

Docket No. 15-1007

IN THE

Supreme Court of the United States

October Term, 2015

United States,
Petitioner,

v.

Kourtney Luhv,
Respondent

*On Writ of Certiorari to the
United States Court of Appeals*

BRIEF FOR PETITIONERS

QUESTIONS PRESENTED

- I. Whether the Trademark Trial and Appeal Board erred in rejecting a solo music artist's application to register the trademark DUMB BLONDE as her stage name on ground that the mark may be disparaging to women within the meaning of § 2(a) of the Lanham Act?
- II. Does § 2(a)'s prohibition on registering marks that may be disparaging violate the United States Constitution?

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CONSTITUTIONAL PROVISIONS

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

STATUTORY PROVISIONS

I. **§ 1052. Trademarks registrable on the principal register; concurrent registration**

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or 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; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [19 USCS § 3501(9)]) enters into force with respect to the United States.

STATEMENT OF THE CASE

I. Fact Statement

Kourtney Luhv (“Respondent”) has been performing under the stage name, Dumb Blonde, since 2012. (R. at 1, ¶ 3.) Respondent is a vocalist and solo performer whose work focuses on issues faced by women in today’s society. (*Id.*) Respondent’s work incorporates elements from musical genres including Grindcore, Neurofunk, and American Folk music. (*Id.*) Respondent appears in venues in the southern Calidonia region and a myriad other states. (*Id.*) Her work attracts a devoted fan base that frequents her concerts. Respondent also has a vast number of online users who follow her on www.soundpuff.com (“Soundpuff”). Respondent also has an active account on www.uTube.com (“uTube”) under the name DumbBlondeMusic where she uploads videos to share with her users. Respondent had over 40,000 followers of her Soundpuff account and over 100,000 subscribers to her uTube channel at the time of her application for trademark registration. (*Id.*)

In 2014, Respondent recorded several pieces of music she planned on releasing via a record label. Respondent negotiated a record deal with a record label, which includes a \$2,000,000 advance upon execution of the contract. This deal, however, is contingent on her successful registration of the trademark for “DUMB BLONDE.” (*Id.*, ¶ 4).

II. Procedural History

On July 9, 2014, Respondent filed her application for trademark registration for the name “DUMB BLONDE” with the Patent and Trademark Office (“PTO”),

application No. 99/989,052 (“052 application”). She aimed to register the mark for the purposes of “[e]ntertainment, namely live performances by a musical band” and related merchandize such as “clothing, namely, sweatshirts, t-shirts, tank tops, and headwear.” (R. at 2, ¶ 5.)

The PTO examining attorney concluded that the mark “*may* be disparaging to women under 15. U.S.C. § 1052(a) (“the Lanham Act”) (emphasis added) and refused to grant registration for the mark. The attorney cited material submitted with the “052 application.” (*Id.*)

Respondent brought an appeal before the Trademark Trial and Appeal Board (“TTAB”), which affirmed the refusal of the PTO to register the mark. (*Id.*, ¶ 6.) The TTAB determined that it refused to reverse the PTO’s decision on the basis that the mark “may be disparaging to a substantial composite of the referenced group, namely women who have a blonde hair color.” (*Id.*) The TTAB cited several materials, including images from Respondent’s website showing a blonde woman eating plastic fruit and applying White-Out to text displayed on her computer monitor. (*Id.*) TTAB also used dictionary definitions, numerous articles, and user comments on Respondent’s uTube videos, which support the fact women find the phrase “DUMB BLONDE” to be offensive. (*Id.*)

Respondent appeals the decision from the TTAB alleging that it erred in affirming the PTO’s rejection of her application for registration on the grounds that the mark may be disparaging. (*Id.*, ¶ 8.)

III. Background on 15 U.S.C. § 1071

This suit was brought under 15 U.S.C. § 1071, which provides that any "party to . . . a trademark cancellation proceeding . . . who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board," may contest this decision in one of two ways.

First, the party may "appeal to the United States Court of Appeals for the Federal Circuit." § 1071(a)(1). The Federal Circuit shall "review the decision from which the appeal is taken on the record before the United States Patent and Trademark Office." § 1071(a)(4). In other words, the Federal Circuit "is limited to the record before the TTAB" when reviewing the case. *See Swatch, S.A. v. Beehive Wholesale, L.L.C.*, 888 F. Supp. 2d 738, 745 (E.D. Va. 2012) (quoting J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS & UNFAIR COMPETITION* § 21:20 (4th ed. 2013) ("McCarthy")).

Second, the party "may . . . [seek] remedy by a civil action" by filing in a United States district court. § 1071(b)(1). The Court "may adjudge that an applicant is entitled to a registration upon the application involved, that a registration should be canceled, or such other matters as the issues in the proceeding require." § 1071(b)(1). "A civil action in district court affords 'litigants the option of producing new evidence in a trial court.'" *See Swatch*, 888 F. Supp. 2d at 745 (quoting McCarthy § 21.20). Remedy by civil action is available to "a person authorized by subsection (a) of this section to appeal to the [Federal Circuit] . . .

unless appeal has been taken to said [Federal Circuit]." § 1071(b)(1). *Pro-Football, Inc. v. Blackhorse*, 62 F. Supp. 3d 498, 503–04 (E.D. Va. 2014).

SUMMARY OF THE ARGUMENT

I.

First, Respondent contends that the views of women cited by the PTO examining attorney are not an accurate representation of views held by Respondent's fans or a substantial composite of women.

Respondent contends that she chose the name "DUMB BLONDE" as a way to reclaim the stereotype associated with blonde women as well as raise awareness of the challenging which stem from gender discrimination and adverse stereotypes faced by *all* women.

II.

Second, Respondent argues that section 2(a) of the Lanham Act's prohibition on registering marks that may be disparaging is unconstitutional.

STANDARD OF REVIEW

The Trademark and Appeal Board's factual findings for substantial evidence and its ultimate conclusion regarding registration de novo.

ARGUMENTS

I. The TTAB did not err in rejecting Respondent's application to register the trademark "DUMB BLONDE" on the ground the mark may be disparaging to women within section 2(a) of the Lanham Act

The TTAB correctly rejected the Respondent's application to register "DUMB BLONDE" as a trademark because the mark is disparaging to women under the Lanham Act. Petitioner asks the court to AFFIRM the TTAB's rejection of the application to register "DUMB BLONDE" as a trademark. For the first issue, the appellate court correctly identified that "DUMB BLONDE" is a mark disparaging to women.

Section 2(a) of Lanham Act prohibits registration of any mark that "consists of or comprises . . . matter which may disparage . . . persons." For example, in *In re Geller*, the appellate court affirmed the TTAB's refusal to register the mark "STOP THE ISLAMISATION OF AMERICA" because it concluded that its likely meaning could be disparaging to a substantial composite of the group associated with the mark, that is, American Muslims. *In re Geller*, 751 F.3d 1355, 1356–58 (Fed. Cir. 2014).

Similarly, Respondent seeks approval to register "DUMB BLONDE," a mark well recognized as a negative stereotype towards blonde women. The PTO and the TTAB correctly refused to register the mark, which the appellate court recognized as disparaging. Approving the "DUMB BLONDE" mark for registration would

undermine the purposes of the PTO and TTAB, and ultimately the Lanham Act itself. 15 U.S.C. § 1052(a).

The PTO may refuse to register any mark that consists of “. . . matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols . . .” 15 U.S.C. § 1052(a). The TTAB uses a two-part test to determine whether a mark may be disparaging. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (TTAB Apr. 2, 1999). The Factors the *Geller* court considered to determine whether a mark may be disparaging are as follows:

1. The likely meaning of the matter in question, taking into account:
 - a) The dictionary definition of the term, including literary, scholarly works; media references. *Pro-Football, Inc. v. Blackhorse*, 2015 U.S. Dist. LEXIS 90091, *5 (E.D. Va. July 8, 2015);
 - b) The relationship of the [term] to other elements of the mark;
 - c) The nature of the goods and services; and
 - d) How the mark will appear in the marketplace (commerce) in connection with the goods and services, including statements of individuals and groups in the referenced group that mark “may disparage” substantial composite. *Pro-Football, Inc. v. Blackhorse*, 2015 U.S. Dist. LEXIS 90091, *5 (E.D. Va. July 8, 2015); and
2. If that meaning is found to refer to identifiable persons . . . whether that meaning may be disparaging to a substantial composite of the referenced group.

In re Geller, 751 F.3d at 1358 (citing *In re Lebanese Arak Corp.*, 2010 TTAB LEXIS 68, *10–11, 94 U.S.P.Q.2D (BNA), 1215, 1217 (TTAB Mar. 4, 2010)). Both questions must be answered as of the dates of registration of the marks at issue. See *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 125 (D.D.C. 2003); *Harjo v. Pro-Football, Inc.*, 1999 TTAB LEXIS 181, *126, 50 U.S.P.Q.2D (BNA) 1705, 1741 (TTAB Apr. 2, 1999). A mark may disparage when it “dishonor[s] by comparison with what is inferior, slight[s], deprecate[s], degrade[s], or affect[s] or injure[s] by unjust comparison.” *In re Geller*, 751 F.3d at 1356. A determination that a trademark is disparaging is a conclusion of law based upon underlying factual inquiries. *Id.* at 1358. We analyze each of the two parts as follows.

A. The likely meaning of the matter in question, the mark “DUMB BLONDE,” is a reference to blonde women

The first prong of the disparagement test determines “the likely meaning of the matter in question.” *Id.* Here, the likely meaning of the mark “DUMB BLONDE” is a reference to blonde women.

The likely meaning of the mark is determined by taking into account (a) not only dictionary definitions, but also (b) the relationship of the matter to the other elements in the mark; (c) the nature of the goods or services; and (d) the manner in which the mark is used in the marketplace in connection with the goods or services. *In re Geller*, 751 F.3d at 1358.

a. Dictionary definitions of the matter in question

According to Merriam-Webster's Dictionary, the term “disparage” means “to describe (someone or something) as unimportant, weak, bad, etc.; to lower in rank or reputation.” *Nationwide Mut. Ins. Co. v. Gum Tree Prop. Mgmt., L.L.C.*, 597 Fed. Appx. 241, 247 (5th Cir. Miss. 2015) (citing Merriam-Webster’s Dictionary). The Federal Circuit and the TTAB use “offensive” and “disparage” interchangeably when deciding whether a mark consists of a matter that may disparage. *Geller*, 751 F.3d at 1355. Section 2(a) sets a “low bar” by prohibiting a mark that *may* disparage. *Pro-Football*, 2015 U.S. Dist. LEXIS 90091, at *58.

In 2008, the TTAB denied registration of the mark “HEEB” for a clothing and entertainment line. *Pro-Football*, 2015 U.S. Dist. Lexis 90091, *86, (quoting *In re Heeb Media, LLC.*, 2008 TTAB LEXIS 65, *8 (TTAB Nov. 26, 2008)). Under Section 2(a) of the Lanham Act, the PTO’s examining attorney and TTAB refused to register the mark, finding it a disparaging term for Jewish people. The TTAB considered both formal dictionary definitions, online and slang definitions, the views of a professor and “ordinary citizens.” *Heeb*, 2008 TTAB LEXIS at *7–8. If registered, the mark “HEEB” could be disparaging if displayed on a t-shirt or some other entertainment services. *Id.*

Here, Respondent argues that the mark is not intended to disparage blonde women. (R. at 4, ¶ 13.) Her argument appears to rely on the fact that she has a large female fan base as well as a loyal online following, which, she argues, somehow proves that the mark “DUMB BLONDE” is not disparaging. (*Id.*) However, the likely meaning of a “dumb blonde” is a reference to blonde women

through a negative stereotype. The dictionary definition of “dumb” has multiple meanings, one of which is “lacking intelligence” or “requiring no intelligence.” “Dumb.” Merriam-Webster Online Dictionary. 2015. <http://www.merriam-webster.com> (16 Oct. 2015). Ultimately, the term “Dumb Blonde” is slang in nature. An example of a popular definition is from urbandictionary.com: “Dumb Blonde: A blonde who is dumb (in other words, a blonde). *Also see:* Redundant.” Being literally so stupid that one is unable to think or speak is the stereotype exploited in “dumb blonde” jokes. Nina Regenber, *Are Blondes Really Dumb?*, THE INQUISITIVE MIND, June 2007, at 1.

Further, dictionary evidence alone can be sufficient to satisfy the PTO’s burden as to offensive matter, where the mark has one pertinent meaning. *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1340–41 (Fed. Cir. 2003). Here, according to the evidence before the examining attorney in the record, “DUMB BLONDE” has a singular, derogatory meaning.

b. Relationship of the term to other elements of the mark

In *Heeb*, no other elements in the mark indicate that it could refer to anything but Jewish people. *Heeb*, 2008 TTAB LEXIS at *3. Similarly, “DUMB BLONDE” contains no other element that refers to anything but dumb blonde women. Nothing else in the mark alleviates the mark’s derogatory connotation.

c. Nature of the goods and services

In *Blackhorse*, the court found that the likely meaning of “REDSKINS” in the Washington Redskins trademark is a disparaging reference to Native Americans.

Pro-Football, Inc. v. Blackhorse, 2015 U.S. Dist. LEXIS 90091, *99 (E.D. Va. July 8, 2015). The Court considered two of the Redskins Marks to reach this determination; one, which contained an image of a man in profile alluding to Native Americans; and another image including a man carrying a spear, also alluding to Native Americans. *Id.* at *54. As the TTAB and D.C. District court stated, the term “redskins” has not lost its original meaning, and the nature of its goods and services relates an allusion to Native Americans, as well as football. *Id.* at *55. Similarly, two of the Respondent’s “DUMB BLONDE” marks contain an image of a blonde woman eating plastic fruit, and another using White-Out on her computer screen, which unequivocally alludes to the dumb blonde negative stereotype. (R. at 2, ¶ 6.)

d. Manner in which the mark will appear in connection to the goods and services

The Respondent’s use of images of blonde women on her Website, in connection with music performances, and banners displayed during musical performances, demonstrate that the mark “DUMB BLONDE” refers to blonde women. (*Id.*, ¶ 11.)

Refusing to register the trademark is not a government attempt to legislate morality, but rather a “judgment by Congress that [such] marks not occupy the time, services, and use of funds of federal government.” *In re Fox*, 702 F.3d 633, 634 (Fed. Cir. 2012) (citing *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994)).

B. The likely meaning of the mark “DUMB BLONDE” is disparaging to a substantial composite of blonde women

The second prong of the disparagement inquiry asks whether the likely meaning identified in prong one "is found to refer to identifiable persons," and if so, whether that meaning "may be disparaging to a substantial composite of the referenced group." *In re Geller*, 751 F.3d at 1360–61. For example, under Section 2(a) of the Lanham Act, the TTAB in *Heeb* refused to register the mark “HEEB,” finding it disparaging to a substantial composite of the referenced group, Jewish people. *Id.*

Determining disparagement is not limited to the substantial composite of fans of the product. *Heeb*, 2008 TTAB LEXIS at *6. Rather, the PTO and TTAB must consider the views of the entire referenced group. *Id.* For example, the applicant in *Heeb* argues that “HEEB” is a symbol of pride and progressivism among young Jews, and that its entertainment is tailored to Jewish communities. *Heeb*, 2008 TTAB LEXIS at *6. However, the mark “HEEB” is not exclusively limited to un-offended, young Jewish audiences. *Id.* Rather, the mark would become a public trademark viewable by any member of the referenced group, including those who may be offended. *Id.* The PTO examining attorney considered evidence that the term is indeed disparaging to a substantial composite of many Jews. *Id.*

Similarly, the mark “DUMB BLONDE” is disparaging to a substantial composite of blonde women. This analysis considers the view of the group referenced in the mark. *See In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014). A majority

of blonde women may disagree that the mark is disparaging to their group, but a “substantial composite” of the referenced group does not require a majority viewpoint. *Blackhorse*, 2015 U.S. Dist. LEXIS at *51, *91; *In re Geller*, 751 F.3d at 1358; *In re McGinley*, 660 F.2d 481, 485, (C.C.P.A. 1981).

Respondent’s good intentions are to reclaim the term “DUMB BLONDE” from the negative stereotype. (R. at 4, ¶ 13.) However, good intentions fail to erase the fact that a substantial composite of the referenced group may find the term objectionable. *Heeb*, 2008 TTAB LEXIS at *8. Instead, the examining attorney focuses on the perception of the referenced group, not the applicant’s good intentions. *Id.*

While the Respondent’s fan base may infer a positive meaning from the mark, other evidence suggests that women view “dumb blonde” negatively. The applicant in *Heeb* also argued that using “HEEB” reclaimed the word from its derogatory meaning. *Heeb*, 2008 TTAB LEXIS at *3. The “Heeb” company was popular, receiving support from Jewish leaders and retaining thousands of Jewish fans. *Id.* Respondent refers to the mark “DYKES ON BIKES”—a disparaging mark used to positively reclaim the term. Serial No. 78/281,746, filed July 31, 2003 (Dykes on Bikes).¹ But, as the appellate court noted, neither good intentions nor prior registration of a similarly disparaging mark bind the TTAB’s decision to register or refuse a mark. *Id.* Ultimately, the Respondent’s mark is an effort “to get some attention with a tasteless title.” *Heeb*, 2008 TTAB LEXIS at *2.

¹ See *McDermott v. San Francisco Women’s Motorcycle Contingent*, 240 Fed. Appx. 865, 866 (Fed. Cir. 2007).

As a blonde woman, the Respondent attempts to raise awareness of gender discrimination by reclaiming the negative stereotype. (R. at 3, ¶ 13) However, the Respondent's identity is irrelevant to the examining attorney's evaluation. According to usual PTO practice, the examining attorneys take no notice of applicant's identity.²

Ironically, the images the Respondent chooses to represent her mark only further propagate the negative connotation. The record states that Respondent does not dispute the facts; the facts are that the "Dumb Blonde" website displays images of blonde women behaving in a manner that suggests the stereotype of blonde stupidity. One image is of a blonde woman eating plastic fruit; another is a blonde woman using White-Out on her computer screen. (R. at 2, ¶ 6.)

Lastly, Respondent offers the popularity of her music as evidence that she successfully addresses women's issues in a positive way, and thus her mark should be granted registration for federal protection. (R. at 4, ¶ 13.) However, the popularity of the product behind the mark is not a factor when considering registration. For example, the popularity of the Washington Redskins is demonstrated by the fact it has garnered a following since 1933, and throughout its continuous registrations in 1967, 1974, 1978, and 1990. *Pro-football v. Blackhorse*, 2015 U.S. Dist. LEXIS at *2. Yet, its popularity did not influence the consideration of terminating its registered trademark. Likewise, popularity of Respondent's music is not a factor when considering whether to approve or deny registration of

² Serial No. 78/281,746, Office Action Outgoing at 1, Oct. 28, 2004 (Dykes on Bikes).

her mark. The refusal to register a mark does not “proscribe any conduct or suppress any form of expression because it does not affect the applicant's right to use the mark in question.” *Boulevard*, 334 F.3d at 1343. Petitioner is not denying the Respondent’s ability to perform. She is free to continue making money, making music, and using the “DUMB BLONDE” name—just not as a registered trademark.

The TTAB may conclude there is substantial evidence supporting the Board’s finding that the mark is disparaging to a substantial composite of women with blonde hair, without conducting a marketing survey or other quantitative measure of the term's offensiveness. The Board does not have the resources, “nor is it required, to conduct a marketing survey each time it evaluates whether a term is disparaging.” *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768 (Fed. Cir. 1985). Further, to support the PTO’s finding of disparagement, the court only looks for substantial evidence, or “more than a scintilla of evidence.” *In re Pacer Tech.*, 338 F. 3d 1348, 1349 (Fed. Cir. 2003). In the absence of direct evidence, the PTO may also meet its burden by “extrapolating” from evidence in the record that a substantial composite finds the mark used for goods and services to be disparaging. *Heeb*, 89 U.S.P.Q 2d at *7–8.

Approving “DUMB BLONDE” as a registered trademark simply because there are disparate opinions about its offensiveness would undermine the authority and purposes of the PTO and TTAB. 15 U.S.C. § 1052(a). The mark does not first have to be registered to find out whether or not it is offensive. 15 U.S.C. 1052(a).

Rather, the Lanham Act is a threshold, and the PTO and TTAB are gatekeepers that determine which marks may be registered or refused. *Id.*

The court of appeals correctly found that section 2(a) of the Lanham Act prohibits registration of a disparaging mark. *Pro-Football, Inc. v. Blackhorse*, 2015 U.S. Dist. LEXIS 90091, *45 (E.D. Va. July 8, 2015). The duty of the examining attorney is to determine whether a mark is disparaging within the meaning of the Lanham Act, and deny registration where evidence demonstrates a disparaging mark. *Id.* That is what happened here: both the PTO and TTAB correctly denied the Respondent's "DUMB BLONDE" mark because it is disparaging; therefore, the mark fails to pass the test required under the Lanham Act required before approval as a federally registered trademark.

II. Section 2(a) of the Lanham Act does not violate the First Amendment by prohibiting the registration of disparaging marks

Long standing precedent set by this Court unambiguously shows that when the Government is speaking, the First Amendment is not implicated. The federal trademark registration program is squarely within the well-established parameters of the government speech doctrine for three reasons. First, it requires the government to affirmatively endorse approved marks by publishing them in a government owned and operated publication. Second, it requires the government to issue a certificate of registration for marks it approves. Third, approved marks are physically registered in a government run database.

Respondent's argument that the Lanham Act violates the First Amendment should be rejected for the following reasons:

- a) The appellate court erred by misconstruing the Federal Trademark Registration process as protected commercial speech;
- b) The Trademark Registration process is governmental speech under the Fourth Circuit's Four-Factor Test;
- c) Even if the appellate court properly construed the Federal Trademark Registration as commercial speech, the court erred by inappropriately applying the Central Hudson Test;
- d) The Unconstitutional Condition Doctrine does not apply because the USPTO relies on congressionally appropriated funds; and
- e) The appellate court erred by ignoring the Constitutional Avoidance Doctrine.

A. The appellate court erred by misconstruing the Federal Trademark Registration Process as Protected Commercial Speech.

The appellate court erred by conducting its commercial speech analysis as if Respondent had already been awarded a federal trademark. *In re Luhv*, 1337 F.3d 455, 459 (Fed. Cir. 2015) (“[W]e consider whether a trademark can be construed as commercial speech. . . . [W]e find that *her* trademark . . .”)(emphasis added). This is a significant error because it fundamentally changed the appellate court’s constitutional analysis with regards to commercial speech. The lower court initially set out to determine “whether section 2(a)’s prohibition on registering marks that may be disparaging violates the United States Constitution.” *Id.* at 455. However, as it pertains to commercial speech, the lower court never actually examined the prohibition on registering marks or the federal registration process, they began their analysis as if the trademark had already been awarded. This is an incredibly

important technical error because the actual issue is whether the federal trademark registration program and process is commercial speech, not whether the presumptive end product, the registered trademark, is commercial speech. The lower court ignored a crucial and determinative step in their analysis by overlooking the federal trademark registration process.

Trademark rights do not arise out of federal law but rather common law. *See e.g., B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015) (citing *In re Trade-Mark Cases*, 100 U.S. 82, 91–92 (1879)). The federal government merely offers statutory trademark protections—via the Lanham Act—to certain entities that meet federal qualifications and complete the federal registration process with the United States Patent and Trademark Office (PTO). *Id.* If the PTO approves a mark, they endorse it by publishing the mark in the Official Gazette of the Patent and Trademark office, and subsequently issue a registration certificate. *Pro-Football, Inc. v. Blackhorse*, 2015 U.S. Dist. LEXIS 90091, *11 (E.D. Va. July 8, 2015); *See also* U.S.P.T.O., Trademarks—What Happens Next? (describing the step-by-step registration process). While registration is significant in that it provides enhanced protection as well as a streamlined statutory cause of action for infringement, it does not alter the common law foundation of trademark protection. *B & B Hardware*, 135 S. Ct. at 1298–1300. In other words, registration does not confer additional rights beyond what is granted by the common law; it merely confers additional mechanisms to protect those rights. *Id.* Crucially, regardless of

whether or not a mark is registered, its holder still enjoys common law protection.
Id.

One of the aforementioned qualifications for federal registration—codified as section 2(a) of the Lanham Act—is that a mark not be disparaging to any person, entity, or belief. 15 U.S.C. 1052(a). In fact, the Act expressly forbids the federal registration of any mark, “which may disparage . . . persons, living or dead . . .” *Id.* Importantly, nothing in the Act strips disparaging marks of their common law protection. *Id.* Consequently, federal courts have long held that since the Lanham Act leaves common law trademark the Act’s prohibition on registration of such marks does not implicate the first amendment. *In re McGinley*, 660 F.2d at 484. In effect, the *McGinley* court implied, without directly stating, that the federal trademark registration process was government speech. In the decades following the *McGinley* decision this Court has clarified and reinforced the government speech doctrine, such that it is now unequivocally apparent that the federal trademark registration program is absolutely government speech. *See e.g., Pleasant Grove City, Utah v. Summum*, 555 U.S. 460, 467 (2009) (where Justice Alito gives a brief but substantive overview of notable government speech decisions).

In 1995 this Court opined that when the government is promoting its own policies, or furthering its own policy goals, “it is entitled to say what it wishes.” *Rosenberger v. Rector & Visitors of Univ. of Virginia*, 515 U.S. 819, 833 (1995) (citing *Rust v. Sullivan*, 500 U.S. 173, 194, (1991)). Shortly thereafter, in 1998, this Court reaffirmed and solidified that position in *National Endowment For The Arts*

v. Finley. There, an artist alleged that the National Endowment For The Arts (NEA) violated her first amendment rights by denying a grant application. *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569 (1998). This Court, with an eight-member majority opinion, resoundingly rejected the notion that the first amendment is implicated when a federal entity chooses not to fund or endorse a non-governmental program or entity. *Id.* at 586–87. Notably, in his concurring opinion, Justice Scalia correctly pointed out that in a democratic republic “[i]t is the very business of government to favor and disfavor points of view . . .” *Id.* at 598 (Scalia, J., concurring).

Two years after *NEA v. Finley*, a group of students at the University of Wisconsin sued the Board of Regents, asserting that the universities mandatory “student activity fee” violated their first amendment rights by forcing them to fund organizations they oppose. *Bd. of Regents of Univ. of Wisconsin Sys. v. Southworth*, 529 U.S. 217 (2000). In a unanimous opinion this Court held that the first amendment does not prohibit a public entity from charging mandatory fees to fund programs which are “viewpoint neutral,” noting also that “the government can speak for itself” regarding what activities or speech it chooses to endorse. *Id.* at 221, 229. Taken together, the “viewpoint neutrality” and “government speech” doctrines function to say that when the government is speaking the first amendment is not implicated, but when the government is funding or facilitating private speech, that speech must be viewpoint neutral.³

³ See Andy G. Olree, *Identifying Government Speech*, 42 CONN. L. REV. 365 (2009).

In 2005, this Court once again upheld the government speech doctrine when a group of beef producers brought suit against the U.S. Department of Agriculture, seeking to enjoin the department from using mandatory fees to fund a beef promotion program, which burdened the producers. *Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550 (2005). The majority concluded that government advertising and promotion is government speech, which is “exempt from first amendment scrutiny.” *Id.*

Most recently, in *Walker*, this Court reaffirmed that government speech is immune from first amendment challenges. *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2245, 192 L. Ed. 2d 274 (2015). In *Walker*, the Sons of Confederate Veterans, a non-profit organization, brought suit after the Texas Department of Motor Vehicles refused to adopt and issue a custom license plate displaying the confederate flag, which the organization had designed and submitted for approval. *Id.* The Majority concluded that because a license plate is issued by the government, it is government speech and not susceptible to first amendment challenges. *Id.* at 2245–46, 2249–51. It is unquestionably clear, as evidenced by decades of precedent set by this very Court, that the first amendment is not a barrier for government speech.

The federal trademark registration program is logically identical to the license plates in *Walker*. Like the license plate in *Walker*, Respondent here is seeking government approval of her mark. In *Walker*, the organization was not seeking permission to use their logo, they were asking the government to affiliate

itself with their logo, which this Court correctly held the government was not obligated to do. Similarly, Respondent is not asking permission to use her mark, she is asking the government to affiliate itself with her mark by publishing it in an official government reporter, and by issuing her a trademark certificate, which like a license plate, is tantamount to a government endorsement.

Furthermore, a registered federal trademark is comparable to the federal grant at issue in *NEA v. Finley*. There, this Court concluded that the government had the authority to pick and choose what entities or individuals it wished to endorse by issuing a grant without implicating the First Amendment. Like the NEA, the PTO ought to have the power to choose whom to affiliate itself with. If the government can choose who is worthy of a federal grant it must also be able to choose who is deserving of a registered trademark.

Moreover, like the University of Wisconsin students⁴ and the beef producers,⁵ Respondent is implicitly irritated by the government's choice in refusing to use their resources for her benefit, while simultaneously using them to benefit others. In *University of Wisconsin v. Southworth*, Plaintiffs were upset by the university's endorsement of particular organizations via an allocation of funds. Similarly, in *Johanns v. Livestock Marketing*, Plaintiffs were disgruntled by the government's advertising method for promoting beef. In both of those cases this Court determined that the government is free to choose how to allocate its time and capital. Here, Respondent is equally perturbed by the government's refusal to use

⁴ See *Bd. of Regents of Univ. of Wisconsin Sys. v. Southworth*, 529 U.S. 217 (2000).

⁵ See *Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550 (2005).

its time and capital to register her mark. If the government is permitted to endorse specific private organizations using public funds, and is allowed to advertise specific products however they see fit, the inverse must also be true, such that the government is free to avoid affiliating itself with an individual or entity it finds unsavory, and in this case, disparaging.

The appellate court's decision to ignore actual federal registration process and skip straight to a commercial speech analysis diverges from a multitude of precedent in that it disregards the government's role in the process. A USPTO registration certificate is a government issued document, and the trademark registry is a government registry. By completely ignoring the well-established government speech doctrine the lower court insinuates that the First Amendment requires the government, through the PTO, to be a proverbial "yes man" and rubber-stamp anything they are presented with. This reasoning is inexcusably dangerous because it would permit an individual to weaponize the First Amendment and use it to hold the government hostage by forcing them to endorse, protect, and affiliate themselves with any and all trademarks via the registration process. Upholding the lower court's decision would effectively slaughter the government speech doctrine by forbidding the government from using its best judgment when deciding how to allocate its resources. Essentially, what the Respondent wants, and what the lower court gave her, is a system where government endorsements and resources are given out on a first-come first-serve basis, with no mechanism to judge the wisdom of those endorsements or allocations.

That cannot be allowed. This Court should uphold the government speech doctrine and reverse the lower court's decision for failing to properly conduct a government speech analysis.

B. The Trademark Registration Process is government speech under the Fourth Circuit's four-factor test

The Fourth Circuit has developed a well-respected comprehensive standard to identify government speech. Their equally weighted four-factor test examines:

1. The central purpose of the program in which the speech in question occurs;
2. The degree of editorial control exercised by the government or private entities over the content of the speech;
3. The identity of the literal speaker; and
4. Whether the government or the private entity bears the ultimate responsibility for the content of the speech.

Sons of Confederate Veterans v. Vehicles, 288 F.3d 610, 618 (4th Cir. Va. 2002).

First, the central purpose of the federal trademark registration program is to provide enhanced governmental protections for trademarks used in interstate and international commerce. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985). This enhanced protection only arises after the government chooses to register a mark; the registration process is not a simple mechanical operation. Rather, it requires subjective government oversight. The Lanham Act makes this abundantly clear.

Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the United States Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon, and a record thereof shall be kept in the United States Patent and Trademark Office.

15 U.S.C. § 1057(a).

Second, the government, through the USPTO, has absolute editorial control over what is published in the Official Gazette of the United States Patent and Trademark Office, as well as the content of the government issued certificate. 15 U.S.C. §§ 1052, 1062.

As to the third factor, the identity of the literal speaker is indisputable. The government owns and operates the Official Gazette where publication of an approved mark is required. *Id.* Additionally, the government creates and issues the official registration certificates. 15 U.S.C. § 1057. There can be no doubt that the literal speaker is the government.

Finally, because the government is the literal speaker, it bears the ultimate responsibility for the content of the Official Gazette publication, as well as the government issued registration certificate. *Id.*

While the Fourth Circuit's four-factor test has no controlling precedential value, it provides a strong persuasive framework that reinforces this Court's own precedent indicating that the federal trademark registration process is government speech and exempt from first amendment scrutiny.

C. Even if the appellate court properly construed the federal trademark registration as commercial speech, they erred by inappropriately applying The Central Hudson Test to Section 2(a)

In 1980 New York’s Public Service Commission banned any and all advertising by electricity providers. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of New York*, 447 U.S. 557 (1980). The ban was challenged as an unconstitutional abridgement of electric utilities protected commercial speech. *Id.* Importantly, this Court noted at the outset of its examination the line of cases demonstrating that commercial speech is fundamentally different from private speech, and is not entitled to the full force of First Amendment protections. *Id.* at 562–63 (internal citations omitted). Next, the Court developed a four-factor test to determine when government interference of commercial speech is permissible under the First Amendment. *Id.* at 566.

The Court’s test asks four questions:

1. Does the speech concern illegal activity or is it misleading? If not,
2. Is the asserted governmental interest substantial? If so,
3. Does the regulation directly advance the interest? If so,
4. Is the regulation more extensive than necessary to serve that interest?

Id. Here, the speech in question is lawful. The appellate court focused their analysis on the second prong of the test and incorrectly concluded that there was no substantial government interest in denying federal registration of Respondent’s “DUMB BLONDE” mark. *In re Luhv*, 1337 F.3d at 460. In reaching this conclusion the appellate court relied on *Bolger v. Youngs Drug Prods. Corp.*, where this Court

held that offensiveness does not justify suppression of protected commercial speech. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983). This analysis was inappropriate and fundamentally incorrect because Respondent's speech is not being suppressed, she is free to use her mark however she sees fit, regardless of whether it is registered or not. In fact, registering her mark would actually function as a form of suppression because it would limit third parties' use of the term "DUMB BLONDE." This nuance was entirely overlooked by the lower court.

Approximately sixteen percent of Americans are naturally blonde, and forty percent of American women who dye their hair opt for blonde.⁶ The government's interest in seeking to avoid affiliating itself with a mark that could potentially disparage a sizeable portion of the population is both substantial and legitimate.

D. The Unconstitutional Conditions Doctrine does not apply because the USPTO relies on congressionally appropriated funds

In *Perry v. Sindermann* this Court established the unconstitutional conditions doctrine, which states that the Government may not deny benefits to individuals on any basis that infringes constitutionally protected interest. *Perry v. Sindermann*, 408 U.S. 593, 597 (1972). However, this is far from a black letter rule and functions less like a "doctrine" and more like a persuasive guideline. *Dolan v. City of Tigard*, 512 U.S. 374, 407 n. 12 (1994). While the doctrine itself is ambiguous, the fact that

⁶ Bo Emerson, *Light-colored hair can be golden for women*, CHICAGO TRIBUNE, (Apr. 12, 2006), http://articles.chicagotribune.com/2006-04-12/features/0604120014_1_clairol-natalia-ilyin-blonde-myth; Margaret Loftus, *The roots of being blond*, U.S. NEWS & WORLD REPORT, Mar. 13, 2000, at 51.

it does not apply when the alleged violator is government funded is quite clear. *Rust v. Sullivan*, 500 U.S. 173, 194 (1991).

While the U.S.P.T.O funds its entire operating budget with user-generated fees, it still relies on federal appropriations for its employee benefit programs. *Figueroa v. United States*, 466 F.3d 1023, 1028 (Fed. Cir. 2006). Moreover, the U.S.P.T.O. relies on government-funded infrastructure to conduct its operations.⁷ Without congressional appropriations the U.S.P.T.O would be unable to function, therefore the unconstitutional conditions doctrine does not apply.

E. The appellate court erred by ignoring the Constitutional Avoidance Doctrine

Finally, democratically passed legislation is presumptively constitutional. *United States v. Carolene Products Co.*, 304 U.S. 144 (1938); *Walters v. Nat'l Ass'n of Radiation Survivors*, 468 U.S. 1323, (1984). With respect to the presumption of constitutionality, this Court crafted, and has long maintained, a respect for the Constitutional Avoidance Doctrine. *See e.g., Clark v. Martinez*, 543 U.S. 371, 381, (2005); *Edward J. DeBartolo Corp. v. Florida Gulf Coast Bldg. & Const. Trades Council*, 485 U.S. 568, 575 (1988). Under this doctrine, when there are two or more plausible statutory interpretations, the court construes the statute in a manner that avoids implicating the Constitution. *Id.*

Here, because Section 2(a) of the Lanham Act is presumptively constitutional the appellate court erred by conducting a constitutional analysis after they

⁷ United States Government Accountability Office, *Federal Buildings Fund*, (Jul. 2012) <http://www.gao.gov/assets/600/592377.pdf> (last visited Oct. 19, 2015).

unambiguously upheld the trial courts determination that the mark in question is in fact disparaging. Under *Rust*, the federal government has substantial latitude in choosing how to manage programs it funds and creates. *Rust v. Sullivan*, 500 U.S. 173, 194 (1991). Because the Federal Trademark Registration Program was independently created by Congress, is solely managed by federal officials, and exists only so long as Congress chooses to fund it, and because the trial court did not err in determining the mark in question was disparaging under the Act, the Constitutional Avoidance Doctrine should have been respected by the appellate court, and should now function as a barrier preventing any further implication of the Constitution.

CONCLUSION

This Court should AFFIRM the TTAB's decision to reject Respondent's mark for federal registration. For the first issue, the appellate court correctly identified that "DUMB BLONDE" is a mark disparaging to women. A finding that the mark is disparaging warrants denial of registration as a trademark under the Lanham Act. For the second issue, section 2(a) of the Lanham Act does not implicate the first amendment because the trademark registration process is government speech. Moreover, even if the government speech doctrine did not exist, Respondent's rights have not been infringed in any way whatsoever because she is free to use her mark in any manner she pleases. This Court should preserve the integrity of long standing precedent, which prevents rogue individual entities from using the First

Amendment as a sword, instead of a shield, against the government. The lower court's decision should be reversed on the second point.

CERTIFICATE OF SERVICE

The undersigned certify that this brief was prepared in accordance with the 2015 Pepperdine University School of Law 18th Annual National Entertainment Law Moot Court Competition Rules. The undersigned also certify that this brief is the work product of team members only.

The undersigned certify that five true and correct copies of this brief was mailed to Patty Hayes to the following address on October 20, 2015:

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