

Case No. 15-1007

*In the
Supreme Court of the United
States*

UNITED STATES,
Petitioner,

v.

KOURTNEY LUHV,
Respondent.

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

BRIEF OF RESPONDENT

Team 122
Counsel for RESPONDENT

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 grounds that the mark may be disparaging to a substantial composite of women within the meaning of Section 2(a) of the Lanham Act?

- II. Whether the Court of Appeals for the Federal Circuit properly held that Section 2(a) of the Lanham Act's prohibition on registering trademarks that may disparage is unconstitutional when the trademark is protected as commercial speech, satisfies the unconstitutional conditions doctrine, and is analyzed under the *Central Hudson* four-part framework.

TABLE OF CONTENTS

QUESTIONS PRESENTED..... I

 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 grounds that the mark may be disparaging to a substantial composite of women within the meaning of Section 2(a) of the Lanham Act? i

 II. Whether the Court of Appeals for the Federal Circuit properly held that Section 2(a) of the Lanham Act’s prohibition on registering trademarks that may disparage is unconstitutional when the trademark is protected as commercial speech, satisfies the unconstitutional conditions doctrine, and is analyzed under the *Central Hudson* four-part framework..... i

TABLE OF CONTENTSII

TABLE OF CITED AUTHORITIESIV

STATEMENT OF JURISDICTION..... 1

STANDARD OF REVIEW..... 1

RELEVANT STATUTORY PROVISIONSERROR! BOOKMARK NOT DEFINED.

STATEMENT OF THE CASE..... 2

 1. Preliminary Statement 2

 2. Statement of Facts 3

 3. Procedural History 4

SUMMARY OF THE ARGUMENT..... 7

ARGUMENT 10

 I. THE FEDERAL CIRCUIT ERRED AS A MATTER OF LAW WHEN IT UPHELD THE TTAB’S REFUSAL TO REGISTER THE TRADEMARK “DUMB BLONDE” AS MS. LUHV’S STAGE NAME ON THE GROUNDS THAT THE MARK IS DISPARAGING TO A SUBSTANTIAL COMPOSITE OF WOMEN.... 10

 A. The Examining Attorney Did Not Meet His Burden To Show A Prima Facie Case Of Disparagement 11

 1. The Examining Attorney failed to properly establish the “likely meaning” of the mark “Dumb Blonde”..... 12

 2. The Examining Attorney failed to provide any evidence showing that a substantial composite of women find the mark disparaging..... 17

 B. The Federal Circuit Erred As A Matter of Law when it upheld the TTAB’s Refusal and found that the Refusal Was Supported By Sufficient and Substantial Evidence Showing That The Likely Meaning Of The Mark “Dumb Blonde” Would Be Disparaging To Substantial Composite Of Blonde Women . 22

II. THE UNITED STATES COURT OF APPEALS FEDERAL CIRCUIT WAS CORRECT IN HOLDING THAT SECTION 2(a) IS AN UNCONSTITUTIONAL VIOLATION OF MS. LUHV’S FIRST AMENDMENT RIGHTS	24
A. The Lower Court Correctly Held That Ms. Luhv’s Trademark, “Dumb Blonde,” Is Protected Commercial Speech.	25
B. The Lower Court Correctly Held That The Government’s Refusal To Register Ms. Luhv’s Mark Implicates The First Amendment Under The Unconstitutional Conditions Doctrine.....	28
C. The Lower Court Correctly Held That The Government’s Refusal To Register Ms. Luhv’s Mark Is Unconstitutional Under The First Amendment..	31
1. Ms. Luhv’s trademark is not misleading and it does not concern illegal activities.	32
2. The Government’s asserted interest in limiting trademarks under Section 2(a) is not substantial.	34
3. Even if the Government’s asserted interest is substantial, Section 2(a) does not directly advance that interest.	36
4. Even if the Government’s asserted interest is substantial and Section 2(a) does directly advance that interest, Section 2(a) is more extensive than necessary.	38
<u>CONCLUSION</u>	40
<u>CERTIFICATION</u>	41

TABLE OF CITED AUTHORITIES

UNITED STATES SUPREME COURT CASES

<i>Bates v. State Bar of Arizona</i> , 433 U.S. 350 (1977).....	38, 39
<i>B&B Hardware, Inc. v. Hargis Ind., Inc.</i> , 135 S. Ct. 1293 (2015).....	29, 30
<i>Bigelow v. Virginia</i> , 421 U.S. 809 (1975).....	26
<i>Bolger v. Youngs Drug Prods. Corp.</i> , 463 U.S. 60 (1983).....	36, 37
<i>Cent. Hudson Gas & Elec. Corp. v. Pub. Serve. Comm'n</i> , 447 U.S. 557 (1980).....	<i>passim</i>
<i>Friedman v. Rodger</i> , 440 U.S. 1 (1979).....	26, 28, 29
<i>Perry v. Sindermann</i> , 408 U.S. 593 (1972).....	30, 31, 32
<i>Roth v. United States</i> , 354 U.S. 476 (1957).....	26
<i>Rubin v. Coors Brewing Co.</i> , 514 U.S. 476 (1995).....	38, 39, 40
<i>Rumsfeld v. Forum for Academic & Institutional Rights, Inc.</i> , 547 U.S. 47 (2006).....	29
<i>Sorrell v. IMS Health Inc.</i> , 131 S. Ct. 2653 (2011).....	35, 36, 37
<i>Texas v. Johnson</i> , 491 U.S. 397 (1989).....	26
<i>United States v. Am. Library Ass'n, Inc.</i> , 539 U.S. 194 (2003).....	29
<i>United States v. Eichman</i> , 496 U.S.310 (1990).....	36
<i>Va. State Bd. of Pharmacy v. Va. Citizens Consumer Counsel</i> , 425 U.S. 748 (1979).....	27, 28
<i>44 Liquormart, Inc. v. Rhode Island</i> , 517 U.S. 484 (1996).....	40

CIRCUIT COURT OF APPEALS CASES

Bad Frog Brewery, Inc. v. New York State Liquor Auth., 134 F.3d 87 (2nd Cir. 1998)..... 39, 40

Dep't of Tex. Veterans of Foreign Wars v. Tex. Lottery Comm'n, 760 F.3d 427 (5th Cir. 2014).....30

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Figueroa v. United States, 466 F.3d 1023 (Fed. Cir. 2006).....30, 32

In re Boulevard Entm't, 334 F.3d 1336, 1340 (Fed. Cir.2003).....14, 16

In re Budge Mfg. Co., 857 F.2d 773 (Fed Cir. 1988).....34

In re California Innovations, Inc., 329 F.3d 1334 (Fed. Cir. 2003)34

In re Geller, 751 F.3d 1355, 1358 (Fed.Cir.2014)11, 12, 13, 18

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

In re Save Venice New York, Inc., 259 F.3d 1346 (Fed. Cir. 2001).....34

In re Tam, 114 U.S.P.Q.2d 1469 (Fed. Cir. 2015) (*Appeal reinstated, en banc hearing granted*).....14, 15, 20

In re Wada, 194 F.3d 1297 (Fed. Cir. 1999).....34

DISTRICT COURT CASES

Pro-Football, Inc. v. Harjo, 284 F.Supp.2d 96, 124 (D.D.C.2003).....11

TRADEMARK TRIAL AND APPEAL BOARD OPINIONS

In Re Heeb Media LLC, 2008 WL 5065114 (T.T.A.B. 2008) 14, 15, 16, 17, 18, 19

In re La Estancia Argentina Corp. 79 U.S.P.Q.2d 151 (T.T.A.B. 1979).....22

<i>In re Squaw Valley Dev. Co.</i> , 80 U.S.P.Q.2d 1264 (T.T.A.B. 2006)	12,13,18
<i>In re Volvo Cars of North America, Inc.</i> 46 U.S.P.Q.2d 1455,1456 (T.T.A.B. 1998)..	22

UNITED STATES CONSTITUTION

U.S. Const. amend. I	<i>passim</i>
----------------------------	---------------

FEDERAL STATUTES

15 U.S.C § 1052(a).....	<i>passim</i>
15 U.S.C § 1057(b).....	31
15 U.S.C § 1072.....	31
15 U.S.C. § 1254(1).....	1

AGENCY RULES AND PROCEDURE MANUALS

Trademark Rule 2.142 (d)	22
TMEP § 1203.03 (b) (July 2015)	11, 12, 18

STATEMENT OF JURISDICTION

The United States Government appeals the Federal Circuit Court's decision in which the Federal Circuit Court held that Section 2(a) of the Lanham act is unconstitutional. Respondent, Ms. Luhv appeals the Federal Circuit Court's decision to affirm the TTAB and PTO's refusal to register the mark "Dumb Blonde" because it was disparaging. The Supreme Court granted certiorari. The jurisdiction of this Court rests on 28 U.S.C. § 1254(1).

STANDARD OF REVIEW

A Court of Appeals reviews a final action of the TTAB under a mixed standard, with the underlying factual considerations reviewed for substantial evidence and the ultimate registration decision reviewed de novo. *In re Kourtney Luhv*, 1337 F.3d 455 (Fed. Cir. 2015). Constitutional challenges are reviewed de novo. *Id.*

STATEMENT OF THE CASE

1. Preliminary Statement

This appeal is about more than the registration of a trademark. This appeal concerns a governmental agencies' ability to deny the Respondent her constitutional rights because she is a woman. Respondent respectfully requests that this court uphold the Federal Circuit Court of Appeals' ruling that Section 2(a) of the Lanham Act is unconstitutional. Respondent further requests that this court order the Patent and Trademark Office ('PTO') to register her trademark because "Dumb Blonde" is not disparaging and the evidence relied upon by the PTO and TTAB in determining that it was disparaging, was insufficient and improper.

Respondent is a solo musician and vocalist who is widely known by her stage name, "Dumb Blonde." *In re Kourtney Luhv*, 1337 F.3d 455 (Fed. Cir. 2015). She has claimed use of this name since 2012. *Id.* As the Federal Circuit noted, Ms. Luhv makes concerted efforts through the use of her mark, her persona, and her music to address the issues faced by women in today's society. *Id.* This nexus between entertainment, speech and society is crucial to this appeal. Through the use of her stage name, image, musical lyrics, uTube videos and tutorials, Ms. Luhv has intentionally designed a 'persona' that serves to break down stereotypes and which acts valuable social commentary. Since 2012, her use of the name "Dumb Blonde" has attracted a devoted following of fans and has already begun to change contemporary attitudes towards blonde women as demonstrated by uTube comments such as "Your ability to bring attention to the challenges faced by women

is inspiring,” or “as a blonde woman I totally support you even if haters gon’ [sic] hate.” *Id.* at 458.

Importantly, Ms. Luhv is not just addressing issues faced by women through her music. The respondent has gone further and has begun to build a brand around her stage name “Dumb Blonde.” The uTube channel “DumbBlondeMusic” is not a collection of videos indicating that blondes are inferior to other women. Rather, Ms. Luhv uses her uTube channel to support her fan’s careers and passions as she often shares music-production-related tips with other uTube users. *Id.* at 456. When perceived in the proper context, Ms. Luhv’s stage name, “Dumb Blonde” is a social commentary, not a disparaging statement. The PTO and TTAB failed to recognize this when they gave no weight to a uTube user’s observation that, “there need [sic] to be more women like you serving as positive role models for young girls rather than grinding on Robert Thin!” *Id.* at 458.

2. Statement of Facts

Ms. Luhv’s music blends elements of Grindcore, Neurofunk and American Folk music, with lyrics addressing issues faced by women in today’s society. *Id.* Ms. Luhv is blonde woman who chose “to reclaim the stereotype associated with blonde women and raise awareness of challenges stemming from gender discrimination and negative stereotypes of all women.” *Id.* at 457. Since 2012, Ms. Luhv has been performing under the stage name “Dumb Blonde.” *Id.* Dumb Blonde, regularly plays concerts in the Southern Caledonia region and in various other states. *Id.* Across

the country, Dumb Blonde has a devoted fan base who frequently attend her concerts. *Id.*

In addition to her devoted, concert going, fan base, Ms. Luhv also has a large number of online fans. *Id.* at 456. These fans generally consume Ms. Luhv's music on either www.soundpuff.com, an online music streaming service, or www.uTube.com, a video hosting website. *Id.* Ms. Luhv has over 40,000 followers on her Soundpuff account and over 100,000 active subscribers to her uTube channel. *Id.* Ms. Luhv's registered uTube account name is "DumbBlondeMusic." *Id.* It is through these mediums that she has broken down barriers with music, social commentary and even free music-production tips. *Id.*

In June 2014, Ms. Luhv finished recording several new songs and negotiated a deal with a record label to release an extended-play format record. *Id.* at 456. The contract included a \$2,000,000.00 advance contingent upon execution of the agreement. *Id.* A precondition to the execution of the agreement was that Ms. Luhv register "Dumb Blonde" as a trademark. *Id.* Ms. Luhv was denied registration by both the PTO's initial reviewing attorney and the TTAB. *Id.* Because Ms. Luhv has been unable to register her stage name, she has not received the \$2,000,000.00 dollar bonus and has suffered harm as a result. More importantly, Ms. Luhv has not been able to build upon her success changing social preconceptions of women.

3. Procedural History

On July 9, 2014, Ms. Luhv filed Application No. 99/989,052 ('052 Application') with the United States Patent and Trademark Office. *In re Kourtney Luhv*, 1337

F.3d 455, 456 (Fed. Cir. 2015). Her application stated that she was seeking to register the mark “DUMB BLONDE” for “entertainment, namely live performances by a musical band” and “clothing, namely, sweatshirts, t-shirts, tank-tops and headwear.” *Id.*

In an unreported opinion, The PTO refused to register the mark because the examining attorney made the factual determination that the mark “DUMB BLONDE” “may be disparaging to women under Section 2(a) of the Lanham Act. *Id.* The examiner’s decision was based solely on the materials contained in Ms. Luhv’s application for registration. *Id.*

Ms. Luhv appealed the refusal to register her stage name to the TTAB based on the record created by the examining attorney. *Id.* The TTAB affirmed the PTO’s refusal and stated that the mark, “may be disparaging to a substantial composite of the referenced group, namely women who have a blonde hair color.” *Id.*

Ms. Luhv appealed the TTAB decision alleging that the TTAB erred in affirming the examining attorney’s rejection on the basis that the mark may be disparaging because the views cited by the examiner do not accurately reflect her fan’s perceptions of the mark. She also alleged that the views cited were not reflective of the views of a substantial composite of women. In her appeal, she also claimed that Section 2(a) of the Lanham Act is unconstitutional. *Id.* at 457.

In the opinion below, The Federal Circuit affirmed the TTAB’s holding that the mark was disparaging, but found Section 2(a) of the Lanham Act to be unconstitutional. *Id.*

SUMMARY OF THE ARGUMENT

The Supreme Court of the United States should reverse the Federal Circuit Court of Appeal's erroneous ruling that Ms. Luhv's trademark, "Dumb Blonde," is disparaging but should affirm the Federal Circuits Court's correct ruling that § 1052(a) is unconstitutional.

Respondent asserts that the mark she wishes to register was rejected in error because the examining attorney never established the *prima facie* case for disparagement as required by trademark precedent and case law. Furthermore, Respondent contends that the TTAB's findings were in error because the evidence does not support the conclusion that the mark "Dumb Blonde" is disparaging to a substantial composite of women. The procedural errors in the TTAB ruling are based on the examiner's factual conclusions which were based on insufficient evidence. *In re Kourtney Luhv*, 1337 F.3d 455, 456 (Fed. Cir. 2015). The TTAB further erred when it affirmed the examining attorney's refusal to register Ms. Luhv's mark based on an inadequate record that failed to fully consider the evidence supporting registration. Despite the Federal Circuit Court's ruling that Section 2(a) is unconstitutional, it is still Respondent's position that her stage name, as utilized in conjunction with her musical performances, was erroneously denied registration because the evidence relied upon failed to show that the use of the mark, as stated in her application, will or may be perceived by a substantial composite of women as disparaging. It is unfathomable that a few online trolls, or

the views of one government employee as to the mark's perception could have the ability to halt the career of a woman engaging in beneficial social commentary.

Section 2(a)'s limitation on the content of trademark applications is a violation of the First Amendment. A trademark is protected commercial speech under the First Amendment because it proposes a commercial transaction for the pecuniary benefit of the mark holder. Section 2(a) implicates the First Amendment under the unconstitutional conditions doctrine. The unconstitutional conditions doctrine applies when a governmental benefit, in this case the substantive and procedural benefits associated with registration, is denied based on a waiver of a constitutional right. In this case, the waiver is the tacit agreement not to trademark a logo or name violating § 1052(a). Because the First Amendment is implicated under the unconstitutional conditions doctrine, the court must analyze whether the abridgement is constitutional. Here, under the required four-prong analysis, Section 2(a) is unconstitutional. First, the trademark "Dumb Blonde" is not misleading and does not concern illegal activities. Second, the government's interest in refusing trademarks that may disparage individuals is not substantial because a governmental interest is not substantial when it seeks to protect a small minority of people from a speculative harm through broad content-based restrictions. The government's interest in preventing consumers from interpreting a disparaging mark as being endorsed by the government is not substantial. In today's world, there is little risk that the average consumer will conflate a trademarked logo with governmental endorsement. Third, even if the government's interest is substantial,

the restrictions in Section 2(a) do not directly advance that interest. Ms. Luhv is still permitted to use the “Dumb Blonde” name even if it is not registered.

Therefore, by preventing its registration, the government does not keep the moniker out of the public’s view. Under Section 2(a) the government simply denies potential applicants the substantive and procedural benefits associated with registration.

Fourth, even if the government’s asserted interest is substantial and the governmental regulations directly advance that interest, the regulations are more extensive than necessary to serve that interest. Were Section 2(a)’s prohibition on disparaging speech to be struck, the government could still prevent disparaging and socially harmful speech through the enforcement of other constitutional limitations on speech such as the prohibition on hate speech and fighting words. Section 2(a) of the Lanham act is an overbroad regulation that serves to deny individuals the substantive and procedural benefits associated with registration based on their constitutionally protected speech.

For the foregoing reasons, Respondent respectfully requests that this Court affirm the Federal Circuit’s proper holding that Section 2(a) is unconstitutional and order the PTO to register the trademark. Alternatively, if Section 2(a) is upheld as constitutional, Ms. Luhv respectfully requests that this Court order registration of the mark because “Dumb Blonde” is not disparaging. If this Court declines to find that the mark “Dumb Blonde” is not disparaging, Ms. Luhv requests that this Court, remand to the TTAB for rehearing.

ARGUMENT

I. THE FEDERAL CIRCUIT ERRED AS A MATTER OF LAW WHEN IT UPHELD THE TTAB'S REFUSAL TO REGISTER THE TRADEMARK "DUMB BLONDE" AS MS. LUHV'S STAGE NAME ON THE GROUNDS THAT THE MARK IS DISPARAGING TO A SUBSTANTIAL COMPOSITE OF WOMEN.

Respondent respectfully requests that this Court reverse the Federal Circuit's ruling affirming the TTAB's refusal to register the trademark "Dumb Blonde." The TTAB erroneously found that the mark was disparaging to a substantial composite of women, because the examining attorney failed to meet his burden to establish a prima facie case of disparagement and because the TTAB refusal was not based on substantial evidence. As a result, the Federal Circuit erred in upholding the finding that substantial evidence supported the TTAB's refusal.

Under Section 2(a) of the Lanham Act, the United States Patent and Trademark Office has the power to refuse registration for a mark that:

"[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."

15 U.S.C. § 1052(a). A mark may be considered disparaging if it "dishonors by comparison with what is inferior, slights, depreciates, degrades, or affects or injures by unjust comparison." *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) (quoting *Pro-Football, Inc. v. Harjo*, 284 F.Supp.2d 96, 124 (D.D.C. 2003)).

In ex parte cases, the prohibition on disparaging marks is applied through burden shifting scheme. *Trademark Examiners Procedure Manual* (TMEP) § 1203.03 (b) (July 2015). The Trademark Examiner Procedure guide (TMEP) states

that the examining attorney carries the initial burden and is required to establish a prima facie case of disparagement. *Id.*(citing *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 1271 (T.T.A.B. 2006)). The Board does not carry the burden. *Id.*

When a mark may disparage “persons,” “institutions,” “beliefs,” or “national symbols,” the attorney must establish the prima facie case of disparagement using a two-prong test. *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014). First, an examiner must first inquire into the “likely meaning” of the mark. *Id.* Second, an examiner must show that the “likely meaning” would disparage a substantial composite of the group implicated by the likely meaning. TMEP § 1203.03(b)(i) (citing *In re Geller*, 751 F.3d at 1358). The analysis under the second prong is related to the first prong in that a mark can be inherently disparaging or disparaging only in certain context and thus, the second prong is entirely dependent on the determination of the mark’s “likely meaning.” *See In re Tam*, 114 U.S.P.Q.2d 1469 (Fed Cir 2015) (Appeal reinstated, en banc hearing granted).

A. The Examining Attorney Did Not Meet His Burden To Show A Prima Facie Case Of Disparagement

The examining attorney erred as a matter of law when he relied solely on the materials in the “052 Application” as the basis for his refusal to register the stage name “Dumb Blonde.” The examiner’s failure is fatal in this instance. He not only failed to establish a prima facie case of disparagement under Section 2 (a)’s burden shifting framework, but he also failed to supplement his personal assumptions with any substantive evidence that would support refusal. This failure to develop a sufficient, usable record that would provide the basis for meaningful appellate

review distinguishes this trademark prosecution from the precedent relied upon in the opinion below. Thus, because the examiner never established a prima facie case of disparagement and erred as a matter of law in applying the two prong test for disparagement, Respondent respectfully requests that this Court reverse the Federal Circuit's holding that the TTAB correctly denied Ms. Luhv's application to trademark her stage name "Dumb Blonde." The examiner failed to provide any evidence, much less sufficient and substantial evidence, to support the refusal. Put another way, there was insufficient process to conclude that the likely meaning of the mark is disparaging. In addition the examiner could not prove that the mark was viewed by any specific women as disparaging in the context of contemporary attitudes.

1. The Examining Attorney failed to properly establish the "likely meaning" of the mark "Dumb Blonde"

The burden of proving that a mark is disparaging rests with the USPTO and the examining attorney. *Squaw Valley*, 80 U.S.P.Q.2d at 1271. The first step in proving a prima facie case for refusal under Section 2(a) requires that an examining attorney determine a mark's "likely meaning." *In re Geller*, 751 F.3d at 1358. More specifically, the first prong asks:

"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?"

Geller, 751 F.3d 1355.

This inquiry starts with dictionary definitions, as they can be sufficient alone in certain circumstances to make a determination. In addition, “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... individual views.” *In re Boulevard Entm’t*, 334 F.3d 1336, 1340 (Fed. Cir.2003). The determination of a mark’s likely meaning must also take into account the nature of the goods and services and the manner in which the mark is used in the marketplace. *In Re Heeb Media LLC*, 2008 WL 5065114 (T.T.A.B. 2008).

When analyzing a mark’s “likely meaning,” not every mark is necessarily treated the same. A proposed trademark can be an innocuous term, a disparaging term that does not retain the disparaging meaning in certain context or, a disparaging term with no non-disparaging meanings. See *In re Tam*, 114 U.S.P.Q.2d 1469 (Fed Cir 2015); *In Re Heeb Media LLC*, 2008 WL 5065114 (T.T.A.B. 2008).

In *Tam*, the PTO initially refused to register the mark “The Slants” on the grounds that it may be disparaging to people of Asian descent under Section 2(a). See *In re Tam*, 114 U.S.P.Q.2d 1469 (Fed Cir 2015) (Appeal reinstated, en banc hearing granted)). The TTAB affirmed the refusal after considering the examiners prima facie showing. *Id.* On appeal, the examiners presented the board with evidence including: dictionary definitions universally ascribing a derogatory meaning to the term slants, a Wikipedia entry claiming the band’s name to be based on a slur, a quote from the band stating its intent to use the derogatory meaning,

and printouts from reputable organizations indicating their opposition to the mark or their belief that the term was disparaging. *Id.* The TTAB found that the evidence on record, “universally characterized the word ‘slant’ as disparaging or offensive when used to refer to a person of Asian descent.” *Id.* Importantly, the TTAB noted that any potential disparagement is viewed from the perspective of the injured or disparaged group, not the applicant. *Id.* Tam, however, failed to submit evidence rebutting the likely derogatory meaning. He could have presented evidence suggesting that his use of the mark has resulted in members of the referenced group no longer perceiving the mark as disparaging. *Id.*

When the Federal Circuit affirmed the PTO’s denial of Ms. Luhv’s application, it relied heavily on TTAB’s ruling in *In Re Heeb Media LLC*, 2008 WL 5065114 (T.T.A.B. 2008). However, *Heeb Media* is not only substantively distinguishable from the instant case, but is illustrative of why Ms. Luhv’s appeal must succeed. In *Heeb Media*, the TTAB refused registration for the term “HEEB” under Section 2 (a), because it found that the proposed use of the mark as stated in the application was disparaging to a substantial composite of the Jewish community. *Id.* at 1. In analyzing the “likely meaning” of “HEEB,” the examiner provided the board with information from his initial review and evidence collected at a reconsideration hearing. *Id.* Thus, despite applicant’s rebuttal, the Board found that the examiner provided substantial and sufficient evidence showing that specific reliable authorities, such as individual views from the community, dictionaries and Internet research, ascribed a highly disparaging meaning to the

term. *Id.* at 2-3. Importantly, as in *Tam*, the Board held that the manner of use did not change perceptions, even when used by small portions of the injured group who are trying to reclaim the term. *Id.* at 3. As one professor of Jewish-American Literature put it, “it would have to be explained to me that” the person using the term “HEEB” was not meaning to be offensive.” *Id.* at 2.

Here, while it is arguable that the examiner correctly determined the mark’s likely meaning was a reference to a blonde woman, the examiner did not engage in a complete analysis as required under the first prong of the disparagement test. Unlike the examiner in *In re Tam*, the examining attorney in this case did not reference any outside information, much less dictionaries or other materials in an effort to make the prima facie case of disparagement. See *In re Boulevard*, 67 U.S.P.Q.2d at 1478 (noting that where a mark has only one meaning, dictionary evidence alone can be sufficient to satisfy the PTO’s burden).

In this case, the examiner also failed to properly analyze the mark’s likely meaning because he failed to take into account the manner in which the mark is perceived. This is evidenced by the fact that no weight was given to a statement made by one uTube user which was, “*as a blonde woman* I totally support you even if haters gon’ [*sic*] hate.” *In re Kourtney Luhv*, 1337 F.3d. at 458. (emphasis added). This statement does not stand alone, as other online commentators have weighed in on “Dumb Blonde” and her work through comments such as, “there need [*sic*] to be more women like you serving as positive role models for young girls rather than grinding on Robert Thin!” or “[y]our ability to bring attention to the challenges

faced by women is inspiring,” *Id.* at 458. These statements are the only statements about Ms. Luhv’s use of the mark on the record that express the views of women and blonde women. Moreover, in *Heeb Media*, the Board’s analysis under the first prong noted that the derogatory meaning of the word was not undermined by any other elements of the mark. *In Re Heeb Media LLC*, 2008 WL 5065114, at 5 (T.T.A.B. 2008). Here, the context and manner of use rebut any assumption of negative meaning made by the examiner. Thus, because the term “Dumb Blonde” is used as social commentary and as an identifier, it is not the same as marks that are “universally” disparaging because they are derogatory in any context. There has been no initial showing that the likely meaning is what the examiner thinks it is. The application materials are insufficient in this instance.

Although Ms. Luhv’s and Mr. Tam both desired to reclaim and/or recast a negative identifier, this intent does not suffice without actual proof and proper analysis which Ms. Luhv provides. Here, unlike in *Tam*, the examiner failed to find that the mark in question was 1) highly disparaging (as it was universally ascribed a derogatory meaning) or, 2) that it retained a disparaging meaning to a substantial composite of people referenced by the mark. Moreover, unlike Tam who failed to present evidence that his use of the mark impacted contemporary perceptions of the meaning in a positive sense, Ms. Luhv has sufficient rebuttal evidence showing that her use of the mark has actually changed perceptions. The market’s approval of her mark’s “likely meaning” whatever it might be, is evident in the fact that the market

offered her a 2 million dollar record deal, all contingent upon her ability to use the stage name “Dumb Blonde.”

Ms. Luhv has also shown that, unlike “THE SLANTS” her mark does not retain the ascribed meaning when attached to her music and work. Ms. Luhv has demonstrated, through her devoted fans and online commentators that she has changed contemporary attitudes in the span of less than three years.

2. The Examining Attorney failed to provide any evidence showing that a substantial composite of women find the mark disparaging

The second prong of the disparagement test applied by examiners, requires that the PTO examiner “make a prima facie showing that a substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark, as used on or in connection with the relevant goods or services, to be disparaging in the context of contemporary attitudes. TMEP § 1203.03(b); *In re Geller* 751 F.3d at 1362. It is this prima facie showing, made by the examining attorney and not the TTAB, which triggers an applicant’s ability to appeal and rebut the examiner’s evidence. *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d at 1267.

As noted above, the Federal Circuit reliance on the substantive analysis in *Heeb Media* is misplaced as *Heeb Media*, is substantively distinguishable. The applicant in *Heeb Media* previously registered the same term for use as a mark on magazine publications but was refused in his attempt to register it for use on clothing because the PTO found it was disparaging to members of the Jewish community. *In Re Heeb Media LLC*, 2008 WL 5065114 (T.T.A.B. 2008). Applicant

challenged the examining attorney's refusal, and contended that refusal was improper because: 1) there was insufficient evidence, 2) the PTO previously registered the word "HEEB" without a finding of disparagement, 3) only a portion of the relevant community viewed the term as derogatory and rebuttal evidence supports the conclusion that a large portion of the Jewish community does not view it as such, and 4) that applicants intended use of the mark was ignored. *Id.* at 2. The TTAB affirmed the examining attorney's refusal following a comprehensive review of the examiner's prima facie case and the applicant's evidence submitted in rebuttal. *Id.* at 7. Despite arguing that the examiner failed to meet his burden, the importance of the examiner's evidentiary prima facie case was clear as the Board found that the examining attorney had met his burden to show that a substantial composite of the referenced community and/or public viewed the mark as disparaging. *Id.* Notably, the TTAB acknowledged that the examiner could have extrapolated his rationale from the evidence of record. *Id.* However, the evidence of record substantially supported the refusal because: 1) the term "HEEB" is highly disparaging, 2) the term "HEEB" retains that meaning when used and; 3) that an actual and substantial portion of the community was in vocal opposition to the use of the word, regardless of context. *Id.*

In *Tam*, the Board also found that the examining attorney met his burden under the second prong. *In re Tam*, 114 U.S.P.Q.2d 1469 (Fed Cir 2015) (Appeal reinstated, en banc hearing granted). According to the Board, it was shown that "THE SLANTS" retained its derogatory meaning because the record "clearly shows

both that members of the referenced group ascribe the derogatory meaning based on applicant's manner of use and that members of the referenced group find it objectionable.” *Id.* The Board also acknowledged that a finding of disparagement is not dependent on the applicant’s ethnicity, but instead on the circumstances related to his use of the term. *Id.*

Proper procedure and analysis is crucial to agency function. Without it, the examiner and any subsequent reviewer is beholden to the views of an individual and not the evidence of record. In Ms. Luhv’s trademark prosecution, the examiner failed to provide or cite to any specific evidence relating to the potential disparagement extending from registration of Respondent’s mark. Thus, based on the evidence of record, it cannot be said that a “substantial composite” of women perceive the mark, as used, to be disparaging. This is because Respondent’s mark has not been proven to be universally disparaging and because it has not been shown to actually disparage anyone.

The PTO argued that Ms. Luhv’s use of the term “Dumb Blonde” does in fact disparage blonde women and that it is still disparaging when used specifically in connection with Ms. Luhv’s musical performances. There is no empirical or statistically relevant evidence to suggest a “substantial composite” of women, or blonde women, find the use disparaging. In *Heeb Media* and *Tam*, there was a plethora of information provided to the board. This information ranged from online research to personal interviews and statements. Thus any reliance on this precedent is misplaced, as the only relevant indications that Ms. Luhv’s mark has

ever been ascribed a disparaging meaning allegedly lie in materials contained in her application.

In re Heeb Media and *In Re Tam* are instructive in this instance for two main reasons: first, the circumstances and records in those matters provide a revealing comparison to the case amassed by the examining attorney and thus, reveal the extreme level of arbitrariness found in the refusal of Ms. Luhv's application. Second *In re Heeb* and *In re Tam* provide some examples of information that might actually establish proper grounds for refusal of marks that may disparage disparagement. As the examiners in *Heeb Media* and *Tam* implicitly acknowledge, their burden must be carried out under the proper framework. Under the first prong, the examiner of the 052 application erred because the *framework requires production of*, at the very least, more than a scintilla of evidence, and in this case, dictionary definitions to show his perception of the mark's "likely meaning." The examiner erred under second prong because he failed to show any evidence that a single identifiable woman, much less a composite of women perceive the mark as disparaging.

Had the examiner cited to anything outside of the application and based his view in evidence, the TTAB would at least have the ability to affirm the support of the underlying factual determination. Here however, Respondent is faced with the impossible task of rebutting the undocumented and intuitive beliefs of the examiner.

While it is true that the TTAB ultimately considered “dictionary definitions” and “numerous articles,” the procedural posture of the trademark prosecution and lack of reconsideration, suggests that the “dictionary definitions, numerous articles and user comments” on her uTube account were not actually cited to by the examining attorney, as he relied solely on her application. Trademark Rule of Practice 2.142(d) prohibits the introduction of new evidence on appeal to the TTAB unless good cause exists. Thus, because the evidence appears to have been collected and provided by the TTAB and because the evidence was considered by the Board following the filing of the notice of appeal, the TTAB should not have considered it and the Federal Circuit should have ignored it. This Court should also refuse to consider it. *See In re Volvo Cars of North America, Inc.* 46 USPQ2d 1455,1456 (TTAB 1998) (Evidentiary record must be complete at the time notice of appeal is filed and new evidence should be excluded); *In re La Estancia Argentina Corp.* 79 USPQ.2d 1531, 1532 (T.T.A.B 1979) (evidence filed for first time with examiners brief on appeal was untimely and not considered.). The only alternative for addressing this evidence is to remand the decision to the examiner for reconsideration, at which point the record could be more fully developed by the examining attorney. ¹

¹ Respondent contends however that this alternative is not proper, where as here, Respondent chose to appeal the decision to the TTAB instead of requesting a hearing. This strategic decision was based on the fact that the initial determination based on insufficient evidence, could be bolstered by the examining attorney had Respondent requested reconsideration.

B. The Federal Circuit Erred As A Matter of Law When It Upheld The TTAB's Refusal And Found That The Refusal Was Supported By Sufficient And Substantial Evidence Showing That The Likely Meaning Of The Mark "Dumb Blonde" Would Be Disparaging To Substantial Composite Of Blonde Women

It is clear from the Federal Circuit Opinion and the above analysis that The PTO did not and could not show that the stage name "Dumb Blonde" was disparaging to a substantial composite of blonde women. As a result, both the Federal Circuit and TTAB were forced to provide additional evidence to support any underlying factual determinations. Even if this evidence was properly considered, it cannot be said to be sufficient to justify the TTAB's holding or the Federal Circuit's holding that the refusal was based in substantial evidence. As noted above, the conclusion that a substantial composite of blonde women would find Ms. Luhv's mark disparaging has no basis in the evidence generated by the PTO. Even if the entirety of evidence cited to in the opinion below is considered, there is still insufficient evidence on record showing that the likely meaning of the mark is perceived as disparaging by any women, much less a substantial composite.

Moreover, because the examiner is required to find that a substantial composite of women may find the mark disparaging, the utter lack of statistically relevant evidence on record is outcome determinative. Here, the TTAB's refusal is based on the PTO's decision and "dictionary definitions, numerous articles and user comments." This evidence is not only irrelevant but it is un-rebuttable when it is not properly placed on the record.

Even if the above evidence is considered, one cannot argue that the refusal was based in substantial evidence, even under a policy of deference to the TTAB. In this case, the Federal Circuit erroneously upheld this ruling under the substantial evidence standard. The relevant user comments support Ms. Luhv's intended use of the mark and its actual perceived benefit. Only one article is cited and used to show that women as a whole are likely to find dumb blonde jokes offensive. This evidence provides no support for the contention that Ms. Luhv's mark is disparaging when viewed by women or blonde women. Additionally, the supposed negative comments on her website or fan pages cannot be attributed to the perceived group and thus are not probative of a finding that a substantial composite of a referenced group may be disparaged by a mark.

The Federal Circuit, therefore erred as a matter of law when it found that a substantial composite of women find Ms. Luhv's use disparaging based on comments, definitions and a single citation to *The Handbook of Gender, Sex, and Media. In re Luhv*, F.3d at 457. From this, citation, the Court draws the conclusion that "women view 'dumb blonde' jokes negatively" and that this evidence is sufficient to show that a substantial composite of blonde women perceive the Ms. Luhv's mark as disparaging. *Id.* This argument is without merit because the generalization regarding women's views on jokes has no relevance on the mark's use by Ms. Luhv.

Had the proper analysis been used from the start, it would be clear that the disparaged group perceives "Dumb Blonde" differently when associated with Ms.

Luhv. This is because the mark is not inherently disparaging. The Board has acknowledged that marks are sometimes consumed and understood differently when perceived in different context. Thus the Board must recognize that “Dumb Blonde” is not universally or inherently disparaging like a racial or ethnic slur but instead it is a mark perceived by women as empowering and needed.

Here Ms. Luhv’s express intent is to undermine the dumb blonde jokes and break down gender stereotypes, as she finds these issues of great concern to herself and society. A review of the opinion below makes it clear that there is no evidence actually suggesting the mark is perceived by any blonde women as disparaging. Aside from a satirical photo taken out of context and a single citation suggesting that a category of jokes was viewed as disparaging in 2011, nothing supports the holding that a *substantial* composite of women view her mark as disparaging in the context of contemporary attitudes. If anything, the comments cited above and in the federal circuit opinion stress the opposite conclusion. For these reasons, Respondent respectfully requests that this court order the PTO to register the trademark “Dumb Blonde.”

II. THE UNITED STATES COURT OF APPEALS FEDERAL CIRCUIT WAS CORRECT IN HOLDING THAT SECTION 2(a) IS AN UNCONSTITUTIONAL VIOLATION OF MS. LUHV’S FIRST AMENDMENT RIGHTS

Article 1 of the U.S. Constitution provides that, “Congress shall make no law...abridging the freedom of speech.” US Const. amend. I. Although, the First Amendment is not always interpreted literally, only small limitations on freedom of

speech are constitutionally permissible. *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 566 (1980). Section 2(a)'s limitation is not constitutionally permissible. Section 2(a) provides that the PTO may refuse to register a mark that "consists of or comprises...matter[s] which may disparage." 15 U.S.C. § 1052(a) (2006). In determining the constitutionality of the above provision, this Court should apply the standard three part constitutionality inquiry which asks: (1) whether the speech is constitutionally protected; (2) whether the Government's regulations implicate the First Amendment; and (3) whether the Government's actions are unconstitutional. *Texas v. Johnson*, 491 U.S. 397, 405 (1989); *Cent. Hudson* 447 U.S. at 557; *Roth v. United States*, 354 U.S. 476, 481 (1957).

A. The Lower Court Correctly Held That Ms. Luhv's Trademark, "Dumb Blonde," Is Protected Commercial Speech.

The First Amendment protects commercial speech from unwarranted governmental intrusion particularly if that speech seeks to editorialize or make societal observations. *Cent. Hudson*, 447 U.S. at 566; *Friedman v. Rodger*, 440 U.S. 1 (1979). Even if the speech is purely commercial, and makes no observations about society, the speech is still protected as commercial speech. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Counsel*, 425 U.S. 748, 765 (1976); *Bigelow v. Virginia*, 421 U.S. 809 (1975).

The lower court correctly held that Ms. Luhv's application to trademark her stage name "Dumb Blonde" is protected commercial speech. Commercial speech is

any speech which proposes a commercial transaction or is calculated to enhance the commercial gain of the speaker. *Va. Bd. of Pharmacy*, 425 U.S. at 765.

In *Virginia Board of Pharmacy*, consumers brought suit challenging the validity of a Virginia statute regulating the advertisement of prescription drug prices. *Id.* In determining whether advertising was considered commercial speech, the court distinguished between pharmaceutical advertisements which are designed to promote commercial transactions and the door-to-door distribution of leaflets designed to publicize religious meetings. *Id.* at 758. The court held that speech, which does “no more than propose a commercial transaction,” is protected by the First Amendment. *Id.* at 762. Where the speech creates a pecuniary gain for the speaker, or where the speech is promulgated for a pecuniary benefit, the speech is protected by the First Amendment. *Id.*

Here, “Dumb Blonde” is Ms. Luhv’s stage name. Her stage name is of vital commercial importance to her as a musician. When fans attend a concert, they attend to see “Dumb Blonde,” not Ms. Luhv. Ms. Luhv has been using her stage name continuously since 2012. During that time she has acquired a devoted fan base who identify Ms. Luhv as “Dumb Blonde” and are willing to purchase tickets to her shows. In addition, Ms. Luhv consistently posts videos on the video hosting website www.uTube.com under the name “Dumb Blonde.” Her video channel has over 100,000 followers who identify the mark “Dumb Blonde” with their music of choice. Ms. Luhv’s stage name is a direct form of advertising that proposes a commercial transaction; buy my music. Furthermore, when Ms. Luhv’s fans see a

product with the “Dumb Blonde” mark on it, they are more likely to buy that product due to her popularity as Dumb Blonde. This directly benefits Ms. Luhv financially. Therefore, Ms. Luhv’s stage name proposes the sale of her commercial and musical products just as the pharmacist’s advertisements proposed the sale of their product in *Virginia Board of Pharmacy*.

In *Friedman v. Rodgers*, an optometrist challenged a provision in the Texas Optometry Act prohibiting optometrists from operating under a trade name. *Friedman*, 440 U.S. at 1. The court held that a trade name is a form of commercial speech because it proposes a commercial transaction and thus is entitled to protection under the First Amendment. *Id.* at 11.

Here, “Dumb Blonde” proposes a commercial transaction. When a client walked past a store bearing Rodgers’ trademark, they are instantly able to identify it as an optometrist’s office. For an individual requiring the services of an optometrist, this is a clear invitation to conduct a business transaction. When an individual who is a fan of Dumb Blonde sees an item with a Dumb Blonde logo on it, the logo entices that fan to buy the product. Ms. Luhv benefits commercially from that purchase. Because an individual will be more likely to purchase a product based on a popular logo or trademark, the owners of these trademarks gain a direct pecuniary benefit from their use. In addition, a finding that Ms. Luhv did intend to editorialize on societal issues is not required in order to find that her trademark is protected commercial speech under the holding in *Friedman*.

Because Ms. Luhv's trademark proposes a commercial transaction for her pecuniary benefit, Ms. Luhv's trade name is protected under the First Amendment as commercial speech.

B. The Lower Court Correctly Held That The Government's Refusal To Register Ms. Luhv's Mark Implicates The First Amendment Under The Unconstitutional Conditions Doctrine.

The First Amendment is implicated when the government takes any action that abridges the right of the individual to exercise freedom of speech. *B&B Hardware, Inc. v. Hargis Ind., Inc.*, 135 S. Ct. 1293, 1300 (2015). In this case, Ms. Luhv's constitutional rights are abridged under the unconstitutional conditions doctrine. The unconstitutional conditions doctrine states that the government cannot condition a person's receipt of a governmental benefit on the waiver of a constitutionally protected right. *Rumsfeld v. Forum for Academic & Institutional Rights, Inc.*, 547 U.S. 47, 59 (2006). In addition, for the unconstitutional conditions doctrine to apply, the government benefit being denied must arise from a regulatory scheme and not a program supported by public funds. *United States v. Am. Library Ass'n, Inc.*, 539 U.S. 194, 211 (2003) The PTO is not supported by public funds. Since 1991, PTO operations have been funded entirely by registration fees, not the taxpayer. *Figueroa v. United States*, 466 F.3d 1023, 1028 (Fed. Cir. 2006).

In *B&B Hardware, Inc. v. Hargis Ind., Inc.*, the court held that the registration of a trademark confers "important legal rights and benefits" on the trademark owner and therefore, the registration of a mark implicates the First

Amendment under the unconstitutional conditions doctrine. *B&B Hardware* 135 S. Ct. at 1300.

In *Perry v. Sindermann*, a state junior college professor, who was employed through a succession of one year contracts, was terminated based on statements he made critical of the school's administration. The court held that the respondent's lack of a contractual right to re-employment is immaterial to his free speech claim. In doing so, the court stated that, even though a person has no 'right' to a valuable governmental benefit, and even though the government may deny him the benefit for a variety of constitutional reasons, the government may not deny a benefit to a person based on an infringement of his constitutionally protected interests—especially, his interest in freedom of speech. *Perry v. Sindermann*, 408 U.S. 593, 597 (1972).

In *Dep't of Tex. Veterans of Foreign Wars v. Tex. Lottery Comm'n*, the Veterans of Foreign Wars challenged a Texas law allowing charitable organizations to hold bingo games so long as the resulting funds were not used for lobbying. *Dep't of Tex. Veterans of Foreign Wars v. Tex. Lottery Comm'n*, 760 F.3d 427, 430 (5th Cir. 2014). In that case, the Fifth Circuit found that if public funds are not used to support the program, the government may not attach speech restrictions to the regulation. *Id.* at 436. Because no public funds were used to regulate the bingo games the Fifth Circuit held that the unconstitutional conditions doctrine applied and the first amendment was implicated. *Id.*

Section 2(a) of the Lanham act implicates the unconstitutional conditions doctrine. Ms. Luhv has a constitutional right to exercise her freedom of speech in a commercial context. However, Section 2(a) expressly limits her ability exercise this right by abridging her ability to trademark “Dumb Blonde.” Here, the governmental benefit denied is the registration of the trademark.

It is uncontroverted that the registration of a trademark provides a benefit to Ms. Luhv since registration of a trademark provides significant substantive and procedural benefits such as the presumptive validity of the mark, 15 U.S.C. §1057(b), the incontestability of the mark, *Id.* at §1065, and “the right to exclusive nationwide use of the mark.” 15 U.S.C. §1072. Ms. Luhv’s outstanding musical contract is also predicated on the registration of her mark and therefore, the Government’s denial of her registration is an existential threat to her music career.

It is equally uncontroverted that freedom of speech is a constitutionally protected interest and that Ms. Luhv’s stage name falls within the category of protected commercial speech as discussed in Section A above. As in *Perry*, where a governmental benefit was denied to an professor based on his speech, here, the government is predicating the benefits of registration on the tacit agreement not to trademark certain items. This agreement is the waiver of constitutional rights required by the unconstitutional conditions doctrine. Section 2(a) of the Lanham act denies Ms. Luhv a clear benefit based on the exercise of her protected commercial speech.

In addition, the unconstitutional conditions doctrine applies because the governmental benefit denied arises out of a regulatory scheme and not a publicly funded program. Similar to the regulatory scheme in *Tex. Lottery Comm'n*, the PTO is not funded through public funds but rather is funded through registration fees. *Figueroa* 466 F.3d at 1028. Here, because public funds are not used to support the PTO, the government is foreclosed from placing First Amendment limitations on speech associated with the PTO regulations. Section 2(a) is a prototypical regulatory regime, not a government funded program. Therefore, the unconstitutional conditions doctrine should apply as it did in *Tex. Lottery Comm'n*.

This rationale is supported by the written holding of the lower court. The lower court correctly held that the Lanham Act confers substantive and procedural rights and benefits to trademark owners who register their marks and that Ms. Luhv's tradename was a constitutionally protected interest. *In re Kourtney Luhv*, 1337 F.3d 455, 459 (Fed. Cir. 2015). In accordance with *Perry*, the court further held that the unconstitutional conditions doctrine was violated when the government denied a benefit to Ms. Luhv, based on an abridgment of her First Amendment right to freedom of speech. *Id.*

Because Ms. Luhv was denied registration of her stage name, and because her stage name is protected commercial speech, the Government has taken an action implicates the First Amendment under the unconstitutional conditions doctrine.

C. The Lower Court Correctly Held That The Government's Refusal To Register Ms. Luhv's Mark Is Unconstitutional Under The First Amendment.

The government's regulations limiting Ms. Luhv's ability to trademark her stage name in violation of her First Amendment rights are unconstitutional under the *Central Hudson* framework.

In order for a government action limiting protected speech to be constitutional, the government must meet four interrelated tests. *Cent. Hudson*, 447 U.S. at 566. First, if the speech does not concern illegal activity, or is not misleading, it is unconstitutional for the government to regulate it. *Id.* Second, if the government's interest is not substantial, it is unconstitutional for the government to regulate the speech. *Id.* Third, if the regulation does not advance the substantial governmental interest, the regulation is unconstitutional. *Id.* Fourth, if the regulation is more extensive than necessary to serve the substantial governmental interest, the regulation is unconstitutional. *Id.*

1. Ms. Luhv's trademark is not misleading and it does not concern illegal activities.

The first prong of the *Central Hudson* analysis is a restatement of U.S.C. § 1052(e) (a mark that is deceptive or misleading may not be registered). *Cent. Hudson*, 447 U.S. at 566. Under § 1052(e), the "PTO may not simply rely on a lack of distinctiveness to deny registration, but must make the more difficult showing of public deception." *In re California Innovations, Inc.*, 329 F.3d 1334, 1336-37 (Fed. Cir. 2003). In addition, the court in *In re California* adopted the following test for deception. To deny a mark protection under § 1052(a), the PTO must establish that; (1) the mark misrepresents or misdescribes the goods, (2) the public would likely

believe the misrepresentation, and (3) the misrepresentation would materially affect the public's decision to purchase the goods. *Id.*; See *In re Budge Mfg. Co.*, 857 F.2d 773, 775 (Fed. Cir. 1988). This test should be applied here.

In *In re Save Venice New York, Inc.*, the applicant, who was a producer of Venetian style art manufactured in the United States, sought to register the mark “The Venice Collection.” The court held that because the types of goods manufactured by the applicant so closely resembled goods actually manufactured in Venice, the mark was deceptive. In *In re Save Venice New York, Inc.*, 259 F.3d 1346 (Fed. Cir. 2001).

Similarly, in *In re Wada*, the applicant sought to register the trade name “New York Ways Gallery” in order to market leather goods manufactured outside New York. The court held that the use of the name New York in the mark created a misleading expectation in the mind of the consumer that the goods were produced in New York. *In re Wada*, 194 F.3d 1297 (Fed. Cir. 1999).

Here, that misleading expectation is not present. The record is clear that Ms. Luhv’s countless fans understand that the mark “Dumb Blonde” refers to Ms. Luhv. There is no more danger that an individual consumer would mistake the name “Dumb Blonde” for something other than Ms. Luhv’s musical persona than there is danger that a consumer would mistake the NFL logo as representing something other than the NFL. Additionally, there is no danger that whatever “misrepresentation” could possibly exist as to the name “Dumb Blond” would materially affect consumer’s purchase of Ms. Luhv’s merchandise or music. There is

no commercially viable connection between the mark “Dumb Blonde” and any other commercial industry or product as there was in *Wada* and *In re Save Venice*.

Therefore, Ms. Luhv’s stage name, “Dumb Blonde” is not misleading and certainly cannot be said to concern illegal activities.

2. The Government’s asserted interest in limiting trademarks under Section 2(a) is not substantial.

In *Sorrell v. IMS Health Inc.*, data miners, who buy medical prescription data from pharmacies, challenged the constitutionality of a Vermont law prohibiting the distribution of that information on the grounds that it violated their First Amendment right to commercial speech. *Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653, 2656 (2011). In applying the *Central Hudson* analysis, the court looked to the government’s asserted interest which was preventing doctors from being coerced or harassed by pharmaceutical sales representatives that utilize medical prescription data. The court held that this interest was not substantial because although, “a few physicians may [feel] coerced and harassed, [the First Amendment cannot] sustain a broad content-based rule” abridging the First Amendment. *Id.* at 2669. The court further stated, “[m]any [individuals] must endure speech they do not like, but that is a necessary cost of freedom” reasoning that only a minority of doctors felt coerced and harassed. *Id.*; *See also Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60, 71 (1983) (holding that the Supreme Court has “consistently held that the fact that protected speech may be offensive to some does not justify its suppression.”). In addition, in *United States v. Eichman*, the court held that “[it is a] bedrock principle

underlying the First Amendment...that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable. *United States v. Eichman*, 496 U.S. 310, 319 (1990).

Here, the government's interest is in preventing trademarks from offending or disparaging individuals. This interest is not substantial. Under the logic of *Sorrell*, *Bolger*, and *Eichman*, a governmental interest implemented through broad content based speech bans is not substantial if it seeks to prevent injury to a small group of individuals, who may or may not be harmed. Here, the government is seeking to broadly ban all trademarks that could potentially be disparaging or offensive to certain individual. This is a broad, content based, First Amendment restriction. As in *Sorrell*, few individuals find Ms. Luhv's trademark offensive or derogatory. In fact, many women who are familiar with Ms. Luhv's work infer a positive meaning from the mark "Dumb Blonde." These individuals, as well as Ms. Luhv, see the mark "Dumb Blonde" as a way to "reclaim" a stereotype. Ms. Luhv has a devoted fan base of women in their twenties and thirties who have an assortment of hair color. Many of these women leave positive comments on media sites associated with "Dumb Blonde." These comments include, "Your ability to bring attention to the challenges faced by women is inspiring," "[A]s a blonde woman, I totally support you" and "There need [sic] to be more women like you serving as positive role models for young girls." In short, Ms. Luhv's trademark is protected speech which, though it may be offensive to a small group of individuals,

is constitutionally inviolate under the logic of *Sorrell* and *Bolger*. Therefore, the government's interest is not substantial.

The government may also claim a substantial interest is in preventing consumers from interpreting a disparaging mark as being endorsed by the government. This risk is overstated. Consumers in today's world see trademarks on a day to day basis and would not conflate trademarks with government endorsement of the product or message. For example, the Nike symbol is a well-known and popular trademark. It would be unreasonable to believe that the average consumer, seeing a Nike symbol, would believe that the government is endorsing the Nike product or message. In fact, the average person would probably not even realize that the symbol is trademarked through government action at all. Therefore, the risk that consumers would interpret a potentially disparaging mark as endorsed by the government is negligible.

The government's interest is not substantial, and without a substantial governmental interest, Section 2(a) of the Lanham Act, the government fails the *Central Hudson* test.

3. Even if the Government's asserted interest is substantial, Section 2(a) does not directly advance that interest.

Even if this Court finds that the governmental interest provided in this case is substantial, the governmental restriction does not directly advance that interest.

In order for a governmental regulation to advance a substantial interest, the restriction must directly advance the state interest involved. *Central Hudson*, 447

U.S. at 564. In addition, the regulation will not be sustained if it provides only ineffective or remote support for the government's purpose. *Id.*

In *Bates v. State Bar of Arizona*, two attorneys were disciplined for violating a rule banning them from advertising. *Bates v. State Bar of Arizona*, 433 U.S. 350 (1977). The State Bar asserted that the governmental interest was legal professionalism in the state of Arizona and the protection of consumers from subpar legal work. The court held that although these were substantial interests, the governmental regulation did not directly advance those interests because advertising has little effect on the competency of a lawyer. A lawyer could be competent and advertise or incompetent and not advertise. After all, bankers and engineers advertise and yet their professionalism is not in question. *Id.*

In *Rubin v. Coors Brewing Co.*, Coors Brewing challenged a Federal Alcohol Administration Act prohibiting the placement of alcoholic content labels on containers of beer but not on containers of wine or spirits. *Rubin v. Coors Brewing Co.*, 514 U.S. 476, 478-79 (1995). The asserted governmental interest was the prevention of an “alcohol content war” among producers of alcoholic beverages. *Id.* at 487-88. The court in *Rubin* held that the governmental regulation did not directly advance that interest for two reasons. *Id.* First, the prohibition only applied to beer labels and not other types of alcoholic beverages. Second, the prohibition only prevented alcohol content from being placed on labels but did not prohibit alcohol content from being placed on other forms of advertising. The governmental interest was not directly advanced because the regulation is under broad and thus did not

prevent an “alcohol content war” in advertising or on other forms of alcoholic beverages.

The same is true here. Non-registration of the mark does not limit Ms. Luhv’s ability to use the mark. Even without registration, Ms. Luhv is free to use the mark whenever she so chooses. This fact defeats the purpose of the governmental regulation as was the case in *Rubin* and *Bates*. Here, any individual who the Lanham act allegedly protects from disparagement would inevitably still be subject to the same disparagement if Ms. Luhv continued to use the mark without registration. Thus, just as in *Rubin*, the offending mark will be in the public eye no matter what the prohibition in Section 2(a) states. *See also Bad Frog Brewery, Inc. v. New York State Liquor Auth., 134 F.3d 87, 101 (2d Cir. 1998)*. In fact, the only individual directly affected by the application of Section 2(a) is Ms. Luhv who is left unable to protect the brand name she built her career around. Therefore, the prohibition against the registration of Ms. Luhv’s trademark does not actually serve the asserted state interest.

Because the governmental interest is not directly advanced by Section 2(a), the government fails to meet the third prong of the *Central Hudson* analysis and consequently, Section 2(a) is unconstitutional.

4. Even if the Government’s asserted interest is substantial and Section 2(a) does directly advance that interest, Section 2(a) is more extensive than necessary.

The last prong of the *Central Hudson* analysis asks if the governmental interest could still be served by a more limited restriction. *Central Hudson*, 447 U.S.

at 564. If the governmental interest could be served by a more limited restriction, the challenged constraint is unconstitutional. *Id.* In general, courts find that the governmental interest is more extensive than necessary if an alternative method of advancing the state interest, that doesn't implicate the First Amendment, is available. *Bad Frog Brewery, Inc. v. New York State Liquor Auth.*, 134 F.3d 87, 101 (2d Cir. 1998).

For example, in *44 Liquormart*, retail liquor price advertising was banned in order to advance an asserted state interest in temperance. The Court held that several less restrictive and equally effective measures were available to the state such as increased taxation, limits on purchases, and educational campaigns. *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 506 (1996); *See Rubin*, 514 U.S. 491 (holding that alternatives were available that would not implicate the First Amendment's protection of commercial speech; *See also Bad Frog* 134 F.3d at 101 (holding that numerous less intrusive alternatives existed to advance the asserted state interest in protecting children from vulgarity).

In this case, as in *44 Liquormart*, *Rubin* and *Bad Frog*, alternatives exist to further the governmental interest. The governmental interest in preventing disparaging speech is an interest in preventing social harm by the written or spoken words. That goal can be accomplished through the enforcement of other regulatory measures such as the enforcement of hate speech legislation and the enforcement of limitations on dangerous speech or speech deemed "fighting words." Each of these forms of speech are already considered unprotected by the First Amendment.

Therefore, if Section 2a were to be struck from the Lanham act, the government would still be able to limit certain particularly detrimental forms of speech, including speech which is derogatory towards groups of people, but would only be able to do so under a framework that is unquestionably constitutional. This regulation of speech would be a less intrusive alternative that would advance the same asserted governmental interest.

Therefore, because alternative regulatory schemes which do not implicate the First Amendment exist, Section 2(a) of the Lanham act is more extensive than necessary and fails to satisfy the requirements of the *Central Hudson* four prong test.

CONCLUSION

Wherefore, the Respondent respectfully requests that the Federal Circuit’s decision that the mark “Dumb Blonde” is disparaging within the meaning of 15 U.S.C. § 1052(a) be reversed. Further, Respondent respectfully requests that the Federal Circuits decision finding that 15 U.S.C. § 1052(a) is an unconstitutional violation of the First Amendment be upheld.

Respectfully submitted,

/s/ Team 122
Team 122

CERTIFICATION

Submission of the brief certifies that such brief has been prepared in accordance with the Rules of the Competition and that it represents the work product solely of competing Team 122.

/s/ Team 122
Team 122

