

## NOTES & COMMENTS

### TRADEMARKING HATE SPEECH: THE DANGERS OF INCONSISTENCY IN THE FEDERAL TRADEMARK REGISTRATION PROCESS

by  
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*In 2017, the United States Supreme Court decided in *Matal v. Tam* that the Lanham Act's prohibitions on disparaging trademarks violated the First Amendment of the Constitution. Two years later, it decided in *Iancu v. Brunetti* that prohibitions on "immoral or scandalous" marks were similarly unconstitutional. In the wake of these decisions, and at a time when hate speech is surging in the United States, this Comment seeks to address the danger of the USPTO's approach to federal trademark registration. Part I uses the example of the WHITE LIVES MATTER mark to introduce the problems that arise in this new, less-regulated trademark environment. Part II explains the importance of federal registration for trademark owners and the effect of *Tam* and *Brunetti* on the USPTO's ability to refuse registration of certain marks. Part III addresses how the USPTO's inconsistent decision-making, both before and after *Tam* and *Brunetti*, thwarts trademark's ultimate goals of protecting consumers from confusion and protecting trademark owners' property rights. Part IV examines solutions to the inconsistencies in federal registration and seeks to propose a workable fix that the USPTO can implement. Ultimately,*

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*this Comment concludes that the inconsistencies in the USPTO's federal trademark registration process enable the use and commercialization of hate speech. The USPTO must therefore adopt an intersectional critical race lens and standardize its practices to properly combat such virulent rhetoric.*

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## I. INTRODUCTION

In recent years, derogatory and harmful hate speech based on racial or ethnic biases has proliferated in the United States of America.<sup>1</sup> Such hate speech is directly linked to violent and deadly crimes—and even an attempted overthrow of the United States government.<sup>2</sup> Yet, in contrast to most of the Western world, Congress has not passed legislation criminalizing hate speech due to the First Amendment's requirement that it "shall make no law . . . abridging the freedom of speech."<sup>3</sup>

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<sup>1</sup> See, e.g., *2020 FBI Hate Crime Statistics*, U.S. DEP'T OF JUST., <https://www.justice.gov/crs/highlights/2020-hate-crimes-statistics> (Apr. 4, 2023) (finding an increase in reported incidents of hate crimes in 2020, with 62% of hate crimes based on race, ethnicity, or ancestry); *2021 Hate Crime Statistics*, U.S. DEP'T OF JUST., <https://www.justice.gov/hatecrimes/2021-hate-crime-statistics> (Oct. 30, 2023) (finding 64.5% of reported hate crimes were based on race, ethnicity, or ancestry).

<sup>2</sup> NORA FUTTNER & NATALIA BRUSCO, GENEVA INT'L CTR. FOR JUST., *HATE SPEECH IS ON THE RISE 5* (2021), [https://www.gicj.org/images/2021/Hate\\_Speech\\_is\\_On\\_the\\_Rise-FINAL\\_1.pdf](https://www.gicj.org/images/2021/Hate_Speech_is_On_the_Rise-FINAL_1.pdf) (contending that the storming of the U.S. Capitol on January 6, 2021, was "an extreme consequence of allowing hate speech to flourish and spread on social media").

<sup>3</sup> U.S. CONST. amend. I; see *R.A.V. v. St. Paul*, 505 U.S. 377, 382 (1992) ("The First Amendment generally prevents government from proscribing speech, or even expressive conduct, because of disapproval of the ideas expressed." (citations omitted)); FUTTNER & BRUSCO, *supra* note 2, at 4–5 ("The approach of the U.S. to not criminalize hate speech is an outlier when compared to other western democracies.").

Given this background, other legal avenues must emerge to combat the increasing presence and consequences of hate speech in America. Although intellectual property law is largely untapped by activists seeking to eradicate hate speech, trademark law recently came into popular culture when Ye, the rap artist formerly known as Kanye West, attempted to sell clothing with the phrase “White Lives Matter,” but was thwarted in his efforts.<sup>4</sup> To Ye’s dismay, another individual named Jae Gibson had already applied to register WHITE LIVES MATTER for jogging suits, shirts, sweatpants, and sweatshirts.<sup>5</sup> Gibson later assigned the mark to Civic Cipher LLC, a business entity comprised of Ramses Ja and Quinton Ward, both radio hosts in Phoenix, Arizona.<sup>6</sup> Therefore, Ye could not sell his anticipated clothing line without risking a potential trademark infringement action from Ja and Ward, which was enough to cease his efforts to market and produce such merchandise, at least in the near-term.<sup>7</sup>

“White Lives Matter” came into public perception around 2015 as a “racist response to the Black Lives Matter movement” and is commonly invoked by white supremacists, including the Aryan Renaissance Society and the Ku Klux Klan.<sup>8</sup> The phrase is “deemed white supremacist hate speech by the Anti-Defamation League.”<sup>9</sup> While marks containing disparaging or immoral phrases can be federally registered following the landmark Supreme Court cases of *Matal v. Tam*<sup>10</sup> and *Iancu v. Brunetti*,<sup>11</sup> the registered phrase or mark must still have legal basis as a trademark.<sup>12</sup>

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<sup>4</sup> Christie D’Zurilla, *Kanye West’s Tee Is a Fashion Don’t. Someone Else Owns ‘White Lives Matter’ Trademark*, L.A. TIMES (Nov. 3, 2022, 1:43 PM), <https://www.latimes.com/entertainment-arts/story/2022-11-03/ye-kanye-west-white-lives-matter-trademark-civic-cipher>.

<sup>5</sup> See U.S. Trademark Application Serial No. 97/617,868 (filed Oct. 3, 2022). On October 11, 2023, the USPTO issued a non-final Office Action refusing registration of the mark. *Id.* An extension of time to respond was requested on January 8, 2024; as of February 2024, no response has been filed with the USPTO.

<sup>6</sup> U.S. Trademark Application Serial No. 97/617,868 (filed Oct. 3, 2022); see D’Zurilla, *supra* note 4.

<sup>7</sup> Justin Gamble & Nicole Chavez, *Kanye West Can’t Sell ‘White Lives Matter’ Shirts Because Two Black Men Own the Trademark*, CNN, <https://www.cnn.com/2022/11/02/us/white-lives-matter-trademark-reaj/index.html> (Nov. 4, 2022, 5:24 AM); see Will Richards, *Owners of White Lives Matter Trademark Offer to Sell to Kanye West for \$1 Billion*, NME (Nov. 7, 2022), <https://www.nme.com/news/music/owners-of-white-lives-matter-trademark-offer-to-sell-to-kanye-west-for-1billion-3343946>.

<sup>8</sup> *Hate Symbol: White Lives Matter*, ANTI-DEFAMATION LEAGUE: HATE ON DISPLAY, <https://www.adl.org/resources/hate-symbol/white-lives-matter> (last visited Feb. 24, 2024).

<sup>9</sup> D’Zurilla, *supra* note 4; *Hate Symbol: White Lives Matter*, *supra* note 8.

<sup>10</sup> See *Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>11</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

<sup>12</sup> See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:8 (5th ed. 2023), Westlaw (“Under the legal system in the United States, it is use of a mark in the marketplace that creates a trademark which then is capable of federal registration under the

However, the legal basis of the WHITE LIVES MATTER mark and its use in commerce is suspicious. Trademarks are recognized, and federal registration is allowed, for “any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods.”<sup>13</sup> In the case of the WHITE LIVES MATTER mark, the original owner filed for federal registration on the exact day that Ye wore a “shirt with an image of Pope John Paul II on the front and the words ‘White Lives Matter’ written on the back,”<sup>14</sup> presumably to ensure that Ye would not be able to profit from the language.<sup>15</sup> Additionally, when asked about the mark’s use in commerce, a requirement of any trademark, Ja and Ward responded only that, “it is possible to engage in commerce and fail at it.”<sup>16</sup> Although the basis of the WHITE LIVES MATTER mark may be shaky, the mere assertion that Ja and Ward owned the trademark, and that an application had been filed to register the mark, was enough to impede Ye’s efforts to sell merchandise containing the phrase.

This Comment contends that while trademark ownership may be invoked to prevent proliferation of hate speech, stories like that of the WHITE LIVES MATTER mark highlight serious inconsistencies in United States Patent and Trademark Office (USPTO) practices that require reform. Such reform is particularly necessary after the Supreme Court’s decisions that the Lanham Act’s former prohibitions on “disparaging” trademarks<sup>17</sup> and “immoral or scandalous” trademarks<sup>18</sup> were unconstitutional. As discussed *infra*, USPTO examiners approve certain hateful marks for registration while denying others,<sup>19</sup> creating a guessing game for mark owners that increases attempted registration of hateful phrases, either for prevention of the mark’s use as hate speech or for invocation of such hate speech. Although federal

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Lanham Act. “Before there can be registration, there must be a trademark.” (quoting Application of Bose Corp., 546 F.2d 893, 896 (C.C.P.A. 1976)).

<sup>13</sup> 15 U.S.C. § 1127.

<sup>14</sup> Gamble & Chavez, *supra* note 7.

<sup>15</sup> D’Zurilla, *supra* note 4 (According to Ramses Ja, “This person who first procured it didn’t really love owning it, because the purpose was not necessarily to get rich off of it; the purpose was to make sure that other people didn’t get rich off of that pain.”).

<sup>16</sup> The Emancipator, *Interview with Ramses Ja and Quinton Ward—White Lives Matter Trademark*, YOUTUBE (Dec. 22, 2022), [https://youtu.be/-gUv\\_Ye94C0?si=I3AIhFveeZzjaR3l](https://youtu.be/-gUv_Ye94C0?si=I3AIhFveeZzjaR3l).

<sup>17</sup> See *Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>18</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

<sup>19</sup> See, e.g., Stephanie L. Mahin & Victoria Smith Ekstrand, *Old Law, New Tech, and Citizen-Created Hashtags: #BlackLivesMatter and the Case for Provisional Hashtag Marks*, 98 JOURNALISM & MASS COMM’N Q. 13, 23–26 (2021) (discussing that some trademarks, like “Trans Lives Matter,” have been federally registered while others, like “Black Lives Matter,” have been consistently denied federal registration).

registration is desirable for trademark owners, the inconsistencies in trademark registration show that the USPTO has strayed from trademark's core goals—protecting consumers from deception and protecting the rights of mark holders.<sup>20</sup> Therefore, the USPTO has an obligation to review its federal trademark registration practices to ensure that it is not, in effect, increasing hate speech through inconsistent decision-making.

Part II emphasizes the effect of the Supreme Court decisions *Tam* and *Brunetti*, which struck down the portions of the Lanham Act primarily responsible for preventing the use of hate speech in trademarks and allowed for federal registration of disparaging, immoral, or scandalous marks. Some individuals sought to address the implications of these decisions by applying for registration of hateful marks, which the USPTO inconsistently grants. Part II argues that in the wake of these decisions and subsequent applications for marks containing hate speech, there is an urgent need for the USPTO to evaluate and change its policies to avoid inconsistent results.

Part III addresses examples of the USPTO's subjective examination approach that approves some marks containing hate speech but rejects others, despite the remarkable similarity between such marks. These inconsistencies not only increase hate speech, but they put the goals of trademark law in conflict, with USPTO examiners deciding between consumer protection and property rights for mark holders. Additionally, Part III argues that the Lanham Act's definition of "use in commerce," an essential element of a trademark, has not adapted to the modern environment and therefore fails to recognize marks that are used in ways that are incongruous with 1940s methods, causing further disparities for minority communities.

Finally, Part IV evaluates solutions to these inconsistencies in the federal trademark registration process by drawing on the work of several intersectional scholars to apply critical race theory to the trademark context. This Part encourages the broader intellectual property community to adopt a Critical Race Theory IP (CRT-IP) policy that would seek to address historical inequalities in trademark law through recognition of personhood, and address inconsistencies that disproportionately affect minority communities. This Part also evaluates proposed amendments to the Lanham Act which, together with CRT-IP policies, may work to address many of the inconsistencies currently present in the federal trademark registration process.

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<sup>20</sup> MCCARTHY, *supra* note 12, § 2:2.

## II. EFFECT OF *TAM* AND *BRUNETTI* ON FEDERAL TRADEMARK REGISTRATION

### A. *Background*

In 1946, the Lanham Act, in addition to providing a framework for trademark rights, created a system for federal registration of trademarks conducted by the USPTO.<sup>21</sup> The Lanham Act included prohibitions on federal registration of disparaging, scandalous, or immoral trademarks, but did not specifically address marks containing hate speech.<sup>22</sup> As some scholars make evident, the Lanham Act was insufficient in addressing these marks because it contained no broad prohibition on the use and recognition of unregistered disparaging, scandalous, or immoral trademarks.<sup>23</sup> Rather, marks containing hate speech were merely precluded from federal registration under § 2(a) of the Lanham Act.<sup>24</sup>

However, § 2(a) of the Lanham Act faced routine criticism by First Amendment advocates<sup>25</sup> and eventually most of its protections were struck down. In 2017, the Supreme Court decided the case of *Matal v. Tam*, in which Simon Tam brought a First Amendment claim addressing the prohibition on “disparaging marks” in the Lanham Act.<sup>26</sup> Tam’s claim was on behalf of his Asian-American dance-rock band named “The Slants.”<sup>27</sup> The USPTO had denied the band’s application for federal registration of the mark THE SLANTS based on § 2(a)’s “disparaging” prong.<sup>28</sup>

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<sup>21</sup> The Lanham Act, ch. 540, 60 Stat. 427 (codified as amended in scattered sections of 15 U.S.C.).

<sup>22</sup> 15 U.S.C. § 1052(a).

<sup>23</sup> See K.J. Greene, *Trademark Law and Racial Subordination: From Marketing of Stereotypes to Norms of Authorship*, 58 SYRACUSE L. REV. 431, 437 (2008).

<sup>24</sup> See *id.* (arguing that the Lanham Act “in no way resolves the issue of racially derogatory trademarks; it merely prohibits federal registration, not *use* of a racially derogatory trademark”); see also Vicki Huang, *Trademarks, Race and Slur-Appropriation: An Interdisciplinary and Empirical Study*, 2021 U. ILL. L. REV. 1605, 1607–09 (2021) (explaining the original denial of Simon Tam’s application for “The Slants” on a § 2(a) “disparaging” basis, leading to the Supreme Court’s evaluation of the case in *Matal v. Tam*).

<sup>25</sup> See Michael Stephenson, *The Lanham Act’s Immoral or Scandalous Provision: Down, but Not Out*, 111 TRADEMARK REP. 877, 879 (2021) (“For decades, critics have placed the immoral or scandalous provision under a microscope, arguing that it is unconstitutional under the Free Speech Clause of the First Amendment . . .”).

<sup>26</sup> *Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>27</sup> *Id.* at 1751.

<sup>28</sup> *Id.* at 1751, 1753–54.

However, the Supreme Court held that the Lanham Act's non-disparagement requirement violated the First Amendment's free speech protections and struck it down as facially unconstitutional.<sup>29</sup>

In 2019, only a few years after *Tam*, the Supreme Court decided *Iancu v. Brunetti*, which addressed the "immoral or scandalous" language of § 2(a) of the Lanham Act.<sup>30</sup> Erik Brunetti, "an artist and entrepreneur who founded a clothing line that uses the trademark FUCT," brought a claim after the USPTO denied his application for federal registration under the "immoral or scandalous" prong of § 2(a).<sup>31</sup> Similar to *Tam*, the Supreme Court decided that the "immoral or scandalous" language was unconstitutional under the First Amendment of the Constitution,<sup>32</sup> and struck it from the Lanham Act.

Through *Tam* and *Brunetti*, the Supreme Court stripped the only provisions of the Lanham Act that even impliedly addressed trademarks containing hate speech. Although *Brunetti* explicitly left open the possibility of legislative amendment to the Lanham Act to address this gap,<sup>33</sup> there has been no change to date.<sup>34</sup> In other words, hate speech is on the rise in America, and the USPTO currently has no way or authority to address such a significant issue within the trademark context. Therefore, there is a real danger that hate speech will increasingly infiltrate the American consumer experience, particularly as marches, speeches, posters, and slogans proliferate in the physical and digital world.<sup>35</sup>

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<sup>29</sup> *Id.* at 1751 ("We now hold that this provision violates the Free Speech Clause of the First Amendment. It offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.").

<sup>30</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

<sup>31</sup> *Id.* at 2297.

<sup>32</sup> *Id.* ("We hold that this provision infringes the First Amendment for the same reason [as *Tam*]: It too disfavors certain ideas.").

<sup>33</sup> *Id.* at 2303 (Alito, J., concurring) ("Our decision does not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.").

<sup>34</sup> Of note, Congress passed the Trademark Modernization Act in 2020, which went into effect on December 18, 2021, but this Act did not address any amendment or reformation to the "immoral or scandalous" or disparagement clauses of the Lanham Act § 2(a). *See* Trademark Modernization Act of 2020, Pub. L. No. 116-260, §§ 221–28, 134 Stat 2200 (codified in scattered sections of 15 U.S.C.); Changes to Implement Provisions of the Trademark Modernization Act of 2020, 37 C.F.R. pts. 3, 7 (2021).

<sup>35</sup> *See, e.g.*, Katherine K. Carey, Comment, *Preventing Tam's "Proudest Boast" from Protecting the Proud Boys: A Response to Free Speech Absolutism in Trademark Law*, 71 EMORY L.J. 609, 611 (2022) ("Less than two months [after the Supreme Court decided *Tam*], on August 11, 2017, a horde of white supremacists marched through the streets of Charlottesville, Virginia, bearing 'tiki torches, swastikas, and semi-automatic rifles and chanting slogans like "White lives matter" and "Jews will not replace us!"' in the Unite the Right rally." (quoting *What Charlottesville Changed*, POLITICO MAG. (Aug. 12, 2018), <https://www.politico.com/magazine/story/2018/08/12/>

*B. Effect on Modern Federal Registration*

In the post-*Tam* and post-*Brunetti* world, many scholars predicted an immediate uptick in registrations of trademarks containing hate speech.<sup>36</sup> Indeed, on the day of the *Tam* decision, eyebrows were raised as individuals applied for trademark registration on several racially-offensive marks.<sup>37</sup> However, not all individuals seeking trademark registration intended to use these trademarks to promote hate speech.<sup>38</sup> Steve Maynard, a former patent agent at the USPTO, made headlines with his attempts to register marks in N\*\*\*A<sup>39</sup> and the swastika symbol,<sup>40</sup> both of which he sought, somewhat quixotically, to prevent the widespread dissemination of these marks.<sup>41</sup>

Interestingly, Maynard filed both applications before the *Brunetti* decision. However, since the federal trademark registration process can drag on for years, Maynard was able to cite the decision in his later responses to the USPTO's Office Action to argue that its refusal to grant a design mark for the swastika was "unconstitutional viewpoint discrimination" in the wake of both *Tam* and *Brunetti*.<sup>42</sup> Additionally, Maynard overtly hinted to the USPTO that he intended to use the mark

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charlottesville-anniversary-supremacists-protests-dc-virginia-219353)).

<sup>36</sup> Huang, *supra* note 24, at 1609 ("[T]here was world-wide interest in the outcomes of *Tam* and *Brunetti* and concern that the PTO would be flooded with applications for racist trademarks.").

<sup>37</sup> *E.g.*, Ailsa Chang, *After Supreme Court Decision, People Race to Trademark Racially Offensive Words*, NPR (July 21, 2017, 4:25 PM), <https://www.npr.org/2017/07/21/538608404/after-supreme-court-decision-people-race-to-trademark-racially-offensive-words>; Carey, *supra* note 35, at 640 ("Since *Tam*, applications for federal registration of marks containing racial epithets have been filed with and approved by the USPTO. Some of these applications were filed on June 19, 2017—the very day the *Tam* decision was announced." (footnotes omitted)).

<sup>38</sup> *See, e.g.*, Erica Snow, *Meet the Man Who Wants to Trademark the Swastika—So Bigots Can't Use It*, FORWARD (July 19, 2017), <https://forward.com/news/377428/meet-the-man-who-wants-to-trademark-the-swastika-so-bigots-cant-use-it>.

<sup>39</sup> Steve Maynard, through his company Snowflake Enterprises, LLC, attempted to register the mark NIGGA for athletic apparel and other clothing. U.S. Trademark Application Serial No. 87/496,454 (filed June 19, 2017). To avoid unnecessary use of this word, I will refer it throughout as "N\*\*\*a," or "N\*\*\*A" where it is used in reference to a trademark.

<sup>40</sup> U.S. Trademark Application Serial No. 87/503,998 (filed June 24, 2017). Snowflake Enterprises was issued "failure to function" refusals from the USPTO on September 19, 2019 and May 15, 2020. The company responded to both non-final actions and the information is currently under review by an examining attorney.

<sup>41</sup> Snow, *supra* note 38; *cf.* Carey, *supra* note 35 at 640 ("Ironically, under this course of action, applicants have to actually use the marks in commerce to some degree to obtain and maintain their registration.").

<sup>42</sup> *See* Response to Office Action Dated September 19, 2019, at 2 (Feb. 7, 2020), U.S. Trademark Application Serial No. 87/503,998 (filed June 24, 2017).

in interstate commerce to prevent hate groups from profiting off such a mark.<sup>43</sup> To news outlets, Maynard was less subtle, claiming that he intended to prevent use of the swastika symbol by placing it on merchandise and “charg[ing] a high rate” to consumers.<sup>44</sup> While Maynard attached screenshots to his Office Action responses indicating the mark’s use on flags for sale through a website called “N\*\*\*a Brand Goods,”<sup>45</sup> the website does not appear to be active. Even if Maynard can obtain federal registration of the swastika mark, it will be difficult for Maynard to pursue any would-be infringers of his trademark because consumers likely do not associate the historically reviled mark with his brand.<sup>46</sup>

Although the idea of holding and federally registering trademarks for their value apart from standard business use by so-called “trademark trolls”<sup>47</sup> is not novel,<sup>48</sup> trademark registration after *Tam* and *Brunetti* can have more serious consequences since the USPTO now has no basis upon which to deny federal registration of hate speech. Although some individuals like Steve Maynard, Ramses Ja, and Quinton Ward attempt to register otherwise harmful trademarks to *prevent* their use as hate speech, others have more nefarious goals. Therefore, the USPTO must analyze its trademark review and approval process to ensure consistency in the way it approaches registration of hate speech.

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<sup>43</sup> *Id.* at 13 (“For example, if Snowflake Enterprises desires that ‘hate’ groups selling items in interstate commerce using the subject mark be prevented from doing so, a federal trademark registration allows Snowflake Enterprises to ask a court to stop such use nationally, requiring a ‘hate’ philosophy not be associated with Snowflake Enterprises or its business.”).

<sup>44</sup> Snow, *supra* note 38.

<sup>45</sup> Response to Office Action Dated September 19, 2019, Attached Exhibits, *supra* note 42.

<sup>46</sup> Oliver Herzfeld & Tal Benschar, *Could You Register the Swastika as a Trademark?*, FORBES (Aug. 28, 2017, 9:07 AM), <https://www.forbes.com/sites/oliverherzfeld/2017/08/28/could-you-register-the-swastika-as-a-trademark/?sh=4c7c6c8a157c>.

<sup>47</sup> The term “trademark troll”—a play on non-practicing entities commonly referred to as “patent trolls”—refers to individuals who retain trademarks without an intention to use the mark. See Delfina Homen, *Don’t Let Your Core Brands Fall Victim to Trademark Trolls*, MILLER NASH (Aug. 4, 2022), <https://www.millernash.com/industry-news/dont-let-your-core-brands-fall-victim-to-trademark-trolls>.

<sup>48</sup> For example, millionaire Mike Lin has made headlines by registering several marks that bear a striking resemblance to strong brand names (including Disney and Pokémon) and claims to have received oppositions to registration of his marks from “parties including Beyoncé Knowles, Kobe Bryant and Disney.” Tim Lince, *‘I’m the Banksy of Trademarks’ – Millionaire Applicant of NASTY WOMAN Regards Cease-and-Desist from Beyoncé as ‘Great Marketing,’* WORLD TRADEMARK REV. (Nov. 3, 2016), <https://www.worldtrademarkreview.com/article/im-the-banksy-of-trademarks-millionaire-applicant-of-nasty-woman-regards-cease-and-desist-beyonce-great-marketing>.

## III. USPTO INCONSISTENCY &amp; FAILURE OF TRADEMARK'S GOALS

As a leading trademark scholar acknowledges, modern trademark law has two goals: “to protect consumers from deception and confusion over trademarks as well as to protect the plaintiff’s infringed trademark as property.”<sup>49</sup> While these are often seen as parallel objectives, “in some areas of modern expansion in trademark law, there will be a dissonance or conflict between the two goals.”<sup>50</sup> As discussed *infra*, federal trademark registration poses one such conflict, with USPTO examining attorneys often sacrificing one goal for another.

Although the owner of a trademark has certain common law rights under state law<sup>51</sup> as well as federal law<sup>52</sup> without registering their mark, federal registration confers significant benefits, such as a presumption of mark’s validity, nationwide notice of the mark owner’s rights, and an option for the mark to obtain incontestability status.<sup>53</sup> Federal registration can have a significant effect on a mark’s value and enforceability options available to the owner, and is so desirable that some owners even seek registration for marks that are limited to short-term use.<sup>54</sup>

Although discussion of trademark law is often centered in economic theory,<sup>55</sup> some scholars argue that to better serve trademark’s goals of reducing consumer confusion while protecting owners’ property rights, trademarks should be instead

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<sup>49</sup> MCCARTHY, *supra* note 12, § 2:2.

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

<sup>51</sup> *Id.* § 19:8.

<sup>52</sup> *See* 15 U.S.C. § 1125.

<sup>53</sup> § 1115(a), (b); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297–98 (2019) (“[R]egistration gives trademark owners valuable benefits. For example, registration constitutes ‘prima facie evidence’ of the mark’s validity. And registration serves as ‘constructive notice of the registrant’s claim of ownership,’ which forecloses some defenses in infringement actions.” (citations omitted)).

<sup>54</sup> Consider, for example, the Washington D.C. football team formerly named the “Redskins.” On July 13, 2020, owner Daniel Snyder decided to change the controversial team’s name and adopted “Washington Football Team” in the interim while the deciding on a permanent name. Despite the temporary nature of the change, the team sought to register a mark for WASHINGTON FOOTBALL TEAM. *E.g.*, Greg Patuto, *Washington Football Team Faces Problem with Trademark Request After Patent Ruling*, SPORTS ILLUSTRATED: COMMANDER COUNTRY (June 19, 2021, 2:39 PM), <https://www.si.com/nfl/commanders/news/washington-football-team-problem-trademark-request-nfl>. Federal registration was granted on May 23, 2023, and is still active despite that the Washington team has since been renamed to the “Commanders.” WASHINGTON FOOTBALL TEAM, Registration No. 7,062,526.

<sup>55</sup> *See* Mark Bartholomew, *Trademark Morality*, 55 WM & MARY L. REV. 85, 88 (2013) (“Current thinking about trademark law is dominated by economic analysis, which views the law as a system of rules designed to promote informational efficiencies.” (quoting Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 621 (2004))); *see also* MCCARTHY, *supra* note 12, § 2:3 (“Microeconomic theory teaches that trademarks perform at least two important market functions: (1) they encourage the production of quality products; and (2) they reduce the customer’s costs of shopping and marking purchasing decisions.”).

evaluated for their expressive qualities.<sup>56</sup> Other scholars posit that trademark law already confuses its stated goals because of the inherent role of moral judgments in assessing recognition of trademarks, particularly in infringement litigation.<sup>57</sup>

Nevertheless, during the trademark registration process, USPTO examining attorneys often must choose between addressing consumer confusion or protecting property rights. The USPTO has broad discretion to determine whether a portion of a mark needs to be disclaimed, whether a term is generic or descriptive, and ultimately, whether a registration should be granted.<sup>58</sup> These determinations can be quite subjective and lead to inconsistency in the process, which denies some hateful marks while approving others, creating uncertainties for mark owners. Therefore, to simultaneously enforce trademark's goals of consumer protection and protection of property rights, the USPTO must evaluate and reform its federal registration process.

#### A. *Inconsistencies Pre-Tam and Brunetti*

Scholars have noted the USPTO's inconsistent approach to granting or denying federal registration of trademarks long before the Supreme Court's *Tam* decision. For example, the USPTO granted federal registration for the mark REDSKINS for the Washington, D.C. football team—now called the “Commanders”—based on “insufficient evidence to demonstrate that the term was disparaging to Native Americans.”<sup>59</sup> However, the same body found, a few years later, that the

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<sup>56</sup> Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601, 1605 (2010) (“The law governing trademarks presumes that a mark is a type of economic property—it has a fixed presumption of meaning as a brand, and as an identity, in the marketplace of goods. However, a variety of nonowners who are affected by a mark posit just the opposite view—that trademarks are far more expressive than economic in nature, and are thus inherently unstable because they can mean so many different things within the marketplace of ideas.”).

<sup>57</sup> See, e.g., Bartholomew, *supra* note 55, at 118 (“The defendant’s intent is considered relevant to the question of consumer confusion, even though it arguably has little bearing on how a consumer perceives the defendant’s use of the plaintiff’s mark.”).

<sup>58</sup> *Examination of Your Application*, USPTO, <https://www.uspto.gov/trademarks/basics/examination-application> (June 13, 2022, 6:08 PM); see Mahin & Ekstrand, *supra* note 19 (discussing attorney examiners’ comments and processes in evaluating applications for marks such as BLACK LIVES MATTER, TRANS LIVES MATTER, and CHRISTIAN LIVES MATTER).

<sup>59</sup> Katyal, *supra* note 56, at 1603. See generally *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003) (reviewing the Trademark Trial and Appeal Board’s decision to cancel trademark registrations involving the Washington Redskins and reversing the decision due to lack of support for a finding of disparagement).

term “dyke” was “vulgar, offensive, and scandalous” and rejected a trademark application for DYKES ON BIKES.<sup>60</sup> While some of these inconsistencies are likely inevitable considering the USPTO’s trademark office employs over six hundred examining attorneys,<sup>61</sup> such range in decision-making can be alarming and have serious consequences, both to consumers and to holders of these intellectual property rights.

The following Sections will describe several examples of inconsistencies in the USPTO’s approach to trademark applications. First, Section III.A.1 will address the USPTO’s inconsistent approach for marks that contain the same language, resulting in the USPTO granting registration for the mark N.W.A., but denying registration to marks like N\*\*\*A. Then, Section III.A.2 will address the USPTO’s inconsistent approach applying a “failure to function” analysis, resulting in the USPTO granting registration for some “N-word” marks while denying other applications on a “failure to function” basis.

### 1. “N-Word” Marks

Concerningly, some inconsistencies in federal trademark registration appear rooted in the systemic racism that undercuts American society. For example, Damon Wayans, a Black American actor, twice attempted to register the mark N\*\*\*A, first for clothing,<sup>62</sup> and then more broadly for “clothing, books, music, and general merchandise,”<sup>63</sup> but the USPTO denied both registrations under the Lanham Act’s § 2(a) provisions.<sup>64</sup> Although the media reported that Wayans had the option to appeal the registration refusal,<sup>65</sup> the USPTO records do not indicate that he ever filed a response to the Office Actions.<sup>66</sup>

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<sup>60</sup> Kaytal, *supra* note 56, at 1604 (“[B]oth cases raise the potential conflict between the fluidity of language and the seemingly stabilizing force of property rights, demonstrating that intellectual property’s incomplete framework offers us little to address the complexities between culture, property, and speech.”).

<sup>61</sup> *Become a Trademark Examining Attorney*, USPTO, <https://www.uspto.gov/jobs/become-trademark-examining-attorney> (Sept. 7, 2023, 11:43 AM).

<sup>62</sup> U.S. Trademark Application Serial No. 76/623,949 (filed Dec. 10, 2004).

<sup>63</sup> U.S. Trademark Application Serial No. 76/639,548 (filed May 25, 2005).

<sup>64</sup> Serial No. 76/623,949 was rejected only as “scandalous,” while Serial No. 76/639,548 was rejected as “scandalous,” “disparaging,” and as having a likelihood of confusion with a prior pending application. Office Action (July 24, 2005), U.S. Trademark Application Serial No. 76/623949 (filed Dec. 10, 2004); Office Action (Dec. 22, 2005), U.S. Trademark Application Serial No. 76/639548 (filed May 25, 2005); *see also Actor Tries to Trademark ‘N’ Word*, WIRED (Feb. 23, 2006, 12:00 PM), <https://www.wired.com/2006/02/actor-tries-to-trademark-n-word>.

<sup>65</sup> *Actor Tries to Trademark ‘N’ Word*, *supra* note 64.

<sup>66</sup> *See* U.S. Trademark Application Serial No. 76/623,949 (filed Dec. 10, 2004); U.S. Trademark Application Serial No. 76/639,548 (filed May 25, 2005).

However, a few years prior to Wayans's attempt to register the mark N\*\*\*A, the rap group N.W.A., whose name represents an acronym of N\*\*\*as With Attitude,<sup>67</sup> was able to obtain federal registration on a mark of their name.<sup>68</sup> N.W.A. became notorious in the 1980s, particularly after their release of "the album *Straight Outta Compton*, which resulted in an enormous backlash from law enforcement – specifically because of the track 'Fuck Tha Police.'"<sup>69</sup> In the wake of this notoriety, it is difficult to surmise that USPTO examiners had no knowledge of the language N.W.A. was purporting to register through this mark; yet, the USPTO nevertheless granted federal registration. Although the rap group's name is undoubtedly more subtle than Wayans's mark, it is difficult to discern how one mark is scandalous or disparaging and the other is acceptable, illustrating the subjectivity of the federal registration process.

## 2. "Failure to Function" Analysis

Additionally, before the *Brunetti* decision, the USPTO inconsistently applied certain rationale for registration of federal trademarks, including denials based on a mark's "failure to function." The USPTO may find that a mark has failed to function when "evidence shows it has not been used as a trademark," such as "matter that is commonly used in everyday speech by many different sources and merely conveys an informational social, political, religious, or similar kind of message."<sup>70</sup> As discussed in the context of Steve Maynard's registration attempts,<sup>71</sup> the USPTO often denied applications for registration of N\*\*\*A or similar derivations on a "failure to function" basis.<sup>72</sup> However, the USPTO has not denied every instance of an "N" word mark on a "failure to function" basis, revealing inconsistencies in this determination process.<sup>73</sup>

Although the inconsistencies in registration of race-specific trademarks are alarming in the pre-*Brunetti* era, one scholar more optimistically noted that the USPTO's denial of these race-based phrases as trademarks illustrated a semblance

<sup>67</sup> See Eric Spitznagel, *Ice Cube, Formerly of N.W.A., Thinks the N-Word is "Corny"*, VANITY FAIR (Sept. 24, 2010), <https://www.vanityfair.com/culture/2010/09/ice-cube-formerly-of-nwa-thinks-the-n-word-is-corny>.

<sup>68</sup> N.W.A., Registration No. 2,522,163.

<sup>69</sup> *Origins*, CLARK UNIV.: HIP HOP & POLITICS, <https://wordpress.clarku.edu/musc210-hhp/introduction/a-look-back-in-hip-hop> [http://web.archive.org/web/20230331083546/https://wordpress.clarku.edu/musc210-hhp/introduction/a-look-back-in-hip-hop] (last visited Apr. 8, 2024).

<sup>70</sup> MCCARTHY, *supra* note 12, § 19:4.50.

<sup>71</sup> See *supra* notes 42–46 and accompanying text.

<sup>72</sup> Huang, *supra* note 24, at 1643.

<sup>73</sup> See *id.* at 1644 ("These refusals are conspicuous because there were two contemporaneous applications for the 'n-word,' filed by Curtis Bordenave, which did not receive failure to function refusals.").

of progress as a society.<sup>74</sup> Previously, “the ‘N’ word . . . was commonly used in our early history,” and phrases such as “n[\*\*\*\*]rhair tobacco” achieved trademark registration,<sup>75</sup> often to the detriment of the groups affected by such marks. However, while the USPTO’s refusal to register N\*\*\*A from Wayans and others may have been a noble attempt to limit racially-based hate speech, its inconsistent approach denied slur reclamation by members of the affected group<sup>76</sup> and raised the potential for future owners to use these marks as hate speech.

### B. *Inconsistencies Post-Tam and Brunetti*

One might assume that the USPTO would be more consistent in its registration determinations with the elimination of the “disparaging” and “immoral or scandalous” trademark prohibitions post-*Tam* and *Brunetti*; however, recent studies show that inconsistencies in federal registration still abound. The following Sections will describe several examples of inconsistencies in the USPTO’s approach to trademark applications in the post-*Tam* and *Brunetti* era. First, Section III.B.1 will address the USPTO’s inconsistent approach for marks that contain the same language, resulting in the USPTO granting registration to a mark like TRANS LIVES MATTER, but denying registration to a mark like BLACK LIVES MATTER. Then, Section III.B.2 will address the USPTO’s inconsistent approach to trademark’s “use in commerce” requirement, specifically addressing the USPTO’s failure to consistently recognize collective social movements.

#### 1. “\_\_\_ Lives Matter” Marks

A study published in 2021 reviewed trademark registrations for many types of “\_\_\_ Lives Matter” marks and hashtags, including ALL LIVES MATTER, BADGE LIVES MATTER, and BLACK LIVES MATTER.<sup>77</sup> It found that the USPTO consistently denied registrations for the marks BLACK LIVES MATTER, as well as ALL LIVES MATTER, BLUE LIVES MATTER, and POLICE LIVES MATTER on the basis that these marks were “considered political and/or informational slogans that do not indicate a sole source.”<sup>78</sup> However, the study also found that the USPTO approved registration for other “Lives Matter” marks such as IRISH LIVES MATTER, SMALL LIVES MATTER, and FAT LIVES MATTER.<sup>79</sup> Considering that these marks are only one word apart, the approval of some marks and the denial of others appears to

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<sup>74</sup> Greene, *supra* note 23, at 437.

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

<sup>76</sup> Huang, *supra* note 24, at 1644 (“In a sense, the PTO are telling African American applicants that they cannot self-appropriate the ‘n-word’ as a trademark because it has already been appropriated into the vernacular by the African American community.”).

<sup>77</sup> Mahin & Smith Ekstrand, *supra* note 19.

<sup>78</sup> *Id.* at 30.

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

further indicate the subjective nature of USPTO decision-making. While this subjective determination may not intentionally disfavor some groups, one may be skeptical when the USPTO denies federal registration to impactful marks like BLACK LIVES MATTER<sup>80</sup> while approving relatively unknown marks like IRISH LIVES MATTER.<sup>81</sup>

However, there is also the WHITE LIVES MATTER trademark which is still pending federal registration, but has already been successfully invoked to prevent proliferation of the phrase.<sup>82</sup> As discussed in Part I, “White Lives Matter,” the same as “Black Lives Matter,” existed as a slogan and rally-cry before its federal trademark registration filing.<sup>83</sup> However, while the USPTO has denied many applications for the BLACK LIVES MATTER mark on a “failure to function” basis,<sup>84</sup> the WHITE LIVES MATTER mark may have a different fate. Admittedly, the WHITE LIVES MATTER owners may have a better chance of a successful registration based on the news coverage surrounding their mark, which may be enough to meet the source-indication requirements of trademark. However, the Black Lives Matter movement was also well-publicized, with many news articles published about marches and activities,<sup>85</sup> so news coverage itself is not a clear indicator that the mark will be granted. Regardless, the USPTO’s registration of trademarks protecting certain groups and not others, whether intentional or not, demonstrates the need for education and reform in the trademark registration process.

## 2. *Use in Commerce*

The 1946 version of the Lanham Act did not contemplate the many new avenues of commerce that would emerge in the modern era. Although the Lanham Act

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<sup>80</sup> *Id.* at 15 (“As a cultural mark that signals a powerful public message (‘stop killing black and brown people’) and a private good—namely a collection of people who identify with changing how the system carries out justice for Black and Brown people in the United States — #Black Lives Matter has high value.”).

<sup>81</sup> *See id.* at 30 (“USPTO approval of these marks represent exactly the kind of ‘colorblind conventions’ and ‘ways that state and culture apparatuses protect the privileges of whiteness at the expense of people of color’ described by critical race and CRT-IP scholars.” (citation omitted)).

<sup>82</sup> *See supra* Part I.

<sup>83</sup> *See supra* note 8 and accompanying text. *Compare* Mahin & Smith Ekstrand, *supra* note 19, at 21 (“The hashtag #BlackLivesMatter was first publicly introduced in the summer of 2013 by community organizer Patrisse Cullors.”) *with id.* at 26 (“Thirteen Black Lives Matter applications were filed between January 2015 and August 2018.”).

<sup>84</sup> Mahin & Smith Ekstrand, *supra* note 19, at 26 (“[T]he applied-for mark BLACK LIVES MATTER merely conveys an informational social, political, religious, or similar kind of message . . . .” (quoting Office Actions in response to eleven different trademark registrations filed between Jan. 2015 and Aug. 2018)).

<sup>85</sup> *See, e.g., News*, BLACK LIVES MATTER, <https://blacklivesmatter.com/news> (last visited Feb. 24, 2024).

was recently amended,<sup>86</sup> the requirement for a trademark to be “use[d] in commerce” has not faced modernization since 1988, when Congress merely added language to allow for “intent-to-use” applications.<sup>87</sup> While the Lanham Act has a broad definition of commerce that includes “all commerce which may lawfully be regulated by Congress,” its definition of “use in commerce” is far more limited.<sup>88</sup> Specifically, the Lanham Act requires the following:

[A] mark shall be deemed to be in use in commerce—

(1) on goods when—

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods make such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce . . . .<sup>89</sup>

Although scholars and courts have recognized a somewhat broader scope of a trademark’s “use in commerce,”<sup>90</sup> the Lanham Act’s limited definition has not changed.<sup>91</sup>

However, modern society has changed dramatically, particularly in the growth of the Internet age, and American consumers are constantly inundated with advertisements, social movements on social media, and even digital currencies and non-fungible tokens. The Lanham Act’s archaic definition of “use in commerce” quite simply does not address many of these concerns, which jeopardizes its goals to reduce consumer confusion and protect property rights.

In a study examining the registration of trademarks based on social movement hashtags, the authors found the conventional “use in commerce” definition to be a roadblock for online social movements.<sup>92</sup> Additionally, the “use in commerce” limitation can often mean that individuals who exploit, rather than create, a name,

<sup>86</sup> See Trademark Modernization Act of 2020, Pub. L. No. 116-260, §§ 221–28, 134 Stat. 2200 (codified in scattered sections of 15 U.S.C.).

<sup>87</sup> See Trademark Law Revision Act of 1988, Pub. L. No. 100–667, § 103, 102 Stat. 3935, 3935–36 (current version at 15 U.S.C. § 1051(b)).

<sup>88</sup> 15 U.S.C. § 1127.

<sup>89</sup> *Id.* (excluding definitions of service marks used in commerce).

<sup>90</sup> See, e.g., Mahin & Smith Ekstrand, *supra* note 19, at 16 (discussing the Third Restatement of Unfair Competition’s expansion of the definition of “associated” displays and recognizing that some courts employ a “case-by-case” analysis to construe the term “use in commerce”).

<sup>91</sup> 15 U.S.C. § 1127.

<sup>92</sup> Mahin & Smith Ekstrand, *supra* note 19, at 21 (“#BlackLivesMatter represents a clear example of a descriptive online movement hashtag where traditional trademark requirements of ‘use in commerce’ appear problematic.”).

phrase, or slogan are entitled to trademark protections simply because they used the phrase in commerce.<sup>93</sup> As the study addresses, “the government’s conception of a ‘source’ relies on traditional notions of commerce, ones that existed long before the kind of community creation we see happening online today.”<sup>94</sup> This limited definition of “use in commerce,” coupled with a narrow view of source-indication, may have made sense in a pre-Internet age but now does not keep up with modern practices of collective action. Additionally, since the USPTO inconsistently denies registration of trademarks containing social, political, and religious messages on a “failure to function” basis, some movements may end up gaining trademark protections while others are left out.

As a solution to the issues raised by an outdated “use in commerce” definition, scholars identify a school of thought that converges critical race theory and intellectual property (referred to as “CRT-IP”).<sup>95</sup> CRT-IP recognizes that “trademark law, with its focus on commerce and neoliberal economies, underestimates trademark’s role in the marketplace of ideas and notions of community generated labels and content.”<sup>96</sup> By recognizing the role of community members in creating and shaping brands, identities, and movements, trademark law would be working towards converging its sometimes dueling goals—protecting the rights of consumers against confusion and misinformation while ensuring property rights to the holders of this intellectual property. As will be discussed *infra*, CRT-IP poses thought-provoking solutions to the USPTO’s inconsistency problems and may ameliorate some of the historical impacts of trademark law on minority groups.

#### IV. SOLUTIONS

Prior to *Tam* and *Brunetti*, the USPTO relied upon the Lanham Act’s prohibitions on “scandalous” and “immoral” or “disparag[ing]” trademarks to regulate the use of racially-charged hate speech as a mark.<sup>97</sup> However, in the wake of these cases, and amidst the many inconsistencies that exist in the trademark registration

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<sup>93</sup> See, e.g., Caleb L. Green, *Patently Unfair: Racial Inequality Through the U.S. Intellectual Property Legal System*, CLARK CNTY. BAR ASS’N, <https://clarkcountybar.org/patently-unfair-racial-inequality-through-the-u-s-intellectual-property-legal-system> (Feb. 2021) (“[A]fter the unfortunate murder of Breonna Taylor, numerous retail companies began to sell clothing and apparel bearing Ms. Taylor’s name, image, and likeness. Further, these companies compounded this misappropriation by filing several trademark applications bearing Ms. Taylor’s name . . .”).

<sup>94</sup> Mahin & Smith Ekstrand, *supra* note 19, at 30.

<sup>95</sup> *Id.* at 19 (“CRT-IP, therefore, ‘refers to the interdisciplinary movements of scholars connected by their focus on the racial and colonial non-neutrality of the laws of copyright, patent, trademark, right of publicity, trade secret, and unfair competition using principles informed by CRT.’” (quoting Anjali Vats & Deidré A. Keller, *Critical Race IP*, CARDOZO ARTS & ENT. L.J. 735, 740 (2018))).

<sup>96</sup> *Id.*

<sup>97</sup> 15 U.S.C. § 1052(a).

process, the USPTO must revisit its processes by educating its examining attorneys on the historical inequities in trademark law and adopting a CRT-IP-informed process for evaluation and consistency in registration of marks.

Additionally, Congress should consider the various proposals for amendments to the Lanham Act, including the addition of an anti-hate speech clause,<sup>98</sup> which, when combined with CRT-IP education, may work to resolve some of these inconsistencies in federal registration.

#### A. *CRT-IP Policies in Trademark*

As one scholar writes, “although trademark law, like copyright, is a ‘race-neutral’ legal regime, it has both impacted and been impacted by the racial dynamics underlying American society.”<sup>99</sup> Scholars also recognize that “trademarked imagery has been central to the promotion of derogatory racial stereotypes.”<sup>100</sup> However, the dueling goals of trademark law, preventing consumer confusion while recognizing property rights, are thwarted by a failure to address the historical approval of racist and racially-insensitive trademarks such as the REDSKINS mark.<sup>101</sup> In failing to address the offensiveness of such marks, trademark law serves only the property interest of the holder while subordinating the interest of consumers. Instead, scholars advocate for an approach to trademark law that would look beyond the “colorblind” mindset currently in place and use a subordination principle whereby “courts would look to see whether the use of the mark fosters subordination in society, based on historical antecedents.”<sup>102</sup> This proposal would be one way to foster a more comprehensive understanding of the nature of a mark and ascertain whether the mark serves an identity reclamation function, like in *Tam*,<sup>103</sup> or rather solely promotes hate.

However, the subordination approach, while well-intentioned, does not appear entirely workable from a federal registration perspective. The USPTO sorts through hundreds of thousands of trademark applications annually,<sup>104</sup> and likely does not

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<sup>98</sup> See Carey, *supra* note 35, at 615.

<sup>99</sup> Greene, *supra* note 23, at 433.

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

<sup>101</sup> *Id.* at 435, 437.

<sup>102</sup> *Id.* at 438 (explaining that such a subordination principle is “drawn from the work of ‘critical race’ scholars” and “would provide a superior approach” to the economic approach currently employed).

<sup>103</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (“[T]he band members believe that by taking that slur [“The Slants”] as the name of their group, they will help to ‘reclaim’ the term and drain its denigrating force.”).

<sup>104</sup> For example, as of the time of this writing, the USPTO had received 176,735 applications for 2023. *Trademark Data Q1 2023 At a Glance*, USPTO, <https://www.uspto.gov/dashboard/>

have the capacity to do the research and historical analysis necessary to determine whether the mark's use has a subordinating purpose. Additionally, this approach does not address many of the subjectivity concerns discussed *infra* and could lead to additional inconsistencies as examiners would presumably be left to their own discretion to determine which history to evaluate and consider.

However, a new and emerging body of legal scholarship, the CRT-IP movement,<sup>105</sup> also offers a lens through which to evaluate potential solutions to federal trademark registration trademark inconsistencies. CRT-IP echoes “[critical race theory]’s core themes, particularly its acknowledgement of intellectual property’s investments in whiteness,”<sup>106</sup> and specifically addresses the following:

[W]hites have historically constructed information regimes in ways which devalue the knowledge and practices of non-whites; whites have historically held the power and authority to determine the legal structures which govern intellectual property rights; whites have historically crafted legal doctrines which favor the protection of Western understandings of creativity; and whites largely continue to manage domestic and international intellectual property rights regimes.<sup>107</sup>

CRT-IP also recognizes that intellectual property rights, while typically viewed through a stark economic framework, could be better evaluated through a lens of personhood.<sup>108</sup> The acknowledgement of personhood would work both for protection of consumers, and historically excluded property rights holders, serving to unite both of trademark’s goals.

In this sense, one could apply CRT-IP in the trademark context to consider whether a mark is evocative of personhood, either individually or collectively, instead of merely indicative of a source of goods. Adoption of the CRT-IP framework would broaden the scope of trademark consideration, while enforcing trademark’s function to signal the source of the goods to consumers and protect the rights of the mark holder. Applying this lens, social movements could hold and register a mark like BLACK LIVES MATTER because the mark signifies the founding group and its use on clothing or other merchandise signals that the Black Lives Matter group is

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trademarks [https://web.archive.org/web/20230213165629/https://www.uspto.gov/dashboard/trademarks] (last visited Apr. 8, 2024).

<sup>105</sup> The concept of CRT-IP appears to be first articulated in a law review article by Anjali Vats and Deidré Keller following the 2017 “Race + IP” conference hosted by Boston College. See generally Anjali Vats & Deidré A. Keller, *Critical Race IP*, 36 CARDOZO ARTS & ENT. L.J. 735 (2018).

<sup>106</sup> *Id.* at 758.

<sup>107</sup> *Id.* at 758–59 (footnotes omitted).

<sup>108</sup> *Id.* at 765 (“A central issue in Critical Race IP scholarship—one which might be called a fundamental tenet of the interdisciplinary movement—is critical analysis of how intellectual property does and should relate to conceptual personhood, particularly for those that were not and are not, explicitly and/or implicitly, considered to be fully human.”).

behind and profiting from this purchase. This application would work to address issues of consumer confusion because the mark would give a clear indication of the associated group. Additionally, this application would better protect the Black Lives Matter founders' property rights in the mark and help to keep others from commercializing and profiting off its brand and message.

Of course, this CRT-IP approach could also be a double-edged sword, allowing hate groups such as the Ku Klux Klan to attempt registration of hate speech under a trademark guise with full intent to use the mark to promote further hate. One way to combat such use would be a limited adoption of the subordination principle proposed by Greene. Although Greene's proposal is not workable in its entirety, it could be invoked in opposition to registration of hateful marks for use by hate groups to address these historical subordination concerns. Additionally, state or federal anti-discrimination laws may function to block such use, but an evaluation of those legal avenues is beyond the scope of this Comment.

CRT-IP also offers more existential solutions to the address the whiteness of intellectual property, such as "understanding, situating, and retelling intellectual property's stories," "defining and negotiating the scope of the public domain," and "remaking intellectual property law to reflect those 'faces at the bottom' and with an eye toward real-world solutions."<sup>109</sup> While these solutions would benefit trademark law more broadly, they would be beyond the scope of the USPTO authority in the realm of federal registration. Fundamentally, the USPTO is an executive administrative agency tasked with granting patents and registering trademarks.<sup>110</sup> Congress delegates authority to the USPTO, which must follow the legislature's approved laws and its own administrative rules.<sup>111</sup> Therefore, solutions such as "remaking intellectual property law" are best left to legislators.

The USPTO employs a large workforce of trademark examining attorneys tasked with ruling on applications for federal trademark registration.<sup>112</sup> Although the USPTO has an extensive manual for its examining attorneys to reference in granting or denying trademark registration,<sup>113</sup> a large amount of discretion exists in rendering these decisions.<sup>114</sup> Therefore, as in any setting where individuals render a subjective opinion, understanding examining attorneys' implicit biases<sup>115</sup> as well as

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<sup>109</sup> *Id.* at 767.

<sup>110</sup> *About Us*, USPTO, <https://www.uspto.gov/about-us> (Nov. 7, 2022, 9:36 AM).

<sup>111</sup> *See id.*

<sup>112</sup> *See supra* note 61 and accompanying text.

<sup>113</sup> TMEP (5th ed. Nov. 2023).

<sup>114</sup> *See id.* § 1202 (explaining the refusal process, which includes some subjective criteria).

<sup>115</sup> The USPTO appears to have offered some internal bias training through workshops, although an official training policy does not appear available online. *See, e.g., Diversity and Inclusion v. Implicit Bias in the Workplace*, USPTO, <https://www.uspto.gov/about-us/uspto-locations/silicon-valley-ca/diversity-inclusion-v-implicit-bias-workplace> (Oct. 9, 2018, 12:24 PM).

providing them with information about the use of trademarks throughout American history to stereotype and subordinate minority groups is imperative.<sup>116</sup> While education and training are likely not enough to address these larger issues in the intellectual property field, this background could lend a necessary consistency to the process.

### B. *Lanham Act Amendments*

Moving beyond the limited reach of the USPTO, other scholars have suggested solutions to the proliferation of hate speech in trademark law through amendment of the Lanham Act. In *Brunetti*, Justice Samuel Alito made clear that despite the Court's ruling, Congress still had the requisite authority to amend the Lanham Act to prohibit federal registration of immoral or scandalous trademarks by constitutional means.<sup>117</sup> Scholars point to Justice Alito's opinion to encourage Congress to pass legislation addressing these constitutionally struck portions of the Lanham Act.<sup>118</sup>

However, even if Congress were to constitutionally prohibit immoral, scandalous, or disparaging trademarks once again, this may not be enough to address the many inconsistencies in the trademark registration process. As discussed *infra*, the federal trademark registration process is highly subjective and likely impacted by many layers of implicit bias, creating inconsistencies in registration both before and after *Tam* and *Brunetti*. Therefore, although the idea of simply re-enacting Lanham's invalidated § 2(a) provisions is appealing, such amendment may not have any effect on the trademark registration process.

A more novel idea comes from another scholar who proposed Lanham Act amendments that would go beyond a return to pre-*Brunetti* policies and instead argued for a ban on "federal registration of marks that would constitute hate speech."<sup>119</sup> This proposal, coupled with a "reappropriation exception . . . for minority groups to engage in reappropriation of hate speech," is compelling but complicated.<sup>120</sup> The proposal assumes that the federal government would adopt a policy

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<sup>116</sup> For further discussion on this topic, see Greene, *supra* note 23.

<sup>117</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2303 (2019) (Alito, J., concurring) ("Our decision does not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.").

<sup>118</sup> See, e.g., Ned Snow, *Immoral Trademarks After Brunetti*, 58 HOUS. L. REV. 401, 404 (2020) (arguing "that Congress should deny protection [to immoral trademarks] and that doing so would not violate the First Amendment").

<sup>119</sup> Carey, *supra* note 35, at 646 (outlining such policy as a "part of a widespread decision on the part of the federal government to exclude hate speech from First Amendment protection").

<sup>120</sup> *Id.*

excluding hate speech from First Amendment protection,<sup>121</sup> but it does not articulate whether this policy would come in the form of Congressional legislation, an executive order, or a decision from the Supreme Court. Since the constitutionality of hate speech has been considered and affirmed by the Supreme Court,<sup>122</sup> one must assume the proposal is relying upon one of the latter two options, both of which may be constitutionally challenged under the same premises.

Putting aside the constitutional challenges, this proposal would likely still exclude “trademark trolls” like Steve Maynard, Ramses Ja, and Quinton Ward from obtaining federal registration in marks containing hate speech unassociated with their identities. For example, Ja and Ward are attempting to register the WHITE LIVES MATTER mark, which would be deemed hate speech and initially denied federal registration under this proposal. However, under the “reappropriation exception,” the burden would shift to the applicant “to introduce evidence that they are making a reappropriation use of the mark.”<sup>123</sup> It would be difficult for Ja and Ward, both Black, to prove that they are making a reappropriation use of the mark by attempting to reclaim it and prevent others from profiting off it. If the USPTO applied a subordination or CRT-IP lens, it might consider the history of the mark as a retaliatory response to Black Americans during the Black Lives Matter movement. However, it remains unclear whether Ja and Ward would ultimately be successful in registering the mark.

While this approach likely would prohibit “trademark trolls” from registering marks containing hate speech unless the applicant is part of the group to which the hate speech is directed, the solution is likely workable when used in combination with recognition of personhood and the broader policies of the CRT-IP movement. If trademark law were to recognize the historically biased underpinnings of its process, inform USPTO examining attorneys about the implications of these historical biases, and include a recognition of personhood as brand, trademark law would be serving consumers’ interests by reducing source confusion. Additionally, by banning hate speech from federal registration altogether, trademarks would be far less likely to be a vehicle for hate speech. Finally, by having a mechanism for slur appropriation by affected groups, trademark law would be protecting the property rights of histor-

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<sup>121</sup> *Id.*

<sup>122</sup> *E.g.*, *Snyder v. Phelps*, 562 U.S. 443, 460–61 (2011) (holding that defendants were not liable in tort for peacefully displaying homophobic hate speech at a soldier’s funeral because their statements were protected by the First Amendment).

<sup>123</sup> *Carey*, *supra* note 35, at 647 (“An applicant could establish a prima facie claim of reappropriation by (1) demonstrating that they are a member of a protected class or a class that has been historically discriminated against and (2) providing evidence that they are using the mark to engage in reappropriation.”).

ically underrepresented groups. Thus, the anti-hate speech proposal, when combined with CRT-IP policies, would work to finally meld the two primary goals of trademark law.

## V. CONCLUSION

Given the broken infrastructure of the Lanham Act after the Supreme Court's decisions in *Tam* and *Brunetti* and the broad protections of First Amendment rights that protect hate speech, it is unsurprising that individuals are seeking alternative methods to protect their trademarks and prohibit the proliferation of harmful marks. However, the story of the WHITE LIVES MATTER mark reveals that the federal trademark registration system is fraught with inconsistencies that leave the door open for abuse and commercialization of hate speech, especially for groups that have historically been excluded from holding any property, including intellectual property.

To address the concerns about hate speech as trademarks raised in this post-*Tam* and *Brunetti* legal world, one must look to solutions that center an intersectional critical race lens and particularly apply CRT-IP policies. Additionally, while amendments to the Lanham Act that simply rewrite pre-*Tam* and *Brunetti* provisions may not have a significant effect on hate speech within trademark, a specific anti-hate speech amendment may prove fruitful. These solutions, when combined, could successfully ensure that trademark law is recognizing property beyond its traditionally white-based approach and resolve the many inconsistencies in the federal trademark registration process. Now more than ever before, it is imperative to prevent any avenue of the law from becoming a safe harbor for derogatory, biased, and harmful hate speech.