

No. 15—1007

*In the Supreme Court of the
United States*

OCTOBER TERM 2015

UNITED STATES,
Petitioner,

v.

KOURTNEY LUHV,
Respondent.

*ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE FEDERAL CIRCUIT*

BRIEF FOR RESPONDENT

Counsel for Respondent
October 20, 2015

QUESTIONS PRESENTED

- I. Whether the Trademark Trial and Appeal Board (“TTAB”) erred in rejecting a trademark application under §2(a) of the Lanham Act, where the applicant used the mark in connection with an empowering message, and provided evidence of the mark’s positive reception.
- II. Whether § 2(a)’s prohibition on registering marks that may be disparaging violates the First Amendment where the registration of the mark is conditioned upon forfeiture of free speech and the government interests in the law are illegitimate and not advanced by the law?

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OPINION BELOW

The opinion of the Trademark Trial and Appeal Board is unreported. The United States Court of Appeals for the Federal Circuit decision is reported as *United States v. Kourtney Luhv*, 1337 F.3d 455 (Fed. Cir. 2015).

STATEMENT OF JURISDICTION

The Court of Appeals rendered judgment on June 6, 2015. The petition for writ of certiorari was granted by this Court. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1) (2012).

STANDARD OF REVIEW

The Court reviews findings of fact of the Trademark Trial and Appeal Board (“TTAB”) under a substantial evidence test. *See Pro-Football, Inc. v. Harjo*, 284 F.Supp.2d 96, 116 (D.D.C. 2003). The ultimate question of registration is reviewed *de novo*. *See United States v. Luhv*, 1337 F.3d 455, 455 (Fed. Cir. 2015).

CONSTITUTIONAL AND STATUTORY PROVISIONS

The relevant statutory provisions are § 1052(a) of the Lanham Act, Title 15, Chapter 22, of the United States Code (“§ 2(a”). The relevant constitutional provision is U.S. Const. Amend. I.

STATEMENT OF THE CASE

Factual History

Appellant Kourtney Luhv (“Appellant”) is a vocalist and solo music artist, performing under the stage name “Dumb Blonde.” *United States. v. Luhv*, 1337 F.3d 455, 455 (Fed. Cir. 2015). Ms. Luhv creates music focused on women’s issues in today’s society. *Id.* She has a devoted fan base whom frequent her concerts, as well as a prominent online presence with many users following her music on www.soundpuff.com and www.uTube.com, where she posts videos under the name DumbBlondeMusic. *Id.* at 455-56. At the time she applied to register her trademark, she had over 40,000 followers on her Soundpuff account and over 100,000 active subscribers on her uTube channel. *Id.* at 456. In June 2014, appellant sought to release a record via a record label and negotiated a recording contract that included a \$2,000,000.00 advance upon execution of the agreement. *Id.* This deal was contingent upon her ability to register a trademark for “Dumb Blonde.” *Id.*

Procedural History

On July 9, 2014, Appellant filed Application No. 99/989,052 (“’052 Application”) with the Patent and Trademark Office (“PTO”). *Id.* She sought to register the mark “Dumb Blonde” for “[e]ntertainment, namely live performances by a musical band and clothing, namely, sweatshirts, t-shirts, tank tops, and headwear.” *Id.* (internal quotations omitted). The examining attorney refused to register the mark because it may be disparaging to women under 15 U.S.C. § 1052(a) (the “Lanham Act”), citing various materials submitted with the ‘052

application. *Id.* Appellant contested the denial and appealed the decision to the Trademark Trial and Appeal Board (“TTAB”). *Id.* The TTAB affirmed the examining attorney’s decision, stating that the mark may be disparaging to a substantial composite of the referenced group, namely, women with blonde hair. *Id.* In affirming the decision, the TTAB looked at photographs of blonde women from Appellant’s website, dictionary definitions, articles and user comments on Appellant’s uTube videos. *Id.* at 456-57.

Ms. Luhv asserts that she chose the mark as a way to reclaim the stereotype and raise awareness of the challenges stemming from gender discrimination. *Id.* at 457. Additionally, she provided evidence that women view the term positively, pointing to supportive comments left on her social media websites. *Id.* at 458. She appealed the TTAB’s decision, contending that “1) the views of the women cited by the examining attorney do not accurately reflect the views held by [her] fans or a substantial composite of women; and 2) that the Lanham Act’s prohibition on registering marks that may be disparaging violates the Constitution.” *Id.*

SUMMARY OF THE ARGUMENT

The United States Court of Appeal, Federal Circuit (“Federal Circuit”) incorrectly affirmed the TTAB’s refusal to register Ms. Luv’s trademark “Dumb Blonde.” First, the trademark is not disparaging within the meaning of § 2(a) because the likely meaning of “Dumb Blonde,” considered in the context of Ms. Luv’s music and merchandise, is a positive reference towards blonde women. Next, Petitioner provided insufficient evidence that a substantial composite of blonde women do in fact find the mark disparaging. Moreover, Ms. Luv provided evidence that contradicts Petitioner’s contention, weighing in favor of passing the mark for publication.

Second, § 2(a)’s prohibition on marks that may be disparaging violates the First Amendment of the United States Constitution. The benefits of trademark registration are conditioned upon the forfeiture of First Amendment free speech rights. This violates the Unconstitutional Conditions Doctrine. Furthermore, as entwined commercial and expressive speech, trademarks are entitled to the full protections of the First Amendment and cannot be prohibited by content-based means. Even if trademarks are held to be purely commercial, the government interests in § 2(a) do not fulfill the requirements of the *Central Hudson* test, therefore invalidating the law.

ARGUMENT

I. THE TTAB ERRED IN REJECTING MS. LUHV'S APPLICATION TO REGISTER THE MARK 'DUMB BLONDE' BECAUSE PETITIONER FAILED TO PROVE THAT A SUBSTANTIAL COMPOSITE OF BLONDE WOMEN FIND THE MARK DISPARAGING WITHIN THE MEANING OF THE LANHAM ACT § 2(A).

In order to refuse a trademark, Petitioner bears the burden of proving that the mark fell within a prohibition of § 2(a) of the Lanham Act. *See In Re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 2006 WL 1546500, at *8 (TTAB May 23, 2006). § 2(a) bars registering trademarks that “[c]onsist[] of . . . 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). To determine whether a mark is disparaging, the Trade Trial and Appeal Board (“TTAB”) applies the following two-part test:

- “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 and in connection with the goods and services; and
- 2) If the meaning is found to refer to identifiable persons . . . whether that meaning may be disparaging to a substantial composite of the referenced group.”

In Re Heeb Media, LLC, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, at *4 (TTAB Nov. 26, 2008). The inquiry is necessarily a case-by-case determination, with conflicting evidence regarding disparagement weighing in favor of publication. *See In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994).

A. The Likely Meaning Of The Mark, Considered In Conjunction With Ms. Luv's Performances And Merchandise, Is A Positive Reference Towards Women.

To determine the likely meaning of a mark, courts must look beyond the dictionary definition of the term. *See In Re Tam*, 108 U.S.P.Q.2d 1305, 2013 WL 5498164, at *5 (TTAB Sept. 26, 2013). Specifically, courts examine the manner in which the applicant uses the mark in the context of the marketplace, as applied only to the goods and services described in the application for registration. *See In Re Heeb Media, LLC*, 2008 WL 5065114, at *4, 89 U.S.P.Q.2d 1071 (TTAB Nov. 26, 2008); *see also In Re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 2006 WL 1546500, at *22 (TTAB May 23, 2006).

A derogatory dictionary definition is probative in determining a mark's meaning. *See Heeb*, 2008 WL 5065114, at *4. In *Heeb*, the court rejected the applicant's trademark, finding the likely meaning of the term "Heeb," when used in connection with applicant's goods and services (namely, clothing and entertainment) violated § 2(a) of the Lanham Act. *Id.* at *1. The TTAB looked negatively upon the fact that "the dictionary definitions unanimously underscore the derogatory nature of Heeb." *Id.* at *6. Therefore, the court refused to recognize that the term carried a second, non-offensive meaning. *Id.*

Courts are likely to find that a mark has a negative meaning when the public continues ascribing the term its original, derogatory meaning. *See Tam*, 2013 WL 5498164, at *5; *see also Heeb*, 2008 WL 5065114, at, *1 (noting that many individuals in the referenced group considered the term disparaging when used in connections with applicant’s magazine). In *Tam*, the evidence demonstrated that members of the referenced group continued to interpret the mark as a derogatory term, even when used in connection with the band’s music and imagery. *Id.* at *6.

The meaning of a mark changes when consumers interpret the mark in a manner that strips the term of its negative connotation. *See Applicant’s Req. for Recons.* at 13-16, *In re San Francisco Women’s Motorcycle Contingent*, No. 78/281.746, (TTAB April 26, 2005) (“Dykes on Bikes”); *See also Squaw Valley*, 2006 WL 1546500, at *22 (noting that when the term “squaw” was used in connection with applicant's goods consumers thought of the well known ski resort). In *Dykes on Bikes*, the TTAB published the mark “Dykes on Bikes” based on evidence that the referenced group ascribed the term a new and positive meaning when used in connection with applicant’s services. *Id.* at 16. The fact that consumers now associated “dyke” with community pride events exemplified the term’s non-disparaging meaning. *Id.* at 17.

While it is undisputed that in the abstract, the term “Dumb Blonde” references women with blonde hair, considered in conjunction with Ms. Luhv’s performances and merchandise, the term’s meaning transforms. As a threshold matter, unlike the racial and religious epithets at issue in *Heeb* and *Tam*, the

dictionary does not define the term “Dumb Blonde” as derogatory. Additionally, unlike the band’s use of the mark in *Tam*, Ms. Luhv uses the mark in a manner that gives the term a positive meaning. For example, her lyrics focus on the issues women face in today’s society and her brand raises awareness of gender discrimination and negative stereotypes. *See Luhv*, 1337 F.3d at 455-57. Further, Ms. Luhv receives positive comments on her social media websites, demonstrating that women support her use of the term. *Id.* at 457.

In *Dykes on Bikes*, the pride events became so popular that consumers began associating the once offensive term with the community bike ride. Similarly, Ms. Luhv’s popularity demonstrates that consumers likely associate the mark with her music and merchandise, ascribing a new meaning to the term. Ms. Luhv has a widespread fanbase, with over 40,000 followers on her Soundpuff account and over 100,000 active subscribers on her uTube channel, not to mention those who support her music even though they do not follow her on social media. *Id.* at 456. Accordingly, through Ms. Luhv’s use of the mark, those in the relevant group now prescribe the term an empowering meaning.

B. Petitioner Failed To Satisfy Its Burden Of Proving That A Substantial Composite Of Blonde Women Find The Mark Disparaging.

To determine whether a mark is disparaging, the perceptions of the examining attorney and the general public are irrelevant. *See Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d. 96, 129 (2003); *see also In re Boulevard Entm’t*, 334 F.3d 1336, 1340 (Fed. Cir. 2003). Further, it is insufficient to present evidence that a

substantial composite of the referenced group deems a term disparaging or offensive in the abstract. *See In Re Squaw Valley Dev. Co.*, 2006 WL 1546500 at *7, 80 U.S.P.Q.2d 1264 (TTAB May 23, 2006). Rather, courts consistently hold that context is particularly important, and there must be evidence that the referenced group does in fact find the use of the mark disparaging, when used in connection with the relevant goods or services. *Id.*; *In Re Heeb Media, LLC*, 2008 WL 5065114, at *5, 89 U.S.P.Q.2d 1071 (TTAB Nov. 26, 2008).

The PTO fails to meet its burden absent evidence that the relevant group finds applicant's use of the mark disparaging. *See Harjo*, 284 F.Supp.2d. at 136; *see also Squaw Valley*, 2006 WL 1546500, at *22 (stating that it is inapposite whether the referenced group finds the term offensive in the abstract.). In *Harjo*, the TTAB cancelled the registration of the mark "Redskins." *Id.* at 99. The TTAB examined evidence demonstrating the disparaging nature of the term, including expert testimony, a survey of Native Americans, historical commentary, letters from prominent Native Americans, and news articles. *Id.* at 130-35. Despite the abundance of evidence, the court reversed the TTAB decision, continuously stating that the evidence failed to shed light on whether a substantial composite of Native American's *actually* found the term disparaging in the context of the professional football team. *Id.* (emphasis added). Further, the court noted that merely because a term offends, does not mean it disparages. *Id.* at 130.

Receiving positive reception from those in the referenced group proves the mark's non-disparaging nature. *See Applicant's Req. for Recons.* at 19-23, *In re San*

Francisco Women’s Motorcycle Contingent, No. 78/281.746, (TTAB April 26, 2005) (“Dykes on Bikes”). In *Dykes on Bikes*, the Board approved the controversial mark “Dykes on Bikes.” The applicant submitted evidence that the LGBT community, including community leaders and scholars, harbored a positive perception of the term “dyke” when used in connection with the San Francisco Women’s Motorcycle Contingent. *Id.* Moreover, the applicant stated their intent to reclaim the term and recast it in manner that invoked pride. *Id.* at 23.

Conversely, evidence that prominent leaders in the referenced group find the term objectionable weighs in favor of finding disparagement. *See Heeb*, 2008 WL 5065114, at *7-8. In *Heeb*, the court refused to register the mark “Heeb.” *Id.* at *1. The examining attorney provided ample evidence that prominent members of the Jewish community found the term objectionable in any context, including in the context of the goods and services listed in the application. *Id.* at *8. Specifically, the founder of HEEB magazine admitted that there are “some people, who are fairly prominent in the Jewish community, who have written me some nasty emails, who definitely said that they're offended by the name.” *Id.* at *6.

Associating the mark with offensive sentiments demonstrates that the referenced group finds the mark disparaging. *See In re Geller*, 751 F.3d 1355, 1361 (Fed. Cir. 2014). In *Geller*, applicants sought to register the mark “STOP THE ISLAMISATION OF AMERICA.” *Id.* at 1357. The goods and services included informational pamphlets on understanding and preventing terrorism. *Id.* The TTAB

rejected the mark, noting that associating Islam with terrorism created a direct connection that disparaged a substantial composite of Muslims. *Id.* at 1361.

Petitioner provided scant evidence as to whether a substantial composite of blonde women find the mark disparaging when used with Ms. Luhv's products. In *Harjo*, Plaintiff provided an array of evidence to demonstrate the disparaging nature of the term "Redskin." However, the court found the evidence insufficient because it did not matter whether the term was disparaging in a vacuum or to members of the public who are not in the referenced group. Contrastingly, in *Heeb*, the PTO provided ample evidence that members of the Jewish community found the term offensive, even when used in connection with the applicant's goods. In the instant case, Petitioner's only evidence consists of dictionary definitions, online comments, and articles supporting the idea that women find the phrase "dumb blonde," as well as dumb blonde jokes to be offensive. However, this is irrelevant in this Court's analysis, as it does not adequately address the second inquiry. Absent evidence that blonde women in particular find the term disparaging when used in connection with Ms. Luhv's performances and merchandise, the second prong necessarily fails.

Moreover, Ms. Luhv did in fact provide evidence that women in the referenced group perceive the mark positively when used in connection with her performances. In *Dykes on Bikes*, applicant provided abundant evidence that the LGBT community supported applicant's use of the term and viewed it as a positive reclamation. Similarly, Ms. Luhv provided ample evidence that women view the

mark positively, specifically, the composition and prevalence of women at her concerts and the feedback she received regarding the images on her website. *See Luhv*, 1337 F.3d at 458. Additionally, Ms. Luhv points to positive comments posted by members of the referenced group on social media websites, including “[A]s a blonde woman I totally support you even if the haters gon’ hate,” and “[t]here need to be more women like you serving as positive role models for young girls rather than grinding on Robert Thin!” *Id.*

Further, in *Dykes on Bikes*, the applicant was a member of the “referenced group” and the Board looked favorably at the applicant’s intent to reclaim the term. Likewise, Ms. Luhv asserts an intent to reclaim the term “by displaying it positively alongside a woman with a successful career, and through musical lyrics that shed light on critical issues faced by women.” *Id.*

Accordingly, the PTO failed to meet its burden of providing sufficient evidence that a substantial composite of blonde women find Ms. Luhv’s use of the mark disparaging.

C. The TTAB Improperly Rejected Passing The Mark For Publication Because Ms. Luhv Provided Sufficient Evidence To Raise Doubts Regarding The Mark’s Offensiveness.

When doubts arise as to a mark’s offensiveness, courts should resolve the issue in favor of the applicant. *See In re Mavety Media Group Ltd*, 33 F.3d 1367, 1374 (Fed. Cir. 1994). Subsequently, anyone who opposes the mark has the opportunity to bring an opposition proceeding and establish a more complete record.

See In Re in over Our Heads Inc., 16 U.S.P.Q.2d 1653, 1990 WL 354546, at *1 (TTAB Aug. 28,1990).

The TTAB passes a mark for publication when there is evidence that the referenced group supports the use of the mark. *See In over Our Heads Inc.*, 1990 WL 354546, at *1; *see also In Re Squaw Valley Dev. Co.*, 2006 WL 1546500 at *7, 80 U.S.P.Q.2d 1264 (TTAB May 23, 2006) (“[d]oubts on the issue of whether a mark is disparaging are resolved in favor of the applicant[.]”). In *In over our Heads*, the TTAB reversed the examining attorney’s refusal to register the mark “Moonies” on the basis that the mark may disparage the Unification Church founded by the Reverend Sun Myung Moon. *Id.* The Board examined conflicting evidence regarding how the referenced group viewed the term and emphasized that determining whether a mark disparages a certain group is necessarily highly subjective. *Id.* Therefore, doubts should be resolved in favor of the applicant, with the knowledge that if a group finds the mark disparaging, they can bring an opposition proceeding in order to establish a more complete record. *Id.*

As the dissent correctly determined, Ms. Luhv provided substantial rebuttal evidence that women find the term empowering, rather than disparaging. Ms. Luhv demonstrated that hundreds of thousands of female fans attend her concerts. Additionally, she receives positive reception from her website’s images of blonde women and positive comments on her social media sites. *Luhv*, 1337 F.3d at 458. Therefore, even if this Court found Petitioner’s nominal evidence persuasive, the fact that Ms. Luhv raised doubts as to the disparaging nature of the term

demonstrates that the TTAB should have passed the mark for publication. At that point, if a blonde woman took issue with the stage name, it would be her prerogative to bring an opposition proceeding in order to create a more complete record.

II. §2(A) OF THE LANHAM ACT IS UNCONSTITUTIONAL BECAUSE IT VIOLATES BOTH THE UNCONSTITUTIONAL CONDITIONS DOCTRINE AND THE CENTRAL HUDSON TEST FOR COMMERCIAL SPEECH.

Trademarks are speech, entitled to the same First Amendment protections as other forms of speech. *See Friedman v. Rogers*, 440 U.S. 1, 11 (1979). The Supreme Court held that “the creation and dissemination of information are speech within the first amendment.” *Sorrell v. IMS Health Inc.*, 131 S.Ct. 2653, 2667 (2011).

Trademarks are “a device (as a word) pointing distinctly to the origin or ownership of merchandise to which it is applied and legally reserved to the exclusive use of the owner as maker or seller.” Webster’s Dictionary: Trademark, <http://www.merriam-webster.com/dictionary/trademark> (last visited October 19, 2015). As such, they are creations that are disseminated onto the public in order to inform of the corresponding product.

A bedrock principle underlying the First Amendment is that “the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.” *Texas v. Johnson*, 491 U.S. 397, 414 (1989). The Lanham Act, the primary federal device for trademark law, includes § 2(a), in which disparaging trademarks are excluded from the protections of federal trademark

registration. 15 U.S.C. 1052(a). § 2(a) violates the First Amendment of the Constitution, as it attempts to prohibit possibly disparaging trademark speech from registration. As demonstrated herein, § 2(a) violates the Unconstitutional Conditions Doctrine and the *Central Hudson* test for commercial speech.

A. The Action Taken By The Government Violates The Unconstitutional Conditions Doctrine Because The Benefits Of Federal Trademark Registration Are Conditioned Upon A Forfeiture Of First Amendment Rights.

The Unconstitutional Conditions Doctrine states that the federal government cannot condition access to a benefit upon the surrender of a constitutional right. *See Perry v. Sindermann*, 408 U.S. 593, 597 (1972); *see also Rumsfeld v. Forum For Acad. & Inst. Rights, Inc.*, 547 U.S. 47, 59 (2006) (stating the government cannot deny a benefit conditioned on “freedom of speech even if he has no entitlement to that benefit.”). The first essential element of an Unconstitutional Conditions Doctrine violation is that the federal government provides a benefit. *See Perry*, 408 U.S. at 597. Next, the government must only provide the benefit in exchange for the tempering of an individual constitutional right. *Id.* Here, the PTO and TTAB unfairly burdened Ms. Luhv’s freedom of speech by enforcing § 2(a) against her “Dumb Blonde” trademark.

1. Registration provides trademark holders with substantial benefits.

It has long been the case that federal trademark registration confers a myriad of benefits upon the mark holders not available at common law. *See*

Brittingham v. Jenkins, 914 F.2d 447, 452 (4th Cir. 1990). Registration not only saves the public from deception in the marketplace, but also allows the mark's owner to defend against the misappropriation of her labor. *See Zippo Mfg. Co. v. Rogers Imports, Inc.*, 216 F.Supp. 670, 694 (S.D.N.Y. 1963). These policy goals, codified in the Lanham Act, have remained a constant in trademark law.

By registering a mark through the Lanham Act, a mark owner gains several unique benefits. *See Brittingham*, 914 F.2d at 452. First, a registered mark acts as constructive notice of ownership. *Id.*; 15 U.S.C. § 1072. Second, registration provides prima facie evidence of ownership, validity, and the exclusive right to use the mark in commerce. *Id.* Next, the registration gives federal courts original jurisdiction over infringement claims. *Id.*; 15 U.S.C. § 1121. Further, by registering the mark, an owner can use the U.S. Customs Office in order to actively oppose importation of infringing products. *Id.*; 15 U.S.C. § 1124.

Formerly, courts found registration benefits to be more procedural rather than substantive. *See In re McGingley*, 660 F.2d 481, 484 (C.C.P.A. 1981). However, trademark legislation has since advanced. The Supreme Court recently noted that “The Lanham Act confers important legal rights and benefits’ on trademark owners who register their marks.” *B & B Hardware Inc. v. Hargis Indus., Inc.*, 135 S.Ct. 1293, 1300 (2015). Additionally, new legislation such as the Trademark Law Revision Act of 1988 expanded the benefits received through registration. *See* 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 5:9 (4th ed.).

The court in *In re McGinley* grossly underestimates the benefits granted by registration. Without federal registration under the Lanham Act, Ms. Luhv would not be able to use any of the aforementioned benefits for her mark, “Dumb Blonde.” By refusing her registration, the government directly deprived her of essential protections offered by the registry. For example, without original jurisdiction in federal courts, Ms. Luhv would be forced to argue infringement claims state by state. In the current music industry climate, Ms. Luhv’s mark travels by social media through Soundpuff and uTube across several states in an instant, making the benefits of original federal jurisdiction self-evident. *Luhv*, 1337 F.3dat 456. This additional time, effort, and cost incurred by Ms. Luhv are a direct result of the mark’s rejection and solely burden her.

2. The Government conditions registration upon forfeiting free speech rights.

§ 2(a) abridges speech, thereby violating the Constitution. The government cannot improperly condition the benefits of federal registration upon the limitation of free speech. *See Perry*, 408 U.S. at 597. Under the Unconstitutional Conditions Doctrine, it makes no difference whether the abridgment is direct or indirect. *See Int’l Ass’n of Machinists v. Street*, 367 U.S. 740, 777 (1961) (Douglas, J., concurring).

The government cannot deny a benefit because an individual exercises her constitutional rights. *See Perry*, 408 U.S. at 597. This is especially true if the government abridges First Amendment freedom of speech. *Id.* In *Perry*, a state denied a teacher the benefit of continued employment after he criticized the

administration. *Id.* at 593. The Court held that firing the teacher based on his criticism violated the Constitution because the government used a benefit to abridge certain speech. *Id.* at 597-98.

Similarly, the PTO's rejection curbs Ms. Luhv's free speech rights in exchange for the benefits of federal trademark registration. The teacher in *Perry* used his free speech rights to criticize a college program. Here, Ms. Luhv used her free speech rights to choose the stage name "Dumb Blonde." Just as the government denied employment benefits to the teacher because of the exercise of his First Amendment rights, the federal government directly denied Ms. Luhv registry benefits based upon her exercise of First Amendment rights. Therefore, the same conclusion follows; the denial violates the Unconstitutional Conditions Doctrine.

The framework of §2(a) indirectly abridges free speech by conditioning the use of the right with the deprivation of the benefit. *In re McGinley* held that denying trademark registration does not abridge free speech because the failed applicant can still use the trademark privately. 660 F.2d at 484. Indirect abridgment can occur notwithstanding the fact that free speech is still technically available. While it is accurate that Ms. Luhv could still use the "Dumb Blonde" trademark without the PTO registry, she would have to do so without the protections and benefits provided by the registry. Under the §2(a) framework, if an applicant wishes to receive the benefits of registering, they must choose a trademark that cannot be construed as disparaging. Consequently, the PTO and TTAB indirectly abridge speech and infringe upon the First Amendment rights of all Americans. *See Simon & Schuster,*

Inc. v. Members of the New York State Crime Victims Bd., et al., 502 U.S. 105, 115 (1991) (stating that financial disincentive only on particular content speech is inconsistent with the First Amendment).

According to § 2(a), if Ms. Luhv wants to receive the government benefits of registering her trademark, she must choose a different name to go by. She would have to relinquish a part of her identity and forfeit the opportunity to reclaim the term “Dumb Blonde.” This forces her to abandon the mark that she has been identified by throughout her career and build a new brand. Accordingly, this both directly and indirectly abridges her First Amendment right to express herself.

B. Trademarks Require The Free Speech Protection Of The First Amendment When Viewed As Either Hybrid Or Purely Commercial Speech.

1. Trademarks are entitled to full First Amendment protection, as they are commercial speech entwined with expressive speech,

When commercial aspects of speech are inextricably entwined with the expressive elements of speech, the speech receives full First Amendment protection. *See Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1185 (9th Cir. 2001). In *Hoffman*, a photographer used the likeness of a famous actor in a magazine article without permission. *Id.* at 1183. The court held that the speech contained commercial aspects since it was used to sell copies of the magazine. *Id.* at 1184. However, the speech in question was not limited to the commercial speech. *Hoffman*, 255 F.3d at 1184. The photographer was also promoting fashion, humor and editorial commentary. *Id.* These non-commercial elements were entwined with

the commercial elements, therefore requiring full First Amendment protections. *Id.* at 1185. Therefore, even though the speech was not “purely commercial” it was entitled to the same first amendment protection as private speech. *Id.* at 1185.

The speech in *Hoffman* is analogous to the trademark used by Ms. Luhv. It is undisputed that there are economic interests related to trademarks. Ms. Luhv conducts business and uses her trademark in order to further her economic interests. She sells her music as well as merchandise, using the mark to make her products clearly identifiable. *Luhv*, 1337 F.3d at 456. This is similar to how the article in *Hoffman* was used to sell copies of the magazine.

There is more to Ms. Luhv’s trademark than financial interest. She also uses *Dumb Blonde* as a form of artistic expression, just as the photographer in *Hoffman* used the article to express ideas. Ms. Luhv’s stated desire is to take back the term, *Dumb Blonde* and change the stereotype. *Id.* at 457. This goes beyond the merely economic considerations of commercial speech and demonstrates that trademarks are entwined with non-commercial speech. Accordingly, trademarks require full first amendment protection and cannot be prohibited based on content as occurs under § 2(a).

2. Even if this Court considered trademark registration commercial speech, § 2(a) fails the Central Hudson test.

Even applying the lower standard used for purely commercial speech, § 2(a) still violates the Constitution. Commercial speech is entitled to constitutional protection, even if not afforded the same protection as private speech. *See Zauderer*

v. Office of Disciplinary Counsel of the Sup. Ct. of Ohio, 471 U.S. 626, 637 (1985). In *Central Hudson*, the Supreme Court developed a four prong test for determining the constitutionality of commercial speech. 447 U.S. at 564 (1980). When the accuracy and legality of the speech is not in question, as is the case here, the test is limited to three prongs: 1) whether there was a substantial government interest to achieve through the restriction; 2) whether the interest was directly advanced by the action taken; and 3) whether the action taken was overbroad and excessive. *See Cent. Hudson*, 447 U.S. at 564 (enumerating the test); *see also Sorrell*, 131 S.Ct. at 2667 (limiting the test to three prongs). Failure to satisfy any prong invalidates the entire regulation. *Cnty. for Creative Non-Violence, et al. v. Turner*, 893 F.2d 1387, 1392 (D.C. Cir. 1990).

Three main policy interests justify § 2(a), and at least one must pass the *Central Hudson* test in order to validate the law. The interests are as follows: 1) to avoid a government endorsement of disparaging marks; 2) to dissuade the use of disparaging marks in the marketplace; and 3) to avoid the expenditure of government resources on disparaging marks. As demonstrated herein, all three interests fail the *Central Hudson* test, thereby invalidating § 2(a) as an unconstitutional prohibition of commercial speech.

a) Section 2(a) does not advance the Government's interest in avoiding governmental endorsement because the trademark registry is not a forum for government speech.

Under the *Central Hudson* framework, the government action must advance the governmental interest in order to be constitutional. *Cent. Hudson*, 447 U.S. at 564. The action must advance the interest “in a direct and material way.” *Edenfield v. Fane*, 507 U.S. 761, 767 (1993). As a government proclaimed to be “by the people,” the federal government has a substantial interest in not endorsing disparaging speech. However, § 2(a) does not substantially advance this interest.

When the government registers a trademark, it does not endorse the quality of the product, nor does it give the stamp of approval to the message. *See Old Glory Condom*, 1993 WL 114384, at *5, 26 U.S.P.Q.2d, 1216, 1219, n.3 (TTAB March 3, 1993); *see also Michael J. McDermott v. San Francisco Women's Motorcycle Contingent*, 2006 WL 2682345, at *6, 81 U.S.P.Q.2d 1212 (T.T.A.B. Sept. 13, 2006) (holding that “it is well settled that registration of a trademark reflects no endorsement by the USPTO of the applicant's products or services.”). In *Old Glory Condom*, the TTAB held “the PTO is doing nothing more and nothing less than to register those marks that are functioning to identify and distinguish goods and services in the marketplace.” *Id.*

States have an interest in not endorsing offensive products which reasonably appear to be government speech. *See Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2246 (2015). In *Walker*, the Court held that the state could reject offensive custom license plates without violating free speech rights. *Id.*

at 2244. The Court considered the license plates government speech for several distinct reasons. *Id.* at 2246. First, license plate are a traditional forum for states to send messages, such as their slogans or honoring important events. *Id.* at 2248. Second, each license plate in *Walker* actually says “Texas” on it and has the silhouette of the state, creating an impression of state endorsement of the plate’s contents. *Id.* Third, Texas maintained full control over the design and contents of the license plates. *Id.* at 2249. Citizens could submit suggestions, however the state still made and distributed the plates. *Id.*

Unlike the license plates in *Walker*, trademarks are not government speech. First, no historical purpose exists for trademark registries, which inform of marks that are used nationally. Additionally, trademarks do not have a signature from the federal government and simply appear on the registry as used in the marketplace. Finally, in *Walker*, the court looked to the amount of control that the state retained over the plates. Contrastingly, trademarks are always in the creative control and ownership of the mark holder, not the federal government.

Further, as a practical matter, if the government did in fact endorse every trademark that it approved for registration, the message would be full of contradictions and hypocrisy. Political groups are able to register trademarks that oppose the government’s position. If this registration resulted in a government endorsement, the government would inherently contradict its own stances on any of these occasions. In this case, the Court of Appeals explained that the trademark “DYKES ON BIKES” was accepted for registration. *Luhv*, 1337 F.3d at 458.

However, it would be unreasonable to state that upon registration, the government publicly endorsed the use of the term “Dyke” or the efforts to reclaim it.

If the TTAB approved Ms. Luhv’s mark for registration, there would be no government endorsement of her message. The only message by the government when registering a mark is that the mark is used in commercial activity and is the property of the mark holder. Ms. Luhv would still be the owner of the mark and the speaker of its message. Therefore, this policy fails the *Central Hudson* test.

b) The Government’s interest in stopping the use of disparaging language is not valid.

The second policy justifying § 2(a) is stopping the use of trademarks that may be disparaging in the marketplace, thus removing the disparaging language from society. On its face, the policy fails because it is not a valid substantial government interest. The federal government cannot use “broad discretion to suppress truthful, non-misleading information for paternalistic purposes.” *Liquormart v. Rhode Island*, 517 U.S. 484, 510 (1996). It is not the role of the government to be a moral arbiter for which ideas are allowed in the marketplace and which subjects are too controversial for the public. In fact, it is controversial speech that most requires the protection of the first amendment. *See Sorrell v. IMS Health Inc.*, 131 S.Ct 2653, 2670 (2011). The chance that someone may be offended by speech is not traditionally accepted as a reason to suppress First Amendment rights. *See Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 71 (1983).

Even if this policy constituted a substantial government interest, it still fails the *Central Hudson* test because § 2(a) does not advance the interest. Although citizens are denied benefits when they cannot register their trademark, they are still able to use trademarks that are not registered. *See Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 319 (C.C.P.A. 1976). Though they are incentivized not to use certain disparaging marks, the fact remains that disparaging marks will still enter the marketplace. The use and publication of disparaging language will exist outside of the trademark context, despite the efforts of § 2(a).

Due to the fact that § 2(a) allows for such a wide scope of trademark prohibition, the law would remove essential ideas from the marketplace. *Abrams v. United States*, 250 U.S. 616, 630 (1919) (Holmes, J., dissenting). Furthermore, § 2(a)'s vague language encompasses too much. To say that any mark that "may" be disparaging can be rejected from registry allows for almost anything to be rejected without a clear threshold. The limits to what "may" be disparaging are as expansive as human imagination. Accordingly, the second policy justification fails all three prongs of the *Central Hudson* test.

c) § 2(a) does not advance the Government's interest in not spending resources on disparaging speech.

A third potential government interest is avoiding spending resources and time on disparaging marks that are unworthy of those resources. *See McGinley*, 660 F.2d at 486 (explaining that such marks should not take the time, services, or use

the funds of the government.) However, this misrepresents registration procedures as well as the role of the government.

The PTO's resources are not overly burdened by registering arguably disparaging marks. *Figueroa v. United States*, 466 F.3d 1023, 1028 (Fed. Cir. 2006). In fact, registration fees fund the PTO's operations budget. *Id.* Therefore, the more registrants applying, the more fees there are to fund operations.

Furthermore, prohibiting disparaging marks results in a significant burden on the federal government's time and money beyond the costs of registration. *See McGingley*, 660 F.2d at 487 (Rich, J., dissenting). To remove the need for such proceedings by eliminating § 2(a) would actually reduce the cost and resource waste for the PTO.

Ms. Luhv's registration of Dumb Blonde would not financially burden the federal government financially. Her registration fees would cover the operational costs incurred by her registration. However, by rejecting "Dumb Blonde" and necessitating the TTAB proceeding as well as the current proceeding, the costs to the federal government significantly increased. Therefore, the actual effect of § 2(a) runs counter to the proposed government interest. Accordingly, the third policy justification also fails the *Central Hudson* test.

CONCLUSION

For the foregoing reasons, Respondent respectfully requests this Court REVERSE the Federal Circuit Court of Appeal's decision affirming the TTAB's refusal to Respondent's trademark.

Dated: October 20, 2015

Respectfully Submitted,

Team 124
Brief for Respondent

*In the Supreme Court of the
United States*

OCTOBER TERM 2015

UNITED STATES,
Petitioner,

v.

KOURTNEY LUHV,
Respondent.

*ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF
APPEALS FOR THE FEDERAL CIRCUIT*

CERTIFICATE OF SERVICE

We, Team 124, attorney for Respondent, do swear and declare that on the 20th day of October, 2015, as required by Supreme Court Rule 29, we have served the enclosed BRIEF FOR RESPONDENT on each party to the above proceeding or that party's counsel, and on every other person required to be served, by personally serving a copy to each of them.

The names and addresses of those served are as follows:

Patty Hayes/Moot Court Board
Pepperdine University School of Law
24255 Pacific Coast Highway
Malibu, California 90263

I declare under penalty of perjury that the foregoing is true and correct.

Dated: October 15, 2015

Team 124
Counsel for Respondent