

New USPTO trademark exam guide: Compliance with Section 2(a)'s Scandalousness & Disparagement Provisions While Constitutionality Remains in Question

[Posted by ipelton on: March 11th, 2016](#)

The USPTO has requested an extension of time to potentially seek Cert. from the Supreme Court (Application of Michelle K. Lee to Extend the Time to File a Petition for a Writ of Certiorari, March 9, 2016 (Supreme Court No.15A925) regarding the CAFC's decision in *In re Tam* (No. 14-1203, *Federal Circuit*), which held that the Lanham's Act provision in Section 2(a) refusing registration of disparaging marks violated the First Amendment. The case involved the attempt to register the band name *The Slants*.

In addition to possible Supreme Court review of the *In Re Tam* decision, there is a lot of other activity in this area of law lately. The Washington Redskins' registrations were cancelled by the TTAB, but that matter has been appealed to the E.D. of Virginia and now to the 4th Circuit Court of Appeals (*Pro-Football v. Blackhorse* (No. 15-1874, Fourth Circuit). The Redskins have raised constitutional arguments as well.

There is another CAFC case pending, *In Re Brunetti* (No. 15-1109) which involves the scandalousness provision of Section 2(a) of the Lanham Act.

Yesterday, the USPTO has issued a guide to all Examining Attorneys:

- The USPTO will issue "advisory refusals on the grounds that a mark consists of or comprises scandalous, immoral, or disparaging matter under Section 2(a)."
- However, no final refusal's under Section 2(a) will be issued for now, as the Exam Guide directs that "the application will be suspended when the application is in condition for final action on those other requirements or refusals."
- Such suspension shall remain "until at least the last of the following occurs: (1) the period to petition for a writ of certiorari (including any extensions) in *Tam* expires without a petition being filed; (2) a petition for certiorari is denied; or (3) certiorari is granted and the U.S. Supreme Court issues a decision."

Will the USPTO request the Supreme Court review *In Re Tam*? Will the Redskins case eventually make it to the Supreme Court? How will the *Tam* decision affect *In Re Brunetti*, which was argued in December at the Federal Circuit? Stay tuned.....

To download the USPTO's examination guide 01-16 Examination for Compliance with Section 2(a)'s Scandalousness and Disparagement Provisions While Constitutionality Remains in Question,

see: <http://www.uspto.gov/trademark/trademark-updates-and-announcements/recent-postings>