

Case No. 15-1007

In The
Supreme Court of the United States

UNITED STATES,
Petitioner,

v.

KOURTNEY LUHV,
Respondent.

Appeal from the Order Entered June 6, 2015
In the United States Court of Appeals
For the Federal Circuit

Brief for Petitioner

Questions Presented

- I. Whether the Trademark Trial and Appeal Board erred in rejecting a solo music artist's application to register the trademark DUMB BLONDE as her stage name on the ground that the mark may be disparaging to women within the meaning of Section 2(a) of the Lanham Act.

- II. Whether Section 2(a)'s prohibition on registering marks that may be disparaging violates the United States Constitution.

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Internet Sources

<http://dictionary.reference.com/browse/dumb-blonde> 9

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Statement of Jurisdiction

The judgment of the United States Court of Appeals for the Federal Circuit was entered on June 6, 2015. The petition for writ of certiorari was approved for the October 2015 term. The jurisdiction of this Court is invoked under 28 U.S.C. §1295(a)(4)(B), which states “the United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction of an appeal from a decision of the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office or the Trademark Trial and Appeal Board with respect to applications for registration of marks and other proceedings as provided in section 21 of the Trademark Act of 1946 (15 U.S.C. §1071).”

Statement of the Case

Cases which tend to establish or overturn precedents are often found at the intersection of opposing interests and rights. Where the First Amendment is implicated, the interest is no less than Freedoms guaranteed under the Constitution. The Freedom of Speech is premier among these rights, but its coverage is not absolute. Exceptions to free speech arise out of obscenity, child pornography, speech that incites lawless action, and other limited arenas. As in the case here, limitations on free speech are also borne out of Commercial and Government Speech, and the nuanced application of each has significant impact on an individual's right to register disparaging trademarks under 15 USC §1052, the Lanham Act.

A. Statement of Facts

Respondent Kourtney Luhv is a Grindcore, Neurofunk, and American Folk music artist performing under the stage name "Dumb Blonde."¹ She has used this stage name for the past three years throughout southern California and in various states, performing at concerts and online.² She has garnered a devoted fan base through her live shows, her www.soundpuff.com account, and her www.uTube.com profile.³ Ms. Luhv cites an online following of roughly 140,000 fans, and has most

¹ *In re Kourtney Luhv*, 1337 F.3d 455, 455 (Fed. Cir. 2015).

² *Id.*

³ *Id.* at 456.

recently negotiated a deal to release an extended play format record.⁴ It is this deal which led to the pending action.

Ms. Luhv's record deal, in exchange for a \$2,000,000 advance, required that she register the Dumb Blonde trademark with the United States Patent and Trademark Office (PTO).⁵ The mark, she emphasized, was to be used for the purposes of live performances and product placement.⁶ The Trademark Trial and Appeal Board (TTAB), whose examining attorneys review trademark applications brought before the PTO, does not certify registration of disparaging trademarks.⁷ Having found the Dumb Blonde trademark disparaging to women under Section 2(a) of the Lanham Act, the TTAB denied federal trademark registration to Dumb Blonde.⁸

B. Procedural History

Upon denial of her registration Ms. Luhv brought an appeal before the TTAB, which affirmed the examining attorney's finding that the Dumb Blonde mark "may be disparaging to a substantial composite of the referenced group, namely women who have a blonde hair color."⁹ Ms. Luhv, though, claimed she chose the mark "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

⁴ *Id.*

⁵ *Id.*

⁶ *Id.*

⁷ 15 USCS § 1052.

⁸ *Kourtney Luhv*, 1337 F.3d at 456.

⁹ *Id.*

by all women.”¹⁰ The TTAB, unconvinced by this claim, found that the mark may further “disparage a substantial composite of women because dictionary definitions, numerous articles, and user comments on [her] uTube videos support the fact that women find the phrase ‘dumb blonde’ to be offensive.”¹¹

Ms. Luhv then appealed the TTAB’s decision to the United States Court of Appeals for the Federal Circuit below. In its own analysis the appeals court held that “the mark is likely intended to refer to women who have a blonde hair color” and “the voices of those who do find the phrase ‘dumb blonde’ to be offensive should not be discounted” before looking to an unconstitutionality claim.¹² On the First Amendment claim the below court erroneously found that federal trademark registration is now funded exclusively by private funds and is, therefore, a form of Commercial Speech.¹³ This speech, the court argued, is not tempered by Congress’ spending power and, since no substantial government interest exists in the limitation on the speech, the Lanham Act is unconstitutional.¹⁴

The Solicitor General’s Office, on behalf of the United States and the PTO, now brings this appeal before this court.

Standard of Review

A determination that a mark consists of or comprises matters that may disparage a group of people or their religious beliefs, or bring them into contempt or

¹⁰ *Id.* at 457.

¹¹ *Id.*

¹² *Id.*

¹³ *Id.* at 459.

¹⁴ *Kourtney Luhv*, 1337 F.3d at 460.

disrepute, is a conclusion of law based on underlying factual inquiries.”¹⁵ It has been further held that if a mark has two possible meanings at the first level of the analysis, both meanings proceed to the second level of the analysis where the Board or the reviewing court asks how a substantial composite of the referenced group perceives the mark.¹⁶ In the First Amendment context, this Court applies the doctrine to require *de novo* review of not only questions of law, but of mixed questions of law and fact for the purpose of determining what falls within, and what falls outside, the protections of the First Amendment, “to ensure that the judgment does not constitute a forbidden intrusion on the field of free expression.”¹⁷ Therefore, the standard of review for both questions presented is *de novo* judicial review.

Summary of Argument

To be eligible for registration, a trademark must satisfy the criteria of Section 2(a) of the Lanham Act, 15 USCS § 1052. Section 2(a) provides, in relevant part, that no trademark shall be registered on the Principal Register that “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.”¹⁸

In determining whether a mark “may disparage” persons, the two-part test from *In re Geller* is applied. Under this test the likely meaning of Dumb Blonde

¹⁵ *In re Fox*, 702 F.3d 633, 637 (Fed. Cir. 2012).

¹⁶ *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

¹⁷ *Bose Corp. v. Consumers Union*, 466 U.S. 485, 511 (U.S. 1984).

¹⁸ 15 USCS § 1052.

refers to negative gender stereotypes of women, especially those with blonde hair color, and the use of that meaning leaves no doubt as to the relationship between the disparaging trademark and the substantial composite of women with blonde hair. Per the decision from *In re Heeb*, the intent to use the trademark positively in order to reclaim the term is not relevant to settling whether that term can overcome the disparagement inquiry placed before this court. Use of the Lanham Act to further such intent is an inappropriate means of accomplishing that end.

The question of the Lanham Act's constitutionality turns upon the court's definition of the speech at issue. Because public treasury monies are used in funding some of the PTO's operations, federal trademark registration is most appropriately deemed to be Government Speech under the Spending Power of Congress. This designation as Government Speech allows that "when the Government appropriates public funds to establish a program it is entitled to define the limits of that program," thus confirming the valid limitations on free speech employed in federal trademark registration.¹⁹

Even if the speech is deemed Commercial Speech, though, the Lanham Act satisfies all four prongs of the test in *Central Hudson*.²⁰ Under this test the court should find that the Government possesses a substantial interest in exercising its own right to free speech where the Spending Power is implicated, and the Lanham Act is not more extensive than necessary to serve that interest. Further, because

¹⁹ *Rust v. Sullivan*, 500 U.S. 173, 194 (U.S. 1991).

²⁰ *Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 557, 566 (U.S. 1980).

the Spending Clause permits the Government to place valid limitations on free speech as related to federal trademark registration, application of the unconstitutional conditions clause is inappropriate.

This court should find that (1) the trademark trial and appeal board did not err in rejecting the dumb blonde trademark on the ground that it is disparaging to women under Section 2(a) of the Lanham Act, and (2) The Lanham Act Section 2(a) prohibition on registering marks that may be disparaging does not violate the First Amendment to the United States Constitution.

Argument

- I. **THE TRADEMARK TRIAL AND APPEAL BOARD DID NOT ERR IN REJECTING THE DUMB BLONDE TRADEMARK ON THE GROUND THAT IT IS DISPARAGING TO WOMEN UNDER SECTION 2(A) OF THE LANHAM ACT.**
 - A. **UNDER THE TWO-PART TEST IN *GELLER*, THE LIKELY MEANING OF THE TERM “DUMB BLONDE” IS DISPARAGING TO A SUBSTANTIAL COMPOSITE OF WOMEN WITH BLONDE HAIR.**

The terms “scandalous” and “disparaging” were often used in past legislation interchangeably; however these two terms have very different meanings and address different injuries and classes of potential plaintiffs within the context of the Lanham Act. The Court in *Pro-Football, Inc. v. Harjo* established a bright line distinction which clearly and explicitly indicated that the prohibition of scandalous marks are intended to protect the public as a whole, and the mark is to be evaluated from the perspective of the general public.²¹ By contrast, disparaging marks are

²¹ *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 113 (D.D.C. 2003).

viewed from the perspective of a particular person, group, set, beliefs, institution, or symbol which is allegedly being damaged by the mark.²² As relevant to this matter, it is crucial that the court applies and addresses only the test of disparagement and its definitions for analysis.

The United States District Court for the District of Columbia affirmed the TTAB's definition of "disparage" in its 2003 *Pro-Football, Inc. v. Harjo* opinion.²³ Something is thus disparaging, for the purposes of Section 2(a), when it "may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison." The Missouri and Iowa Supreme Courts both cited Webster's Dictionary in holding that "disparage" means "to lower in esteem or reputation," "to diminish the respect for," "to lower in rank by actions or words," "to speak slightingly of," or "to run down."²⁴ Consequently, by definition, the perceptions of the general public are only partly relevant in determining whether or not a mark is disparaging. Further, because Section 2(a) prohibits disparaging marks that target certain persons, institutions, or beliefs, the perceptions of those implicated in some recognizable manner by the mark are primarily relevant to the determination.²⁵ In this matter, because Respondent's Dumb Blonde trademark primarily implicates women with blonde hair color, the determination of

²² *Id.* at 114.

²³ *Id.* at 124.

²⁴ *McCormack Baron Mgmt. Servs., Inc. v. American Guar. & Liab. Ins. Co.*, 989 S.W.2d 168, 171 (Mo. 1999); *Ottumwa Hous. Auth. v. State Farm Fire & Casualty Co.*, 495 N.W.2d 723, 728 (Iowa 1993).

²⁵ 15 USCS § 1052.

disparagement must be made from the perspective of women, especially those with blonde hair color.

The United States Court of Appeals for the Federal Circuit, in its *In re Geller* opinion, adopted a two-part legal analysis for a Section 2(a) refusal based on disparagement:

(1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and

(2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.²⁶

1. The Term “Dumb Blonde” Refers to Negative Stereotypes of Women, Especially Those With Blonde Hair Color.

To determine if a trademark is disparaging, the first consideration is “the likely meaning of the matter in question.”²⁷ The TTAB found that the phrase “dumb blonde” implies “a negative, stereotypical view of women,” and “supports the fact

²⁶ *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) (citing *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2D (BNA) 1215, 1217 (Trademark Trial & App. Bd. Mar. 4, 2010)).

²⁷ *Geller*, 751 F.3d at 1358.

that the mark... indeed refers to women, in particular women who have a blonde hair color.”²⁸

In beginning its analysis, the United States Court of Appeals for the Federal Circuit’s *In re Boulevard* opinion looked to the dictionary definitions of “jack off” when examining its potentially vulgar nature. That court noted “dictionary definitions represent an effort to distill the collective understanding of the community with respect to language and thus clearly constitute more than a reflection of the individual views of either the examining attorney or the dictionary editors.”²⁹

The analysis, then, starts with the most accessible dictionary, Dictionary.com, where “dumb blonde” is defined as “a pretty but rather stupid blonde young woman; bimbo, dumb bunny, dumb dora.”³⁰ According to the Oxford Dictionaries, a “dumb blonde” is “a blond-haired woman perceived in a stereotypical way as being attractive but unintelligent.”³¹ The Macmillan Dictionary defines the term as being “an insulting word for a woman with blonde hair who is considered to be sexually attractive but not very intelligent.”³²

Even the group-moderated site UrbanDictionary.com, which accepts popular-culture terms and phrases added by anonymous users from all over the world,

²⁸ *Kourtney Luhv*, 1337 F.3d at 457.

²⁹ *In re Blvd. Entm’t*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

³⁰ <http://dictionary.reference.com/browse/dumb-blonde> (last visited October 20, 2015).

³¹ http://www.oxforddictionaries.com/us/definition/american_english/dumb-blonde (last visited October 20, 2015).

³² <http://www.macmillandictionary.com/us/dictionary/british/dumb-blonde> (last visited October 20, 2015).

recognized “dumb blonde” as meaning “essentially blonde with the addition of ‘dumb’ for clarification.”³³ The site publishes various proposed meanings for terms and asks users in search of the term to either give a positive or negative rating of the definition. Among other accepted definitions for “dumb blonde” are “a person who cant [sic] really do anything right” and “a blonde who is dumb (in other words, a blonde). Also see: ‘Redundant.’”³⁴ These definitions, from textbook sources to the freely-defined internet, indicate that the meaning of “dumb blonde” is overwhelmingly, and without exception, disparaging to the general intelligence level of women with blonde hair color.

In identifying the likely meaning of the Dumb Blonde trademark under the first prong of the two-part test, it is clear and undisputed that the mark, as used by Respondent on her goods and services, refers to negative gender stereotypes of women, especially those with blonde hair color.

2. The Term “Dumb Blonde” is Disparaging to a Substantial Composite of Women With Blonde Hair Color

Once the meaning of the mark is found to refer to identifiable persons, institutions, beliefs, or national symbols, the second prong takes into account whether that meaning may be disparaging to a substantial composite of the referenced group. In analyzing the second prong, the TTAB follows the precedents

³³ <http://www.urbandictionary.com/define.php?term=Dumb+Blonde> (last visited October 20, 2015).

³⁴ *Id.*

set forth in *In Re McGinley*, *In Re Tinseltown*, and *Greyhound Corp.*³⁵ The process of such analyses requires scrutiny of Respondent's Dumb Blonde trademark as it relates to Respondent's clothing, goods, and entertainment services, thereby determining whether it is disparaging to a substantial composite of the its targeted community.

The *McGinley* court addresses the second prong in the refusal to register a trademark consisting of a “photograph of a nude man and woman kissing and embracing in a manner appears to expose the male genitalia” for a sexually-oriented newsletter and social club services.³⁶ In looking at the manner in which the mark was used in the marketplace, the court held that the TTAB appropriately denied the registration of the mark because the unrestricted description of the goods and services contained in the application made possible the mark's exposure to virtually the entire populace.³⁷ Thus, the court in *McGinley* set forth that the exposure and accessibility of disparaging marks in the marketplace are relevant to the trademark's ability to be registered.

The TTAB's *In re Tinseltown* decision found that, in the context of the marketplace as applied to “accessories of a personal nature, and wearing apparel, namely: attaché cases, handbags, purses, belts, and wallets,” the mark BULLSHIT

³⁵ *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981); *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863 (Trademark Trial & App. Bd. Dec. 9, 1981); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2D (BNA) 1635 (Trademark Trial & App. Bd. Mar. 30, 1988).

³⁶ *McGinley*, 660 F.2d at 482.

³⁷ *Id.* at 483.

was offensive to a substantial composite of the general public under Section 2(a).³⁸ The Board, in keeping with the court in *McGinley*, concluded that the term would be perceived by a substantial majority of the public as profane and, thus, the term was prohibited as outlined in Section 2(a).³⁹

In keeping with these precedents the TTAB in *Greyhound Corporation v. Both Worlds, Inc.* denied the attempt to register a shirt design mark consisting of a defecating dog on Section 2(a) grounds.⁴⁰ The Board emphasized that “the determination of [the mark] . . . must be made in the context of the marketplace for the goods identified in the application, and must be ascertained from the standpoint of not necessarily a majority, but a substantial composite.”⁴¹

Respondent’s present case is similar in that the goods in question here are clothing, namely: sweatshirts, t-shirts, tank tops, and headwear. These are goods that have been presented and evidenced by the referenced cases which may be encountered in sales establishments frequented by people of all ages, beliefs, associations, and convictions.⁴² Further, these clothing goods may be worn or understood by people in practically all public places, which may expose such disparaging marks to the targeted groups offended by them.

Looking specifically to the broad potential audience that may view Respondent's trademark, it is certainly evident that a substantial composite of the

³⁸ *Tinseltown*, 212 U.S.P.Q. (BNA) at 866.

³⁹ *Id.*

⁴⁰ *Greyhound Corp*, 6 U.S.P.Q.2D (BNA) at 1639.

⁴¹ *Id.*

⁴² *McGinley*, 660 F.2d at 486.

general public would be exposed to the term “Dumb Blonde” as it pertains to the merchandising and distribution of clothing. More applicable to this matter, the Dumb Blonde trademark would be exposed to women with blonde hair color. However, this is not the only marketplace-type arena that is taken under consideration. Respondent in the present matter also showcases the Dumb Blonde trademark on her website in combination with images of other women with blonde hair color. Respondent additionally displays banners in conjunction with her performances, leaving no doubt as to the relationship between the disparaging trademark and women with blonde hair color.

B. EVIDENCE OF LIMITED POSITIVE REACTION TO THE DUMB BLONDE TRADEMARK IS INSUFFICIENT TO NEGATE THE DISPARAGEMENT IMPLICIT IN ITS USE AGAINST BLONDE WOMEN.

If the likely meaning of the mark “is found to refer to identifiable persons, institutions, beliefs or national symbols,” we next consider “whether that meaning may be disparaging to a substantial composite of the referenced group.”⁴³ Respondent's principal argument against the Section 2(a) registration refusal is that that women from the her fan base, and women familiar with her musical performances, understand a different and more positive meaning for the term “Dumb Blonde”. Respondent proposes three examples in support of her assertion. Despite Respondent’s intentions, though, the reasoning given in support of the arguments does not prove contrary to the fact that a substantial composite of the community of women with blonde hair color still finds the term to be disparaging.

⁴³ *Geller*, 751 F.3d at 1360.

1. A Fan Base Comprised of 20-30 Year Old Men and Women With An Assortment of Different Hair Colors Does Not Adequately Represent The Substantial Composite of the Group Being Disparaged by the Term “Dumb Blonde.”

The language of the Lanham Act Section 2(a) calls for refusal of registration when a trademark disparages a substantial composite of the targeted group.⁴⁴ The bar on disparagement is specific in that “there is a particular object of disparagement, i.e., a person, group, set of beliefs, institution or symbol, and the statutory bar depends on the perspective of the object of disparagement.”⁴⁵ The views of a random sampling of the general population do not speak to this perspective.⁴⁶ Therefore, the statutory language indicates that Respondent’s offer of proof of a diverse fan base composition is irrelevant to a Section 2(a) analysis.

2. The Substantial Composite of Women With Blonde Hair is not Arbitrarily Represented by the Percentage of Females at a Music Concert.

As expressed in various dictionaries, the term “dumb blonde” is consistently defined by its plain language and associated inferences to include exclusively women with blonde hair color, rather than the general population of women as a whole. Respondent offers as proof that a majority of her performance attendees are women in an attempt to show that a substantial composite of the community does not consider “dumb blonde” to be disparaging, but in fact supportive.⁴⁷ This

⁴⁴ 15 USCS § 1052.

⁴⁵ *Lebanese Arak Corp.*, 94 U.S.P.Q.2D (BNA) at 1217.

⁴⁶ *Lipton Indus. v. Ralston Purina Co.*, 670 F.2d 1024, 1028 (C.C.P.A. 1982).

⁴⁷ *Kourtney Luhn*, 1337 F.3d at 457.

argument is *non sequitur*. The TTAB's *In re Lebanese Arak Corporation* opinion held the support of the larger encompassing group is not sufficient in representing the particular group against which the disparagement is being targeted.⁴⁸ Therefore, Respondent's evidence that the general population of the patrons supporting her music performances disproves the claim of disparagement against blonde women does not weigh in on the statutory analysis.

3. Random Samplings of Social Media Commentary Does Not Adequately Represent The Substantial Composite of the Group Being Disparaged by the Term "Dumb Blonde."

The United States Court of Appeals for the Federal Circuit below notes three examples of statements cited by Respondent to illustrate that women who are familiar with her musical performances infer a different, more positive meaning for the Dumb Blonde trademark.⁴⁹ Such statements include "Your ability to bring attention to the challenges faced by women is inspiring," "There need to be more women like you serving as positive role models for young girls rather than grinding on Robert Thin!" and "[A]s a blonde woman I totally support you even if the haters gon' hate."⁵⁰

As noted, the Section 2(a) analysis does not consider an unaccounted-for sample of positive commentary referencing Respondent's music sufficient to represent the substantial composite of the community of women with blonde hair color. These comments, although positive and supportive of Respondent's music, fail

⁴⁸ *Lebanese Arak Corp.*, 94 U.S.P.Q.2D (BNA) at 1217.

⁴⁹ *Kourtney Luhv*, 1337 F.3d at 458.

⁵⁰ *Id.*

to demonstrate that the substantial composite of the targeted community to which the Dumb Blonde trademark refers would not find the mark to be disparaging.

The first comment suggests that Respondent sheds light on challenges faced by women as a whole, a group which fails to narrowly represent the targeted community of women with blonde hair color. This principle was affirmed in *Pro-Football v. Harjo*, where the District Court, “in deciding whether the matter may be disparaging, [looked] not to American society as a whole... but to the views of the referenced group.”⁵¹ The *Harjo* court held that the views of the general public were not probative, and inferring that a substantial composite of the community being disparaged by the mark would simply agree with those views would be an error.⁵² In the present case, Respondent argues that where the general population of women find her music to be inspiring, this somehow proves that women of blonde hair color do not find the term “dumb blonde” to be disparaging. The distinction is clear from the court’s two-part test, and the explanation in *Harjo*, that the opinion of those not targeted by the disparaging mark are not appropriate to determining whether a mark is disparaging to the targeted group.

The second comment suggests that Respondent serves as a positive role model. Although this is optimistic, it again does not address the substantial composite of women with blonde hair color being disparaged by the term “dumb

⁵¹ *Harjo*, 284 F. Supp. 2d at 124.

⁵² *Id.* at 128.

blonde,” and thus is not probative to the determination of whether the term is disparaging.⁵³

Respondent’s third comment is the only offer of proof that does not deviate from the two-part analysis, however its probative value is more detrimental to Respondent’s argument than favorable. This comment does address the group targeted by the mark’s disparagement, but by no means is this a representation of the substantial composite of this group. The District Court’s *Harjo* decision explained that “the views of the referenced group... are ‘reasonably determined by the views of a substantial composite thereof.’”⁵⁴ The court added that “a substantial composite of the referenced group is not necessarily a majority.”⁵⁵

This cherry-picked comment is representative of how the majority of blonde-haired women perceive the term “dumb blonde,” and confirms its disparaging effect. By promoting the assumption that a small subset of the “blog-commenting” community of women with blonde hair does not consider the Dumb Blonde trademark to be disparaging, Respondent side-steps the very issue of whether the substantial composite of the community is disparaged by the term. The comment in particular makes clear that there is, indeed, a substantial composite of the community of women with blonde hair that finds this term disparaging, referred to here as “haters.”

⁵³ *Id.*

⁵⁴ *Id.* at 124.

⁵⁵ *Id.*

In determining whether a mark is disparaging, the perceptions of the general public are irrelevant. Rather, because the portion of Section 2(a) proscribing disparaging marks targets certain persons, institutions or beliefs, only the perceptions of those referred to, identified or implicated in some recognizable manner by the involved mark are relevant to this determination. From the combination of Section 2(a) precedent, court rationales, and the sample of comments provided by Respondent, it is evident that Respondent's suggestion the term “dumb blonde” has been reclaimed with a “more positive meaning” acknowledged by the community of women with blonde hair is insufficient to defend the disparagement analysis here.

C. THE INTENT TO TRANSVALUE THE TERM “DUMB BLONDE” IS NOT RELEVANT TO THE DISPARAGEMENT INQUIRY UNDER SECTION 2(A).

Respondent’s comparison of the facts here to the United States Court of Appeals for the Federal Circuit’s decision in *McDermott v. San Francisco Women's Motorcycle Contingent* is in error.⁵⁶ There the application to register the trademark DYKES ON BIKES was initially “refused under 15 USCS § 1052(a) on the basis that the word ‘dyke’ was disparaging to lesbians.”⁵⁷ Upon request of both a reexamination and a reconsideration of the application, Applicants were able to submit overwhelming evidence that contributed to the reversal of registration

⁵⁶ *McDermott v. San Francisco Women's Motorcycle Contingent*, 240 Fed. Appx. 865 (Fed. Cir. 2007).

⁵⁷ *Id.* at 866.

refusal.⁵⁸ To thoroughly show that the term “dyke” was not disparaging to the lesbian community, the SFWMC provided additional evidence in the form of declarations from academic and linguistic experts, evidence of the positive use of “dyke” in publications and websites, a list of other reappropriated slurs approved by the USPTO, and even a videotape of a Dykes on Bikes pride rally, highlighting the positive response of those in attendance.⁵⁹

There are several material dissimilarities between the reversal in *SFWMC* and the one sought by Respondent. Here Respondent asserts that hundreds of thousands of female fans have attended her concerts and have positively received photographic images on her website featuring a blonde woman depicted as the president of the United States. She thus contends that these circumstances are equivalent to those of *San Francisco Women’s Motorcycle Contingent*.⁶⁰ This association holds no merit. All evidence that SFWMC submitted was founded upon and entered by members of the lesbian community,⁶¹ whereas Respondent’s evidence does not even specify the percentage of her female fans that fall within the community of women with blonde hair. Further, Respondent fails to provide any evidence, besides that which is found relating directly to her music, of the targeted community’s positive use of the term “dumb blonde” in any publications, websites,

⁵⁸ *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 U.S.P.Q.2D (BNA) 1212 (Trademark Trial & App. Bd. Sept. 13, 2006).

⁵⁹ U.S. Trademark Application Serial No. 78/281,746, Applicant’s Request to Remand for Additional Evidence, Exhibit A, Sept. 15, 2005.

⁶⁰ *Kourtney Luhv*, 1337 F.3d at 458.

⁶¹ U.S. Trademark Application Serial No. 78/281,746, Paper Correspondence Incoming, Aug. 23, 2004 (Declaration of Soni S.H.S. Wolf).

or academic declarations. The only positive implications of “dumb blonde” are founded upon bloggers and attendees of concerts that, if they account for a portion of the targeted community, by no means represent a substantial composite of the targeted community. Because Respondent’s evidence is not to the caliber or specificity of *SFWMC*, her comparison is not analogous to that of *SFWMC* for purposes of obtaining a reversal of registration refusal.

Respondent’s claim is more appropriately akin to *In re Heeb*.⁶² The TTAB’s *In re Heeb* decision refused a media company’s application to register the word “heeb” because it “is a highly disparaging reference to Jewish people and that a substantial composite of the referenced group finds it to be disparaging.”⁶³ Although the main focus of *In Re Heeb* was the issue of the “substantial composite” versus the “majority” in respect to applicant’s evidence and evidence obtained by the TTAB, the Board also addressed applicant’s intent to “to transvalue the term ‘heeb’ from an epithet into a term of Jewish empowerment.”⁶⁴ The Board in *Heeb* speaks to the applicant’s intent by stating “the fact that applicant has good intentions with its use of the term does not obviate the fact that a substantial composite of the referenced group find the term objectionable.”⁶⁵ The Board further noted that “while applicant may intend to transform this word, the best that can be said is that it is still in transition,” which implies that in the future, once it has lost its generally-offensive

⁶² *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (Trademark Tr. & App. Bd.).

⁶³ *Id.* at 1072.

⁶⁴ *Id.* at 1074.

⁶⁵ *Id.* at 1079.

power, the term might suitable for registration.⁶⁶ Respondent here is similar situated to the applicant in *Heeb*, in the sense that the disparaging terms are still fresh in their transition to being reclaimed. Further, the composite of the communities denying disparagement by the terms “Heeb” and “Dumb Blonde” is miniscule in comparison to the substantial composite of the targeted communities.

II. THE LANHAM ACT SECTION 2(A) PROHIBITION ON REGISTERING MARKS THAT MAY BE DISPARAGING DOES NOT VIOLATE THE FIRST AMENDMENT TO THE UNITED STATES CONSTITUTION.

A. THE GOVERNMENT’S REFUSAL TO REGISTER A TRADEMARK DOES NOT FORECLOSE IT’S COMMERCIAL USE, AND THUS DOES NOT SUPPRESS THE FREE SPEECH GUARANTEED UNDER THE FIRST AMENDMENT.

The United States Court of Customs and Patent Appeals established the prototype for Lanham Act Section 2(a) analyses in its *In re McGinley* decision when looking to the refused registration of “immoral... or scandalous matter.”⁶⁷ Appellant there sought to register a trademark comprising “a photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia.”⁶⁸ This photograph, when used as a mark *per se*, would not be registerable because “applicant’s photograph... is offensive to propriety and morality, outrages a sense of decency, and is shocking to the moral sense of members of the community, whose sensibilities are protected by the statute.”⁶⁹ The court held, though, that this

⁶⁶ *Id.*

⁶⁷ *McGinley*, 660 F.2d at 481.

⁶⁸ *Id.* at 482.

⁶⁹ *Id.* at 483.

refusal to register the trademark is not “an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.”⁷⁰ This conclusion, the court opined, is justified in that “no conduct is proscribed” by refusal to register the trademark, “and no tangible form of expression is suppressed.”⁷¹ “The PTO’s refusal to register appellant’s mark does not affect his right to use it.”⁷²

This conclusion that Respondent may continue to use her mark in commerce despite refused registration is supported by a wide body of case law, and was recently affirmed by the United States Court of Appeals for the Federal Circuit’s 2012 *In re Fox* decision.⁷³ There the court looked to the registration application for Cock-Sucker as it related to the sale of “chocolate suckers molded in the shape of a rooster” targeted at fans of athletic teams using gamecocks as their athletic mascots.⁷⁴ The court recognized the “possibility of [a] double entendre,” but held the PTO is not “required to prove anything more than the existence of a vulgar meaning to a substantial composite of the general public in order to justify its refusal.”⁷⁵ In upholding the PTO’s decision, the Federal Circuit emphasized that “nothing in this decision precludes [appellant] from continuing to sell her merchandise under the

⁷⁰ *Id.* at 486.

⁷¹ *Id.* at 484.

⁷² *Id.*

⁷³ *Fox*, 702 F.3d at 633.

⁷⁴ *Id.* at 635.

⁷⁵ *Id.* at 638.

mark at issue.”⁷⁶ “She will be unable, however, to call upon the resources of the federal government in order to enforce that mark.”⁷⁷

In the matter here the facts show that Respondent “has been performing under the Dumb Blonde name since 2012,” and that she “has grown a devoted fan base who frequently attends her concerts, as well as a sizeable number of online users who follow her music.”⁷⁸ None of these activities are foreclosed by the PTO’s refusal to register her trademark, and Respondent may continue to perform at concerts and online as she has been doing. In fact, Respondent did not even seek trademark registration until it was placed as a requirement in a multi-million dollar deal that she hoped to sign. Even this potential contract is outside the realm of the First Amendment, as it addresses only the right to contract between Respondent and her record label. The Government has not taken the position that Respondent may not enter into this contract, merely that Respondent may not receive the benefits of registering her disparaging trademark with the PTO. Respondent is free to continue all of her commercial endeavors under her trademark, including creating her music, spreading her message, and recording extended play format records, despite any holding of the TTAB and the PTO. Because Respondent’s commercial use of the trademark is not foreclosed by the PTO’s refusal of its registration, her freedom of speech, as guaranteed under the First Amendment, is not suppressed.

⁷⁶ *Id.* at 639.

⁷⁷ *Id.* at 640.

⁷⁸ *Kourtney Luvh*, 1337 F.3d at 455.

B. FEDERAL TRADEMARK REGISTRATION DOES NOT IMPLICATE THE FIRST AMENDMENT AND IS WHOLLY SUBJECT TO THE GOVERNMENT’S AUTHORITY AND DISCRETION.

1. Registration of the Dumb Blonde Trademark Goes Beyond the Scope of Commercial Speech.

This court held in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council* that Commercial Speech is speech that does “no more than propose a commercial transaction.”⁷⁹ The court analyzed a Virginia state law that prohibited the advertising, “in any manner whatsoever, any amount, price, fee, premium, discount, rebate or credit terms... for any drugs which may be dispensed only by prescription.”⁸⁰ In coming to its decision, the court noted that “the allocation of our resources in large measure will be made through numerous private economic decisions. It is a matter of public interest that those decisions, in the aggregate, be intelligent and well informed.”⁸¹ These private economic decisions, though, relate to the general public interest in commercial advertising of products on the open market. The court cited, as examples, the advertising for sale of abortion referral services,⁸² artificial furs,⁸³ and domestically made products.⁸⁴ All of these examples, including the advertising of prescription drug prices central to the case, are deemed

⁷⁹ *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748, 763 (U.S. 1976) (*Pittsburgh Press Co. v. Pittsburgh Com. on Human Relations*, 413 U.S. 376 (U.S. 1973)).

⁸⁰ *Virginia State Bd.*, 425 U.S. at 751.

⁸¹ *Id.* at 766.

⁸² see *Bigelow v. Virginia*, 421 U.S. 809 (U.S. 1975).

⁸³ see *Fur Info. & Fashion Council, Inc. v. E. F. Timme & Son, Inc.*, 364 F. Supp. 16 (S.D.N.Y. 1973).

⁸⁴ see *Chicago Joint Board, etc. v. Chicago Tribune Co.*, 435 F.2d 470 (7th Cir. Ill. 1970).

Commercial Speech because they relate to the advertising of a product for sale by its seller, and not to the name by which the seller intends to sell his products.

Such an understanding of the activities that define Commercial Speech was reinforced by this court in *United States v. United Foods* when noting that a statute compelling mushroom grower contributions to generic mushroom advertising, with which they disagreed, is in violation of the First Amendment.⁸⁵ In coming to its decision the court cited examples of compelled contribution to advertising by fruit growers⁸⁶ and licensed attorneys,⁸⁷ finding that these precedents were appropriate since “the speech is in aid of a commercial purpose.”⁸⁸ Such selections further emphasize the “advertising of a product for sale” nature of Commercial Speech, as opposed to the identification of a seller of a product.

This court added to the *United Foods* precedent in its 2014 *Harris v. Quinn* decision when looking to whether a state can compel personal care providers to subsidize speech on matters of public concern by a union that they do not wish to join or support.⁸⁹ The court held “it is apparent that the speech compelled in this case is not Commercial Speech. Our precedents define Commercial Speech as ‘speech that does no more than propose a commercial transaction,’... and the union speech in question in this case does much more than that.”⁹⁰ That union speech, the

⁸⁵ *United States v. United Foods*, 533 U.S. 405, 408-409 (U.S. 2001).

⁸⁶ see *Glickman v. Wileman Bros. & Elliott*, 521 U.S. 457 (U.S. 1997).

⁸⁷ see *Zauderer v. Office of Disciplinary Counsel of Supreme Court*, 471 U.S. 626 (U.S. 1985).

⁸⁸ *United Foods*, 533 U.S. at 410.

⁸⁹ *Harris v. Quinn*, 134 S. Ct. 2618, 2623 (U.S. 2014).

⁹⁰ *Id.* at 2639.

court summarized, allowed the union to speak on behalf of personal assistants who “cannot effectively voice their concerns about the organization of the Home Services program, their role in the program, or the terms and conditions of their employment under the Program.”⁹¹ This extended role of the speech, beyond just the proposal of commercial transactions, carried it beyond the definition of Commercial Speech.

To deem registration of the trademark Dumb Blonde as Commercial Speech is to find that its sole purpose as a trademark is to “propose a commercial transaction” through the advertising of products or services. By Respondent’s own admission the use of Dumb Blonde is intended “to reclaim the stereotype associated with blonde women and raise awareness of the challenges stemming from gender discrimination and negative stereotypes of women.”⁹² Further, the Government’s publishing of the trademark on its Principal Register, were it to be deemed Commercial Speech, would amount to the Government’s advertising of the Dumb Blonde product in the marketplace. Because the trademark itself is not proposing a commercial transaction and, actually, goes beyond the purpose of a commercial transaction, and because the Government does not propose commercial transactions through its use of the Principal Register, registration of a trademark is not Commercial Speech.

⁹¹ *Id.* at 2627.

⁹² *Kourtney Luvv*, 1337 F.3d at 457.

2. Federal Trademark Registration Is a Form of Government Speech and Falls Outside of First Amendment Limitations.

This court established the test for determining whether federal trademark registration is a form of Government Speech in its 2015 *Walker v. Texas Division, Sons of Confederate Veterans, Inc.* opinion.⁹³ In analyzing the rejection of a proposed Texas specialty license plate, this court held that (1) specialty license plates have long communicated messages from the States, (2) the public closely associates state license plate designs with the state, and (3) Texas maintains final approval authority over how to present itself and its constituency.⁹⁴ The holding of this court in *Walker* finally reversed the Fifth Circuit’s holding that the specialty license plate designs were private speech and that the state had engaged in constitutionally forbidden viewpoint discrimination.⁹⁵

The first *Walker* element looks to whether the trademark registration program communicates a message that the federal government has approved the trademark. There the court cited various messages that Texas chose to communicate on their plates, including “Centennial,” “150 Years of Statehood,” “Read to Succeed,” “Texans Conquer Cancer,” and “Girl Scouts,” as official speech by the state.⁹⁶ Congress codified in 15 USCS §1127 that any “person,” for the purposes of the Trademark Chapter of Title 15, shall include “any agency or instrumentality

⁹³ *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (U.S. 2015).

⁹⁴ *Id.* at 2242.

⁹⁵ *Id.* at 2245.

⁹⁶ *Id.* at 2248.

thereof, or any individual, firm, or corporation acting for the United States and with the authorization and consent of the United States.”⁹⁷ The purpose of this section is to give notice that the PTO and the TTAB speak on behalf of the government, and that their actions carry the approval of the legislature.

The second *Walker* element questions whether the public closely associates trademark registration with the federal government. In *Walker* this court noted that “a person who displays a message on a Texas license plate likely intends to convey to the public that the State has endorsed that message. If not, the individual could simply display the message in question in larger letters on a bumper sticker right next to the plate. But the individual prefers a license plate design to the purely private speech expressed through bumper stickers.”⁹⁸ Similarly, 15 USCS §1111 grants use of the registered trademark symbol, ®, only to “a registrant of a mark registered in the Patent Office,” and adds that “in any suit for infringement under this Act by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this Act unless the defendant had actual notice of the registration.”⁹⁹ The registered trademark symbol clearly denotes that the legal benefits of registration have been conferred upon that trademark by the federal government, as opposed to the unregistered trademark symbol, ™, which carries with it no such implication.

⁹⁷ 15 USCS § 1127.

⁹⁸ *Walker*, 135 S. Ct. at 2249.

⁹⁹ 15 USCS § 1111.

The final *Walker* element concerns itself with the federal government’s control over the trademarks presented in the Principal Register. *Walker*’s analysis observed that the state “has sole control over the design, typeface, color, and alphanumeric pattern for all license plates,” and that “the Board must approve every specialty plate design proposal before the design can appear on a Texas plate.”¹⁰⁰ The statute central to the issue here, the Lanham Act as codified in 15 USCS §1052, outlines the elements by which federal trademark registration may be approved, canceled, or denied to a trademark owner. Included among the prohibited marks is any that “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,” clarifying that the government intends to and does control which trademarks it approves.¹⁰¹ Speech that satisfies the three elements of the *Walker* test is appropriately deemed Government Speech.

This court charted the limits of Government Speech in its *Rust v. Sullivan* analysis. There Petitioner brought an action challenging the conditions placed on federal funds appropriated under Title X for family-planning services. The *Rust* court held that physicians could not engage in abortion advocacy through Title X-funded projects since, “when the Government appropriates public funds to establish a program it is entitled to define the limits of that program.”¹⁰² “The Government

¹⁰⁰ *Walker*, 135 S. Ct. at 2249.

¹⁰¹ 15 USCS § 1052.

¹⁰² *Rust*, 500 U.S. at 194.

can, without violating the Constitution, selectively fund a program to encourage certain activities it believes to be in the public interest.”¹⁰³ Because federal trademark registration communicates government approval of trademarks, is closely associated with government activities and benefits, and is exclusively controlled by the government it is most appropriately deemed Government Speech and is not subject to First Amendment limitations.

C. EVEN AS COMMERCIAL SPEECH THE FEDERAL TRADEMARK REGISTRATION PROGRAM SATISFIES THE TEST PUT FORTH IN *CENTRAL HUDSON*.

1. Trademark Registration Implicates Congress’ Spending Power, Satisfying the Inquiry Into a Substantial Government Interest.

The United States Court of Appeals for the Federal Circuit held in its below opinion that Respondent’s “trademark constitutes protected Commercial Speech.”¹⁰⁴ Assuming *arguendo* that this court should deem federal trademark registration as Commercial Speech, the four-prong test laid out in *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York* applies:

1. Does the speech concern illegal activity or is it misleading; if not,
2. Is the asserted governmental interest substantial; if so,
3. Does the regulation directly advance the interest; and, if so,
4. Is the regulation more extensive than necessary to serve that interest?¹⁰⁵

¹⁰³ *Id.* at 193.

¹⁰⁴ *Kourtney Luvv*, 1337 F.3d at 459.

¹⁰⁵ *Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 566 (U.S. 1980).

“Because there is nothing illegal about a disparaging trademark,” the court below found that the first prong of the test is satisfied.¹⁰⁶

The second prong requires that a substantial government interest in the limiting of Commercial Speech exist independent of simply disapproving that speech’s message. The court below noted this court’s ruling in *Bolger v. Young Drug Products Corp.* where “the fact that protected speech may be offensive to some does not justify its suppression.”¹⁰⁷ The *Bolger* case concerned itself with a statute that prohibited “the mailing of unsolicited advertisements for contraceptives.”¹⁰⁸ This court determined that these mailings fell “within the core notion of Commercial Speech”¹⁰⁹ and found that the first claimed government interest, that the statute “shields recipients of mail from materials that they are likely to find offensive,” carried little weight.¹¹⁰ Applying this analysis to the matter here, the *Central Hudson* test would appear to defeat the government’s claim. This court in *Bolger* also considered the second claimed interest in “aiding parent’s efforts to discuss birth control with their children.”¹¹¹ This interest was deemed to be “undoubtedly substantial,”¹¹² though it failed because the “sweeping prohibition on the mailing of

¹⁰⁶ *Kourtney Luvh*, 1337 F.3d at 460.

¹⁰⁷ *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71 (U.S. 1983).

¹⁰⁸ *Id.* at 61.

¹⁰⁹ *Id.* at 66.

¹¹⁰ *Id.* at 71.

¹¹¹ *Id.* at 73.

¹¹² *Id.*

unsolicited contraceptive advertisements,” was judged more extensive than necessary to serve the substantial interest.¹¹³

In the matter here the government’s substantial interest in federal trademark registration arises through its Spending Power. The court below held that “although the trademark registration process has previously been funded by the federal treasury, it has since become funded through trademark owners’ registration fees rather than by taxpayers.¹¹⁴ The court adds that “while some federal funds may be used for the enforcement of trademarks... enforcement related spending is attenuated from the benefits provided to applicants through trademark registration.”¹¹⁵ This conclusion is in error.

The United States Court of Appeals for the Federal Circuit in *Figueroa v. United States*, in analyzing the use of patent application fees, found that “PTO employee benefits, including pensions, health insurance, and life insurance” have been funded from the general treasury.¹¹⁶ These costs are substantial, “averaging in excess of \$27.5 million per year for FYs 1999 through 2003. In addition, costs of executive oversight for the PTO and other aspects of the patent system by the Commerce Department are not included in the PTO appropriation.”¹¹⁷ Finally, “the costs of operating the federal court system, which provides a forum for resolving

¹¹³ *Bolger*, 463 U.S. at 76.

¹¹⁴ *Kourtney Luvh*, 1337 F.3d at 459 (citing *Figueroa v. United States*, 466 F.3d 1023 (Fed. Cir. 2006)).

¹¹⁵ *Kourtney Luvh*, 1337 F.3d at 459 -460.

¹¹⁶ *Figueroa*, 466 F.3d at 1028.

¹¹⁷ *Id.* at 1032.

patent disputes, both on appeals from PTO actions and in private infringement litigation,” arise from taxpayer funding.¹¹⁸

The United States Court of Customs and Patent Appeals in its *In re McGinley* opinion noted that “once a registration is granted, the responsibilities of the government with respect to a mark are not ended. The benefits of registration, in part with government assistance, include public notice of the mark in an official government publication and in official records which are distributed throughout the world, maintenance of permanent public records concerning the mark, availability of the Customs Service for blocking importation of infringing goods, access to federal courts where there is a presumption of validity of the registration (e.g., that the mark is not immoral or scandalous), notices to the registrant concerning maintenance of the registration, and, to some extent, direct government protection of the mark in that the PTO searches its records and refuses registrations to others of conflicting marks. Apart from nominal fees, these costs are underwritten by public funds.”¹¹⁹

Such spending is not, as the lower court held, “attenuated from the benefits provided to applicants through trademark registration,”¹²⁰ and, in fact, implicates Congress’ Spending Power of federal trademark registration. Where the Spending

¹¹⁸ *Id.*

¹¹⁹ *McGinley*, 660 F.2d at 486.

¹²⁰ *Kourtney Luvv*, 1337 F.3d at 459 -460.

Power has been implicated, the government possesses a substantial interest in determining which “marks not be afforded the statutory benefits of registration.”¹²¹

The third prong of the *Central Hudson* test asks if the regulation directly advances the government’s substantial interest. Decisions whether to certify a trademark for registration are not “an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.”¹²² This bearing of the regulation to trademark registration is sufficient to satisfy the third prong of *Central Hudson*.

Under the fourth prong the regulation must not be more extensive than necessary to serve the interest. Here the Lanham Act elucidates which trademarks may benefit from government spending related to federal trademark registration. The regulation is not a broad-sweeping prohibition on all trademarks, similar to the ban in *Bolger*,¹²³ but is narrowly-tailored to specify both the requirements for trademarks seeking government benefits and the benefits afforded to compliant trademarks. This narrow-tailoring of the regulation to trademark registration is sufficient to satisfy the fourth prong of *Central Hudson*.

2. Trademark Registration Implicates Congress’ Spending Power, Rendering Application of the Unconstitutional Conditions Doctrine Inappropriate.

The United States Court of Appeals for the Federal Circuit held in its below opinion that “the government may not deny a benefit to an individual on a basis

¹²¹ *McGinley*, 660 F.2d at 486.

¹²² *Id.*

¹²³ *Bolger*, 463 U.S. at 71.

that infringes a constitutionally protected interest.”¹²⁴ This court in *Perry v. Sindermann*, when looking at a professor’s termination from a state college, noted that “if the government could deny a benefit to a person because of his constitutionally protected speech or associations, his exercise of those freedoms would in effect be penalized and inhibited... Such interference with constitutional rights is impermissible.”¹²⁵ This court in *Agency for International Development v. Alliance for Open Society International, Inc.* observed that “the Spending Clause... provides Congress broad discretion to tax and spend for the ‘general Welfare,’ including by funding particular state or private programs or activities. That power includes the authority to impose limits on the use of such funds to ensure they are used in the manner Congress intends.”¹²⁶

In seeking to define that power and those limits, the United States Court of Appeals for the Ninth Circuit analyzed a treaty which sought to “facilitate the international circulation of audio-visual materials that are of an ‘educational, scientific and cultural character.” by providing tax and licensing benefits to qualifying exporters.¹²⁷ The court rationalized that the requirements placed on the materials, that they “must be balanced and truthful; must neither criticize nor advocate any political, religious, or economic views; and must not ‘by special pleading’ seek to influence opinion or policy,” directly implicated the First

¹²⁴ *Perry v. Sindermann*, 408 U.S. 593, 597 (U.S. 1972).

¹²⁵ *Id.*

¹²⁶ *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2327-2328 (U.S. 2013).

¹²⁷ *Bullfrog Films, Inc. v. Wick*, 847 F.2d 502, 504 (9th Cir. Cal. 1988).

Amendment.¹²⁸ In its defense the government cited “Congress’ choice under the Spending Power to refuse to use Treasury funds to subsidize” the proscribed activity.¹²⁹ The court explained, though, that the offered trade benefits were not a “subsidy” because “no Treasury Department funds [were] involved and any funds to be paid “would come from the treasuries of the foreign states that agree to waive their customs duties.”¹³⁰

The Ninth Circuit’s opinion is distinguished from the case here. The government, through its funding of federal trademark registration benefits, has implicated its Spending Power, and the application of the unconstitutional conditions doctrine is inappropriate.

Conclusion

To be eligible for registration, a trademark must satisfy the criteria of Section 2(a) of the Lanham Act, 15 USCS § 1052. Section 2(a) provides, in relevant part, that no trademark shall be registered on the Principal Register that “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.”¹³¹

In determining whether a mark “may disparage” persons, the two-part test from *In re Geller* is applied. Under this test the likely meaning of Dumb Blonde refers to negative gender stereotypes of women, especially those with blonde hair

¹²⁸ *Id.* at 510.

¹²⁹ *Id.* at 509.

¹³⁰ *Id.* at 509.

¹³¹ 15 USCS § 1052.

color, and the use of that meaning leaves no doubt as to the relationship between the disparaging trademark and the substantial composite of women with blonde hair. Per the decision from *In re Heeb*, the intent to use the trademark positively in order to reclaim the term is not relevant to settling whether that term can overcome the disparagement inquiry placed before this court. Use of the Lanham Act to further such intent is an inappropriate means of accomplishing that end.

The question of the Lanham Act's constitutionality turns upon the court's definition of the speech at issue. Because public treasury monies are used in funding some of the PTO's operations, federal trademark registration is most appropriately deemed to be Government Speech under the Spending Power of Congress. This designation as Government Speech allows that "when the Government appropriates public funds to establish a program it is entitled to define the limits of that program," thus confirming the valid limitations on free speech employed in federal trademark registration.¹³²

Even if the speech is deemed Commercial Speech, though, the Lanham Act satisfies all four prongs of the test in *Central Hudson*.¹³³ Under this test the court should find that the Government possesses a substantial interest in exercising its own right to free speech where the Spending Power is implicated, and the Lanham Act is not more extensive than necessary to serve that interest. Further, because the Spending Clause permits the Government to place valid limitations on free

¹³² *Rust*, 500 U.S. at 194.

¹³³ *Cent. Hudson*, 447 U.S. at 566.

speech as related to federal trademark registration, application of the unconstitutional conditions clause is inappropriate.

This court should find that (1) the trademark trial and appeal board did not err in rejecting the dumb blonde trademark on the ground that it is disparaging to women under Section 2(a) of the Lanham Act, and (2) The Lanham Act Section 2(a) prohibition on registering marks that may be disparaging does not violate the First Amendment to the United States Constitution.

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Respectfully Submitted,

Team 121

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