

CAUSE No. 15-1007

IN THE

Supreme Court of the United States

FALL TERM 2015

UNITED STATES OF AMERICA,
Petitioner,

—*against*—

KOURTNEY LUHV,
Respondent.

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

BRIEF FOR RESPONDENT

ORAL ARGUMENT REQUESTED

QUESTIONS PRESENTED

- I. Whether the Trademark Trial and Appeal Board wrongfully rejected Kourtney Luhv's application to register the trademark DUMB BLONDE under section 2(a) of the Lanham Act.
- II. Whether section 2(a) of the Lanham Act violates the United States Constitution by prohibiting the registration of potentially disparaging trademarks.

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OPINIONS BELOW

The Trademark Trial and Appeal Board's order affirming the Patent and Trademark Office's refusal to register respondent Kourtney Luhv's mark is unreported.

The Circuit Court's order reversing the rejection of Luhv's trademark application may be found at *In re Kourtney Luhv*, 1337 F.3d 455 (13th Cir. 2015).

STATEMENT OF JURISDICTION

The decision of the Thirteenth Court of Appeals was entered on June 6, 2015. The Government's petition for writ of certiorari was subsequently granted. This Court has jurisdiction over the subject matter of this case pursuant to 28 U.S.C. § 1254(1) (West 2015).

PROVISIONS INVOLVED

The Lanham Act, 15 U.S.C. § 1052(a), bars the registration of any trademark consisting of "matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute"

The First Amendment to the United States Constitution provides: "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances." U.S. CONST. amend. I.

STATEMENT OF THE CASE

Kourtney Luhv Sings About Women’s Social Issues

Kourtney Luhv (“Luhv”) is a popular solo vocalist well-known by her stage name, Dumb Blonde. *In re Kourtney Luhv*, 1337 F.3d 455, 455 (13th Cir. 2015). She started using this stage name in 2012, during which time she developed a substantial fan base. *Id.* Luhv has enjoyed great success both on the Internet and throughout Calidonia for her music, which emphasizes social issues pertaining to women. *Id.* In fact, a large portion of Luhv’s fan base is composed of women. *Id.* at 457. Over 100,000 fans have connected with Luhv on www.UTube.com, a video hosting website where Luhv uses the account name DumbBlondeMusic. *Id.* at 456. In June 2014, Luhv received a lucrative offer from a record label for a recording contract contingent upon Luhv registering a trademark for her stage name, Dumb Blonde. *Id.* at 455.

The PTO Rejects Luhv’s Trademark Application

On July 9, 2014, Luhv submitted an application to register the mark, DUMB BLONDE, with the Patent and Trademark Office (“PTO”). *Id.* at 456; DUMB BLONDE Application No. 99/989,052. The mark was for “[e]ntertainment, namely live performances by a musical band” and “clothing, namely, sweatshirts, t-shirts, tank tops, and headwear.” *Id.* After receiving Luhv’s application, the PTO’s examining attorney determined that the mark was disparaging to women. *Id.* The attorney, therefore, refused to accept Luhv’s application under section 2(a) of the Lanham Act, which permits the denial of “disparaging” mark applications. *Id.*

Kourtney Luhv Challenges the PTO's Decision on Appeal

Luhv contested the denial of her mark application to the Trademark Trial and Appeal Board (“TTAB”). *Id.* On appeal, Luhv provided evidence demonstrating her efforts to reclaim the DUMB BLONDE name from negative stereotypes and showing a substantial number of her fans were women. *Id.* at 457. Upon reviewing Luhv’s case, however, the TTAB affirmed the examining attorney’s refusal to approve the mark application. *Id.* at 456. The TTAB found the mark disparaging to blonde women, despite Luhv’s explanation that the Dumb Blonde name was a means of raising awareness about gender stereotypes and reclaiming stereotypes surrounding blonde women. *Id.*

Luhv, consequently, appealed the TTAB’s decision to the United States Court of Appeals for the Thirteenth Circuit, which reversed the judgment of the TTAB. *Id.* at 460. In the Court’s view, although the trademark DUMB BLONDE may be disparaging to women, section 2(a) of the Lanham Act is unconstitutional. *Id.* As a result, the Lanham Act was held to provide no basis for rejecting Luhv’s trademark application. *Id.* This appeal followed.

SUMMARY OF THE ARGUMENT

I.

The Trademark Trial and Appeal Board wrongfully rejected Kourtney Luhv's trademark application under section 2(a) of the Lanham Act. Because Petitioner is unable to demonstrate that a substantial composite of the affected group perceives Luhv's mark as disparaging and because all doubts should be resolved in the applicant's favor, Luhv's trademark application warranted approval. Furthermore, Luhv supplied rebuttal evidence that illustrates how the DUMB BLONDE mark is used as an instrument for empowering blonde women, thereby reclaiming the term from negative stereotypes. For these reasons, Luhv's mark is not disparaging.

II.

Section 2(a) of the Lanham Act unconstitutionally abridges the First Amendment right to the freedom of speech because trademarks are a form of commercial speech afforded constitutional protection. Because the possible offensiveness of speech cannot justify governmental regulation and because the prohibition against disparaging trademarks does not further a substantial governmental interest, Section 2(a) is unconstitutional. Even if a substantial interest was advanced, less restrictive means can be used to further this interest. Section 2(a) of the Lanham Act, therefore, constitutes an unconstitutional abridgement of this First Amendment right.

ARGUMENT

I. THE TRADEMARK TRIAL AND APPEAL BOARD WRONGFULLY REJECTED LUHV'S APPLICATION TO REGISTER THE TRADEMARK, DUMB BLONDE, UNDER SECTION 2(A) OF THE LANHAM ACT.

Under section 2(a) of the Lanham Act of 1946, an application for trademark registration will be denied if the mark consists of “matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute”¹ 15 U.S.C. § 1052(a) (West 2015). The legislative history surrounding section 2(a) is sparse and sheds little light on what all this prohibition is meant to encompass. 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, 277 (2004). Furthermore, the Lanham Act itself fails to define “disparaging.” *Id.* Courts have, thus, used the ordinary and common meaning of the term as it existed in 1946—“trademarks may disparage if they may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.” *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124 (D.D.C. 2003) *remanded* 415 F.3d 44 (Fed. Cir. 2005).

When, as here, the government seeks to prohibit the registration of a mark under Section 2(a) of the Lanham Act, the trademark must be reviewed under a two-part analysis. First, a court must determine the likely meaning of the mark in

¹ “Even though both patent and copyright law have long since abandoned moral prerequisites, uniquely, trademark law contains one of the few content-based classifications in our legal system” Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601, 1623 (2010).

question by considering, “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 and services” *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014). Second, if the meaning of the mark is “found to refer to identifiable persons”, the TTAB weighs “whether that meaning may be disparaging to a substantial composite of the referenced group.” *Id.*

Because Petitioner is unable to demonstrate that a substantial composite of blonde women feel disparaged by the DUMB BLONDE mark, Luhv’s application was wrongfully rejected. Additionally, Luhv’s evidence rebuts any finding for disparagement by showing the DUMB BLONDE mark was meant to be used as a means of reclaiming the disparaging term for blonde women. Even if this Court were to find some merit in Petitioner’s assertions, disparate opinions within the potentially affected group require a finding in the mark applicant’s favor. *In re Hines*, 31 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994). Accordingly, the lower courts erred in affirming the PTO’s refusal to register Luhv’s mark.

A. This Court Reviews the Denial of Trademark Application Under a Bifurcated Standard and the Government has the Burden to Prove That a Mark is Disparaging.

The determination that a mark may be disparaging “is a conclusion of law based upon underlying factual inquiries.” *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). The factual findings reached by TTAB are reviewed under a substantial evidence standard. *In re Fox*, 702 F.3d 633, 673 (Fed. Cir.

2012); *McDermott v. S.F. Women's Motorcycle Contingent*, 240 F. App'x. 865, 867 (Fed. Cir. 2007). Under this standard, a court must accept all factual findings made by the fact-finder unless "it would not be possible for any reasonable fact-finder to come to the conclusion reached" *Menendez-Donis v. Ashcroft*, 360 F.3d 915, 918 (8th Cir. 2004). In contrast, the ultimate decision regarding the registrability of a trademark is a question of law reviewed *de novo*. *In re Geller*, 751 F.3d at 1358; *In re Fox*, 702 F.3d at 673; *McDermott*, 240 F. App'x. at 867. Under a *de novo* standard, this Court independently examines the legal principles animating the Lanham Act and owes no deference to the legal conclusions of the lower courts. *Id.*

The burden of proving that a mark is unregistrable lies with the government's examining attorney. *In re Mavety Media Grp. Ltd.*, 33 F.3d at 1371. According to the Trademark Manual for Examining Practitioners, examiners favoring rejection of a mark are required to come forward with evidence supporting rejection. TRADEMARK MANUAL FOR EXAMINING PRACTITIONERS (Catherine P. Cain, 3d ed. 2015), <http://tmep.uspto.gov/RDMS/detail/manual/TMEP/current/d1e2.xml#/manual/TMEP/current/d1e2.xml>. The examining attorney "must make a prima facie showing that a substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark, as used on or in connection with the relevant goods or services, to be disparaging in the context of contemporary moral attitudes." *Id.* As a result, there is a strong preference for erring on the side of publication. *Id.*

B. Luhv’s Use of the Mark is Consistent with Section 2(a) of the Lanham Act Under the Two-Part Disparagement Analysis Provided in *Harjo*.

The Lanham Act does not include an express definition for disparagement and provides no recommendations for identifying a disparaging mark.² 15 U.S.C. § 1051 *et seq.* (West 2015). In the absence of an explicit definition, the TTAB applied varying levels of standards for determining disparagement in the years following passage of the Lanham Act. Amanda E. Compton, *N.I.G.G.A., Slumdog, Dyke, Jap, and Heeb: Reconsidering Disparaging Trademarks in a Post-Racial Era*, 15 WAKE FOREST J. BUS. & INTELL. PROP. L. 5, 18 (2014). As early as 1951, the government denied the application of a mark it deemed “obviously” disparaging toward a national symbol, but provided no framework for making such determinations in the future. *See, e.g., Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q.2d (BNA) 227, 228 (P.T.O. 1951) (denying a mark for medication treating sexually transmitted diseases because it invoked the “Doughboy” name, commonly used to refer to American soldiers). Mark rejections based on disparagement continued without a concrete test for years. *See In re Anti-Communist World Freedom Cong., Inc.*, 161 U.S.P.Q.2d (BNA) 304 (T.T.A.B. 1969) (denying a mark for disparaging the Soviet national symbol but applying no particular form of analysis).

²“The prohibition against registration of scandalous marks first appeared in the Trademark Act of 1905, and was repeated in Section 2(a) of the Lanham Act of 1946.” Oswald, 41 AM. BUS. L.J. at 268. In contrast, the prohibition regarding the registration of disparaging marks did not exist until the enactment of the 1946 Lanham Act. *Id.*

In 1999, the TTAB established a two-step process, commonly called the *Harjo* test, for determining disparagement under the Lanham Act. *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003). In its simplest form, the *Harjo* test considers (1) the likely meaning of the mark in question and (2) whether the meaning is one that would disparage the referenced group. *Id.* The TTAB continues to apply this two-part test for assessing disparagement and, therefore, the *Harjo* test should guide this Court's evaluation of Luhv's trademark registration application. *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2010); *In re Geller*, 751 F.3d at 1355.

1. ***Under the first prong of the Harjo Test, the meaning of the DUMB BLONDE mark refers to an identifiable group of people—blonde-haired women.***

The first prong of the modern test for disparagement assesses the likely meaning of the matter in question. *Harjo*, 284 F. Supp. at 125. Stated differently, the first prong seeks to determine whether the mark refers to an identifiable group of people. *Id.* The meaning of a mark may be established by considering several factors, beginning with dictionary definitions and then moving to the relationship of the matter to the other elements in the mark, the type of goods or services provided, and how the mark will be used in the marketplace in relation to goods and services provided. *In re Geller*, 751 F.3d at 1358; *accord In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264 (T.T.A.B. 2006).

Dictionary definitions provide a starting point for the likely meaning of the mark in question, as they “represent an effort to distill the collective understanding of the community with respect to language” *In re Boulevard Entm’t*, 334 F.3d 1336, 1340 (Fed. Cir. 2003). Here, the Oxford Dictionary describes a “dumb blonde” as “[a] blonde-haired woman perceived in a stereotypical way as being attractive but unintelligent.” *Dumb Blonde Definition*, OXFORDDICTIONARIES.COM, http://oxforddictionaries.com/us/definitions/american_english_dumb-blonde (last visited Oct. 20, 2015). The dictionary definition, however, does not conclude the analysis and additional factors must also be considered. *In re Mavety Media Grp. Ltd.*, 33 F.3d at 1373.

Additional factors include “other elements in the mark, the nature of the goods or services, and the manner in which in the mark is used in the marketplace in connection with the goods and services.” *In re Geller*, 751 F.3d at 1358. Luhv is a blonde-haired woman and uses the DUMB BLONDE mark on her website and concert banners alongside photographs of other blonde-haired women. *In re Kourtney Luhv*, 1337 F.3d at 457. The nature of the mark and the manner of its use in the marketplace supports the definition provided above and clearly references an identifiable group of people—blonde-haired women.

2. *The Government fails to satisfy the second prong of the Harjo Test because the mark is not disparaging to the referenced group of persons.*

Once a mark is found to refer to an identifiable group of persons, the second prong of the *Harjo* test evaluates whether the mark may, in fact, be perceived as

disparaging in context “by a substantial composite of the referenced group.” *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d at 1215. A mark “disparages” when it may “dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.” *Harjo*, 284 F. Supp. 2d at 124. In considering disparagement, “perceptions of the general public are irrelevant . . . [o]nly the perceptions of those referred to, identified or implicated in some recognizable manner by the involved mark are relevant to determination.” *Id.* at 124.³

- a. **The Government’s evidence of disparagement is deficient because mere personal opinions and dictionary sources are not enough to demonstrate that the referenced group is insulted by the mark.**

The PTO must “avoid interposing its own judgment” for that of the composite group in question. *In re Hines*, 31 U.S.P.Q.2d at 1376. Instead, the “Board has a duty to obtain the views of the affected public” and “[o]fficers of the PTO may not readily assume, without more, that they know the views of a substantial composite of the public.” *Ritchie v. Simpson*, 170 F.3d 1092, 1094 (Fed. Cir. 1999). Evidence that can demonstrate a feeling of disparagement typically entails witness statements, public opinion polling, and historical background on the phrase in question. *Order Sons of It. in Am. v. Memphis Mafia, Inc.*, 52 U.S.P.Q.2d (BNA) 1364 (T.T.A.B. 1999). In refining the *Harjo* test, the TTAB has clarified that only

³ An earlier iteration of a Lanham Act disparagement test weighed whether a reasonable person would find the mark disparaging. *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1988). In *Harjo*, however, the TTAB clarified the reasonable person standard is to be applied only when considering disparagement toward particular individuals or commercial entities. *Harjo*, 50 U.S.P.Q.2d at 1740.

views of the relevant group may be taken into consideration. *Harjo*, 50 U.S.P.Q.2d at 1743.

Here, the TTAB primarily “cited photograph images from [Respondent]’s website depicting a blonde woman eating plastic fruit and applying Wite-Out (C) to text displayed on her computer monitor.” *In re Kourtney Luhv*, 1337 F.3d at 456. The TTAB also pointed to “dictionary definitions, numerous articles, and user comments on [Luhv]’s uTube videos” as evidence that a substantial composite of women feel disparaged by the mark. *Id.* None of Petitioner’s evidence, however, supports a finding for disparagement under the second prong of the test.

In *Harjo*, parties challenging a sports team’s potentially disparaging name, Redskins, provided extensive survey data and polling information as to whether the term was offensive to Native Americans. *Harjo*, 50 U.S.P.Q.2d at 1705. Even so, the court determined that 36.6% of Native Americans did not constitute a “substantial composite” of the affected group for purposes of the disparagement test. *Harjo*, 284 F. Supp. 2d at 129. Though a substantial composite does not necessarily mean a majority of the group, *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981), the court’s findings in *Harjo* imply a “substantial composite” constitutes a very high number of the population. *Harjo*, 284 F. Supp. 2d at 129. This conclusion was not rejected by the Federal Circuit on appeal. *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (Fed. Cir. 2005). If a thorough opinion survey calculating 36.6% of a referenced group feels disparaged by a term is not enough to represent a substantial composite, certainly Petitioner’s evidence, consisting vaguely of subjective photographs and

“dictionary definitions, numerous articles, and user comments,” is likewise deficient. *In re Kourtney Luhv*, 1337 F.3d at 456.

Additionally, the Federal Circuit has previously chastised a Board “[a]rmed with only personal opinions and dictionary sources,” concluding a mark to be “an affront to a substantial composite of the general public.” *In re Mavety Grp. Ltd.*, 33 F.3d at 1373. The court also criticized the TTAB’s rejection of a mark for relying too heavily on dictionary definitions and being “devoid of factual inquiry . . . concerning the substantial composite of the general public, the context of the relevant marketplace, or contemporary attitudes.” *Id.* at 1372. Rejections of a mark cannot be based on “essentially nothing but speculation about how [a] term would be perceived by the public.” *Id.* at 1373. Instead, courts prefer more concrete “evidence such as consumer surveys.” *Id.* at 1373; *Harjo* 284 F. Supp. 2d at 129. “[T]he opinion of an expert witness not affiliated with petitioner” could also be probative. *Order Sons of It. in Am.*, 52 U.S.P.Q.2d at *5. Petitioner has provided no such information. *In re Kourtney Luhv*, 1337 F.3d at 455.

What little evidence Petitioner has submitted mirrors the type of evidence previously found insufficient by the Federal Circuit. As in *In re Mavety Grp. Ltd.*, the TTAB entered a conclusory judgment about the DUMB BLONDE mark with little more than dictionaries and personal opinions. 33 F.3d at 1373. Without an opinion poll, survey, or expert witnesses from the public who could register their opposition to Luhv’s registration, the TTAB substituted its own opinion for that of a substantial composite of blonde women.

b. Contextual evidence concerning Luhv's membership in the referenced group of blondes constitutes a reappropriation of this stereotype, thereby rebutting any finding for disparagement.

Though the burden to demonstrate disparagement rests with the opponent of a mark's registration, an applicant may present evidence to rebut presumptions of a disparaging mark. *In re Heeb Media, LLC*, 89 U.S.P.Q.2d (BNA) 1071 (T.T.A.B. 2008).⁴ As a result, even if this Court were to find Petitioner's evidence persuasive, the wealth of evidence provided by Luhv defuses any finding that DUMB BLONDE disparages a substantial composite number of blonde women.

As evidence in support of her contention, Luhv points to "the hundreds of thousands of female fans that have attended her concerts" and women supporters "who infer a different, more positive meaning for the mark." *In re Kourtney Luhv*, 1337 F.3d at 457. Social media comments from blonde women also illustrate positive support for Luhv's reclaiming of the term.⁵ *Id.* Internet comments can "provide additional insight into the public's perception" and may properly be considered in weighing whether disparagement exists. *In re Geller*, 751 F.3d at 1360. At a minimum, Luhv's social media comments balance the online images and

⁴ The Thirteenth Circuit relies heavily on *In re Heeb Media* to assert the TTAB is unwilling to approve a disparaging mark even for applicants seeking to reclaim a term. *In re Kourtney Luhv*, 1337 F.3d at 455, 456. Five years prior to the cited opinion, however, the PTO already approved registration for the mark HEEB, the same term at issue in the case cited by the Thirteenth Circuit. HEEB, Registration No. 2,858,011.

⁵ Such positive comments include: "[A]s a blonde woman I totally support you even if the haters gon' hate;" and "There need to be more women like you serving as positive role models for young girls rather than grinding on Robin Thin!" *In re Kourtney Luhv*, 1337 F.3d at 457.

comments presented by Petitioner. Luhv's hundreds of thousands of concert-attending fans, most of whom are women, provide the quantifiable data lacking in Petitioner's argument.

A key factor in determining disparagement is the context of the mark. *Harjo*, 284 F. Supp. 2d at 127. One contextual aspect the TTAB has long considered is the applicant's membership in the group that would be disparaged. *See, e.g., In re Condas S.A.*, 188 U.S.P.Q. (BNA) 544 (T.T.A.B. 1975) (finding persuasive the assertion that "it would be inconceivable that someone of Japanese origin would choose a mark that would disparage his own heritage."). In registering marks, "[t]he reappropriation of slurs is a common source of empowerment among disparaged groups." Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388, 392 (2006).

In the most well-known case on the issue, *McDermott v. San Francisco Women's Motorcycle Contingent*, applicants seeking to register the mark DYKES ON BIKES were initially denied due to the examining attorney's conclusion that the term "dyke" was disparaging to lesbian women. 81 U.S.P.Q.2d (BNA) 212, 1212 (T.T.A.B. 2006), *affm'd* 240 F. App'x. 865. Subsequently, however, the applicants provided evidence demonstrating an aim to reclaim the term in a positive light. *Id.* The mark was ultimately approved. *Id.* Where an applicant is a member of the allegedly disparaged group, examiners often allow greater deference. *See* QUEER EYE FOR THE STRAIGHT GUY, Registration No. 2,905,014 (approving the mark

QUEER EYE FOR THE STRAIGHT GUY where the applicant was a member of the allegedly disparaged group); *see also* QUEER AS FOLK, Registration No. 2,592,636 (approving the mark QUEER AS FOLK where applicant was a member of the potentially disparaged population); QUEERGEAR, Registration No. 1,828, 351.

Luhv, like the applicants who registered DYKES ON BIKES, seeks to recapture a term from past social negativity. In context, Luhv is an artist whose music seeks to “focus on issues faced by women in today’s society.” *In re Kourtney Luhv*, 1337 F.3d at 456. She maintains, “that she 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 faced by all women.” *Id.* Accordingly, her goal is to “recast the phrase in a positive light by displaying it alongside a woman with a successful career, and through musical lyrics that shed light on critical issues faced by women.” *Id.* at 457.

Like the women who successfully registered DYKES ON BIKES, Luhv has also presented evidence of successful efforts to reclaim the term in question. Hundreds of thousands of women have found resonance in Luhv’s message about the term. *Id.* at 455, 458. Additionally, Luhv’s website includes “photographic images on her website featuring a blonde woman depicted as the president of the United States, sitting in the oval office.” *Id.* at 457. Luhv’s successful career, juxtaposed with her blonde hair and significant number of female fans, represents

the type of reclaiming previously vindicated by the courts. *McDermott*, 240 F. App'x. at 865.

C. Any Doubt About the Existence of Disparagement Should Be Resolved in Luv's Favor.

Where the existence of disparagement is unclear, precedent from the TTAB and courts requires the government to operate with a presumption in favor of publishing the applicant's trademark. *See In re Mavety Media Grp. Ltd.*, 33 F.3d at 1371 (explaining that the party arguing against a mark's registration has the burden to show the mark is unregistrable). As early as 1972, the TTAB has stated that where there is "no easily applicable objective test," the standard practice is to resolve the matter in the applicant's behalf "on the theory that any person who believes that he would be damaged by the registration will have an opportunity . . . to oppose the registration of the mark" *In re Gourmet Bakers*, 173 U.S.P.Q. (BNA) 565 (T.T.A.B. 1972). Should conflicting evidence lead the examining attorney to harbor doubts as to whether a mark is disparaging, the examiner's doubts should be resolved in the applicant's favor. *In re Hines*, 32 U.S.P.Q.2d at 1376; *see also In re Watkins*, 2005 TTAB Lexis 66 (T.T.A.B. 2005) finding "[t]o the extent that there is doubt . . . that doubt must be resolved in favor of publication of the mark.").

As the TTAB has previously explained, "because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is . . . disparaging in favor of applicant and pass the mark for publication" *In re In Over Our Heads*, 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990). The theory behind erring on the side of publication is that once a mark is approved, "if a group

does find the mark to be . . . disparaging, an opposition proceeding can be brought and a more complete record established.” *Id.* A mark will survive the disparagement test “in light of [an] incongruous connotation of applicants’ mark given its context” *Bd. of Trs. of Univ. of Ala. v. Pitts*, 107 U.S.P.Q.2d (BNA) 2001 (T.T.A.B. 2013).

Rejecting a mark where the matter of disparagement is unclear takes the power of input away from the hands of the public and potentially affected group. As explained by the Federal Circuit, “[t]o be sure, appellate judges are a part of the composite of the general public, but they represent only a tiny fraction of the whole, which necessarily encompasses a wondrous diversity of thought.” *In re Mavety Grp. Ltd.*, 33 F.3d at 1371. The Federal Circuit has long commended the practice of passing marks for publication where disparagement is unclear. *Id.*; *see also Ritchie*, 170 F.3d at 1094 (holding “we have commended the practice of resolving the issue . . . by first permitting the mark to pass for publication, and then allowing interested members of a composite of the general public . . . to bring opposition proceedings.”). As one commentator has asserted, “the courts and Board prefer that the examiner publish the mark for opposition rather than deny registration during the examination process” in order to avoid placing the government “in the position of censoring marks without public input.” Oswald, 41 AM. BUS. L.J. at 264.

Even if this Court were to find the DUMB BLONDE mark could be perceived by some blonde-haired women as disparaging, the mark should still be passed for publication in accordance with the general presumption in an applicant’s favor.

Both Luhv and Petitioner present evidence they assert encapsulates the viewpoint of a substantial composite of blonde women. In light of the conflicting evidence, the examining attorney should have determined a finding for ambiguity in disparagement and passed the mark for publication. *In re Hines*, 32 U.S.P.Q.2d at 1376. For these reasons, this Court should find that the DUMB BLONDE mark survives the *Harjo* disparagement test and merits approval.

II. SECTION 2(A) OF THE LANHAM ACT'S PROHIBITION ON REGISTERING DISPARAGING MARKS VIOLATES THE FREE SPEECH CLAUSE OF THE FIRST AMENDMENT.

The First Amendment provides that “Congress shall make no law . . . abridging the freedom of speech” U.S. CONST. amend. I. In *Police Department of City of Chicago v. Mosley*, 408 U.S. 92, 95 (1972), this Court explained that, “above all else, the First Amendment means that government has no power to restrict expression because of its message, its ideas, its subject matter, or its content.” This Court has, therefore, treaded carefully when restricting the First Amendment right to free speech—a protection that extends to commercial speech.

Commercial speech is speech that does “no more than propose a commercial transaction.” *Pittsburgh Press Co. v. Pittsburgh Comm’n on Human Relations*, 413 U.S. 376, 385 (1973). Stated differently, commercial speech is an “expression related solely to the economic interests of the speaker and its audience.” *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 561 (1980). A trademark is a form of pure commercial speech when its purpose is “strictly business.” *Friedman v. Rogers*, 440 U.S. 1, 11 (1979). When, however, a trademark

“editorialize[s] on any subject, cultural, philosophical, or political,” reports on a “newsworthy fact,” or makes “generalized observations even about commercial matters,” then the mark is pure speech.⁶ *Id.*

Here, Luhv seeks to register the mark DUMB BLONDE for “[e]ntertainment, namely live performances by a musical band and clothing, namely sweatshirts, t-shirts, tank tops, and headwear.” *In re Kourtney Luhv*, 1337 F.3d at 456. Thus, while trademarks may be either commercial or non-commercial speech, Luhv’s proposed use of the mark in advertising and product packaging falls within the definition of pure commercial speech. Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 395–96 (2008).

“The fact that the speech is in aid of a commercial purpose does not deprive respondent of all First Amendment protection” *United States v. United Foods, Inc.*, 533 U.S. 405, 410 (2001). As a result, a law that regulates commercial speech must pass the four-part test established by this Court in *Central Hudson*, 447 U.S. at 563–66. Under this test, the Court must (1) determine whether the expression falls under the protection of the First Amendment. *Id.* If the speech is shielded by the free speech clause, then (2) the governmental interest achieved by the speech restriction must be substantial. *Id.* If both of these prongs are met, then this Court must determine whether the limitation on commercial speech is carefully designed to achieve the governmental interest. *Id.* This is determined under the third and

⁶ For example, “[a] pink triangle as a logo or design mark to indicate source or origin of a brand of t-shirts is commercial speech; nevertheless, a t-shirt with a pink triangle on it sold at a Gay Pride Parade serves to communicate Gay Pride (pure speech).” Llewellyn Joseph Gibbons, 9 MARQ. INTELL. PROP. L. REV. at 226.

fourth prongs of the *Hudson* test. *Id.* These final prongs require that (3) the restriction “directly advance the state interest involved” and (4) this interest cannot be achieved by less restrictive means. *Id.*

Because Luhv’s proposed trademark falls under First Amendment protection and because the Lanham Act’s restriction on disparaging marks fails to further a substantial governmental interest, section 2(a) of the Lanham Act is unconstitutional. Even if section 2(a) furthered a substantial government interest, the regulation still fails the *Central Hudson* Test because the restriction fails to directly advance a governmental interest under less restrictive means. For these reasons, the prohibition on disparaging marks should be held unconstitutional.

A. This Court Evaluates the Constitutional Validity of Section 2(a) of the Lanham Act Under a *De Novo* Standard of Review.

This Court evaluates constitutional questions under a *de novo* standard of review. *Ornelas v. United States*, 517 U.S. 690, 697 (1996). The validity and constitutionality of a statute thereby requires an application of the same legal standard. *Konikov v. Orange Cnty.*, 410 F.3d 1317, 1321 (11th Cir. 2005). “When interpreting a statute an appellate court must defer to its plain meaning and review its application *de novo*.” *U.S. Nat’l Bank of Oregon v. Indep. Ins. Agents of Am., Inc.*, 508 U.S. 439, 454 (1993). The idea that “[a]n act of congress repugnant to the constitution [sic] cannot become a law,” dates back to this Court’s holding in *Marbury v. Madison*, 5 U.S. 137, 138 (1803). This Court’s continued adherence to a *de novo* review of a law’s constitutionality affirms the importance of ensuring that laws are consistent with the Constitution. *Wright v. West*, 505 U.S. 277, 299–300

(1992) (O’Conner, J., concurring).

B. First Amendment Protection Extends to Commercial Speech; Therefore, the Lanham Act’s Restriction on Disparaging Marks Interferes with this Constitutional Right.

The first prong of the *Central Hudson* test requires a Court to determine whether the speech in question is protected under the First Amendment. *Cent Hudson*, 447 U.S. at 563–66. Although a trademark is pure commercial speech, it is not devoid of constitutional protection. *Friedman*, 440 U.S. at 11. In fact, this Court’s precedent has increasingly afforded First Amendment protection to commercial speech. Deciding an early case in 1942, this Court upheld a statute prohibiting the distribution of advertising material in New York streets in *Valentine v. Chrestensen*, 316 U.S. 52, 54–55 (1942). While streets were recognized as “proper places for the exercise of the freedom of communicating information” that may not be unduly burdened by states and municipalities, the *Valentine* court found that “the Constitution imposes no such restraint on government as respects purely commercial advertising.” *Id.* at 54.

Although *Valentine* marks the beginning of the commercial speech doctrine, subsequent Supreme Court cases have shown “that speech is not rendered commercial by the mere fact that it relates to an advertisement.” *Pittsburgh Press Co.*, 413 U.S. at 384. Furthermore, since 1951, this Court “has never denied [First Amendment] protection on the ground that the speech in issue was commercial speech.” *Va. State Bd. of Pharm. v. Va. Citizens Consumer Council*, 425 U.S. 748, 759 (1976). As a result, this Court has rejected the idea that the government has

complete and unlimited authority to regulate or suppress commercial speech. *Cent. Hudson*, 447 U.S. at 562. Thus, “[t]he First Amendment . . . protects commercial speech from unwarranted governmental regulation.” *Id.* at 561. Protection is extended with the caveat that the speech “must at least concern lawful activity and not be misleading.” *Id.* at 566.

Here, Luhv sought registration of the DUMB BLONDE mark for “[e]ntertainment, namely live performances by a musical band” and “clothing, namely sweatshirts, t-shirts, tank tops, and headwear.” *In re Kourtney Luhv*, 1337 F.3d at 456. DUMB BLONDE advertises Luhv’s business, and proposes a commercial transaction within the meaning of commercial speech. The mark identifies Luhv as producer and seller of entertainment and clothing related to her music, and qualifies as purely commercial speech. Because Luhv’s proposed mark is in no way unlawful and Petitioner has not asserted the mark may mislead any audience as to its purpose or nature, Luhv’s commercial speech implicates First Amendment protection under the first prong of the *Hudson* test.

Section 2(a) of the Lanham Act abridges free speech in a manner that warrants protection. This Court has held that “the First Amendment is implicated when the government places a financial burden on the commercial value of speech based on content.” *Simon & Schuster v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105, 123 (1991). “[U]nder some circumstances, indirect ‘discouragements’ undoubtedly have the same coercive effect upon the exercise of First Amendment rights as imprisonments, fines, injunctions, or taxes.” *Am.*

Comm'ns Ass'n v. Douds, 339 U.S. 382, 402 (1950). When examining this issue in *In re McGinley*, 660 F.2d at 484, the Court of Customs and Patent Appeals asserted that because a trademark rejection does not preclude the applicant from making the speech, section 2(a) does not infringe on the First Amendment. Subsequent decisions from this Court, however, have solidified constitutional safeguards on the value of commercial speech and today, “[a] statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech.” *Simon & Schuster*, 502 U.S. at 115.

By rejecting a mark under section 2(a), the government denies applicants with allegedly disparaging mark the right to exclude the public from impermissibly using their marks—a right the government grants to non-disparaging mark holders. Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law After Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187, 228 (2005). This reduces the commercial value of an applicant’s speech and places a private financial burden on the applicant to protect his own speech. *Id.* Such government action is presumptively invalid because it “plainly imposes a financial disincentive only on speech of a particular content” and constitutes content-based regulation. *Simon & Schuster*, 502 U.S. at 116. While no one has a constitutional right to the benefit of a federal trademark, “[the government] 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). The government is not permitted to

impose regulations “conditioning a valuable governmental benefit on the basis of speech content.” *Bullfrog Films, Inc. v. Wick*, 847 F.2d 502, 509 (9th Cir. 1988). Section 2(a) conditions the commercial benefit of a trademark on the government’s own determination as to disparagement in the mark’s content. Accordingly, section 2(a) of the Lanham Act impermissibly interferes with this First Amendment right.

C. The Lanham Act’s Restriction on Disparaging Marks Fails to Further a Substantial Governmental Interest.

In order to satisfy the second prong of the *Hudson* test, Petitioner must show the Lanham Act’s restriction on disparaging marks furthers a substantial governmental interest. *Central Hudson*, 447 U.S. at 563–66. There are two rationales that are often used to support the policy implication of Section 2(a): (1) the “implied imprimatur” theory and (2) the “waste of government resources” theory. Justin G. Blankenship, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words that Offend?*, 72 U. COLO. L. REV. 415, 447 (2001).

According to the first theory, because the registration process entails registration of a mark in the Trademark Principal Register, substantial governmental interest may lie in keeping the public from mistaking mark approval as a federal imprimatur, or approval, of the mark’s message. Courts have largely rejected the “implied imprimatur” theory. *Id.* As the TTAB has explained, “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 (BNA) 1216, 1219 n.3 (T.T.A.B. 1993). “[T]he issuance of a

trademark registration by [the Patent Trademark Office] does not amount to a government endorsement of the quality of the goods to which the mark is applied.”

Id. A trademark, like a copyright, is private speech without full government endorsement. *Id.*; see also *Mitchell Bros. Film Grp. v. Cinema Adult Theater*, 604 F.2d 852, 856 (5th Cir. 1979) (holding approval of obscene copyright did not indicate acceptability to the government). As a result, trademarks cannot be construed as governmental endorsements, and the “implied imprimatur” theory fails to supply a substantial government interest in the suppression of free speech.

The “waste of government resources” theory similarly fails to hold water. This theory argues that courts should “not see [Section 2(a)] as an attempt to legislate morality, but, rather, a judgment by Congress that such marks not occupy the time, services, and use of the funds of the federal government.” *In re McGinley*, 660 F.2d at 486. However, “[s]ince FY 1991, PTO operations have been funded entirely by fee revenue.” *Figueroa v. United States*, 466 F.3d 1023, 1028 (2006). The only general treasury funds allotted for trademark purposes are PTO employee benefits, which will exist regardless of whether disparaging marks are registered. *Id.* Defending the government’s mark denial decisions could cost more in federal funds than approving a mark in the first place. See *In re McGinley*, 660 F.2d at 487 (Rich, J., dissenting) (“More ‘public funds’ are being expended in the prosecution of this appeal than would ever result from the registration of the mark.”). This theory, thus, lacks persuasive force and “the traditional justification for section 2(a) appear unpersuasive.” Blankenship, 72 U. COLO. L. REV. at 447.

Petitioner may additionally assert that a substantial government interest can be found within the factual language of the Lanham Act itself by discouraging the registration of particular marks based on subjective disparagement toward persons, beliefs or national symbols. *See* 15 U.S.C. § 1052(a) (West 2015) (requiring marks that are disparaging in nature to be refused registration). This is an “offensiveness” theory, that the government has an interest in keeping potentially offensive or distasteful marks from seeping into the general public. Oswald, 41 AM. BUS. L.J. at 287. Legislative history for the Lanham Act reveals such an underlying governmental interest in regulating marks deemed subjectively offensive or distasteful. *See Hearings Before the Comm. On Patents, Subcomm. on Trademarks, House of Representatives on H.R. 4744, 76th Cong., 1st Sess. 18-21 (1939)* (statement of Congressman Thomas E. Robertson) (testifying a mark like “Abraham Lincoln gin ought not to be used . . .” and a provision on disparagement “would take care of [such] abuses.”).

This Court has “consistently held that the fact that protected speech may be offensive to some does not justify its suppression.” *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 71 (1983). On the contrary, “[i]f 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 (1989). This principle applies with equal force to commercial speech. *Bolger*, 463 U.S. at 71. For example, in *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2D at 1219, the TTAB explained that while some

people may disagree with the use of an American flag in trademarks, there is not justification for refusing to register a mark based upon the mere presence of flag imagery. Similarly, a mark containing an illustration of an American flag-bearing condom should not, “simply because of the fact, be refused registration as scandalous.” *Id.* For these reasons, there is no substantial governmental interest to justify an infringement upon the First Amendment and section 2(a) should be accordingly deemed unconstitutional.

D. Even if the Government’s Interest was Compelling, Section 2(a) Fails to Further This Interest Through the Least Restrictive Means.

Even if this Court were to find Petitioner has a substantial governmental interest in regulating potentially disparaging marks, section 2(a) fails the third and fourth prongs of the *Hudson* test. *Cent. Hudson*, 447 U.S. at 566. Under this test, the government must demonstrate that the regulation “directly advance[s] the state interest involved” and that this interest cannot be achieved by less restrictive means. *Id.* In order to satisfy this half of the test, the government must show a “reasonable fit between the means and ends of the regulatory scheme.” *Id.* at 561. “[I]f the Government could achieve its interests in a manner that does not restrict speech, or that restricts less speech, [it] must do so.” *Thompson v. W. States Med. Ctr.*, 535 U.S. 357, 371 (2002). Here, the Government seeks to advance three interests: (1) the “improper imprimatur” theory, (2) the “waste of governmental resources” theory, and (3) the “offensiveness” theory. Because the restrictions furthering these interests are “more extensive than necessary to serve that

interest,” this Court should hold that Section 2(a) improperly burdens the First Amendment right to free speech. *Cent. Hudson*, 447 U.S. at 566.

Assuming *arguendo* that the “improper imprimatur” theory provides a substantial government interest, this interest could have been achieved through less restrictive means by utilizing disclaimers. In *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 651 (1985), this Court held that since government intrusion into the realm of commercial speech must be minimal, disclaimers and disclosures are preferable over complete prohibitions on categories of speech. Stated differently, if the government wanted to avoid public perception of a trademark as a federal endorsement of its message, a less restrictive solution would be to affix trademarks with governmental disclaimers expressly stating the trademark did not constitute an imprimatur. *Id.* This echoes the Court’s belief that, “because disclosure requirements trench much more narrowly on advertiser’s interests than do flat prohibitions on speech, ‘warning or disclaimer might be appropriately required . . . in order to dissipate the possibility of consumer confusion or deception.’” *Id.* at 651, (quoting *In re R.M.J.*, 455 U.S. 191, 201 (1982)). Because the option of disclaimer is an available alternative previously promoted by this Court, Lanham Act regulation does not directly advance the “implied imprimatur” theory under less restrictive means.

Similarly, the government had less restrictive means available under the “waste of government resources” theory. As previously noted, the government should err on the side of the applicant and publish an ambiguous mark to invite

public opinion and opposition. *In re Mavety*, 33 F.3d at 1374. The Federal Circuit has previously acknowledged some government interest in keeping scandalous marks from occupying government resources, but explained that a mark can be passed for publication “with the knowledge that if a group does find the mark to be scandalous . . . an opposition proceeding can be brought and a more complete record can be established.” *Id.* (quoting *In re In Over Our Heads*, 16 U.S.P.Q.2d at 1655). A direct rejection of the allegedly disparaging mark fails to directly further the “waste of government resources” interest since applicants can pursue their cases on appeal to the TTAB and Federal Circuit, at the government’s expense. 15 U.S.C. § 1071 (West 2015). At least one member of the judiciary has noted the government expense in denying marks and opening the door to litigation. *In re McGinley*, 660 F.2d at 487 (Rich, J., dissenting). Opting to pass the mark for publication rather than issuing a flat rejection provides a less restrictive means of regulation more carefully designed to achieve any interest the government may have in preserving section 2(a).

Finally, section 2(a) of the Lanham Act fails to directly advance any governmental interest in preventing social “offensiveness” from disseminating into the public. Even if the government had a substantial interest in protecting members of the public from offensively disparaging symbols, the power of blanket prohibition on such marks fails under the third prong of the *Hudson* test—that the means “directly advance[s] the state interest involved.” *Cent. Hudson*, 447 U.S. at 566. The PTO’s refusal to register a trademark does not preclude the applicant

from dispersing a message to the public because applicants are remain free to promote their message independently of a trademark.. *In re McGinley*, 660 F.2d at 484. As such, any federal prohibition on the mark does not “directly advance” the government’s interest in keeping disparaging messages out of the public. *Cent. Hudson*, 447 U.S. at 566.

The government fails to provide a substantial governmental interest for interfering with Luv’s First Amendment right to free speech. Even if the government was able to supply a compelling interest, section 2(a) fails to direct further this interest through the use of least restrictive means. As a result, section 2(a) of the Lanham Act cannot satisfy the four-prong *Central Hudson* test for regulation of protected commercial speech. Accordingly, section 2(a) of the Lanham Act constitutes an unconstitutional infringement on the First Amendment right to the freedom of speech.

CONCLUSION AND PRAYER

For the reasons set forth, Luv's mark is not disparaging in nature and Section 2(a) of the Lanham Act should be held unconstitutional. Respondents, therefore, pray that this Court reverse in part and affirm in part the decision of the United States Court of Appeals for the Thirteenth Circuit.

Respectfully submitted this 20th day of October, 2015.

ATTORNEYS FOR RESPONDENT