Federal Circuit Denies Bid to Expedite Registration of "Disparaging" Trademarks

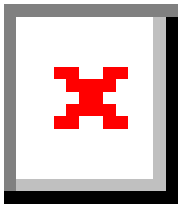
March 31, 2016

DC Client Alert - March 2016

by Scott A.M. Chambers, Ph.D. and Matthew J. Laskoski

The Federal Circuit has denied a petition for a writ of mandamus filed by Simon Shiao Tam that would have forced the U.S. Patent and Trademark Office (USPTO) to immediately comply with the Federal Circuit's recent invalidation of the government's ban on "disparaging" trademarks by registering his "The Slants" trademark.

The USPTO originally refused to register "The Slants" as a trademark for Mr. Tam's band, arguing that the trademark was disparaging to Asian Americans. Mr. Tam appealed that decision and in December of last year, the en banc Federal Circuit struck down the "disparaging" trademark rule, arguing that it was a violation of the First Amendment.

Despite the December ruling, the USPTO refused to publish for registration the trademark for "The Slants" under the auspices that there is still time for appeal of the December ruling. Instead, the USPTO has suspended prosecution of all "disparaging" trademarks. The denial of the recent petition by Mr. Tam allows the USPTO to hold off on registering all "disparaging" trademarks until all appeals are exhausted.

This is a closely watched decision not only for Mr. Tam and his "The Slants" band, but also because the Washington Redskins had their trademark canceled under the "disparaging" trademark rule in 2014 as being disparaging to Native Americans. With the December 2015 Federal Circuit ruling that the "disparaging" trademark rule is invalid, the door is open for the Washington Redskins to resurrect their federal trademark rights.