

No. 15-1007

IN THE SUPREME COURT OF THE UNITED STATES

UNITED STATES,

Petitioner,

v.

KOURTNEY LUHV,

Respondent.

ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF FOR PETITIONER

TEAM No. 101
COUNSEL FOR THE PETITIONER

QUESTIONS PRESENTED

A. Whether the United States Court of Appeals for the Federal Circuit properly held that under Section 2(a) of the Lanham Act, the trademark DUMB BLONDE may be disparaging when the definition of the term Dumb Blonde is offensive towards blonde women and when a substantial composite of blonde women were offended?

B. Whether the United States Court of Appeals for the Federal Circuit erred in holding that Section 2(a) of the Lanham Act's prohibition on registering marks that may be disparaging violates the First Amendment when the restriction does not constitute government action or an unconstitutional condition on registration, and when the federal trademark registration program is government speech?

PARTIES TO THE PROCEEDINGS BELOW

Petitioner, the United States, represented by the Solicitor General's Office. The Government will argue the Patent and Trademark Office's (PTO) interests in the underlying action before the Supreme Court.

Respondent, Ms. Kourtney Luhv, was the applicant in the review of her case before the T.T.A.B., and was the appellant in the review of her case before the United States Court of Appeals for the Federal Circuit.

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OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit is reported at 1337 F.3d 450. The opinion of the Trademark Trial and Appeal Board (T.T.A.B.) is signed with the number 18201565.

JURISDICTION

The judgment of the court of appeals was entered on June 6, 2015. The petition for a writ of certiorari was filed and granted by this Court. The jurisdiction of this Court rests on 28 U.S.C. § 1254(1).

STATEMENT OF THE CASE

Ms. Kourtney Luhv known by her stage name DUMB BLONDE, is a vocalist and solo artist. *In re Kourtney Luhv*, 1337 F.3d 455, 455 (Fed. Cir. 2015). In June 2014, she finished recording several music pieces intended to be released as an extended play format record via a record label. *Id.* at 456. Ms. Luhv successfully negotiated a recording deal with a record label that would include a \$2,000,000 advance upon execution of the agreement. *Id.* The agreement had a clause requiring that she register the mark, DUMB BLONDE. *Id.*

On July 9th, 2014, Ms. Luhv filed the Application No. 99/989,052 (“052 application”) with the Patent and Trademark Office (“PTO”), seeking to register DUMB BLONDE for entertainment namely live performances by a musical band and clothing namely, sweatshirts, t-shirts, tank tops and headwear. *Id.* Upon review of the 052 application, the examining attorney declined to register the mark,

pursuant to Section 2(a) of the Lanham Act (“Section 2(a”). *Id.* Ms. Luhv appealed the decision to the Trademark Trial and Appeal Board (“T.T.A.B.”). *In re Kourtney Luhv*, 1337 F.3d 455, 456 (Fed. Cir. 2015). The T.T.A.B. affirmed the examining attorney’s decision stating that the mark “may be disparaging to a substantial composite of the referenced group, namely women who have a blonde hair color.” *Id.* The T.T.A.B. cited photograph images from Ms. Luhv’s website. *Id.* at 457. One depicted a blonde woman eating plastic food and another a blonde woman applying White-Out® to text displayed on her computer monitor. *Id.* The T.T.A.B. also held that the mark may disparage a substantial composite of women because dictionary definitions, numerous articles, and user comments on Ms. Luhv’s uTube page support the fact that women find the phrase “dumb blonde” to be offensive. *Id.*

Ms. Luhv has been performing under her stage name DUMB BLONDE since 2012, appearing at venues in Southern Calidonia region and several other states. *Id.* at 455. Her music incorporates elements from Grindcore, Neurofunk, and American Folk music genres, and her lyrics focus on issues faced by women in today’s society. *Id.* Respondent has a fan base that attends her concerts and who follow her music on the online streaming service at www.soundpuff.com (“Soundpuff”). *In re Kourtney Luhv*, 1337 F.3d 455, 456 (Fed. Cir. 2015). Respondent also, registered an account under the name DumbBlondeMusic to post videos and share music production-related tips. *Id.* At the time she filed her application for trademark registration, she had over 40,000 followers on Soundpuff and over a 100,000 subscribers on her uTube channel. *Id.* Ms. Luhv contends that she chose to

use DUMB BLONDE to reclaim the stereotype associated with blonde women and raise awareness of the challenges stemming from gender discrimination and negative stereotypes faced by all women. *Id.* at 457.

Ms. Luhv appealed the T.T.A.B.'s decision to the U.S. Court of Appeals in the Federal Circuit, claiming that the views of women cited by the examining attorney do not represent the views of her fans or a substantial composite of blonde women. *Id.* Ms. Luhv also argued that Section 2(a)'s prohibition on registering marks that may be disparaging is unconstitutional. *In re Kourtney Luhv*, 1337 F.3d 455, 460 (Fed. Cir. 2015). The U.S. Court of Appeals in the Federal Circuit affirmed the T.T.A.B.'s decision, stating that DUMB BLONDE may be disparaging to blonde women, and held that Section 2(a) was unconstitutional. *Id.* Both issues were preserved to the Supreme Court and Certiorari was granted. *Id.*

SUMMARY OF THE ARGUMENT

This Court should affirm the Court of Appeals' rejection of Kourtney Luhv's ("Ms. Luhv") application to register DUMB BLONDE pursuant to Section 2(a). While the appellate court accurately ruled on the question of whether the mark was disparaging, it erroneously ruled on the question of whether Section 2(a) is constitutional. This Court should reverse the lower court's erroneous finding that Section 2(a) is unconstitutional.

The Court of Appeals properly applied the two-prong *Geller* test in finding that the mark was disparaging. The *Geller* test requires courts to analyze: (1) the

dictionary definition of the term DUMB BLONDE, and the meaning of the mark in the context of the marketplace; and (2) whether the term offends a substantial composite of the referenced group, namely blonde women.

The court accurately held that the mark was disparaging because the likely meaning may be offensive to a substantial composite of blonde women. First, the dictionary definition of the word “dumb blonde” implies a negative, offensive, and insulting stereotypical view of women. There was substantial evidence to support a finding that the mark may also be disparaging in the context of the marketplace. Second, substantial evidence such as comments on Ms. Luhv’s uTube channel supports the court’s finding that a substantial composite of blonde women were offended by the mark.

The appellate court erroneously held that Section 2(a) is unconstitutional. First, Section 2(a) is constitutional because when a mark is denied, the mark owner is in no way prohibited from continuing to use the mark. Therefore, no tangible form of expression is suppressed. Second, the Lanham Act does not impose an unconstitutional condition on mark registration. Third, the federal trademark registration process is separate from the use of the mark itself. While the use of the mark is commercial speech, the registration of the mark is government speech, which is not subject to First Amendment scrutiny. Finally, even if this Court found that Section 2(a) restricted private speech, it would find that it is a valid regulation of commercial speech under the *Central Hudson* Test.

Therefore, this Court must find that the PTO examining attorney properly restricted Ms. Luhv from registering the mark, DUMB BLONDE and uphold the findings of the T.T.A.B. and the Court of Appeals for the Federal Circuit. While the Court of Appeals for the Federal Circuit properly ruled on the application of Section 2(a), it was erroneous in finding that Section 2(a) violated the First Amendment of the United States Constitution. Therefore, this Court must reverse its finding and uphold the constitutionality of Section 2(a).

ARGUMENT

I. DUMB BLONDE IS DISPARAGING TO BLONDE WOMEN WITHIN THE MEANING OF SECTION 2(A) OF THE LANHAM ACT.

The examining attorney at the Patent and Trademark Office (“PTO”) properly determined that the mark, DUMB BLONDE, is offensive and may be disparaging to a substantial composite of blonde women. *See* 15 U.S.C. § 1052(a) (2006) (prohibiting the registration of any trademark that “[C]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage.”). Also, the Trademark Trial and Appeal Board (“T.T.A.B.”) properly denied the registration of DUMB BLONDE pursuant Section 2(a) of the Lanham Act’s (“Section 2(a)”) restriction on marks that may be disparaging. *Id.* Therefore, this Court should find that the U.S. Court of Appeals for the Federal Circuit properly applied the *Geller* test in affirming that DUMB BLONDE is disparaging pursuant to Section 2(a).

The *Geller* test requires that courts look at: (1) the likely meaning of the mark considered in connection with the goods and services and (2) whether the meaning may be disparaging to a substantial composite of the referenced group. *See*

In re Geller, 751 F.3d 1355, 1358 (Fed. Cir. 2014). Pursuant to this test, the court must determine the referenced group, by looking to “the perceptions of ‘those referred to, identified or implicated in some recognizable manner by the involved mark.’” *See Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124 (D.C. 2003) (citations omitted).

Based on its application of the *Geller* test, the T.T.A.B. properly affirmed the PTO’s decision to deny the registration of DUMB BLONDE, pursuant to Section 2(a). *In re Kourney Luvv*, 1337 F.3d at 457. Courts must give deference to lower courts when they act as fact finders and fact triers. *See B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293 (2015). Since the fact triers (T.T.B.A. and appellate court) are in a better position to determine factual contentions and reach conclusions based on factual based allegations, this Court should give deference to the lower court and affirm the finding that DUMB BLONDE cannot be registered because is disparaging and violates Section 2(a).

A. THE TERM DUMB BLONDE IS DISPARAGING BECAUSE ITS DEFINITION AND ITS USE IN THE MARKETPLACE IS OFFENSIVE TOWARDS BLONDE WOMEN.

The first prong of the *Geller* test is to determine the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter with the goods and services described in the application for registration. *See In re Geller*, 751 F.3d at 1355, 1358 (holding that the mark STOP THE ISLAMISATION OF AMERICA is disparaging based on its dictionary definition); *see also In re Heeb Media, LLC*, No. 78558043, 2008 T.T.A.B. LEXIS 65,

at*1, *9 (Nov. 26, 2008) (holding the dictionary definition of HEEB considered in the marketplace in relation to the goods was disparaging towards Jewish people); *See Pro-Football, Inc.*, 284 F. Supp. 2d 96, 124 (holding that the definition of the mark is disparaging towards Native Americans). For purposes of Section 2(a), a mark is disparaging when its dictionary definition and its use in the marketplace tends to be offensive. *See In re Geller*, 752 F.3d at 1355; *see also In re Squaw Valley Development Co.*, No. 76511145, 2006 WL 1546500 (T.T.A.B. 2006) (holding that the mark SQUAW is disparaging towards Native American Women). To meet the evidentiary burden of demonstrating that a mark is disparaging the T.T.A.B. must look at the dictionary definition, the context in which the mark may be used, and the segment of people to whom the mark would be directed without considering the intention of the applicant. *In re Heeb Media, LLC*, 2008 T.T.A.B. LEXIS 65 at *13 (HEEB as defined by the dictionary is an offensive word towards Jewish individuals).

1. DICTIONARY DEFINITION OF DUMB BLONDE IS OFFENSIVE.

In *In re Geller*, the T.T.A.B. looked at dictionary definitions in deciding to deny registration of the mark “STOP THE ISLAMISATION OF AMERICA” on the basis that it was disparaging. 752 F.3d at 1355. The T.T.A.B. denied the registration based on dictionary searches of the word “islamization.” *Id.* The T.T.A.B.’s textual analysis of the mark concluded that the mark associated American Muslims with terrorism and that it “[S]ets a negative tone and signals that Islamization is

undesirable and is something that must be brought to an end in America.” *Id.* at 1357.

In this case, the definition of DUMB BLONDE is offensive because it degrades a person’s cognitive skills based solely on their physical appearance. First, “dumb” is defined as “a person often offensive: lack of intelligence” and therefore has an inherent offensive connotation.¹ Second, the term “blonde” refers to “a person with a yellow or very light hair color.”² The two words become even more offensive when they are combined to create the term “Dumb Blonde.” The term Dumb Blonde is commonly directed towards women and is understood to mean “Someone who can't do anything without messing it up.”³ Similar to *In re Geller*, the definition of Dumb Blonde may be disparaging to blonde individuals, as it stereotypes them as lacking intelligence or overall skills based solely on their physical appearance.

Furthermore, the word dumb sets a negative tone. It signals that being blonde is undesirable and can create a stigma on an individual based only in the color of his or her hair. A mark that creates or relies on stigmatization is wrong in its face. *See Anita Bernstein, What’s Wrong With Stereotyping?*, 55 *Ariz. L. Rev.* 655, 659 (2013) (“The answer explored in this article is that stereotyping is wrong to the extent that it functions to deprive individuals of their freedom without a good cause.”). A

¹ *See Dumb*, Merriam-Webster Dictionary, <http://www.merriam-webster.com/dictionary/dumb> (last visited Sept. 27, 2015).

² *See Blonde*, Merriam-Webster Dictionary, <http://www.merriam-webster.com/dictionary/blonde> (last visited Oct. 10, 2015).

³ *See Dumb Blonde*, UrbanDictionary, <http://www.urbandictionary.com/define.php?term=Dumb+Blonde> (last visited Sept. 27, 2015).

stereotype based on an individual's looks cannot be registered because is offensive and disparaging. *In re Squaw Valley Development Co.*, No. 76511145, 2006 WL 1546500 (T.T.A.B. 2006). Ms. Luhv contends that she "chose the mark DUMB BLONDE as a way to reclaim the stereotype associated with blonde woman and raise awareness of the challenges stemming from gender discrimination and negative stereotypes faced by all women." *In re Kourtney Luhv*, 1337 F.3d at 457. However, the T.T.A.B. correctly relied on photographic images from Ms. Luhv's website that depict a blonde woman eating plastic fruit, and another a blonde woman applying White-Out to text displayed on her computer monitor to determine that Ms. Luhv is relying on an existing stereotype to market her music and to make profit out of it. *Id.*

Although Ms. Luhv has stated that she wants to change the stereotype, she has failed to take adequate action to make young women reconsider the stigma suffered by blonde women. To the contrary, she is furthering the stereotype by injecting imagery of blonde women performing acts that display a lack of intelligence and commonsense. Therefore, the PTO, the T.T.A.B., and the appellate court properly denied registration of the mark.

2. THE MEANING OF DUMB BLONDE IS OFFENSIVE IN THE CONTEXT OF THE MARKETPLACE.

A mark is disparaging if is likely to offend when put in the context of the products and services in connection with the marketplace. *In re Heeb Media, LLC*, 2008 T.T.A.B. LEXIS 65, at *13. This means that courts must look at the "relationship of the matter to the other elements in the mark, the nature of the

goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services.” See *In re Geller*, 751 F.3d at 1358 (citation omitted); *In re Heeb Media, LLC*, 2008 T.T.A.B. LEXIS 65, at *13.

In *In re Heeb*, Heeb Media LLC filed an application to register the mark “HEEB” for “clothing, namely, jackets, jerseys, sweat pants, sweat shirts, t-shirts [...] and entertainment.” *Id.* Despite the applicant’s allegation that the use of “means a symbol of pride and progressive identity among today’s Jews,” the T.T.A.B. held the mark was disparaging based on the use of the mark in connection with applicant’s goods and services. *Id.* at 3. The T.T.A.B. held that the mark “HEEB” is disparaging because its use in products, especially t-shirts, did not provide further context to show HEEB was being used to show Jewish pride, rather than demonstrate anti-Semitism. *Id.* at 21. Therefore, the subjective intention of the applicant is irrelevant when determining whether the mark is disparaging. *Id.* Instead courts must only look at whether the mark is objectively offensive to the targeted group. *Id.* (stating that the “the fact that applicant has good intentions with its use of the term does not obviate the fact that a substantial composite of the referenced group find the term objectionable.”).

Just as in *In re Heeb*, DUMB BLONDE is intended to protect the commercialization of clothing, namely, t-shirts among other items, and entertainment. *In re Kourtney Luhv*, 1337 F.3d at 456. Like the applicant in *In re Heeb*, Ms. Luhv stated that her mark was not meant to be offensive. *Id.* at 457. However, the mark is still disparaging. The T.T.A.B. met its burden of showing that

the use of DUMB BLONDE in the context of the products Ms. Luhv seeks to commercialize did nothing to prove the mark was meant to show pride rather than be offensive to blonde woman. For example, the court in *In re Heeb* stated that the meaning of the mark HEEB on a T-shirt, is more ambiguous because T-shirts do not enrich the context in which to consider the meaning of the word. *In re Heeb Media, LLC*, 2008 T.T.A.B. LEXIS 65, at *20. The use of DUMB BLONDE on t-shirts would have the same outcome as *In re Heeb* because the use of term DUMB BLONDE on t-shirts would not provide the context in which to consider the meaning of the mark beyond its already offensive stereotype meaning. The use of Dumb Blonde in relation to the products and services in the marketplace would inevitably lead to the conclusion that the mark is disparaging.

DUMB BLONDE has not fulfilled the first prong of the *Geller* test. The mark's dictionary definition is offensive and disparaging. Further, the meaning of the mark within the marketplace is also disparaging since its use does nothing to mitigate its objective meaning to offend blonde women. Not only does the likely meaning of DUMB BLONDE meet the first prong of the *Geller* test, the mark also meets the second prong because it is offensive to a substantial portion of an identifiable group of blonde women.

B. THE TERM DUMB BLONDE IS DISPARAGING TO A SUBSTANTIAL COMPOSITE OF BLONDE WOMEN TOWARDS WHOM THE TERM IS DIRECTED.

The second prong of the *Geller* test requires considering whether the meaning of the mark is referring to identifiable persons, institutions, beliefs or national

symbols, whether that meaning may be disparaging to a substantial composite of the referenced group. *See In re Geller*, 751 F.3d at 1360; *In re Heeb Media, LLC*, 2008 T.T.A.B. LEXIS 65, at *9 (Heeb is a word offensive to Jewish individuals); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1998) (a disparaging mark requires that the communication would be reasonably understood as referring to the plaintiff). The proper ground for refusing marks that would offend the sensibilities of a group is that the matter is disparaging to members of that referenced group. *See In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1, 1 (T.T.A.B. 2010) (holding that the mark must only be disparaging to a substantial composite of the referenced group not the general public); *see also In re Squaw Valley Development Co.*, No. 76511145, 2006 WL 1546500 (T.T.A.B. 2006) (affirming the Board's denial of the registration of the mark "Squaw" because evidence demonstrated that a substantial composite of Native American women would find applicant's mark disparaging).

DUMB BLONDE is directed towards a specific group of people, namely blonde women. *In re Kourtney Luhv*, 1337 F.3d at 457. Pursuant to the rule set forth in *In re Lebanese*, the analysis of disparagement has to be done from the standpoint of blonde women. *See In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) at 4. The U.S. Court of Appeals held that DUMB BLONDE was disparaging based on "significant evidence suggest[ing] that women view dumb blonde jokes negatively." *In re Kourtney Luhv*, 1337 F.3d at 457 (citing Karen Ross, *The Handbook of Gender, Sex, and Media* 88 (John Wiley & Sons, Sept. 7, 2011)). The court also relied on

comments made by user on respondent's uTube videos that suggested blonde woman find the term dumb blonde offensive. *Id.*

Based on the evidence presented, a substantial composite of the referenced group find DUMB BLONDE to be offensive. Therefore, registration was properly bared. Similar to *In re Squaw Valley*, where the T.T.A.B. affirmed the denial of the mark Squaw because it was disparaging to Native American Women, DUMB BLONDE is offensive to women who have blonde hair. *Id.* In this case, the Court should apply the same reasoning and deny registration of DUMB BLONDE. There is sufficient evidence to conclude that the dumb blonde stereotype is offensive to blonde woman, and that indeed blonde woman feel offended by DUMB BLONDE. *In re Kourtney Luhv*, 1337 F.3d at 456.

Ms. Luhv could argue that her case is more in line with *In re San Francisco Women's Motorcycle Contingent Appeal*, where the mark, "Dykes on Bikes," was registered even though it could have been considered disparaging. *In re San Francisco Women's Motorcycle Contingent Appeal*, No. 000020-007200US (T.T.A.B. Sept. 15, 2005). However, "Dykes on Bikes" was directed at a much more narrowly defined group of women. In that case the mark was directed at women, who were gay, and who road motorcycles. In the present case, the composite group is much larger as it is directed to all blonde women. *In re Kourtney Luhv*, 1337 F.3d 457.

Finally, the Court should not take a "wait-and-see" approach. Respondent may rely on *The Memphis Mafia* case where the court held that if a mark is considered disparaging, a member of the referenced group should oppose the registration.

Order Sons of Italy in America v. The Memphis Mafia, Inc., 52 U.S.P.Q.2d (BNA) 1364, 1366 (1999). The policy argument behind the wait and see approach is not valid when enough evidence has been presented demonstrating that DUMB BLONDE is offensive. *In re Kourtney Luhv*, 1337 F.3d at 457 (multiple people posted their discomfort with Ms. Luhv's mark). Especially when, the mark carries a negative connotation that could create a stigma on the targeted group, in this case, blonde women. The comments individuals made on Ms. Luhv's uTube channel and website, demonstrated that a substantial composite of blonde women were offended by the mark. *In re Kourtney Luhv*, 1337 F.3d at 457. This Court should allow the examining attorney to prevent marks that are proven to be disparaging to be even published as part of the registration process. If the court limits the power of examining attorneys to prevent a mark to damage the reputation of an identified group for the sole benefit of the applicant, the PTO would lose ground in fighting disparaging, immoral or scandalous marks.

II. THE TRADEMARK OFFICE'S REFUSAL TO REGISTER DUMB BLONDE PURSUANT TO SECTION 2(A) IS CONSTITUTIONAL.

The Court should reverse the appellate court's erroneous divergence from twenty years of well-developed precedence and uphold the constitutionality of Section 2(a). *See In re McGinley*, 660 F.2d 481, 484 (Ct. Cust. App. 1981) (citations omitted). Determination of the constitutionality of a statute presents a question of law over which this Court must exercise *de novo* review. *Bose Corp. v. Consumers Union of U.S., Inc.*, 466 U.S. 485, 503-11 (1984) (independent fact review in First Amendment cases "reflects a deeply held conviction that judges...must

exercise such review in order to preserve the precious liberties established and ordained by the Constitution.”); *see also N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 285 (1964). To avoid an unconstitutional infringement of an individual’s rights, the Court must determine whether registering a trademark with the PTO is a right protected by the First Amendment based on all of the facts and circumstances. *N.Y. Times Co.*, 376 U.S. at 285.

In *In re McGinley*, the U.S. Court of Customs and Patent Appeals held that the PTO’s refusal to register an applicant’s mark does not infringe upon the mark owner’s First Amendment rights because “[n]o conduct is proscribed, and no tangible form of expression is suppressed.” 660 F.2d at 484. While this is an issue of first impression for the Supreme Court, the Federal Circuit has consistently adopted this precedent, holding that Section 2(a) does not condition a benefit of trademark registration on the relinquishment of protected speech. *See, e.g., In re Fox*, 702 F.3d 633, 640 (Fed. Cir. 2012) (affirming refusal to register mark under Section 2(a)); *Ritchie v. Simpson*, 170 F.3d 1092, 1099 (Fed. Cir. 1999) (“denial of federal registration of a mark does not prohibit the use of that mark”). Section 2(a) does nothing to offend the core principles of free speech because the mark owner is still able to use the mark in commerce or discuss it in society. *In re McGinley*, 660 F.2d at 484; *Thornhill v. Alabama*, 310 U.S. 88, 101 (1940) (the right of free expression is meant to remove Government imposed restraints from public discussion by placing the decision as to what views shall be voiced in the hands of individuals).

The registration process is separate from the actual use of the mark. As such, Section 2(a) is only relevant to the trademark registrations process, not a mark owner's right to use his or her mark. *In re McGinley*, 660 F.2d at 484 (reflecting that registration is independent the use of a mark); *Volkswagenwerk v. Wheeler*, 814 F.2d 812, 819 (1st Cir. 1987) ("rights to a mark do not arise out of registration.") (*Wheeler*). The Court cannot find that Section 2(a) violates the First Amendment unless it meets three requirements. First, the speech in question must be a protected speech. *See, e.g., Roth v. United States*, 354 U.S. 476, 481 (1957). Second, the government must have taken some action to restrict that protected speech in a manner that implicates the First Amendment. *See, e.g., Texas v. Johnson*, 491 U.S. 397, 405 (1989) (a government ban on flag burning constitutes the government action requirement). Third, the restriction on speech must be found unconstitutional when analyzed under the appropriate framework. *See Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 566 (1980).

Section 2(a) does not violate the First Amendment because it does not meet the three necessary requirements. First, the federal trademark program is Government speech and is not subject to First Amendment scrutiny. *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015)) (articulating the three part test to determine whether the controversial speech is government speech); *Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550, 562-67 (2005) (stating that government speech is not subject to First Amendment scrutiny). Second, there is no government action because the PTO's refusal to register an appellant's mark does

not affect his right to use it. *See e.g., In re McGinley*, 660 F.2d at 484. Additionally, Section 2(a) does not impose an unconstitutional condition on the trademark registration process. *See Rust v. Sullivan*, 500 U.S. 173, 193-94 (1991) (defining an unconstitutional condition). Third, even if the Court finds that Section 2(a) restricted commercial speech and that denial of registration constitutes government action, Section 2(a) would still be a valid regulation of speech under *Central Hudson* because it is narrowly tailored to directly advance the Government's substantial interest in dissociating itself from speech that may disparage. *See generally Central Hudson Gas & Elec. Corp.*, 447 U.S. 557 (1980).

A. DENYING FEDERAL REGISTRATION OF THE MARK, DUMB BLONDE, DOES NOT CONSTITUTE GOVERNMENT ACTION.

1. MS. LUHV'S RIGHT TO ENJOIN OTHERS FROM USING DUMB BLONDE IS NOT PROTECTED BY THE FIRST AMENDMENT.

The PTO merely impacted Ms. Luhv's ability to restrict the speech of others because denying registration of DUMB BLONDE only affected her ability to invoke the procedures provided by the Lanham Act to enjoin others from using the mark. There is no right to enjoin others from speaking under First Amendment right. U.S. Const. amend. I. In fact, the Supreme Court has explained that a trademark-owner's ability to enforce a trademark is not a right protected by First Amendment. *In re Int'l Flavors & Fragrances, Inc.*, 183 F.3d 1361, 1368 (Fed. Cir. 1999) (“[t]here is no constitutionally protected right to federal registration of any mark.”). Rather, the right to enforce a trademark is a common law and statutory right that is a

permissible restriction on commercial speech rights of the public. *See San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 534-40 (1987).

Restricting Ms. Luhv from registering DUMB BLONDE does not affect *her* First Amendment speech rights. The PTO's refusal to register the mark merely restricts Ms. Luhv's ability to limit the speech of others by denying her protection under the Lanham Act. Therefore, Section 2(a) does not constitute the Government taking action to restrict First Amendment protected speech and consequently, does not violate the First Amendment facially, nor as applied to this case.

2. SECTION 2(A) DOES NOT IMPOSE AN UNCONSTITUTIONAL CONDITION ON TRADEMARK REGISTRATION.

Section 2(a) establishes a permissible condition on participation in the Government's trademark registration program. Section 2(a) does not fall under the Unconstitutional Conditions Doctrine for two reasons. First, Section 2(a) simply defines the limits of the federal trademark registration program, which the Government created and manages. Second, its restrictions do not leverage speech outside the contours of the program because a refusal to register a mark does not preclude the applicant from any substantive benefit.

a) WHEN THE GOVERNMENT CREATES AND MANAGES ITS OWN PROGRAM IT HAS THE RIGHT TO DETERMINE ITS CONTENTS AND LIMITS.

When the Government creates and manages its own program, it has the right to determine the contents and limits of that program, without violating the First Amendment, even where a private component of speech exists. *See Rust*, 500 U.S. at

193-94 (1991) (“a legislature’s decision not to subsidize the exercise of a fundamental right does not infringe the right.”); *see also Regan v. Taxation with Representation of Wash.*, 461 U.S. 540, 549 (1983) (holding that Congress’ decision not to subsidize the exercise of a fundamental right does not infringe upon that right); *Planned Parenthood of S.C., Inc. v. Rose*, 361 F.3d 786, 795-96 (4th Cir. 2004). In enacting the Lanham Act, Congress created a federal program managed by the PTO. 15 U.S.C. § 1051 *et seq.* (“Lanham Act”). The program provides separate procedure, protections, and remedies for preexisting trademark rights, which arise independently from use. *Id.* Having created and undertaken to manage its own program for existing trademark rights, Congress can determine the program’s contents and limits by determining which types of marks may be registered. *See generally Rust*, 500 U.S. at 173. Moreover, nothing in the federal trademark program seeks to leverage its coverage to regulate any speech outside of the contours of the program because owners remain free to use any mark. *See Agency for Int’l Development v. Alliance for Open Society Int’l. Inc.*, 133 S. Ct 2321, 2328 (2013) (“*Open Society*”); *see generally Rust*, 500 U.S. 173 (1991) (holding that the program was constitutional because it did not prohibit recipients of funding from performing activities prohibited by the program independently).

The Government’s right to determine the limits of its own programs is not limited to programs that provide financial subsidies, the Government need only provide something valuable in the form of registration. The unconstitutional conditions inquiry does not depend on whether a Government program is funded by

general revenues of the Treasury or through a special fund collected from program applicants. *See, e.g., Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550, 562-67 (2005). In *Johanns*, the Supreme Court held that since the Government created and managed the beef promotion program there was no violation of the beef producers' First Amendment rights, even though the program was funded by "a targeted assessment on beef producers, rather than by general revenues." *Id.*

Therefore, the PTO's refusal to register DUMB BLONDE pursuant to Section 2(a) does not violate Ms. Luhv's First Amendment rights because Congress is simply implementing limitations on the federal trademark registration program, which it created and manages. *See Rust*, 500 U.S. at 193; *see also Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 588 (1998) (holding that it does not violate the First Amendment for such programs to convey a message of "decency" and "respect" for others).

b) SECTION 2(A) DOES NOT LEVERAGE PRIVATE SPEECH OUTSIDE THE CONTOURS OF THE FEDERAL TRADEMARK REGISTRATION PROGRAM.

While the Government has a right to define the limits of a program that it created and manages, it cannot restrict activities of program participants acting as private individuals. *Perry v. Sindermann*, 408 U.S. 593, 597 (1972) (holding that the Government may not deny a benefit to an individual on a basis that infringes a constitutionally protected interest). Section 2(a) restrictions do not impact the First Amendment Rights of applicants such as Ms. Luhv because the restrictions are limited to the confines of the registration program and the Lanham Act does not create any substantive rights that the mark owner did not already have.

In *Rust*, the Supreme Court considered whether regulations restricting the use of funds by grantees under Title X of the Public Health Act violated the First Amendment. *See generally* 500 U.S. 173. The regulations prohibited doctors from engaging in any activity advocating abortion in Title X projects. *Id.* at 196. However, the program did not prohibit such activities when performed in programs independent from Title X projects. *Id.* The Court held that the regulations were constitutional because they were “designated to ensure that the limits of the federal program are observed.” *Id.* at 193. Like the restrictions defined in the program in *Rust*, Section 2(a) only restricts speech within the limits of the federal trademark registration program. § 1125. Just as the doctors in *Rust* could advocate for abortion when acting outside the scope Title X, owners of marks that are not eligible for registration pursuant to Section 2(a) can still use their marks and seek protection outside the scope of the Lanham Act. § 1125; *Wheeler*, 814 F.2d at 819 (“[r]efusal by the PTO to register a mark does not preclude the owner of the mark from his right to use it.”).

Furthermore, the denial of registration is not so coercive that the owner has no choice but to abandon its mark. *See Grove City Coll. v. Bell*, 465 U.S. 555, 575-76 (1984). The mark-owner may seek protection of their mark from two other sources: state registration, or the common law. § 1125; *Wheeler*, 814 F.2d at 819. While many states have trademark registration statutes that mirror the Lanham Act, protection is still available pursuant to common law. Model State Trademark Act, § 2 (1964). At common law, the right to a trademark grows out of its use. *See, e.g.,*

United Drug Co. v. Theodore Rectannus Co., 248 U.S. 90, 99 (1918). The closest parallel to trademark registration is the common law right to call one's self by a name of one's own choosing. While an individual has the right to name his or herself, the government may regulate access to official registration of name changes. See, e.g., *In re Petition of Variable for Change of Name*, 190 P.3d 354, 356 (N.M. Ct. App. 2008) (holding that denial of name change request does not infringe on the right to free speech because, he may still "use any name at all"). Once a trademark is adopted and then used in connection with goods or services, the common law creates an enforceable right of exclusivity for the mark's owner in the geographic area in which the mark is used.

Therefore, the Lanham Act does not create any substantive rights that the mark owner did not already have.

A trademark is not a grant, does not spring up through registration as do patents and copyrights, but is a right growing out of use. *United Drug Co. v. Theodore Rectanus Co.*, [248 U.S. 90, 99 (1918)]. The federal trademark statutes did not attempt to create exclusive rights in marks, but attempted to provide appropriate procedure and to give protection and remedies for rights that already existed....

Willson v. Graphol Prods. Co., 188 F.2d 498, 501-02 (Ct. Cust. App. 1951). Denial of registration pursuant to Section 2(a) cannot cause the loss of any rights because the Lanham Act does not confer any trademark rights beyond what the owner already had, *In re McGinley*, 660 F.2d at 484.

B&B Hardware, Inc., did not change the fact that the benefits of registration are procedural rather than substantive. Compare *B&B Hardware, Inc.*, 135 S. Ct. at 1300, and *Walmart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000) (stating

that participation in the Lanham primarily confers procedural advantages that mitigate the challenges of trademark enforcement under state law). While the Court referred to the “benefits of registration” and stated the Lanham Act as confers “important legal rights and remedies” on owners who register, such registration only provides access to procedural devices such as constructive notice of ownership, *prima facie* evidence of validity and ownership, and a possible incontestable right to use the registered mark. *See generally* Lanham Act; *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 319-20 & n. 6 (Ct. Cust. App. 1976). Registration does not change the source or nature of trademark rights; it merely makes it easier to use federal mechanisms to obtain remedies for the rights that the owner already had. *See United Drug*, 248 U.S. at 99.

Section 2(a) defines the registration program, but does not limit or restrict a trademark owner’s speech. *Open Society*, 133 S. Ct. at 2330. Under *Open Society*, the relevant question is whether the Government compels the trademark owner to speak or to refrain from speaking in anyway by issuing or denying registration. 133 S. Ct. 2321 (2013). This court must find that the answer to this question, is “NO” because the applicant can continue to use the disparaging mark and maintains the ability to register other marks that do not contain disparaging matter. While the Lanham Act may offer benefits for marks that satisfy registration criteria, it does not burden the use of marks that are not. *See Wheeler*, 814 F.2d at 819; *In re McGinley*, 660 F.2d at 484.

Congress created and manages the federal trademark registration program. It is not constitutionally required to participate in the protection of marks that may be disparaging to certain groups of individuals. It is free to decide which marks it approves pursuant to provisions such as Section 2(a), which allow the government to exercise editorial discretion without impacting the use of the marks. Ms. Luhv suffered no violation of her First Amendment rights. The PTO office acted within its rights when it decided not to approve the registration of DUMB BLONDE because it may be disparaging to a substantial composite of women with blonde hair. Furthermore, Ms. Luhv may continue to use the mark and seek protection under common and state law.

B. ISSUING TRADEMARK REGISTRATION FALLS WITHIN THE GOVERNMENT SPEECH DOCTRINE.

The use of a trademark is distinct and separate from the PTO's registration and publication process. *See In re McGinley*, 660 F.2d at 484 (reflecting that the registration process is independent from the use of the mark). While use of the mark is constitutionally protected commercial speech, the federal trademark registration process constitutes government speech. *See Briggs & Stratton Corp. v. Baldrige*, 728 F.2d 915, 917-18 (7th Cir. 1984) (explaining that the "hallmark of commercial speech" is that it "pertains to commercial transactions," including those "facilitated through the use of a trademark"); *see also Pro-Football, Inc. v. Blackhorse*, 2015 WL 4096277, at *11-15 (E. D. Va. July, 8, 2015) (holding that the federal trademark registration program is government speech). When marks are approved through the federal trademark registration program they "are published

in the Official Gazette of the PTO and the Principal Register in order to inform the public of marks registered with the federal government.” §§ 1051-1072. The publication of the mark in the Official Gazette of the PTO and Principal Register is Government speech and distinct from the commercial speech expressed by the actual use of a mark, which is not affected by the success of the registration itself. *See In re McGinley*, 660 F.2d at 484 (holding that the owner’s use of a mark is not impacted when the PTO refuses to register it pursuant to Section 2(a)). Registration is not commercial speech because it does not propose a commercial transaction. *See Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410, 423 (1993) (citation and internal quotation marks omitted) (noting that the proposal of a commercial transaction is “the test for identifying commercial speech.”).

The test for determining whether the Government Speech Doctrine applies supports a finding that the federal trademark registration program is government speech. *See Walker*, 135 S. Ct. at 39 (citing *Pleasant Grove City v. Summum*, 555 U.S. 460, 467-68 (2009)). The test requires the Court to analyze three factors. First, whether the publication of the expression communicates a message from the government. *Id.* at 2248. Second, whether the publication is “closely identified in the public mind with the” government. *Id.* Third, whether the government exercises “direct control” over the message by approving it or rejecting it. *Id.* at 2248-49.

In *Walker*, the Supreme Court ruled that Texas Department of Motor Vehicles Board (“the Board”) “may refuse to create a new specialty license plate” for many reasons, such as “if the design might be offense to any member of the

public.”). *See generally* 135 S. Ct. 2239 (2015). If approved, the license plate design becomes available for Texans to select and place on their vehicles. *See Id.* at 2243. The Sons of Confederate Veterans, Texas Division (“SCV Texas”), applied to sponsor a specialty plate with a design that included the Confederate flag. *Id.* at 2245. The Board rejected the design pursuant to the statute and SCV Texas filed a federal lawsuit against the Board, claiming that its decision violated the First Amendment’s Free Speech Clause. The Court held that the first factor supported a finding of government speech because history shows that license plates communicate messages from the state. *Id.* at 2248. The second factor supported government speech because the public closely associates official state license plate designs with the state because license plates are essentially government IDs and issuers of IDs typically do not permit the placement of messages they do not wish to be associated.” *Id.* at 2248. The third factor supported a finding of government speech because the Board maintained “direct control” over the message conveyed by approving or rejecting every specialty plate design. *Id.* The Court noted that the Board “actively exercised this authority” by rejecting designs, which allows Texas to choose how to present itself and its constituency. *Id.*

In the present case, the first factor weighs in favor of a determination of government speech “as registry with the federal trademark registration program communicates the message that the federal government has approved the trademark.” *See Blackhorse*, 2015 WL 4096277 at *12. The second factor also weighs in favor of government speech because “the public closely associates federal

trademark registration with the federal government” because the insignia for federal trademark registration, ®, signifies the government’s recognition and approval of the mark. *Id.* The third factor weighs in favor of government speech because the government exercises direct editorial control over the federal trademark registration program. *Id.* Section 2 of the Lanham Act controls what appears on the Principal Register because it gives the PTO the discretion to accept, deny, or cancel a mark’s registration. *Id.*

When government speaks, the Free Speech Clause does not restrict it from determining the content of what it says. *Walker*, 135 S. Ct. at 2241. Similarly, the First Amendment does not preclude the government from exercising editorial discretion over its own medium of expression." *Muir v. Ala. Educ. Television Comm'n*, 688 F.2d 1033, 1044 (5th Cir. 1982). Section 2(a) is a common exercise of editorial discretion over the government’s own medium of expression, not an unconstitutional restriction of an individual’s First Amendment rights to free speech. In restricting the registration of disparaging marks, the PTO is merely exercising editorial discretion over what marks it endorses through approval and publication. Ms. Luhv’s First Amendment right to free speech was in no way abridged b the government exercising this discretion.

C. EVEN IF SECTION 2(A) RESTRICTED PRIVATE SPEECH, IT WOULD BE A VALID REGULATION OF COMMERCIAL SPEECH UNDER THE *CENTRAL HUDSON* TEST.

Even if the Court finds that the trademark registration process is commercial speech and that denying registration pursuant to Section 2(a) constitutes government action, Section 2(a) is still a permissible regulation of commercial

speech under the *Central Hudson* Test. *Central Hudson*, 447 U.S. at 566. Under the *Central Hudson* Test, Section 2(a) is constitutional both facially and as applied to Ms. Luhv. Under *Central Hudson*'s test, courts must look at four factors to determine whether a restriction of commercial speech is constitutional: (1) whether the speech concerns unlawful activity or is misleading; (2) whether there is a substantial governmental interest asserted; (3) whether the regulation directly advances that interest; and (4) whether the regulation is more extensive than necessary to serve that interest. *Id.* While trademarks may not be considered as concerning unlawful or misleading speech, they do meet the other three prongs of the *Central Hudson* Test. Therefore Section 2(a) is constitutional.

1. SECTION 2(A) DIRECTLY ADVANCES THE GOVERNMENT'S SUBSTANTIAL INTEREST IN NOT APPEARING TO ENDORSE DISPARAGING MARKS.

The second requirement of *Central Hudson* examines whether the asserted governmental interest is substantial. 447 U.S. at 566. The government has a substantial interest in not facilitating use of marks that may be disparaging as source identifier in interstate commerce and allowing States to make their own determinations as to whether such marks should be enforced, which pairs with its substantial interest in protecting the health and welfare of its citizens.⁴ The

⁴ See, e.g., *Trustees of the Emps. Ret. Sys. v. Baltimore*, 562 A.2d 720, 754 (Md. 1989) (finding the government's interest in disassociating itself from disparaging commercial speech as a "substantial" interest); *Air Transp. Ass'n of Am. v. San Francisco*, 992 F. Supp. 1149, 1164 (N.D. Cal. 1998) (describing the interest as strong); see also *Greyhound Corp.*, 6 U.S.P.Q.2d (BNA) at 1639 ("Disparagement is essentially a violation of one's right to privacy—the right to be 'let alone' from contempt and ridicule.")

registration of marks (such as disparaging marks), that are prohibited from federal registration, are not only offensive and harmful to the groups they disparage.

By approving and publishing such marks, the government would be magnifying the harm of disparagement, especially where the group subject to denigration has been historically subjected to such disparagement. Part of the registration process is that the government publishes each approved mark in the Trademark Principal Register. §§ 1051-1072. Although “issuance of a trademark registration” does not amount to “the awarding of the U.S. Government’s ‘imprimatur,’” *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1219 n.3 (T.T.A.B. 1993), federal registration is likely to create the perception of government endorsement.⁵ If Section 2(a) were to be found unconstitutional the government would be forced to register trademarks that would be disparaging to the public. As the marks are displayed in a government publication, it is likely that the public will interpret the government publication of marks as the government’s endorsement of the mark’s subject matter. The government’s interest in choosing how it represents itself and its constituency is substantial. Therefore, the second prong of the *Central Hudson* Test is met.

Section 2(a) also meets third prong of the *Central Hudson* Test because the statute directly advances the government’s substantial interest in avoiding the appearance that it is endorsing marks that may be offensive to persons,

⁵ See Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 Trademark Rep. 661, 663 n.6 (1993).

institutions, beliefs, or national symbols. In the present case, the Government has substantial interest in avoiding facilitating use of marks that may be disparaging to women (more specifically women with blonde hair). The PTO directly advanced that interest when it refused to register DUMB BLONDE because there is significant evidence showing that women find dumb blonde jokes to be offensive and evidence showing that blonde women find Ms. Luhv's state name, DUMB BLONDE disparaging. *In re Kourtney Luhv*, 1337 F.3d at 457.

2. SECTION 2(A) IS A PERMISSIBLE RESTRICTION OF COMMERCIAL SPEECH BECAUSE IT IS NARROWLY TAILORED.

The fourth *Central Hudson* requirement concerns “whether the regulation is more extensive than is necessary to serve the governmental interest.” *See* 447 U.S. at 566 (commercial speech cases require a fit that “is not necessarily perfect, but reasonable.”).

Under Section 2(a), a mark is only denied registration if it falls under one of the specific categories thoroughly defined in the statute. § 1052. Section 2(a) is “narrowly tailored” and not “more extensive than necessary” to serve the substantial governmental interests. *See San Francisco Arts & Athletics, Inc.*, 483 U.S. at 539 (upholding restrictions placed on commercial speech by the Lanham Act that were “not broader than Congress reasonably could have determined to be necessary.”). Section 2(a) does not prohibit or restrict any speech. *In re McGinley*, 660 F.2d at 484. Section 2(a) does not limit the owner's right or ability to use a disparaging term to identify its goods or services. *Wheeler*, 814 F.2d at 819. Nothing in the Lanham Act goes far enough to prohibit use of disparaging marks. *Id.* The

Act also does not criminalize or penalize the use of disparaging marks, nor does it tax or impose any fees on the use or the user of disparaging marks. § 1051. As Section 2(a) could not be much less restrictive and still directly advance the government's interests, the fourth requirement of *Central Hudson* confirms Section 2(a) is constitutional.

The PTO's denial of Ms. Luhv's application to register DUMB BLONDE was a permissible restriction on her commercial speech and it directly advanced the government's substantial interest in avoiding facilitating speech that may be disparaging to women. Furthermore, Section 2(a) is not more extensive than necessary because in order of the PTO to deny registration, the mark must meet the narrowly tailored *Geller* Test and because Ms. Luhv is in no way prohibited from using the mark.

CONCLUSION

For the foregoing reasons we ask that this court affirm the lower court's finding that Ms. Luhv's trademark was properly denied registration pursuant to Section 2(a) of the Lanham Act as it may be disparaging to women. We also ask that the court protect the Section 2(a) by finding that it is constitutional.

Dated: October 20, 2015

Respectfully submitted,
TEAM 101

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1. This brief complies with the Rules for the Seventeenth Annual National Entertainment Law Moot Court Competition. This brief contains X words, excluding the parts of the brief exempted by Rule 3.
2. This brief complies with the typeface requirements of Rule 3(i) since it has been prepared in accordance with the Rules of the Competition and represents the work product solely of the members of Team 101.

(s) Team 101

Attorney for: the United States Government

Dated: October 20, 2015