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The times they are a-changing: IP law takes on new points of view

In Akira Kurosawa's classic film "Rashomon," viewpoint plays a critical role as various characters provide conflicting testimony regarding the events surrounding the murder of a samurai.

Viewpoint has played a similar role in crafting the boundaries for intellectual property rights. From the removal of the Confederate flag on license plates and in statehouses, to the decision to cancel the registration for Washington Redskins marks because they disparage Native Americans, minority viewpoints are gaining traction in long-standing debates over the balance between public and private interests.

At the center of these momentous changes are the dual demands of commerce and free speech.

The bellwether for these changes in the United States may well be the recent decision in *Pro-Football Inc. v. Blackhorse* to uphold the decision by the U.S. Patent and Trademark Office to cancel six federal trademark registrations used in connection with pro football services on the basis of their "disparaging" nature.

Under Section 2(a) of the Lanham Act, the USPTO may refuse registration to a mark that "consists of ... matter which may disparage ... persons [or] beliefs." The six marks all contained the term "Redskins."

After a 20-plus-year battle, Judge Gerald Bruce Lee of the Eastern District of Virginia finally recognized that minority viewpoints take precedence in deciding whether the Washington Redskins marks were "disparaging" to Native Americans. This precedence applies even if the Washington Redskins marks have other meanings, including as a source designator for professional football services.

In upholding the USPTO's decision to cancel the contested registrations, Lee expressly rejected the owner's claims that cancella-

tion of their longstanding marks violated the company's free speech guarantees under the First Amendment.

Relying on the Supreme Court's recent decision in *Walker v. Texas Division, Sons of Confederate Veterans Inc.*, which dealt with Texas' refusal to issue license plates bearing the Confederate flag, Lee found that registration determinations did not implicate free speech rights. Instead, like the license plates at issue in *Walker*, the registration of the Washington Redskins marks could be denied in light of the government's express rejection of "disparaging" marks as a matter of government policy.

Such decisions qualified as protected "government speech" under *Walker* because registration "communicates the message that the federal government has approved the trademark."

Technically, *Blackhorse* does not prohibit Pro-Football Inc., the trademark owner, from continuing to use its Washington Redskins marks. The court's decision was narrowly crafted to address only the question of federal registration.

But, similar to the decision by the South Carolina legislature to remove the Confederate flag from statehouse grounds, *Blackhorse* sends a strong signal that the law has caught up with changing social values. The year 2015 may go down as the banner year when

Reliance on minority viewpoints to determine the availability of intellectual property protection is not limited to trademark rights.

previously silenced voices are being heard and their opinions are given weight in establishing both domestic and international protection norms.

Despite the controversy caused by *Blackhorse*, the court's findings are fully in keeping with inter-



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national practice and norms. Under Article 6quinquies of the Paris Convention for the Protection of Industrial Property, countries may decline to register marks considered "contrary to morality or public order."

Equally defensible is the reliance by the courts and the USPTO on the impact of the mark on the group being disparaged — in this case Native Americans. In New Zealand, for example, the trademark office actually relies upon the review of applied-for marks by a Maori Advisory Committee which advises the commissioner whether a mark "is, or is likely to be, offensive to Maori."

from which an invention is derived.

Such disclosure obligations are reportedly included in the draft Trans-Pacific Partnership Agreement and are a constant suggested amendment to most attempted international IP treaties. Countries as diverse as Switzerland, Brazil, India, the Andean Communities, South Africa and New Zealand already impose a disclosure obligation.

Similar to its treatment of trademarks, New Zealand has created a Maori Advisory Committee to advise the commissioner on whether a claimed invention "is derived from Maori traditional knowledge." Section 226 of the 2013 Patent Act goes further and requests input from the committee on "whether the commercial exploitation of that invention is likely to be contrary to Maori values."

It is too soon to determine how many inventions will be rejected on this basis. But the inclusion of such a committee is a clear signal that Section 226 will have teeth.

Minority views regarding the protection of their traditional cultural expressions are similarly finding greater traction as countries increasingly recognize both the cultural and economic value of protecting indigenous art and expression.

According the World Intellectual Property Organization, more than 100 countries have laws that protect such expressions. Increasingly, countries such as South Africa, are establishing special government agencies empowered to give effect to these protections.

The increasing acceptance of minority viewpoints, such as "Rashomon," will undoubtedly lead to conflicting claims regarding the role such minority views should play in establishing domestic and international norms. But, such as "Rashomon," the debate and the ultimate decision will be the richer for such diversity.