HOW *MATAL V. TAM* BECAME A FIRST AMENDMENT CASE: THE RECORD AND THE REALITY

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Introduction

According to the Supreme Court of the United States, I am the lead singer of The Slants. I am not. I have never been. I am the bassist—the founder, the bassist, and the person who spent the better part of a decade fighting the federal government over the right to use our band's name. Anyone who has ever listened to our music, attended one of our shows, or spent a few moments searching our name

would know this. But the Supreme Court's opinion in *Matal v. Tam*[1] says otherwise,[2] and because it does, so do the law review articles, the IP textbooks, and the classroom discussions that have built up around the case in the years since it was decided.[3]

I raise this not to embarrass anyone. I raise it because it is a precise and verifiable illustration of something that practitioners and scholars who study *Matal v. Tam* should understand: The legal record of a landmark case is not the same thing as what actually happened. The opinion is not the case. The briefs are not the strategy. And the story that has calcified in the legal literature—about what this case

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[1] Matal v. Tam, 582 U.S. 218 (2017).

[2] The characterization "lead singer" does not appear in either the December 2015 or February 11, 2016 corrected versions of the en banc Federal Circuit opinion, both of which correctly identify Tam as the band's "front man." *See In re* Tam, 808 F.3d 1321, 1331 (Fed. Cir. 2015) (en banc), *as corrected* (Feb. 11, 2016). The error was introduced in the USPTO's merits brief to the Supreme Court: "Respondent is the lead singer of a dance-rock band called 'The Slants.'" Brief for the Petitioner at 4, Lee v. Tam, No. 15-1293 (U.S. Nov. 9, 2016) (citing Pet. App. 10a, which uses "front man"). Justice Alito adopted the government's characterization without verification. *See* Matal v. Tam, 582 U.S. 218, 218–19 (2017). It has since propagated through the secondary literature uncorrected. *See, e.g.*, Elly Goettelman, Joseph Matal v. Tam, 28 DEPAUL J. ART, TECH. & INTELL. PROP. L. 57, 58 (2017); Amy Smith, Matal v. Tam*: Trademark Law Meets Free Speech*, 29 S. L.J. 1, 1 (2019); Cody Uyeda, *Considering* Matal v. Tam, 29 REV. L. & SOC. JUST. 303, 303 (2020); Eliza Sayedy, Matal v. Tam *Revisited*, CARDOZO AELJ (Jan. 17, 2018); Timothy Hsieh, *The Hybrid Trademark and Free Speech Right Forged from* Matal v. Tam, 7 N.Y.U. J. INTELL. PROP. & ENT. L. (2017); D. Song, *Blackhorse's Last Stand*, 19 WAKE FOREST J. BUS. & INTELL. PROP. L. (2018); H. Haider, Matal v. Tam, 22 INTELL. PROP. & TECH. L.J. (2017). One scholar noted the error in passing. *See* Mark A. Conrad, Matal v. Tam—*A Victory for the Slants, A Touchdown for the Redskins, But an Ambiguous Journey for the First Amendment and Trademark Law*, 36 CARDOZO ARTS & ENT. L.J. (2018) ("The court misidentified Tam as the 'lead singer' when in fact he was not. He plays bass guitar for the group."). Conrad's correction has gone unacknowledged in subsequent scholarship. The "lead singer" error is not the only casualty of the secondary literature's reliance on the judicial record. A practitioner newsletter from a major IP firm described Tam as "a humble guitar player in a band made up of Asian-American men." John K. Burke, *The Slants Win in* Matal v. Tam, Vedder Price Newsletter (June 2017). Tam plays bass, not guitar. Whether the adjective "humble" accurately describes someone who spent nearly a decade litigating against the federal government through multiple levels of the federal courts is left to the reader.

[3] The error also appears in the Harvard Law Review case note, which derives its factual account from the Supreme Court opinion and makes no mention of the first application. Matal v. Tam, 131 HARV. L. REV. 243 (2017).

was, how it developed, and why the decisions made along the way were made—contains gaps and errors that only a firsthand account can correct.

This article is that account.

Almost a decade has passed since the Supreme Court unanimously struck down the disparagement provision of Section 2(a) of the Lanham Act.[4] In that time, *Matal v. Tam* has been cited in hundreds of law review articles, briefed in subsequent First Amendment cases, and assigned in IP and constitutional law courses across the country. Scholars have analyzed the decision's doctrinal implications, its impact on subsequent cases like *Iancu v. Brunetti,*[5] and its effect on the registration of marks by marginalized communities.[6] What they have not done—because they could not—is tell the story of how the case was actually made.

That story is more complicated, and more instructive, than the legal literature suggests. *Matal v. Tam* is taught as a First Amendment case. It was not designed as one. It became one through a sequence of institutional interventions—each of which narrowed the legal question, foreclosed certain arguments, and ultimately transformed a trademark dispute about cultural identity into a constitutional referendum on government speech regulation. Understanding that transformation is not merely historically interesting. It changes how practitioners should approach impact litigation involving marginalized communities, how law professors should teach the case, and how future litigants should think about what they are actually fighting for when they bring a case that institutions decide to use for their own purposes.

The errors in the legal record are the place to start, because they are evidence that something is missing.

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[4] Matal v. Tam, 582 U.S. 218, 233 (2017).

[5] Iancu v. Brunetti, 588 U.S. 388 (2019).

[6] *See, e.g.*, Michael P. Goodyear, *Queer Trademarks*, 2024 U. ILL. L. REV. 163 (empirical study of 144 LGBTQ+-oriented trademark applications before and after Tam, finding that affirming uses by in-group members overwhelmingly predominated and not a single disparaging use of slurs was identified over the entire nine-year study period); James L. Gibson, Lee Epstein & Gregory P. Magarian, *Taming Uncivil Discourse*, 41 POL. PSYCH. 383 (2020) (nationally representative survey finding that perceived reappropriation motives significantly reduce judgments of insult, using *Matal v. Tam* as empirical context).

I. WHAT THE RECORD GOT WRONG: THE ERRORS THAT REVEAL THE GAP

A. The "Lead Singer" Error and Its Genealogy

The "lead singer" error is documented in footnote 2. Its significance here is not the error itself but its mechanism: A factual mischaracterization introduced by the government in its Supreme Court merits brief was adopted by Justice Alito without verification, entered the permanent legal record, and has been reproduced across the secondary literature ever since—despite being corrected in a law review footnote as early as 2018. The document superseded the person. The opinion became the authoritative source on a fact about which I am the more credible authority.

This mechanism operates throughout the legal record of *Matal v. Tam*, not just in the "lead singer" characterization. It is the structural problem this article addresses.

B. The AAYLC Concert Error: How the Record Got Sealed

A second error—one that reveals how the two-application structure shaped what courts could see—appears in the account of a 2009 concert by The Slants at the Asian American Youth Leadership Conference (AAYLC) in Portland. To understand why this error matters, some background is necessary.

The Slants' trademark history involves two distinct applications, each building on different legal strategies. The first was filed in March 2010.[7] When the USPTO refused registration, we mounted an extensive evidentiary challenge—a national survey, expert linguistics testimony, legal declarations from Asian American community leaders, and documented examples of reappropriative usage of "slant"—establishing that the term was not disparaging to the community it purportedly harmed. That entire record, and what the USPTO did with it, is addressed in Section III. For present purposes, what matters is that after the USPTO dismissed our rebuttal evidence in the reconsideration phase as "laudable, but not persuasive,"[8] we eventually abandoned that application and filed a second application in 2011 with a different legal strategy. The evidentiary record from the first application did not carry over into the second application and subsequent litigation.

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[7] U.S. Trademark Application Serial No. 77/952,263 (filed Mar. 5, 2010).

[8] U.S. Trademark Application Serial No. 77/952,263, Reconsideration Letter (July 7, 2011) ("applicant's analysis and arguments are not persuasive nor do they shed new light on the issues").

It is against this background that the AAYLC error must be understood. The examining attorney's opinion denying the second application cited a blog suggesting the concert was canceled due to controversy over the band name—evidence that the Asian American community found the name offensive. The Federal Circuit panel repeated this as record evidence of community opposition: "[Mr. Tam] was initially slated to give the keynote address at the 2009 Asian American Youth Leadership Conference in Portland. But some conference supporters and attendees felt the name of the band was offensive and racist, and out of respect for these opinions the conference organizers decided to choose someone less controversial."[9] The en banc court reproduced the same account as "unrebutted evidence."[10]

The rebuttal evidence—the AAYLC board chair's sworn declaration, concert programs, photographs, documentation of Tam (me) delivering the keynote at subsequent AAYLC events, the organization's later award to me—had been submitted and assessed during the first application proceedings. By the time the case reached the Federal Circuit, it was no longer part of the active record, not because it was unavailable, but because it lived in the record of the abandoned application. The account of the concert cancellation appeared before the court without the rebuttal that had once accompanied it, and the court characterized it accordingly.

This is not a peripheral factual dispute. The AAYLC concert characterization was part of the evidentiary basis for the finding that the Asian American community found the band name disparaging. The community evidence that told a different story was not missing from the record because it did not exist—it was missing because the legal machinery processed only the second application, and the structure of that process had no mechanism for importing evidence developed in a separate, earlier proceeding.

C. The Selective Construction of Community Opposition

The AAYLC error is one instance of a broader pattern in the government's evidentiary record. Throughout the prosecution history and subsequent litigation, the USPTO compiled sources that portrayed the Asian American community as uniformly opposed to The Slants' name—while ignoring or dismissing evidence that told a more complex story.

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[9] *In re* Tam, 785 F.3d 567, 570–71 (Fed. Cir. 2015) (panel op.) (quoting J.A. 95).

[10] *In re* Tam, 808 F.3d 1321, 1332 (Fed. Cir. 2015) (en banc) (citing Panel Op. at 570–71).

The examining attorney introduced a brochure from the Japanese American Citizens League (JACL) describing "slant" as a derogatory term used to "cripple the spirit," which the Federal Circuit panel then cited as evidence of community opposition.[11] This citation warrants careful attention. The brochure was not discovered independently by the court—it entered the record through the examining attorney's initial rejection and was carried forward through the prosecution history. It was, in other words, government-selected evidence of community sentiment.

What the Federal Circuit did not know was that the Portland JACL chapter had been actively engaged with The Slants throughout the litigation period: writing legal declarations in support of the first trademark application, covering the band in the national JACL publication Pacific Citizen, and inviting Tam to participate in JACL events across the country, including the anniversary commemoration of the Japanese American Historical Plaza in Portland.[12] By the time the case reached the Supreme Court, the Portland JACL chapter had signed onto the ACLU coalition amicus brief in support of the respondent.[13]

This matters not as an organizational contradiction but as an evidentiary one. The Lanham Act's own disparagement standard requires the USPTO to assess how a mark is perceived by the relevant community—which is precisely why examining

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[11] *In re Tam*, 785 F.3d at 570–71 (citing J.A. 95 and noting a JACL brochure describing "slant" as a derogatory term used to "cripple the spirit").

[12] The Portland JACL chapter's active engagement with The Slants during the litigation period—including legal declarations in the first application proceedings, coverage in Pacific Citizen, and invitations to events including the Japanese American plaza commemoration—existed in the record of the first application and was therefore invisible to the courts that cited the JACL brochure as evidence of community opposition.

[13] *See* Brief Amici Curiae of the American Civil Liberties Union, the ACLU of the Nation's Capital, the ACLU Foundation of Oregon, the Asian American Legal Defense and Education Fund, the Asian Pacific American Network of Oregon, the Chinese American Citizens Alliance Portland Lodge, the Portland Japanese American Citizens League, and the Oregon Commission on Asian and Pacific Islander Affairs, in Support of Respondent, *Matal v. Tam*, 582 U.S. 218 (No. 15-1293). Almost every Asian American organization that the examining attorney had cited in the prosecution history to suggest community opposition to the band's name ultimately signed a legal brief in support of the respondent at the Supreme Court.

attorneys consult dictionaries and conduct online searches in the first place.[14] A general educational brochure about the historical use of a word as a slur is a different kind of evidence from contemporaneous declarations by community leaders, coverage in community publications, and invitations to community events. The USPTO's standard, however, provided no mechanism for weighing these different categories of evidence against one another, and no procedural pathway for the community's contemporaneous engagement with the band to appear in the record of the second application. The brochure was in that record. The declarations and community's involvement were not.

The evidence existed. What didn't exist was any process to get it in front of the Federal Circuit, so the court ruled on an incomplete record.

D. The Broader Pattern: What the Literature Has Missed

These gaps share a common feature. The legal record of *Matal v. Tam* is built almost entirely on the second application, the TTAB proceedings, the Federal Circuit opinions, and the Supreme Court decision. The first application—where the legal strategy began, where the evidentiary record was assembled and assessed, where the community evidence first entered and exited the proceedings—is absent from nearly every scholarly treatment of the case.[15]

This is not because scholars chose to ignore it. The judicial record begins with the second application, and the literature follows the judicial record. The result is that doctrinal analysis of *Matal v. Tam* proceeds on an incomplete factual foundation—one that, as the foregoing demonstrates, contains errors of omission significant enough to change how the case should be taught and understood.

There is a secondary consequence worth naming. The federal government's characterization of The Slants' mark as "disparaging"—a characterization that

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[14] *See* TMEP § 1203.03(b)(i) (Apr. 2017) (describing the two-part test for disparagement, which requires the USPTO to assess the likely meaning of the mark and whether that meaning is disparaging to a substantial composite of the referenced group—a standard that necessarily contemplates evidence of actual community perception).

[15] The government's own merits brief acknowledged the first application in a single footnote: "Respondent first filed a trademark-registration application for THE SLANTS in 2010, but he subsequently abandoned that application." Brief for the Petitioner, *supra* note 2, at 4 n.4. Nearly every scholarly treatment of the case follows this model. *See, e.g.*, Goettelman, *supra* note 2, at 58–60 (beginning factual account with 2011 application); Smith, *supra* note 2, at 1–3 (same); Uyeda, *supra* note 2, at 306–07 (same); Matal v. Tam, 131 HARV. L. REV. 243 (2017) (same).

courts at every level were required to accept as a predicate for reaching the constitutional question—did not exist in a vacuum. Within the Asian American community, which had been broadly supportive of the band, the official legal finding of disparagement created confusion and doubt. Institutions and individuals who might otherwise have remained neutral or supportive were put in the position of either endorsing what a federal court had labeled a racial slur, or distancing themselves from it. The legal record's incompleteness, in other words, had community consequences that no subsequent doctrinal analysis has examined. This point is addressed further below, in Part VII.

II. THE FIRST APPLICATION: WHAT WAS ACTUALLY ARGUED, AND WHAT THE SYSTEM DID WITH IT

A. The Evidentiary Record We Built

The first application was filed on March 5, 2010.[16] The USPTO's initial rejection relied on sources including UrbanDictionary.com, Asian-jokes.com, and a photograph of Miley Cyrus making a "slant-eye" gesture[17]—but not a single Asian American who found the term disparaging. Our response was to build the kind of evidentiary record the Lanham Act's own standard would seem to require: direct, community-sourced evidence of how the mark was actually perceived.

That record included a national survey conducted by Dr. Charlton McIlwain and Dr. Stephen Caliendo showing that only eight to sixteen percent of Asian Americans found the name disparaging.[18] For context, the only available benchmark in the case law was *Pro-Football, Inc. v. Harjo*, where the Trademark Trial and Appeal Board had found that 36.6 percent was insufficient to constitute a "substantial composite."[19] Our survey showed less than half that figure. The record also included linguistics and dictionary expertise from Dr. Ron Butters (the same expert who had worked on the *Dykes on Bikes* appeal[20]), legal declarations from prominent Asian American activists and organization leaders across the country, dozens of articles from Asian American press and media, and multiple documented examples

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[16] U.S. Trademark Application Serial No. 77/952,263 (filed Mar. 5, 2010).

[17] *Id.*, Office Action Outgoing (June 11, 2010).

[18] *Id.*, Expert Report of Charlton McIlwain, Ph.D. & Stephen Caliendo, Ph.D. (June 16, 2011).

[19] Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96, 133 n.32 (D.D.C. 2003).

[20] U.S. Trademark Application Serial No. 77/952,263, Expert Report of Ronald Butters, Ph.D. (June 16, 2011).

of "slant" being used in a self-referential, self-empowering manner by Asian Americans.[21] The total estimated value of donated expert services for the first application alone was approximately $200,000—a figure that grew considerably across the full appellate record, with some estimates placing the total cost of the litigation closer to $1 million when accounting for billable hours, appellate printing, and amicus brief preparation at multiple levels.

The breadth of the USPTO's inconsistency is worth recording as context for what the evidentiary challenge was up against. By the time The Slants first applied for registration, nearly every racial slur associated with Asian Americans existed as a registered trademark—held by non-Asian applicants who had faced no disparagement challenge. The narrow category of denials under Section 2(a) in this context was occupied almost entirely by Asian Americans attempting to reappropriate those same terms.[22] The provision did not apply to the terms themselves. It applied to the communities that reclaimed them.

B. What the USPTO Did with It

The record before the USPTO thus included a professionally designed national survey, a leading linguistics expert, and extensive community documentation—all pointing in one direction. The agency found the submission "laudable, but not persuasive,"[23] without explaining what kind of evidence would have been sufficient or how the survey's findings related to the "substantial composite" standard that governed the analysis. The gap between what *Harjo* suggested the threshold should be and what the USPTO applied here was not addressed.[24]

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[21] *Id.*, Response to Office Action (Dec. 3, 2010).

[22] The pattern of Section 2(a) denials for Asian American reappropriation is documented throughout the prosecution history of the first and second applications. *See, e.g.*, U.S. Trademark Application Serial No. 85/967,142 (CHINK PROUD, filed June 21, 2013) (denied as disparaging despite multiple existing registrations for CHINK held by non-Asian applicants). The disproportionate impact of Section 2(a) on applicants from marginalized communities who sought to reappropriate derogatory terms was documented empirically in Megan M. Carpenter & Kathryn T. Murphy, *Calling Bullshit on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465 (2010), and Megan M. Carpenter & Mary Garner, *NSFW: An Empirical Study of Scandalous Trademarks*, 33 CARDOZO ARTS & ENT. L.J. 321 (2015).

[23] U.S. Trademark Application Serial No. 77/952,263, Reconsideration Letter (July 7, 2011).

[24] The disproportionate burden of Section 2(a) on under-resourced applicants and marginalized communities was documented empirically in Carpenter & Murphy, *supra* note 22, and Carpenter & Garner, *supra* note 22.

The response to the Oregon Commission on Asian and Pacific Islander Affairs—a governor-appointed commission of nine eminent community members and two legislators—illustrates how the USPTO's evidentiary framework operated in practice. After hearing a presentation on The Slants' trademark situation, OCAPIA wrote to the USPTO urging the agency to "assure their review and approval process includes professionals with diverse cultural viewpoints, especially for decisions that may involve Section 2(a)," noting that this was "the only way for Government to remain in step with the civil rights sensibilities of communities of color."[25] The USPTO's response, signed by Cynthia C. Lynch, the Administrator for Trademark Policy and Procedure, on December 23, 2011, did not address the substance of OCAPIA's request. It confirmed that twenty-seven percent of the USPTO's workforce was Asian and that the agency maintained a thriving employee resource group—and assured OCAPIA that agency decisions involve "an impartial application of the relevant statutory provisions, regulations, and caselaw, considering the evidence of record."[26] OCAPIA's letter had been addressed to Lynch by name and copied to the Oregon Governor's Office and congressional delegation. Her response arrived within three days. The response letter was dated six weeks after the first application was abandoned, and the day after the second application was assigned to the same examining attorney whose conduct OCAPIA's letter had implicitly questioned. Three weeks later—during the holiday period, at a pace unusually fast by USPTO standards—that examiner issued his rejection of the second

[25] Letter from Oregon Commission on Asian and Pacific Islander Affairs to Cynthia C. Lynch, Adm'r for Trademark Policy & Procedure, U.S. Patent and Trademark Office (Dec. 20, 2011) (on file with author); Letter from Cynthia C. Lynch, Adm'r for Trademark Policy & Procedure, U.S. Patent and Trademark Office, to Oregon Commission on Asian and Pacific Islander Affairs (Dec. 23, 2011) (on file with author). OCAPIA's letter, addressed directly to Lynch by name, was copied to the Oregon Governor's Office and Oregon's congressional delegation. Lynch's reply arrived within three days. OCAPIA is a governor-appointed commission of nine eminent community members and two legislators appointed by House and Senate leadership, established to advise Oregon policymakers on the needs of API communities in Oregon.

[26] Letter from Cynthia C. Lynch, Adm'r for Trademark Policy & Procedure, U.S. Patent and Trademark Office, to Oregon Commission on Asian and Pacific Islander Affairs (Dec. 23, 2011) (on file with author).

application under the disparagement provision.[27] The assurance of impartiality and the identity-based rejection were simultaneous institutional acts. OCAPIA later signed onto the ACLU coalition brief in support of the respondent at the Supreme Court.[28]

C. The Irrefutable Fact Problem

There is a practitioner lesson embedded in this failure that the legal literature has never examined, because the literature does not know the first application existed. To the band and the Asian American community, the non-disparaging nature of the name was not a matter of interpretation. It was documented, empirically supported, and community-verified. The survey data, the linguistics expert, the community declarations, the press coverage—these were not arguments. They were facts.

To the USPTO, every piece of evidence was subject to the examining attorney's interpretive discretion. The Lanham Act's own standard requires assessment of how a mark is perceived by the relevant community, but that same standard contains no defined threshold for what would constitute sufficient community evidence, and no procedural hierarchy that distinguishes between professionally designed survey data and anonymous message board posts. Both are potentially relevant under the governing framework; neither is categorically privileged over the other. The result is a system in which the examiner's judgment about the weight of evidence is effectively unreviewable, because there is no defined standard against which to measure it. What a national survey showing eight to sixteen percent opposition means relative to a "substantial composite" requirement is, under the

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[27] The relevant dates: U.S. Trademark Application Serial No. 77/952,263 abandoned Nov. 8, 2011; U.S. Trademark Application Serial No. 85/472,044 filed Nov. 14, 2011; second application assigned to examining attorney Dec. 22, 2011; OCAPIA letter sent Dec. 20, 2011; Lynch response Dec. 23, 2011; examiner's Office Action issued Jan. 6, 2012. *See* TMEP § 704.01 (Apr. 2017); U.S. Trademark Application Serial No. 85/472,044, Office Action Outgoing (Jan. 6, 2012). The OCAPIA letter also identified the author as "Manager for The Slants"—a third institutional characterization of his role, distinct from both "lead singer" and "front man," in correspondence from a community organization that had just heard him present in person.

[28] *See* Brief Amici Curiae of the American Civil Liberties Union et al., *supra* note 13 (listing the Oregon Commission on Asian and Pacific Islander Affairs among the amici in support of respondent).

USPTO's framework, a matter for the examiner to determine—and once made, that determination is, in practice, very difficult to dislodge.[29]

The asymmetry is worth naming directly for practitioners: Some arguments do not fail because they are wrong. They fail because they are being made at the wrong stage of a legal journey, before an institution whose evidentiary framework lacks the tools to evaluate them on their merits.

D. The Second Application and the Identity-Based Finding

The second application—filed November 14, 2011, as a deliberately "ethnic neutral" submission to test whether the disparagement finding was about the word or the applicant—was assigned to the same examining attorney as the first.[30] The prosecution history of the second application incorporated evidence from the first rejection, including sources that predated the new application by several years, without a fresh search of the kind the Trademark Examining Procedures Manual required.[31]

On appeal, the basis for the disparagement finding was made explicit in the examining attorney's response: "[T]he evidence is uncontested that the applicant is a founding member of a band (The Slants) that is self-described as being composed of members of Asian descent . . . . Thus, the association of the term SLANTS with those of Asian descent is evidenced by how the applicant uses the mark—as the name of an all Asian-American band."[32]

The USPTO had already acknowledged that "slant" is not an inherent racial slur.[33] The disparagement finding therefore did not rest on the word's intrinsic meaning—it rested on the identity of the applicant and the association that identity created. This argument—that the finding amounted to a race-based denial of trademark rights—was raised at the Federal Circuit in both the panel briefing and the

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[29] *Id.*, Reconsideration Letter (July 7, 2011).

[30] THE SLANTS, Registration No. 5,332,283; U.S. Trademark Application Serial No. 85/472,044 (filed Nov. 14, 2011).

[31] TMEP § 704.01 (Apr. 2017) (requiring a fresh search for each application).

[32] U.S. Trademark Application Serial No. 85/472,044, Office Action Outgoing (June 20, 2012).

[33] *Id.* (USPTO acknowledged that "slant" is not an inherent racial slur; the disparagement finding depended on the applicant's identity as Asian American and the association created by that identity).

evidentiary and procedural challenges. It did not provide the basis for relief at that stage.[34] The case went forward on other grounds.

The legal consequence, however, is worth stating clearly: A mark that would have been registrable if applied for by a non-Asian band was denied registration because the applicant was Asian American. The mechanism was the discretionary disparagement standard, applied through an identity-based association that the USPTO's own framework had made possible.

E. Why We Did Not Introduce Survey or Dictionary Evidence on the Second Application

Legal scholars who have written about *Matal v. Tam* have consistently puzzled over or mischaracterized the evidentiary strategy of the second application. The answer is straightforward and has never been published.

The Federal Circuit reviews the record developed before the TTAB; as a standard feature of appellate procedure, no new evidence could be introduced at that stage. The evidentiary record was closed. This was understood and accepted by the team as a strategic constraint that could be turned into an advantage: Locking the record in meant that the examining attorney's procedural violations—the stale evidence, the race-based association, the departure from the Trademark Examining Procedures Manual—were preserved exactly as they had occurred, available for argument without the government being able to supplement or rehabilitate them on appeal.

The team also considered whether the survey experts from the first application should file an amicus brief at the Federal Circuit. The decision against it was deliberate: Introducing the survey evidence at the appellate stage would have implied that the question of disparagement remained open, which would have undermined the core procedural argument that the examining attorney's evidentiary process was defective on its face. The procedural arguments presupposed the very question of determining disparagement—that is, they argued the process was broken before it ever reached the merits. Reintroducing the merits evidence risked conceding that the process had functioned properly and that the merits were genuinely in dispute.

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[34] *See In re* Tam, 785 F.3d 567 (Fed. Cir. 2015) (panel) (affirming the TTAB's disparagement determination and rejecting respondent's constitutional challenges without substantive engagement with the procedural and evidentiary objections raised in briefing).

Examining the record of every major Section 2(a) reappropriation appeal—*Dykes on Bikes*, *Heeb Media*, and others—confirms that no applicant has ever successfully won a "we are not disparaging" argument at the TTAB or Federal Circuit level. The strategic choice to focus on procedural and evidentiary violations rather than re-litigating the merits has been misread in the literature as a failure to build an evidentiary case. It was the opposite: a recognition that the evidentiary case had already been made, dismissed, and that a different theory of error was necessary at this stage.

III. THE FEDERAL CIRCUIT AND THE CASE WE DIDN'T PLAN TO MAKE

A. The Three-Panel Loss and Judge Moore's Additional Views

The Federal Circuit three-judge panel ruled against us in April 2015, affirming the TTAB.[35] The panel's ruling on the disparagement determination was consistent with every precedent in the field—no applicant had ever successfully appealed a Section 2(a) disparagement refusal at any level, and both sides had prepared accordingly. The case had been litigated and argued as a technical trademark matter, focused on procedural and evidentiary issues. First Amendment questions appeared only at the margins of the respondent's brief, and their placement was telling. The Statement of Issues on Appeal listed nine questions for review. The first six addressed procedural and evidentiary errors. Question seven raised a due process challenge to the USPTO's inconsistent application of the statute. Questions eight and nine raised the vagueness and First Amendment arguments, respectively.[36] The constitutional arguments had been drafted by the firm's associate attorney, who told the author directly: "This is just in case this thing ever goes up. It won't . . . but this is just in case."[37] The lead attorney, preparing for oral argument

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[35] *In re* Tam, 785 F.3d 567 (Fed. Cir. 2015) (panel).

[36] The USPTO's decision to decline substantive engagement with First Amendment questions during oral argument before the panel reflected both parties' understanding of the Federal Circuit as a technical court primarily concerned with procedural and evidentiary matters. The constitutional question appeared in our brief as a fallback, and both the panel and the USPTO treated it accordingly.

[37] Simon Tam, SLANTED: HOW AN ASIAN AMERICAN TROUBLEMAKER TOOK ON THE SUPREME COURT 196–97 (2019). The associate attorney also explained that attorneys routinely include backup constitutional arguments at the appellate stage to "hold the argument"—if the argument is not submitted at this stage, it cannot be raised later. The First Amendment and Fifth Amendment

before a technical court focused on procedural and evidentiary questions, did not review that section. Neither side was prepared to argue constitutional issues in any depth, and when First Amendment questions arose during argument, the USPTO declined to engage with them substantively. The argument that would become the basis of a unanimous Supreme Court decision was, at the Federal Circuit panel stage, a placeholder.

What distinguished the panel's ruling was not its holding but its structure. Judge Kimberly Moore filed a lengthy section titled "Additional Views" in which she argued that the disparagement provision was constitutionally suspect and urged en banc reconsideration.[38] This was not a casual aside. Judge Moore had written on the disparagement provision two decades earlier, as a law professor, arguing that the doctrine was "how politically correct must a trademark be" and questioning its constitutional foundations.[39] Her "Additional Views" in the panel opinion gave explicit voice to what had been an academic position for twenty years. They also acknowledged directly what a three-judge panel could not do: reach a constitutional holding on a question that had not been fully briefed or argued. The implicit invitation to the full court was clear.

B. The Sua Sponte Order

One week after the panel decision, the Federal Circuit issued a sua sponte order, vacating its own ruling and inviting en banc reargument.[40] The court would hear one question, and one question only: Does the disparagement provision of Section 2(a) of the Lanham Act violate the First Amendment? Nothing else would be considered.

For the court to reach the constitutional question, The Slants had to be accepted as disparaging. When it decided the case, the en banc court reviewed the record

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arguments were included on this basis. The Statement of Issues on Appeal listed nine questions; the First Amendment question appeared ninth. *See* Brief of Respondent-Appellant Simon Shiao Tam, *In re Tam*, No. 14-1203 (Fed. Cir. 2014), Statement of Issues on Appeal.

[38] *See In re Tam*, 785 F.3d at 580–91 (Moore, J., additional views).

[39] Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPP. L. REV. 1 (1994). Judge Moore authored this article as a law professor under her previous name, before her appointment to the Federal Circuit. The article argued that the disparagement doctrine was inconsistent with First Amendment principles—a position she articulated again, from the bench, more than two decades later.

[40] *See In re* Tam, 600 F. App'x 775 (Fed. Cir. 2015) (en banc order).

evidence and upheld the panel's disparagement determination before proceeding to the constitutional analysis.[41] This meant that the evidentiary record built for the first application—the national survey, the linguistics expert, the community declarations, all of it—was not only beside the point, but was also structurally incompatible with the question the court had decided to answer.

A court cannot simultaneously find a mark non-disparaging and then address whether the statutory bar on disparaging marks violates the First Amendment. The disparagement finding was the necessary predicate for the constitutional question. The court needed us to lose on the merits in order to reach the question it wanted to decide.

C. The Internal Decision: Leaning In

The team's response was to embrace the First Amendment question fully, because it was the best opportunity available to win. We also genuinely believed that the law was outdated, incompatible with the First Amendment, and disproportionately harmful to marginalized communities engaged in reappropriation. The decision to lean into that opportunity was values-based as well as strategic.

But it is important to be honest about what that decision meant. The First Amendment argument had appeared near the back of our legal brief as a fallback. It was not the primary theory of the case. The primary theories—that the examining attorney's conduct was procedurally defective, that the evidence did not support a disparagement finding, that the word "slant" is not inherently a slur and was not being used as one—had been made, submitted, and either dismissed or ignored. The constitutional question was the question the Federal Circuit had decided it wanted to answer, and our case was the vehicle.

D. The Narrowing Dynamic

Impact litigants rarely discuss this openly: The case you plan to bring and the case you end up litigating are often not the same case. At each institutional level, the legal question contracted. At the USPTO, the question was whether the word was disparaging—answered by a single examining attorney's subjective interpretation using evidence that predated the application and violated the agency's own procedures. At the TTAB, the question was whether the examiner's process com-

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[41] *In re* Tam, 808 F.3d 1321, 1332 n.3 (Fed. Cir. 2015) (en banc).

plied with the rules—answered by dismissing our corrective evidence as not persuasive. At the Federal Circuit panel, the question was whether the TTAB erred—answered against us, with a JACL brochure and a Wikipedia entry cited as evidence of community opposition.[42] At the Federal Circuit en banc, the question was imposed by the court itself.[43] At the Supreme Court, the question was the constitutional question, and only the constitutional question.[44]

What began as a broad, factually grounded dispute about cultural identity and community meaning had been sharpened, at each stage, into a narrow constitutional blade. The human and cultural complexity that motivated the fight—the reappropriation, the community evidence, the examining attorney's racial reasoning—was not what the Supreme Court decided. It was the backdrop. This is not a complaint about the outcome, which was both correct and important. It is an observation about process that practitioners and scholars who study impact litigation need to understand.

IV. The Supreme Court Phase: Decisions the Literature Has Never Examined

A. Two Briefs, One Abstraction

By the time the case reached the Supreme Court, both parties were operating within the frame the Federal Circuit had imposed: The constitutional question was the question, and the factual record was what it was. The government's merits brief had reconstructed that record in the ways documented above—presenting a "lead singer," a Wikipedia-sourced reappropriation argument, and a single footnote acknowledging the entire first application. The respondent's brief was written from within the same frame, but pushed against it from the inside.

The respondent's brief opens its Statement: "Simon Tam is an Asian-American musician, lecturer, and political activist. He is the founder and leader of The Slants, a rock band based in Portland, Oregon."[45] This opening was deliberate. The con-

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[42] *In re Tam*, 785 F.3d at 570–71.

[43] *In re* Tam, 600 F. App'x 775 (Fed. Cir. 2015).

[44] Matal v. Tam, 582 U.S. 218 (2017).

[45] Brief for Respondent at 1, Lee v. Tam, No. 15-1293 (U.S. Dec. 9, 2016). The respondent's brief also included the Galinsky reappropriation study—the same social science framework the

stitutional question required establishing that the mark was expressive speech motivated by community-oriented values—which required front-loading identity, purpose, and context. The author had insisted the community work be included; the team agreed it strengthened the First Amendment argument by grounding the constitutional question in a specific human and community reality rather than as an abstract legal dispute.

The tension is worth naming directly. The brief simultaneously argues, in Section II, that the mark is not disparaging—presenting the community evidence that had been the foundation of the case from the beginning—while also accepting, for purposes of the constitutional question, that the mark had been found disparaging and proceeding on that basis. Both arguments were necessary. But the structure required the richer human account to be subordinated to the constitutional architecture, to serve as context for a question that had been imposed on the case rather than grown from it.

Meanwhile, a different account of the case was being made in public. Through media coverage, speaking engagements, and community events, the author was still arguing something closer to the substance of the first application—contesting the disparagement label, explaining the reappropriation context, presenting the community evidence the legal record had set aside. The legal brief had to accept the Federal Circuit's frame; the public account did not. Those two versions of the case ran in parallel, rarely intersecting in the legal literature.

B. Declining Co-Counsel

When the Federal Circuit granted en banc review, the case attracted a different kind of attention. Over the months that followed—and especially after certiorari was granted—approximately fifty to sixty law firms and prominent attorneys reached out, most seeking to take over representation. The argument they made was consistent: Our small firm had done admirable work, but Supreme Court litigation was a different practice, they argued before the Court regularly, they knew the Justices, and we would be disadvantaged by going in with counsel who lacked that institutional experience.

USPTO had declined to credit through the first application proceedings—in its opening Statement as scholarly support for the reappropriation argument. *See id.* at 2 (citing Adam D. Galinsky et al., *The Reappropriation of Stigmatizing Labels: The Reciprocal Relationship Between Power and Self-Labeling*, 24 PSYCH. SCI. 2020 (2013)).

I did not find this persuasive, for reasons both principled and personal. On the principled side: I did not want to win while abandoning the attorneys who had believed in the case when it was not prestigious enough to attract that kind of interest. Ron Coleman had taken the second application pro bono because he believed in the principle; John Connell and Joel MacMull had worked alongside him with comparable commitment. They had earned the right to see the case through. On the personal side: I wondered why the firms now offering help had not been available five years earlier, when I was fighting the USPTO with a single overextended attorney and evidence the government was simply choosing not to credit.

The history of how I came to work with my attorneys is itself worth recording. My original attorney on the first application, Spencer Trowbridge, had taken the case because he believed in it—but eventually became burnt out and declined to renew his license to practice law. I found Ron Coleman because he had written about the case on his legal blog, Likelihood of Confusion, and I reached out. Ron spoke with Spencer, agreed to take the case pro bono, and acknowledged from the outset that I was a deeply involved client who cared about every dimension of the litigation. That relationship—built on shared principle and collaboration—was not something I was willing to trade away for institutional credibility.

Several organizations also offered co-counsel arrangements, some of which would have required framing the case's arguments differently than we had planned. We declined those as well, and invited those organizations to file amicus briefs instead. Many did. Some of the attorneys who had offered to take over the case subsequently spoke negatively about our litigation choices in public settings, suggesting that our position was legally flawed and that they agreed with the USPTO's approach. That view did not prove persuasive to the Supreme Court.

C. Who Argued Before the Court

Ron Coleman was lead attorney throughout the case. John Connell argued before the Supreme Court. This decision—among the most consequential a litigation team makes at the SCOTUS level—has never been discussed publicly.

The reasoning was captured in a conversation I had with Ron at Georgetown during our moot court session: "It's easier to teach trademark law to a constitutional guy than constitutional law to someone who does trademarks." This was not a matter of John's seniority or of lack of confidence in Ron's abilities, which had been demonstrated across years of litigation. It was a strategic calculus based on the arguments our brief was advancing—arguments that had been significantly shaped

by the UCLA School of Law Supreme Court Clinic. Stuart Banner and Eugene Volokh of UCLA's Supreme Court Clinic had joined the brief alongside Connell, Coleman, and Joel MacMull, who had originally raised the First Amendment argument in the Federal Circuit briefing. The brief's constitutional architecture called for a constitutional advocate in the room.

I had worried about what the decision meant for Ron, who had invested years in the case pro bono. He was characteristically direct: "I've been busy with my kid's wedding this weekend, so this is a relief. I wouldn't be able to dedicate myself to the arguments as much as I'd like, and you deserve the very best chance to win."[46]

D. The Moot Court Process

Our formal moot court session was held at the Georgetown University Law Center on January 12, 2017, approximately one week before oral argument.[47] The Supreme Court Institute at Georgetown had constructed a replica of the Supreme Court's courtroom, complete with velvet curtains and leather chairs, designed to approximate the physical and psychological experience of arguing before the Court. The legal team also practiced in their office on several additional occasions.

There is a dimension of the moot process that the legal literature does not capture. By the time our team arrived at Georgetown, other institutions were already mooting the case without us. The New York Intellectual Property Law Association conducted its own moot court session with judges from the Second Circuit—our team registered and watched from a distance, learning how others anticipated the constitutional questions would be framed.[48] The case had, by that point, taken on a life of its own in the moot court community; I have since met student teams from across the country who mooted arguments for or against our position as part of academic competitions.

By some accounts, our team could have benefited from additional sessions. The First Amendment questions that dominated the Supreme Court argument were not where our attorneys had spent the previous years of litigation. The constitutional

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[46] TAM, *supra* note 37, at 247–48.

[47] The moot court session at Georgetown was conducted under the auspices of the Supreme Court Institute on January 12, 2017. Oral argument before the Supreme Court was held on January 18, 2017.

[48] *3rd Annual Second Circuit Moot Court Argument CLE Program*, N.Y. INTELL. PROP. L. ASS'N (2016), https://perma.cc/R8PF-5567.

architecture, while carefully developed in the brief with UCLA's assistance, was newer territory than the trademark and evidentiary issues that had occupied the case from the beginning.

E. The Government's Selective Use of Record Evidence at SCOTUS

One passage from the government's merits brief to the Supreme Court illuminates the full scope of what had been lost in the transition from the first application to the constitutional question. On page four of the Statement, the brief introduces the case as follows: "Respondent is the lead singer of a dance-rock band called 'The Slants.'"[49] It then states, in the main text: "Respondent had argued that he sought to 'take on . . . stereotypes' about Asians rather than to disparage persons of Asian ancestry . . . but the Board determined that a mark's status as 'disparaging' does not depend on the applicant's purpose in using the mark."[50]

The framing requires examination. The "take on stereotypes" language does not come from our legal arguments or briefs in the second application proceedings. It was drawn from a Wikipedia entry that the Federal Circuit panel had cited as record evidence—not as our argument, but as government-submitted evidence that the mark referred to people of Asian descent.[51] The en banc court inherited this from the panel. The government's brief then reframed it as our affirmative argument—while simultaneously using the Board's ruling that intent is irrelevant to undercut it—attributing to the second application an argument that had been the foundation of the first, without acknowledging the extensive evidentiary record that had been built around it, submitted, and dismissed.

The acknowledgment of the first application appeared in a single footnote: "Respondent first filed a trademark-registration application for THE SLANTS in 2010, but he subsequently abandoned that application."[52] The argument from that abandoned application was invoked in the main text. The evidence that accompanied it

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[49] Brief for the Petitioner, *supra* note 2, at 4.

[50] *Id.* at 5.

[51] *See In re Tam*, 785 F.3d at 570 (panel) (quoting J.A. 57, a Wikipedia entry stating, "We want to take on these stereotypes that people have about us, like the slanted eyes, and own them"). The panel cited this entry as evidence that the mark referred to people of Asian descent—as record evidence introduced by the examining attorney—not as a characterization of the respondent's legal argument.

[52] Brief for the Petitioner, *supra* note 2, at 4 n.4.

was not. The subsequent literature, following the judicial record, neither noticed nor had reason to look.

V. THE AMICUS ECOSYSTEM: COALITION BUILDING AS STRATEGY

A. Building the Coalition

My introduction to amicus briefs was as a legal outsider. When asked to help build an amicus coalition at the Federal Circuit, I initially could not quite parse what that meant or what it required. What I came to understand—in part by trying to recruit organizations with limited legal budgets—is that for many community groups and small nonprofits, filing an amicus brief is prohibitively expensive. The legal infrastructure of appellate advocacy is not accessible to most of the communities most affected by the laws being litigated. This disconnect—between the cost of participating in the legal system and the communities that system most affects—is itself a structural issue that impact litigation scholarship rarely examines.

At the Federal Circuit, we had been focused primarily on technical and evidentiary issues, and community coalition-building had been less central. By the time the case reached the Supreme Court, that changed. I was determined that community voices be part of the record, and I worked actively to bring them in—while also being careful, given the experience with unsolicited co-counsel offers, that organizations understood the arguments we were making before agreeing to support them.

The coalition that ultimately assembled was remarkable in its breadth. Over thirty organizations and individuals filed nineteen briefs in support of the respondent, representing the full ideological spectrum from the ACLU to the Cato Institute. The breadth of that coalition—uniting groups that would typically be opposed on other questions—reflected the genuine First Amendment stakes the case presented.[53]

The significance of a particular alignment within that coalition was probably lost on the government. Nearly every Asian American organization that the examining attorney had cited in the prosecution history to suggest that the band's name was offensive—the JACL, OCAPIA, and others—signed a legal brief in support of the respondent.[54]

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[53] For a full list of amici in support of respondent, *see* Docket, *Matal v. Tam*, 582 U.S. 218 (No. 15-1293).

[54] *See* Brief Amici Curiae of the American Civil Liberties Union et al., *supra* note 13.

B. The NAPABA Brief: How Institutional Decisions Get Made

The National Asian Pacific American Bar Association filed amicus briefs opposing our position at both the Federal Circuit and the Supreme Court.[55] The story of how that came to happen is instructive—not as an account of organizational failure, but as a case study in how institutional decisions in impact litigation can diverge from community reality in ways that the legal process neither surfaces nor corrects.

Prior to the litigation reaching the Federal Circuit, the relationship between NAPABA and The Slants had been a warm one. I had spoken and appeared on panels at NAPABA events, including their national convention in November 2014.[56] The reception among members was enthusiastic, and discussions about future collaboration were underway. That prior relationship was not reflected in the brief that followed.

The decision to file appears to have reflected a confluence of factors internal to the organization at a particular institutional moment—including the strong views of a board member with a prior public position on the case—rather than a settled organizational view or a systematic assessment of the community record. A number of NAPABA members and state chapters disagreed with the decision and communicated that disagreement both privately and publicly. The organization subsequently softened its public framing of the brief, and it has since evolved in its relationship with the issues the case raised.

The amicus brief filed at the Supreme Court itself was written by an attorney who was not an Asian American or a NAPABA member, retained for the purpose. At an Atlanta Inn of Court after the Supreme Court decision, that attorney acknowledged to me that he had not been familiar with the community context of the case and would not have written the brief had he understood it. He had engaged with the narrow constitutional question the Federal Circuit had defined—the same abstraction that had progressively displaced the community record—without

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[55] Brief of Amicus Curiae National Asian Pacific American Bar Association, *In re Tam*, No. 14-1203 (Fed. Cir. 2015); Brief of Amicus Curiae National Asian Pacific American Bar Association, Matal v. Tam, 582 U.S. 218 (No. 15-1293).

[56] NAPABA National Convention, Nov. 2014. The author appeared as a panelist and speaker at this event, before the Federal Circuit litigation had concluded.

knowledge of the evidentiary history or the relationships that gave the case its human dimension. I have chosen not to identify him; the point is the dynamic, not the individual.

The brief was filed under the banner of the Korematsu Center for Law and Equality. Karen Korematsu—Fred Korematsu's daughter and the custodian of his civil rights legacy—told me she supported our position.

What the episode illustrates is a structural feature of how legal institutions engage with impact litigation. The brief-writing process rewarded familiarity with the legal question while providing no mechanism for surfacing the community context that the question had displaced. The attorney who wrote the brief knew the constitutional framework. He did not know about the national survey, the community declarations, the AAYLC documentation, or the years of relationships between The Slants and the Asian American organizations whose positions the brief characterized. The legal system had no pathway for making that context available to him, because it had been progressively removed from the active record as the case narrowed toward the constitutional question. The NAPABA brief is one illustration of a broader pattern: The more a complex community dispute is abstracted into a clean legal question, the more the institutions that engage with it are likely to engage with the abstraction rather than the underlying reality.

C. What the Amicus Record Reveals

The contrast between how institutions processed this case and how the communities most affected by it understood it is visible in the amicus alignment. Nineteen briefs supported the respondent. Four supported the petitioner. Seven supported neither party.

There is a further complexity that the formal record cannot capture. Asian Americans Advancing Justice—AAJC—filed a brief in support of neither party.[57] Their brief argued that applicants wrongly accused of disparagement should be able to "submit evidence of their own reclamation efforts"—a position that I disagreed with as both regressive and inequitable, since it continues to place additional evidentiary burdens on already-burdened communities, with decision-making power remaining in the hands of examining attorneys who had already demonstrated they

[57] Brief for Asian Am. Advancing Just. et al. as Amici Curiae Supporting Neither Party, Matal v. Tam, 582 U.S. 218 (No. 15-1293).

would not credit community evidence.[58] But I understood that AAJC held similar values to ours and that their theory of change was different rather than hostile. And once again, this was based on an interpretation of facts of the case that did not show we had indeed submitted evidence of our own reclamation efforts.

That distinction was lost in press coverage, which characterized the brief as in opposition.[59] It was not. The organization's leadership clarified afterward that they had not been opposed and were open to ongoing work together. That work followed: Through The Slants Foundation, we collaborated on multiple campaigns targeting anti-Asian hate, and their executive director participated in several of our events. The legal record's snapshot of institutional positions—frozen at the moment of filing, then repeated in the press and the secondary literature—was a moment, not a relationship.

VI. WHAT THE CASE ACTUALLY WON— AND THE EVIDENCE THE FEARMONGERS IGNORED

A. The Floodgate Argument

The most consistent criticism of *Matal v. Tam* was the prediction that striking down the disparagement provision would open the trademark system to a flood of hate speech, racial slurs, and offensive marks. This argument was made by advocacy organizations, legal scholars, and minority bar associations—including, at times, organizations that claimed to speak for the communities most likely to benefit from reappropriation.

B. What the Empirical Record Shows

Several years of post-decision data are now available, and they are unambiguous.

Michael Goodyear's empirical study of 144 LGBTQ+-oriented trademark applications filed before and after Tam found that the number of such applications more than doubled following the decision. Affirming uses by in-group members

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[58] *Id.* (arguing that the existing system could accommodate reappropriation claims through evidence of reclamation). The first application's record demonstrates precisely why this argument is insufficient: we submitted extensive evidence of reclamation, and the USPTO dismissed it as "laudable, but not persuasive."

[59] *See, e.g.*, Kat Chow, *What's Next for the Founder of The Slants and the Fight Over Racial Slurs*, NPR: CODE SWITCH (July 6, 2017), https://perma.cc/9GSQ-W5TN (characterizing the brief as among those filed "against Tam").

overwhelmingly predominated: Not a single disparaging use of slurs in trademarks was identified over the entire nine-year study period.[60] The communities the floodgate argument claimed to protect used the ruling as it was intended—to assert their own identities in commerce.

Gibson, Epstein, and Magarian's nationally representative survey, using *Matal v. Tam* as its empirical context, found that when reappropriation motives are perceived, insulting words are judged to be significantly less insulting.[61] This is the social science vindication of what the community evidence had been saying from the first application onward—and what the USPTO had dismissed as "not persuasive."

The psychological literature supports these findings more broadly. Galinsky and colleagues established that self-labeling with a derogatory term increases perceived power for both the labeler and observers—providing the social science framework for reappropriation that the USPTO's examining process had no mechanism to evaluate.[62] Uysal and Acar found that reappropriation of stigmatizing labels among activists is associated with greater willingness to participate in collective action through increased agency, empowerment, and identity change.[63]

C. The Broader Point

The floodgate argument treated the case as a constitutional abstraction. The public did not use it as a vehicle for hate speech. They used it as intended. This outcome makes sense when the case is understood from the inside: The floodgate argument assumed that removing the government's gatekeeping function would empower bad actors. What it missed is that bad actors seeking to deploy hateful imagery rarely route their efforts through the trademark registration system in the first place—and that the communities with the most at stake in how this ruling landed were precisely the ones who had spent years making the affirmative case for reappropriation.

The communities that had been most directly burdened by the disparagement provision were among the first to make use of the ruling. Dykes on Bikes—the San

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[60] Goodyear, *supra* note 6, at 163, 185–92.

[61] Gibson, Epstein & Magarian, *supra* note 6, at 383, 395–97.

[62] Adam D. Galinsky et al., *The Reappropriation of Stigmatizing Labels: The Reciprocal Relationship Between Power and Self-Labeling*, 24 PSYCH. SCI. 2020, 2020–21 (2013).

[63] M.S. Uysal & Y.G. Acar, *Wear It Like Armor and It Can Never Be Used to Hurt You: Reappropriation, Identity Change, and Collective Action*, 46 POL. PSYCH. 548, 548–49 (2025).

Francisco lesbian motorcycle organization whose logo mark application had been placed on hold pending the outcome of *Matal v. Tam*—moved forward with their application within months of the Supreme Court's decision, and the DYKES ON BIKES W M C logo mark was registered in January 2018.[64] Dykes on Bikes had filed an amicus brief in *Matal v. Tam* arguing that they, like The Slants, had chosen to reclaim a self-referential term as a trademark on behalf of the community to which they belonged—and that the First Amendment protected that choice. The human dimension of that fight is worth recording. Soni Wolf, a founding member of Dykes on Bikes who had steadfastly refused to accept "dyke" as a derogatory epithet and had driven the organization's trademark campaign for decades, died in April 2017—two months before the ruling that finally vindicated the effort.[65] The legal literature records the registration dates and the doctrinal outcomes. It does not record what a decades-long fight against an unresponsive administrative process meant to the people who undertake it.

THUNDERPUSSY, the Seattle rock band that had been denied registration on the ground that their mark was scandalous—despite the existence of registered marks with functionally similar terms—successfully registered following *Iancu v. Brunetti*, the 2019 decision that extended *Matal v. Tam*'s logic to the scandalous and immoral provisions. These were precisely the communities—reappropriating language, using defiance to claim identity on their own terms—for whom Section

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[64] DYKES ON BIKES, Registration No. 3,323,803 (registered Oct. 30, 2007) (word mark); DYKES ON BIKES W M C, Registration No. 5,389,061 (registered Jan. 30, 2018) (logo mark). The logo mark application was placed on hold following the USPTO's determination that the same term it had registered as a word mark in 2007 was now "derogatory" when incorporated into a logo. *See Our History*, S.F. DYKES ON BIKES, https://perma.cc/XH8Z-4K2Y (last visited September 30, 2026) ("The USPTO accepted the term Dykes on Bikes in 2007 but when we use the same words in a logo it is rejected as 'derogatory'? EXACTLY!!!"); Brief Amici Curiae of San Francisco Dykes on Bikes Women's Motorcycle Contingent et al. in Support of Respondent, *Matal v. Tam*, 582 U.S. 218 (No. 15-1293).

[65] *See* Jamie Feldman, *Dykes On Bikes Supported Asian-American Band's Fight to Reclaim Racial Slur*, HUFFPOST (June 23, 2017), https://perma.cc/8P98-CNFJ; Diane Anderson-Minshall, *The Supreme Court Loves Dykes on Bikes*, ADVOCATE (May 21, 2018), https://perma.cc/39VN-TP2X (describing Wolf as having "steadfastly refused to accept 'dyke' as an epithet" and having "blazed the trail for the rest of us in courage and LGBTQ pride").

2(a) had functioned as a structural barrier. The post-decision record shows they used the ruling for exactly that purpose.[66]

The legal system assumed throughout this litigation that appeal was always available as a remedy. What it did not account for is what appeal costs in practice. Appellate printing, court filing fees, and legal database access charges accumulate in ways that restructure a litigant's life—and none of them are reimbursable even upon a unanimous Supreme Court victory. The mounting costs of the litigation required the author to leave The Slants as a full-time musician. The band was started to challenge stereotypes and to make music; the case concluded with a landmark First Amendment ruling and the practical impossibility of continuing to do either of those things full-time. That tradeoff is recorded nowhere in the legal literature. It is precisely the kind of fact that only a firsthand account can supply, and the kind of fact that practitioners need to convey honestly if impact litigants are to understand what they are undertaking.[67]

VII. WHAT PRACTITIONERS AND SCHOLARS SHOULD TAKE FROM THIS

Several lessons emerge from this account that do not appear in the existing literature on *Matal v. Tam*—because the existing literature does not have access to the account:

(1) On impact litigation: Impact litigation is not a plan—it is a series of responses to institutional decisions made by courts, agencies, and opposing parties, any of which can transform the case you thought you were bringing. The Federal Circuit decided it wanted to answer a constitutional question and used our case as

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[66] THUNDERPUSSY, Registration No. 6,021,338 (registered following *Iancu v. Brunetti*, 588 U.S. 388 (2019)). The application had previously been refused registration under Section 2(a)'s scandalous marks provision. *See* OXFORD HANDBOOK OF MUSIC LAW AND POLICY (Sean M. O'Connor ed., 2020) (discussing THUNDERPUSSY registration history).

[67] The Lanham Act provides no mechanism for reimbursing successful appellants for the costs of litigation, including court fees, appellate printing, and legal database access fees. 15 U.S.C. § 1117 (authorizing damages only in trademark infringement actions, not in registration disputes). The financial burden of extended trademark litigation falls entirely on the applicant regardless of outcome—a structural feature of the registration system that, as Carpenter and Garner document empirically, weighs most heavily on individual and small-business applicants. *See* Carpenter & Garner, *supra* note 22, at 326 (documenting that Section 2(a) proceedings disproportionately impact individuals and small businesses).

the vehicle. Practitioners advising marginalized community litigants should prepare them for this explicitly, because it has profound consequences for resources, strategy, and community relationships.

(2) On evidence: Knowing when an argument is correct but legally unavailable at a given stage is as important as knowing how to make it. The evidentiary record built for the first application was not wrong—it was being made before an institution that had no mechanism to evaluate it properly. The donated expert services—estimated at $200,000 for the first application alone, and far more across the full appellate record—were not wasted; they documented a reality that the legal system was not yet equipped to credit. That documentation matters for the historical record even when it fails in the immediate proceeding.

(3) On identity and strategy: The identity of the litigant is not incidental to impact litigation strategy—it is central to every major decision, from what evidence to introduce, to whether to accept co-counsel, to how to build an amicus coalition. Scholarship that treats these cases as purely doctrinal exercises misses the most important strategic variables. The decisions described in Section V of this article—each shaped by community values, relational commitments, and principled judgment—do not appear in any brief and have not appeared in any prior account of the case.

(4) On the legal record: Firsthand accounts from litigants are not memoirs—they are evidence. The legal academy's habit of treating the opinion and the briefs as the authoritative record of a case, while treating the litigant's account as personal narrative, produces exactly the kind of errors this article has documented: a "lead singer" who plays bass, a concert "canceled due to controversy" that the organizers described as logistically postponed, a community evidence record dismissed as "not persuasive" and then rendered invisible, and a distorted Wikipedia entry recharacterized as a legal argument in a government Supreme Court brief.

(5) On the complexity of community: Any marginalized community is not a monolith, and courts and commentators who treat it as one will consistently misread the evidence before them. The Asian American community did not, as a whole, oppose The Slants. Multiple surveys, dozens of community organizations, and hundreds of individual leaders supported us throughout the litigation. A smaller number of law professors, attorneys, and institutional actors did not—and their institutional authority meant their opposition was legible to courts and media in ways that diffuse community support often was not.

This dynamic was compounded by media coverage that flattened institutional nuance into false binaries. An amicus brief filed "in support of neither party" was reported as opposition.[68] It was not. There is also a structural observation embedded in the amicus alignment that practitioners should take seriously. The organizations that filed against us were generally led by lawyers and legal scholars—people insulated by professional credentials, institutional affiliation, and resources from the consequences of the policies they were defending. The communities most affected by the disparagement provision—small business owners, artists, and community organizations engaged in reappropriation—were not the ones who filed to maintain it.

(6) On the secondary harms of official disparagement findings: There is a consequence of this litigation that has received no scholarly attention. Throughout the case, at every level, courts were required to accept the finding that The Slants' mark was "disparaging" as a necessary predicate to reaching the constitutional question. This produced a paradox: a unanimous Supreme Court victory that required affirming, at least for purposes of the litigation, that the band's name disparaged the very community it sought to represent. The Court held the mechanism unconstitutional. It did not, and could not, retract the label the mechanism had produced.

(7) On teaching *Matal v. Tam*: Law professors should address what they currently do not: the evidentiary record of the first application and why it failed; the Federal Circuit's sua sponte reframing of the constitutional question and Judge Moore's role in catalyzing it; the strategic decisions made at the Supreme Court phase; and the gap between what the opinion says happened and what actually did. The case is more instructive, and more honest, when taught with these dimensions present.

Conclusion

According to the Supreme Court of the United States, I am the lead singer of The Slants. I am not. I never was. I am the bassist—a fact that is easily verified and has never been corrected in the legal record that now defines the case for every practitioner, scholar, and student who encounters it.

There is an irony in that error that runs deeper than a misidentified instrument. When The Slants first applied for trademark registration in 2010, the band had a different lead singer than when we stood before the Supreme Court in 2017. The

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[68] *See, e.g.*, Chow, *supra* note 60.

legal record does not acknowledge this either. To the institutions that processed the case—the USPTO, the TTAB, the Federal Circuit, the Supreme Court—one Asian American band member was interchangeable with another, in the same way that a general educational brochure could stand in for community consensus, a Wikipedia entry could substitute for a legal argument, and an abandoned application's evidence could be cited without its context. The legal machinery processed proxies and abstractions. The human reality behind them was, in the most literal sense, a secondary source.[69]

This article has argued that this substitutability—of person for person, of document for community, of abstraction for lived reality—is not incidental to how *Matal v. Tam* was processed. It is structural. And it is not unique to this case. It is how legal institutions manage complexity: by reducing the particular to the general, the community to the composite, the individual to the category. That reduction is often necessary for a legal system to function at scale. But in impact litigation involving marginalized communities—where the particular, the community, and the individual are precisely what is at stake—the cost of that reduction is highest, and least often named.

The case did not begin as a First Amendment case. It became one because the Federal Circuit decided it wanted to answer a constitutional question, and our case was available—in part because Judge Moore had spent two decades arguing, first as a scholar and then from the bench, that the disparagement provision was constitutionally untenable. The team leaned into that opportunity because it was the right

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[69] The mechanism documented throughout this article—authoritative documents generating errors that propagate unchecked through legal research systems—is not unique to the pre-digital era. Recent empirical work finds that commercially available AI legal research tools, including Westlaw and Lexis+ AI, hallucinate at substantial rates. One peer-reviewed study found that Westlaw's AI responses contained hallucinations in approximately one-third of queries, while Lexis+ AI produced misleading or false information in more than one in six. *See* Varun Magesh et al., *Hallucination-Free? Assessing the Reliability of Leading AI Legal Research Tools*, 22 J. EMPIRICAL LEGAL STUD. 216, 216–17 (2025); Bakht Munir, *Hallucinations in Legal Practice: A Comparative Case Law Analysis*, INT'L J.L. ETHICS & TECH. (Feb. 24, 2025), https://ssrn.com/abstract=5265375. If practitioners cannot rely on these tools to accurately represent the legal record, the problem this article documents—errors entering authoritative sources and being reproduced without verification—will accelerate rather than diminish. The person at the center of a case remains the most reliable source about that case; the legal system has no mechanism for privileging that account over what the tools report.

opportunity, and because the law needed to change. But the full account of how that change came about—the first application and its evidentiary record, the ethnic-neutral strategy and its reasoning, the decision about co-counsel and who would argue, the management of the amicus coalition, the moot process, the community relationships that the legal record never captured—belongs in the scholarly record too.

Matal v. Tam changed First Amendment law in ways that have benefited the communities the disparagement provision claimed to protect. The empirical evidence on this point is now clear.[70] What remains unclear, because it has never been published, is how the case actually got made. That story matters—not as a corrective to the legal record, which will carry the wrong instrument and the same lead singer until someone changes it, but as a contribution to how practitioners, scholars, and future litigants understand what impact litigation actually requires.

The Court held unanimously that trademark registration is not government speech. But the USPTO's conduct throughout the litigation functioned as speech in every practical sense. The government spoke when it called the mark disparaging. It spoke when it assembled the evidence to support that conclusion—a few keystrokes selecting anonymous message board posts and a celebrity photograph while setting aside national surveys, a linguistics expert, and declarations from community leaders across the country. And when the corrective evidence was submitted, the government did not remain silent: It dismissed it as "laudable, but not persuasive," a formulation that acknowledged the evidence existed while refusing to let it matter. When legal literature subsequently accepted those determinations without examining what had been dismissed, it participated in the same erasure.

The Supreme Court's decision did not retract the label. It held the mechanism that produced it unconstitutional. Those are different things, and the gap between them has real consequences. Band members left, worn down by years of legal battle that had come to overshadow the music the band was formed to make. Years of debt from fees that no winning party in a registration dispute can recover continued accumulating after the decision came down. Community organizations and venue bookers who had been supportive grew cautious, uncertain whether to associate

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[70] *See* Goodyear, *supra* note 6; Gibson, Epstein & Magarian, *supra* note 6; Galinsky et al., *supra* note 63; Uysal & Acar, *supra* note 64.

with a mark a federal agency had officially called disparaging. This is a chilling effect in the technical sense—behavior altered not by prohibition but by the penumbra of official disapproval. The mechanism is familiar from other contexts: When government institutions signal disfavor toward a category of expression or association, private actors recalibrate to avoid proximity to the designated risk, regardless of whether any legal prohibition exists.

A case ends, in the legal sense, when the court issues its decision. It ends in a different sense—in public consciousness, in institutional memory, in the lives of the people who lived it—when people stop talking about it. The legal record assumes those two endings coincide. They rarely do.