



BTLJ Podcast, Episode 8
Disparaging the Disparagement Clause
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Featuring Chante Westmoreland, Tony Bedel, and Liz Freeman Rosenzweig
Special thanks to the Berkeley Law chapter of the American Constitution Society

An interview with
Simon Tam
Founder of “The Slants”



BTLJ Podcast 10/30/2017: Disparaging the Disparagement Clause: Simon Tam

[Note: This podcast has been automatically transcribed and may contain errors.]

Tony: [00:00:00] Hi folks, I'm Liz Freeman Rosenzweig, you're listening to the Berkeley Technology Law Journal Podcast!

In today's podcast, our hosts Chante and Tony speak with a recent champion of the supreme court: Simon Tam!

Simon Tam was in the Supreme Court because of the name of the rock band he founded. Simon named his band "the Slants" as a way to reclaim a racial slur. The bandmembers, including Simon, are of Asian descent, and wanted to use the name to reframe cultural identities and fight stereotypes. But when the band attempted to get a registered trademark from the federal government, their application was rejected for being offensive. So Simon went to court, and fought it all the way to the Supreme Court, where finally he prevailed. All nine justices supported his argument!

Today, Tony and Chante discuss with Simon his Supreme Court argument and why the old requirement for trademarks to be non-disparaging failed to protect minority groups. As a heads-up for potentially sensitive listeners, they'll be discussing racial epithets.

Tony: [00:01:02] Hi Simon, thanks for joining us today by phone. Could you give us background on how you formed your band into why you thought it was important to use the name the Slants?

Simon: [00:01:11] I formed the band mostly because I thought there was a distinct lack of representation of Asian-Americans in the music industry. I was kind of inspired by that theme, like under-representation that I saw in Hollywood. And when I noticed that I noticed, that basically, Asian-Americans are facing the same kind of thing. That there were so few of us and we weren't getting any kind of starring roles that I wanted that changed.

Simon: [00:01:34] So that's kind of why I started at the slams and decided to call it the Slants because I was referring to my perspective on life as people of color.

Chante: [00:01:45] What happened from there between you starting the band and you wanting to secure a trademark to protect the brand?

Simon: [00:01:51] Well to be clear we actually always had a trademark we lots of the trademark its creation and trademark rights earned through to use they are not granted by the government. So we were never looking for trademark rights. We had we just wanted the registration for extended benefits. Take

Liz: [00:02:10] Hey, Liz again, with some background information in case you're not so familiar with trademarks - what IS a trademark?

A trademark is some kind of recognizable sign that consumers can use to identify the source of a product or service. For example, a trademark might be the logo, or a mark, on a product that you can use to link to a "brand name." When you see a computer with an Apple with a bite taken out of it, you think Apple computers.

Federal registration of the trademark means you get to have the fancy little "R" in a circle next to your mark and more importantly if someone messes with your trademark you get more tools to sue them.

Ok, back to the discussion!

Simon: [00:02:45] In the two years that kind of spanned between the genesis of the band and our initial application we were doing what bands do. At least those with an activist kind of mindset.

Simon: [00:03:00] So, touring. We wrote and released at least three records by the time we filed. We would help raise money for charities. We raised about a million dollars for Asian-American organizations. And anti-racism workshops on behalf of the U.S. government. You know we worked for about 440 or so social justice organizations. So there were these kind of relationships getting established. That's kind of what we did.

Tony: [00:03:23] So what exactly was the trademark office's original argument against granting you the registration?

Simon: [00:03:32] The initial rejection was based on an old bit of law or section made of the law, called section 2-8 of the Lanham Act. And that law states that registrations cannot be granted for marks that are considered scandalous, immoral or disparaging. And not just with anybody considers as disparaging. Focus is only the reference group. Only their perspective matters. And they have to find that a substantial composite of the reference group finds its disparaging. When they when they rejected my application they actually couldn't find a single Asian American that was offended by our name. And why are they by having seven million of us. They instead relied instead on urbandictionary.com and photographs of Miley Cyrus pulling her eyes back—in like a “slant” or “chink-eye” gesture.

Chante: [00:04:21] “Scholarly sources.”

Tony: [00:04:22] Yeah these are things we all study in law school and cite regularly: Urban Dictionary.

Simon: [00:04:26] Yeah. And then they quoted another wiki joke website called asianjokes.com and that for that was all they had.

Simon: [00:04:36] And so when we kind of fought back, we used actual signed legal declarations of executive directors of numerous well-regarded API organizations and we had dictionary experts and an independent national survey conducted by professors with like bulletproof cites under them, like survey technique.

Tony: [00:04:52] Yeah and it was one of the first times that that the Patent and Trademark Office was confronted with that type of evidence. Isn't that right?

Simon: [00:04:59] Yeah. The second time. The only other time was in [Harjo v. Pro Football](#) case – better known as the Washington Redskins case. And in that case they found thirty six point six percent of Native Americans on the name to be highly disparaging. However the trademark office said thirty six point six percent was not considered a substantial composite. In our case our survey showed that 8, possibly, up to 16 percent of Asian-American found it disparaging. We are well under that 30 percent threshold. The problem is never define what is a substantial composite. In the other case it was not considered a substantial composite, but in our case the 8 percent is a composite. They changed the standard as we were kind of fighting here.

Tony: [00:05:45] And historically the Patent and Trademark office had you know issued registrations to things like Heeb media and Dykes on Bikes which might be offensive to a higher

percentage of folks. Did you have an understanding of why those registrations were granted, and in yours, you presented all this evidence and they kind of ignored it.

Simon: [00:06:06] They're subjective in nature and the thing is, like for example, with Heeb Media, they were approved for the magazine but when they applied for registration for T-shirts and events they were rejected.

Simon: [00:06:16] In the case of dykes on bikes they actually were initially rejected and they appealed for almost a decade.

Simon: [00:06:22] In fact they had to write a letter directly to the commissioner of the former director of the USPTO.

Simon: [00:06:29] And it was only then that they got the objection withdrawn.

Tony: [00:06:39] But neither of those organizations had the actual hard data that you presented. They didn't have surveys.

Simon: [00:06:40] They didn't have survey's that's vorrect. But it shows that it is the whim of the examining attorney and whoever their supervisor is. If they say well I've got a gut feeling this is not good or I personally experienced this once, but then they make that decision on behalf of the country, essentially, without any data.

Simon: [00:07:02] When you ask them, they say well we don't have the resources to conduct a survey or to do any kind of extensive analysis.

Simon: [00:07:08] So therefore they have to rely on these kind of common sources like you know googling first thing that popped up.

Chante: [00:07:17] And you mentioned on behalf of the country it's even more paternalistically on behalf of the group that they purport that they're trying to protect that they're saying that these things are offense.

Simon: [00:07:25] Yeah I mean it's obvious they enjoy a certain sense of privilege and they in their mind they are here in theory doing marginalized groups a favor saying oh well we understand your needs and we want to protect you. But the reality is far from it.

I mean for example, after we presented survey evidence or evidence at all that other stuff that they've never had was put to the table before, the brought us a new deadline that it happened to coincide with the anniversary of executive order 9066, which is the date that the US government thought it'd be a great idea to round up all people of Japanese descent that are American and put them in concentration camps.

Simon: [00:08:08] And It's like they don't know that date, but I certainly do.

Chante: [00:08:13] Right, such dissonance. Okay, so then after you you know tried to present all this evidence you still got another bad decision. How did you and your lawyer decide to strategize to sort of pivot and frame this in another way?

Simon: [00:08:25] We actually have switched attorneys from my attorney who had been with him for the first two years left private practice. And he basically said as long as you say are not disparaging to yourself you're not going to win because nobody has ever won on appeal to a

rejection never won. And so we've got an attorney who switched tactics and applied for what's called an ethnic-neutral application. In other words, there was nothing about it that suggested we're of Asian descent. We thought slant means many different things, perhaps, and perhaps we'll get a different attorney doesn't see it as a potential slur but we got the exact same examining attorney who copied and pasted the previous response to the current application.

Simon: [00:09:08] And so for the next two years the appeal on the procedural and evidentiary issues. That the evidence was actually cherry picked and two that he actually violated the procedures manual by in fact not conducting the fresh search on the mark which he's supposed to.

Simon: [00:09:27] The associate attorney, at that time as we're going into the federal circuit, basically once we got past the PTB the trademark appeals, he decided to throw in the first amendment argument that just because we hold it for the future. No one in their mind thought it would ever go there. They all thought it was all going to be procedural and evidentiary because that's what the Federal Circuit cares about. They all thought possibly, maybe, they might care about the equal protection issues of Trademark Office denying us the right precisely because we were Asian. But the court didn't care about any of those things. They just picked up on a few paragraphs about the first amendment and decided to run with that.

Tony: [00:10:14] Now, as the litigation is ongoing and things are directing more towards the First Amendment, did you and your lawyer have conversations about the potential meaning of a victory, especially on appeal at the Supreme Court?

Simon: [00:10:23] We talked about it as we were going to the Federal Circuit, en banc because by then the court limited this to only one question: whether it violates the First Amendment. And we did talk about it for a while spoke with the senior attorney at the ACLU who also argued for our case at the Federal Circuit and filed an amicus brief. And that's when I realized that no amount of cultural competency that I was requesting would ever come from the government. That if you give them the power to make up the rules the privileged dominant groups would find a way around those rules and continue to basically trample on the rights of marginalized folks who do not have the resources of appealing their way through a very complex and frankly outdated system of law because we have examining attorneys who are under quota, who have less than an hour maybe two hours to go through an application. They're not going to take the time to actually look at their intentions of the mark, of how it's being used in the marketplace and certainly they're not going to look at how perceived under privilege groups might experience the mark. You know I kept thinking like if this whole perceived racist intent like the greatest kind of counter argument to my case is that if I win that my allow the Washington football team to win their case. I thought that still it isn't. The end then don't justify the means. Because if they, Harjo or Blackhorse, was still successful with it and the Washington for voting registrations were canceled, they would not be obligated in the least bit to change their name. Like if the goal was to them to stop the human beings as mascots, as degrading kind of logos and slurs as team names that would not actually achieve it's goal.

Simon: [00:12:17] And so we can't be so obsessed with trying to punish folks like Dan Snyder, who are you willing to say that the collateral damage should be experienced and marginalized groups trying to reappropriate and claim their identity. To me that is not an acceptable loss.

Chante: [00:12:32] Absolutely. You alluded to this earlier when you mentioned that you already had trademark rights prior to registering the name the Slants. So can you sort of walk some of our listeners that may not be as trademark laws you are can you sort of walk them through why. Canceling the Redskins registration would not have required them to change their names.

Simon: [00:12:54] It's kind of like what the name and the strongest argument that the government

was also their weakest when they were arguing against it they said hey you can still use the name you just don't need the registration.

Simon: [00:13:07] And that is true. But when we think about things like justice and equity we have to realize that people have more power and more rights than others and an established a football franchise with half a billion dollars of advertising behind almost a century of market permutation is going to have substantial trademark rights compared to say a nonprofit group or a band. The football team would not have suffered great financial loss at all because they already have it. They've got so much trademark equity it could have they could protect their name without the registration without any issue whatsoever with you. Even at customs or dealing with knock-off merchandise, I to think they could have easily enforced their trademark right.

Simon: [00:13:55] And that accrual of equity is always going to favor dominant groups.

Simon: [00:13:57] Correct. Groups that have been established for some time and we know which identities and which groups in this country have been established longer who have wealth and power and influence. And that's why Dan Snyder was able to think go ahead, cancel it. Because he knew it would not effect him.

Tony: [00:14:15] So something that you talked about earlier is that you know this paternalism of the United States government has failed. But you know a lot of people reacting to your case express a lot of concern for minority groups so I just wanted to hear what your reaction was for that in terms of whether there is more of a threat or potential harm to minority groups from your perspective or what might be a better alternative?

Simon: [00:14:39] I don't I don't think there are any greater threats. I mean they that for two reasons. First of all as a person of color my greatest threat, my greatest challenges don't come from people using racial slurs or defense defensive fire. They come from systemic and institutionalized discrimination. Like what's worse someone calling me a slant or a chink, or possibly the government saying you're too Asian to get this registration. To me that's far more far more of a danger.

Simon: [00:15:11] And the second part of that is that people will need trademark registration to use offensive language. I've been called many things in my life and I don't recall anyone ever saying but hold on a second let me go and get a trademark registration before I call you that.

Simon: [00:15:27] They just go ahead and do it.

Simon: [00:15:30] And the reality is that if you really want to go through the process and registered trademark I say go for it because that means that they have to put money into it. That means they have to release their personal contact information and that means there will actually be accountability.

Simon: [00:15:46] I'd rather have know my enemy rather than have anonymous threats at my door. I'd rather know exactly where they are how they conduct their business. So there's a way to fight it.

Chante: [00:15:56] And speaking of fighting it you have a TED talk out there that discusses community building as a way to fight racism. How do you see this particular victory advance that philosophy.

Simon: [00:16:08] I mean I think a couple different ways.

Simon: [00:16:10] But at the end of the day we have to realize—one of the things I'm most proud of in terms of my case is that there is bipartisan support. It was a unanimous victory at Supreme Court. We were actually able to bring groups like the ACLU and Cato Institute and have them agree on something.

Simon: [00:16:31] It shows that you know there are certain core values that we have as Americans that we can all agree on regardless of our possible political stripes. And that as a country we need to focus more on shared values because we don't have different values. We have different interpretations of the same values that we all care about. For example, some people that protection that it comes from gun ownership while other believe in restrictions of weapons.

Simon: [00:17:00] So its like lets build on that conversation of shared values, not the differences that divide us. That's how we can build unity.

The second part of it is that the trademark office is trying its very best to use the its tools to do positive things by trying to reduce the amount of hate speech. They're trying to prevent these kinds of things from affecting the marketplace. We have to realize that intention does not matter we actually have to look at the impact. What is the social impact of a particular bit of law.

Simon: [00:17:38] Because if the impact is being experienced by marginalized groups then it doesn't matter what your intention is. And I'm pretty sure slave owners thought they had good intentions when they had house slaves, but it does not mean that they weren't slaves.

Simon: [00:17:50] So for the government to say to me that oh you can use the mark, you just can't get the registration. It echoes the same kind of second class citizen argument that they've made over the years. like you can still ride the bus, you just have to sit in the back. Or you can get the civil benefits of a union, you just can't get a married, but you can get a certificate from the government.

Simon: [00:18:19] And that kind of thing is degrading for folks who are already experiencing other discrimination in other facets of their life.

Tony: [00:18:27] So Simon, one of the ways we got to meet you was you came and spoke at a local American Constitution Society event and we're just curious as to what you see as your mission as you tour and make stops to law schools. Could you tell us what your goal behind doing that?

Simon: [00:18:42] I want people to see the humanity in the name of in the context that was like how they are experienced people.

Simon: [00:18:53] It's easy to get locked in the weeds and kind of outdated bits of law or in a case law or forget that these are actual human beings involved in that. And what that might be like I mean like my very well intentioned attorneys who are working very hard and working for free like pro bono would still do legal maneuvers hey we're going to try this particular thing. It's probably not going to work. We're going to throw it in the shot in the dark and then tension's great. But I'm like hey that shot in the dark just cost me \$3,500 in appellate printing. I mean it's all those things and that is not even you know for them. They're like we're doing this for free. Yes. You know no big deal. But I don't realize like what that was like for the first time the other end who you know is struggling. I mean the reason why I am pro bono is because I can't afford their hourly rate so how could I afford all these other things. It's just too easy to forget that. And so, I wanted to remind folks that that it looks a little bit more complex than the other side.

Simon: [00:20:08] Now I also wanted to remind people that we don't have to go to life you don't have to accept status quo as if that's the only way to do things. I want to present a new perspective

in how we can approach law one that ends with a viewpoint from our most vulnerable members of our society and not you know we should build our laws around them to lift them up rather than building laws that try and punish people who abuse their civil liberties.

Tony: [00:20:38] That certainly shines through in your presentation. We definitely talked a lot about that. So Simon that wraps it up for us. Thank you again so much. Do you want to tell our listeners where they can find you online?

Simon: [00:20:49] If they're interested in my personal writing and activism they can go to simontam.org or for more information about the band they can go to theslants.com.

Liz: [00:21:01] Thanks for joining today's podcast! Today's episode was brought to you by Chante Westmoreland and Tony Bedel with production help from me, Liz Freeman Rosenzweig.

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