

Case No. 15 – 1007

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

ϕ

UNITED STATES PATENT AND TRADEMARK OFFICE, et al.,

Petitioners,

v.

KOURTNEY MS. LUHV, et al.,

Respondent.

ϕ

On Writ Of Certiorari From The
United States Court Of Appeals
For The Federal Circuit

ϕ

BRIEF OF RESPONDENT

ϕ

LAW OFFICES OF
MOOT & MOOT, P.C.

101 Argument Drive, Suite 100, HotBench, California 95630

Counsel of Record

Counsel for Respondent

QUESTIONS PRESENTED

1. Did the Trademark Trial and Appeal Board err in denying the registration of the trademark DUMB BLONDE on the grounds that it was disparaging under §2(a) of the Lanham Act, when it did not use the views of a substantial composite of blonde women, did not consider re-appropriation, and did not consider the underlying content of the mark because it was seemingly disparaging?
2. Does the prohibition set forth in § 2(a) against marks which may be disparaging, violate the First Amendment of the United States Constitution, when it discriminates against constitutionally protected speech based on its content, conditions the benefit of federal trademark registration on that discrimination, grants the PTO unbridled discretion to deny or approve trademarks, fails to provide adequate procedures to ensure against erroneous deprivations, and fails to put reasonably prudent trademark filers on notice of what marks may be considered disparaging?

TABLE OF CONTENTS

Questions Presented	i
Table of contents	ii
Table of Authorities	iv
Jurisdiction.....	viii
Constitutional Provisions	viii
Statement of the Case	1
Summary of the Argument	3
Argument	6
I. THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT ERRED IN FINDING THAT THE TRADEMARK DUMB BLONDE IS DISPARAGING UNDER § 2(a) OF THE LANHAM ACT BECAUSE THE EVIDENCE SUGGESTS THAT IT DOES NOT DISPARAGE A SUBSTANTIAL COMPOSITE OF BLONDE WOMEN.....	6
A. <u>The word “disparagement” as used within §2(a) of the Lanham Act, refers to groups of persons or institutions and not an individual such as Ms. Luhv.....</u>	8
B. <u>DUMB BLONDE, does not disparage a substantial composite of the referenced group.....</u>	13
C. <u>Reappropriation should be considered before determining whether a mark “disparaging” when the mark is used toward seemingly self- disparaging trademarks”.....</u>	17
II. THE LOWER COURT WAS CORRECT IN FINDING THAT SECTION 2(a) VIOLATED THE FIRST AMENDMENT BECAUSE IT IMPOSES A DISCRIMINATORY BASED BURDEN ON CONSTITUTIONALLY PROTECETD SPEECH.....	19

A. The lower court correctly held that “DUMB BLONDE” is protected speech under the First Amendment because it proposes a commercial transaction, but it also does more....20

B. The Government Speech Doctrine is inapplicable because the PTO has minimal editorial control over any of the trademarks it publishes, the identity of _____ the literal speaker is clearly identified, the speaker bears the ultimate burden of the mark, and the section 2(a) is inconsistent with legislatures’ purpose in enacting the Lanham Act.....22

C. Section 2(a) of the Lanham Act fails under the “Central Hudson Test” because “DUMB BLONDE” is protected speech, the Government has not met its burden in demonstrating a substantial interest in burdening this speech or how § 2(a) would advance that interest, and § 2(a) is more extensive than necessary to achieve any speculative interest.....25

D. Even if this court finds that Section 2(a) surmounts the intermediate level of scrutiny applied under the Central Hudson Test, it must fall regardless, because it places a content-based burden on protected speech.....28

E. The disparagement prohibition mandated by Section 2(a) cannot surmount the strict level of scrutiny applied to content based regulations nor cannot it surmount the intermediate level of scrutiny applied to content-neutral regulations because it is substantially overbroad, and places a prior restraint on speech due to its overbreadth.....34

TABLE OF AUTHORITIES

<i>Ada v. Guam Society of Obstetricians & Gynecologists</i> , 506 U.S. 1011, 1012.....	39
<i>American Civil Liberties Union of North Carolina v. Tata</i> , 742 F.3d 563, (4th Cir. 2014).....	23,24,37
<i>City of Houston</i> , 482 U.S. 451, 458–59 (1987).....	36
<i>In Board of Regents of University of Wisconsin System v. Southworth</i> 529 U.S. 217 (2000).....	33
<i>Bolger v. Young Drug Products Corp.</i> , 463 U.S. 60 (1983).....	20
<i>Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n of N.Y.</i> , 447 U.S. 557 (1980).....	19,25
<i>City of Cincinnati v. Discovery Network, Inc.</i> , 507 U.S. 410 (U.S. 1993).....	27,28
<i>City of Lakewood v. Plain Dealer Pub. Co.</i> , 486 U.S. 750 (U.S. Ohio, 1988).	
<i>Dex Media West, Inc. v. City of Seattle</i> , 793 F. Supp. 2d 1213, 1222 (W.D. Wash., 2011).....	21
<i>Doughboy Industries, Inc. v. Reese Chemical Co.</i> , 88 U.S.P.Q. (BNA) 227 (P.T.O. 1951).....	9
<i>Figueroa v. U.S.</i> , 466 F.3d 1023 (Fed. Cir. 2006).....	32
<i>Forsyth Cnty. v. Nationalist Movement</i> , 505 U.S. 123 (1992).....	31
<i>Friedman v. Rogers</i> , 440 U.S. 9 - 10 (1979).....	19
<i>Gooding v. Wilson</i> , 405 U.S. 518 (1972).....	36
<i>Harjo v. Pro-Football Inc.</i> , 50 U.S.P.Q. 2d (BNA) 1708 (T.T.A.B 1999).....	7,8,14
<i>Hornell Brewing Co., Inc. v. Brady</i> , 819 F. Supp. 1227, 1236 (E.D.N.Y., 1993).....	26
<i>In Condas S.A.</i> , 188 U.S.P.Q. (BNA) 544 (T.T.A.B 1975).....	6,7,8
<i>In re Geller</i> , 751 F.3d 1358 (Fed. Cir. 2014)	6,7,10,12,15

<i>In re Heeb Media, LLC</i> , 2008 TTAB Lexis 65 (T.T.A.B 2008).....	11,18
<i>In re Hines</i> , 31 U.S.P.Q. 2d 1685 (T.T.A.B 1994).....	9
<i>In re Luhv</i> , 1337 F.3d 455 (2015).....	<i>Passim</i>
<i>In re Lebanese Arak Corp.</i> 94 U.S.P.Q. 2d 1217 (T.T.A.B 2010).....	15
<i>In re Mavety Media Group. Ltd.</i> , 33 F. 3d 1373 (Fed. Cir. 1994).....	7
<i>In re McGinley</i> , 660 F.2d 481, 486 (Cust. & Pat.App., 1981).....	37
<i>In re Old Glory Condom Corp.</i> , 26 U.S.P.Q. 2d 216, 1219 n.3 (T.T.A.B. 1993).....	25
<i>In re Simon Shiao Tam</i> , 108 U.S.P.Q. 2d 1305 (T.T.A.B 2013).....	14
<i>League of Women Voters of California v. FCC</i> , 468 U.S. 364, 367 (1984).....	32
<i>National Endowment of the Arts v. Finley</i> , 524 U.S. 569 (1998).....	35
<i>New York v. Ferber</i> , 458 U.S. 747, (1982).....	25
<i>Pleasant Grove City v. Summum</i> , 555 U.S. 460 (2009).....	22
<i>Texas v. Johnson</i> , 491 U.S. 397 (1989).....	27
<i>U.S. v. Nat’l Treasury Emp. Union</i> , 513 U.S. 454 (1995).....	27,31
<i>U.S. v. Playboy Entm’t Grp., Inc.</i> , 529 U.S. 803 (2000).....	32
<i>United States v. Salerno</i> , 481 U.S. 739, 745, 107 S.Ct. 2095, 2100, 95 L.Ed.2d 697 (1987).....	35

CONSTITUTIONAL PROVISIONS

U.S. CONST. AMEND. I.....	18
---------------------------	----

STATUTES

S. REP. No. 100-515, At 2 (1988).....	24
---------------------------------------	----

Trademark Law Revision Act of 1988-Satellite Home Viewer Act of 1988 Dates of Consideration and Passage.

15 U.S.C. §1052(2)(a).....*Passim*

15 U.S.C § 1063(a).....24

Other

Jessica M. Kiser, *How Dykes on Bikes Got It Right: Procedural Inequities Inherent In The Trademark Office’s Review Of Disparaging Trademarks*, 46 u.s.f.l. rev. 7 (2011).....6,11,17

Kimberly A. Pace, *The Washington Redskins and The Doctrine of Disparagement: How Politically Correct must a Trademark be?* 22 pepp. l. rev. 28 (1994).....9

Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of slurs into Section 2(A) of the Lanham Act*, 106 Colum. L. Rev. 389 (2006).....8,12,13

JURISDICTION

The United States Court of Appeals for the Federal Circuit entered judgement on June 6, 2015. This Court granted certiorari in October of 2015. This Court has jurisdiction pursuant to 28 U.S.C.A § 1295 (a)(4)(A).

_____ ϕ _____

CONSTITUTIONAL PROVISION INVOLVED

Amendment I

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.

Amendment I

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.

_____ ϕ _____

STATEMENT OF THE CASE

On July 9, 2014, Kourtney Luhv, (“Ms. Luhv”) filed an application with the United States Patent and Trademark Office, (“PTO”) to register the mark “DUMB BLONDE.” *In Re Luhv*, 1337 F.3d 455, 457 (2015). After review, the examining attorney refused to register DUMB BLONDE on the grounds that under §2(a) of the Lanham Act, the mark was disparaging to a substantial composite of blonde women. *Id.* Ms. Luhv appealed this decision to the Trademark Trial and Appeals Board, (“TTAB” or “Board”) who affirmed the examining attorney’s refusal to register the mark. *Id.* Ms. Luhv appealed the TTAB’s decision to the United States Court of Appeals for the Federal Circuit. *Id.* at 460. The Federal Circuit reversed the decision of the TTAB, and this Court granted certiorari. *Id.* at 461.

Ms. Luhv is an esteemed musician who, since 2012, has performed under the stage name DUMB BLONDE. *Id.* at 456 (2015). The music Ms. Luhv creates under her stage name brings to the forefront various issues faced by women in today’s society. *Id.* As a result of her music and live performances in various states under this stage name, Ms. Luhv has garnered a devoted fan base who faithfully follow her music online and at shows, in which she performs. *Id.* Notably, Ms. Luhv’s account on www.SoundPuff.com (“SoundPuff”) boasts forty thousand followers (40,000), while her channel on www.uTube.com (“uTube”), which is suitably named “DumbBlondeMusic,” boasts one hundred thousand (100,000) active subscribers. *Id.*

at 457. Ms. Luhv uses the latter account to communicate with her fans and share music production related tips through video posts. *Id.*

In June 2014, Ms. Luhv recorded several pieces of music, and sought to have the pieces released through a record label. *Id.* Ms. Luhv was fortunate to secure a deal with a record label for a recording contract that would allow her to receive a two million dollar (\$2,000,000) advance upon execution of the agreement, so long as she secured federal trademark registration for her stage name, “DUMB BLONDE.” *Id.* Ms. Luhv submitted her complete application to the PTO with hopes of securing the trademark and record label advance. *Id.*

The examining attorney for the PTO refused to register the mark on the grounds that it may be disparaging to women, thus violating the prohibition against the registration of disparaging trademarks in §2(a) of the Lanham Act. *Id.* The TTAB affirmed the decision of the examining attorney on appeal. *Id.* The TTAB held that the mark “DUMB BLONDE” could be disparaging to a substantial composite of women with blonde hair color. *Id.* at 458. The United States Court of Appeals for the Federal Circuit affirmed the TTAB’s findings that the mark is disparaging, but reversed the decision of the TTAB on constitutional grounds. *Id.* at 461. This court granted certiorari to answer the following questions. First, Whether the TTAB erred in rejecting Ms. Luhv’s application. Second, whether the prohibition set out in §2(a) of the Lanham Act violates the United States Constitution.

SUMMARY OF THE ARGUMENT

The Federal Circuit Court of Appeals was incorrect in finding that the trademark DUMB BLONDE was disparaging. Instead it is a satirical name that references Ms. Luhv in connection with her music, merchandise, and live performances. Both the adjective and the noun, respectively DUMB and BLONDE, are singular and refer back to Ms. Luhv and not groups, other individuals, or institutions. Furthermore, reappropriation must be considered when a seemingly disparaging mark is in fact not disparaging to prevent an erroneous denial of perfectly legitimate trademarks. The trademark DUMB BLONDE is merely a satirical name that references back to Ms. Luhv and her belief that society casts a negative stereotype onto women with blonde hair. Her music clearly speaks to the contrary and brings to the forefront issues faced by women in society because of negative stereotyping. Additionally, Ms. Luhv uses the platform she has established through the use of this satirical name to provide educational videos on her uTube page. Reappropriation should not be discounted when a trademark contributes such added value to society. Moreover, it is evident that the trademark DUMB BLONDE does not disparage a substantial composite of Blonde women because Ms. Luhv has a substantial group of supporters (specifically Ms. Luhv has upwards of 140,000 followers on her social media platform). It would be economically unfeasible to have a trademark that is disparaging to the very group of people Ms. Luhv seeks to build a profitable career on. It is clear that Ms. Luhv is referring to herself and does not

intend to disparage any group or institutions. Therefore, the trademark DUMB BLONDE is not disparaging.

Ms. Luhv's mark should be registered because she is solely referring to herself and not others in with her name. The mark DUMB BLONDE is not disparaging to others and is self-referential in its meaning. The word disparagement as used in title 15 U.S.C §1052 for §2(a) of the Lanham Act refers to groups of persons or institutions and not to individuals. In the case at bar, Ms. Luhv uses the name in a singular noun referring only to herself and not to others.

Even under the logic the mark refers to groups of women who have blonde hair, Ms. Luhv's mark, DUMB BLONDE, does not compose of a substantial composite of the referenced group. Ms. Luhv's fans clearly understand the mark as referring to the musician's stage name and not a reference towards any group of persons. Furthermore, the TTAB has not presented substantive evidence that women find this mark disparaging.

Section 2(a) of the Lanham Act violates the First Amendment of the United States Constitution, because it mandates content-based discrimination which places a significant burden on constitutionally protected speech. The Government is not speaking when it registers a trademark because the TTAB has disclaimed that notion. The legislative history further supports that Congress acts as a regulatory body rather than an active speaker. Moreover, §2(a) violates the unconstitutional conditions doctrine by conditioning the benefit of federal trademark registration on Congress's view of acceptable speech. This prohibition is not tempered by Congress's

spending power because trademark applicant's fees cover the operating costs for the PTO. Congress must not be given the power to undermine the Constitution under the guise of the commerce and spending clauses. This dereliction of the First Amendment seeks to circumvent the precedence established by this Court and the mandates of the constitution. Moreover, Congress has failed to articulate any interest besides its desire to not have a President's name on a bottle of gin. As a result, the mandate imposed by §2(a) fails both strict and intermediate scrutiny.

Section 2(a) is substantially overbroad and imposes a prior restraint on constitutionally protected speech due to this overbreadth. The PTO neglects to provide adequate procedures to ensure an erroneous deprivation of a property interest in a trademark does not occur. Federal registered trademarks are created by the people and for the people and Congress must be prohibited from burdening speech not already prescribed unacceptable by the Constitution and jurisprudence of this court.

ARGUMENT

I. THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT ERRED IN FINDING THAT THE TRADEMARK DUMB BLONDE IS DISPARAGING UNDER SECTION 2(a) OF THE LANHAM ACT BECAUSE THE EVIDENCE SUGGESTS THAT IT DOES NOT DISPARAGE A SUBSTANTIAL COMPOSITE OF BLONDE WOMEN.

The trademark DUMB BLONDE is not “disparaging” to a substantial composite of blonde women because the mark is a satirical name referencing Luvv and not any individual group, contrary to the United States Court of Appeals for the Federal Circuit’s findings.

Section 2(a) of the Lanham Act provides in pertinent part:

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 . . . Consists of or comprises immoral, deceptive, or scandalous matter, or matter which *may* (emphasis added) disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbol, or bring them into contempt, or disrepute . . . respect to the United States.
15 U.S.C.A §1052(2)(a) (2006)

Case law has concluded that a mark is not disparaging if a dictionary definition shows multiple meanings, is self-disparaging, or is used in appropriation for groups or individuals in that group. *In Condas S.A.*, 188 U.S.P.Q. (BNA) 544, 1 (T.T.A.B 1975). (holding that someone of Japanese origin would not choose a mark that would disparage his own heritage). “Legislative history for §2(a) does not indicate the legislature’s goals for, or reasoning behind, adding this disparagement prohibition to federal trademark registration.” Jessica M. Kiser, *How Dykes on*

Bikes Got It Right: Procedural Inequities Inherent In The Trademark Office's Review Of Disparaging Trademarks, 46 u.s.f.l. l. rev. 7, 1 (2011)

The PTO has not properly utilized the term “disparaging” as was intended in §2(a) of the Lanham Act. *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) The determination that a mark may be disparaging is a conclusion of law based upon underlying factual inquiries. *Id.* The court further stated the Board’s findings are reviewed for substantial evidence, while its ultimate conclusion as to registrability is reviewed *de novo*. *Id.* Additionally, in *Geller*, the Board found the mark contained a “matter which may disparage” a group of persons in violation of §2(a) of the Lanham Act because the Board’s finding was supported by substantial evidence. *Id.* The *Geller* court used the *Harjo* test (*see Pro Football, Inc. v. Harjo*, 565 F.3d 880, 418 (Fed. Cir. 2009)), which is a two prong test for determining whether a mark “may disparage” persons or group of persons. *Geller*, 751 F.3d at 1358. The first prong determines “the likely meaning of the matter in question.” *Id.* The court considers dictionary definitions, essays posted on the Appellant’s website, and finally reader’s comments posted on Appellant’s website as “reflective of the websites messages.” *Id.* The second prong considers whether the meaning is found to refer to identifiable persons and if that meaning may be disparaging to a substantial composite of the referenced group. *Id.* In addition, the dissent in this case stated, “although limited evidence suggests that the phrase ‘dumb blonde’ is offensive to some women, this court has previously refrained from upholding the PTO’s refusal to register a mark when the issue of the extent to which a mark is

viewed as offensive was unclear. *In re Luhv*, 1337 F.3d 455, 460 (Fed. Cir. 2015) See also, *In re Mavety Media Group, Ltd.*, 33 F.3d 1367, 1373 (Fed. Cir. 1994) 1337 F.3d 455.

- A. The word “disparagement” as used within Section 2(a) of the Lanham Act, refers to groups of persons or institutions and not an individual such as Ms. Luhv.

The mark DUMB BLONDE is not disparaging under section 2(a) of the Lanham Act because Ms. Luhv uses the mark in a singular noun referring only to herself and not others. Section 2(a) makes a reference to persons or groups and not an individual. A mark cannot be disparaging or derogatory if the person using the name is referring to herself. *In re Condas S.A.*, 188 U.S.P.Q. (BNA) at 1. (The court reasoned that it would be inconceivable that someone of Japanese origin would choose a mark that would disparage his own heritage and therefore was self-disparagement and was permissible). Here, Ms. Luhv has blonde hair and refers to herself as DUMB BLONDE, which is self-disparaging in its meaning. Similar to *In re Condas*, Ms. Luhv’s self-disparagement should be permissible because she is not referring to any persons or group. Demonstrating that a permissible mark contains a term which is usually considered to be a slur towards a particular group, yet the applicant is a member of that group suggests that the slur has lost its disparaging potency. Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of slurs into Section 2(a) of the Lanham Act*, 106 colum. L. rev. 388, 389 (2006). See also *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q. 2d (BNA) 1705, 1708 (T.T.A.B 1999), *In re In Over Our Heads Inc.* 16 U.S.P.Q. 2d (BNA) 1653,1653

(T.T.A.B 1990). (holding that marks such as “Redskins” and “Moonies” were considered disparaging because the applicants were not members of the group.) Luhv has blonde hair and is a member of the stereotyped group considered to be dumb because of their blonde hair.

A vital element of a §2(a) Disparagement Refusal is that the mark has to be disparaging to one’s personal reputation. Trademark Man. Of Exam Proc. 1203-03(b)(i). The name DUMB BLONDE does not ruin Ms. Luhv’s reputation. Ms.Luhv’s reputation is highly popularized by her immense following and fans. Due to her popularity she has been offered a \$2,000,000 contract by a record company with the stipulation that she be able to trademark the name DUMB BLONDE. *In re Luhv*, 1337 F.3d 455, 456 (Fed. Cir. 2015). An intrinsically disparaging mark contains a term that a substantial composite of the target group would always find disparaging, regardless of the mark’s contextual use but based on the mere presence of a hateful slur. *Id.* DUMB BLONDE does not have a long history of being a hateful slur and has been a stereotype towards a group of women. Ms. Luhv takes pride in who she is and wants to discredit that stereotype through her celebrity status by demonstrating that blonde women can be successful and not in fact dumb.

The name DUMB BLONDE is not disparaging according to its meaning, although the Lanham act is silent as to what is considered “disparaging.” *Doughboy Indus., Inc. v. Reese Chem. Co.* was the first case to refuse registration to a trademark on the grounds that it was disparaging. 88 U.S.P.Q.

227, 2 (P.T.O. 1951), *See also* Kimberly A. Pace, *The Washington Redskins and The Doctrine of Disparagement: How Politically Correct must a Trademark be?* 22 *pepp. l. rev.* 7, 28 (1994) (In discussion of disparaging trademarks). However, neither *Doughboy* or The Lanham Act give guidance on defining “disparaging.” Subsequently, as a result, the PTO decided to first look at the dictionary definition of disparage. Kimberly A. Pace, *The Washington Redskins and The Doctrine of Disparagement: How Politically Correct must a Trademark be?* 22 *pepp. l. rev.* 7, 28 (1994). In another case the applicant submitted a dictionary listing for “Buddha” and the files histories of five registrations for marks which include the word “Budda” and/or a Budda design. *In Re Hines*, 31 U.S.P.Q.2d 1, 1685 (T.T.A.B 1994). The TTAB held that dictionary evidence alone is not sufficient to show that the mark is used in a disparaging manner. *Id.*

Ms. Luhv has provided sufficient evidence beyond dictionary definitions to show that her mark is not disparaging. However, even only looking at the dictionary definitions, DUMB BLONDE is not disparaging in its meaning. The word “dumb,” as defined in Webster’s Dictionary has several meanings. The literal meaning of the word “dumb” is “to silence;” the informal definition means: “simplify or reduce the intellectual content of something so as to make it accessible to a larger number of people.” The offensive term means: “unable to speak, most typically of congenital deafness.” *webster-merriam*, <http://www.merriam-webster.com> (last visited October 18, 2015) The term “blonde”, according to Webster’s Dictionary is an

adjective referring the color of one's hair or of a person's hair. webster-merriam, <http://www.merriam-webster.com> (last visited October 18, 2015)

A court gives a word used in a statute its ordinary and common meaning where legislative history did not show intent of Congress in enactment of the statute. *In re Riverbank Canning Co.*, 95 F.2d 327, 1029 (T.T.A.B 1938) There is nothing disparaging about any of the above meanings, they are vague in their terminology, and not definitive of the meaning intended by Ms. Luhv's trade name. Furthermore, when there is more than one possible meaning of a mark, the likely meaning is determined not only by dictionary definitions, but also the manner in which the mark is used in the marketplace. *In re Geller*, 751 F.3d at 1358. In this case, Ms. Luhv's mark is used to promote her music as a successful musician.

Ms. Luhv's music incorporates lyrics that focus on issues faced by women in today's society. *In re Luhv* at 456. Luhv's fan base consists of mainly women in their thirties and forties with a variety of hair colors. *Id* at 457. This proves that Ms. Luhv is not disparaging any particular group as is defined in §2(a) of the Lanham Act. The TTAB should not solely base its opinion on the dictionary definition, that becomes problematic in an ex parte proceeding, but determine how she is viewed in the marketplace. The TTAB has explained that "in evaluating the examining attorney's evidence we must be cognizant of the PTO's limitations in amassing evidence and 'we look only for...more than a scintilla of evidence, in support of the USPTO's prima face case.'" Jessica M. Kissler, *How Dykes On Bikes Got It Right: Procedural Inequities Inherent In The Trademark Office's Review Of Disparaging*

Trademarks, 46 *u.s.f. l. rev.* 28, 20 (1994). Ms. Luhv's evidence is more than a scintilla of evidence based on the numerous followers who attend her concerts and post positive feedback on her social media platforms and how she uses her mark in the marketplace.

In determining whether a mark is disparaging or offensive to another group the court held that the guidelines for that inquiry are somewhat vague because the determination is so highly subjective. *In Re Heeb Media, LLC*, 2008 TTAB Lexis 9, 65 (T.T.A.B 2008). "[W]e are inclined to resolve doubts on the issue of whether a mark is disparaging in favor of the applicant and pass the mark for publication with the knowledge that if a group does find the mark to be disparaging, an opposition proceeding can be brought and a more complete record can be established." *Id.* There is not enough substantial evidence found to determine whether the mark contains a "matter which may disparage." In *In re Geller*, the board refused registration of the mark STOP THE ISLAMISATION OF AMERICA because there was enough evidence to show that the term was used in the marketplace and the Board found this meaning was "more reflective of the public's current understanding of the term." *In re Geller* at 1356. Ms. Luhv's fans understand the term DUMB BLONDE as a stage name and understand that the meaning is part satirical and part self-referential and not disparaging to any other person or group.

An examiner's assessment is akin to a prediction of how a particular group of people might conceivably react to the mark without the benefit of an actual member of the disparaged group coming forward to challenge the mark. Todd Anten, *Self-*

Disparaging Trademarks and Social Change: Factoring the Reappropriation of slurs into Section 2(a) of the Lanham Act, 106 colum. l. rev. 389, 406. The court in, *In re Gourmet Bakers, Inc.*, held that “any person who believes that he would be damaged by the registration will have an opportunity under §13 to oppose the registration of the mark and to present evidence, usually not present in the ex parte application.” 173 U.S.P.Q 1, 565 (T.T.A.B. 1972). DUMB BLONDE is vague as to what a reasonable person would dispute as being disparaging because no other member with blonde hair has come forth to contest the name.

The TTAB incorrectly denied the trademark application because the name DUMB BLONDE is not disparaging as is used in §2(a) of the Lanham Act.

B. DUMB BLONDE, does not disparage a substantial composite of the referenced group.

DUMB BLONDE does not disparage a substantial composite of the referenced group. There is substantial evidence that Ms. Luhv’s popularity points to the composition of her fan base, the attendance at her concerts, and the positive feedback displayed on various social media websites. *In re Luhv* at 458. Once it is established that the mark at issue refers to an identifiable group of persons, the examining attorney must then evaluate whether a substantial composite of people in that referenced group would view the use of the mark, in the context presented as disparaging. Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of slurs into Section 2(a) of the Lanham Act*, 106 colum. l. rev. 389, 405. Although the TTAB looked at numerous articles and user

comments on Appellant's uTube videos of women who did find the phrase DUMB BLONDE to be offensive. These users do not compose a substantial group of members in comparison to the enormous amount of fans who attend one single concert. Additionally, the courts are silent as to what is considered "substantial." The TTAB's decision used all women in general when it was supposed to use only blonde women, in doing this they did not analyze the element properly. Furthermore, there is no reference to which articles were used to support their decision or the content in those articles.

The courts determined in the Harjo two-prong test that a proposed mark which is considered disparaging must be from the standpoint of a substantial composite of the referenced group in context of contemporary attitudes. *In re Simon Shiao Tam*, 108 U.S.P.Q. 2d 1305, 4 (T.T.A.B. 2013). The *Harjo* test consists of two elements that are required for determining whether a mark is disparaging:

1. the meaning of the matter in question "as it appears in the marks and as those marks are used in connection with the services identified in the registrations" must be determined and;
2. The TTAB must determine whether such meaning may disparage a substantial composite of the referenced persons, institutions, beliefs, or national symbols.

Pro Football, Inc. v. Harjo, 565 F.3d 880, (Fed. Cir. 2009)

The mark DUMB BLONDE does not meet (or satisfy) either prong. As to the first prong of the Harjo test, Ms. Luhv's services include her performances to her

fans, her clothing line, her online services as identified by her brand name, and her music. As to the second prong, Ms. Luhv is promoting the fact that women in today's society have proven to be smart and successful. For example, Ms. Luhv displays on her website a depiction of a blonde woman as president of the United States sitting in the oval office. *In re Luhv* at 458.

Ms. Luhv's fan's perceive her as being an intelligent musician and the meaning of her trademark is to overcome the stereotype of DUMB BLONDE In a case distinguishable from the instant case, the court considered the "nature of the identified services." *In re Simon Shiao Tam*, 108 U.S.P.Q. 2d 1305, 4 (T.T.A.B 2006), The court was faced with a term, THE SLANTS, that necessarily identified the live performers of a band. Thus, those who attend the live performances will understand THE SLANTS to refer to the persons who comprise the musical band. *In re Tam*, 108 U.S.P.Q. 2d at 4. However, THE SLANTS were refused registration because there was substantial evidence through the band's repeated public discussions of its name referring to the slang meaning that they were disparaging their racial background and through the Asian-American groups who refuted its usage. *Id.* In *In Re Tam*, the focus of the inquiry into whether a mark is disparaging is not on applicant's race but rather on the referenced group's perception of the likely meaning of the mark. Ms. Luhv's meaning is not from the standpoint of a substantial composite of the referenced group of blonde women. Furthermore, there is no slang meaning for DUMB BLONDE; and finally, there no racial history that connects the mark.

No other person would find the mark DUMB BLONDE disparaging because a reasonable person would understand it to refer to Ms. Luhv herself, thus, the term is not used to disparage a racial group.

A court cannot determine whether a substantial group of women with blonde hair would find DUMB BLONDE disparaging unless the mark is registered and publicized in the Gazette for third parties to appeal *In Re Geller* at 1358, *See also In re Lebanese Arak Corp.* 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B 2010). (Reasoning the board improperly relied “on arbitrary and anecdotal evidence” in determining the mark’s meaning and in finding that meaning may disparage American Muslims.) In *In re Lebanese Arak Corp.*, The TTAB reversed its decision and allowed its mark to be registered. However, using the same standard the TTAB refused to register the mark DUMB BLONDE. The substantial composite of women would understand the name DUMB BLONDE as referring to Ms. Luhv and her re-appropriation of the name through her music and lyrics. They identify Ms. Luhv as being a popular and successful musician. This would further protect her merchandise from being fraudulently mimicked and prevent impersonators from fouling Ms. Luhv’s image impinging on her goal for reappropriation. Therefore, this court should register the mark and any opposition can file a complaint with further evidence on whether DUMB BLONDE is disparaging and reaches a substantial composite of women who can seek for opposition.

Further, proof that there is not substantial evidence that Ms. Luhv’s stage name DUMB BLONDE is disparaging, is the hair product, “DUMB BLONDE

SHAMPOO.” There is no substantial composite of persons complaining on this companies website about the trade name. ultra beauty, <http://www.ulta.com> (last visited October 18, 2015) The name DUMB BLONDE SHAMPOO was approved for registration in 2002. United states patent and trademark office, <http://www.uspto.gov> (last visited October 18, 2015). DUMB BLONDE SHAMPOO reaches only women with blonde hair whereas Ms. Luhv’s music attracts men and women of all hair colors.

C. Reappropriation should be considered before determining a mark “disparaging” when the mark is used toward seemingly self-disparaging trademarks”

Ms. Luhv’s use of the mark DUMB BLONDE is to reappropriate the stereotypical meaning that society places on women with blonde hair. Ms. Luhv wants to reclaim the name to show society and specifically women who have blonde hair that they are not dumb. Ms. Luhv chose the mark DUMB BLONDE as a way to reclaim the stereotype associated with blonde women and raise awareness of the challenges stemming from gender discrimination and negative stereotypes faced by all women. *In re Luhv* at 457. The seminal case for reappropriation was the San Francisco Women’s Motorcycle Contingent when the mark DYKES ON BIKES was registered. Jessica Kiser, *How Dykes On Bikes Got It Right: Procedural Inequities Inherent In The Trademark Office’s Review Of Disparaging Trademarks*, 46 u.s.f. l. rev.1 (2001) (discussing trademark background). In this case, the PTO found that a substantial composite of the lesbian community had accepted the new meaning of

Dyke. *Id.* Despite the government’s intention to protect groups from disparagement, the targets “may suffer in the long run because they have surrendered the power to confront, survive, and transform these negative representations of themselves. *Id.*” Ms. Luhv’s proposed use of the trademark is to reappropriate the stereotypical meaning of DUMB BLONDE. *In re Luhv* at 457. Like the applicants for the mark DYKES ON BIKES, Ms. Luhv asserts a similar intent for the mark DUMB BLONDE in that she aims to recast the phrase in a positive light by displaying it prominently alongside a woman with a successful career whose musical lyrics shed light on critical issues faced by women. *In re Luhv* at 458. In a similar case, the court held reappropriation of a name was valid to receive registration. *In re Heeb Media, LLC*, 2008 TTAB Lexis 65, 7 (T.T.A.B 2008) (holding the applicants slur is thus persuasive evidence that the slur is no longer disparaging in all situations—the mark is transforming into a contextually disparaging mark that might not disparage a “substantial composite” of the referenced group). There are countless other slurs currently undergoing such revision that have been approved for registration due to re-appropriation such as “dyke,” “queer,” “nigger,” “spic,” “chink,” “bitch,” “heeb,” and “J.A.P.” that are all in reappropriation by lesbians, gay men, bisexuals, transgender people, African Americans, Latinos, Asian Americans, women, and Jews.” *Id.* While DUMB BLONDE has been the term of jokes, Ms. Luhv’s goal is to reappropriate the term and show the public that women with blonde hair are smart and successful, and further to do away with old stereotypes.

II. THE LOWER COURT WAS CORRECT IN FINDING THAT SECTION 2(a) VIOLATED THE FIRST AMENDMENT BECAUSE IT IMPOSES A DISCRIMINATORY BASED BURDEN ON CONSTITUTIONALLY PROTECTED SPEECH.

The burdens on speech imposed by § 2(a) contravene the fundamental principles of the First Amendment, which provides that, “Congress shall make no law . . . abridging the freedom of speech” The content-based discrimination mandated by Congress through § 2(a), cannot be allowed to act as a deterrent, suppressor, or censor of protected speech.

Society requires the free flow of commercial information absent unwarranted government interference. This Court has recognized that the free flow of commercial information is an integral element of society because it informs consumer choices and contains matters of general public interest. *Friedman v. Rogers*, 440 U.S. 9 - 10 (1979). Hesitation to afford commercial speech greater protection remains guarded due to its inherent ability to mislead and deceive consumers and the public in general. *Id.* at 10. Nevertheless, this Court has reasoned that even if commercial speech contains an incomplete version of relevant facts, some accurate information is better than no information at all. *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n of N.Y.*, 447 U.S. 557 (1980).

DUMB BLONDE is an integral element of society. It is not misleading because it identifies Ms. Luhv. *In re Luhv*, 1337 F.3d at 455 (2015). Ms. Luhv has traveled to various states to perform her music and has built a strong social media following that attribute “DUMB BLONDE” to her. *Id.* at 456 – 457. Furthermore, “DUMB BLONDE” is intimately related to the lyrics in Ms. Luhv’s music.

Therefore, this Court should uphold the decision of the Federal Circuit, and find that the prohibition against the registration of disparaging trademarks in §2(a) strikes at the core First Amendment.

- A. The lower court correctly held that DUMB BLONDE is protected speech under the First Amendment because it proposes a commercial transaction, but it also does more.

The Federal Circuit correctly held that DUMB BLONDE is commercial speech because it does propose a commercial transaction. All speech is presumptively protected against government interference, leaving it to the government to demonstrate, either through a well-crafted statute or case-specific application, the historical basis for or a compelling need to remove some speech from protection. *U.S. v. Alvarez*, 617 F.3d 1198, 1205 (9th Cir. 2010). Commercial speech is speech that proposes a commercial transaction. *Virginia State Bd. of Pharm. v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748, 762 (1976). Speech that does no more than propose a commercial transaction is protected by the First Amendment. *Id.* at 761-62. To fall within First Amendment protection, commercial speech must not be misleading or concern unlawful activity. *Bolger v. Young Drug Prod. Corp.*, 463 U.S. 60, 69 (1983). Finally, speech that is obscene, defamatory, pertaining to fraud, incitement, or speech that is integral to criminal conduct is not protected, regardless if it is commercial or not. *Alvarez*, 617 F.3d at 1202 (2010). This distinction is critical because it designates the degree of protection afforded to the category of speech protected.

DUMB BLONDE does not fall within a category of unprotected speech. It conveys a message to Ms. Luhv's audience and tells them who she is, what her music is about, and the name they can search to find it. *In re Luhv*, 1337 F.3d at 455 - 456. In addition, Ms. Luhv has a financial incentive to seek federal trademark protection, because the Record Company is conditioning an advance of two million dollars on her ability to secure the mark. *Id.* at 457. Economic motive is a strong indicator of whether speech is commercial or not. *Dex Media West, Inc. v. City of Seattle*, 793 F. Supp. 2d 1213, 1222 (2011). The incentive to have financial backing is a critical consideration to determine whether her actions were financially motivated or not. Moreover, not only did Ms. Luhv have a financial incentive to seek federal trademark protection, but the record label also undoubtedly has a financial interest in protecting its investment.

The inquiry must not end here because DUMB BLONDE does more than propose a commercial transaction. This Court has held that a few factors are not determinative to label speech as purely commercial. *Bolger*, 463 U.S. at 66. Instead, it is essential to carefully evaluate all the facts of a particular situation to ensure that speech that warrants greater protection is not carelessly suppressed. *Id.* In *Bolger*, this Court held that informational pamphlets constituted commercial speech. In that case, the government enacted a statute that prohibited unsolicited advertisements regarding conception prevention. *Bolger*, 463 U.S. at 62. The plaintiff distributed pamphlets that contained conception prevention information. *Id.* at 63. The circumstances were carefully evaluated to ensure that speech

deserving a higher degree of protection would receive it. *Id.* at 67-69. (reasoning that an advertisement cannot be characterized as commercial speech based on the fact that it is an advertisement, especially when it contained information about contraceptives, which is a matter of societal interest). The court concluded that a combination of all of the characteristics mentioned above provided strong support that the pamphlets, in fact, were commercial speech.

Here, DUMB BLONDE does more than propose a commercial transaction. As such, it should be afforded the utmost protection under the First Amendment.

Therefore, this Court should affirm the decision of the lower court, and find that DUMB BLONDE commands First Amendment protection.

B. The Government Speech Doctrine is inapplicable because the PTO has minimal editorial control over any of the trademarks it publishes, the identity of the literal speaker is clearly identified, the speaker bears the ultimate burden of the mark, and the section 2(a) is inconsistent with legislatures purpose in enacting the Lanham Act.

The Government is not speaking when it registers, approves, and publishes a trademark. Under the government speech doctrine, a government entity is exempt from First Amendment scrutiny. *Pleasant Grove City v. Sumnum*, 555 U.S. 460, 467-468 (2009). In order to determine whether speech is that of the government, private parties, or both, this Court must consider: (1) the central purpose of the program where the speech in question occurs; (2) the identity of the literal speaker; (3) the degree of editorial control exercised by both parties; and (4) the party ultimately responsible for the speech. *Planned Parenthood Of South Carolina v.*

Rose, 361 F. 3d. 786, 793 (4th Cir. 2004). Factors such as legislative intent, revenue generation and allocation are also illustrative. *Id. at* 799.

The PTO exercises minimal editorial control over the trademarks it publishes. In *American Civil Liberties Union of North Carolina*, the court reasoned that the government possessed a great degree of editorial control because it determined and approved the message that appeared on specialty license plates. *American Civil Liberties Union of North Carolina v. Tata*, 742 F.3d 563, 570 (4th Cir. 2014). Also, the government expressly agreed that it would have complete editorial control. Here, unlike the message displayed on the license plates, the Government has not designated a single message it seeks to convey. Therefore, this factor weighs in favor of finding that DUMB BLONDE is private speech because a majority of the editorial control is vested with Ms. Luhv.

Additionally, the identity of the literal speaker is patently evident. In *American Civil Liberties Union*, the court reasoned that the identity of the literal speaker weighed in favor of finding that the specialty license plates were private speech because each driver had the choice between various vanity plates and thus the choice was closely related to them. *Id. at* 574. It also noted that plates were located on the driver's vehicles. *Id.* Here, DUMB BLONDE has been used in commerce for several years and in several states. *In re Luhv*, 1337 F.3d at 455. Her fans also identify her with the name. *Id. at* 459. Further, she intends to use DUMB BLONDE on various items of clothing, which do not have the government's imprimatur. *Id. at* 457. Moreover, Ms. Luhv chose a satirical stage name to raise

awareness to issues faced by women. *Id.* at 456. As a result, the name she chose is intimately related to her brand, products, ideas and beliefs. *Id.* at 459. Therefore, this factor weighs in favor of finding that “DUMB BLONDE” is private speech.

Furthermore, Ms. Luhv bears the ultimate responsibility for DUMB BLONDE. In *American Civil Liberties Union*, the Fourth Circuit reasoned that the ultimate responsibility of the speech weighed in favor of finding that it was private speech because the drivers displayed the license plates on their cars, and thus bore the ultimate responsibility of the message on those plates. *American Civil Liberties Union of North Carolina v. Tata*, 742 F.3d at 575 Here, Ms. Luhv sought out, registration fee. *Id.* at 457. If an individual or group sought to oppose DUMB BLONDE under 15 U.S.C §1063(a), Ms. Luhv, would be solely responsible for defending the mark. *Id.* Therefore, this factor weighs in favor of finding that “DUMB BLONDE” is private speech.

Lastly, the §2(a) contravenes the core purpose of the Lanham Act. Legislative history provides that the Lanham Act was enacted to encourage competition, promote economic growth, and protect producers of products, S. Rep. No. 100-515, At 2 (1988). Ms. Luhv is seeking to protect her products and grow economically as an artist. *In re Luhv*, 1337 F.3d. 455. In *American Civil Liberties Union of North Carolina*, the Fourth Circuit held that the purpose of a specialty license plate program weighed in favor of finding that it was private speech. *American Civil Liberties Union*, 742 F.3d at 573. It reasoned that the programs purpose was to allow drivers to express themselves, and that when a specialty license plate was

purchased, it was the private citizen who engaged the government to publish his message and not the other way around, thus without the private citizen, specialty license plates would not exist.

Furthermore, Ms. Luhv is the one who engaged the PTO to publish here message. *In re Luhv*, 1337 F.3d. at 456. In addition, the operation of the PTO is exclusively funded by applicant fees. *Figueroa v. U.S.*, 466 F.3d 1023, 1028 (Fed. Cir. 2006). Moreover, it would be inconsistent for the government to claim it is now speaking. *In re Old Glory Condom Corp*, the TTAB acknowledged that trademark registration does not implicate the government. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 216, 1219 n.3 (T.T.A.B. 1993) (stating that “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.”).

Therefore, this Court should not allow the Government to now claim it is under the umbrella of the Government Speech Doctrine so that it may avoid the scrutiny under the First Amendment.

- C. Section 2(a) of the Lanham Act fails under the “Central Hudson Test” because “DUMB BLONDE” is protected speech, the Government has not met its burden in demonstrating a substantial interest in burdening this speech or how § 2(a) would advance that interest, and § 2(a) is more extensive than necessary to achieve any speculative interest.

Section 2(a) of the Lanham Act cannot surmount the intermediate level of scrutiny under the Central Hudson Test. In order to regulate commercial speech, a four-part test must be satisfied. *Central Hudson Gas & Elec. Corp. v. Public Service*

Comm'n of New York, 447 U.S. 557, 566 (1980). The speech cannot be unlawful or misleading, the asserted government interest must be substantial, and the regulation must directly advance that interest. *Id.* at 567. Lastly, the regulation cannot be more extensive than necessary to serve that interest, which means there must be a reasonable fit between the Government's interest and the means chosen to achieve that interest. *Bd. of Tr., State Univ. of N.Y. v. Fox*, 492 U.S. 469, 481 (1989).

DUMB BLONDE is not misleading, concerns lawful activity, and the Government has failed to identify any interest, let alone a substantial one, that would warrant such a burden on speech. Even if a speculative interest is identified, § 2(a) does not advance it because it is more extensive than necessary. First, DUMB BLONDE refers to Ms. Luhv and her music. *In re Luhv*, 1337 F.3d at 455. She intends to use DUMB BLONDE for entertainment purposes, such as live performances by a musical band and on clothing such as sweatshirts, t-shirts, tank tops, and headwear. *Id.* at 456. These instances hardly resemble unlawful or misleading activity. Although the government may argue that DUMB BLONDE is misleading because it does not reference the particular blonde it is referring to, that argument must fail because the name is fairly attributable to Ms. Luhv. She has traveled to several states and performed under that stage name for over three years. *Id.* at 455. She has a strong presence on the Internet with over 140,000 followers and fans. *Id.* Therefore, there is substantial evidence that the mark would not mislead the public.

Furthermore, the Government has failed to meet its burden by identifying any interest, substantial or not. When the government regulates speech, any interest must be real and not speculative *Hornell Brewing Co., Inc. v. Brady*, 819 F. Supp. 1227, 1236 (E.D.N.Y., 1993). Even if the government has an interest in protecting particular groups from names that may offend, this interest is not substantial. In *Texas v. Johnson*, this Court reasoned that the desire to protect society from the disparaging speech is not a substantial interest, which would justify prohibition. *Texas v. Johnson*, 491 U.S. 397, 399 (1989).

In addition, §2(a) minimally advances the Government's speculative interests and is not a reasonable fit between to achieve any interest. Seemingly disparaging marks like DUMB BLONDE can be precluded from registration, but patently disparaging marks get approved. *see* DUMB BLONDE WHORES, (serial number 77731907, used in connection with comedy), Trademark Electronic Search System (TESS), <http://tmsearch.uspto.gov/> (2015). As a result, §2(a) is grossly over and underinclusive. Thus, §2(a) is not reasonable fit.

Furthermore, the legislative history is devoid of evidence that suggests blonde women need to be protected by §2(a). When the Government defends a regulation on speech as a means to redress past wrongs or prevent anticipated harms, it must demonstrate that the recited wrongs are real and not merely conjectural and that the regulation will in fact alleviate those harms. *U.S. v. Nat'l Treasury Emp. Union*, 513 U.S. 454, 475 (1995). The government has undoubtedly failed to do that here.

In *City of Cincinnati v. Discovery Networks, Inc.*, this Court held that a city regulation to reduce clutter and waste on the sidewalks by banning newsracks for commercial handbills was not a reasonable fit to achieve its objective. *City of Cincinnati v. Discovery Network, Inc.*, 507 U.S. 410,418 (U.S. 1993). In that case, Cincinnati enacted an ordinance that placed a ban on newsracks that distributed commercial handbills, but that ban did not apply to news racks containing newspapers. *Id.* at 411. As a result, sixty-two news racks that distributed commercial handbills were banned, while 1,500 – 2000 that did not, remained in place. *Id.* at 418. This Court determined that Cincinnati had not satisfied its burden of establishing a reasonable fit between. *Id.* (reasoning that the reasonable fit was absent because the benefit achieved by was minute and paltry.)

Here, §2(a) does not provide a list of what names may disparage as examples for the public to use. Even if it did, a balancing test that views the totality of the circumstances and not just a few items in connection with a mark would be helpful to prevent patently disparaging marks from being registered and the denial of satirical names like DUMB BLONDE.

Therefore, the decision of the lower court, which found that §2(a) did not withstand scrutiny under the Central Hudson Test, must be affirmed.

D. Even if this court finds that Section 2(a) surmounts the intermediate level of scrutiny applied under the Central Hudson Test, it must fall regardless, because it places a content-based burden on protected speech.

Section 2(a) of the Lanham Act implicates the First Amendment because it utilizes content-based discrimination to place a burden on protected speech. A law that does not impose a complete ban on speech, but instead imposes a burden on that speech, is subject to the same analysis as a law that completely bans that speech. *U.S. v. Playboy Entm't Grp., Inc.*, 529 U.S. 803, 812 (2000). The must be content-neutral in both viewpoint and subject matter when it seeks to regulate protected speech. *Perry Educ. Assn. v. Perry Local Educators' Assn.*, 460 U.S. 37, 45 (1983). The viewpoint neutrality requirement prohibits the Government from regulating constitutionally protected speech based on the ideology, system of ideas and ideals of its message, or the message the artist wishes her audience to take away from her art. THINKING ABOUT CONTENT: CAN IT PLAY AN APPROPRIATE ROLE IN GOVERNMENT FUNDING OF THE ARTS? 102 Yale L.J. 1209, 1218, 1220 (1993). The subject matter neutrality requirement prohibits the Government from regulating speech based on the topic of the speech. 102 Yale L.J. 1209). Any such content-based restrictions on speech are presumptively invalid. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 382 (1992). The principal inquiry in determining whether a restriction is content-neutral or content based is whether the government adopted the restriction because of its disagreement with the message the speech conveyed. *Ward v. Rock Against Racism*, 491 U.S. 781, 794 (1989). The Government's purpose is the controlling consideration *Id.* at 792.

Finally, In order for a regulation to be narrowly tailored, it must not be substantially broader than necessary. *Id.* at 800.

Section 2(a) expressly provides that, “No trademark . . . shall be refused registration on the principal register . . . unless it [c]onsists of or comprises [a] matter which may disparage or falsely suggest a connection with persons, living or dead . . . or bring them into contempt, or disrepute[.]” In order to determine whether a trademark is disparaging, the PTO, TTAB, and Courts rely on the beliefs and views of the examining attorney, a substantial composite of a group that may be disparaged. *In Re Luhv*, 1337 F.3d at 457-459. By its terms, §2(a) discriminates against differing viewpoints by placing at contention, the views of the Government, the trademark registrant, the examining PTO attorney, and a substantial composite of a particular group. It then uses that discrimination to deny or grant the benefit of federal trademark protection. A conversation amongst Congress provides scant evidence of their intent.

Mr. Robertson. Why should [.] . .Congress [.] . .permit Benjamin Harrison’s name [.] . .to be used as a trademark on any article, device, or merchandise, even though dead?

Mr. Marony. In other words, we would not want to have Abraham Lincoln gin

Mr. Robertson. Nor sir, we would not.

Mr. Fenning. Or, George Washington coffee.

Mr. Rogers. . . . I quite agree that Abraham Lincoln gin ought not to be used, but I would not say the use of G. Washington coffee should not be permissible. . . . it would not prevent the legitimate uses of names.

THE WASHINGTON REDSKINS CASE AND THE DOCTRINE OF DISPARAGEMENT: HOW POLITICALLY CORRECT MUST A TRADEMARK BE? PEPLR 22 Pepp. L. Rev.

According to Congress it is allowable to place a President’s name on coffee, but not gin. The difference is the subject of what the name is being placed on and

viewpoint that the placement would convey a certain message that it did not find agreeable. This conversation supports the contention that the purpose of § 2(a), is viewpoint and subject matter based. Furthermore, § 2(a) places a significant financial burden on protected speech because it singled out “DUMB BLONDE” based on the viewpoint of the PTO examining attorney and the general public. *In re Luvv*, 1337 F.3d at 457-459. Specifically, §2(a) placed a significant financial burden on Ms. Luvv because absent federal registration, she will be unable to execute the recording agreement she negotiated, and secure the accompanying two million dollar advance. *Id.* at 457.

This Court cannot allow the Government to act as a censor, through §2(a), by allowing Congress to place a financial burden on Ms. Luvv’s message, based on the fact that some may disagree with it. Speech cannot be financially burdened, any more than it can be punished or banned simple because some find it offensive. *Forsyth Cnty. v. Nationalist Movement*, 505 U.S. 123, 136 (1992). §2(a) may silence Ms. Luvv. She has dedicated three years of her career to building a fan base and traveling the states to garner a following, she may engage in Self-censorship as a consequence of §2 (a) .

In *United States v. Nat’l Treasury Emp. Union*, this Court found that a ban on honoraria for Government employees imposed a financial burden that abridged speech under the First Amendment. *Nat’l Treasury Emp. Union*, 513 U.S. at 454, 471 (reasoning that the denial of compensation for the lower paid employees would have diminished their expressive output because without the money, they would not

have engaged in the protected expressive activity and that such a policy would also impose a significant burden on the public's right to read and hear what the employees had to say.)

In, *League of Women Voters of California v. FCC*, the plaintiffs challenged a provision in the Public Broadcasting Act that prohibited stations receiving federal funds from "editorializing." *League of Women Voters of California v. FCC*, 468 U.S. 364, 367 (1984). The Court struck down the provision because it was concerned with the fact that it barred a grantee from using wholly private funds to finance its editorial activity." *Id.* at 400. Here, Ms. Luhv has no comparable alternative to federal trademark registration because every state legislature has adopted the prohibition in § 2(a) against disparaging trademarks. 22 Pepp. L. Rev. 7, 23 (1994). Moreover, Congress must not be allowed to disregard this doctrine under its spending powers, because federal trademark fees derive wholly from applicant fees paid to the PTO. *Figueroa*, 466 F.3d at 1028 (Fed. Cir. 2006). The absence of a content-neutral regulation is patently evident. § 2(a) is not content-neutral because it expressly prohibits the registration of disparaging trademarks. §1052(a).

In *United States v. Playboy Entertainment Group, Inc.*, this court held that the "signal bleed" provision of the Telecommunications Act of 1996 constituted a content-based burden that violated the First Amendment. In that case, a provision of a federal statute required cable operators to scramble, block in full, or otherwise limit the programming of sexually explicit channels to certain hours when children were unlikely to be viewing. In reaching its conclusion that the signal bleed

provision was content-based, the court reasoned that the regulation singled out programming based on its sexual content and that the law was designed to suppress or restrict the expression of specific speakers and this contradicted basic first amendment principles. The court noted that under the First Amendment's free speech clause, the citizen is entitled to seek out or reject certain ideas or influences without government interference.

Section 2(a) allows the general public to oppose or seek cancellation of a trademark based on their contrasting viewpoints. In *Board of Regents of University of Wisconsin System v. Southworth*, the court held that there was a question of fact with regard to the viewpoint neutrality of the schools program because the referendum aspect of the University's program appeared to condition funding or defunding of a program by majority vote of the student body. The court reasoned that the referendum substituted the majority determinations for viewpoint neutrality. 529 U.S. 217 (2000).

The Lanham Act allows the registration of trademarks subject to the statutory exceptions set out in section 2(a) under that reading anyone can register any trademark as long as it is not disparaging. On its face, Section 2(a) mandates content-based and speaker based discrimination. The provision first forbids the registration based in large part on the content-of the trademark and the message of the speaker. As a result, trademark filers with perceived disparaging marks may not receive the protection of federal registration, while trademark filers with diverse purposes and viewpoints can. The law, on its face, burdens disfavored

speech by disfavored speakers. The government has conditioned a benefit of a content-based rule that is not drawn to serve the state's asserted interest.

- E. The disparagement prohibition mandated by Section 2(a) cannot surmount the strict level of scrutiny applied to content based regulations nor cannot it surmount the intermediate level of scrutiny applied to content-neutral regulations because it is substantially overbroad, and places a prior restraint on speech due to its overbreadth.

The mandate against the registration of disparaging trademarks set forth in Section 2(a) is not narrowly tailored in any sense because it is substantially overbroad, and regulates more speech than necessary, and because it grants the PTO unbridled discretion to approve or deny trademarks absent any clear legislative standards. When the government seeks to place a content-based burden on private commercial speech, it must show that the burden on speech is narrowly tailored to promote a compelling governmental interest and if a less restrictive alternative would serve the government's interest, the legislature must use that alternative. (*U.S. v. Playboy Entertainment Group, Inc.*, 120 S.Ct. 1878, 1886, 529 U.S. 803, 812 (U.S. 2000)). If the government seeks to regulate private commercial speech and the regulation is found to be content-neutral, the regulation on time, place or manner of expression must be narrowly tailored to serve significant government interest, and must provide ample alternative channels of communication. (*Ward v. Rock Against Racism*, 491 U.S. 781 (U.S.N.Y. 1989)). A facial overbreadth challenge lies whenever a licensing law gives a government official or agency substantial power to discriminate based on the content or

viewpoint of speech by suppressing disfavored speech or disliked speakers. *City of Lakewood v. Plain Dealer Pub. Co.*, 108 S.Ct. 2138, 2145, 486 U.S. 750, 759 (U.S. Ohio, 1988). In order to render a statute invalid under the overbreadth doctrine, it must establish that no set of circumstances exists under which the Act would be valid. *United States v. Salerno*, 481 U.S. 739, 745, 107 S.Ct. 2095, 2100, 95 L.Ed.2d 697 (1987). However, it is a well settled principle that this general rule does not apply to First Amendment challenges. *National Endowment of the Arts v. Finley*, 524 U.S. 569 (1998). The capable-of-constitutional-application rule recognized in this Court's jurisprudence for facial challenges based upon First Amendment free-speech grounds establishes an exception to this general rule. *National Endowment of the Arts v. Finley*, 524 U.S. 569 (1998). Under this exception, a regulation that restricts speech-based on its content is facially invalid in all of its applications if it is invalid of any of them. *Ada v. Guam Society of Obstetricians & Gynecologists*, 506 U.S. 1011, 1012, 113 S.Ct. 633, 634, 121 L.Ed.2d 564 (1992) (SCALIA, J., dissenting from denial of certiorari). Lastly, the law should not be invalidated for overbreadth unless it reaches a substantial number of impermissible applications," *New York v. Ferber*, 458 U.S. 747, 771, 102 S.Ct. 3348, 3362, 73 L.Ed.2d 1113 (1982).

Furthermore, this Court has readily applied the over breadth doctrine to render regulations on speech facially invalid in all of its applications, if it is invalid in any one of them. See, *Ada v. Guam Society of Obstetricians & Gynecologists*, 506 U.S. 1011, 1012, 113 S.Ct. 633, 634, 121 L.Ed.2d 564 (1992) (SCALIA, J., dissenting

from denial of certiorari); see, e.g., *Reno v. American Civil Liberties Union*, 521 U.S. 844, 117 S.Ct. 2329, 138 L.Ed.2d 874 (1997) (striking down decency provision of Communications Decency Act as facially overbroad); *id.*, at 893–894, 117 S.Ct., at 2355 (O'CONNOR, J., concurring in judgment in part and dissenting in part) (declining to apply the rule of *Salerno* because the plaintiffs' claim arose under the First Amendment); *Schad v. Mount Ephraim*, 452 U.S., at 66, 101 S.Ct., at 2181 (“Because appellants' claims are rooted in the First Amendment, they are entitled to ... raise an overbreadth challenge”) (internal quotation marks omitted); *Gooding v. Wilson*, 405 U.S. 518, 521–522, (1972).

The first step in reviewing a facial challenge to a law's overbreadth requires this Court to construe the statute to determine whether the enactment reaches a substantial amount of constitutionally protected conduct. *City of Houston*, 482 U.S. at 458–59, 107 S.Ct. 2502 (quoting *Vill. of Hoffman Estates*, 455 U.S. at 494, 102 S.Ct. 1186; *Kolender v. Lawson*, 461 U.S. 352, 359 n. 8, 103 S.Ct. 1855, 75 L.Ed.2d 903 (1983)). In evaluating a facial challenge any limiting construction that an enforcement agency has proffered must be considered. (citing *Grayned v. City of Rockford*, 408 U.S. 104, 110, 92 S.Ct. 2294, 33 L.Ed.2d 222 (1972)). Next, this Court must consider whether the regulation is susceptible to punish speech that is protected by the First Amendment. *Good v. Wilson*, 405 U.S. 518 (1972). The statute must be carefully drawn or be authoritatively construed to punish unprotected speech and not be susceptible applied to protected expression. *Gooding v. Wilson*.

In this case, the statute cannot be read to limit its constitutional effect on protected speech. By its express terms Section 2(a) prohibits a whole category of speech that the First Amendment protects, on the grounds that it may be disparaging. In addition, the Federal Circuit has construed the statute to mean that marks seeking registration under Section 2(a) not be afforded the statutory benefits of registration. *In re McGinley*, 660 F.2d 481, 486 (Cust. & Pat.App., 1981). This Court must accept this construction. If the statute had prohibited disparaging trademarks in connection with the underlying goods, topic, or in connection with an unprotected form of speech, such as fighting words the construction may be limited, and such a limiting construction would save the provision. However, that limit is not present here.

In *Reno v. American Civil Liberties Union*, this Court found that the Communication Decency Act could be saved from the facial overbreadth challenge by severing a term from the statute pursuant to the severability clause. Here, the Lanham Act contains a severability provision which provides that, “If any provision of this Act or the application of such provision to any person or circumstance is held invalid, the remainder of the Act shall not be affected thereby.” §50 (15 U.S.C. § 1051 note). This provision must be utilized to prevent the disparagement prohibition in Section 2(a) from continuing to place a broad sweeping discriminatory burden on speech. It would also allow the remaining mandates in the provision to be upheld.

The unconstitutional mandate set forth in Section 2(a) grants the PTO unbridled discretion to burden constitutionally protected speech. Furthermore, the availability of less restrictive alternatives exist that would readily address Congress' speculative interest in protecting individuals from truly disparaging trademarks. Due to its overbroad application, Section 2(a) cannot withstand strict or intermediate scrutiny, because it is not narrowly tailored to achieve a compelling government interest and because it does not leave open comparable ample alternative channels for communication.

Thus, this Court should affirm the decision of the lower and find that Section 2(a) of the Lanham Act is not narrowly tailored to achieve any speculative interests Congress may have had.

CONCLUSION

For the foregoing reasons, the United States Court of Appeals for the Federal Circuit's decision denying the registration of the trademark, DUMB BLONDE on the grounds that it is disparaging should be reversed, and its decision invalidating the constitutionality of Section 2(a) of the Lanham Act should be affirmed.

Respectfully submitted,

LAW OFFICES OF
MOOT & MOOT, P.C.
101 Argument Drive, Suite 100
HotBench, California 95630

Counsel for Respondent