
Case No. 15-1007

In The
Supreme Court of the United States

November Term, 2016

UNITED STATES,

Petitioner,

v.

KOURTNEY LUHV

Respondent.

On Writ of Certiorari from the United State Court of Appeals, Federal Circuit
Cause No. 90263-2015

BRIEF FOR KOURTNEY LUHV
Respondent

Team 118
Counsel for Respondent

QUESTIONS PRESENTED

1. Did the TTAB err in rejecting Ms. Luhv's application to register the mark DUMB BLONDE because it was disparaging to women under § 2(a) of the Lanham Act when her stated purpose of using the mark was to reclaim the stereotype, and many women actually viewed the mark as positive?
2. Does § 2(a) of the Lanham Act violate the First Amendment because it allows for rejection of trademarks on the basis of constitutionally protected speech?

CERTIFICATE OF INTERESTED PARTIES

Pursuant to Rule 24(1)(b) of the Rules of the Supreme Court of the United States, the caption of this case contains the names of all parties involved in the proceeding under review.

Team 118
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Counsel for Respondent

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OPINIONS BELOW

The Trademark Trial and Appeal Board (TTAB) affirmed the Patent and Trademark Office's (PTO's) rejection of Ms. Luhv's trademark, DUMB BLONDE, on the basis that it is disparaging to women, and rejected her constitutional argument in an unreported opinion. The United States Court of Appeals for the Federal Circuit affirmed in part and reversed in part. The opinion is reported as 1337 F.3d 455 (Fed. Cir. 2015).

STATEMENT OF JURISDICTION

The Court of Appeals for the Federal Circuit rendered judgment on June 6, 2015. Petitioner filed for writ of certiorari, which this Court granted. This Court properly has jurisdiction pursuant to 28 U.S.C. § 1254(1).

RELEVANT CONSTITUTIONAL AND STATUTORY PROVISIONS

The following Constitutional provision is relevant to the decision of this case:

U.S. Const. amend. I.

The following federal statute is relevant to the decision in this case:

15 U.S.C. § 1052(a)

STATEMENT OF THE CASE

This case is an appeal by the United States from the decision of the United States Court of Appeals for the Federal Circuit, which upheld the TTAB's rejection of Ms. Luhv's application to register the trademark DUMB BLONDE, but also declared § 2(a) of the Lanham Act unconstitutional as a violation of the First Amendment. *In re Luhv*, 1337 F.3d 455, 456–57 (Fed. Cir. 2014). This case initially arose when Ms. Luhv filed an application with the PTO to register the mark DUMB BLONDE on July 9, 2014. *Id.* at 456. The examining attorney rejected the application on the grounds that it was disparaging to women.

Ms. Luhv appealed to the United States Court of Appeals for the Federal Circuit, which reversed, in part, the decision of the TTAB. *Id.* at 460. The Federal Circuit affirmed that the PTO's rejection of the trademark DUMB BLONDE was proper under § 2(a) of the Lanham Act because it was disparaging to women, but the Federal Circuit ultimately invalidated the law, declaring it unconstitutional as violating the First Amendment. *Id.* at 460. Thus, the rejection of the trademark under § 2(a) of the Lanham Act was improper. *Id.* The United States appeals.

STATEMENT OF FACTS

Ms. Luhv is a vocalist and solo artist who is on the brink of signing a recording contract worth \$2,000,000. *In re Luhv*, 1337 F.3d 455, 455-56. The only way she can make this deal, however, is if she successfully registers her stage name, “Dumb Blonde”, as a trademark. *Id.* at 456.

Ms. Luhv began using the stage name Dumb Blonde in 2012. *Id.* at 455. She chose Dumb Blonde as her stage name in hopes of “recast[ing] the phrase in a positive light by displaying it prominently alongside a woman with a successful career, and through musical lyrics that shed light on critical issues faced by women.” *Id.* at 458. She first started performing in various venues in southern Calidonia, attracting a devoted fan base that frequently attends her concerts. *Id.* at 456.

In addition to her devoted concert-going fans, Ms. Luhv grew a sizeable online fan base through her uTube channel, DumbBlondeMusic, and the online streaming service, Soundpuff. *Id.* Currently, Ms. Luhv has over 40,000 “followers” on Soundpuff, and over 100,000 subscribers to her uTube channel. *Id.*

By June 2014, Ms. Luhv had enough recorded material to release an extended-play record (EP). *Id.* After negotiating the deal and finding out that it was contingent upon her ability to register Dumb Blonde as a trademark, she applied for registration with the PTO, but was rejected. *Id.*

SUMMARY OF THE ARGUMENT

We respectfully ask this Court to reverse the decision of the Federal Circuit in concluding that the TTAB erred in refusing registration of the mark DUMB BLONDE on the grounds that it is disparaging to women. Contrary to the Federal Circuit's determination, the likely meaning of the mark is not a disparaging reference to women. Rather, in the context of Ms. Luhv's performances, which seek to bring attention to women's issues in today's society, women demonstrably interpreted the term positively as a way to illustrate the irony of a "dumb blond" in today's society. Furthermore, Ms. Luhv has provided significant evidence illustrating that a substantial composite of women, in light of the context in this case, do not find the term disparaging. Nevertheless, all doubt should have been resolved in Ms. Luhv's favor, as parties who feel disparaged still have the opportunity to challenge the registration of the mark in an opposition proceeding.

We also respectfully request this Court to declare § 2(a) of the Lanham Act unconstitutional because it is a restriction on commercial speech that impermissibly denies benefits to Ms. Luhv based on the content of her speech. Commercial speech provides information as to who is selling the product, for what reason, and for what price. Through the mark DUMB BLONDE, Ms. Luhv identifies the source of her music, which will, in turn, lead people to purchase her music and apparel associated with her band. Additionally, in using the mark DUMB BLONDE, Ms. Luhv hopes to change the way women are viewed and draw attention to issues faced by women in today's modern society. This type of speech is considered to be at the heart of the

First Amendment. By conditioning access to government benefits on the content of protected speech, the Lanham Act violates the unconstitutional conditions doctrine.

Furthermore, the government has not advanced any substantial interest that justifies the suppression of speech in this context. Without a substantial interest to support it, any restriction on speech is presumed invalid. Even if the Court determines that the government does have a substantial interest in preventing the use of federal funds, protecting the public from offensive speech, or giving the impression that it endorses disparaging marks, the restrictions placed upon speech by the Lanham Act do not sufficiently further these interests. For the foregoing reasons, the Court should reverse the decision of the Federal Circuit in regards to the registration of the mark DUMB BLONDE and affirm the decision rejecting § 2(a) of the Lanham Act as unconstitutional.

ARGUMENT

I. This Court should reverse the decision of the Federal Circuit because the TTAB erroneously concluded that Ms. Luhv’s proposed mark, DUMB BLONDE, is disparaging to women under § 2(a) of the Lanham Act.

Section 2(a) of the Lanham Act provides that no otherwise valid trademark may be refused registration by the United States Patent and Trademark Office (PTO) “unless it 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.” 15 U.S.C. § 1052(a). In *Harjo v. Pro-Football, Inc.*, the Trademark Trial and Appeal Board (TTAB) distinguished the disparagement language of § 2(a) as a separate and distinct ground for refusing registration, and concluded that a mark is disparaging if it “dishonor[s] by comparison with what is inferior, slight[s], deprecate[s], degrade[s], or affect[s] or injure[s] by unjust comparison.” *Harjo v. Pro-Football, Inc. (Harjo II)*, 50 U.S.P.Q.2d 1705, 1736, 1738 (T.T.A.B. 1999), *rev’d on other grounds*, 284 F.Supp.2d 96 (D.D.C. 2003) (finding no error in the disparagement test).

With this definition in mind, the TTAB further delineated a two-step process for determining whether a proposed mark may be refused registration on the grounds that it is disparaging. *Id.* at 1736. The “Harjo Test” asks the following two questions:

- (1) [W]hat is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the

manner in which the mark is used in the marketplace in connection with the goods or services; and (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Id. at 1740–41.

Under the Harjo Test, the burden is on the PTO’s examining attorney to first establish that the mark, based upon substantial evidence (or more than a scintilla of evidence), is disparaging. *In re Squaw Valley Dev. Co. (Squaw Valley)*, 80 U.S.P.Q.2d 1264, 1270–71 (T.T.A.B. 2006). If the examining attorney meets this burden, there is a presumption of disparagement. *Id.* However, the applicant may present additional evidence to rebut and overcome that presumption. *Id.* The PTO’s decision on whether a trademark is disparaging is “a conclusion of law based upon its underlying factual inquiries;” thus, on appeal, its factual findings are reviewed for substantial evidence and its ultimate conclusion for registration is reviewed de novo. *See, e.g., In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014).

A. The likely meaning of DUMB BLONDE is not disparaging because, in the context of Ms. Luhv’s musical entertainment, women interpret the term as an ironic, positive reference to feminine stereotypes.

The first prong of the Harjo Test requires the examining attorney to determine the “likely meaning of the matter in question.” *Harjo II*, 50 U.S.P.Q.2d at 1740–41. To do so, the examining attorney must take into account (i) dictionary definitions; (ii) the relationship of the matter to the other elements in the mark; (iii) the nature of the goods or services; and (iv) the manner in which the mark is used in the marketplace in connection with the goods or services. *Geller*, 751 F.3d at 1358. Although the PTO is recognizably an “agency of limited resources,” examining

attorneys have traditionally referenced a wide range of sources to determine the likely meaning of the mark, including: surveys, legislative materials, academic publications, and scholarly articles. *See Squaw Valley*, 80 U.S.P.Q.2d at 1271.

To determine the likely meaning of a particular mark under the Harjo Test, examining attorneys typically reference dictionary definitions as they “represent an effort to distill the collective understanding of the community with respect to language.” *In re Boulevard*, 334 F.3d 1336, 1340 (Fed. Cir. 2003). Nevertheless, there is an “inherent fallibility” in relying on dictionary definitions as the meaning of a particular word invariably changes over time. *See In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1373 (Fed. Cir. 1994). This inherent distrust in dictionary definitions promulgated the rule that the examining attorney’s reliance on dictionary definitions alone is insufficient to meet the burden of establishing that a mark is disparaging, unless the definitions unanimously posit a single interpretation. *Boulevard*, 334 F.3d at 1340–41.

Given this skepticism towards relying solely on dictionary definitions, the examining attorney must also interpret the mark in conjunction with the nature of the goods and services. *See Squaw Valley*, 80 U.S.P.Q.2d at 1269. The relevant goods and services for this analysis are those articulated in the application for registration. *Id.* In *Squaw Valley*, the PTO initially refused registration of the mark SQUAW on ski apparel and equipment for the world-famous ski resort, Squaw Valley, because it was, according to all dictionary definitions, a disparaging term for Native Americans. *Id.* at 1267. However, on appeal, the TTAB reversed, recognizing

that SQUAW, in this context, was a reference to the famous ski resort, not a disparaging nickname for Native Americans. *Id.* at 1279.

The importance of analyzing the mark in the context of the applicant's goods and services was further reiterated in *In re Heeb*. See *In re Heeb*, No. 78558043, 2008 WL 5065114 at *3–4 (T.T.A.B. 2008). In *Heeb*, the TTAB denied registration of the mark HEEB for clothing despite the fact that the applicant had already successfully registered the mark for a magazine. *Id.* The TTAB recognized that many Jewish people “understood the playful, satirical nature and format of the magazine.” *Id.* at *3. But, this argument did not translate over to the context of clothing. *Id.* at *1. Instead, for use on clothing, the TTAB found that HEEB was “an effort to get some attention with a tasteless title.” *Id.* at *2. Additionally, because the TTAB was limited in considering only the goods and services identified in the application, which did not include the magazine, the TTAB refused registration. *Id.* at *1.

Lastly, to determine the mark's likely meaning, the TTAB must also consider how the applicant is portraying the mark in the marketplace. See *Geller*, 751 F.3d at 1359–60. In *Geller*, the Federal Circuit looked to features on the applicant's website to determine whether the meaning of STOP THE ISLAMISATION OF AMERICA was disparagingly associating American Muslims with violence. *Id.* The examining attorney looked specifically to the content of the scholarly articles and anonymous comments posted on the applicant's website to determine the likely meaning of the mark. *Id.* at 1360. Similarly, in *In re Tam*, the examining attorney

determined the likely meaning of the mark THE SLANTS by looking to the band's website, which displayed a condescending, stereotypical picture of an Asian woman, sun imagery, and a dragon. *In re Tam*, 785 F.3d 567, 569 (Fed. Cir.), *reh'g granted en banc*, 600 F. App'x 775 (Fed. Cir. 2015) (Mem.).

In this case, the TTAB erred in concluding that DUMB BLONDE implied a negative, stereotypical view of women in a manner that was offensive, insulting, and disparaging. *See In re Luhv*, 1337 F.3d 455, 457 (Fed. Cir. 2015). First and foremost, the TTAB's conclusion regarding the disparaging nature of the mark was not supported by substantial evidence. In affirming the TTAB's decision to refuse registration of DUMB BLONDE, the Federal Circuit referenced the "evidence presented by the examining attorney and reviewed by the TTAB;" however, it provided no specific evidence for this Court to review beyond noting the general existence of "dictionary definitions, numerous articles, and [online] user comments." *Id.* This lack of evidence alone is sufficient to conclude that the PTO failed to meet its burden of providing substantial evidence that DUMB BLONDE is a disparaging term to women. On the other hand, Ms. Luhv provided ample evidence to conclude that DUMB BLONDE, as used in the context of the goods and services and as portrayed in the marketplace, is used ironically, not disparagingly, to draw attention to women's issues in today's society. *Id.*

Even though dictionary definitions may define the phrase "dumb blonde" in a matter that is disparaging to women, when the mark is viewed in the context of the goods in the marketplace, it is not a disparaging term. The online Oxford Dictionary

defines a “dumb blonde” as “[a] blond-haired women perceived in a stereotypical way as being attractive but unintelligent.” *Dumb Blonde*, OXFORD DICTIONARIES, http://www.oxforddictionaries.com/us/definition/american_english/dumb-blonde (last visited Oct. 16, 2015). Moreover, the Online Slang Dictionary defines “blonde” as “dumb or stupid . . . [u]sed on anyone who acts stupid or to describe yourself when you do something stupid.” *Blonde*, OnlineSlangDictionary, <http://onlineslangdictionary.com/meaning-definition-of/blonde> (last visited Oct. 16, 2015). Nevertheless, as in *Squaw Valley*, the fact that a term may be defined in a disparaging manner does not end the analysis under the Harjo Test. Rather, a term may take on a secondary, non-disparaging meaning when viewed in light of the goods and services in the application for registration. *See Squaw Valley*, 80 U.S.P.Q.2d at 1279.

Therefore, in the context of this case, the mark DUMB BLONDE is being used to redefine the term into one of empowerment for women. As stated in Ms. Luhv’s application for registration, she is seeking to register the mark for use in both entertainment and clothing in connection with her profession as a vocalist who raises awareness of issues faced by women in today’s society. *Luhv*, 1337 F.3d at 455–56. Therefore, like SQUAW, DUMB BLONDE may initially appear to have only one meaning; however, when analyzed in conjunction with entertainment services and clothing designed specifically to address gender discrimination and gender stereotypes, the mark takes on a more expansive and ironic, yet positive meaning.

Lastly, the manner in which DUMB BLONDE is used in the marketplace further supports the notion that the mark's likely meaning is positive rather than disparaging. As in *Geller*, analyzing the applicant's website provides useful information in discerning the likely meaning of the mark in this case. *Geller*, 751 F.3d at 1359–60. Like *Tam*'s stereotypical portrayal of Asian imagery on its website, the TTAB similarly referenced pictures from Ms. Luhv's website depicting a blonde woman eating plastic fruit and applying Wite-Out to text displayed on her computer monitor. *See Luhv*, 1337 F.3d at 456–57. However, this evidence simply illustrates that Ms. Luhv is attempting to use humor to show the absurdity of the stereotype of a dumb blonde. *See id.* Unlike *Tam*, Ms. Luhv is not using the term disparagingly. *See id.* Additionally, the TTAB failed to address other pictures on applicant's website which featured a blonde woman as President of the United States. *Id.* at 458.

Furthermore, Ms. Luhv's fans and anonymous social media users posted overwhelmingly positive comments about her use of the mark to raise awareness of all women's challenges in society. *See id.* at 458. Therefore, regardless of the dictionary definitions, the use of DUMB BLONDE in this context illustrates that it is a term of irony. Nevertheless, the ultimate legal inquiry is not whether the mark is a pejorative term, but whether the mark may be disparaging to the referenced group; in this case, women with blonde hair. *See Harjo II*, 50 U.S.P.Q.2d at 1747.

B. Ms. Luhv provided sufficient evidence to support the conclusion that a substantial composite of women do not find DUMB BLONDE disparaging in connection with her music.

If the PTO determines, under the first prong of the Harjo Test, that the likely meaning refers to identifiable persons, institutions, beliefs, or national symbols, then the second prong of the Harjo test is implicated, and the PTO must then determine whether that meaning is disparaging to a substantial composite of the referenced group in the context of contemporary attitudes and in conjunction with the goods and services. *Geller*, 751 F.3d at 1358. Whether a mark is disparaging turns on the facts of the particular case. *Id.* Generally, under the disparagement analysis, proposed marks fall within of the three categories: “(1) an innocuous term that in the context of the goods or services is disparaging . . . (2) a disparaging term that may have a non-disparaging meaning in a specific context . . . [or] (3) a term that is disparaging, regardless of the applicant’s goods or services. *In re Matthew Beck*, 114 U.S.P.Q.2d 1048, 1052 (T.T.A.B. 2015).

In order to deny registration of a mark, the PTO must determine, on the examining attorney’s gathered evidence, that a substantial composite of the referenced group would find the mark disparaging. *Geller*, 751 F.3d at 1358. Even if the panel members *personally* find the mark disparaging, their analysis “must derive from the perspective of the substantial composite.” *Mavety*, 33 F.3d at 1371. What constitutes a “substantial composite” has yet to be conclusively demarcated in terms of a fixed number or percentage; however, the TTAB has clarified that a substantial composite is not necessarily a majority. *See Heeb*, 2008 WL 5065114, at

*5. In *Blackhorse v. Pro-Football, Inc.*, the examining attorney relied on a statement from the National Congress of American Indians, which comprised approximately 30% of the American Indian population, to find that a substantial composite of Native Americans found the Redskins Professional Football team name disparaging. *Blackhorse v. Pro-Football Inc.*, 111 U.S.P.Q.2d 1080, 1111 (T.T.A.B. 2014). The TTAB stated, “Thirty percent is without a doubt a substantial composite.” *Id.* However, such representative evidence of the referenced group’s viewpoint is hard to come across unless, like the Redskins cases, media attention has prompted a nationwide response from the referenced group. *See id.*

Therefore, a substantial composite is typically delineated in less defined terms. In *Heeb*, there was a sharp generational divide over whether the mark HEEB was disparaging to a substantial composite of the Jewish population. *Heeb*, 2008 WL 5065114, at *6. The applicant, and members of the younger generation, sought to use the term in order to reclaim the traditional negative stereotype; however, the TTAB found that the older generations still found the term derogative. *Id.* at *7. Because the older generations still viewed the term as disparaging, the board found that it was likely disparaging to a substantial composite of the referenced group; namely, older generations. *Id.*

Whether a mark is disparaging must also be determined in the context of contemporary attitudes. *See, e.g., Beck*, 114 U.S.P.Q.2d at 1052. This analysis necessarily takes into account the progressive views of the referenced group in modern society. *Mavety*, 33 F.3d at 1371 (“[W]e must be mindful of ever-changing

social attitudes and sensitivities.”). Therefore, a term that has been historically disparaging may not be disparaging at the time the applicant seeks registration due to changing social perceptions. *See id.* Such progressive societal views have given rise to a number of recent cases in which an applicant seeks to register a mark containing a historically disparaging term in order to “reclaim” a particular stereotype. *See Tam*, 785 F.3d at 568; *see also Heeb*, 2008 WL 5065114, at *8;

Nevertheless, such applicants have been largely unsuccessful in registering the marks if it is readily ascertainable that a substantial composite of the referenced group still finds the mark disparaging, *See Heeb*, 2008 WL 5064114, at *7, or if the mark, regardless of context, retains its disparaging meaning. *See Tam*, 785 F.3d at 568. In *Heeb*, the TTAB denied HEEB for registration despite the applicant’s stated intention to “transvalue the term from an epithet into a term of Jewish empowerment.” *Heeb*, 2008 WL 5065114, at *3. The examining attorney cited readily available evidence of the generational divide on the disparaging nature of the term and the TTAB affirmed refusal on this finding. *Id.* at *6.

In the absence of a readily discernable substantial composite, the TTAB may also affirm refusal when a term is so disparaging regardless of the context. *See Tam*, 785 F.3d at 568; *see also Beck*, 114 U.S.P.Q.2d at 1052. In *Tam*, the applicant sought to register THE SLANTS in order to “take on these stereotypes that people have about [Asians], like the slanted eyes, and own them.” *Tam*, 785 F.3d at 570. The TTAB affirmed refusal because there was ample evidence that Asians were still offended by the term despite the applicant’s stated purpose. *See id.* at 569. Most

notably, the evidence illustrated that the applicant was scheduled to give a speech at the Asian American Youth Leadership Conference, but his speech was cancelled due to some attendees' perception that the mark, the applicant's band name, was offensive and racist. *Id.* at 571.

Lastly, the examining attorney may reference previously registered marks to decide whether a mark is disparaging, although the existence of similar registered marks is not binding. *Boulevard*, 334 F.3d at 1343. “[W]hether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases.” *Id.* Nevertheless, such prior registered marks are still useful in discerning what the referenced group may find disparaging. *See id.* For example, in *In re San Francisco Women's Motorcycle Contingent*, the applicant was able to successfully appeal the TTAB's refusal, and ultimately secured registration, of DYKES ON BIKES by presenting evidence of prior similar marks that were offensive to homosexuals, yet still passed for registration. *See generally* Applicant's Request to Remand for Additional Evidence, *In re San Francisco Women's Motorcycle Contingent Appeal*, Serial No. 78281747 (T.T.A.B. Sept. 15, 2005) (approving the mark DYKES ON BIKES, Registration No. 3323803).

In this case, the TTAB failed to put forth substantial evidence that a substantial composite of women find the mark DUMB BLONDE disparaging. The Federal Circuit relied almost exclusively on a single treatise, *The Handbook of*

Gender, Sex, and Media, in holding that “significant evidence suggests that women view ‘dumb blonde’ jokes negatively.” *Luhv*, 1337 F.3d at 457. However, contrary to the TTAB’s interpretation, this book is dedicated to finding ways to overcome gender stereotypes KAREN ROSS, *THE HANDBOOK OF GENDER, SEX, AND MEDIA*, at xxi (2011). Furthermore, unlike *Blackhorse*, in which the court relied on a statement from the most representative organization of Native Americans, this isolated source is not so representative of the female population to conclusively determine that a substantial composite of women find DUMB BLONDE disparaging. *See Blackhorse*, 111 U.S.P.Q.2d at 1111.

The TTAB’s reliance on sporadic “dictionary definitions, numerous articles, and user comments” is similarly insufficient to meet its burden of showing that a substantial composite of the referenced group finds the mark disparaging. Unlike the older generation in *Heeb*, where the group was very outspoken about their feelings on the disparaging nature of the term, there is no readily apparent subset of women in this case that are as outwardly opposed to Ms. Luhv’s use of the mark. *See Luhv*, 1337 F.3d at 458. Rather, the evidence indicates that women of all ages and hair types support DUMB BLONDE. *Id.* Therefore, the PTO did not meet its burden of establishing that a substantial composite of women felt disparaged by the mark.

However, even if this Court finds that the TTAB’s conclusion was sufficiently supported by substantial evidence, as to establish a presumptive case of disparagement, Ms. Luhv’s evidence to the contrary sufficiently rebuts that

presumption. Under the *Beck* framework, DUMB BLONDE falls within the second category; namely, it constitutes a potentially disparaging term that has a non-disparaging meaning in a particular context. *Beck*, 114 U.S.P.Q.2d at 1052. Within the context of Ms. Luhv’s goods and services—music and clothing supporting a solo performer and entertainer whose lyrics are designed to empower women and cast light on gender discrimination issues—a substantial composite of women do not find the mark disparaging. *See Luhv*. 1337 F.3d at 455. Rather, those women who are familiar with Ms. Luhv’s music are overwhelmingly supportive of her cause. *See id.* at 457–58. These women “infer a different, more positive meaning for the mark.” *Id.* at 457. Furthermore, Ms. Luhv currently has over 40,000 followers on her online Soundpuff account and over 100,000 subscribers on her uTube channel. *Id.* at 456. Therefore, Ms. Luhv has sufficiently illustrated that regardless of the PTO’s initial determination on potential disparagement, her evidence overwhelming supports the notion that a substantial composite of women do not find the mark disparaging in this particular context. *Id.* at 457.

Additionally, there is no indication that women would perceive this term disparaging in light of contemporary attitudes towards “reclaiming” a feminine stereotype. This case is factually distinguishable from both *Heeb* and *Tam*, which warrants a different outcome in this case. The applicants in *Heeb* and *Tam* sought to register a stereotypical, disparaging word in conjunction with clothing and musical entertainment that were unaffiliated with the meaning of the mark. *See Tam*, 785 F.3d at 570; *see also Heeb*, 2008 WL 5065114, at *3; Conversely, Ms.

Luhv's music itself is dedicated to shedding positive light on women. *In re Luhv*, 1337 F.3d at 457. In this way, she is not using the appeal from a controversial name to support an unrelated endeavor. *See id.* at 458.

Additionally, as discussed previously, the exceptions pronounced in *Heeb* and *Tam*—clear indicia of a substantial composite and evidence of extreme disparagement—are not implicated here. Unlike *Heeb*, where there was clear evidence that the older generations found the mark disparaging, there is no readily discernable group of blonde women that clearly find DUMB BLONDE disparaging. *See id.* at 457. Rather, women of all ages and hair colors support Ms. Luhv's music. *Id.* Lastly, DUMB BLONDE is not as overtly disparaging as THE SLANTS. Rather, unlike *Tam*, where the applicant's followers denounced the use of the mark even in conjunction with the applicant's band to reclaim the stereotype, the followers in this case overwhelmingly support Ms. Luhv's initiative to do the same. *Id.* at 457–58.

Finally, prior registered trademarks illustrate that other disparaging trademarks referencing women have already been passed for registration. These marks include: HUSTLER'S YOUNG SLUTS, Registration No. 2785841, for use in adult entertainment; CHEAP SLUT, Registration No. 2891787, for candles; WHORE, Registration No. 2958436, for women's' cosmetics; and both PSYCHOBITCH, Registration No. 2205038, and EVIL PUSSY, Registration No. 2672107, for clothing. *See Applicant's Request to Remand for Additional Evidence, In re San Francisco Women's Motorcycle Contingent*, Serial No. 78281747 (T.T.A.B. Sept. 15, 2005). All of these phrases were registered despite dictionary definitions

indicating that words therein were derogatory to women. Like DYKES ON BIKES, the TTAB should have passed DUMB BLONDE for registration because even more disparaging marks have already been registered. Although such determinations are not binding, this illustrates that the PTO was using an impermissible and arbitrary standard for approving registrations.

C. The TTAB should have passed DUMB BLONDE for registration because any doubt regarding the disparaging nature of a mark should be resolved in the applicant's favor.

All doubt regarding whether a mark comprises disparaging matter under § 2(a) should be resolved in favor of the applicant. *See, e.g., Mavety*, 33 F.3d at 1374. “The frequent manner of disposition is resolution in favor of the applicant on the theory that any person believed damaged by the registration would have the opportunity to oppose registration and present evidence” in an opposition proceeding. *See id.*

An opposition board is inherently distinct from the TTAB. *See About the Trademark Trial and Appeal Board*, UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/trademark/laws-regulations/trademark-trial-and-appeal-board> (last visited Oct. 19, 2015). An appeal before the TTAB is determined by an a three-judge panel conducting an independent record review, while an opposition provides interested parties a chance to oppose the trademark application in an adversarial manner. *See id.* In an opposition proceeding, the panel issues a decision only after both sides have had an opportunity to present their evidence and make arguments in legal briefs before the Board. *Id.*

An opposition proceeding is also preferred because, as previously recognized, the PTO is an “agency of limited resources,” and as such, it is inherently hampered by time and resource constraints in its determination that a particular mark is disparaging to a substantial composite of the referenced group. *Squaw Valley*, 80 U.S.P.Q.2d at 1271. Furthermore, passing a mark for publication in favor of the applicant furthers the well-established legal truism for standing that resolution of legal issues are better addressed through adversarial proceedings. *See Ritchie v. Simpson*, 170 F.3d 1092, 1094 (Fed. Cir. 1999).

Therefore, in this case, the TTAB and later, the Federal Circuit, should have passed DUMB BLONDE for registration. Given the considerable doubt over whether a substantial composite of women would find the term disparaging, and given the relatively small amount of representative evidence of women’s views on the issue from the record, the TTAB erred in refusing to resolve doubt in Ms. Luhv’s favor. An opposition board would rectify the concerns regarding the PTO’s limited resources and provide women who feel disparaged by the mark an opportunity to challenge registration.

II. Section 2(a) of the Lanham Act violates Ms. Luhv’s right to free speech and expression guaranteed by the First Amendment.

In order to successfully claim that a plaintiff’s First Amendment rights were violated in connection with a restriction placed on speech, a plaintiff must prove three things. *Tam*, 785 F.3d at 574 (Moore, J., additional views). The plaintiff must first show that the speech in question is protected speech. *Roth v. United States*, 354 U.S. 476, 481 (1957). Next, the plaintiff must prove that the government has

restricted that speech in a manner that implicates the First Amendment. *Texas v. Johnson*, 491 U.S. 397, 405 (1989). Finally, the plaintiff must prove that the restriction is unconstitutional when analyzed under the appropriate framework. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*, 447 U.S. 557, 566 (1980).

This Court should uphold the Federal Circuit’s decision because Ms. Luhv’s speech falls under the protected category of commercial speech, and § 2(a) of the Lanham Act unconstitutionally denies her benefits based on the content of her protected speech.

A. The trademark DUMB BLONDE falls under the protected category of commercial speech because it identifies the source of commercial goods, which aids consumers in making purchasing decisions.

The Supreme Court first held that the First Amendment protects commercial speech in 1975. *Bigelow v. Virginia*, 421 U.S. 809, 818 (1975). Commercial speech is defined as the “dissemination of information as to who is producing and selling what product, for what reason, and for what price.” *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council, Inc.*, 425 U.S. 748, 765 (1975).

For example, in *Friedman v. Rogers*, the appellant challenged the state optometry board’s regulation barring the use of “an assumed name, trade name, or corporate name” in association with the practice of optometry. *Friedman v. Rogers*, 440 U.S. 1, 5 (1979). The Court held that a trade name may convey information regarding the type, price, and quality of service offered, and that “[t]he use of trade names in connection with optometrical practice, then, is a form of commercial speech....” *Id.* at 11. It is not necessary for commercial speech to “editorialize on any

subject, cultural, philosophical, or political,” and it need not “report any particularly newsworthy fact, or...make generalized observations even about commercial matters.” *Id.*

Similarly, in *Bolger v. Youngs Drug Prods. Corp.*, the Court found unsolicited advertisements sent through the mail to be commercial speech even though they did more than simply propose a commercial transaction. *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 67 (1983). The advertisements in question “contain[ed] discussions of important public issues such as venereal disease and family planning.” *Id.* at 67-68. The fact that commercial speech links a product to a current public debate does not bring it into the realm of noncommercial speech. *Id.* at 68.

Like the optometrist in *Friedman*, Ms. Luhv’s use of the trade name DUMB BLONDE in connection with her band and associated merchandise is a form of commercial speech. *See Friedman*, 440 U.S. at 5. Trademarks distinguish brands from others in the marketplace, and reduce the cost of shopping and making purchasing decisions for consumers. *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159, 163-64 (1995). The mark DUMB BLONDE serves to identify the source of the music, which, in turn, will lead interested consumers to find outlets where the music can be purchased. *See Va. State Bd. of Pharmacy*, 426 U.S. at 765.

Similar to the contraceptive advertisements in *Bolger*, Ms. Luhv’s trademark invokes the discussion of important public issues; mainly, the way women are viewed and treated in today’s society. *Luhv*, 1337 F.2d at 458. The Federal Circuit found that there are disparate views on how women perceived the mark DUMB

BLONDE. *Id.* Some women view the mark as offensive, while many other women “view the mark as positive, such as the hundreds of thousands of female fans that have attended her concerts and the positive reception of photographic images on her website....” *Id.* This Court has previously stated “that a principal ‘function of free speech under our system of government is to invite dispute. It may indeed best serve its high purpose when it induces a condition of unrest, creates dissatisfaction with conditions as they are, or even stirs people to anger.’” *Johnson*, 491 U.S. at 408-09 (quoting *Terminiello v. Chicago*, 337 U.S. 1, 4 (1949)). In choosing the mark DUMB BLONDE, Ms. Luhv is inviting dispute and challenging the status quo as to how women are viewed and treated. *See Luhv*, 1337 F.3d at 458. In other words, she is hoping to create dissatisfaction with conditions as they are, one of the principal functions of free speech. *See Johnson*, 491 U.S. at 408-09. However, just because the name DUMB BLONDE may inherently invoke public discussion, it still falls under the category of commercial speech because it primarily proposes a commercial transaction—it identifies the source of her music, which allows consumers to locate and purchase her songs, albums, merchandise, and concert tickets.

B. The disparagement provision of § 2(a) of the Lanham Act is unconstitutional on its face because it abridges trademark holders’ right to free speech under the First Amendment.

The First Amendment serves to prevent the government from placing restrictions on speech or expressive conduct because it disapproves of the message. *R.A.V. v. City of St. Paul*, 505 U.S. 337, 382 (1992) (citing *Cantwell v. Connecticut*, 310 U.S. 296, 309-11 (1940); *Johnson*, 491 U.S. 397, 406 (1989)). “Content-based

regulations are presumptively invalid.” *Id.* However, there are a few limited categories of speech that are not protected by the First Amendment; namely, obscenity, fighting words, and defamation. *Id.* The First Amendment does not protect these types of speech because they are “of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality.” *Chaplinski v. New Hampshire*, 315 U.S. 568, 572 (1942).

However, the Lanham Act allows the PTO to refuse to register trademarks if they find them immoral, scandalous, or disparaging. 15 U.S.C. § 1052(a). For the past thirty-four years, courts have held that the Lanham Act does not implicate the First Amendment because it does not prevent the mark holder from using the mark; it only prevents them from registering it. *In re McGinley*, 660 F.2d 481, 484 (1981). The *McGinley* Court noted, however, that § 2(a) does deny the applicant access to “benefits provided by the Lanham Act which enhance the value of the mark.” *Id.* at 486 n.12. Once a trademark is registered, “[t]he Lanham Act confers ‘important legal rights and benefits’ on trademark owners....” *B & B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S. Ct. 1293, 1300 (2015).

For example, registration serves as “constructive notice of the registrant’s claim of ownership” of the mark. 15 U.S.C. § 1072. A registered mark is also presumed to be valid, and the validity of the mark’s ownership becomes incontestable after five years of use. 15 U.S.C. §§ 1057(b), 1065, 1115(b). Owners of registered marks may also enlist the services of the U.S. Customs and Border

Protection to restrict the importation of goods that may infringe upon or counterfeit the mark. 15 U.S.C. § 1125(d). Owners may sue in federal courts to enforce their trademarks, even when diversity jurisdiction does not exist. 15 U.S.C. § 1121. If the owner proves that her mark was willfully infringed, she is entitled to treble damages. 15 U.S.C. § 1117. Under § 2(a) of the Lanham Act, all of these benefits are denied to certain applicants based solely on their mark’s expressive conduct. *See* 15 U.S.C. § 1152(a).

Under the “unconstitutional conditions” doctrine, however, 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. Sinderman*, 408 U.S. 593, 597 (1972). Although a person has no right to valuable government benefits, this doctrine prevents the government from refusing access to those benefits on the basis of constitutionally protected speech because it would essentially penalize and inhibit the speaker. *Id.*

For example, in *Perry*, the respondent, Robert Sinderman, was a teacher in the Texas state college system. *Id.* at 594. During his time at Odessa Junior College, he was elected president of the Texas Junior College Teachers Association. *Id.* As president, he was called away from his teaching duties on several occasions to testify before the Texas Legislature, and he publicly disagreed with the college’s Board of Regents. *Id.* at 594-95. He associated with a group advocating change opposed by the Regents, and his name appeared under a newspaper advertisement that was very critical of the Board of Regents. *Id.* at 595. At the end of his one-year

contract, Sinderman was not rehired, and the Board of Regents “issued a press release setting forth allegations of [Sinderman’s] insubordination.” *Id.* Because the district court initially granted summary judgment in favor of Perry, there was not enough evidence on the record for the Court to make a definitive ruling as to whether Sinderman’s rights had been violated in that case. *Id.* at 598. However, the Court held more generally that even though Sinderman had no right to re-employment, the Board of Regents could not deny him the benefit of re-employment based on speech protected by the First Amendment. *Id.* at 597.

Like the respondent in *Perry*, Ms. Luhv has been denied substantial government benefits associated with trademark registration based on the content of her speech. *Luhv*, 1337 F.3d at 459-60. Because the mark DUMB BLONDE is a form of constitutionally protected speech, the government may not deny Ms. Luhv the benefits of registration simply because they find her mark disparaging. *See Perry*, 408 U.S. at 597. This is unquestionably a purely content-based determination, which is impermissible. *See Johnson*, 491 U.S. at 406 (“Content-based regulations are presumptively invalid.”). Freedom of speech should be protected against punishment, unless there is evidence that it is likely to produce a clear and present danger that will do more than cause public annoyance, inconvenience, or unrest. *Terminiello*, 337 U.S. at 4. “There is no room under our Constitution for a more restrictive view. For the alternative would lead to standardization of ideas either by legislatures, courts, or dominant political or community groups.” *Id.* at 4-5. There is no showing that Ms. Luhv’s mark is likely to

create a clear and present danger, only some evidence that some people find it offensive. *Luhv*, 1337 F.3d at 458. By passing § 2(a) of the Lanham Act, Congress is attempting to legislatively standardize what the public is exposed to; something this Court has said the Constitution simply cannot allow. *See Terminiello*, 337 U.S. at 4-5.

C. The restriction on trademarks based on their content is unconstitutional when analyzed under the *Central Hudson* Test.

The Supreme Court has established a four-part test for determining whether commercial speech has been unconstitutionally restricted under the First Amendment. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 566. The first part of the test requires a determination as to whether the speech in question is protected by the First Amendment. *Id.* In order to fall under the protection of the First Amendment, commercial speech cannot concern unlawful activity or mislead the public. *Id.* The second part of the test requires the Court to determine whether that asserted government interest is substantial. *Id.* If the answers to the first two parts of the test are “yes,” the Court must next determine “whether the regulation directly advances the governmental interest asserted, and whether it is more extensive than necessary to serve that interest.” *Id.* In most cases, the third and fourth prongs of the test are folded into one discussion. *See Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983). Because the mark DUMB BLONDE neither promotes illegal activity, nor misleads the public as to the source of the music, the Court must determine whether the government interest in restricting access to benefits based on the content of the mark is substantial. *Id.*

1. The government has not put forth any substantial interest that would justify violating Ms. Luvv's First Amendment rights.

According to J. Thomas McCarthy, trademark law serves three distinct purposes: (1) to protect the public from deception in the marketplace; (2) to protect the trademark owner from having the fruits of her labor misappropriated; and (3) to encourage competition from which the public benefits. *McCarthy on Trademarks and Unfair Competition* § 2.1 (4th ed.). In this case, the government has not set forth any interest advancing any of the established purposes of trademark law that would justify restricting constitutionally protected speech.

In *McGinley*, the seminal case from which all previous rejections of trademarks under the Lanham Act flow, the court stated that, in passing the act, “Congress expressed its will that such marks not be afforded the statutory benefits of registration,” and that it was not “an attempt to legislate morality, but, rather, a judgment by Congress that such marks not occupy the time, services, and use of funds of the federal government.” *McGinley*, 660 F.2d at 486. However, this interest is antiquated because the federal treasury no longer funds the trademark registration process; instead, it is funded through trademark owners’ registration fees. *Figueroa v. United States*, 466 F.3d 1023, 1028 (Fed. Cir. 2006).

In addition to the justification set forth in *McGinley*, the government also argues “that it has an interest in discouraging the use of marks that may be offensive.” *Luvv*, 1337 F.3d at 460. While this interest is admirable, the Supreme Court has stated that offensiveness of speech does not justify its suppression. *Bolger*, 463 U.S. at 71. Even in the context of commercial speech, the Supreme

Court has rejected the notion that protecting the public from offensive speech is a sufficient interest to justify government restriction. *Id.*

Lastly, the government may also have an interest in refusing to register disparaging trademarks because it does not want to give the impression that it endorses or approves of the mark. *Luhv*, 1337 F.3d at 461 (McCartny, J., dissenting). However, in *In re Old Glory Condom Corp.*, the PTO stated that “[j]ust as the issuance of a trademark registration by this Office does not amount to a government endorsement on the quality of the goods to which the mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a “good” one in an aesthetic, or any analogous, sense.” *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219-20 n.3. Additionally, the primary function of a trademark is to identify the source of the goods or services to consumers. *Qualitex*, 514 U.S. at 162. Because the government has previously stated that registration of a mark does not constitute its approval, and trademarks serve to identify their source, it is highly unlikely that people will perceive registration as a stamp of approval rather than simply providing notice of claimed trademarks. None of these interests asserted by the government further any of the traditional purposes of trademark law, and fail to stand on their own reasoning.

2. Refusing to register DUMB BLONDE is unnecessarily restrictive and does not directly advance the government’s interest in using funds, protecting the public from offensive marks, or giving the impression that the government endorses the marks.

The final two prongs of the *Central Hudson* test require the Court to determine whether the government’s restriction on commercial speech directly

advances its interest in a manner that is no more extensive than necessary. *Cent. Hudson*, 447 U.S. at 566. For example, in *Bolger*, Youngs Drug Products Corporation sent unsolicited advertisements in the mail promoting the sale of contraceptives. *Bolger*, 463 U.S. at 62. Although the Court found the government's interest in protecting consumers from offensive materials to be insubstantial, the Court found the second asserted interest—"aiding parents' efforts to discuss birth control with their children"—to be substantial. *Id.* at 73. However, the Court found that the law completely banning the mailing of the advertisements was unnecessarily extensive and was ineffective in promoting that interest. *Id.* The "ban on unsolicited advertisements serves only to assist those parents who desire to keep their children from confronting such mailing, who are otherwise unable to do so, and whose children have remained relatively free from such stimuli." *Id.*

As discussed earlier, the trademark registration process is no longer funded by taxpayer dollars, but is instead funded by prospective markholders' application fees. *Figueroa*, 466 F.3d at 1028. The government does provide PTO employees benefits, including health insurance and life insurance. *Id.* However, the expenses dedicated to providing those employee benefits will exist whether or not disparaging marks are registered. Arguably, the government spends more money defending the rejection of marks than it would registering them, especially now that registration is funded by applicants' fees. *McGinley*, 660 F.2d at 478 (Rich, J., dissenting). Just as it is more expensive to defend rejecting a mark, it also occupies more governmental time and services. Government attorneys must spend time defending

the rejection that could otherwise be dedicated elsewhere, and judges must preside over the hearings.

Even if this Court diverts from previous holdings, and finds that protecting the public from offensive marks is a substantial interest on which the government can restrict speech, refusing to register disparaging marks is not an effective means of protecting the public from offensive marks. As the *McGinley* Court noted, rejecting a mark for federal registration does not prevent it from being used. *McGinley*, 660 F.2d at 484. Because marks can still be used even though they are not registered with the federal government, refusing to register disparaging marks is an ineffective means for protecting the public from them.

With respect to the government's interest in not wanting to appear as though it endorses disparaging marks, the TTAB has previously stated that registration of marks does not constitute government endorsement. *Old Glory Condom Corp.*, 26 U.S.P.Q.2d at 1219-20 n.3. It is counterintuitive to state that registration of trademarks does not constitute government endorsement, then to argue that the government does not wish to give the impression that it endorses disparaging trademarks by registering them. Additionally, in order for the government's interest in not appearing to endorse disparaging trademarks to be feasible, citizens must understand the process of trademark registration. Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of Redskins?*, 52 *Stan. L. Rev.* 665, 684 (2000). There is not any substantial evidence that suggests that the average citizen understands the regulatory scheme. *Id.* Most citizens encounter trademarks as consumers, not as

beneficiaries of registering trademarks. *Id.* “[T]he only way trademark registration is likely to be seen as government endorsement is if certain trademarks are denied registration on the basis of their content.” *Id.* The public would be less likely to perceive registration as government endorsement if the government unconditionally registered trademarks without reference to their offensive content. *Id.*

CONCLUSION

For the foregoing reasons, Respondent respectfully requests that this Court reverse the decision of the Federal Circuit in regards to the registration of the mark DUMB BLONDE and affirm the decision rejecting § 2(a) of the Lanham Act as unconstitutional.

Respectfully Submitted,

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