

No. 15 – 1007

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*In The  
Supreme Court of the United States*

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UNITED STATES OF AMERICA,

Petitioner,

v.

KOURTNEY LUHV,

Respondent.

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*On Writ of Certiorari to  
The United States Court of Appeals  
For the Federal Circuit*

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BRIEF FOR RESPONDENT

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TEAM NO. 126  
COUNSEL FOR RESPONDENT  
OCTOBER 20, 2015

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## QUESTIONS PRESENTED

- I. Whether the Trademark Trial and Appeal Board erred in rejecting Kourtney Luhv's application to register the trademark DUMB BLONDE as Ms. Luhv's stage name, on the basis that the mark may be disparaging to women under Section 2(a) of the Lanham Act.
  
- II. Does Section 2(a)'s prohibition on registering marks that may be disparaging to some violate the United States Constitution and First Amendment principles?

TABLE OF CONTENTS

QUESTIONS PRESENTED.....i

TABLE OF CONTENTS.....ii-iii

TABLE OF AUTHORITIES.....iv-ix

OPINIONS BELOW.....x

STATEMENT OF JURISDICTION.....x

STANDARD OF REVIEW.....x

STATEMENT OF THE CASE .....1

SUMMARY OF THE ARGUMENT.....4

ARGUMENT.....6

    I.    THIS COURT SHOULD REVERSE IN PART THE FEDERAL  
          CIRCUIT’S DECISION BECAUSE THE TTAB ERRED IN REJECTING  
          RESPONDENT’S TRADEMARK APPLICATION.....6

        A.  The Likely Meaning Of Respondent’s Proposed Mark When Taking  
            Into Account All Of The Relevant Evidence Is That It Is A Caricature  
            Of The Former, Antiquated, “Dumb Blonde” Stereotype.....8

        B.  The TTAB Erred in Determining That The “Likely Meaning” Of The  
            Proposed Mark, As Used In Connection With Ms. Luhv’s Goods And  
            Services, Would Be Disparaging To A Substantial Composite Of  
            Blonde Women.....12

        C.  Any Doubt As To Whether DUMB BLONDE Would Be Disparaging  
            To Blonde Women Should Be Resolved In Favor Of Publication.....19

    II.   THIS COURT SHOULD AFFIRM IN PART THE FEDERAL CIRCUIT’S  
          DECISION BECAUSE SECTION 2(A)’S PROHIBITION ON  
          REGISTERING MARKS THAT MAY BE DISPARAGING VIOLATES  
          THE UNITED STATES CONSTITUTION.....20

        A.  “Dumb Blonde” Is A Trade Name Or Trademark Protected By The  
            First Amendment As Commercial Speech.....21

B. Section 2(a)'s Prohibition On Registering Marks That May Be Disparaging Is An Abridgment of Protected Speech.....	24
1. Section 2(a) implicates the First Amendment by substantially burdening a registrant's protected expression.....	24
2. Section 2(a)'s conditional treatment of protected speech runs afoul the unconstitutional conditions doctrine.....	30
C. Section 2(a) is an Unconstitutional Content-Based Abridgement Of Ms. Luvh's Protected Speech Under First Amendment Scrutiny.....	34
1. Section 2(a) is a content based restriction on the exercise of protected commercial speech.....	34
2. Section 2(a) is unconstitutional because it fails intermediate scrutiny under <i>Central Hudson's</i> test for regulation of commercial speech.....	35
CONCLUSION.....	38

TABLE OF AUTHORITIES

UNITED STATES SUPREME COURT

*Agency for Intern Development v. Alliance for Open Society Intern., Inc.*

133 S.Ct. 2321 (2013).....32

*B & B Hardware, Inc. v. Hargis Ind., Inc.*

135 S.Ct. 1293 (2015).....27-28

*Bigelow v. Virginia*

421 U.S. 809 (1975).....21

*Bolger v. Young Drug Prod. Corp.*

463 U.S. 60 (1983).....36

*Carey v. Population Services Int’l*

431 U.S. 678 (1977).....20

*Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n*

447 U.S. 557 (1980).....passim

*Cincinnati v. Discovery Network*

507 U.S. 410 (1993).....22

*Figueroa v. United States*

466 F.3d 1023 (Fed. Cir. 2006).....33

*Friedman v. Rogers*

440 U.S. 1 (1979).....21-22

*Perry v. Sindermann*

408 U.S. 593 (1972).....24,30

<i>Pierce v. Underwood</i>	
487 U.S. 552 (1988).....	x
<i>Koontz v. St. Johns River Water Management Dist.</i>	
133 S.Ct. 2586 (2013).....	31
<i>R.A.V. v. City of St. Paul, Minn.</i>	
505 U.S. 377 (1992).....	34
<i>Regan v. Taxation with Representation of Wash.</i>	
461 U.S. 540 (1991).....	31
<i>Roth v. United States</i>	
354 U.S. 476 (1957).....	21
<i>Rust v. Sullivan</i>	
500 U.S. 540 (1983).....	31
<i>Simon &amp; Schuster, Inc., v. Members of N.Y. State Crime Victims Bd.</i>	
502 U.S. 105 (1991).....	26
<i>Sorrell v. IMS Health Inc.</i>	
131 S.Ct. 2653 (2011).....	26,36
<i>United States v. Playboy Ent. Grp., Inc.</i>	
529 U.S. 803 (2000).....	24
<i>United States v. Edge Broad. Co.</i>	
509 U.S. 418 (1993).....	34
<i>Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council</i>	
425 U.S. 748 (1976) .....	20, 34

<i>Walker v. Tex. Div., Sons of Confederate Veterans, Inc.</i>	
135 S.Ct. 2239 (2015) .....	36

UNITED STATES COURTS OF APPEALS

*Bullfrog Films Inc. v. Wick*

847 F.2d 502 (9th Cir. 1988) .....	32
------------------------------------	----

*Carson v. Here's Johnny Portable Toilets, Inc.*

698 F.2d 831 (6th Cir. 1983) .....	15
------------------------------------	----

*Dep't of Tex., Veterans for Foreign Wars v. Tex. Lottery Comm'n*

760 F.3d 427 (5th Cir. 2014) .....	32
------------------------------------	----

*In re Boulevard Ent.*

334 F.3d 1336 (Fed. Cir. 2003) .....	7, 14-16, 25
--------------------------------------	--------------

*In re Geller*

751 F.3d 1355 (Fed. Cir. 2014) .....	6-8, 10
--------------------------------------	---------

*In re Kourtney Luv*

1337 F.3d 455 (Fed. Cir. 2015) .....	passim
--------------------------------------	--------

*In re Mavety Media Grp. Ltd.*

33 F.3d 1367 (Fed. Cir. 1994) .....	passim
-------------------------------------	--------

*Ritchie v. Simpson*

170 F.3d 1092 (Fed. Cir. 1999) .....	25
--------------------------------------	----

*Satellite Broad. & Commc'ns Ass'n v. FCC*

275 F.3d 337 (4th Cir. 2001) .....	32
------------------------------------	----

<i>Volkswagenwerk Aktiengesellschaft v. Wheeler</i>	
814 F.2d 812 (1st Cir. 1987) .....	25
<i>Santana Products Inc. v. Compression Polymers, Inc.</i>	
8 F.3d 152 (3d Cir. 1993) .....	25
<i>Test Masters Educational Services v. Inc. v Singh</i>	
428 F.3d 559 (5th Cir. 1981) .....	25

UNITED STATES DISTRICT COURTS

<i>Pro-Football Inc. v. Blackhorse</i>	
2015 WL 4096277 (E.D. Va. July 8, 2015) .....	36
<i>Pro-Football, Inc. v. Harjo</i>	
284 F. Supp. 2d 96 (D.D.C. 2003).....	7, 12-13, 16

TRADEMARK TRIAL & APPEAL BOARD

<i>In re in Over Our Heads Inc.</i>	
16 U.S.P.Q.2d 1653 (P.T.O. Aug. 28, 1990) .....	10, 18-19
<i>In re McGinley</i>	
660 F.2d 481 (C.C.P.A. 1979) .....	passim
<i>In re Lebanese Arak Corp.</i>	
94 U.S.P.Q.2d 1215 (P.T.O. Mar. 4, 2010) .....	9
<i>In re Old Glory Condom Corp.</i>	
26 U.S.P.Q.2d 1216 (TTAB Mar. 3, 1993).....	14, 36

*In re Prosynthesis Labs., Inc.*

77902555, 2012 WL 1267929 (Mar. 23, 2012).....9, 14-15, 17

*In re Squaw Valley Dev. Co.*

80 U.S.P.Q.2d 1264 (P.T.O. May 23, 2006) .....10

*In re Tam*

108 U.S.P.Q.2d 1305, \*5 (P.T.O. Sept. 26, 2013) .....9-10

*Order Sons of Italy in Am.*

52 U.S.P.Q.2d 1364 (P.T.O. July 9, 1999) .....8, 10

UNITED STATES CONSTITUTION

U.S. Const. amend. I.....x, 20

FEDERAL STATUTES

15 U.S.C. § 1052(a) (2006) .....x

15 U.S.C. § 1121 (1998).....x, 27

15 U.S.C. § 1117 (2008).....x, 27

28 U.S.C. § 1254(1) (2006).....x

SECONDARY SOURCES

*Jeffrey Lefstin*

Does the First Amendment Bar Cancellation of Redskins? 52 Stan. L. Rev.

665 (2000).....35

*Stephen R. Baird*

Moral Intervention in the Trademark Arena: Banning the Registration of  
Scandalous and Immoral Trademarks, 83 Trademark Rep. 661 (1993)...25, 34

*Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. On Trademarks of the  
House Comm. On Patents, 76th Cong., 1st Sess. 18-21 (1939).....35*

UNITED STATES TRADEMARKS

DUMB BLONDE, Registration No. 2601964.....18

DYKES ON BIKES, Registration No. 3323803.....17

## OPINIONS AND ORDERS BELOW

The opinion of the United States Court of Appeals for the Federal Circuit is reported at *In re Kourtney Luhv*, 1337 F.3d 455 (Fed. Cir. 2015).

## STATEMENT OF JURISDICTION

This Court has jurisdiction to review the final judgment of the Federal Circuit pursuant to 28 § U.S.C. 1254(1) (2006).

## STANDARD OF REVIEW

This Court reviews questions of law *de novo*. *Pierce v. Underwood*, 487 U.S. 552, 558 (1988).

## CONSTITUTIONAL AND STATUTORY PROVISIONS

15 U.S.C. §§ 1052(a), 1121, 1117

U.S. Const. amend. I

## STATEMENT OF THE CASE

The Respondent, Ms. Kourtney Luhv (“Ms. Luhv”), is a vocalist and solo artist known by her stage name, DUMB BLONDE. *In re Kourtney Luhv*, 1337 F.3d 455 (Fed. Cir. 2015). The music she creates incorporate elements from multiple genres, including Grindcore, Neurofunk, and American Folk music. *Id.* DUMB BLONDE’s lyrics specifically focus on issues faced by women in today’s society, and create discussion on specific problems such as gender stereotyping. *Id.* Ms. Luhv’s trade name has become synonymous with her music, as she has performed under DUMB BLONDE since 2012. *Id.* During this time, she has appeared in various venues across various states and garnered a significant fan base who frequently attend her concerts across the country. *Id.* Ms. Luhv has also acquired the interest of thousands of active online users who follow her music on online streaming services, such as [www.soundpuff.com](http://www.soundpuff.com) (“soundpuff”) and [www.uTube.com](http://www.uTube.com) (“utube”) under the account DumbBlondeMusic. *Id.* at 456.

Through DumbBlondeMusic, Ms. Luhv posts videos to communicate with her devoted fan base and share music-related tips with other users. *Id.* When Ms. Luhv filed her application for registration of DUMB BLONDE with the Patent and Trademark Office, she had already acquired over 40,000 “followers” on her soundpuff account and 100,000 active subscribers to her uTube channel. *Id.*

In June 2014, Ms. Luhv finished recording several pieces of music that she wished to release in extended play format through a record label. *Id.* Consequently, Ms. Luhv negotiated a deal with the record label for a recording

contract that would include a \$2,000,000 advance upon execution of the agreement.

*Id.* However, this contract was contingent on Ms. Luhv's registration of DUMB BLONDE with the United States Patent and Trademark Office ("PTO"). *Id.*

Although Ms. Luhv filed an application with the PTO on July 9, 2014 (No. 99/989, 052) to register DUMB BLONDE for "entertainment, namely live performances by a musical band" and "clothing, namely sweatshirts, t-shirts, tank tops and headwear," the examining attorney for the PTO denied Ms. Luhv's application. *Id.* Upon examining materials submitted in the '052 registration, the examining attorney found that the mark could be disparaging to some women under 15 U.S.C. § 1052(a), the Lanham Act and refused registration of the mark. *Id.* Ms. Luhv subsequently contested the application's denial and appealed before the Trademark Trial and Appeal Board ("TTAB"). *Id.*

However, the TTAB affirmed the examining attorney's refusal to register Ms. Luhv's mark on the basis that it "may be disparaging to a substantial composite of the referenced group, namely women with blonde hair color." *Id.* In making this determination, the TTAB cited photograph images from Ms. Luhv's website. *Id.* Ms. Luhv maintained during her appeal that she chose DUMB BLONDE as her trade name as a means of reclaiming the stereotype associated with blonde women while raising awareness for the challenges stemming from gender stereotypes and discrimination. *Id.* at 457. Nonetheless, the TTAB chose to refer to dictionary definitions, articles and some user comments from Ms. Luhv's uTube account to conclude that some women find the phrase "dumb blonde" to be offensive. *Id.*

Ms. Luhv subsequently appealed the TTAB's decision, contending that (1) the evidence before the TTAB was insufficient to find the mark disparaging to a substantial composite of women and (2) Section 2(a) of the Lanham Act's prohibition on registering marks that may be disparaging is unconstitutional. *Id.* The Federal Circuit reversed. *Id.* at 460.

## SUMMARY OF THE ARGUMENT

This Court should reverse in part the Federal Circuit's decision because the TTAB erred in rejecting respondent's trademark application. The TTAB grounded its determination that the proposed mark was disparaging on insufficient evidence and failed to consider contrary evidence presented by Respondent. When taking into account all the evidence before the Court the "likely meaning" of the Respondent's mark is that it is an inoffensive caricature of the former, antiquated, "dumb blonde" stereotype.

Additionally, the TTAB engaged in the same brand of piecemeal fact finding to support its finding that the mark would be disparaging to "a substantial composite of blonde women." At no point did the TTAB establish whether the evidence before the board was in fact representative of a substantial composite or if the anonymous declarations were indeed those of blonde women. Further, the board neglected to follow its own precedent of passing for registration marks if there is evidence that similar marks have been registered.

Any doubt as to whether "DUMB BLONDE" would be disparaging to blonde women should be resolved in favor of publication. The TTAB has a longstanding practice and policy of resolving cases of doubt in favor of passing a mark for publication due to the office's limited resources. The examining attorney's evidence raised a question of doubt and thus the TTAB failed to follow its own precedent by not passing this mark for publication. This approach would allow for an opposition hearing to be brought if a party felt disparaged and a more complete record could be

developed, conserving the limited resources of the PTO by sparing it the expense of unnecessary litigation.

Further, this Court should affirm in part the Federal Circuit's decision because Section 2(a) of the Lanham Act's prohibition on registration of marks that may be "disparaging" is unconstitutional under the First Amendment. Trademarks and trade names are commercial speech, and any content-based regulation or abridgement of a mark's expression must be justified by a substantial government interest and intermediate scrutiny.

Ms. Luhv's trademark DUMB BLONDE expresses valuable social commentary, and Section 2(a)'s refusal to grant registration on the basis of its disapproval of the mark's message amounts to a content-based regulation. Moreover, Section 2(a) imposes both procedural and economic burdens on to Ms. Luhv's protected speech and a "financial disincentive," resulting in an indirect abridgement of speech or chilling effect. The First Amendment is further implicated, where the government denies significant benefits purely because a Ms. Luhv wishes exercise their constitutional right to free speech.

This content based abridgement of commercial speech is unjustified and unsupported by any substantial government interest independent of its disapproval of DUMB BLONDE's message. As such, Section 2(a)'s prohibition on registration of disparaging marks cannot withstand intermediate scrutiny and must be found unconstitutional under the First Amendment.

## ARGUMENT

### I. THIS COURT SHOULD REVERSE IN PART THE FEDERAL CIRCUIT'S DECISION BECAUSE THE TTAB ERRED IN REJECTING RESPONDENT'S TRADEMARK APPLICATION.

The TTAB erred as a matter of law because it failed to correctly determine the “likely meaning” of the proposed mark, it had insufficient evidence to find that the mark was disparaging, and because it broke with its own practice and precedent by refusing to allow the mark to pass for publication. The TTAB and the Federal Circuit have developed a two-prong test to determine whether a proposed mark is “disparaging” under §2(a) of the Lanham Act and thus to be refused registration. *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014). Prong one of the “*Harjo I*” test mandates that the TTAB to make its determination as to the “likely meaning” of the mark in light of all of the relevant circumstances including “dictionary definitions . . . the relationship of the matter to the other elements in the mark, the nature of the goods and services, and the manner in which the mark is used in the marketplace in connection with the goods and services.” *Id.* at 1358.

When a mark is capable of multiple meanings the TTAB must consider the “likely meaning” that a “substantial composite of the referenced group” would associate with the mark. *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994). In this case, the evidence before the TTAB clearly demonstrates that people would attribute an alternative, non-disparaging meaning to respondent's proposed mark when it is considered in the context of her songs which serve to break down the “dumb blonde” stereotype and in its place provide a positive

message that brings attention to the issues faced by young women in today's world. *Kourtney Luhv*, 1337 F.3d at 457.

The second prong of this test requires the TTAB to consider whether the “likely meaning” may be disparaging to a substantial composite of the referenced group. *Geller*, 751 F.3d at 1358. The factual record must contain affirmative evidence that accurately evinces the views of a substantial composite of the referenced group in order for the TTAB to find a mark to be disparaging. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 128-29 (D.D.C. 2003). The TTAB is required to weigh all of the evidence and base its determination on the cumulative effect of the entire record. *Id* at 127-28. However, the TTAB may not rely on anecdotal evidence that merely consists of the personal opinions of the declarants themselves. *In re Boulevard Ent., Inc.*, 334 F.3d 1336, 1341 (Fed. Cir. 2003).

Here the TTAB not only rested its determination that the mark was disparaging on insufficient evidence but also failed to consider contrary evidence presented by the respondent which shows that the phrase “dumb blonde” would not be viewed as disparaging by blonde women. The limited resources of the PTO necessarily dictate that the TTAB to have a policy of resolving doubts as to whether a mark is disparaging in favor of publication. *Mavety Media*, 33 F.3d at 1374. Resolving doubts in favor of publication thus allows for an opposition proceeding to be brought and a more complete record to be established if a party believes the trademark to be disparaging. The evidence presented by the examining attorney here at best raised a question of doubt as to whether the mark is disparaging and

thus the proper course of action would have been for the TTAB to pass the mark for publication.

A. The Likely Meaning Of Respondent's Proposed Mark When Taking Into Account All Of The Relevant Evidence Is That It Is A Caricature Of The Former, Antiquated, "Dumb Blonde" Stereotype.

The first prong of the *Harjo I* disparagement test mandates the TTAB to make its determination as to the "likely meaning" of the mark in light of all of the relevant circumstances including "dictionary definitions . . . the relationship of the matter to the other elements in the mark, the nature of the goods and services, and the manner in which the mark is used in the marketplace in connection with the good and services." *Geller*, 751 F.3d at 1358. The TTAB considers the "meaning most likely to be attributed to the [proposed mark], as it is being used in [the applicant's] mark and in connection with [the applicant's] services." *Order Sons of Italy in Am.*, 52 U.S.P.Q.2d 1364, \*5 (P.T.O. July 9, 1999). The proposed trademark "must be considered in the context of the marketplace as applied to only the goods or services described in the application for registration." *In re McGinley*, 660 F.2d 481, 385 (C.C.P.A. 1981).

When a mark is capable of multiple meanings there must be an evidentiary showing as to which of the multiple meanings the substantial composite would associate with the mark. In *Mavety*, the TTAB affirmed the examiner's refusal to register the trademark "BLACK TAIL" for "an adult entertainment magazine featuring photographs of both naked and scantily-clad African American women." *Mavety Media*, 33 F.3d at 1368-69. The Federal Circuit found that the proposed

mark was capable of both an offensive meaning: “sexual intercourse” and a non-offensive meaning: “the rear end.” *Id.* at 1373-74. The court vacated the TTAB’s finding that the mark was prohibited by §2(a) of the Lanham Act because there was no “evidence as to which of these definitions the substantial composite would choose . . . .” *Id.* at 1374. *See also In Re Prosynthesis Labs., Inc.*, 77902555, 2012 WL 1267929, at \*18 n. 22 (Mar. 23, 2012) (noting that even a dictionary definition indicating that a term is derogatory or offensive may not be sufficient where the term has both offensive and inoffensive meanings).

The likely meaning of the mark is to be determined from the standpoint of the general public and not simply from the perspective of the alleged disparaged group. In *In re Lebanese Arak*, the examining attorney refused the registration of the mark “KHORAN” for “alcoholic beverages, namely wines” on the grounds that it was disparaging to Muslims. *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, \*1 (P.T.O. Mar. 4, 2010). The TTAB affirmed the refusal because although “Khoran” is the Armenian word for “altar” there was no evidence that people would not view the proposed mark as an alternate spelling of “Koran.” *Id.* at \*6. The lengthy dissenting opinion expressed significant concern with the majority’s approach, criticizing it for focusing on the views of the referenced group in determining the likely meaning of the mark and thus breaking with TTAB precedent and “loading the deck” for purposes of any disparagement test.” *Id.* at \*7. *See In Re Tam*, 108 U.S.P.Q.2d 1305, \*5 (P.T.O. Sept. 26, 2013) (“[E]vidence of public perception of the meaning of [the proposed mark], as used in connection with applicant’s services” is

determinative of the “likely meaning” of the proposed mark”); *In re in Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653 (P.T.O. Aug. 28, 1990) (determining the “likely meaning” of a mark from the perspective of the general public).

Here the TTAB failed to properly consider the “likely meaning” of the proposed mark in the context of the “manner in which the mark is used in the marketplace in connection with the goods and services” as required by the first prong of the *Harjo I* test. *Geller*, 751 F.3d at 1358. The facts of this case are similar to those at issue in cases where a proposed mark is capable of multiple meanings, both offensive and inoffensive. *See, e.g. In re in Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653 (proposed mark “Moonies” was not disparaging because in context it was descriptive of the applicant’s product as opposed to a reference to The Unification Church); *Order Sons of Italy in Am.*, 52 U.S.P.Q.2d 1364 (proposed mark “THE MEMPHIS MAFIA” was not disparaging because in context it referred to “an exclusive and dominant group” as opposed to “a criminal organization composed of persons of Italian origin); *Mavety Media*, 33 F.3d 1367 (proposed mark “BLACK TAIL” was not disparaging because in context it referred to “the rear end” as opposed to “sexual intercourse”); *and In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (P.T.O. May 23, 2006) (proposed mark “SQUAW” was not disparaging because in context it referred to applicant’s Squaw Valley ski resort and not to Native American women ).

The evidence before the TTAB and the Federal Circuit as well as the evidence now before this Court demonstrates that the proposed mark “DUMB BLONDE” is

in fact capable of both an offensive meaning (that blonde women are unintelligent) and a non-offensive meaning (respondent's caricature of the dumb blonde stereotype for purposes of bringing attention to the challenges faced by women). *Kourtney Luhv*, 1337 F.3d at 457. The TTAB failed to follow the standard set out in *McGinley* which requires the "likely meaning" of the mark to be determined "in the context of the marketplace as applied to only the goods or services described in the application for registration." *McGinley*, 660 F.2d at 385. The TTAB erred to the extent it relied on photographs from the respondent's website and anonymous comments on her uTube channel in determining the "likely meaning" of the mark because these goods and services were not included in respondent' application for "Entertainment, namely live performances by a musical band" and "clothing, namely, sweatshirts, t-shirts, tank tops, and headwear." *Kourtney Luhv*, 1337 F.3d at 456. Unlike the TTAB in *Mavety Media*, which erred because it *did not* have evidence as to which of the multiple meanings the substantial composite would choose, here the TTAB erred because it *did* have such evidence and nevertheless ignored it. The TTAB here committed reversible error because it had direct evidence which showed that the substantial composite would likely choose the non-offensive meaning and nevertheless found the "likely meaning" to be the offensive one. The facts of record show that Ms. Luhv, along with her message that hair color is not an indicia of intelligence, has achieved immense popularity. *Id.* at 455-56. The fact that Ms. Luhv has over 40,000 "followers" of her Soundpuff account and over 100,000 active subscribers to her uTube channel, show that her message is well known to many

people and that a substantial composite of blonde women would very likely attribute the aforementioned “non-offensive” meaning to the “DUMB BLONDE” trademark as used for live performances and merchandising. *Id.* at 456.

B. The TTAB Erred in Determining That The “Likely Meaning” Of The Proposed Mark, As Used In Connection With Ms. Luhv’s Goods And Services, Would Be Disparaging To A Substantial Composite Of Blonde Women.

The Federal Circuit has held that it is “duty-bound” by its predecessors to use a “substantial composite of the general public” standard while applying the second-prong of the *Harjo I* test. *Mavety Media Grp.*, 33 F.3d at 1371. The TTAB may not deny registration of a proposed mark unless its findings of fact directly prove that the mark at issue “may disparage” a “substantial composite” of the referenced group. *Harjo*, 284 F. Supp. 2d at 127. The TTAB’s finding of disparagement must be predicated on “the cumulative effect of the entire record.” *Id.* at 128.

The TTAB must have direct evidence before it that tends to either prove or disprove that the proposed trademark is disparaging to a substantial composite of the referenced group. In *Harjo I* a group of Native Americans brought a trademark cancellation action against the owner of the Washington Redskins’ trademarks alleging that they were disparaging to Native Americans. *Id.* at 99. The United States District Court for the District of Columbia reversed, holding that the TTAB’s finding of disparagement was not supported by substantial evidence. *Id.* at 145. The district court criticized the TTAB’s failure to make a conclusion “*based on the cumulative effect of the entire record.*” *Id.* at 127-28 (emphasis original, internal citation omitted). Central to the district court’s holding was the fact that the

TTAB's findings of fact were "in only two very specific areas; and many . . . simply summarized undisputed testimony." *Id.*

The TTAB must consider all of the relevant evidence and take into account not only evidence supporting a finding of disparagement but also evidence weighing against it. The district court in *Harjo I* reiterated this standard in finding that the TTAB may not "[reach] its decision . . . inferentially, by piecing together bits of limited, undisputed evidence from the record." *Id.* at 128. The court went on to elucidate that the TTAB's findings of fact must involve "weighing conflicting evidence [and] addressing criticisms of some of the evidence." *Id.*

The determination of whether a proposed mark is disparaging is made from the view point of the referenced group and absent a showing that "the views of the [referenced group] on the issue [are] congruent with that of the population as a whole", evidence of the views of the general public is not probative of the views of the referenced group. *Id.* at 128-29. The district court reasoned that in order for the TTAB to find that a survey represents the views of the referenced group as a whole it must have a "scientific basis for the extrapolation." *Id.* at 121. Further, there must be evidence regarding the aggregate number of individuals in the referenced group who find the proposed mark offensive. *Id.*

A court may not rely on anecdotal evidence consisting of anonymous declarations that a mark is offensive or insulting. The Federal Circuit has found that declarations "consist[ing] mainly of the personal opinions of the declarants as to the offensiveness of the [proposed mark] . . . do not provide strong factual

support” that the proposed mark is disparaging to a substantial composite of the referenced group. *Boulevard Ent.*, 334 F.3d at 1341.

The TTAB must consider the potential for disparagement in the context of contemporary attitudes and acknowledge the fact that social mores and sensitivities change and evolve over time. In *Mavety Media*, the Federal Circuit vacated the judgment of the TTAB and found that the TTAB failed to consider the mark “in the context of contemporary attitudes.” *Mavety Media*, 33 F.3d at 1471 (quoting *In re Old Glory Condom Corp.*, 26 USPQ2d 1216, 1219 (TTAB 1993)).

Although an applicant’s good intentions do not change the analysis when the facts directly demonstrate that a mark would be viewed as disparaging to a substantial composite, the applicant’s intent in using the mark is an important consideration bearing on whether or not the mark is actually viewed as disparaging by the referenced group. In *Prosynthesis*, the United States Patent and Trademark Office (“PTO”)’s managing attorney refused registration of an applicant’s mark on the ground that it was disparaging. *Prosynthesis Labs*, 77902555, 2012 WL 1267929 at \*1. On appeal to the TTAB, the TTAB concluded that the evidence of record did not support the refusal of registration under §2(a) of the Lanham Act and reversed. *Id.* at \*18. Central to the TTAB’s holding was the fact that there was no “clear evidence on [the] record that applicant’s motivation [was] to disparage China.” *Id.* at \*16. The TTAB reasoned that the applicant’s intent is a key finding of fact because of the analogousness of disparagement to “a violation of one’s right of privacy – the right to be ‘let alone’ from contempt or ridicule.” *Id.* at \*12 (quoting

*Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 218 USPQ 1, 3 (6th Cir. 1983)). “Although the term might be used . . . with the intent to slight [the referenced group] or that it might be perceived by [the referenced group] in such a way, it is also possible that it is not.” *Id.* at \*12.

Here, the TTAB’s and the Federal Circuit’s findings of fact do not directly prove that the mark at issue might disparage a substantial composite of blonde women. Just as the TTAB in *Harjo I* erred by making findings of fact “in only two very specific areas” and “simply summarized undisputed testimony” here too the TTAB erred in finding disparagement based solely on two images from the respondent’s website as well as unspecified “dictionary definitions”, “numerous articles” and anonymous user comments on respondent’s uTube videos. *Kourtney Luhv*, 1337 F.3d at 467. Neither the TTAB nor the Federal Circuit cited which dictionary its definitions were located in and thus there is no way to verify whether these definitions are accurate or represent the views of a substantial composite of blonde women.

Regardless of the fact that these “dictionary definitions” are of dubious origin, any reliance on dictionary definitions under prong two of the *Harjo I* test was improper. The Federal Circuit has established that “dictionary definitions represent an effort to distill the collective understanding of the community with respect to language.” *Boulevard Ent.*, 334 F.3d at 1340. Therefore, just as the TTAB in *Harjo I* erred by considering evidence of the views of the general public probative of the views of the referenced group here too the TTAB improperly relied

on dictionary definitions to determine whether the mark may disparage a substantial composite of blonde women. *Kourtney Luhv*, 1337 F.3d at 467. When the TTAB relied on anonymous uTube comments it failed to heed the warning of the Federal Circuit that such declarations “consist mainly of the personal opinions of the declarants . . . .” and thus “do not provide strong factual support . . . .” that the proposed mark is disparaging to a substantial composite. *Boulevard Ent.*, 334 F.3d at 1341.

Just as the TTAB in *Harjo 1* erred by “[reaching] its decision . . . inferentially, by piecing together bits of limited, undisputed evidence from the record,” here too the TTAB and the Federal Circuit erred by resting their entire decisions on the limited, undisputed evidence that supported a finding of disparagement. *Harjo*, 284 F. Supp. 2d at 128. The TTAB and the Federal Circuit here did not conduct the kind of weighing of conflicting evidence and criticisms of the evidence that the district court in *Harjo I* held was mandatory for reviewing a finding of disparagement. Here, there is no meaningful discussion by the TTAB or the Federal Circuit of the evidence of positive reception to respondent’s use of her proposed mark as demonstrated by comments on various social media sites.

*Kourtney Luhv*, 1337 F.3d at 458. The TTAB fixated on two images, taken out of context, of blonde women on Ms. Luhv’s website. *Id.* at 456-57. Notably, the TTAB makes no mention of the images from respondent’s website that show blonde women in a positive light, such as depicting a blonde women as the president of the United States, sitting in the oval office. *Id.* at 458. This is exactly the kind of piecemeal

and inferential fact-finding that the district court in *Harjo I* found constitutes reversible error.

The TTAB and Federal Circuit in this case improperly dismissed the respondent's intent in making its determination that the mark was disparaging. Just as there was no “..clear evidence on [the] record” in *Prosynthehsis* that “applicant's motivation [was] to disparage China”, here too there is no clear evidence on the record that respondent's motivation was to disparage blonde women. *Prosynthesis Labs.*, 77902555, 2012 WL 1267929 at \*16. On the contrary, the evidence clearly demonstrates that Ms. Luhv's motivation was to “reclaim the stereotype associated with blonde women and raise awareness of the challenges stemming from gender discrimination and negative stereotypes faced by all women.” *Kourtney Luhv*, 1337 F.3d at 457.

Finally, the PTO allows registration of trademarks that were initially opposed by the PTO if an applicant presents evidence of other trademarks that are potentially disparaging but were nevertheless registered. *DYKES ON BIKES*, Registration No. 3323803. An application for the trademark “DYKES ON BIKES” was “initially rejected on the basis that the term ‘dyke’ may be offensive to lesbian women . . . .” *Id.* at 458. The applicant in that case “presented evidence of other trademarks that contained terms that were offensive to members of the gay community and were nevertheless registered.” *Id.* The applicant there “submitted evidence of positive public reception to the mark's use . . . .” and “[t]he applicants specifically asserted their intent to use the mark positively in order to reclaim the

term.” *Id.* The examining attorney ultimately passed the mark for registration in light of this additional evidence. *Id.* See also in *Over Our Heads Inc.*, 16 U.S.P.Q.2d at 1653 (finding that a mark is presumed to not be per se disparaging if the PTO has previously passed to publication an identical mark by another applicant).

On February 16, 2000, Mascolo Brothers Limited filed an application for registration of a trademark consisting of the phrase “DUMB BLONDE” for “Hair Care Products, Skin Care products and Cosmetics”. DUMB BLONDE, Registration No. 2601964. The mark was published for opposition on July 10, 2001 and absent any opposition to the proposed mark it was registered on July 30, 2002. *Id.* On its face, the Mascolo Brothers’ trademark is identical to the proposed mark at issue in this case; both consist of the phrase “DUMB BLONDE”. The fact that the PTO has previously passed for publication and subsequently allowed registration of a mark identical to the one at issue in this case demonstrates that “dumb blonde” is not “per se” disparaging otherwise it would have not been afforded trademark protection. Further, an examination of the manner in which the Mascolo Brothers’ trademark is used in the marketplace in connection with the goods and services demonstrates that the likely meaning of that mark is to evoke the archaic “dumb blonde” stereotype of a woman who is physically attractive and unintelligent; the trademark there is being used for the sole purpose of selling products that enhance one’s perceived physical attractiveness. At the very least, the fact that the PTO has allowed “DUMB BLONDE” to be registered for the sole purpose of selling beauty

products demonstrates that in today's day and age, the term is no longer viewed as disparaging by a substantial composite of blonde women.

C. Any Doubt As To Whether DUMB BLONDE Would Be Disparaging To Blonde Women Should Be Resolved In Favor Of Publication.

When there is doubt as to whether a substantial composite of the referenced group would find the mark disparaging the TTAB has a standard practice of passing the mark for publication and subsequently allowing any group that finds the mark to be disparaging to bring an opposition proceeding. In *Mavety*, the Federal Circuit commended the TTAB's practice of resolving doubt in favor of publication as the proper way of achieving Congress's goal in ensuring that disparaging marks do not waste the funds of the federal government through costly and extensive discovery and evidence collection. *Mavety Media*, 33 F.3d at 1374. *See also in Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653 (recognizing that the applicant's evidence raised doubt as to whether the mark would be considered disparaging and thus resolved such doubt in favor of publication).

Here, the evidence presented by the examiner raises a question of doubt at best as to whether the respondent's mark may be disparaging to a substantial composite of blonde women. *Kourtney Luhv*, 1337 F.3d at 456-57. Therefore, the proper course of action in accordance with the TTAB's own precedent should have been to resolve this doubt in favor of publication and allow for an opposition proceeding to be brought if a group of blonde women felt that the mark is disparaging. Allowing this costly litigation to continue this far is contrary to the

policies of the TTAB, which were established in light of the limited resources of the PTO.

II. THIS COURT SHOULD AFFIRM IN PART THE FEDERAL CIRCUIT'S DECISION BECAUSE SECTION 2(A)'S PROHIBITION ON REGISTERING MARKS THAT MAY BE DISPARAGING VIOLATES THE UNITED STATES CONSTITUTION.

The First Amendment of the United States Constitution states: "Congress shall make no law...abridging the freedom of speech, or of the press." U.S. Const. amend. I. Although this Court has held that some limited classes of speech are not protected by the First Amendment, commercial speech *does* receive protection from unwarranted government regulation. *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748, 761-62 (1977); *see also Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557 (1980). As such, the messages conveyed by trademarks and trade names receive First Amendment protection, because they are considered commercial speech. *Friedman v. Rogers*, 440 U.S. 1, 11 (1979). This Court has also held that a content-based regulation abridging the speaker's protected expression necessarily implicates First Amendment rights. *Carey v. Population Services Int'l*, 431 U.S. 678 at 700-02 (1977). Such regulations must be justified by a substantial government interest and satisfy intermediate scrutiny under *Central Hudson's* four prong test. *Central Hudson*, 447 U.S. at 565.

In this case, Section 2(a)'s prohibition on registration of potentially disparaging marks abridges Ms. Luhv's First Amendment rights, because the denial of registration denies her considerable benefits while burdening her exercise of protected speech. Without a substantial government interest justifying the

prohibition, Section 2(a) and the regulation cannot withstand intermediate scrutiny. Therefore, this Court should affirm the decision of the Federal Circuit and find that Section 2(a) prohibition on registering potentially disparaging marks is unconstitutional.

A. “Dumb Blonde” Is A Trade Name Or Trademark Protected By The First Amendment As Commercial Speech.

As this Court has recognized, the First Amendment protects “all ideas having even the slightest redeeming social importance,” regardless of whether such ideas are controversial or unorthodox. *Roth v. United States*, 354 U.S. 476, 484 (1957). This protection extends over commercial speech, or “the dissemination of information as to who is producing and selling what product, for what reason, and at what price.” *Central Hudson*, 447 U.S. at 561, 566. This Court has noted that society has a strong interest in the free flow of commercial information, because the efficient allocation of resources depends on informed consumer choices and general public interest. *Id.* at 764. The relationship of speech to the marketplace of products or services “does not make it valueless in the marketplace of ideas.” *Bigelow v. Virginia*, 421 U.S. 809, 826 (1975).

Moreover, “the use of trade names in [commerce] is a form of commercial speech” because of the factual messages conveyed about the type, cost, and quality of products or services associated with the mark. *Friedman v. Rogers*, 440 U.S. 1, 11 (1979). In *Friedman*, the Court examined the use of trade names in the optometrical practice and determined that an optometrist who used a trade name did not wish to editorialize on any cultural, philosophical or political subject *Id.*

His use of the trade name was “commercial speech and nothing more.” *Id.* The Court then distinguished trade names from other forms of commercial speech that are “self-contained and explanatory,” such as advertisements for products and services. *Id.* at 12. Consequently, the Court held that a state’s ban on the use of trade names in optometry was justified, as trade names have “no intrinsic meaning” and could mislead or deceive the public without regulation. *Id.*

However, commercial speech need not contain commentary on any cultural, philosophical or political subject in order to be protected from unwarranted government regulation by the First Amendment. *Cincinnati v. Discovery Network*, 507 U.S. 410, 421 (1993) (holding that “even speech that does no more than propose a commercial transaction is protected by the First Amendment”). One year after *Friedman*, this Court clarified the nature of the First Amendment’s significant protection of commercial speech and rejected the “highly paternalistic view” that the government has complete power to suppress or regulate commercial speech. *Central Hudson*, 447 U.S. at 561. The Court in *Central Hudson* further held that protection available for commercial speech “turns on the nature of both the expression and of governmental interests served by its regulation.” *Id.*

Here, it is undeniable that the trade name “DUMB BLONDE” serves as the identifier of a particular source of music and entertainment. Ms. Luhv, has performed under the trade name DUMB BLONDE since 2012, and she has uploaded her music to numerous online streaming services under the same mark. *Kourtney Luhv*, 1337 F.3d at 455-56. With over 40,000 “followers” on her

soundpuff account and 100,000 active uTube subscribers, there is no doubt that Ms. Luhv's trade name has become closely associated with the music produced by her band. As the mark serves to inform consumers and the general public of who is producing and selling a product or service, DUMB BLONDE falls squarely within the realm of core commercial speech protected by the First Amendment.

Additionally, Ms. Luhv's use of the trade name DUMB BLONDE does more than simply identify the source of her music. Ms. Luhv chose the trade name in order to reclaim the stereotype associated with the phrase "dumb blonde," and thus her trade name reaches beyond *Friedman's* analysis of "commercial speech and nothing more." Coupled with the lyrical content of her music, Ms. Luhv uses her mark to provide social commentary and weighs in on cultural and political discussions regarding gender stereotypes. This commentary is undoubtedly within the heartland of speech protected by the First Amendment.

Although DUMB BLONDE is commercial speech, this Court should consider it distinguishable from the trade names examined by *Friedman*, because Ms. Luhv has created more than a mark to identify her products and services – she has editorialized on a social and cultural subject through her trade name and the lyrical content of her music. As such, this Court should find that the trade name, DUMB BLONDE, is most certainly protected by the guarantees of the First Amendment.

B. Section 2(a)'s Prohibition On Registering Marks That May Be Disparaging Is An Abridgment of Protected Speech.

Because Section 2(a)'s prohibition on registering marks that may be disparaging does not outright forbid the exercise of protected speech, the United

States Court of Customs and Patent Appeals held that the PTO's refusal to register a trademark under Section 2(a) does not implicate or abridge First Amendment protection. *McGinley*, 660 F.2d at 481. However, this Court has held that laws designed to suppress or restrict protected expression contradict First Amendment principles. *United States v. Playboy Ent. Grp. Inc.*, 529 U.S. 803, 812 (2000). The First Amendment is also implicated where the government conditions the receipt of benefits on the basis of the speaker's exercise of protected speech. *Perry v. Sindermann*, 408 U.S. 593, 597 (1972). Here, the denial of trademark registration both burdens Ms. Luhv's protected expression while withholding substantial benefits due to her exercise of free speech. Consequently, Ms. Luhv's First Amendment rights are implicated and abridged by Section 2(a)'s denial of trademark registration.

1. Section 2(a) implicates the First Amendment by substantially burdening a registrant's protected expression.

In *McGinley*, the United States Court of Customs and Patent Appeals examined the federal Patent and Trademark Office's refusal to register a mark on the basis of the mark being deemed "scandalous" under Section 2(a) of the Lanham Act. *McGinley*, 660 F.2d at 481. The court noted that refusal by the Patent and Trademark Office to register an applicant's trademark under Section 2(a) did not affect the applicant's right to use the mark. *Id.* at 484. As such, the Federal Circuit held that the applicant's First Amendment rights would not be abridged by the refusal to register the applicant's trademark, because "no conduct is proscribed, and no tangible form of expression is suppressed." *Id.*

Over the last three decades, the Federal Circuit has revisited *McGinley's* holding and held that Section 2(a)'s prohibition on certain speech does not implicate the First Amendment, because an applicant's First Amendment rights are not abridged or suppressed in the denial of registration. *Mavety Media*, 33 F.3d at 1374 (holding that precedent forecloses the applicant's challenges to § 1052(a) as unconstitutional on its face or as applied); *see also Boulevard Ent.*, 334 F.3d at 1343 (noting that previous decisions of "this court and our predecessor court" have rejected First Amendment challenges to register marks under § 1052(a)); *Ritchie v. Simpson*, 170 F.3d 1092, 1099 (Fed. Cir. 1999) (indicating in dicta that the mark holder who is denied federal registration can continue to use the mark).

The first, third and fifth circuits have also accepted *McGinley's* holding as binding precedent without delving into the various Constitutional arguments presented by challengers of Section 2(a). *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812, 819 (1st Cir. 1987); *see also Santana Products Inc. v. Compression Polymers, Inc.*, 8 F.3d 152, 155 (3d Cir. 1993); *Test Masters Educational Services v. Inc. v. Singh*, 428 F.3d 559, 578 (5th Cir. 1981)(referencing *McGinley's* holding in the footnotes following the majority opinion).

Through its analysis and holding, *McGinley's* implies that in order to abridge protected speech, a regulation must directly ban, prohibit or forbid a speaker from speaking. *See generally* Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 Trademark Rep. 661, 691 (1993). However, this Court has held that lawmakers

“may no more silence unwanted speech by burdening its utterance than by censoring its content.” *Simon & Schuster, Inc., v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 115 (1991).

In *Simon & Schuster*, this Court examined a statute that required an accused or convicted criminal’s income from works describing his crime to be deposited in an escrow fund. *Id.* at 108. These funds were then made available to victims of the crime and the criminal’s other creditors. *Id.* Although the accused or convicted criminal could continue to publish works about his crime, the statute in question established a “financial disincentive” to create or publish works with a particular content and was subject to scrutiny under First Amendment principles. This Court further held that a statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech. *Id.* at 115.

More recently, this Court noted in *Sorrell v. IMS Health Inc.* that “the distinction between laws burdening and laws banning speech is but a matter of degree.” *Sorrell v. IMS Health Inc.*, 131 S.Ct. 2653, 2664 (2011). In *Sorrell*, the Court specifically examined a state restriction on the sale, disclosure, and use of pharmacy records that reveal the prescribing practices of individual doctors. *Sorrell*, 131 S.Ct. at 2653. Although an outright restriction on speech was at issue, the statute in question amounted to a “specific content-based burden.” *Id.* at 2664. *Sorrell* further emphasized that a Government’s content-based burdens on protected speech must satisfy the same rigorous scrutiny as content-based bans. *Id.*

Denial of federal trademark registration necessarily burdens the unsuccessful applicant, because this Court recognized that the Lanham Act creates at least two adjudicative mechanisms to help protect marks. *B & B Hardware, Inc., v. Hargis Ind., Inc.*, 135 S.Ct. 1293, 1299 (2015). In *B & B Hardware*, this Court further noted that:

Registration is prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate. And once a mark has been registered for five years, it can become incontestable.

*Id.* This Court then noted that incontestability is a “powerful protection,” and Congress itself has determined that trademarks “should receive the greatest protection that can be given them.” *Id.* at 1310; *see also Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985) (quoting S.Rep. No. 1333, 79th Cong., 2d. Sess., 6 (1946)). *B & B Hardware* further emphasized that the importance of registration is “undoubtedly” why Congress has provided for *de novo* review of TTAB decisions. *B & B Hardware*, 135 S.Ct. at 1310. *B & B’s* holding is supported by federal trademark law denoting the benefits of registration and remedies available in federal court for willful infringement. 15 U.S.C.A §1121 (Westlaw current through Pub. L. No. 114-51, approved Sept. 24, 2015); 15 U.S.C.A § 1117 (Westlaw current through Pub. L. No. 114-51, approved Sept. 24, 2015).

Although *McGinley’s* holding would indicate that Ms. Luhv’s First Amendment rights are not abridged because she can still use her trademark, this Court should find that *McGinley’s* rationale is inconsistent with developed First

Amendment jurisprudence. As evidenced by *Sorrell* and its predecessors, a direct ban or prohibition on speech is not required to show an abridgement of protected speech.

The PTO's denial of Ms. Luhv's application for trademark registration proscribes and suppresses her expression, because denial deprives Ms. Luhv the same legal rights and benefits discussed in *B & B Hardware*. By denying Ms. Luhv's application for federal trademark registration, the PTO denies her the benefit of having prima facie evidence of her ownership of the mark, as well as prima facie evidence of the mark's validity. The denial deprives Ms. Luhv the incontestable right to DUMB BLONDE – a right that is the absolute hallmark of trademark law and a right that Congress itself has determined to be of utmost importance to a mark holder.

Moreover, the denial of registration imposes a significant economic burden on Ms. Luhv. Without the benefit of having DUMB BLONDE registered, others may use the mark unwittingly or create confusingly similar marks for their own products and services. This not only dilutes the close association Ms. Luhv has created between her music and her mark, but poses the risk of misleading and confusing consumers as well. Although Ms. Luhv may bring court proceedings for infringement, she is denied a right to sue in federal court to obtain certain treble damages or attorney fees. Even in a state court proceeding, the denial of registration would deprive Ms. Luhv the ability to bring prima facie evidence of her ownership, lengthening proceedings and causing monetary loss.

The economic burdens imposed on Ms. Luhv through the denial of registration under Section 2(a) are comparable to those imposed in *Simon & Schuster*, because Section 2(a) creates a “financial disincentive” to register trademarks with a specific content. Specifically, the PTO’s refusal to register DUMB BLONDE on the basis of its message caused monetary loss where the contract Ms. Luhv negotiated with a record label was contingent on her mark being registered. When registration was denied, Ms. Luhv lost the contract for recording her music in the popular extended play format as well as the \$2,000,000 advance upon execution of the contract. Although Ms. Luhv can resubmit a new application for trademark registration in order to satisfy the contract, she would have to forgo the trademark DUMB BLONDE and its expressive commentary to satisfy the government. Thus, Section 2(a) has attached a “financial disincentive” to Ms. Luhv’s continued use of DUMB BLONDE and its intrinsic expression.

Although Ms. Luhv may continue to use her mark, Section 2(a)’s disapproval of allegedly disparaging marks seek to coerce her, and other registrants, to choose trade names that satisfy the government in order to receive benefits. Consequently, the First Amendment is indirectly implicated as Section 2(a) proscribes speech and suppresses tangible expression through a chilling effect on those who wish to obtain the significant benefits associated with trademark registration without offending the government’s notion of acceptable expression.

2. Section 2(a)'s conditional treatment of protected speech runs afoul the unconstitutional conditions doctrine

Even if this Court finds that Section 2(a)'s denial of registration does not burden or suppress Ms. Luhv's expression, the government cannot deny access to the benefits of trademark registration because of Ms. Luhv's exercise of protected speech. This Court has noted that:

Even though a person has no right to a valuable government benefit and even though the government may deny him benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on the basis that it infringes his constitutionally protected interests – especially his interest in freedom of speech.

*Perry*, 408 U.S. at 597. This Court further emphasized that such a denial of access to benefits would allow the government to produce a result which it could not produce directly. *Id.*

In *Perry*, this Court considered a state college's refusal to rehire a professor because of the professor's exercise of political speech regarding the college's administration and policies. *Id.* The Court held that despite the professor having no right to reemployment and the lack of a "direct" prohibition on the professor's speech, the state college could not deny the benefit of reemployment based on the professor's exercise of free speech. *Id.* at 597-98. The Court further noted that allowing a government entity to withhold benefits from claimants engaging in certain forms of speech is consistent with allowing the government to "penalize or prohibit" a claimant for such speech. *Id.* This holding reflects the overarching principle known as the unconstitutional conditions doctrine, which "vindicate[s] the

Constitution's enumerated rights by preventing the government from coercing people into giving them up." *Koontz v. St. Johns River Water Management Dist.*, 133 S.Ct. 2586, 2594 (2013).

Since *Perry*, this Court has examined the inherent tension between the unconstitutional conditions doctrine and Congress's ability to direct government spending under the Constitution's Spending Clause. *Rust v. Sullivan*, 500 U.S. 173, 197 (1991); *see also Regan v. Taxation with Representation of Wash.*, 461 U.S. 540 (1983)(noting that where Congress refuses to pay for lobbying out of public monies, the unconstitutional conditions doctrine does not apply). In *Rust*, this Court considered Title X of the Public Health Service Act and whether the government could withhold Title X funds from Title X projects engaging in abortion counseling, referral, and activities advocating abortion as a means of family planning. *Rust*, 500 U.S. at 178. The Court noted that the restriction was intended to ensure Title X funds could be used to support certain family planning activities. *Id.*

Although Title X funding would be denied based on a recipients decision to counsel abortion, this Court held that rather than denying a benefit to anyone, Congress was "simply insisting that public funds be spent for the purposes for which they were authorized." *Id.* at 196. Moreover, the condition that federal funds will be used only to further the purposes of the grant does not violate constitutional rights due to Congress's spending power. *Id.* at 198.

While the Spending Clause grants Congress considerable power in regulating the allocation of public funds, that power is not unbounded. *Agency for Intern*

*Development v. Alliance for Open Society Intern., Inc.*, 133 S.Ct. 2321, 2328 (2013).

For example, the Spending Clause does not grant Congress with authority to “attach conditions which seek to leverage funding to regulate speech outside the program itself.” *Id.*

Moreover, Congress’s ability to condition the receipt of funds or benefits turns on whether the regulation in question concerns the Spending Clause at all. *Dep’t of Tex., Veterans for Foreign Wars v. Tex. Lottery Comm’n*, 760 F.3d 427, 430 (5th Cir. 2014); *see also Bullfrog Films Inc., v. Wick*, 847 F.2d 502, 503 (9th Cir. 1988)(holding that the spending exception did not apply to trade benefits, because no Treasury Department Funds were involved); *Satellite Broad. & Commc’ns Ass’n v. FCC*, 275 F.3d 337 (4th Cir. 2001)(holding that the state’s grant of a license did not arise from the Spending Clause because it did not entail benefits obtained through government funds). In *Texas Lottery Comm’n*, the fifth circuit considered whether the Texas Bingo Enabling Act could grant a nonprofit organization a license to conduct bingo games while prohibiting the nonprofit from using bingo proceeds for lobbying. *Id.* at 434.

The fifth circuit noted that although *Rust* and *Regan* examined conditions tied to public funds, licensing the bingo program did not involve any public monies or “spending” by the state. *Id.* at 435. Consequently, it created a regulatory scheme rather than a government subsidy, and the regulation was subject to analysis under the unconstitutional conditions doctrine. *Id.* at 437-39.

When *McGinley* was decided in 1981, trademark registration was “underwritten by public funds,” legitimizing Congress’s regulation of allegedly disparaging speech under its spending power. *McGinley*, 660 F.2d at 486. However, the Federal Circuit has noted that since 1991, trademark registration is now funded by fee revenue from applicants and registrants rather than by taxpayers. *Figueroa v. United States*, 466 F.3d 1023, 1028 (Fed. Cir. 2006). Although some operational aspects continue to be funded by the federal treasury, trademark registration itself is spurred by fees from private applicants and registrants. *Id.*

Likewise, the trademark registration process here is more similar to the regulatory scheme present in *Texas Lottery Comm’n* than the government subsidy in *Rust*. The conditioned benefits of registration are not monetary, are not a subsidy and do not come from public funds or the National Treasury. Additionally, any state spending relating to general operations is too attenuated to implicate the government’s spending power. Consequently, the registration process is consistent with a regulatory scheme like the license program in *Texas Lottery Comm’n* and is subject to analysis under the unconstitutional conditions doctrine articulated by *Perry*. As such, this Court should find that the First Amendment is abridged by denial of registration under Section 2(a), because the regulation imposes burdens and withholds the benefits of registration based solely upon Ms. Luhv’s exercise of constitutionally protected expression.

C. Section 2(a) is an Unconstitutional Content-Based Abridgement Of Ms. Luvh’s Protected Speech Under Frst Amendment Scrutiny

The Constitution “affords a lesser protection to commercial speech than to other constitutionally guaranteed expression.” *United States v. Edge Broad. Co.*, 509 U.S. 418 (1993). Nevertheless, the First Amendment protects commercial speech from unwarranted government regulation. *Virginia State Bd.*, 425 U.S. at 761-62. Where the communication is neither misleading nor related to unlawful activity, the government's power is more circumscribed, and the State must assert a substantial interest to be achieved by restrictions on commercial speech. *Central Hudson*, 447 U.S. at 564. Section 2(a)’s prohibition on the registration of allegedly disparaging speech is a content-based regulation on commercial speech that does not further any substantial government interest. Therefore, Section 2(a) is unconstitutional under the First Amendment.

1. Section 2(a) is a content based restriction on the exercise of protected speech.

This Court has held that the First Amendment generally prevents the government from proscribing speech or expressive conduct based on the ideas being expressed. *R.A.V. v. City of St. Paul, Minn.*, 505 U.S. 377, 382 (1992). Such content-based regulations are “presumptively invalid” because they “raise the specter that the government may effectively drive certain viewpoints from the marketplace.” *Id.* at 387.

Although Section 2(a) does not prohibit an applicant from using their marks, the statute proscribes registration of certain trademarks based on their content or

the messages they impart. Baird, *supra* at 685. Specifically, Section 2(a) denies registrations for trademarks that communicate a shocking or offensive message or viewpoint. *Id.* Consequently, this Court should find that Section 2(a)'s prohibition of allegedly disparaging expression is a content based regulation on commercial speech.

2. Section 2(a) is unconstitutional because it fails intermediate scrutiny under *Central Hudson's* test for regulation commercial speech.

The Lanham Act was drafted in 1946, when commercial speech was generally thought to lack First Amendment protection. Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of Redskins?* 52 Stan. L. Rev. 665, 672 (2000). However, this Court's landmark decision in *Central Hudson* established the principle of intermediate scrutiny for content-based regulation of commercial speech. *Central Hudson*, 447 U.S. at 564. The Court then articulated a four-pronged test to assess the constitutionality of a regulation on commercial speech under intermediate scrutiny:

For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquiries yield positive answers, we must determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest.

*Id.* at 566.

In enacting Section 2(a) of the Lanham Act, Congress noted that it disapproved of the messages conveyed by disparaging marks. *See Trade-Marks: Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on*

*Patents*, 76th Cong., 1st Sess. 18-21 (1939). However, this Court has held that the offensiveness of protected speech does not justify its suppression. *Bolger v. Young Drug Prod. Corp.* 463 U.S. 60, 71 (1983). Consequently, a substantial government interest independent of disapproving the speech's message must justify the regulation of the protected speech. *Sorrell*, 131 S.Ct. at 2668.

However, the government may argue that a substantial interest exists in regulating trademark registration as its own speech, as the Eastern District of Virginia recently held in *Pro-Football Inc. v. Blackhorse* that the Federal Trademark Registration Program is "government speech." *Pro-Football v. Blackhorse*, 2015 WL 4096277 (E.D. Va. July 8, 2015); *Cf. Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S.Ct. 2239 (2015). The District Court based its reasoning on the contention that registry with the federal program communicates the message that the federal government has approved the trademark. *Id.* However, *Blackhorse's* analysis is undercut by the Trademark Trial and Appeal Board's own conclusion that "the act of registration is not a government imprimatur or pronouncement that the mark is good in an aesthetic or analogous sense." *Old Glory Condom*, 26 U.S.P.Q.2d at 1219-20.

Here, the first prong of *Central Hudson* is satisfied as there is nothing illegal or misleading about an allegedly disparaging trademark. *Kourtney Luhv*, 1337 F.3d at 460. As for the second prong, the government has not identified any substantial interest independent of disapproving the trademark's message as justification for denial of registration. While the government may contend that it has a substantial

interest in discouraging commentary that is potentially disparaging or hurtful to its citizens, this argument is belied by the government's insistence that Ms. Luhv may continue to use DUMB BLONDE regardless of registration.

Moreover, any contention by the government that regulation of trademark registration preserves control over its own speech must fail, because registration of DUMB BLONDE does not indicate that the government has approved its allegedly disparaging message under *Old Glory Condom*. As discussed above, trademark registration is now funded entirely by private parties seeking to identify their goods and commercial services in the federal registry. Consequently, the public is more likely to associate DUMB BLONDE and any intrinsic expression with its source, Ms. Luhv, rather than the government, who is merely a keeper of the national registry. Thus, any connection between the trademark's expression and government association is too attenuated to create a substantial interest.

Without a substantial government interest independent of disapproving DUMB BLONDE's message to justify Section 2(a), the regulation cannot withstand First Amendment analysis under *Central Hudson* or survive intermediate scrutiny. Therefore, Ms. Luhv respectfully requests this Court find that Section 2(a)'s prohibition of allegedly disparaging commercial speech is unconstitutional under the First Amendment.

CONCLUSION

For these reasons, Respondent Kourtney Luhv respectfully requests that this Honorable Court REVERSE in part and AFFIRM in part the judgment of the Federal Circuit.

Respectfully submitted,

*Team 126*

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