



Archer Wins Managing IP's North America Award for Trademark Milestone Case of the Year

Press Releases

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Managing Intellectual Property recently announced its 2016 North America Award winners and recognized Archer for its milestone case, *In Re Simon Shiao Tam* (known as "The Slants" case), which has far-reaching implications for its expansion of commercial free speech rights. The case initially made national headlines late last year when, as a result of the efforts of Archer attorneys Ronald Coleman, [John Connell](#) and Joel MacMull, the U.S. Court of Appeals for the Federal Circuit ruled that the Lanham Act's prohibition against registration of so-called "disparaging" trademarks was unconstitutional.

In the case, Simon Shiao Tam, frontman for an Asian-American rock band called The Slants, appealed a decision by the U.S. Patent and Trademark Office ("PTO") rejecting his trademark application for his band's name THE SLANTS. Section 2(a) of the Lanham Act gave the PTO the authority to refuse registration of a trademark that, in its view, "consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."

On appeal, the Trademark Trial and Appeal Board ("Board") affirmed the PTO's decision, denying Tam's application out of concern the band's name was "a highly disparaging reference to people of Asian descent." On further appeal, the Federal Circuit initially affirmed the Board's findings, concluding that the term THE SLANTS likely refers to people of Asian descent, therefore falling within the ambit of section 2(a). Consistent with prior precedent, the Court further held the PTO's refusal to register a trademark does not infringe any form of expression because such a refusal "does not affect the applicant's right to use the mark in question."

Notwithstanding the Court's opinion, Judge Kimberly Moore wrote at length questioning whether the precedent for rejecting disparaging marks, *In re McGinley*, should be revisited given the developments in the law surrounding First Amendment jurisprudence in the 30 years since *McGinley* was decided.

A few days after the opinion was rendered, and in response to Judge Moore's invitation to reconsider *McGinley*, the Federal Circuit vacated its initial opinion and judgment and ordered rehearing of the case before all eleven judges of the Court. The singular question to be decided by the full Court was whether section 2(a) was unconstitutional under the First Amendment. With the issue now recast, the full Court ruled 9-2 in December 2015 that section 2(a) was indeed unconstitutional. Thus, the Court vacated the Board's ruling that Mr. Tam's mark was unregistrable, and sent the case back to the Board for "further proceedings."

Attorneys in Archer's Intellectual Property Group are leaders in their fields and represent clients internationally, nationally and regionally with respect to the protection, enforcement and monetization of their intellectual property interests involving patents, trademarks, copyrights, trade secrets and rights of publicity. The firm's intellectual property attorneys have been recognized by leading legal publications and rankings, and recently Ronald Coleman was identified as one of the world's leading trademark professionals in World Trademark Review's publication, *WTR 1000 2016*.

Archer PC is a full-service regional law firm with more than 175 lawyers and eight offices in Haddonfield, Hackensack, Princeton, Flemington and Red Bank, N.J.; Philadelphia, Pa.; New York, N.Y.; and Wilmington, Del. The Firm has been serving Fortune 100 clients, small to medium-sized businesses and individuals for 85 years. Each office provides full-service litigation and transactional capabilities in nearly every area of law including corporate, estate & trust, family & matrimonial, labor & employment, litigation, medical & personal injury, and real estate services. For more information, visit www.archerlaw.com.

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