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**In the Supreme Court of the  
United States**

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**United States, *Petitioner,***

**v.**

**Kourtney Luhv, *Respondent.***

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

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**BRIEF FOR THE RESPONDENT**

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*Counsel for Respondent  
October 20, 2015*

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## QUESTIONS PRESENTED FOR REVIEW

1. Did the Trademark Trial and Appeal Board err in rejecting solo music artist Kourtney Luhv's application to register the trademark DUMB BLONDE when the mark will not be perceived as disparaging under Section 2(a) of the Lanham Act to a substantial composite of blonde women in connection to the goods and services listed in the application?
2. Is Section 2(a)'s prohibition on registering marks that may be disparaging an unconstitutional violation of the First Amendment and the void for vagueness doctrine?

## TABLE OF CONTENTS

QUESTIONS PRESENTED FOR REVIEW.....	i
TABLE OF CONTENTS.....	ii, iii, iv, v
TABLE OF AUTHORITIES.....	vi, vii, viii, ix, x, xi
STATEMENT OF JURISDICTION.....	xii
STATUTORY AND CONSTITUTIONAL PROVISIONS INVOLVED.....	xii
OPINION BELOW.....	xii
STATEMENT OF THE CASE.....	1
SUMMARY OF THE ARGUMENT.....	4
ARGUMENT.....	7
<b>I. THE FEDERAL CIRCUIT ERRED IN CONCLUDING THAT THE MARK DUMB BLONDE IS DISPARAGING TO A SUBSTANTIAL COMPOSITE OF WOMEN BECAUSE THE MEANING OF THE MARK IS NEITHER OFFENSIVE NOR INSULTING, AND THERE IS NO SUBSTANTIAL EVIDENCE THAT THE MARK IS DISPARAGING TO A SUBSTANTIAL COMPOSITE OF BLONDE WOMEN.....</b>	<b>7</b>
A. The likely meaning of the mark DUMB BLONDE, when considered in combination with the dictionary definition, the nature and manner in which the mark is used in the marketplace in connection with the goods or services, and the intent of the applicant, is neither offensive nor insulting.....	9
1. The dictionary definition of “dumb blonde” is not dispositive and therefore is not the sole factor this Court should utilize in determining the meaning of the mark DUMB BLONDE.....	10
2. The mark DUMB BLONDE is neither offensive nor insulting because there is nothing about the way the mark is used in the marketplace from which one would perceive the mark as meaning the dictionary definition of “dumb blonde.”.....	12

3.	The mark DUMB BLONDE’s meaning should not be found to be insulting or offensive because Luhv is a blonde woman and her intent behind registering the mark is about reclaiming the phrase and eliminating the stereotype through her platform as a famous musician.....	15
B.	The meaning of the mark DUMB BLONDE is not disparaging to a substantial composite of the proper referenced group, blonde women, because there is no substantial evidence to support the claim that the mark is disparaging to a substantial composite of blonde women.....	16
1.	“Blonde Women” is the referenced group in the mark DUMB BLONDE because blonde women are referred to, identified, and implicated in a recognizable manner.....	17
2.	The Federal Circuit erred when affirming the PTO and TTAB findings that significant evidence suggested that DUMB BLONDE was disparaging to a substantial composite of women because the proper referenced group is blonde women, and Luhv satisfactorily rebutted the prima facie case of disparagement.....	18
<b>II.</b>	<b>SECTION 2(a) OF THE LANHAM ACT VIOLATES THE FIRST AMENDMENT BECAUSE IT IS AN UNCONSTITUTIONAL RESTRICTION ON SPEECH.....</b>	<b>22</b>
A.	Trademarks regulated by the Lanham Act are protected speech because they constitute both commercial and expressive speech and the trademark registration program is not government speech.....	22
1.	Trademarks constitute protected commercial speech inextricably intertwined with expressive speech because trademark holders use their marks as a means for social commentary in a manner inseparable from their commercial purpose.....	22
2.	The Federal trademark registration program does not amount to government speech because it is not used by	

	the government to convey a message and it is not closely identified with the government in the public’s mind.....	24
	a. The Federal trademark registration program does not convey a message by government, rather, it merely provides notice of registration.....	25
	b. The Federal trademark register is not closely associated with the government in the mind of the public because there is no indicia of the United States on a trademark.....	26
B.	Section 2(a) abridges speech in a manner implicating the First Amendment because it causes applicants to self-censor and imposes an unconstitutional condition on receipt of a federal benefit.....	27
	1. Section 2(a) causes an applicant to self-censor in hopes of receiving the benefits of trademark registration.....	27
	2. Section 2(a) imposes an unconstitutional condition on obtaining trademark registration because it hinges the benefits of registration on constitutionally protected speech.....	29
C.	Section 2(a) fails intermediate scrutiny because the government has not asserted a substantial interest directly advanced by the regulation and it is more extensive than necessary.....	29
	1. The government does not have a valid substantial interest in discouraging offensive marks or appearing to endorse such marks.....	30
	2. Section 2(a) does not directly advance the government’s interest because marks that may be offensive are still published on the trademark register.....	31
	3. Section 2(a) is more extensive than necessary to serve the government’s asserted interest because it prohibits registration of marks that the TTAB has deemed not disparaging.....	32

D.	Section 2(a) of the Lanham Act is a content based regulation because it permits the denial of trademark registration based on the message the trademark conveys.....	33
<b>III.</b>	<b>SECTION 2(a) OF THE LANHAM ACT IS UNCONSTITUTIONALLY VAGUE BECAUSE IT FAILS TO PROVIDE ADEQUATE NOTICE OF WHAT IS PROHIBITED AND IS ARBITRARILY APPLIED.....</b>	<b>34</b>
A.	Section 2(a) does not provide adequate notice because the term “disparage” is inherently subjective and unclear.....	34
B.	Section 2(a) is arbitrarily and discriminatorily enforced as evidenced by TTAB jurisprudence because the determination of whether a mark is “disparaging” has been inconsistently analyzed.....	35
	CONCLUSION.....	36
	CERTIFICATION.....	38

## TABLE OF AUTHORITIES

### UNITED STATES SUPREME COURT CASES

<i>Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.</i> , 133 S. Ct. 231 (2013) .....	29
<i>American Comm’ns Assoc. v. Douds</i> , 339 U.S. 382 (1950) .....	27
<i>B &amp; B Hardware, Inc. v. Hargis Ind., Inc.</i> , 135 S. Ct. 1293 (2015) .....	7, 28
<i>Bolger v. Young Drug Prods. Corp.</i> , 463 U.S. 60 (1983) .....	30
<i>Cent. Hudson Gas &amp; Elec. Corp. v. Pub. Serv. Comm’n</i> , 447 U.S. 557 (1980) .....	4, 22, 29, 30, 32,37
<i>Consol. Edison Co. of New York v. N.L.R.B.</i> , 305 U.S. 197 (1938) .....	19
<i>Dickinson v. Zurko</i> , 527 U.S. 150 (1999) .....	8, 18
<i>Fed. Commc’n Comm’n v. Fox Television Stations, Inc.</i> , 132 S. Ct 2307 (2012) .....	34
<i>Friedman v. Roger</i> , 440 U.S. 1 (1979) .....	22, 23
<i>Grayned v. City of Rockford</i> , 408 U.S. 104 (1972) .....	35
<i>Leathers v. Medlock</i> , 499 U.S. 439 (1991) .....	27

<i>Nat’l Endowment for the Arts v. Finley</i> ,	
524 U.S. 569 (1998) .....	34
<i>Perry v. Sindermann</i> ,	
408 U.S. 593 (1972) .....	29
<i>Pleasant Grove City, Utah v. Summum</i> ,	
555 U.S. 460 (2009) .....	24, 25, 26
<i>Reed v. Town of Gilbert, Ariz.</i> ,	
135 S. Ct. 2218 (2015) .....	33
<i>Reno v. American Civil Liberties Union</i> ,	
521 U.S. 844 (1997) .....	34
<i>Riley v. Nat’l Fed’n of the Blind, Inc.</i> ,	
487 U.S. 781 (1988) .....	23
<i>Roth v. United States</i> ,	
354 U.S. 476 (1957) .....	22
<i>Schneider v. Irvington</i> ,	
308 U.S. 147 (1939) .....	27
<i>Simon &amp; Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.</i> ,	
502 U.S. 105 (1991) .....	28
<i>Sorrell v. IMS Health Inc.</i> ,	
131 S. Ct. 2653 (2011) .....	30
<i>Texas v. Johnson</i> ,	
491 U.S. 397 (1989) .....	5, 22
<i>Thompson v. Western States Medical Center</i> ,	
535 U.S. 357 (1989) .....	30



<i>Turner Broadcasting System, Inc. v. F.C.C.</i> , 512 U.S. 622 (1994) .....	33
<i>Universal Camera Corp. v. N.L.R.B.</i> , 340 U.S. 474 (1951) .....	19
<i>Va. State Bd. of Pharmacy v. Va. Citizens Consumer</i> , 425 U.S. 748 (1976) .....	23, 24
<i>Walker v. Texas Div., Sons of Confederate Veterans, Inc.</i> , 135. S. Ct. 2239 (2015) .....	25, 26
<i>Ward v. Rock Against Racism</i> , 491 U.S. 781 (1989) .....	33

**UNITED STATES COURT OF APPEALS CASES**

<i>In re Boulevard Entm't</i> , 334 F.3d 1336 (Fed. Cir. 2003).....	10, 13, 14
<i>In re Gartside</i> , 203 F.3d 1305 (Fed. Cir. 2000).....	9, 19
<i>In re Geller</i> , 751 F.3d 1355 (Fed. Cir. 2014).....	9, 10, 11, 12, 15
<i>In re Kourtney Luhv</i> , 1337 F.3d 455 (Fed. Cir. 2015).....	1, 2, 3, 4, 14, 16, 18, 20, 21, 22, 23, 24, 30
<i>In re Pacer Technology</i> , 338 F.3d 1348 (Fed. Cir. 2003).....	8
<i>In re Tam</i> , 785 F.3d 567 (Fed. Cir. 2015), <i>reh'g granted en banc</i> , 600 Fed. Appx. 775 (Mem) .....	23, 25, 36

<i>Nissan Motor Co. v. Nissan Computer Corp.</i> , 378 F.3d 1002 (9th Cir. 2004) .....	33
<i>Recot, Inc. v. Becton</i> , 214 F.3d 1322 (Fed. Cir. 2000).....	9

**FEDERAL DISTRICT COURT CASES**

<i>Pro-Football, Inc. v. Harjo</i> , 284 F. Supp. 2d 96 (D.D.C. 2003) .....	12, 17, 18, 19
--	----------------

**ADMINISTRATIVE DECISIONS**

<i>Boswell v. Mavety Media Grp. Ltd.</i> , 52 U.S.P.Q.2d 1600 (T.T.A.B. 1999) .....	31
<i>In re Condas S.A.</i> , 188 U.S.P.Q.2d 544 (T.T.A.B. 1975) .....	35
<i>In re Heeb Media LLC</i> , 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008) .....	8, 12, 13, 14, 17, 19, 20, 21
<i>In re Hines</i> , 31 U.S.P.Q.2d, 1685 (T.T.A.B. 1994) .....	17
<i>In re Lebanese Arak Corp.</i> , 94 U.S.P.Q.2d 1215 (2010) .....	8, 9, 10, 11, 19
<i>In re McGinely</i> , 660 F.2d 481 (C.C.P.A. 1981) .....	4, 27
<i>In re Old Glory Condom Corp.</i> , 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993) .....	26, 31

<i>In re In Over Our Heads Inc.</i> ,	
16 U.S.P.Q.2d 1653 (T.T.A.B. 1990) .....	35
<i>In re Squaw Valley Dev. Co.</i> ,	
80 U.S.P.Q.2d 1264 (T.T.A.B. 2006) .....	12, 17, 32
<i>In re Wilcher Corp.</i> ,	
40 U.S.P.Q.2d 1929 (T.T.A.B. 1996) .....	9
<i>Harjo v. Pro-football Inc.</i> ,	
50 U.S.P.Q.2d 1705 (T.T.A.B. 1999) .....	12
<i>McDermott v. San Francisco Women’s Motorcycle Contingent</i> ,	
81 U.S.P.Q.2d 1212 (T.T.A.B. 2006) .....	15, 16
<b>FEDERAL STATUTES</b>	
5 U.S.C.A. § 706(2)(E) .....	9
15 U.S.C.A. § 1052(a)-(b) .....	4, 8, 25, 27, 34, 35
15 U.S.C.A. § 1071 .....	8
15 U.S.C.A. § 1072 .....	7
15 U.S.C.A. § 1057(b).....	8
15 U.S.C.A. § 1127 .....	29
<b>OTHER</b>	
“ <i>dumb blond</i> ”, Dictionary.com, <a href="http://dictionary.reference.com/browse/dumb-blond">http://dictionary.reference.com/browse/dumb-blond</a> .....	11
Hearings on H.R. 4744 before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess. 18 (1939) (statement of Leslie Frazer, Assistant Commissioner of Patents).....	35
<a href="http://www.uspto.gov/kids/disclaimer.html">http://www.uspto.gov/kids/disclaimer.html</a> .....	25
<a href="http://www.uspto.gov/learning-and-resources/trademark-faqs">http://www.uspto.gov/learning-and-resources/trademark-faqs</a> .....	27

3 McCarthy on Trademarks and Unfair Competition

§ 19:9 (4th ed. 2015) § 19:3 at 19-21 ..... 7

## **STATEMENT OF JURISDICTION**

The judgment of the United States Court of Appeals for the Federal Circuit was entered on June 6, 2015. This Court has jurisdiction under 28 U.S.C. § 1254(1).

## **STATUTORY AND CONSTITUTIONAL PROVISIONS INVOLVED**

1. U.S. Const. amend. I
2. 15 U.S.C. § 1052 (a)-(b) (West 2015).
3. 5 U.S.C. § 706(2)(E) (West 2015).
4. 15 U.S.C. § 1057(b) (West 2015).
5. 15 U.S.C. § 1127 (West 2015).

## **OPINION BELOW**

The opinion of the United States Court of Appeals for the Federal Circuit and the dissenting opinion are reported at 1337 F.3d 455 (Fed. Cir. 2015).

## STATEMENT OF THE CASE

Kourtney Luhv (Luhv), known by her stage name Dumb Blonde, is a solo artist whose music involves multiple genres. *In re Kourtney Luhv*, 1337 F.3d 455, 455 (Fed. Cir. 2015). Since 2012, Luhv has been performing under her stage name Dumb Blonde all over the southern Calidonia region as well as in various other states. *Id.* Luhv’s lyrics focus on issues faced by women in today’s society. *Id.*

Luhv has a devoted fan base consisting of those who frequently attend her concerts, 40,000 followers on the online music streaming service “Soundpuff,” and over 100,000 active subscribers of her account “DumbBlonde Music” on “uTube” that she uses to communicate with her fans. *Id.* at 456. In June 2014, Luhv wanted to release music as an extended-play-format record. *Id.* In order to release music as an extended-play-format record, Luhv negotiated a contract with a record label which included a \$2,000,000 advance. *Id.* However, the contract required that Luhv register the mark DUMB BLONDE as a trademark before the contract could be executed and her music could be released. *Id.*

On July 9, 2014, Luhv filed an application with the Patent and Trademark Office (PTO) seeking to register the mark DUMB BLONDE for “[e]ntertainment, namely live performances by a musical band” and for clothing. *Id.* The examining attorney reviewed the application and determined, by citing to materials Luhv submitted in her application, that the mark may be disparaging to women under Section 2(a) of the Lanham Act and refused registration. *Id.*

Luhv contested the application's denial and appealed the decision before the Trademark Trial and Appeal Board (TTAB). *Id.* The TTAB affirmed the examining attorney's decision to refuse registration on the basis that the mark may be disparaging to a substantial composite of the referenced group, blonde women. *Id.* The TTAB cited photographic images from Luhv's website depicting a blonde woman eating plastic fruit and applying Wite-Out® to text displayed on her computer monitor in their refusal, evidence that was not in Luhv's application. *Id.* at 457. The TTAB looked to dictionary definitions, numerous articles, and user comments on Luhv's "uTube" videos to determine that women find the phrase to be offensive and held that the mark DUMB BLONDE may disparage a substantial composite of women. *Id.*

Luhv appealed the TTAB decision for three reasons. First, she claimed that the TTAB erred in affirming the examining attorney's rejection of her application for registration on the basis that the mark may be disparaging. *Id.* As a blonde woman, Luhv contended that she chose the mark DUMB BLONDE to reclaim the stereotype associated with blonde women and as a way to openly discuss gender discrimination. *Id.* at 458. Second, Luhv contended that the views of the women cited by the examining attorney did not accurately reflect the views of her fans or a substantial composite of women. *Id.* Luhv submitted evidence showing positive reception of images on her website featuring a blonde woman depicted as President of the United States. *Id.* at 458. She also submitted evidence such as internet comments on various social media sites including "[y]our ability to bring attention

to the challenges faced by women is inspiring,” “as a blonde woman I totally support you even if the haters gon’ hate,” and “[t]here need to be more women like you serving as positive role models for young girls [...]!” *Id.* Third, Luhv contended that the prohibition on registering marks that may be disparaging in Section 2(a) of the Lanham Act is unconstitutional. *Id.* at 457.

On June 6, 2015, the United States Court of Appeals for the Federal Circuit held that the examining attorney did not err in rejecting Luhv’s application for registration of the trademark DUMB BLONDE because the it found that the mark is disparaging to a substantial composite of women. *Id.* at 460. The Federal Circuit reasoned that the evidence examined by the examining attorney and the TTAB showed that the phrase “dumb blonde” was characterized as offensive or insulting. *Id.* at 457. The Federal Circuit found that evidence supported the fact that the mark, as it appears on Luhv’s website, in connection with her musical performances, and on banners displayed during her musical performances, referred to women in particular who have blonde hair. *Id.*

Although the dissent found the majority’s affirmation of the TTAB’s decision to be correct, the dissent noted that Luhv’s immense following and and the ability of her music to reach the public should be seen as evidence that Luhv is successfully addressing women’s issues in a positive way and “reclaiming a stereotype that has long been viewed as a stigma.” *Id.* at 460-61.

The Federal Circuit found that Section 2(a)’s prohibition on registering marks that may be disparaging is unconstitutional. *Id.* at 459. After finding



trademarks to be protected commercial speech, the Federal Circuit applied the intermediate scrutiny review articulated in *Cent. Hudson Gas & Elec. Corp. v. Pub. Ser. Comm'n*, 447 U.S. 557, 566 (1980). As a threshold matter, the Federal Circuit found that disparaging trademarks do not concern illegal activity nor are misleading. *In re Kourtney Luhv*, 1337 F.3d at 460. Next, it found that an asserted government interest in discouraging the use of offensive marks failed constitutional scrutiny. *Id.* The Federal Circuit reasoned that this substantial interest was not independent of disapproving the speech's message in violation of Supreme Court jurisprudence thus ending the intermediate scrutiny analysis there. *Id.*

The dissent, referring to *In Re McGinely*, 660 F.2d 481, 484 (C.C.P.A. 1981), opined that the First Amendment is not implicated. *Id.* at 461. It also observed that some federal funds are expended to cover the costs of the PTO's operation. *Id.* Therefore, the dissent opined that the unconstitutional conditions doctrine does not apply. *Id.* Finally, the dissent stated that the government has a substantial interest in not appearing to endorse offensive or disparaging marks. *Id.*

### **SUMMARY OF ARGUMENT**

Under the Lanham Act, a mark will be refused registration if it consists of [...] matter which may disparage [...]. 15 U.S.C.A. § 1052(a).

The Federal Circuit erred when it refused to register DUMB BLONDE under Section 2(a) because when determining the likely meaning of the mark DUMB BLONDE, taking into account the dictionary definition, the nature and the manner in which the mark is used in the marketplace, and the intent of Luhv, the likely

meaning is not disparaging. The dictionary definition of “dumb blonde” is not dispositive and this Court should look into additional evidence submitted by Luhv and find that disparate views are clearly present within the proper referenced group, blonde women.

Further, the Federal Circuit erred when it held that a substantial composite of women find the mark DUMB BLONDE disparaging because the proper referenced group, blonde women, are the targeted persons referred to, identified, and implicated in a recognizable manner when looking at the mark.

This Court should reverse the TTAB’s findings of fact because Luhv has met her burden of establishing that the findings of fact are unsupported by substantial evidence. When examining the record as a whole, taking into account both evidence that justifies and detracts from the PTO and TTAB’s decision, there is no substantial evidence that finds that blonde women, the proper referenced group, perceive the mark DUMB BLONDE as disparaging.

Therefore, this Court should find that the mark DUMB BLONDE is not disparaging to a substantial composite of blonde women.

Section 2(a)’s prohibition on registering marks that may be disparaging violates the First Amendment of the United States Constitution and is void for vagueness.

“If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.” *Texas v. Johnson*, 491 U.S. 397, 414 (1989).

Courts will not uphold a restriction on speech when the speech involved is protected speech, the government abridges that speech, and the regulation does not pass constitutional scrutiny.

Trademarks have traditionally been treated as protected commercial speech. However, trademarks are also inextricably intertwined with expressive speech. Furthermore, the trademark registration program does not amount to government speech and thus, is not exempt from the First Amendment.

Section 2(a) abridges speech in a manner that implicates the First Amendment. While Section 2(a) does not impose an absolute ban on the use of the trademark, it deprives a trademark applicant of significant rights and benefits if not complied with. Inevitably then, applicants will self-censor in an effort to comply with Section 2(a) resulting in the chilling of speech that the First Amendment attempts to prevent. In addition, Section 2(a) imposes an unconstitutional condition on obtaining a trademark registration by hinging its benefits on constitutionally protected speech.

Courts reviewing regulations on commercial speech have applied intermediate scrutiny. Courts are also able to perform strict scrutiny review because trademarks are inextricably intertwined commercial and expressive speech. In addition, Section 2(a) is a content based regulation. Content based regulations have traditionally been reviewed under strict scrutiny. Because Section 2(a) cannot withstand constitutional scrutiny, it violates the First Amendment.

In addition to violating the First Amendment, Section 2(a) is unconstitutionally vague. The void for vagueness doctrine requires that a regulation provide adequate notice of what is prohibited and that it not permit enforcement of the regulation in an arbitrary or subjective manner. Section 2(a) does not provide adequate notice because the term “disparage” is inherently subjective. Furthermore, TTAB jurisprudence establishes that Section 2(a) has been arbitrarily and discriminatorily enforced.

## ARGUMENT

### **I. THE FEDERAL CIRCUIT ERRED IN CONCLUDING THAT THE MARK DUMB BLONDE IS DISPARAGING TO A SUBSTANTIAL COMPOSITE OF WOMEN BECAUSE THE MEANING OF THE MARK IS NEITHER OFFENSIVE NOR INSULTING, AND THERE IS NO SUBSTANTIAL EVIDENCE THAT THE MARK IS DISPARAGING TO A SUBSTANTIAL COMPOSITE OF BLONDE WOMEN.**

It is important for an entertainment artist to protect and distinguish their mark from other marks in the same trade. *B & B Hardware, Inc. v. Hargis Industries, Inc.*, 135 S. Ct. 1293, 1299 (2015). The Lanham Act confers “important legal rights and benefits” on trademark owners who register their marks. 3 McCarthy on Trademarks and Unfair Competition § 19:9 (4th ed. 2015). Registration of the mark serves as “constructive notice of the registrant’s claim of ownership.” 15 U.S.C.A § 1072 (West 2015). It also is “prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner’s ownership of the mark, and of the owner’s exclusive right to use the registered mark

in commerce on or in connection with the goods or services specified in the certificate.” 15 U.S.C.A. §1057(b) (West 2015).

Under the Lanham Act, a mark will be refused registration if it consists of [...] matter which may disparage. 15 U.S.C.A. § 1052(a) (West 2015).

The determination whether a proposed mark is disparaging requires application of the following two-part test:

- 1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also 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, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

*In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010).

To justify refusal to register a trademark under the first clause of Section 1052(a), the PTO has a burden of establishing a “prima facie case of disparagement.” *In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071, 1078 (T.T.A.B. 2008). In evaluating the examining attorney’s evidence, the TTAB must “look only for substantial evidence, or more than a scintilla of evidence, in support of the PTO’s prima facie case.” *In re Pacer Technology*, 338 F.3d 1348, 1348 (Fed. Cir. 2003). In *Dickinson v. Zurko*, this Court held that in reviewing a decision made by the PTO, the Federal Circuit must apply the “substantial evidence.” 527 U.S. 150, 165 (1999).

After the *Zurko* decision, the Federal Circuit has concluded that the Administrative Procedure Act’s (APA) “substantial evidence” test, is the appropriate standard for findings of fact by the PTO, an agency subject to the APA’s constraints.

*In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000). In addition, the Federal Circuit has concluded that the Supreme Court's holding is also applicable to findings of fact made by the TTAB. *Recot, Inc. v. Becton*, 214 F.3d 1322 (Fed. Cir. 2000). Therefore, this Court will reverse the TTAB's findings of fact only if they are "unsupported by substantial evidence" as indicated in the APA. 5 U.S.C.A. § 706(2)(E) (West 2015).

**A. The likely meaning of the mark DUMB BLONDE, when considered in combination with the dictionary definition, the nature and manner in which the mark is used in the marketplace in connection with the goods or services, and the intent of the applicant, is neither offensive nor insulting.**

To determine whether a proposed mark may disparage, "the likely meaning of the matter in question" must be determined and courts have looked at several factors, including dictionary definitions. *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d at 1217. The nature and "the manner in which the mark is used in the marketplace in connection with the goods and services," and the applicant's intent behind registering the mark are also considered. *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014).

The relationship of the matter to the other elements in the mark is a factor considered by the courts. *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929, 1933 (T.T.A.B. 1996) (reasoning that because the mark DICK HEADS was included underneath a cartoon of a human head comprised of male genitalia, the mark was vulgar.) But here, the mark DUMB BLONDE does not include other elements. It stands alone. Therefore, the relationship of the matter to the other elements in the mark cannot be a factor considered in determining the likely meaning of DUMB BLONDE.

**1. The dictionary definition of “dumb blonde” is not dispositive and therefore is not the sole factor this Court should utilize in determining the meaning of the mark DUMB BLONDE.**

The determination of whether a mark is disparaging involves “taking into account not only dictionary definitions but also the relationship of the matter to the other elements in the mark [...]” *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d at 1217.

“In a case in which the evidence shows that the mark has only one pertinent meaning, dictionary evidence alone can be sufficient to satisfy the PTO’s burden.” *In re Boulevard Entm’t*, 334 F.3d 1336, 1341 (Fed. Cir. 2003) (determining that the term “jack-off” meant “vulgar” and not any other meaning, because of the specific way the mark was being used in connection with adult entertainment).

In *In re Lebanese Arak Corp.*, the applicant wanted to register the mark KHORAN to be used as a trademark for alcoholic beverages. 94 U.S.P.Q.2d at 1217. Finding that the word “Khoran” has varied spellings, the TTAB looked at the definition for the word “Qur’an” and found that the definition referred to the holy book of Islam, a religion where alcohol is prohibited. *Id.* at 1219. To determine the meaning of the mark, the TTAB looked at additional evidence including websites that discussed the “Qur’an,” which contained comments from the public, and articles on the internet that used the mark. *Id.* The TTAB found that by looking at the collective evidence, the use of the mark for alcoholic beverages was disparaging to Muslims. *Id.*

In *In re Geller*, an applicant sought to register the mark “STOP THE ISLAMISATION OF AMERICA” in connection with “understanding and preventing

terrorism.” 751 F.3d at 1356-57. To determine the meaning of the mark, *Geller* examined dictionary definitions of the related word “Islamize” and found that the word meant to “conform to Islam.” *Id.* at 1359. *Geller* also examined essays that discussed the word “Islamisation,” comments left on the applicant’s website, various blogs, and found that the evidence reflected “the religious meaning of Islamisation, and evidenced a desire to stop the spread of Islam in America.” *Id.* at 1361. *Geller* held, after examining the collective evidence, that the meaning of the mark was religious. *Id.* Because the word “Islamisation” was determined to be religious, the entire mark as used by the applicant evidenced intent to disparage the religion and the court refused registration. *Id.*

Here, *Dictionary.com* defines “dumb blond,” also spelled “dumb blonde,” as “a light-haired woman who is stereotyped as beautiful but unintelligent”. “*dumb blond*”, *Dictionary.com*, <http://dictionary.reference.com/browse/dumb-blond> (last visited Oct. 16, 2015). This Court should look to other forms of evidence to determine whether the dictionary definition alone determines the likely meaning of the mark. In both *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d at 1215, and *In re Geller*, 751 F.3d at 1356, the other evidence referencing the mark examined by the TTAB and the Federal Circuit supported the dictionary definition. In the case at hand however, the other evidence, including Luhv’s significant fan following, the specific lyrics Luhv sings that focus on women centered issues, and her intent behind the mark contradict the dictionary definition and therefore the dictionary definition alone is not dispositive.



**2. The mark DUMB BLONDE is neither offensive nor insulting because there is nothing about the way the mark is used in the marketplace from which one would perceive the mark as meaning the dictionary definition of “dumb blonde.”**

Courts determine how the relevant group will perceive a mark by looking at the goods and services as identified in the application. *In re Heeb*, 89 U.S.P.Q.2d at 1075. The use of the mark is presumed to be public use viewable by any member of the references group, including those members of the group who may be offended by the term. *Id. In re Geller*, 751 F.3d at 1361 (determining that using the mark in connection with preventing terrorism “creates a direct association of Islam and its followers with terrorism.”) *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 1267 (T.T.A.B. 2006) (holding that there is no evidence in the record that a substantial composite of Native Americans find applicant's marks on its identified goods and services disparaging because the statements attributed to Native Americans do not address applicant's mark as used on its goods and services at their ski resort.) *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705, 1742 (T.T.A.B. 1999), *rev'd on other grounds, Pro-Football Inc., v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003) (holding that when considered in relation to the other matter comprising at least two of the subject marks and as used in connection with respondent's services, ‘Redskins’ clearly both refers to respondent's professional football team and carries the allusion to Native Americans inherent in the original definition of that word.”)

In *In Re Boulevard*, the applicant entertainment company sought to register the marks 1-800-JACK-OFF and JACK-OFF for “entertainment in the nature of adult orientated conversations by telephone.” 334 F.3d at 1338. Both the examining attorney and the TTAB affirmed the refusal to register on the ground that the marks consisted of scandalous matter. *Id.* at 1338. To affirm the refusal, *Boulevard* relied on four dictionaries and concluded that the term “jack-off” had two meanings; first that the term is offensive and vulgar and second, that it meant a “stupid incompetent person.” *Id.* *Boulevard* held that substantial evidence supported the TTAB’s finding that the term “jack-off” is an offensive and vulgar reference to masturbation. *Id.*

In *In re Heeb*, the applicant sought to register HEEB as a mark for clothing. 89 U.S.P.Q.2d at 1071. The examining attorney found that the dictionary definition of “heeb” is a disparaging reference to Jewish people and that the mark retains the disparaging meaning when used in connection with applicant’s goods and services. *Id.* The applicant argued that the examining attorney “ignored the context and manner in which applicant’s mark is used” specifically, the applicant’s magazine titled “HEEB”, “when determining whether the likely meaning of applicant’s mark is disparaging to the Jewish community.” *Id.* at 1073. However, the TTAB agreed with the examining attorney and reasoned, “while it is useful to understand the context in which the mark is used, we ultimately must determine how the term HEEB will be perceived in connection with the goods and services listed in this application.” *Id.* Further, the TTAB reasoned that while the applicant’s use of the

mark HEEB for a magazine may help determine how the mark will be perceived by the referenced group, the determination is based on the goods and services as identified in the application, which did not include either magazines or the service of publishing magazines. *Id.* at 1076. Therefore, the TTAB held that “there is no dispute that HEEB means a Jewish person and that HEEB has no other meaning pertinent to clothing or entertainment services.” *Id.*

Here, Luhv, a solo artist, uses her mark in connection with the services described in her application, specifically “entertainment, namely live performances by a musical band” and clothing, in a positive light through her lyrics focusing on issues faced by women today during in her live performances in the Southern Calidonia region as well as other states. *In re Kourtney Luhv*, 1337 F.3d at 455. In *Boulevard*, the use of the mark was clearly limited to the vulgar meaning of the word and not the alternate meaning of a stupid or incompetent person when looking at the services of adult orientated conversations via telephone. 334 F.3d at 1341. In *In re Heeb*, the dictionary definition alone was sufficient to satisfy the burden because the mark HEEB only had one pertinent meaning. 89 U.S.P.Q.2d at 1076.

Luhv is distinguishable from both *Boulevard*, 334 F.3d at 1338, and *In re Heeb*, 89 U.S.P.Q.2d at 1076, where the marks were used in the marketplace from which the referenced group would understand the term as meaning the disparaging definition, because DUMB BLONDE as used in the marketplace, specifically the lyrics sung in Luhv’s live performances, will not be perceived by the referenced group as meaning the disparaging definition. *In re Kourtney Luhv*, 1337 F.3d at

456. The Federal Circuit erred when it considered photographic evidence depicted on Luhv's website, specifically a blonde woman eating plastic fruit and applying Wite-Out® to the computer monitor. While the context of DUMB BLONDE is useful, the Federal Circuit should have only considered the specific goods and services listed in Luhv's application and found that the meaning of the mark DUMB BLONDE does not reference the negative definition.

**3. The mark DUMB BLONDE's meaning should not be found to be insulting or offensive because Luhv is a blonde woman and her intent behind registering the mark is about reclaiming the phrase and eliminating the stereotype through her platform as a famous musician.**

The intention of the applicant is an important factor taken into consideration when determining the likely meaning of the mark. *In re Geller*, 751 F.3d at 1359 (reasoning that the intention behind the mark was evident in the appellant's website because the website's comments were "reflective of the website's message of stopping the spread of Islam in the United States.")

In *Dykes on Bikes*, the San Francisco Women's Motorcycle Club (Club) sought to register the mark DYKES ON BIKES for "[e]ducation and [e]ntertainment [s]ervices in the nature of organizing, conducting, and promoting [...] seminars, parties and rallies to support, organize and motivate women motorcyclists everywhere to do the same, thereby fostering pride in a wide variety of sexual orientations and identities, namely lesbian, bisexual and transgender." *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 U.S.P.Q.2d 1212, 1212 (T.T.A.B. 2006).

In the case at hand, the Federal Circuit noted that *Dykes on Bikes* involved evidence consisting of positive public response to the mark DYKES ON BIKES and its use in combination with the Club's prominent role in leading the annual Pride Parade held in San Francisco. *In re Kourtney Luhv*, 1337 F.3d at 458. Further, the Federal Circuit noted that the applicant's intention in *Dykes on Bikes* was to replace the negative meaning of "dykes" with a positive one. *Id.* at 458.

Luhv is similar to *Dykes on Bikes*, where the Club's positive intention was referenced to register the mark, because Luhv chose the mark DUMB BLONDE as a way to reclaim the stereotype associated with blonde women and raise awareness of the challenges stemming from gender discrimination and negative stereotypes. *Id.* at 455. In addition, Luhv "aims to recast the phrase in a positive light by displaying it prominently alongside a woman with a successful career, and through musical lyrics that shed light on critical issues faced by women." *Id.* at 458. Therefore, this Court should look to Luhv's intent and find that because the intent of registering DUMB BLONDE is not to disparage the referenced group but is instead intending to provoke a positive change, the Court should not find the mark disparaging.

**B. The meaning of the mark DUMB BLONDE is not disparaging to a substantial composite of the proper referenced group, blonde women, because there is no substantial evidence to support the claim that the mark is disparaging to a substantial composite of blonde women.**

"Whether a proposed mark is disparaging must be determined from the standpoint of a substantial composite of the referenced group (although not

necessarily a majority).” *In re Squaw Valley*, 80 U.S.P.Q.2d at 1269. The substantial composite standpoint looks to the perceived views of the referenced group, not the views of the general public, because the general public perception of the mark is only used when determining whether a mark is scandalous, not disparaging. *In re McGinley*, 660 F.2d at 485.

**1. “Blonde Women” is the referenced group in the mark DUMB BLONDE because blonde women are referred to, identified, and implicated in a recognizable manner.**

In determining whether or not a mark is disparaging, the perceptions of the general public are irrelevant. *In re Hines*, 31 U.S.P.Q.2d, 1685, 1688 (T.T.A.B. 1994), *vacated on other grounds*, *In re Hines*, 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994). The perceptions of the general public are irrelevant because the portion of Section 2(a) proscribing disparaging marks targets certain persons, institutions, or beliefs. *In re Hines*, 31 U.S.P.Q.2d at 1688. Only the perceptions of those referred to, identified, or implicated in some recognizable manner by the involved mark, is relevant to the determination of whether a mark is disparaging. *Id.* Who “comprises the targeted, or relevant, group” must be answered “on the basis of the facts in each case.” *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 145 n. 25., *quoting Harjo II*, 50 U.S.P.Q.2d at 1739. *In re Heeb*, 89 U.S.P.Q.2d at 1076 (reasoning that because the dictionary definitions defined “heeb” as offensive to a Jewish person or “a derog. term for a Jew.”, there is no dispute that the referenced group in the mark HEEB is Jewish people.)

On the basis of the facts in this case, it is clear that blonde women are the proper targeted persons because blonde women are referred to, identified, and implicated in a recognizable manner in the mark DUMB BLONDE. Luhv, a blonde woman, sought to trademark DUMB BLONDE for “entertainment, namely live performances by a musical band” and clothing for the purpose of reclaiming the stereotype associated with blonde women. *In re Kourtney Luhv*, 1337 F.3d at 457. In addition, Luhv’s website, in connection with her musical performances, and on banners displayed during her musical performances, specifically depict women who have a blonde hair. *Id.* Further, the Federal Circuit even concluded, “the mark is likely intended to refer to women who have a blonde hair color.” *Id.* Therefore, whether the mark DUMB BLONDE is disparaging must be determined from the standpoint of a substantial composite of blonde women.

**2. The Federal Circuit erred when affirming the PTO and TTAB findings that significant evidence suggested that DUMB BLONDE was disparaging to a substantial composite of women because the proper referenced group is blonde women, and Luhv satisfactorily rebutted the prima facie case of disparagement.**

Whether a proposed mark is disparaging is determined from the standpoint of a substantial composite of the referenced group, not society as a whole. *Harjo*, 284 F. Supp. 2d at 128. A court can reverse the TTAB’s findings of facts if the registrant has met their burden of establishing that the findings are unsupported by substantial evidence. *Zurko*, 527 U.S. at 162.

“Substantial evidence is more than a mere scintilla.” *Consol. Edison Co. of New York v. N.L.R.B.*, 305 U.S. 197, 217 (1938). Substantial evidence requires the reviewing court to ask whether a “reasonable mind might accept as adequate” a particular evidentiary record as “adequate to support a conclusion.” *Harjo*, 284 F. Supp. 2d at 115-117, *quoting Consol. Edison Co.*, 305 U.S. at 229.

A review for substantial evidence involves examining the record as a whole, taking into account evidence that both justifies and detracts from an agency’s decision. *In re Gartside*, 203 F.3d 1305, 1312 (Fed. Cir. 2000), *citing Universal Camera Corp. v. N.L.R.B.*, 340 U.S. 474, 487-88 (1951). *Harjo*, 284 F. Supp. 2d at 130-134 (holding that by focusing on the general public and inferring that the Native Americans would simply agree with those views, the TTAB made a decision unsupported by substantial evidence and not relevant to the legal question in the case). *In re Lebanese*, 94 U.S.P.Q.2d at 1219 (reasoning that evidence submitted by the examining attorney, showing that drinking alcohol is considered unacceptable to Muslims, is sufficient to show that the use of the name of the sacred text of Islam for a substance prohibited by that religion would be disparaging to the followers of Islam).

In *In re Heeb*, the TTAB found that the examining attorney had met her burden of providing more than a scintilla of evidence and that the applicant had not satisfactorily rebutted the prima facie case of disparagement. 89 U.S.P.Q.2d at 1078. *Heeb* held that the record clearly evidenced that a substantial composite of the referenced group, Jewish persons, considered HEEB to be a disparaging term.



*Id.* at 1079. *Heeb* reasoned that the examining attorney’s presentation of evidence of various segments from persons of the Jewish community supported this conclusion.

*Id.* Although the applicant submitted evidence that college-age Jewish persons supported the applicant’s contention of term HEEB, applicant’s evidence did not erase the examining attorney’s evidence that post-college age Jewish persons found the mark disparaging. *Id.* Therefore, *Heeb* held that the applicant’s identified goods and services “must be deemed encountered by all members of the referenced group.” *Id.*

The Federal Circuit erred when it found that the TTAB’s opinion in *In re Heeb* persuasive thereby affirming the TTAB’s refusal to register the mark. *In re Kourtney Luhv*, 1337 F.3d at 459. The opinion in *Heeb* should not be found persuasive to determine the case at hand for two reasons.

First, in *Heeb*, the record supported the fact that the mark was disparaging to all members of the referenced group. 89 U.S.P.Q.2d at 1071. Here, the Federal Circuit concluded that, “the mark is likely intended to refer to women who have a blonde hair color.” *In re Kourtney Luhv*, 1337 F.3d at 457. Although the Federal Circuit concluded that the referenced group the mark likely intended to refer to was *blonde* women, it did so by reasoning “significant evidence suggested that women view ‘dumb blonde’ jokes negatively” and therefore held that that the evidence presented demonstrated that the mark DUMB BLONDE implied a negative stereotypical view of women, and characterized it as offensive or insulting. *Id.* at 457 (emphasis added). However, distinguishable from *Heeb*, 89 U.S.P.Q.2d at 1071,

where the record evidenced findings specific to the referenced group, the Federal Circuit record is silent as to what evidence the examining attorney submitted that supports the finding that DUMB BLONDE, in connection with the goods and services listed in the application, is disparaging to the proper referenced group, blonde women, and not just women in general.

Second, as reasoned in *Heeb*, courts in their analysis will only consider how marks will be perceived in connection with the goods and services listed in the application. *Id.* The Federal Circuit can only look to the goods and services listed in Luhv's application, which states that Luhv intends to register the mark for "[e]ntertainment, namely live performances by a musical band" and clothing. *In re Kourtney Luhv*, 1337 F.3d. at 456. The only evidence the TTAB cited to the referenced group, blonde women, consisted of images from Luhv's website depicting a blonde woman eating plastic fruit and applying Wite-Out® to text displayed on her computer monitor. *Id.* at 456-457. In contrast, Luhv presented disparate evidence of the proper referenced group, blonde women, that showed a blonde woman who posted a positive comment on Luhv's webpage that stated "your ability to bring attention to the challenges faced by women is inspiring," "as a blonde woman, I totally support you even if the haters gon' hate," and "there needs to be more women like you serving as positive role models for young girls [...]." *Id.* at 458.

Therefore, using the *Heeb* opinion that the Federal Circuit found to be persuasive, the Federal Circuit erred when considering photographic evidence on a webpage that is not listed as a good or service on Luhv's application, to determine

that DUMB BLONDE was disparaging to a substantial composite of blonde women. *Id.* at 456. A reasonable mind will not accept as adequate a record that lacks any reference to evidence that a substantial composite of blonde women finds DUMB BLONDE disparaging. Luvv has rebutted the prima facie case of disparagement establishing that a substantial composite of the proper referenced group, blonde women, find the mark DUMB BLONDE disparaging.

## **II. SECTION 2(a) OF THE LANHAM ACT VIOLATES THE FIRST AMENDMENT BECAUSE IT IS AN UNCONSTITUTIONAL RESTRICTION ON SPEECH.**

Restrictions on speech are prohibited if three requirements are met. First, the speech being restricted must be protected speech. *Roth v. United States*, 354 U.S. 476, 481 (1957). Second, the government must take some action to abridge that speech. *Texas v. Johnson*, 491 U.S. 397, 405 (1989). Finally, the abridgment does not pass constitutional scrutiny when analyzed under the appropriate framework. *Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 566.

### **A. Trademarks regulated by the Lanham Act are protected speech because they constitute both commercial and expressive speech and the trademark registration program is not government speech.**

#### **1. Trademarks constitute protected commercial speech inextricably intertwined with expressive speech because trademark holders use their marks as a means for social commentary in a manner inseparable from their commercial purpose.**

This Court has made clear that trademarks are protected commercial speech within the realm of First Amendment protection. *Friedman v. Roger*, 440 U.S. 1, 11

(1979). Additionally, this Court has stated that if commercial speech and fully protected speech are “inextricably intertwined,” it will treat the entire speech as fully protected. *Riley v. Nat’l Fed’n of the Blind, Inc.*, 487 U.S. 781, 796 (1988) (finding commercial speech inextricably intertwined with expressive speech because it was impossible to separate solicitations from expressive speech). While this Court has never explicitly held that trademarks inextricably intertwine commercial speech with expressive speech, it has suggested that trademarks do sometimes amount to *more* than just commercial speech. *Friedman v. Roger*, 440 U.S. at 12 (noting that “if the purpose of using a trademark is strictly business, it is commercial speech and nothing more.”)

While some trademarks serve merely as source identifiers, trademarks in many instances inextricably intertwine commercial elements with expressive elements. For example, a band name may serve as an identifier while simultaneously conveying a political message. *In re Tam*, 785 F.3d 567, 570 (Fed. Cir. 2015) (involving a music group comprised of people with Asian heritage who attempted to “take on the stereotypes that people have about [Asian people] like the slanted eyes, and own them.”), *reh’g granted en banc*, 600 Fed. Appx. 775 (Mem).

Here, the Federal Circuit erroneously equated commercial speech with expressive speech. *In Re Kourtney Luhv*, 1337 F.3d at 447. To be sure, commercial speech is a concept distinct from expressive speech. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer*, 425 U.S. 748, 758 (1976). However, the Federal Circuit’s confusion is understandable given the unique nature of trademarks as both

commercial and expressive speech. Here, Luhv attempts to reclaim the stereotype associated with blonde women and raise awareness of the challenges stemming from gender discrimination. *In Re Kourtney Luhv*, 1337 F.3d at 459. While Luhv’s mark will also inform the public as to “who is producing and selling what product,” *Va. State Bd. of Pharmacy*, 425 U.S. at 765, her expressive elements cannot be separated. Luhv is an influential musician who has been performing under the mark for several years. *In re Kourtney Luhv*, at 455. The use of the mark here inevitably expresses her own social commentary on issues faced by women in today’s society, directly echoing her song lyrics. With her lyrics, performances, and celebrity status, Luhv intends to provoke cultural and political discussions about women and society that are within the classic realm of speech protected by the First Amendment.

Because Luhv cannot separate the expressive nature of the mark DUMB BLONDE from the commercial nature, the trademark is commercial speech inextricably intertwined with expressive speech, and thus constitutes protected speech.

**2. The Federal trademark registration program does not amount to government speech because it is not used by the government to convey a message and it is not closely identified with the government in the public’s mind.**

A government program does not amount to government speech unless the program withstands the three-part test mandated in *Pleasant Grove City, Utah v. Summum*, 555 U.S. 460, 460 (2009). First, history must show that the government has long used the program in question to convey a message to the public. *Id.* at 470.

Second, in the public view, the program must be closely identified with the government. *Id.* at 471. Third, the government must maintain editorial control and authority over the program. *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2242 (2015). Because the PTO follows the guidelines set by Congress, the government does maintain editorial control and authority over the trademark register. 15 U.S.C.A. § 1052(a) (West 2015).

**a. The Federal trademark registration program does not convey a message by government, rather, it merely provides notice of registration.**

The government must use the program in question to “speak to the public.” *Summum*, 555 U.S. at 460. There, this Court found that displaying monuments in a city park conveyed a message by reasoning that “a monument by definition, is a structure that is designed as a means of expression.” *Id.* Further, this Court stated “when a government entity arranges for the construction of a monument, it does so because it wishes to convey some thought or instill some feeling in those who see the structure.” *Id.*

The government publishes registered trademarks in the Trademark Principal Register to provide notice of a registered mark, not to communicate a particular message or select a particular viewpoint. *In re Tam*, 785 F.3d at 584, *reh'g granted en banc*, 600 Fed. Appx. 775 (Mem). In fact, the PTO has made an affirmative effort to disassociate itself with trademarks published on the federal register. United States Patent and Trademark Office, Disclaimer, <http://www.uspto.gov/kids/disclaimer.html> (last visited Oct. 16, 2015).

Because the historical use of the trademark register has been a means of providing notice, rather than expression, and the government has explicitly disassociated itself from any content expressed therein, the government has not used the program to convey a message to the public.

**b. The Federal trademark register is not closely associated with the government in the mind of the public because there is no indicia of the United States on a trademark.**

The government program must be closely identified with the government in the public's mind. *Summum*, 555 U.S. at 460. In *Walker*, this Court found that license plate registrations were closely associated with the government in the mind of the public. 135 S. Ct. at 2249. This Court reasoned that license plates carry the issuing states' imprimatur and thus are often closely associated with the state by the public. *Id.* Contrary to license plate registration, trademark registration is not a government imprimatur. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1221 n.3 (T.T.A.B. 1993). It follows that because the government has explicitly stated that trademark registration does not carry the government's imprimatur, the public cannot consequentially associate the two.

Furthermore, the governmental nature of license plates is clear on its face because the State places the name "TEXAS" in large letters at the top of every plate. *Walker* 135 S. Ct. at 2249. In contrast, the federal nature of a registered trademark is not clear on its face because registered trademarks are followed by the "®" symbol but this does not give explicit indicia to the government or the "United States." Furthermore, the United States is not the only country who uses the "®"

symbol to indicate registration. Several foreign countries also use the “®” symbol to indicate that a trademark is registered in the country. United States Patent and Trademark Office, Trademark FAQ’s, <http://www/uspto.gov/learning-and-resources/trademark-faqs> (last visited Oct. 16, 2015). Even if a trademark holder wanted to include indicia of the U.S. on its mark, it is unlawful to do so. 15 U.S.C.A. § 1052(b) (West 2006). Because the first two prongs of the test are not met, the trademark registration program does not amount to government speech.

**B. Section 2(a) abridges speech in a manner implicating the First Amendment because it causes applicants to self-censor and imposes an unconstitutional condition on receipt of a federal benefit.**

**1. Section 2(a) causes an applicant to self-censor in hopes of receiving the benefits of trademark registration.**

The lack of direct restraint imposed upon speech does not determine the free speech question. *American Comm’ns Assoc. v. Douds*, 339 U.S. 382, 402 (1950). Furthermore, “one is not to have the exercise of his liberty of expression in appropriate places abridged on the plea that it may be exercised in some other place.” *Schneider v. Irvington*, 308 U.S. 147, 163 (1939). “A statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech.” *Leathers v. Medlock*, 499 U.S. 439, 477 (1991).

Here, the Federal Circuit correctly diverted from its *In re McGinely* holding. The decision rendered over thirty-four years ago has set precedent unsupported by analysis or citation to any legal authority. The court in *In re McGinely* cursorily



stated, “No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark.” 660 F.2d at 484. But this cannot end the inquiry. While an applicant may still be able to “use” the mark without registration, the denial of registration based on Section 2(a) imposes a financial burden based on the content of the trademark. “Registration is significant. The Lanham Act confers important legal rights and benefits on trademark owners who register their marks.” *B & B Hardware, Inc.*, 135 S. Ct. at 1300.

*Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*

illustrates that a financial burden imposed on a speaker may in fact abridge his speech, even though the government does not directly prevent him from speaking. 502 U.S. 105, 117 (1991). The regulation there, mandated that income derived from an accused or convicted criminal’s depiction of a crime be deposited into an escrow account to then be distributed to the victims of that crime. *Id.* at 105. While the regulation did not actually prevent the criminal authors from speaking, it imposed a financial burden which acted as a disincentive to the speech, thereby abridging the speech.

Similarly, here, Section 2(a) imposes a financial burden on the trademark applicant without preventing actual use. If an applicant does not meet the requirements of Section 2(a), he cannot obtain the benefits of nationwide notice of ownership and the exclusive right to use the mark. Concerned by the prospect of forfeiting these rights, applicants will inevitably self-censor and refrain from using

marks that could potentially be deemed unsuitable for registration under Section 2(a). This is the classic chilling of speech that the First Amendment strives to combat. Because Section 2(a) effectively requires applicants to self-censor, it abridges speech.

**2. Section 2(a) imposes an unconstitutional condition on obtaining trademark registration because it hinges the benefits of registration on constitutionally protected speech.**

The government may not deny access to a benefit “on the basis that infringes his constitutionally protected interest-especially, his interest in freedom of speech.” *Perry v. Sindermann*, 408 U.S. 593, 597 (1972). While Congress may be free to condition subsidies and federally funded financial benefits deriving from its spending powers, *Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 133 S. Ct. 2321, 2327 (2013), trademarks do not fall within this category.

Derived from the Commerce Clause, the purpose of the Lanham Act is to regulate marks in interstate commerce, not to subsidize the mark holders. 15 U.S.C.A. § 1127 (West 2006). The benefits of registration under the Lanham Act cannot be conditioned on constitutionally protected speech, here, the applicant’s word choice. To do so is an abridgment of speech triggering First Amendment scrutiny.

**C. Section 2(a) fails intermediate scrutiny because the government has not asserted a substantial interest directly advanced by the regulation and it is more extensive than necessary.**

Regulations on commercial speech must withstand intermediate scrutiny. *Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 566. At the outset of the analysis, the

court must find that the speech in question does not concern unlawful activity and is not misleading. *Id.* In *Luhv's* case, the Federal Circuit correctly found that there is nothing illegal about a disparaging trademark. *In Re Kourtney Luhv*, 1337 F.3d at 460. Next, the court must find that the government has asserted a substantial interest and that the regulation directly advances that interest. *Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 566. Finally, the regulation must not be more extensive than necessary to serve the asserted government interest. *Id.*

**1. The government does not have a valid substantial interest in discouraging offensive marks or appearing to endorse such marks.**

The government must assert a substantial interest independent of disapproving the speech's message. *Id.* at 566; *Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653, 2670 (2011) (rejecting message-based interest as "contrary to basic First Amendment principles"). Under a commercial speech inquiry, it is the burden of the government to justify its content-based law as consistent with the First Amendment. *Thompson v. Western States Medical Center*, 535 U.S. 357, 373 (1989).

While the government may assert that it has an interest in discouraging use of marks that may be offensive, the offensiveness of protected speech does not justify its suppression. *Bolger v. Young Drug Prods. Corp.*, 463 U.S. 60, 71 (1983). The dissent in *In Re Kourtney Luhv* suggested that the government has an interest in maintaining the integrity of the Trademark Principal Register as it may be seen by the public as the government's imprimatur of marks which some would find offensive or disparaging. 1337 F.3d at 461. But this assertion is inconsistent with

the jurisprudence of the TTAB which is ultimately charged with the duty of comprising the register. The TTAB has stated, “[j]ust as the issuance of a trademark registration by this office does not amount to a government endorsement of the quality of the goods to which the mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a ‘good’ one in an aesthetic, or any analogous, sense.” *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d at 1221 n.3.

The government has not met its burden of asserting a valid substantial interest to justify Section 2(a). Consequentially, the inquiry ends here. The Court is not obligated to examine whether Section 2(a) directly advances the government’s asserted interest or is more extensive than necessary. However, in the event that it does, Section 2(a) does not survive.

**2. Section 2(a) does not directly advance the government’s interest because marks that may be offensive are still published on the trademark register.**

Even if the Court finds a substantial government interest, Section 2(a) does not directly advance the government’s asserted interests in either discouraging marks that may be offensive or not appearing to endorse such marks. It is inevitable that some trademarks are going to survive Section 2(a) even though they could be found offensive. For example, the TTAB found the mark BLACK TAIL, used on adult entertainment magazines, not to be disparaging of women in general, or African-American women in particular. *Boswell v. Mavety Media Grp. Ltd.*, 52 U.S.P.Q.2d 1600, 1600 (T.T.A.B. 1999). Despite the fact that “a substantial portion

of the general public will recognize the words “BLACK TAIL” as used in the name of adult entertainment magazines as characterizing black, or African American, women as mere female sexual objects, and this attitude toward black women is similar to the attitude of slave owners toward black women during the time of slavery”, the trademark is still published on the public register. *Id.* Section 2(a), then, fails to directly advance the government’s asserted interests.

**3. Section 2(a) is more extensive than necessary to serve the government’s asserted interest because it prohibits registration of marks that the TTAB has deemed not disparaging.**

The Court must find that Section 2(a)’s complete suppression of speech which may disparage no more extensive than is necessary to serve the government’s asserted interest. *Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 566.

A regulation completely banning an electric utility company from advertising to promote the use of electricity was found to be more extensive than necessary to further the State’s interest in energy conservation. *Id.* This Court reasoned that the regulation prohibited even advertisements for products and services that could use energy efficiently. *Id.* Similarly, Section 2(a) completely bans registration of trademarks which the TTAB itself has found not to be disparaging. For example, the TTAB found the term SQUAW to not be disparaging when referring to the applicant’s world famous ski resort, Squaw Valley. *In Re Squaw Valley*, 80 U.S.P.Q.2d at 1265. Yet, the term was ultimately denied registration because a dictionary defined “SQUAW” as an American Indian woman. *Id.* Therefore, Section

2(a) is more extensive than is necessary to further the government's asserted interest in discouraging offensive marks and appearing to endorse them.

**D. Section 2(a) of the Lanham Act is a content based regulation because it permits the denial of trademark registration based on the message the trademark conveys.**

The principal inquiry in determining whether a regulation is content based is “whether the government has adopted a regulation of disagreement with the message it conveys”. *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989). Regulations that by their terms distinguish favored speech from disfavored speech on the basis of the ideas or views expressed are content based. *Turner Broad. Sys., Inc. v. F.C.C.*, 512 U.S. 622, 643 (1994). Content-based laws, laws that target speech based on its communicative content, are presumptively unconstitutional and are justified only if the government proves that they are narrowly tailored to serve compelling state interests. *Reed v. Town of Gilbert, Ariz.*, 135 S. Ct. 2218, 2226 (2015).

This Court has not expressed an opinion as to whether Section 2(a) is a content based restriction. In *Nissan Motor Co. v. Nissan Computer Corp.*, the Ninth Circuit held that an injunction prohibiting the defendant from placing links on its website to other sites with “disparaging” commentary regarding the plaintiff was a content based restriction and presumptively unconstitutional. 378 F.3d 1002, 1016 (9th Cir. 2004). The court reasoned that the injunction went “beyond control of the Nissan name as a source identifier” and instead constrained a communicative message. *Id.* Similar to the injunction involved there, Section 2(a) prohibits

“disparaging” marks from registration. 15 U.S.C.A § 1052(a) (West 2006). This consequentially punishes the applicant for the message being conveyed. Because Section 2(a) proscribes registration based on the message a “disparaging” mark conveys, it is a content based regulation.

### **III. SECTION 2(a) OF THE LANHAM ACT IS UNCONSTITUTIONALLY VAGUE BECAUSE IT FAILS TO PROVIDE ADEQUATE NOTICE OF WHAT IS PROHIBITED AND IS ARBITRARILY APPLIED.**

Speakers are protected from arbitrary and discriminatory enforcements of vague standards. *Nat’l Endowment for the Arts v. Finley*, 524 U.S. 569, 588 (1998). “Vagueness of content based regulation of speech raises special First Amendment concerns because of its obvious chilling effect on free speech.” *Reno v. American Civil Liberties Union*, 521 U.S. 844, 872 (1997). This Court has mandated that impermissible vague regulations must be invalidated. *Fed. Commc’ns Comm’n v. Fox Television Stations, Inc.*, 132 S. Ct 2307, 2317 (2012). To withstand the void for vagueness doctrine, a regulation must permit regulated parties to know what is required of them, so that they may act accordingly. *Id.* Additionally, it must not permit enforcement of the regulation in an arbitrary or subjective manner. *Id.* “When speech is involved, rigorous adherence to these requirements is necessary to ensure that ambiguity does not chill protected speech”. *Id.*

#### **A. Section 2(a) does not provide adequate notice because the term “disparage” is inherently subjective and unclear.**

Neither the Lanham Act nor its legislative history define the term “disparage.” 15 U.S.C.A. § 1052. In fact, the Assistant Commissioner of Patents, Leslie Frazer, expressed the concern early on, that the term “disparage” will be

difficult to apply because a determination of disparagement is completely subjective. Hearings on H.R. 4744 before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess. 18 (1939) (statement of Leslie Frazer, Assistant Commissioner of Patents). Since then, even the PTO itself has acknowledged that the “guidelines” for determining what may be “scandalous” or “disparaging” for purposes of § 1052(a) are vague and the determination is highly subjective. *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653, 1653 (T.T.A.B. 1990). If the PTO, a trained and specialized administration, charged with the responsibility of interpreting and applying § 1052(a), does not have a uniform and specific methodology of doing so, it can hardly be expected that the trademark applicant effectively has notice of what is required of him.

**B. Section 2(a) is arbitrarily and discriminatorily enforced as evidenced by TTAB jurisprudence because the determination of whether a mark is “disparaging” has been inconsistently analyzed.**

Laws must provide explicit standards for those who apply them. *Grayned v. City of Rockford*, 408 U.S. 104, 108-109 (1972). A vague law impermissibly delegates basic policy matters to policemen, judges, and juries for resolution on an ad hoc and subjective basis. *Id.*

The absence of a single standard against which to evaluate the potential scandalousness or disparagement of an applicant’s trademark has inevitably led to an arbitrary and discriminatory enforcement of Section 2(a). This is evidenced by TTAB case law. In the case of *In re Condas S.A.*, the TTAB considered the applicant’s contention that “it would be inconceivable that someone of Japanese



origin would choose a mark that would disparage his own heritage.” 188 U.S.P.Q. 544, 544 (T.T.A.B. 1975). As a result, it concluded that the term “JAP” was not disparaging and permitted its registration. *Id.* Yet, in *In re Tam*, the TTAB did not take the applicant’s Asian heritage into consideration when denying the refusal of the mark “THE SLANTS”. 785 F.3d 567, *reh'g granted en banc*, 600 Fed.Appx. 775 (Mem). Even though the applicant stated “We want to take on these stereotypes that people have about us, like the slanted eyes, and own them.” the mark was denied registration on the grounds that it was disparaging. *Id.* at 570.

Section 2(a) and the Lanham Act, altogether, fail to define the term “disparage” thus do not provide adequate notice of what words trademarks applicant must refrain from using in order to get registration. Additionally, as evidenced by the TTAB case law, Section 2(a) has been arbitrarily and discriminatorily applied. As a result, Section 2(a) is unconstitutionally vague.

## CONCLUSION

The Federal Circuit erred when it refused to register DUMB BLONDE under Section 2(a) by determining the likely meaning of the mark was disparaging to a substantial composite of an improper referenced group, women in general. The likely meaning of the mark, taking into account the dictionary definition, the nature and the manner in which the mark is used in the marketplace in connection with the goods and services in the application, and the intent of Luvv, is not disparaging. Blonde women are the proper referenced group because they are the targeted persons referred to, identified, and implicated in a recognizable manner when

looking at DUMB BLONDE. When examining the record as a whole, taking into account both evidence that justifies and detracts from the PTO and TTAB's decision, there is no substantial evidence that finds that blonde women, the proper referenced group, perceive the mark DUMB BLONDE as disparaging.

Section 2(a) is unconstitutional because it violates the First Amendment and is unconstitutionally vague. Section 2(a) implicates the First Amendment because it regulates protected commercial and expressive speech. Furthermore, regulation imposed under Section 2(a) is an abridgment by the government on that protected speech. Section 2(a) ultimately fails constitutional scrutiny when analyzed under the test set forth in *Cent. Hudson Gas & Elec. Corp.* Additionally, Section 2(a) is unconstitutionally void for vagueness because it fails to provide adequate notice of what is prohibited and is arbitrarily and discriminatorily applied.

For these reasons, Kourtney Luhv respectfully requests that this Court reverse the Federal Circuit's ruling and find that the mark DUMB BLONDE is not disparaging to a substantial composite of blonde women and affirm the Federal Circuit's ruling and find Section 2(a) unconstitutional.

## CERTIFICATION

We, Counsel for Respondent, certify that this Brief has been prepared in accordance with the Rules of the Competition and this brief represents the work product solely of the competing team's members.

We further certify that the attached brief contains 9,787 words.

Respectfully Submitted

*Team 112*

Counsel for Respondent