

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 RESPONDENT

TEAM NO. 102
COUNSEL FOR RESPONDENT
OCTOBER 20, 2015

QUESTIONS PRESENTED

1. Did the Trademark Trial and Appeal Board wrongly deny Kourtney Luhv's application for trademark registration on the ground that her proposed mark, "DUMB BLONDE," Luhv's stage name by which she is known by hundreds of thousands of fans, is disparaging within the meaning of Section 2(a) of the Lanham Act?
2. Does the Patent and Trademark Office's ability to deny registration to trademarks it finds disparaging under Section 2(a) of the Lanham Act contravene the free speech protections of the First Amendment?

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OPINIONS AND ORDERS ENTERED BELOW

The final judgment of the United States Court of Appeals for the Federal Circuit is reported and appears at *In re Kourtney Luhv*, 1337 F.3d 455 (Fed. Cir. 2015).

STANDARD OF REVIEW

The determination that a mark may be disparaging is a conclusion of law based upon underlying factual inquiries. The Trademark Trial and Appeals Board's factual findings are reviewed for substantial evidence, while its ultimate conclusion as to registrability is reviewed de novo. *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014).

Whether a federal statute violates the First Amendment is a question of law and is reviewed de novo. *United States v. Hutson*, 843 F.2d 1232, 1234 (9th Cir. 1988).

STATEMENT OF JURISDICTION

The Court of Appeals for the Federal Circuit entered final judgment on June 6, 2015. The Solicitor General of the United States timely filed a petition for writ of certiorari. This Court granted the writ for certiorari and has jurisdiction pursuant to 28 U.S.C. § 1254(1) (2006).

CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

U.S. Const. amend. I

15 U.S.C. § 1052(a) (2006)

28 U.S.C. § 1254(1) (2006)

STATEMENT OF THE CASE

Kourtney Luhv is a solo artist performing under the stage name Dumb Blonde. *In re Kourtney Luhv*, 1337 F.3d 455, 455 (Fed. Cir. 2015). Luhv’s lyrics focus on the challenges stemming from gender discrimination and negative stereotypes faced by all women, a message that has inspired hundreds of thousands of fans. *Id.* at 455, 457–58. Luhv juxtaposes her socially-conscious message with the dumb blonde stereotype and its associated imagery (e.g., a woman applying Wite-Out® to a computer monitor). *Id.* at 456–57. Her fans consist of mostly young women—many with blonde hair—who have reacted positively to her attempt to reappropriate the phrase “dumb blonde.” *Id.* Her fan base frequently comments on various social media sites expressing an admiration for Luhv’s positive message. *Id.* at 458.

Luhv signed a recording contract that required her to register the trademark “DUMB BLONDE” for use in connection with her performances and branded clothing. *Id.* at 456. On July 9, 2014, Luhv filed Application No. 99/989,052 (“Application”) with the Patent and Trademark Office (“PTO”) to register the mark “DUMB BLONDE.” *Id.* The examining attorney denied the Application on the basis that it “may be disparaging to a substantial composite of the referenced group, namely women who have a blonde hair color,” a violation of 15 U.S.C. § 1052(a) (“Section 2(a) of the Lanham Act”). *Id.* Luhv appealed the decision to the Trademark Trial and Appeal Board (“TTAB”). *Id.* The TTAB affirmed the denial of registration

citing the uses of dumb blonde imagery, dictionary definitions, articles, and social media comments to. *Id.* at 456–57.

Luhv further appealed the denial of the Application to the United States Court of Appeals for the Federal Circuit. *Id.* at 457. The Federal Circuit held that, while the TTAB correctly found that the trademark was disparaging, Section 2(a) of the Lanham Act violates the First Amendment. *Id.* at 458–59, 460.

SUMMARY OF THE ARGUMENT

I. The TTAB Erred When It Denied Luhv’s Application to Register the Trademark “DUMB BLONDE” on the Basis that It Is Disparaging to a Substantial Composite of the Referenced Group.

Courts applying Section 2(a) of the Lanham Act do so with little guidance; to the extent that guideposts exist, they are often ignored or misapplied. Courts rely on the *In re Geller* test to determine whether a trademark is disparaging. The first step of the analysis requires a determination of the likely meaning of the trademark using dictionary definitions, other readily available meanings, and the manner in which the trademark is used in connection with the trademarked goods or services. Here, the TTAB failed to appreciate the relatively innocuous meaning of “dumb blonde” and wholly failed to examine the manner in which Luhv used the trademark—namely, in connection with an empowering, women’s issues-focused message and associated clothing.

The second step of the analysis requires a determination of whether the trademark is disparaging. Here, the TTAB relied upon the negative perceptions of “dumb blonde” jokes and stereotypes—completely outside of the context of Luhv’s

use of the trademark—to prove that the term would likely be disparaging. Further, the attorney did not properly consider the vital fact that Luhv is a blonde woman, singing about women’s issues to a fan base of women, many of whom have blonde hair. The context of Luhv’s use of the trademark, combined with the relatively innocuous meaning of “dumb blonde,” compels the result that the trademark “DUMB BLONDE” would not be disparaging within the meaning of Section 2(a). Because the meaning falls short of disparaging, it plainly could not be disparaging to a substantial composite of the referenced group (here, blonde women), the requirement under the third step of the *In re Geller* analysis.

At a minimum, whether “DUMB BLONDE” would prove to be disparaging is seriously in doubt. In this regard, the examining attorney failed to follow an important policy of erring on the side of publication. Courts, recognizing the ineffectiveness of the ex parte hearing as a forum for adjudicating close-call trademark applications, have preferred granting registration and then permitting challenges to that registration by interested parties in a proceeding with a much more complete evidentiary record. The Federal Circuit’s misplaced reliance on *In re Heeb* led it to disregard this overarching policy. Yet, that case bears little resemblance to present case. The flawed analysis of whether “DUMB BLONDE” is disparaging and the disregard of the policy favoring registration led to an incorrect rejection of Luhv’s application. Proper analysis and proper adherence to policy both correct this erroneous result.

II. Section 2(a) of the Lanham Act's Prohibition on Disparaging Trademarks is Unconstitutional Because It Violates the Free Speech Protections of the First Amendment.

The First Amendment protects a broad spectrum of speech. The free speech protections of the Constitution extend to political and social commentary, artistic expression, and, importantly, commercial speech. Courts have almost uniformly found that trademarks are a species of commercial speech; trademark registration is an expression of that speech.

Within the ambit of First Amendment protection, commercial speech may not be abridged without substantial government justification. Here, Section 2(a)'s prohibition on disparaging trademarks: (1) prohibits protected speech; (2) burdens protected speech; and (3) conditions registration on the restriction of speech outside of the contours of the trademark program. Each of these three effects constitute an abridgment of that speech. The government must, therefore, articulate a justification that satisfies the *Central Hudson* test for valid restrictions on commercial speech. It has failed in that task. First, the government has failed to articulate a substantial interest in denying registration to disparaging trademarks. Each argument put forth by the government in this case and other similar cases has been rejected as circular, weak, or inappropriate. Second, even if there is a substantial government interest, the effect of denying registration bears no relation to any purported interest. Because the government cannot satisfy the test for commercial speech restrictions, Section 2(a) of the Lanham Act violates the free speech guarantees of the First Amendment.

ARGUMENT

I. The TTAB Erred When It Denied Luhv’s Application to Register the Trademark “DUMB BLONDE” on the Basis that It Is Disparaging to a Substantial Composite of the Referenced Group.

Trademarks like CRAZY BITCH, S.L.U.T.S., and WHORE COUTURE have been approved for trademark registration. (Reg. No. 4,383,645); (Reg. No. 3,088,943); (Reg. No. 3,357,791). Yet, the PTO refused to register the trademark “DUMB BLONDE” on the grounds that it was disparaging to women. *In re Kourtney Luhv*, 1337 F.3d 455, 456 (Fed. Cir. 2015). Section 2(a) of the Lanham Act, which prohibits registration of a trademark that “consists of or comprises. . . matter which may disparage. . . persons. . . ,” is the source of this glaring inconsistency. 15 U.S.C. § 1052(a) (2006). The legislative history of the Lanham Act has been described as “frustratingly silent as to why [it] denies registration to. . . disparaging matter.” Lynda J. Oswald, *Challenging the Registration of Scandalous and Disparaging Marks Under the Lanham Act: Who Has Standing to Sue?*, 41 Am. Bus. L.J. 251, 265 (2004). This lack of guidance, coupled with vague and overly broad statutory language, has left all levels of the trademark registration process—the PTO examining attorneys, the TTAB, the U.S. Court of Appeals for the Federal Circuit—with an unenviable task of discerning what constitutes an unregistrable disparaging trademark. *See In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990). In response to these conditions, the TTAB and Federal Circuit have established two guideposts to assist their travels through this wilderness: the *In re Geller* test and an overarching policy favoring registration. The

courts first apply the *In re Geller* test to determine whether a trademark “may disparage” persons under the language of Section 2(a). The test determines: (1) the likely meaning of the matter in question, looking to dictionary definitions, 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; and (2) if that meaning is found to refer to identifiable persons, does that meaning disparage a substantial composite of the referenced group. *In re Geller*, 751 F.3d 1355, 1362 (Fed. Cir. 2014) (quoting *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010)).

Recognizing that this test is scarcely less vague than the statutory language that it seeks to clarify, courts employ the second guidepost: a policy of resolving doubts in favor of registration. See, e.g., *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d at 1221; *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) at 1655. The TTAB, in *In re In Over Our Heads*, summarized its purpose:

“Because the guidelines are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established.”

Id. Here, the TTAB’s rejection of Luv’s application was contrary to the result rendered by a proper analysis under *In re Geller* because the trademark “DUMB BLONDE” is not disparaging to blonde women, much less to a substantial composite. However, at a minimum, there exists serious doubt as to whether the

trademark is disparaging and the TTAB's policy of resolving doubts in favor of publication should have been followed. *Id.*

A. The TTAB Erred in Its Application of the *In Re Geller* Two-Part Test.

The two-part test in *In re Geller* provides some limitation to the otherwise-overly broad language of Section 2(a). Though the test is highly subjective and flexible to the point of providing little meaningful control, the TTAB's misapplication of the test to the attempted registration of "DUMB BLONDE" failed to provide even the limited measure of judicial restraint and clarity for which the test was designed. A proper analysis under *In re Geller* demonstrates that the trademark "DUMB BLONDE" is not disparaging, but rather is a self-referential, satirical example of social commentary based on an obsolete and largely innocuous stereotype.

1. The TTAB Failed to Properly Discern the Likely Meaning of the Trademark, "DUMB BLONDE."

The first step in the analysis under *In re Geller* is determining the likely meaning of the matter in question. 751 F.3d 1355, 1358 (Fed. Cir. 2014). The Federal Circuit, TTAB, and PTO relied upon the dictionary definition of the term and the fact that Luhv, herself, has blonde hair to conclude that "DUMB BLONDE" refers to a negative stereotype of women who have blonde hair. *In re Kourtney Luhv*, 1337 F.3d 455, 457 (Fed. Cir. 2015). This analysis was incomplete, because it did not gauge the level of offensiveness inherent in the term and failed to fully consider the context in which Luhv used the phrase.

a. The TTAB Improperly Analyzed the Dictionary and Other Common Definitions of “Dumb Blonde.”

The examining attorney concluded that “dumb blonde” implies “a negative, stereotypical view of women” that is “offensive or insulting.” *Id.* A survey of dictionary definitions does not support the strong negative meaning that the examining attorney ascribed to the term. Dumb blonde is defined as “[a] blond-haired woman perceived in a stereotypical way as being attractive but unintelligent” or “a light-haired woman who is stereotyped as beautiful but unintelligent.” Oxford Online Dictionary, http://www.oxforddictionaries.com/us/definition/american_english/dumb-blonde (last visited Oct. 6, 2015); Dictionary.com’s 21st Century Lexicon, <http://dictionary.reference.com/browse/dumb-blond> (last visited Oct. 6, 2015). Further, by determining at this early stage of the analysis that the term was insulting and offensive (a characteristic not provided explicitly in readily-available dictionary definitions), the examining attorney and TTAB rendered much of the remaining analysis moot; the entire analysis is required to make such a determination. *See In re Geller*, 751 F.3d 1355, 1362 (Fed. Cir. 2014). Further, the dictionary definitions, which merely declare this term to be a “stereotype,” are not sufficient to determine the likely meaning of the term. The context in which the term is used is indispensable to that determination. *See In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1220 (T.T.A.B. 2010).

Additionally, the TTAB failed to properly examine another common source of the term “dumb blonde”—the “dumb blonde” joke. A quick internet search provides

hundreds of web pages dedicated to this form of humor. *Google* search results for “dumb blonde jokes”, <https://www.google.com/search?q=dumb+blonde&ie=utf-8&oe=utf-8#q=dumb+blonde+jokes> (last visited Oct. 6, 2015). This brand of humor, based upon the “obsolete” stereotype of the fair-haired airhead is an equally likely source for the definition of the term as Luhv uses it, especially—as discussed below—when considered in the context of Luhv (a blonde herself) singing empowering, women’s issues-focused lyrics. Ann Hornaday, *In praise of the Dumb Blonde, an archetype in need of saving*, Wash. Post, May 3, 2014; *In re Kourtney Luhv*, 1337 F.3d 455, 457–58 (Fed. Cir. 2015). Neither of the sources relied upon—dictionaries and dumb blonde jokes—lend themselves to the harsh attributes that the TTAB found inherent in the likely meaning of dumb blonde.

b. The TTAB Failed to Properly Consider the Context in Which the Trademark Was to Be Used.

A mark that “otherwise might be considered disparaging [might]. . . also have such a well-known alternative meaning that, as used in connection with particular goods or services, that alternative meaning would be found to be the applicable one.” *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1220 (T.T.A.B. 2010). The TTAB consistently looks beyond dictionary definitions and embraces the trademark’s context to determine the meaning of that mark. *See id.*; *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1280–82 (T.T.A.B. 2006). For example, in *Lebanese Arak Corp.*, the TTAB found that a winery’s trademark, “Khoran,” would be understood as a reference to the holy book of Islam. 94 U.S.P.Q.2d (BNA) at 1217–20. The TTAB concluded that the reference was disparaging because of the

Muslim prohibition on alcohol consumption. *Id.* at 1220–21. Conversely, in *In re Squaw Valley*, the TTAB accepted that the term “squaw” was offensive to Native American women. Still, the TTAB passed the trademark “SQUAW VALLEY” for publication, finding that way in which the mark was used changed its meaning. 80 U.S.P.Q.2d (BNA) at 1280–1282. The mark’s use in connection with ski equipment connected the use of the term “Squaw Valley” with the popular ski destination, rather than with the derogatory term. *Id.* at 1282. In both instances the context in which the mark was used was determinative in whether the mark was passed for publication.

The TTAB has made clear that the context is indispensable to determine the meaning of the trademark. Here, the TTAB and PTO examining attorney concluded “that the mark is likely intended to refer to women who have blonde hair color.” *In re Kourtney Luhv*, 1337 F.3d 455, 457 (Fed. Cir. 2015). While, undoubtedly, the term “dumb blonde” refers to blonde-haired women, the TTAB failed to understand the greater context. Luhv’s trademark is used in connection with goods and services identified with Luhv’s “inspiring” and “positive” persona and message. *Id.* at 457–58. Like in *In re Squaw Valley*, Luhv’s use of a phrase with negative connotations is transformed by its association with her music. The public will encounter the trademark in a manner that ensures that the trademark “DUMB BLONDE” is associated with Luhv’s body of work as a musician, not with the dumb blonde stereotype.

2. The TTAB Failed to Properly Discern Whether the Trademark Is Disparaging.

The second step of the analysis under *In re Geller* is to determine whether the trademark's meaning may be disparaging to the referenced group. 751 F.3d 1355, 1362 (Fed. Cir. 2014). While the likely meaning of the term dumb blonde is derived from a stereotype mirrored in a distinct type of humor, that meaning cannot be reasonably construed as disparaging. Because of the innocuous humor behind the term as used both in common parlance and in Luhv's trademark, the phrase cannot be disparaging under the second part of the *In re Geller* test. 751 F.3d 1355, 1362 (Fed. Cir. 2014). However, even if the likely meaning of the term is determined to be disparaging, the phrase's use in connection with Luhv's music is an obvious attempt to reappropriate an insult by the referenced group, an intent that the PTO and TTAB have recognized should not be construed as disparaging. *See, e.g.*, "TECHNODYKE" (Reg. No. 2,498,459 (2001)) (registering a lesbian-oriented website).

Disparagement has been defined by the TTAB as "the publication of a statement which the publisher intends to be understood, or which the recipient reasonably should understand, as tending 'to cast doubt upon the quality of another's land, chattles, or intangible things.'" *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B 1988). Understandably, most instances of TTAB trademark rejection target suspect racial and religious classifications. *See, e.g., In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2010) (rejecting a trademark for "KHORAN" wine as disparaging to

Islam); *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014) (rejecting a trademark for “STOP THE ISLAMISATION OF AMERICA” as disparaging to Islam); *Pro-Football, Inc. v. Blackhorse*, 2015 U.S. Dist. LEXIS 90091 (E.D Va. 2015) (cancelling the Washington Redskins football team’s trademarks as disparaging to Native Americans). Here, the humorous and weakly negative definition and connotation of “dumb blonde” cannot support a finding that the use of the term in a trademark is disparaging. “Dumb blonde” in no way approaches the level of offensiveness of racial or religious stereotypes. While it would be inconceivable to see an article advocating for the return of various racial and religious stereotypes, Ann Hornaday’s Washington Post article, “In Praise of the Dumb Blonde, an archetype in need of saving,” demonstrates that “DUMB BLONDE” is in an entirely different category from the aforementioned rejected trademarks. Washington Post, May 3, 2014. Clearly, Luhv’s use of “DUMB BLONDE” does not “degrade” or “cast doubt upon the quality” of blonde-haired women. *Greyhound Corp.*, 6 U.S.P.Q.2d (BNA) at 1639.

Likewise, the response of Luhv’s fan base should counsel against determining that “dumb blonde” is disparaging to women with blonde hair. Amongst her fans are many women with blonde hair. *In re Kourtney Luhv*, 1337 F.3d 455, 457–58 (Fed. Cir. 2015). Luhv herself has blonde hair. *Id.* at 457. Additionally, the aim of Luhv’s lyrics is to bring attention to the challenges faced by women. *Id.* at 458. It stretches the limits of imagination to consider that a blonde woman singing about women’s issues to a crowd of women, many of whom are blonde themselves, would employ a

stage name intended to disparage the singer and fans alike. It is equally unlikely that a fan base would support a singer whose stage name they found disparaging.

Yet, even if Luhv's use of the trademark "DUMB BLONDE" is considered disparaging on its face, the use of otherwise-disparaging trademarks by groups seeking to reappropriate those terms has been permitted many times by the PTO and TTAB. *See, e.g., In Re Condas*, 188 U.S.P.Q. (BNA) 544 (T.T.A.B. 1975) (upholding registration of clothing line owned by Japanese-American man); "F A G" (Reg. No. 2,997,761 (2005)) (registering F A G FABULOUS AND GAY grooming products); "TECHNODYKE" (Reg. No. 2,498,459 (2001)) (registering a lesbian-oriented website); "HEEB" (Reg. No. 2,858,011 (2004)) (registering a Jewish-oriented magazine). One of the clearest examples is the San Francisco Women's Motorcycle Contingent's ("SFWMC") registration of "DYKES ON BIKES" for use in their prominent role in San Francisco's Pride Parade. *McDermott v. San Francisco Women's Motorcycle Contingent*, 240 Fed. Appx. 865, 866 (Fed. Cir. 2007). Initially rejected as disparaging to lesbians, the PTO's reconsideration of additional evidence after remand from the TTAB led to the trademark's registration. *Id.*; (Reg. No. 3,323,803). Like the SFWMC, Luhv is attempting to reappropriate a negative phrase by her use of the phrase in a positive context. Like the SFWMC, Luhv's use of the phrase has significant support amongst the referenced group. But unlike the SFWMC, Luhv is attempting to reappropriate a phrase that does not carry with it the weight of a history of discrimination and oppression. The offensiveness of terms like "dyke," "jap," "fag," and "heeb" far exceed any offensiveness inherent in the

term “dumb blonde.” Trademarks using these terms were registered when the applicant was a member of the referenced group; the satirical use of the far more innocuous term “dumb blonde” should receive similar treatment.

3. The TTAB Failed to Properly Discern Whether the Trademark, If Disparaging, Would Be Disparaging to a Substantial Composite of the Referenced Group.

The third step of the analysis under *In re Geller* is to determine whether the trademark’s meaning, if disparaging, “may be disparaging to a substantial composite of the referenced group.” *In re Geller*, 751 F.3d 1355, 1362 (Fed. Cir. 2014). The weak negative connotation of the term “dumb blonde” does not permit it to be deemed disparaging. Therefore, the weak negative connotation cannot support a finding that the term would be disparaging to a substantial composite of the referenced group. The TTAB relied upon a gender and media studies handbook to inform its decision that the term “dumb blonde” and the related jokes are viewed negatively by women. See Karen Ross, *The Handbook of Gender, Sex, and Media* 88 (John Wiley & Sons, Sep. 7, 2011). Yet that same source describes the cross-cultural and cross-gender popularity of the jokes. See Ross, *supra*, at 88-103. The sheer popularity and politically acceptable enjoyment of the jokes betrays any disparagement that is present in the term.

The most important evidence against the term dumb blonde being disparaging to a substantial composite of women is the evidence of Luhv’s success. The volume of support on her social media sites demonstrates the breadth of her following. *In re Kourtney Luhv*, 1337 F.3d 455, 455–56 (Fed. Cir. 2015). Further, the

multi-million dollar record deal that she recently signed shows her appeal. *Id.* Though, as the Federal Circuit below highlighted, the TTAB has previously upheld the denial of trademark registration even after significant evidence of support for the applicant's use of the trademark was provided to the examining attorney, that case is inapposite. *In re Heeb Media, LLC*, 289 U.S.P.Q.2d (BNA) 1071, 1073–74, 1077 (T.T.A.B. 2008). *In re Heeb* also involved substantial evidence from referenced persons who spoke to the offensiveness of the slur, “heeb.” *Id.* at 1076. Here, there is nothing to overcome the evidence against disparagement to a substantial composite provided by Luhv in the form of website comments, commercial success, and social media following. Rather, the TTAB relied upon a scholarly article that looked at the potential offensiveness of blonde jokes—entirely outside the context of the term “dumb blone” as used by Luhv in connection with her musical persona. Ross, *supra*, at 88. The applicability of the article's passing mention of a 1997 study that found some blonde college students “fe[lt] discomfort when hearing blonde jokes” to the present situation is negligible, especially in comparison to the very pertinent insight provided by the public's reaction to Luhv, her stage name, and her music. Ross, *supra*, at 103.

B. The TTAB's Improper Reliance on *In re Heeb* Caused It to Ignore Overarching Trademark Policy.

It is the well-established policy of the TTAB to err on the side of publication when there are doubts as to whether a mark is disparaging under Section 2(a). *E.g.*, *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1688 (T.T.A.B. 1994); *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1375 (Fed. Cir. 1994); *In re Old Glory Condom Corp.*, 26

U.S.P.Q.2d 1216, 1220 n.3 (T.T.A.B. 1993). The existence of any doubt as to whether the trademark may be disparaging is better resolved through a claim by a person who believes that he would be damaged by the registration and permitting the production of evidence not usually present in the ex parte hearing. *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990). Here, the TTAB ignored this guiding principle and, instead, permitted *In re Heeb* to lead it to a contrary conclusion. *In re Kourtney Luhv*, 1337 F.3d 455, 457–59 (Fed. Cir. 2015).

1. The TTAB’s Reliance on *In Re Heeb* Was Misplaced.

There is little similarity between the case at hand and *In re Heeb*. 89 U.S.P.Q.2d (BNA) 1071 (T.T.A.B. 2008). In *In re Heeb*, a magazine attempted to register a traditional anti-Semitic slur as its trademark for a related clothing line. *Id.* at 1071–72. The examining attorney produced a significant amount of evidence showing that the slur was still offensive to many Jewish persons. *Id.* at 1072–73. Despite the applicant’s production of a similar amount of evidence that Jewish persons did not find “heeb” offensive, the TTAB affirmed the examining attorney’s denial of registration because there was substantial evidence to support the PTO’s position. *Id.* at 1076–78. The TTAB concluded that “within the referenced group there are disparate views, perhaps most prominently delineated along generational lines, as to whether ‘HEEB’ retains its disparaging character in the context of applicant’s use in connection with its magazine.” *Id.* at 1076. Here, the examining attorney failed to produce any such evidence. As an evidentiary matter, an examining attorney carries the burden to set forth a prima facie case that the

trademark at issue violates Section 2(a). *See In re Gyulay*, 820 F.2d 1216, 1217 (Fed. Cir. 1987). Once the prima facie case is presented, the applicant may produce evidence to rebut the showing of disparagement. *Id.* Doubts as to whether a prima facie case was established notwithstanding, Luhv produced evidence in various forms to rebut the examining attorney's case. *In re Kourtney Luhv*, 1337 F.3d 455, 455–59 (Fed. Cir. 2015). Because the prima facie case was rebutted, the examining attorney again had the burden to show that the trademark was disparaging to a substantial composite of the referenced group. *See In re Gyulay*, 820 F.2d at 1217. Here, as opposed to *In re Heeb*, the examining attorney did no such thing. The production of a scholarly article on the cultural phenomenon of blonde jokes was inapplicable to the facts at hand and insufficient to overcome the pertinent and substantial evidence produced by Luhv. Further demonstrating the error of reliance upon *In re Heeb* is the nature of the term at issue. “Heeb” is a Jewish slur; “dumb blonde” is a stereotype of attractive, but unintelligent women. The seriousness of anti-Semitism understandably informed the court's decision in *In re Heeb*. 89 U.S.P.Q.2d (BNA) 1071, 1076 (T.T.A.B. 2008). The production of evidence demonstrating that older Jewish persons, who had lived through the horrors of the 20th century's anti-Semitism and the Second World War, were more likely to be offended by the term reveals the role that history played in the court's analysis. *Id.* No such parallel exists here; the “plight” of blonde women and the plight of the Jewish people could not be more distinct.

2. The TTAB Failed to Resolve Doubt as to the Offensiveness of the Trademark in Favor of the Applicant.

The substantial and un rebutted evidence that a substantial composite of Jewish persons would be offended by the term “heeb” compelled the result in *In re Heeb. Id.* Conversely, there is no such evidence here; any offensiveness is conjectural. At a minimum, it must be said that there is doubt as to whether the trademark is disparaging and, certainly, whether it is disparaging to a substantial composite of women. This unresolved doubt does not permit the denial of registration according to ample Federal Circuit and TTAB precedent. *See, e.g., In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1375 (Fed. Cir. 1994). The limited evidentiary procedures of ex parte proceedings do not allow the “opportunity for response by the applicant with evidence that a substantial composite of the general public would not consider the mark at issue scandalous in the context of contemporary attitudes and the relevant marketplace.” *See id.*, slip op. at 16 (Simms, Member, dissenting).

In the absence of clear evidence that a substantial composite of women would be disparaged by Luhv’s trademark, the TTAB erred in not approving the application and permitting justice of a more complete and robust form to ultimately decide the issue. Nothing in the record here permits a claim to the level of certainty that emboldened the TTAB in *In re Heeb* to bypass the overriding policy of favoring registration. In the judicial wilderness that is Section 2(a)’s vague language and the *In re Geller* test, the TTAB and Federal Circuit have wisely invited the clarity that further adversarial proceedings would provide. Here, the TTAB followed a path

hewn by *In re Heeb* that led it to a conclusion that was inappropriate for the facts at hand. Deference to a policy of favoring registration is the proper path.

II. Section 2(a) of the Lanham Act’s Prohibition on Disparaging Trademarks is Unconstitutional Because It Violates the Free Speech Protections of the First Amendment.

Freedom of speech lies at the heart of American democracy. Justice Louis Brandeis, in a passionate defense of free speech, explained that the protection of the First Amendment was a recognition that “freedom to speak as you think [is] a means indispensable to the discovery and spread of political truth. . . .” *Whitney v. California*, 274 U.S. 357, 380 (1927). Yet even this, the most revered of constitutional protections, was never understood to be absolute in application. *See Roth v. United States*, 354 U.S. 476, 483 (1957). However, the spectrum of speech that is afforded protection is exceedingly broad. As Justice William J. Brennan explained, “[a]ll ideas having even the slightest redeeming social importance. . . have the full protection of the guaranties, unless excludable because they encroach upon the limited area of more important interests.” *Id.* at 484. Whether an interest is amongst these “more important interests” that displace First Amendment protection is ascertained by a three-part analysis. First, the speech in question must be protected speech. *See, e.g., id.* at 481. Second, the government must take some action which abridges that speech in a manner that implicates the First Amendment. *See Texas v. Johnson*, 491 U.S. 397, 405–07 (1989). Third, the abridgement must be unconstitutional when analyzed under the appropriate framework. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557,

566 (1980). Section 2(a) of the Lanham Act’s constitutionality rests upon this analysis.

A. The Registration of a Trademark Is Constitutionally Protected Commercial Speech.

Commercial speech has not always enjoyed the protection of the First Amendment. In *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council*, however, the Supreme Court found that speech that “does no more than propose a commercial transaction” is worthy of First Amendment protection. 425 U.S. 748, 762 (1976). Since this pivotal decision, courts have found that myriad forms of commercial speech should be free from unwarranted governmental interference. *See, e.g., Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983). Trademarks have been among the forms of commercial speech extended First Amendment protection. *See, e.g., Piazza’s Seafood World, LLC v. Odom*, 448 F.3d 744, 752–53 (5th Cir. 2006) (trade names are commercial speech); *Transp. Alts., Inc. v. City of N.Y.*, 218 F. Supp. 2d 423, 439 (S.D.N.Y. 2002) (company trademarks are protected by the First Amendment). Here, Kourtney Luhv’s application to register the trademark “DUMB BLONDE” is an expression of constitutionally protected commercial speech.

1. Commercial Speech Is Protected Speech Under the First Amendment.

The Court’s decisions until the late 1970s evinced little hesitation in upholding governmental restrictions on speech that was considered commercial in nature. Until its decision in *Virginia State Board*, the Court deemed that “the

Constitution imposes no [First Amendment] restraint on government as respects purely commercial advertising.” *Valentine v. Chrestensen*, 316 U.S. 52, 55 (1942). Nearly identical cases involving ordinances that banned door-to-door solicitation were decided differently solely on the basis that one involved non-commercial advertisements for a religious meeting and the other involved commercial advertisement for magazine subscriptions. *Martin v. Struthers*, 319 U.S. 141 (1943); *Breard v. Alexandria*, 341 U.S. 622 (1951). However, the Court definitively reversed course in *Virginia State Board of Pharmacy*. 425 U.S. 748 (1976). The Court, now understanding that commercial speech “serves individual and societal interests in assuring informed and reliable decisionmaking,” finally extended it First Amendment protections. *Bates v. State Bar of Ariz.*, 433 U.S. 350, 364 (1977); *Va. State Bd.*, 425 U.S. at 772. Like non-commercial speech, when obscenity is not involved—as here—commercial speech is not stripped of its First Amendment protections because of its offensiveness. *See Carey v. Population Services Int’l.*, 431 U.S. 678, 701 (1977).

2. Trademark Registration Is Commercial Speech and Is Afforded First Amendment Protection.

The metes and bounds of “commercial speech” protections were initially unclear after their recognition in *Virginia State Board*. Decades of judicial contemplation have clarified the scope of protection afforded commercial speech to a large degree. From the onset, however, courts recognized trademarks and trade names as commercial speech. *E.g., Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (The use of trade names. . . is a form of commercial speech. . . .”). This recognition

continues. See, e.g., *Piazza's Seafood World, LLC v. Odom*, 448 F.3d 744, 752-53 (5th Cir. 2006) (finding seafood importer/distributor's trade name to be protected commercial speech); *Bad Frog Brewery v. N.Y. State Liquor Auth.*, 134 F.3d 87, 96–97 (2d Cir. 1998) (finding that a brewery's logo functioned like a trademark and was commercial speech).

3. The Sole Court Finding That Trademark Registration Is Not Commercial Speech Is in the Minority of Jurisdictions and Incorrectly Analyzed the Nature of Trademarks as Speech.

The near-uniformity among jurisdictions finding that trademarks are commercial speech notwithstanding, one jurisdiction has found that trademark registration is not commercial speech. Recently, the U.S. District Court for the Eastern District of Virginia, in *Pro-Football, Inc. v. Blackhorse* waded into the politically-charged waters of the Washington Redskins trademark dispute. 2015 U.S. Dist. LEXIS 90091 (E.D. Va. July 8, 2015). Rather than justifying the cancellation of the Redskins' trademarks using the well-established *Central Hudson* test for constitutionality of commercial speech restrictions, the court sidestepped that analysis by finding that trademarks—once in the hands of the PTO—lost their character as commercial speech. *Id.* at *26. The court, instead, held that the trademark registration program was government speech using two different theories: the *Walker* test and the Fourth Circuit's mixed/hybrid speech test. *Id.* at *26–38; *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2269 (2015); *Sons of Confederate Veterans v. Vehicles*, 288 F.3d 610, 618 (4th Cir. 2002). Both tests were developed in response to a suit by the Sons of Confederate

Veterans challenging the denial of their Confederate battle flag-containing proposed specialty license plate designs; both tests were misapplied by the court in *Blackhorse*.

a. Trademark Registration Is Not Government Speech Under the *Walker* Test.

In *Blackhorse*, the District Court plainly misapplied the government speech test contained in *Walker*, ignoring the dissimilarity between the state specialty license plate program in *Walker* and the federal trademark registration program. See *Blackhorse*, 2015 U.S. Dist. LEXIS 90091 at *26–38. Finding that all three *Walker* factors weighed in favor of government speech, the court concluded that the federal trademark registration program lay outside of the protection of the First Amendment. *Id.* A more careful application of the *Walker* test renders a different result.

In *Walker*, the Supreme Court examined three factors which led it to conclude that the Texas specialty license plate program constituted government speech: (1) the extent to which the program has communicated messages from the government; (2) the degree to which the content of the speech is closely identified in the public mind with the government; and (3) the level of editorial control that the government exerts over the program. 135 S. Ct. at 2248–50. First, the trademark registration program has never been perceived as a vehicle for government messages. To the extent that the public understands trademark registration, trademarks are viewed—properly— as a result of an applicant’s commercial activity. The District Court’s subtle misconstruction of this factor (substituting

whether the program conveys the State’s “approval” rather than communicating messages from the State) was misleading and improperly conflated this factor with the second factor. *Blackhorse*, 2015 Lexis 90091 at * 28–29. Trademark registration has never been used as a vehicle of communication by the government, absent the government using the trademark registration program as a commercial user itself. *See, e.g.*, United States Postal Service Registrations and Trademarks, https://ribbs.usps.gov/trademarks/documents/tech_guides/trademarks.pdf (last visited Oct. 6, 2015).

Second, the content of the speech, like the program itself, has never been viewed as the government’s speech. It is difficult to conceive of a reasonable person believing that a company’s use of the trademark symbol (®) is a government statement. The Supreme Court, in finding that the license plate program was government speech, stated that “Texas license plates are, essentially, government IDs. And issuers of ID ‘typically do not permit’ the placement on their IDs of ‘message[s] with which they do not wish to be associated.’” *Walker*, 135 S. Ct. at 2249. Conversely, persons encountering trademarks do not “interpret them as conveying some message on the [government’s] behalf.” *Id.* Also, the fact that the trademark symbol is not required to be shown alongside the registered trademark further attenuates any connection that the government can claim exists between the content of the mark and itself. *See* 15 U.S.C. § 1111 (2006).

Lastly, while it is conceded that the PTO exerts considerable editorial control over trademark registration, this is the only *Walker* factor that weighs in favor of government speech.

The proper analysis under *Walker* compels a contrary conclusion to that reached by the court in *Blackhorse*. Yet, the *Blackhorse* court's greatest misstep was its failure to consider the reason for the government speech exception's existence: granting governments control over speech likely to be perceived as their own. *Pleasant Grove City v. Sumnum*, 129 S. Ct. 1125, 1139 (2009) (Stevens, J., concurring). The Court in *Walker* concluded that "Texas presents these [license plate] designs on government-mandated, government-controlled, and government-issued IDs that have traditionally been used as a medium for government speech. . . directly below the large letters identifying 'TEXAS' as the issuer of the IDs." *Walker*, 135 S. Ct. at 2269. Here, there is no such basis for concern about the content of such speech being perceived by the public as that of the government; the argument that trademark registration is government speech under *Walker* fails.

b. Trademark Registration Is Not Government Speech Under the Fourth Circuit's Hybrid/Mixed Speech Test.

In nearly identical circumstances to *Walker*, the Fourth Circuit developed a similar test, the hybrid/mixed speech test, to determine whether a state specialty license plate program was government or private speech. *Sons of Confederate Veterans v. Vehicles*, 288 F.3d 610 (4th Cir. 2002). The test was similarly misapplied by the court in *Blackhorse*. A proper application of the test renders a similar result

to the proper application of the *Walker* test: trademark registration is private commercial speech protected by the First Amendment.

The test employed by the Fourth Circuit tracks the same concerns expressed in the *Walker* test. The four factors are: (1) the central "purpose" of the program in which the speech in question occurs; (2) the degree of "editorial control" exercised by the government or private entities over the content of the speech; (3) the identity of the "literal speaker "; and (4) whether the government or the private entity bears the "ultimate responsibility" for the content of the speech. *Id.* at 218. The court in *Blackhorse* found that the first three factors weighed in favor of government speech, with the final factor weighing in favor of private speech. *Pro-Football, Inc. v. Blackhorse*, 2015 U.S. Dist. LEXIS 90091 at *33–38 (E.D. Va. July 8, 2015). Again, the proper analysis results in each factor weighing in favor of private speech, save the factor of government editorial control.

First, a central purpose of the program is to protect “the right of the owner of a trade or service mark to have his or her product or service identified by a distinct name or label.” *Birthright v. Birthright, Inc.*, 827 F. Supp. 1114, 1145 (D.N.J. 1993). This flies in the face of the *Blackhorse* court’s assertion that “the purpose of the program is not for the expression of private views or interests.” *Blackhorse*, at 2015 U.S. Dist. LEXIS 90091 at *34. The protection of the private interest in a commercially valuable identity was one of the major underpinnings of the enactment of the Lanham Act and trademark protection in general. See Ethan Horwitz & Benjamin Levi, *Fifty Years of the Lanham Act: A Retrospective of Section*

43(a), 7 Fordham Intell. Prop. Media & Ent. L.J. 59, 60–61 (1996). Rather than the “expression lay[ing] in the creation of the mark itself,” the program’s purpose is to provide another avenue of expression. *Blackhorse*, 2015 U.S. Dist. LEXIS 90091 at *34. This factor weighs in favor of private commercial speech.

Second, it is again conceded that the degree of editorial control exerted by the PTO weighs in favor of trademark registration being government speech.

Third, the identity of the literal speaker is the trademark owner, not the government. The court’s claim that the government is the speaker because of the trademark registration notice published in the Official Gazette of the PTO and the Principal Register is disingenuous. *Id.* at 36. The context in which the “speech” of the trademark is “heard” is rarely these publications. The average person has no reason to read these publications, much less know of their existence. Instead, registered trademarks are predominantly seen in the marketplace—the only arena where mark owners can fully avail themselves of the benefits of registration. *See Fin. Co. of Am. v. Bankamerica Corp.*, 493 F. Supp. 895, 903 (D. Md. 1980) (stating that a purpose of the Lanham Act is to “protect the interests. . . of those consumers who rely upon such representation in purchasing goods or services.”). The overarching purpose of the government speech test is to provide governments the ability to control speech that is likely to be perceived as their own; it would be inappropriate to permit publication in little-known government registers to outweigh the public’s billions of daily interactions with registered trademarks,

which present these trademarks as the owner's speech. *See Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2246–50 (2015).

Fourth, the ultimate responsibility for the content of the speech is borne by the private entity. The court in *Blackhorse* conceded this point, stating: “When a trademark's federal registration is challenged, it is the mark owner, not the government, who must defend it.” 2015 U.S. Dist. LEXIS 90091 at *36. Because three of the four factors under the Fourth Circuit's hybrid/mixed speech test weigh in favor of private speech, the result under this test is the same as that under the *Walker* test: trademark registration is private commercial speech.

The *Blackhorse* court failed in both tests to remove trademark registration from the ambit of protected speech. As protected speech, trademark registration satisfies the first element in the free speech violation analysis. *Roth v. United States*, 354 U.S. 476, 483 (1957).

B. The Refusal of the PTO to Register Disparaging Trademarks Is an Abridgment of Constitutionally Protected Speech.

Mere burdens upon protected speech are considered abridgements of speech as much as outright prohibitions; the conditioning of benefits as a coercive measure to restrict speech has similarly been treated as an abridgement of free speech. *See, e.g., Turner Broad. Sys. v. FCC*, 520 U.S. 180, 186–87 (1997); *Wisconsin v. Mitchell*, 508 U.S. 476, 488 (1993); *Perry v. Sindermann*, 408 U.S. 593, 597 (1972). Here, under the trademark registration program, refusal to register a trademark constitutes an abridgement of constitutionally protected speech because the refusal: (1) prohibits constitutionally protected speech; (2) burdens constitutionally

protected speech; and (3) places an unconstitutional condition on the receipt of the benefit of trademark registration.

1. The Refusal of the PTO to Register Disparaging Trademarks Is a Prohibition of Constitutionally Protected Speech.

The most obvious effect that denial of registration has is that the constitutionally protected speech is prohibited. Without trademark registration, a person's tradename is not published in the Official Gazette of the PTO or the Principal Register. 15 U.S.C. § 1062; 15 U.S.C. § 1057 (2006). Also, a trademark user is unable to use the "®" symbol alongside their tradename. 15 U.S.C. § 1111 (2006). The effect is that the protected speech is denied its expression as a trademark. Still, some courts have claimed that "the PTO's refusal to register [a] mark does not affect [the] right to use it. . . . No conduct is proscribed, and no tangible form of expression is suppressed." *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981). This analysis fails to recognize that the alternative means of expression do not obviate the prohibition here.

2. The Refusal of the PTO to Register Disparaging Trademarks Places a Burden on Constitutionally Protected Speech.

Even accepting *McGinley's* assertion that registration denial does not prohibit the use of the trademark, the court admitted that when a trademark is denied registration "[w]hat is denied are the benefits provided by the Lanham Act which enhance the value of a mark." *Id.* at 487. Without registration, the use of the trade name is burdened by the lack of access to federal courts and the loss of

exclusive nationwide use of the mark. *In re Tam*, 785 F.3d 567, 575–76 (Fed. Cir. 2015) (J. Moore, addt'l views). These benefits are significant. 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:9 (4th ed.) (2015). The additional financial, legal, and commercial hurdles that lay in the path of unregistrable trademarks leave little doubt that the effect of denial is a substantial burden on that constitutionally protected speech, which the First Amendment does not tolerate. *See id.*; *Sorrell v. IMS Health, Inc.*, 131 S. Ct. 2653, 2664 (2011).

3. The Refusal of the PTO to Register Disparaging Trademarks Places an Unconstitutional Condition on the Receipt of the Benefit of Trademark Registration.

The indirect burdening of constitutional rights accomplished through the coercive technique of denying valuable benefits or privileges to those who would otherwise exercise those rights has been treated as a constitutional violation for nearly a century. *See, e.g., Frost & Frost Trucking Co. v. R.R. Comm'n*, 271 U.S. 583, 599 (1926); *Koontz v. St. Johns River Water Mgmt. Dist.*, 133 S. Ct. 2586, 2594 (2013). Even though a person has no “right” to federal trademark registration or other benefits, the government—which may otherwise deny that benefit for any number of reasons—may not deny a benefit to a person on a basis that “infringes his constitutionally protected interests, especially his interest in freedom of speech.” *Perry v. Sindermann* 408 U.S. 593, 597 (1972). Following this dictate, courts will declare a statute unconstitutional that conditions the receipt of benefits on a restriction of protected speech that lies outside the contours of the program itself.

Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc., 133 S. Ct. 2321, 2328 (2013). Section 2(a) does just that.

a. The Refusal of the PTO to Register Disparaging Trademarks Is an Attempt to Regulate Speech Outside the Contours of the Program.

Under the doctrine of unconstitutional conditions, the PTO is barred from imposing conditions on protected speech that do not relate to the defined limits of the program. *See id.* Here, a trademark’s potential to disparage does not relate to any such limit or purpose of the trademark registration program. Clearly, disparaging trademarks do not become less protectable in federal court, less susceptible to presumed validity by courts or other trademark users, or less publishable in the Gazette or Principal Register. Equally clear is that the purpose of trademark registration—“the right of the owner of a trade or service mark to have his or her product or service identified by a distinct name or label”—is not frustrated by the content of the trademark. *Birthright v. Birthright, Inc.*, 827 F. Supp. 1114, 1145 (D.N.J. 1993). The prohibition of disparaging trademarks results, instead, from Section 2(a)’s “recast[ing] a condition [of receipt of the benefit] as a mere definition of its program”; this justification has been thoroughly rejected by the Supreme Court. *Agency for Int’l Dev.*, 133 S. Ct. at 2328.

Further evidence that this is a proper situation for the application of the doctrine is that the federal trademark program is a regulatory program—not a subsidy program. *In re Tam*, 785 F.3d 567, 580–81 (Fed. Cir. 2015) (J. Moore, add’tl views). Courts have been understandably reluctant to apply the unconstitutional

conditions doctrine to instances where federal funding has been used to “selectively fund a program to encourage certain activities it believes to be in the public interest. . . .” *Rust v. Sullivan*, 500 U.S. 173, 193 (1991). Courts do not, however, express that reluctance with regulatory programs. *See, e.g., FCC v. League of Women Voters of California*, 468 U.S. 364, 376, 402 (1984). The Lanham Act is a regulatory program based in the Commerce Clause—not the Spending Clause—and, since 1991, has been funded entirely by fee revenue. *See Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 133 S. Ct. 2321, 2326–30 (2013); *Figueroa v. United States*, 466 F.3d 1023, 1028 (Fed. Cir. 2006). Here, no deference to a congressional funding decision is owed.

b. Courts’ Failure to Apply the Unconstitutional Conditions Doctrine in Trademark Cases Is Based on Improper Reliance on Outmoded Precedent.

Courts’ reliance on *McGinley* has led to a complete failure to examine the unconstitutional conditions doctrine’s application to the federal trademark registration program. *See, e.g., In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012); *In re Blvd. Entm’t, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003). Yet, *McGinley* was decided only one year after *Central Hudson* articulated the test for permissible restrictions on commercial speech and in a period in which commercial speech was just beginning to be developed, its failure to address unconstitutional conditions appears as understandable as subsequent reliance on its analysis appears misguided. *In re Tam*, 785 F.3d 567, 581 (Fed. Cir. 2015) (J. Moore, addt’l views). Though it is understandable that the *McGinley* court would not have considered the impact of

commercial speech’s recognition and the unconstitutional conditions doctrine on Section 2(a)’s refusal to register disparaging trademarks at that early stage, the passage of nearly thirty five years has rendered that examination long overdue.

C. The Government Regulation of Disparaging Trademarks is Unconstitutional Because It Fails to Satisfy the *Central Hudson* Test.

In *Central Hudson*, the Supreme Court articulated a four-prong test for the constitutionality of government regulation of commercial speech. 447 U.S. 557, 563–64 (1980). First, the Court asks whether the speech concerns illegal activity or is misleading. *Id.* If so, the Court stated, then it is not deserving of protection under the First Amendment. *Id.* If not, then the Court asks whether the asserted government interest is substantial. *Id.* at 564. If so, the Court then asks whether the regulation directly advances that interest. *Id.* Finally, if the regulation advances the interest, the Court asks whether the regulation is more extensive than necessary to serve that interest. *Id.* Here, the government cannot articulate substantial justifications for the restrictions—much less can the government show that the regulations in any way advance its interests.

1. Disparaging Trademarks Do Not Concern Illegal Activity and Are Not Misleading.

The Court in *Central Hudson* stated that “[t]he government may ban forms of communication more likely to deceive the public than to inform it or commercial speech related to illegal activity.” *Id.* at 563–64. Here, there are no allegations that there is anything inherently illegal or misleading about disparaging trademarks.

2. The Government Does Not Have a Substantial Interest in Denying Trademark Registration to Disparaging Trademarks.

Next, the government must assert a substantial interest in denying registration to these trademarks. Many interests have been asserted; none survive scrutiny.

One such asserted interest is that the government does not wish to put its stamp of approval on disparaging trademarks. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1220 n.3 (T.T.A.B. 1993). This interest has been roundly rejected by various courts. *Id.*; *In re McGinley*, 660 F.2d 481, 487 n.13 (C.C.P.A. 1981). Rather than viewing trademarks as “the beneficiaries of a federal registration scheme,” the public views “trademarks in their roles as product identifiers.” Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of REDSKINS?*, 52 Stan. L. Rev. 665, 684 (2000). Further, the government’s editorial control is responsible for any perception that trademarks are “approved” by the government; if the “government unconditionally registers trademarks without reference to their offensive content, the public will not perceive registration as government endorsement.” *Id.* at 685.

Another purported interest is a desire by Congress “that such marks not occupy the time, services, and use of funds of the federal government.” *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981). This fails for several reasons. First, since 1991, the PTO has been funded entirely by applicant fee revenue. *Figueroa v. United States*, 466 F.3d 1023, 1028 (2006). No significant federal time, services, or

funds are expended that are not procured directly by the trademark applicant fees themselves. Second, more resources are expended in the prosecution of appeals for allegedly disparaging trademarks “than would ever result from the registration of the mark.” *In re McGinley*, 660 F.2d at 487 (J. Rich, dissenting). Lastly, this is a rationale that simply “tak[es] the effect of the statute and posit[s] that effect as the State's interest. If accepted, this sort of circular defense can sidestep judicial review of almost any statute, because it makes all statutes look narrowly tailored. . . and eliminates the entire inquiry concerning the validity of content-based discriminations.” *Simon & Schuster, Inc. v. New York State Crime Victims Bd.*, 502 U.S. 105, 120 (1991).

Finally, as evidenced by the legislative history of the Lanham Act, the underlying rationale may simply be a desire to restrict disparaging speech. *See* Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess. 18–21 (1939) (statement of Rep. Thomas E. Robertson) (explaining a reluctance to associate respected historical figures with less reputable goods, like alcohol). Yet, the Supreme Court has unequivocally stated that “the fact that protected speech may be offensive to some does not justify its suppression.” *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71 (1983). In fact, it is a “bedrock principle underlying the First Amendment . . . that the Government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.” *United States v. Eichman*, 496 U.S. 310, 319 (1990). Like the aforementioned rationales, an interest in discouraging the use of

potentially offensive disparaging trademarks is not a legitimate—nor a substantial—government interest. Without a substantial government interest, the restrictions on commercial speech imposed by the PTO’s refusal to register disparaging trademarks are unconstitutional.

3. The Denial of Registration to Disparaging Trademarks Does Not Advance Any Purported Substantial Government Interest.

Without a substantial government interest, the *Central Hudson* analysis proceeds no further; the restrictions posed by Section 2(a) of the Lanham Act are unconstitutional. However, even if one of the above rationales is deemed substantial, the denial of registration would have a *de minimis* or negative impact on the furtherance of the stated interest. First, the editorial control of the PTO actually increases the perception that the government is approving trademark content. Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of REDSKINS?*, 52 Stan. L. Rev. 665, 685 (2000). Second, because the PTO is user fee-funded, the PTO actually receives a financial windfall from rejected disparaging trademarks. Because a trademark application fee is non-refundable, the PTO retains the full fee but is not required to provide the ongoing services owed to registered trademarks. USPTO, *Filing Fee Not Refundable*, <http://www.uspto.gov/trademark/trademark-updates-and-announcements/filing-fee-not-refundable> (last visited on Oct. 6, 2015); see *In re McGinley*, 660 F.2d 481, 487 (C.C.P.A. 1981) (listing examples of trademark registration benefits). Lastly, “[n]othing about Section 2(a) impedes the ability of members of society to discuss

[an offensive] trademark that was not registered by the PTO.” *Pro-Football, Inc. v. Blackhorse*, 2015 U.S. Dist. LEXIS 90091, *20 (E.D. Va. July 8, 2015). In the case of commercially valuable offensive trademarks, the denial of registration and the attendant exclusivity likely causes the proliferation of offensive speech.

Courts’ reluctance to justify Section 2(a)’s prohibition on disparaging trademarks under the *Central Hudson* analysis is understandable; any interest is too weak to survive constitutional scrutiny. Understanding this, courts have attempted to justify Section 2(a)’s restrictions by denying that trademark registration involves the exercise of free speech at all—an untenable argument given the expansive scope of speech that the First Amendment protects. The fallback position is that no speech is abridged by the denial of trademark registration. Here, too, the argument does not survive closer analysis. The significant benefits available through trademark registration evince both the debilitating burden placed on the use of an unregistrable trademark and severity of the coercion by placing unconstitutional conditions on their receipt. The abridgement of commercial speech by Section 2(a) has not been—and cannot be—adequately justified under the *Central Hudson* test. The proffered interests are inappropriate, circular, or too weak. Even assuming that the interests are substantial, the government’s argument still fails owing to the complete absence of a nexus between the purported interests and the effect of denying registration to disparaging trademarks. The exercise of the most sacred of constitutional rights

should not rise and fall based upon the anemic justifications offered for the content-based commercial speech restrictions in Section 2(a).

CONCLUSION

The Court of Appeals for the Federal Circuit incorrectly affirmed the TTAB's and PTO's determination that the trademark "DUMB BLONDE" may be disparaging in violation of Section 2(a) of the Lanham Act. Additionally, the Federal Circuit correctly held that Section 2(a) violated the First Amendment's free speech guarantees. For the aforementioned reasons, this Court should reverse the judgment of the Federal Circuit regarding the disparaging nature of the trademark "DUMB BLONDE" and affirm the judgment regarding the constitutionality of Section 2(a) of the Lanham Act.

CERTIFICATE OF ADHERENCE TO COMPETITION RULES

All team members understand the Rules of the Competition and have adhered to all rules in the writing of this brief. We have not received any assistance in writing this brief, and this brief represents the work product solely of our team's members.

Team No. 102 /s/