

IN THE
Supreme Court of the United States

UNITED STATES,

PETITIONER,

v.

KOURTNEY LUHV,

RESPONDENT.

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

BRIEF FOR PETITIONER

TEAM 125
ATTORNEYS FOR PETITIONER

QUESTIONS PRESENTED

- I. Whether the United States Court of Appeals erred in concluding that section 2(a) of the Lanham Act, which prohibits the registration of disparaging marks, violates the First Amendment of the United States Constitution when it determined that the government has no substantial interest in regulating disparaging marks.

- II. Whether the Trademark Trial and Appeal Board erred in rejecting Respondent's application to register the mark DUMB BLONDE as her stage name on the ground that the mark was disparaging to women within the meaning of section 2(a) of the Lanham Act.

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The opinion of the Court of Appeals for the Federal Circuit has been reported at *In re Kourtney Luhu*, 1337 F.3d 455 (Fed. Cir. 2015).

CONSTITUTIONAL PROVISIONS

The following constitutional provisions are relevant to the present case:

THE FIRST AMENDMENT TO THE UNITED STATES CONSTITUTION:

Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.

STATUTORY PROVISIONS

The following statutory provisions are relevant to the present case:

15 U.S.C. § 1052(A) TRADEMARKS REGISTRABLE ON PRINCIPAL REGISTER; CONCURRENT REGISTRATION

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of Title 19) enters into force with respect to the United States.

5 U.S.C. § 706 SCOPE OF REVIEW;

To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall—

- (1) compel agency action unlawfully withheld or unreasonably delayed; and
- (2) hold unlawful and set aside agency action, findings, and conclusions found to be—
 - (A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;
 - (B) contrary to constitutional right, power, privilege, or immunity;
 - (C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right;
 - (D) without observance of procedure required by law;
 - (E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or
 - (F) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court.

In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.

STATEMENT OF THE CASE

This is an appeal to respectfully request this Court to *reverse* the United States Court of Appeals for the Federal Circuit’s finding that section 2(a) of the Lanham Act is unconstitutional because the government has a substantial interest in prohibiting the registration of disparaging marks, and the regulation imposed is in proportion to that interest. We further request this Court to *affirm* the decision that Respondent’s stage name DUMB BLONDE is disparaging to a substantial composite of women within the meaning of section 2(a) of the Lanham Act after the Trademark Trial and Appeal Board made its decision based upon substantial evidence.

Procedural History

Kourtney Luhv (“Respondent”) filed an application with the Patent and Trademark Office (“PTO”) seeking to register the mark DUMB BLONDE for entertainment purposes, namely live performances by a musical band, and clothing, such as sweatshirts, t-shirts, tank tops and headwear. *In re Kourtney Luhv*, 1337 F.3d 455, 456 (Fed. Cir. 2015). The examining attorney found that, under section 2(a) of the Lanham Act, the mark may be disparaging to women and refused to register it, citing to materials submitted in the application. *Id.* Respondent contested the denial of the application, and brought an appeal before the Trademark Trial and Appeal Board (“TTAB”). *Id.*

The TTAB affirmed the examining attorney’s refusal to register the mark because it may be disparaging to women with blonde hair, a substantial composite

of the referenced group. *Id.* The TTAB cited photographs on Respondent's website showing a blonde woman eating plastic fruit and applying Wite-Out® to text displayed on her computer monitor. *Id.* at 457-58. However, Respondent contends that she chose the mark DUMB BLONDE as a way to reclaim the stereotype associated with blonde women as well as raise awareness of the challenges posed by gender discrimination and negative stereotypes. *Id.*

The TTAB also found that a substantial composite of women may view the phrase as disparaging because dictionary definitions, numerous articles, and user comments on Respondent's online videos support the finding that women regard the phrase "dumb blonde" to be offensive. *Id.*

Respondent appealed the TTAB's decision to the United States Court of Appeals, claiming that that the TTAB erred in affirming the examining attorney's rejection of her application on the basis that the mark may be disparaging. *Id.* Respondent raised two arguments: (1) section 2(a) of the Lanham Act is unconstitutional because of its prohibition on the registration of disparaging marks, and (2) the conclusions made by the examining attorney do not accurately represent the views held by her fans or those held by a substantial composite of women. *Id.*

The Court of Appeals agreed with the TTAB's finding that the proposed mark DUMB BLONDE is disparaging to a substantial composite of women. *Id.* at 460. Thus, the examining attorney's refusal to register the mark was warranted under section 2(a) of the Lanham Act. *Id.* Finally, the court found that the section's prohibition on registering marks that may be disparaging is unconstitutional. *Id.*

Therefore, the ruling of the Court of Appeals is that neither the PTO nor the TTAB may rely on section 2(a) of the Lanham Act as a basis for rejecting Respondent's trademark application. *Id.*

STATEMENT OF THE FACTS

"Dumb Blonde" is the stage name of Respondent, who is a vocalist and solo artist. *Kourtney Luhv*, 1337 F.3d at 455. Her lyrics focus on issues faced by women in today's society, and her music incorporates elements from various genres of music. *Id.* Respondent has been performing as "Dumb Blonde" for about three years. *Id.*

During those three years, she has grown a devoted fan base that frequently attend her concerts. *Id.* A sizeable number of online users follow Respondent's music on the online streaming service at www.soundpuff.com ("Soundpuff"), and she has an account on the video hosting website www.uTube.com ("uTube") under the name DumbBlondeMusic. *Id.* at 455-56. She posts videos on uTube to communicate with her fans and share music-production-related tips with other users. *Id.* at 456. At the time of Respondent's trademark registration application, she demonstrated that she had over 40,000 followers on her Soundpuff account, and over 100,000 active subscribers to her uTube channel. *Id.*

In June 2014, Respondent recorded several pieces of music that she wished to release through a record label. *Id.* She negotiated a deal with a record label in which she would receive a two million dollar advance on the condition that she would register her stage name "Dumb Blonde" with the PTO. *Id.*

SUMMARY OF THE ARGUMENT

- I. The Court of Appeals incorrectly held that section 2(a) of the Lanham Act violates the First Amendment of the United States Constitution. Trademarks, because they are commercial speech, enjoy limited protection from the First Amendment. The government has a substantial interest in regulating disparaging marks in order to protect public order and safety. Section 2(a) is a narrowly tailored restriction on trademarks that directly advances the government's interest.

- II. The decisions of administrative agencies are treated with considerable deference by reviewing courts and are not overturned unless the agency adjudicated a matter without "substantial evidence." The TTAB and the Circuit Court of Appeals utilized a test developed by the Federal Circuit in the case of *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014), which requires the TTAB to examine certain kinds of evidence in order to properly reject the registration of a given mark. The PTO and TTAB reviewed a substantial amount of evidence in consideration of whether to register Respondent's mark.

ARGUMENT

The present case comes before this Court following an incorrect decision by the Court of Appeals for the Federal Circuit in favor of Respondent. The Court of Appeal's decision is incorrect because section 2(a) of the Lanham Act is a narrow regulation of trademarks that is tailored to serve the substantial interest of the government. For those reasons, the Federal Circuit's decision should be *reversed*.

Despite the incorrect holding as to the constitutionality of section 2(a), the court correctly held that the TTAB made its decision to reject the registration of DUMB BLONDE based on substantial evidence. For those reasons, the Federal Circuit’s ruling as to the TTAB’s decision should be *affirmed*.

I. SECTION 2(A) OF THE LANHAM ACT, WHICH PROHIBITS THE REGISTRATION OF MARKS THAT MAY BE DISPARAGING, DOES NOT VIOLATE THE FIRST AMENDMENT OF THE CONSTITUTION OF THE UNITED STATES.

The Court of Appeals erred when it determined that section 2(a) of the Lanham Act violated the First Amendment. It incorrectly concluded that the government did not have a substantial interest in regulating marks that may be disparaging.

“Congress shall make no law . . . abridging the freedom of speech.” U.S. Const. Amend. I. “The protection given speech and press was fashioned to assure unfettered interchange of ideas for the bringing about of political and social changes desired by the people.” *Roth v. U.S.*, 354 U.S. 476, 484 (1957). The Supreme Court of the United States has concluded that “the unconditional phrasing of the First Amendment was not intended to protect every utterance.” *Id.* at 483. Regulations of freedom of expression may be subject to review and, if deemed overbroad, declared invalid. *Boardley v. U.S. Dep’t of Interior*, 615 F.3d 508, 513 (D.C. Cir. 2010). Section 2(a) of the Lanham Act is a narrow regulation of commercial speech and thus, is valid.

A. Trademarks are commercial speech and enjoy limited protection from the First Amendment.

Commercial speech is “expression related solely to the economic interests of the speaker and its audience.” *Central Hudson Gas and Elec. Corp. v. Pub. Serv. Comm’n of New York*, 447 U.S. 557, 561 (1980). Speech that aids in the decision-making process for the consumer on whether to use a product or a service is commercial speech and protected by the First Amendment. *Id.* at 567. “A trademark is a word, phrase or symbol that is used to identify a manufacturer or sponsor of a good or the provider of a service.” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900 (9th Cir. 2002).

Trademarks serve the economic interest of the speaker, assist consumers, and further societal interest. *Central Hudson*, 447 U.S. at 561. Similar to the purpose of advertising, which is considered a type of commercial speech, trademarks enable consumers to make meaningful choices as to what product to buy. *Id.* at 567. Trademarks convey useful information that aid in a consumer’s decision-making process, which is an essential component of commercial speech, by informing consumers who the manufacturer of a product is. *Id.* Because trademarks serve the economic interests of both the trademark owner, who is the speaker, and the consumers, who are the audience, they are commercial speech and thus enjoy limited protection under the First Amendment.

B. Section 2(a) of the Lanham Act does not violate the constitutional protections that are afforded to trademarks.

Commercial speech enjoys less protection from the First Amendment than other constitutionally guaranteed expression. *Central Hudson*, 447 U.S. at 563. The protection commercial speech is entitled to is limited and “is subject to modes of regulation that might be impermissible in the realm of noncommercial expression.” *Florida Bar v. Went For It, Inc.*, 515 U.S. 618, 623 (1995). The *Central Hudson* case established a four-part test to determine the constitutionality of a commercial speech regulation. *Central Hudson*, 447 U.S. at 566. The constitutionality of section 2(a) of the Lanham Act will be analyzed under this test because the act pertains to trademarks, which are commercial speech. The four-part analysis when determining the extent of protection offered to certain commercial speech, and whether the regulation is constitutional, is as follows: (1) the speech being regulated must be protected by the First Amendment; (2) the asserted governmental interest in regulating the speech must be substantial; (3) the regulation needs to directly advance the governmental interest asserted; and (4) the regulation cannot be more extensive than necessary to serve the interest. *Central Hudson*, 447 U.S. at 566. Section 2(a) of the Lanham Act satisfies all four prongs of the *Central Hudson* test and is therefore constitutional.

1. *Disparaging marks enjoy limited protection under the First Amendment because they are neither misleading nor unlawful.*

The first step in determining the extent of protection offered to commercial speech is to examine the nature of the expression. *Central Hudson*, 447 U.S. at 563.

In order to be protected by the First Amendment, the speech at issue must neither be misleading nor relate to unlawful activity. *Id.* at 564. It can be taken into consideration whether the speech is inherently misleading. *WV Ass'n of Club Owners and Fraternal Services, Inc. v. Musgrave*, 553 F.3d 292, 302 (4th Cir. 2009). If the trademark is neither misleading nor related to an unlawful activity, the government has some restrictive power to regulate the commercial speech. *Central Hudson*, 447 U.S. at 564.

The challenged part of the Lanham Act is section 2(a), which specifically denies registration of marks that may be disparaging to persons. 15 U.S.C. § 1052(a) (2006). Disparaging trademarks are neither illegal nor misleading.

Here, the Court of Appeals found that there is nothing illegal about a disparaging trademark. Disparaging trademarks are not inherently misleading. Thus, the first prong of the *Central Hudson* test is satisfied because disparaging trademarks are neither illegal nor misleading.

2. *Restrictions on the registration of disparaging marks further substantial governmental interests by ensuring public order and safety, protecting the reputation of certain individuals, and shielding people from the offensive speech.*

In order for the government to regulate commercial speech, it must assert a substantial interest to be achieved through the regulation. *Central Hudson*, 447 U.S. at 564. The government has a substantial interest in protecting the public order and safety, and it has been recognized that legislation intended to protect public order and safety is legitimate. *Barnes v. Glen Theatre, Inc.*, 501 U.S. 560, 568-69 (1991). Protecting the reputation of a certain group of people is also a

substantial governmental interest. *Florida Bar*, 515 U.S. at 625. Speech that is merely offensive to some does not justify its suppression, however, if the audience cannot easily avoid the offensive speech, then the government has a substantial interest in shielding those people from the offensive speech. *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 71-72 (1983). If the burden of avoiding the offensive speech is slight, the government will not interfere with that particular type of speech. *Id.* at 72.

The PTO has a legitimate and substantial interest in denying registration of disparaging marks if they are offensive to a substantial group of people because the speech may disrupt public order and safety. Furthermore, section 2(a) of the Lanham Act goes beyond denying registration to just disparaging marks; marks that may be immoral or scandalous are also to be denied registration. 15 U.S.C. § 1052(a) (2006). In the *Glen Theatre* case, this Court held that Indiana's public indecency statute was justified, despite its limitations on some expressive conduct, because it was designed to protect morals and public order. *Barnes*, 501 U.S. at 567-69. The Court reasoned that the purpose of the statute was a substantial governmental interest. *Id.* at 569. It is clear from the wording of section 2(a) of the Lanham Act that this part of the statute was designed to protect morals and public order. Thus, the government will not register disparaging marks in order to protect public order and safety.

Certain speech may negatively affect the reputation of a group of people. This Court, in the *Florida Bar* case, upheld a rule of the Florida Bar that prohibited

personal injury lawyers from sending “direct-mail solicitations to victims and their relatives for 30 days following an accident or disaster.” *Florida Bar*, 515 U.S. at 620. The Court agreed with the Bar that, because the reputation of the legal profession had suffered immensely due to the mailings, the rule was a legitimate effort to protect the declining reputations of lawyers. *Id.* at 625. Disparaging trademarks could negatively affect the reputation of certain groups of people. In the present case, the TTAB found that the phrase “dumb blonde” implies a negative, stereotypical view of women. Thus, the reputation of women could potentially be ruined from that phrase. This Court has recognized that protecting the reputations of a certain group of people is a substantial governmental interest.

Although disparaging trademarks will not offend all, they may be difficult for those that are offended by them to avoid. In the *Bolger* case, the Court concluded that a statute prohibiting the mailing of unsolicited advertisements for contraceptives violated the First Amendment. *Bolger*, 463 U.S. at 61. In reaching its decision, the Court reasoned that the recipients of the objectionable mailings could simply avert their eyes from the material and that their burden of avoiding the mailings was slim. *Id.* at 72. (concluding that a short walk from one’s mailbox to the trashcan was an acceptable burden).

Trademarked goods and services can be virtually anywhere: in stores, in a person’s home, on the radio, at a person’s workplace, or on the Internet. For example, in the present case, the term seeking to be registered would appear at the performer’s concerts, on various merchandise, and online via Soudpuff and uTube.

The burden placed on people to try to avoid disparaging trademarks could potentially be extremely high, depending on how prevalent that trademark is. The uncertainty of how great the burden would be, coupled with the possibility that it may not be simple for people to avoid the trademark, justifies the governmental interest in regulating disparaging statements.

Section 2(a) of the Lanham Act ensures that disparaging trademarks will not disrupt public order and safety, prevents them from harming the reputation of certain groups of individuals, and shields the people from the disparaging trademarks that may be perceived as offensive. The second part of the *Central Hudson* test is satisfied because the government has a substantial interest in regulating the registration of phrases that may be disparaging.

3. *The harms posed by disparaging marks are real, and section 2(a) of the Lanham Act directly advances the government's substantial interest in regulating those marks.*

The challenged regulation must advance the government's interest in a direct and material way. *Florida Bar*, 515 U.S. at 625. It must target "a concrete, nonspeculative harm." *Id.* at 629. The governmental body "seeking to sustain a restriction on commercial speech must demonstrate that the harms it recites are real and that its restriction will . . . alleviate them to a material degree." *Florida Bar*, 515 U.S. at 626. Proof that the harms are real include anecdotal and statistical evidence; studies; and quotes from people affected by that particular speech. *Id.* at 626-28. History, consensus, and common sense can also be relied upon as proof that

the regulation directly advances the government's interest. *WV Ass'n of Club Owners*, 553 F.3d at 303.

The concrete, nonspeculative harm posed by disparaging marks is the disruption of public order and safety. Looking at history, it is clear that offensive, disparaging speech disrupts public order and safety, and legislation on that type of speech is necessary. *See Barnes*, 501 U.S. at 568-69. *See also Roth*, 354 U.S. at 482 (noting that in 1792, 10 of the 14 states had laws in effect that made blasphemy or profanity statutory crimes).

In the present case, evidence was brought forth that proved a substantial number of women found the term "dumb blonde" offensive. This included quotes made by women in regards to the phrase as well as various articles about how women view the offensive term negatively. The Court of Appeals also noted that the term "dumb blonde" is frequently used in jokes, and there is significant evidence that suggests women view those jokes unfavorably.

The third prong of the *Central Hudson* test is satisfied because the harms posed by disparaging marks are real and concrete.

4. *Section 2(a) of the Lanham Act is not an overly extensive regulation on trademarks in order to further the government's substantial interest.*

The *Florida Bar* case concluded that the "least restrictive means' test has no role in the commercial context." *Florida Bar*, 515 U.S. at 632. Instead, there must be a reasonable fit between "the legislature's ends and the means chosen to accomplish those ends." *Id.* The means chosen do not have to be the best choice, but

must be in proportion to the interest served. *Id.* Further, the means must be narrowly tailored to achieve the desired objective. *Id.* Commercial speech restrictions must be a necessary, rather than a merely convenient, means of achieving the government's interest. *WV Ass'n of Club Owners*, 553 F.3d at 305. If there are "numerous and obvious less-burdensome alternatives to the restriction on commercial speech," then relevant consideration must be given to those alternatives. *Florida Bar*, 515 U.S. at 632. Finally, this Court has recognized that if it is too difficult for the government to determine what various opinions there may be on certain types of commercial speech, then the regulation on that speech is not overly extensive. *Florida Bar*, 515 U.S. at 633. Section 2(a) of the Lanham Act is in proportion with the government's interest: protecting public order and safety.

There are arguably numerous opinions on the phrase "dumb blonde." The Court of Appeals in the present case found that there were both positive and negative feelings towards the phrase, as evidenced by the comments found on social media. Similar to the *Florida Bar* case, it would be unreasonable to ask the government to determine which disparaging statements may disrupt public order and safety or negatively impact the reputation of a group of people. *See Florida Bar*, 515 U.S. at 633 (concluding that it would be difficult for the Florida Bar to draw the line at what constitutes a severe injury). Thus, there are no other reasonable, less burdensome alternatives that craft a rule not allowing registration of marks that may be disparaging.

The fourth and final prong of the *Central Hudson* test is satisfied because section 2(a) of the Lanham Act is a narrowly tailored restriction on disparaging marks that directly advance the government’s interest in protecting public order and safety.

II. THE TRADEMARK TRIAL AND APPEAL BOARD DID NOT ERR IN REJECTING RESPONDENT’S APPLICATION TO REGISTER THE MARK DUMB BLONDE AS HER STAGE NAME ON THE GROUND THAT THE MARK MAY BE DISPARAGING TO WOMEN WITHIN THE MEANING OF SECTION 2(A) OF THE LANHAM ACT.

The TTAB did not err in its decision to reject Respondent’s application to register the DUMB BLONDE mark. It properly determined that the mark may be disparaging to women, and its determination is supported by substantial evidence.

The findings of administrative agencies are provided broad deference. This deference is so broad that a reviewing court will not overturn the findings of the agency unless “it is either unwarranted in law or without justification in fact.” *Horning v. S.E.C.*, 570 F.3d 337, 343 (D.C. Cir. 2009) (internal quotations omitted). The statute creating and enabling the agency may allow for a more robust form of judicial review. However, absent any language to the contrary in the enabling statute(s), courts are to review the action of the agency using the provisions in the Administrative Procedure Act of 1946 (“APA”). *See W. Watersheds Project v. Bureau of Land Mgmt.*, 629 F. Supp. 2d 951, 966 (D. Ariz. 2009). Congress did not place a specific standard of review in the Lanham Act for courts to use when a litigant has appealed a decision of the TTAB. As a result, courts have deferred to the “substantial evidence” test under in the APA. 5 U.S.C. § 706(2)(E).

Congress entrusted the PTO with registering marks to be used in commerce, provided such marks are not prohibited under the Lanham Act. The prohibitions are numerous, however, the only one at issue in this case is that of disparagement under 15 U.S.C. § 1052(a). The relevant portion of the statute provides: “No trademark [...] shall be refused registration [...] on account of its nature unless it—

(a) Consists of or comprises [...] of matter which may disparage or falsely suggest a connection with persons.” Congress, in prohibiting those marks that disparage individuals or groups, was not attempting to legislate good manners. Rather, the intent was that marks that may become subject to a common law action for disparagement should “not occupy the time, services, and use of funds of the federal government.” *Pro-Football, Inc. v. Blackhorse*, No. 1-14-CV-01043-GBL, 2015 WL 4096277, at *17 (E.D. Va. July 8, 2015) (citing *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981)). It is well established in administrative law that an agency's construction and interpretation of the operative statute be given deference when that statute is “silent or ambiguous” on the issue in question and the agency's interpretation is a “permissible construction of the statute.” *Chevron U.S.A., Inc. v. Natural Resources Defense Council, Inc.*, 467 U.S. 837, 843 (1984).

The rejection of the DUMB BLONDE mark submitted by Respondent is in accord with Congress's intent in providing protection for registered marks and the procedural guidelines set forth in the APA. 5 U.S.C. § 706(2)(E). The TTAB did not err in its decision to reject Respondent's application to register the DUMB BLONDE

mark because it correctly determined that the mark may be disparaging to women based on substantial evidence.

- B. The decision of the Trademark Trial and Appeal Board that the mark DUMB BLONDE is offensive to women is supported by substantial evidence.

The decision of the TTAB to reject registration of the mark DUMB BLONDE was proper because it was supported by substantial evidence, as required under 5 U.S.C. § 706(2)(E).

A reviewing court scrutinizes an agency's reasoning to determine whether it is supported by “substantial evidence.” *Dickinson v. Zurko*, 527 U.S. 150, 164 (1999) (citing e.g., *Sec. & Exch. Comm'n v. Chenery Corp.*, 318 U.S. 80, 89 (1943)). A reviewing court must reverse the TTAB's findings of fact *only if* those findings are “unsupported by substantial evidence.” *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 114 (D.D.C. 2003) (emphasis added). Although the Supreme Court in *Zurko*¹ left open which of the APA's review standards were appropriate, the Federal Circuit has since concluded that the APA's “substantial evidence” test is the appropriate review standard for findings of fact of the agency. *In re Gartside*, 203 F.3d 1305, 1315 (Fed. Cir. 2000). Respondent bears the burden of proving that the decision of the TTAB was not based on substantial evidence. The “substantial evidence” test is a term of art for the standard by which a court evaluates the reasonableness of the agency’s decision based on the evidence presented before it. *United States v. Carlo Bianchi & Co.*, 373 U.S. 709, 715 (1963). The “substantial evidence” test requires a court to ask

¹ The Federal Circuit has concluded that despite the fact that *Zurko* involved the Federal Circuit's review of a decision of the PTO, the Supreme Court's holding is applicable to findings of fact made by the TTAB. *Recot, Inc. v. Becton*, 214 F.3d 1322 (Fed.Cir.2000).

whether a “reasonable mind might accept” a particular evidentiary record in its totality as “adequate to support a conclusion.” *Dickinson v. Zurko*, 527 U.S. at 162 (citing *Consol. Edison Co. of New York v. N.L.R.B.*, 305 U.S. 197, 229 (1938)). “The possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial evidence.” *In re Thrifty, Inc.*, 274 F.3d 1349, 1351 (Fed. Cir. 2001) (quoting *Consolo v. Fed. Mar. Comm'n*, 383 U.S. 607, 620 (1966)).

Much of the substantial evidence test is framed in the negative. The United States Supreme Court described the minimum amount of evidence an agency must consider as “more than a mere scintilla.” *Consol. Edison Co. of New York v. N.L.R.B.*, 305 U.S. 197, 229 (1938). However, viewed from the opposite end of the spectrum, substantial evidence “does not mean a large or considerable amount of evidence.” *Koch v. S.E.C.*, 793 F.3d 147, 151 (D.C. Cir. 2015) (citing *Pierce v. Underwood*, 487 U.S. 552, 565 (1988)).

The TTAB has consistently used a two-prong test to evaluate an examining attorney’s decision to reject a mark for registration. *In Re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215 (P.T.O. Mar. 4, 2010)². The Federal Circuit, which is responsible for reviewing all appeals taken from the TTAB, adopted this test to serve as a guidepost in determining whether the TTAB satisfied the “substantial evidence test” in relation to disparagement determinations. *In re Geller*, 751 F.3d 1355, 1358

² See *In re Heeb Media LLC*, 89 USPQ2d 1071, 1074 (TTAB 2008); *In re Squaw Valley Development Co.*, 80 USPQ2d 1264, 1267 (TTAB 2006); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1740-41 (TTAB 1999), rev'd on other grounds, 284 F.Supp.2d 96, 68 USPQ2d 1225 (D.D.C. 2003), remanded, 415 F.3d 44, 75 USPQ2d 1525 (D.C. Cir. 2005), on remand, 567 F.Supp.2d 46, 87 USPQ2d 1891 (D.D.C. 2008), aff'd 565 F.3d 880, 90 USPQ2d 1593 (DC Cir. 2009).

(Fed. Cir. 2014) *cert. denied sub nom. Geller v. Patent & Trademark Office*, 135 S. Ct. 944 (2015).

The two-prong test requires the PTO/TTAB to first determine the “likely meaning of the [mark],” and, second, determine whether that mark refers to identifiable persons. *In re Geller*, 751 F.3d at 1358. In order to determine the meaning under the first prong, the PTO/TTAB should take into account: (1) dictionary definitions; (2) the relationship of the matter to the other elements in the mark; (3) the nature of the goods or services; and (4) the manner in which the mark is used in the marketplace in connection with the goods or services. *Id.* Next, the PTO/TTAB must move to the second prong and determine if the meaning of the mark refers to identifiable “persons, institutions, beliefs or national symbols.” *Id.* If the PTO/TTAB determines the mark does refer to persons, it must determine whether the meaning discerned under the first prong may be disparaging to “a substantial composite of the referenced group.” *Id.*

Here, the decision of the TTAB was supported by substantial evidence, as it took into account dictionary definitions; photographic evidence from Respondent’s website confirming the association with the dictionary definition; user comments on Respondent’s uTube and social media accounts; and Respondent’s marketing materials. Both prongs of the *Geller* test will be discussed below in parts 1 and 2 as will each prong’s subparts in parts 1(i-iv) and 2(i).

The decision of the TTAB to reject registration of the mark DUMB BLONDE was proper because the decision was supported by substantial evidence, as required by 5 U.S.C. § 706(2)(E).

1. *The Trademark Trial and Appeal Board properly ascertained the meaning of the proposed mark DUMB BLONDE.*

The TTAB's decision to reject the mark was proper under the first prong of the *Geller* test because it was supported by the plain meaning of the words “dumb” and “blonde,” as found in dictionaries, connotations associated with the phrase in the broader culture today, and the manner in which it is used in Respondent's goods and services.

The first element of the *Geller* test when evaluating a mark for registration requires that the PTO/TTAB determine the meaning of the proposed mark. The Court of Appeals for the Federal Circuit has endorsed the test that has been consistently used by the TTAB in its determinations. *In re Geller*, 751 F.3d at 1358. The first prong of the test requires that the TTAB ascertain the “likely meaning of the matter in question.” *Id.* In ascertaining the meaning, the TTAB must take into account dictionary definitions, the relationship of the matter to 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. *Id.* Each factor under the *Geller* test need not provide enough evidence to meet the “substantial evidence” test. *Id.* Rather, the entire test should be examined as a whole to determine whether the factors in their entirety constitute substantial evidence. *Id.*

The first prong is not, in and of itself, dispositive to the PTO/TTAB's decision to reject a mark. Rather, it is foundational in nature, and what is discovered in the course of investigating and collecting data under the first prong is then unpacked and analyzed under the second prong to make an ultimate determination.

Here, the TTAB laid the proper foundation as it analyzed the first prong. The PTO examining attorney investigated multiple dictionary definitions. There was a full investigation of the relationship of the mark DUMB BLONDE in relation to images posted on Respondent's website and uTube page. There is a complete exposition of the nature of Respondent's goods, as well as the manner in which the mark was used in association with Respondent's music, apparel, and the image projected into the marketplace.

i. The Trademark Trial and Appeal Board took into account dictionary definitions.

The TTAB's rejection of the mark DUMB BLONDE was proper because its analysis under the *Geller* test took into account dictionary definitions.

In ascertaining the meaning of the mark DUMB BLONDE, the *Geller* test requires the PTO/TTAB to take into account dictionary definitions. The PTO/TTAB need not examine every dictionary definition in existence, but rather provide enough evidence that it may be considered more than a "mere scintilla." This is one of many steps in creating a foundational understanding of the meaning of the mark as a whole. Dictionaries are often the most cogent source for ascertaining the meaning of a word. The United States Supreme Court has recognized that

dictionary definitions are often not controlling, but they are “at least persuasive that meanings which they do not embrace are not common.” *Aschenbrenner v. U. S. Fid. & Guar. Co.*, 292 U.S. 80 (1934). The *Geller* test was formed from a case in which a mark had multiple dictionary definitions, and the court upheld the TTAB’s decision to reject the registration of that mark based on the multiple dictionary meanings and connotations of the word. *In re Geller*, 751 F.3d at 1359. In that case, the court was faced with the multiple meanings of the word ISLAMISATION, most notably the meanings that dealt with conversion to a belief in Islam by force. *Id.* The TTAB recently refused to register a mark which had several alternate meanings, many of which were found to be innocuous, because alternate, innocuous definitions “do not foreclose the possibility that the proposed mark is disparaging to a group of persons.” *In Re Tam*, 108 U.S.P.Q.2d 1305 (P.T.O. Sept. 26, 2013). The element of a dictionary definition’s persuasiveness is one factor among many taken into account in the *Geller* test. The evidence uncovered in the remaining factors of the test gives the investigating attorney a sound basis and context upon which to accept or reject the mark.

Here, a full exposition of the mark DUMB BLONDE in dictionary definitions leads an ordinary person to the same conclusion as the PTO/TTAB: the word “dumb” suggests “lacking the human power to speak,” “lacking intelligence,” and that the usage of the word is “often offensive.” *Dumb Definition*, Merriam-Webster Dictionary, <http://www.merriam-webster.com/dictionary/dumb> (last visited Oct. 19, 2015). The meaning of the term “blonde,” in addition to referring to hair

that is “of a flaxen, golden, light auburn, or pale yellowish-brown color,” also notes that the word should be spelled “blond” when referring to a male and “blonde” when referring to a female. *Blonde Definition*, Merriam-Webster Dictionary, <http://www.merriam-webster.com/dictionary/blonde> (last visited Oct. 19, 2015). The multiple meanings and connotations of the word “dumb” gives the PTO/TTAB reasonable grounds to refuse the mark based on the plain meaning of the word when it is read together with the meaning of the word “blonde.”

The TTAB’s rejection of the mark DUMB BLONDE was proper because its analysis under the *Geller* test took into account dictionary definitions.

ii. The Trademark Trial and Appeal examined the relationship of the matter to the other elements of the mark.

The TTAB’s rejection of the mark DUMB BLONDE was proper because it took into account the relationship of the matter to other elements of the mark, as required by the *Geller* test.

In ascertaining the meaning of the mark DUMB BLONDE, the *Geller* test requires the PTO/TTAB to take into account the relationship of the matter to other elements in the mark. *In re Geller*, 751 F.3d at 1359. Most proposed marks are more than simple words or slogans. They contain images or stylized text that interplay with the word to give the mark an entirely different meaning. Other elements in the mark can be accompanying logos and images associated with the mark as it is applied to the applicant’s goods and/or services. *Harjo v. Pro Football, Inc.*, 50 U.S.P.Q.2d 1705 (using a side profile of a cartoon of a Native American

man's head in association with the word "Redskins"). Words that would otherwise be innocuous change when placed next to other elements outside of the mark. The TTAB rightfully rejected a proposed mark, KHORAN, because it placed the word in the same context as alcoholic beverage labeling, and the explicit teaching of the Koran states that drinking alcohol is considered unacceptable. *In re Lebanese Arak*, 94 U.S.P.Q.2d 1215.

Here, the PTO/TTAB examined sufficient evidence under the "relationship of the matter to the other elements in the mark" factor to have a well-rounded analysis under the *Geller* test. The PTO examining attorney compiled evidence of the mark with some of its sub-elements, which included images that depicted a blonde woman eating plastic fruit and applying Wite-Out® to her computer monitor.

The TTAB's rejection of the mark DUMB BLONDE was proper because it took into account the relationship of the matter to other elements in the mark, as required by the *Geller* test.

iii. The Trademark Trial and Appeal Board considered the nature of the goods and services.

The TTAB's rejection of the mark DUMB BLONDE was proper because it took into account the nature of the goods and/or services, as required by the *Geller* test.

In ascertaining the meaning of the mark DUMB BLONDE, the *Geller* test requires the PTO/TTAB to take into account the nature of the goods and services for which the mark is to be associated with. This step requires a simple identification of

the type of goods and/or services the applicant seeks to associate with the mark. The type of goods and services is required on the application for a mark, and it is largely supplied by the applicant and not by the PTO examining attorney. *See In Re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (P.T.O. May 23, 2006). It is a factor courts do not tend to dwell upon and requires a short recitation of the findings of the PTO examining attorney.

Here, the PTO/TTAB conducted a proper cataloging of the types of goods and services Respondent intended to use in association with the mark DUMB BLONDE. Respondent used the mark in association with her recorded and live musical performances as well as the sale of clothing connected to her music. The examining attorney went as far to identify the specific genres of music performed by Respondent such as “Grindcore, Neurofunk, and American Folk music.”

The TTAB’s rejection of the mark DUMB BLONDE was proper because it took into account the nature of the goods and/or services, as required by the *Geller* test.

iv. The Trademark Trial and Appeal Board took into account the manner in which the mark DUMB BLONDE is used in the marketplace in connection with the goods or services.

The TTAB’s rejection of the mark DUMB BLONDE was proper because it took into account the manner in which the mark is used in the marketplace in connection with the goods and/or services, as required by the *Geller* test.

In ascertaining the meaning of the mark DUMB BLONDE, the *Geller* test requires the PTO/TTAB to take into account the manner in which the mark is being

used in connection with the goods or services. One factor in analyzing this prong is whether the mark retains its meaning when it is ultimately connected with the goods. *In Re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (P.T.O. Nov. 26, 2008). In *Heeb* the TTAB determined that the mark HEEB retained its meaning as a derogatory term for a Jewish person when used in connection with the applicant's clothing line and party services. *Id.* The TTAB subsequently rejected the mark despite the fact that "heeb" had become hip and trendy in certain Jewish circles, similar to African Americans reclaiming the word "nigger" in the intracultural context. *Id.*

Here, the meaning of the mark DUMB BLONDE have not changed when connected to the goods. In fact, there are elements of the mark that deliberately attempt to connect itself with the longstanding female stereotype, most notably Respondent's use of pictures of women eating plastic fruit and painting Wite-Out® on computer screens.

The TTAB's rejection of the mark DUMB BLONDE was proper because it took into account the manner in which the mark is used in the marketplace in connection with the goods and/or services, as required by the *Geller* test.

2. *The Trademark Trial and Appeal Board properly determined that the mark DUMB BLONDE refers to identifiable persons.*

The TTAB's rejection of the mark DUMB BLONDE was proper because it concluded that the mark refers to identifiable persons under the second prong of the *Geller* test.

Identifiable persons need not be in a necessarily large group. *In Re Heeb Media, LLC*, 89 U.S.P.Q.2d at 1071. The mark need only identify certain

characteristics that describe the group with reasonable specificity. Such characteristics and traits come in a variety of forms: sexual orientation; religion; native or aboriginal origin; and race and sex. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 U.S.P.Q.2d 1212 (P.T.O. Sept. 13, 2006) (orientation); *In Re Heeb Media, LLC*, 89 U.S.P.Q.2d at 1071 (religion); *Harjo v. Pro Football, Inc.*, 50 U.S.P.Q.2d 1705 (P.T.O. Apr. 2, 1999) (native origin); *Boswell v. Mavety Media Group Ltd.*, 52 U.S.P.Q.2d 1600 (P.T.O. July 28, 1999) (race and sex).

The PTO examining attorney viewed a considerable amount of information and determined that the mark DUMB BLONDE referred to women with blonde hair. Respondent admits that the mark is intended to refer to women and contends that it is used for a positive purpose. There is no evidence in the record that the mark was intended to refer to any other identifiable group.

The TTAB's rejection of the mark DUMB BLONDE was proper after it found that the mark DUMB BLONDE refers to identifiable persons under the second prong of the *Geller* test.

i. The Trademark Trial and Appeal Board properly determined that the meaning of DUMB BLONDE may be disparaging to a substantial composite of women.

The TTAB's rejection of the mark DUMB BLONDE was proper in its conclusion that the mark may be disparaging to a substantial composite of women under the second prong of the *Geller* test.

Upon determining whether the proposed mark refers to a group of identifiable persons, the TTAB must determine whether the meaning of the mark "may be disparaging to a substantial composite of the referenced group." *In re*

Geller, 751 F.3d at 1359. There is no bright line rule as to what comprises a substantial composite of the referenced group. The substantial composite is not a simple majority or any fixed percentage. *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981). Courts have found the opinions and beliefs of activists and sympathetic legislators to be persuasive in determining whether the mark disparages a substantial composite of a referenced group. *In Re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (P.T.O. May 23, 2006). Whether the applicant has good intentions with regard to its use of the mark is irrelevant. *In Re Heeb Media, LLC*, 89 U.S.P.Q.2d at 1071. Such good intentions do not alter the fact that a substantial composite of the referenced group may find the term objectionable. *Id.*

Here, the PTO and TTAB concluded that the mark is disparaging to a substantial composite of women based on numerous articles discussing the offensiveness of the term “dumb blonde” as well as user comments on Respondent’s uTube page. The fact that there are women who enjoy Respondent’s music and interpret the stage name “dumb blonde” to have a positive meaning does not require the Court to overturn the findings of the TTAB and the Circuit Court. The statute simply requires that a substantial composite of the identified group—which does not need to be a majority of the group—find the mark offensive.

The TTAB’s rejection of the mark DUMB BLONDE was proper as its conclusion that DUMB BLONDE may be disparaging to a substantial composite of women under the second prong of the *Geller* test.

CONCLUSION

For the reasons stated above, Respondents respectfully request that this Court *reverse* the decision of the Court of Appeals for the Federal Circuit that section 2(a) of the Lanham Act violates the First Amendment of the United States Constitution and *affirm* the decision that the TTAB's rejection of the DUMB BLONDE mark is supported by substantial evidence.