Kennedy bloc did not join—covered only two paragraphs before Alito segued out by citing a list of right-to-offend cases, including *Johnson* and *Falwell*.<sup>106</sup> It's as if Alito tossed in a few sentences about viewpoint discrimination as a sop to Kennedy, who engaged in a lengthy analysis of that problem.

Perhaps most telling is the fact that Alito omitted any reference to viewpoint discrimination in announcing the Court's judgment at the opening of the opinion. He wrote only that the disparagement clause "violates the Free Speech Clause of the First Amendment. It offends a bedrock First Amendment principle: Speech may not be banned

<sup>104</sup> *Cohen v. California*, 403 U.S. 15, 25 (1971).

<sup>105</sup> *Id.* at 26.

<sup>106</sup> *Cohen v. California* is conspicuously missing from this list of cases.

on the ground that it expresses ideas that offend.”<sup>107</sup> For Alito, *Tam* was about protecting offensive expression from the forces of political correctness.

Contrast that with the second paragraph of Justice Kennedy’s concurrence, which reads: “As the Court is correct to hold, [the disparagement clause] constitutes viewpoint discrimination—a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny. The Government’s action and the statute on which it is based cannot survive this scrutiny.”<sup>108</sup> For Kennedy, *Tam* was about preventing viewpoint discrimination in the marketplace of ideas.

This may all seem like two sides of the same legal coin. I doubt, however, that Justice Kennedy thought so when he engaged in the kind of lengthy and thoughtful analysis of viewpoint discrimination that Justice Alito’s opinion lacked.

### **Faith in the Marketplace of Ideas**

Back in 1919, Justice Oliver Wendell Holmes Jr. imported the marketplace-of-ideas theory of free expression into First Amendment jurisprudence in *Abrams v. United States*.<sup>109</sup> Writing in dissent, Holmes contended that

when men have realized that time has upset many fighting faiths, they may come to believe even more than they believe the very foundations of their own conduct that the ultimate good desired is better reached by free trade in ideas—that the best test of truth is the power of the thought to get itself accepted in the competition of the market.<sup>110</sup>

Nearly a century later, Justice Kennedy favorably invoked the marketplace metaphor in *Tam* to explain why viewpoint discrimination is wrong and why, in turn, the disparagement clause is

<sup>107</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

<sup>108</sup> *Id.* at 1765 (2017) (Kennedy, J., concurring).

<sup>109</sup> 250 U.S. 616 (1919).

<sup>110</sup> *Id.* at 630 (Holmes, J., dissenting).

unconstitutional. “By mandating positivity, the law here might silence dissent and distort the marketplace of ideas,” Kennedy opined.<sup>111</sup>

Similarly, Kennedy’s criticism of removing “certain ideas and perspectives from a broader debate” reflects the notion that the consummate marketplace of ideas is a forum for debating all ideas and perspectives. The participants in this ideal marketplace are also rational and thoughtful, with Kennedy confidently suggesting that an initial hostile reaction to a message “may prompt further reflection, leading to a more reasoned, more tolerant position.” Ultimately, Kennedy closed his concurrence with a deep bow to faith in marketplace discussion rather than to trust in the government:

A law that can be directed against speech found offensive to some portion of the public can be turned against minority and dissenting views to the detriment of all. The First Amendment does not entrust that power to the government’s benevolence. Instead, our reliance must be on the substantial safeguards of free and open discussion in a democratic society.<sup>112</sup>

Some, of course, will consider such assuredness in the marketplace of ideas hopelessly naïve. We live in an era in which instantaneous outrage (not reason or reflection) rules in response to offending tweets and “free and open discussion” is replaced by often unhinged—albeit, certainly free and open—verbal confrontation. What’s more, marketplace competition of ideas hasn’t driven out the falsity that is fake news—the great political and journalistic panic of 2016–17—and replaced it with the truth. Many would also argue the marketplace of ideas already is badly distorted by the forces of concentrated, corporate media ownership, so what’s the harm in a little government intervention when it comes to registering trademarks?

But the Court’s continuing invocation of the metaphor is testament, against all else, that it is an aspirational model for which society should strive and upon which the government should not encroach or interfere. It may be a flawed theory, but it clearly captures

<sup>111</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1766 (2017) (Kennedy, J., concurring).

<sup>112</sup> *Id.* at 1769.



why the government cannot jettison ideas and perspectives it disdains from the hurly-burly of today's speech environment.

### Final Thoughts

Although the Court in *Tam* struck down the Lanham Act's disparagement clause, it did not address the constitutionality of another facet of the same statute that allows the PTO to deny registration to marks featuring "immoral, deceptive, or scandalous matter."<sup>113</sup> This clause has been used by the PTO to reject registration for sexually themed trademarks such "1-800-JACK-OFF" and "JACK-OFF" for a dial-a-porn company,<sup>114</sup> as well as the phrase "Cock Sucker" accompanying a drawing of a crowing rooster for a company selling—you guessed it—rooster-shaped chocolate lollipops.<sup>115</sup>

Unpacking the phrase "immoral, deceptive, or scandalous matter" is important. Prohibiting registration for deceptive marks is not problematic because the First Amendment does not safeguard commercial speech that is false or misleading. But refusing registration for immoral or scandalous marks is troubling, given the subjective, value-laden judgments regarding the meaning of those words. In particular, the PTO's use of "scandalous" is often interchangeable with the term "vulgar,"<sup>116</sup> which circles back to the Supreme Court's observation in *Cohen* that "one man's vulgarity is another's lyric."<sup>117</sup> A facial challenge on void-for-vagueness grounds to the part of 15 U.S.C. § 1052(a) targeting immoral and scandalous marks thus might provide another route for further rolling back the PTO's authority over offensive speech.<sup>118</sup>

<sup>113</sup> 15 U.S.C. § 1052(a) (2017).

<sup>114</sup> *In re Blvd. Entm't, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003).

<sup>115</sup> *In re Fox*, 702 F.3d 633 (Fed. Cir. 2012).

<sup>116</sup> Megan M. Carpenter & Mary Garner, NSFW: An Empirical Study of Scandalous Trademarks, 33 *Cardozo Arts & Ent. L.J.* 321, 335 (2015) (noting that "[t]he term 'scandalous' has been held to encompass matter that is merely 'vulgar,'" and adding that "the Federal Circuit has held that dictionary definitions alone can be sufficient to establish scandalousness where multiple dictionaries indicate a word is vulgar and the applicant's mark indicates the vulgar meaning of the word").

<sup>117</sup> 403 U.S. 15, 25 (1971).

<sup>118</sup> See *Grayned v. City of Rockford*, 408 U.S. 104, 108 (1972) (calling it "a basic principle of due process that an enactment is void for vagueness if its prohibitions are not clearly defined" such that they fail to "give the person of ordinary intelligence a reasonable opportunity to know what is prohibited").

On the one hand, the Supreme Court in *Tam* virtually teed up such a future challenge. That's because Justice Alito, in a part of the opinion joined by all of the justices except Thomas, dropped a footnote pointing out that "the PTO has acknowledged that the guidelines 'for determining whether a mark is *scandalous* or disparaging are somewhat vague and the determination of whether a mark is *scandalous* or disparaging is necessarily a highly subjective one.'"<sup>119</sup>

On the other hand, the Supreme Court's current test for obscenity is replete with moralistic terms such as "prurient interest" and "patently offensive."<sup>120</sup> Additionally, "prurient interest" is defined by the Court with the equally subjective and moralistic notion of "a shameful or morbid interest in sex."<sup>121</sup> And, as noted earlier, the Court recently dodged a First Amendment challenge to the FCC's problematic definition of indecency.<sup>122</sup> In brief, the Court demonstrates some tolerance for subjectivity and ambiguity when it comes to regulating sexual matters. Thus, whether a challenge to the PTO's authority over immoral and scandalous marks would be successful with the Supreme Court is unclear, but Alito's footnote in *Tam* certainly encourages the effort.

Although *Tam* addressed a federal statute, the Court's ruling has direct implications for state trademark laws too. That's because dozens of state statutes also target disparaging trademarks and mirror the language of the federal disparagement clause struck down in *Tam*. For instance, Florida Statute § 495.021(b) allows Sunshine State officials to deny registration to any mark that "consists of or comprises matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." Statutes in other populous states such as California and New York contain the same language.<sup>123</sup> These laws are now ripe for First Amendment challenges, with *Tam* serving as precedent for holding them unconstitutional.

<sup>119</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1756, n.5 (2017) (emphasis added) (quoting *In re In Over Our Heads, Inc.*, 16 USPQ 2d 1653, 1654 (TTAB 1990) (brackets and internal quotation marks omitted)).

<sup>120</sup> *Miller v. California*, 413 U.S. 15, 24 (1973).

<sup>121</sup> *Brockett v. Spokane Arcades, Inc.*, 472 U.S. 491, 504 (1985).

<sup>122</sup> *Supra* notes 3–8 and accompanying text.

<sup>123</sup> Cal. Bus. & Prof. Code § 14205 (2017); N.Y. Gen. Bus. § 360-a (Consol. 2017).

Ultimately, from a free-speech perspective, there is much to praise about the ruling in *Tam*. It vindicates and reaffirms key First Amendment principles regarding both offensive expression and viewpoint discrimination. It also rebuffs the government-speech doctrine in the realm of trademarks, while attempting to curb its expansion elsewhere. Furthermore, facets of the opinions of Justices Alito, Thomas, and Kennedy collectively raise questions about the future of an intermediate-scrutiny-based commercial speech doctrine. Additionally, *Tam* reinforces the Court's continued respect for the marketplace of ideas. What's more, Justice Alito came to the aid of offensive expression, while Justice Breyer didn't stray off the beaten doctrinal path. That's just about a First Amendment home run, with the unfortunate 4-4 split among the justices regarding viewpoint discrimination the only item keeping the ball inside the fence for a triple.