

No. 15-1874

**IN THE UNITED STATES COURT OF APPEALS
FOR THE FOURTH CIRCUIT**

PRO-FOOTBALL, INC.,
Plaintiff-Appellant

v.

**AMANDA BLACKHORSE, MARCUS BRIGGS-CLOUD, PHILLIP GOVER,
JILLIAN PAPPAN, and COURTNEY TSOTIGH,**

Defendants-Appellees,

and

UNITED STATES OF AMERICA,

Intervenor.

On appeal from the United States District Court for the Eastern District of
Virginia, Alexandria Division

**BRIEF OF *AMICI CURIAE* AMERICAN CIVIL LIBERTIES UNION,
AMERICAN CIVIL LIBERTIES UNION OF VIRGINIA, AND AMERICAN
CIVIL LIBERTIES UNION OF THE NATION'S CAPITAL
IN SUPPORT OF PLAINTIFF-APPELLANT AND REVERSAL**

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UNITED STATES COURT OF APPEALS FOR THE FOURTH CIRCUIT
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No. 15-1874 Caption: Pro-Football, Inc. v. Blackhorse and United States of America

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(name of party/amicus)

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If yes, identify all parent corporations, including all generations of parent corporations:

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If yes, identify all such owners:

- 4. Is there any other publicly held corporation or other publicly held entity that has a direct financial interest in the outcome of the litigation (Local Rule 26.1(b))? YES NO
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- 6. Does this case arise out of a bankruptcy proceeding? YES NO
If yes, identify any trustee and the members of any creditors' committee:

Signature: /s/ Hope R. Amezquita

Date: November 6, 2015

Counsel for: ACLU Foundation of Virginia

CERTIFICATE OF SERVICE

I certify that on November 6, 2015 the foregoing document was served on all parties or their counsel of record through the CM/ECF system if they are registered users or, if they are not, by serving a true and correct copy at the addresses listed below:

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November 6, 2015
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STATEMENT OF AMICI CURIAE¹

The American Civil Liberties Union (ACLU) is a nationwide, nonprofit, nonpartisan organization with approximately 500,000 members dedicated to the principles of liberty and equality embodied in the Constitution and our nation's civil rights laws. The ACLU of Virginia and the ACLU of the National Capital Area are local affiliates of the ACLU.

Since its founding in 1920, the ACLU has vigorously defended both free speech and racial justice. In specific instances, tensions may arise between these two principles. However, *amici* believe a strong First Amendment is not only compatible with equality but essential to its pursuit. In that regard, it is worth noting that many landmark civil rights decisions of the 1950s and 1960s arose out of free speech controversies, *see, e.g., Shuttlesworth v. City of Birmingham*, 394 U.S. 147 (1969), and that efforts to suppress particular viewpoints are often aimed at racial and ethnic minorities. To preserve the principle of viewpoint neutrality, the ACLU has appeared in numerous cases throughout the country. Recently, and of particular relevance to the issues raised here, these cases include: *Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015) (holding Texas specialty license plates are government speech, so the state's denial of

¹ Pursuant to FED. R. APP. P. 29(c)(5), *amici* state that no party's counsel authored this brief in whole or in part, and that no party or person other than *amici* and its members contributed money toward the preparation or filing of this brief.

confederate flag design did not violate the First Amendment); *ACLU of N.C. v. Tata*, 742 F.3d 563 (4th Cir. 2014) (holding unconstitutional a state’s decision to issue a “Choose Life” specialty license plate while refusing to issue a pro-choice specialty plate), *cert. denied sub nom. Berger v. ACLU of N.C.*, 83 U.S.L.W. 3076 (U.S. June 29, 2015) (No. 14-35); *In re Tam*, 785 F.3d 567 (Fed. Cir.) *reh’g en banc granted, opinion vacated*, 600 F. App’x 775 (Fed. Cir. 2015), and *Reno v. ACLU*, 521 U.S. 844 (1997) (striking down statutory provisions censoring “indecent” and “patently offensive” communications on the Internet).

Accordingly, the proper resolution of this case is a matter of substantial interest to the ACLU and its members.

Amici file this brief with written consent from all parties to the litigation.

INTRODUCTION

This case arose when the Trademark Trial and Appeal Board (“TTAB”) scheduled for cancellation the registered trademarks of the Washington football team—marks that have been registered for decades—in response to a petition from private individuals. In the administrative proceeding, the government agreed with the petitioners that the term “Redskins” is disparaging to Native Americans. *Amici* also agree with that assessment. Indeed, the ACLU has joined calls for the team to change its name and to stop using a word that demeans the dignity of Native Americans and their rich history.²

The fact that certain speech is disparaging, however, does not grant the government the right to disadvantage it for that reason. Indeed, few principles of constitutional law are as settled as the First Amendment’s prohibition against government regulation of private speech based on viewpoint. There is no reason

² See Stephen Pevar, *Why Redskins is Wrong*, ACLU Blog of Rights (Nov. 25, 2013), <https://www.aclu.org/blog/racial-justice/why-redskins-wrong> (“Every dictionary defines ‘Redskins’ as being offensive, derogatory and a racial epithet.”); Stephen Pevar, *The Rights of Indians and Tribes* 237 (2012) (noting that “most national Indian organizations have issued policy statements urging the removal of all Indian mascots on the grounds that they are inherently demeaning, disrespectful, degrading, and reflect racial prejudice”); see also Press Release, Leadership Conference on Civil and Human Rights, Nat’l Civil and Human Rights Coal. Calls for Wash. Football Team to Drop Offensive Name (Dec. 12, 2013), www.civilrights.org/press/2013/washington-football-team-name-change-resolution.html.

why this fundamental rule should be abandoned when that speech consists of trademarks.

The registration of trademarks provides substantial government benefits to the trademark holder. Yet, Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), not only condones but *mandates* viewpoint-based discrimination in the registration of trademarks, by prohibiting the registration of any trademark interpreted by the U.S. Patent and Trademark Office (“PTO”) to “comprise[] immoral, deceptive, or scandalous matter; or matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.” Furthermore, the constitutional harms caused by Section 2(a) are magnified by its vague and subjective terms, which provide no meaningful notice to speakers as to what speech the government will find acceptable, thereby risking—and in this case, demonstrably producing—inconsistent and discriminatory application of the law.

Under every legal doctrine that could conceivably be applied to this case, the courts have stated clearly and repeatedly that the government may not burden private speech based on its viewpoint.

SUMMARY OF ARGUMENT

The district court upheld the PTO’s scheduled cancellation on two grounds: that “the Lanham Act does not implicate the First Amendment,” and that “the

federal trademark registration program is government speech.” *Pro-Football, Inc. v. Blackhorse*, No. 1-14-CV-01043-GBL, 2015 WL 4096277, at *5 (E.D. Va. July 8, 2015). Both rulings were erroneous. Because of these errors, the district court failed to recognize that Section 2(a) imposes a classically unconstitutional condition on the receipt of an important government benefit.

There is no question that the PTO scheduled cancellation of Pro-Football’s marks because of what the government perceived to be the message of the word “Redskins.” The First Amendment is implicated whenever the government grants or withholds benefits based on agreement or disagreement with a private speaker’s point of view. *See, e.g., FCC v. League of Women Voters of Cal.*, 468 U.S. 364, 383–84 (1984) (“A regulation of speech that is motivated by nothing more than a desire to curtail expression of a particular point of view on controversial issues of general interest is the purest example of a ‘law . . . abridging the freedom of speech, or of the press.’” (citations omitted)).

It is equally clear that the speech at issue in this case belongs to the private trademark holder, not the government. This is true as a matter of fact: the government has expressly disclaimed that it speaks through trademarks. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 at *5 n.3 (T.T.A.B. 1993). The nature of the trademark-registration system thus distinguishes this case from cases in which the government extends a contract or creates a program to further the

government's own point of view. It is also true as a matter of law: the Supreme Court's recent decision on the reach of the government speech doctrine, *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015), explicitly states that the government speech analysis does not apply in cases (such as this one) where the medium of speech is traditionally used by private parties to communicate. All three prongs of Walker's three-part test therefore weigh in favor of regarding trademarks as private speech.

The government may not defend its viewpoint-based decision-making in this case by characterizing a trademark as a commercial label rather than an expressive statement, when the entire basis for its action rests on the assertion that the Pro-Football's trademarks embody an expressive—disparaging—portrayal of Native Americans. Nor can the government avoid the rule against viewpoint discrimination by arguing that its refusal to register a trademark does not entirely foreclose its use or ban whatever message may be associated with it. The First Amendment is not limited to circumstances in which a speaker is literally silenced. For example, the Supreme Court has found the First Amendment violated when the government has burdened disfavored speech by withholding tax exemptions or imposing a financial burden on the speaker. Perhaps even more to the point, no one would claim that the government can deny copyright protection—and the financial advantages that come with it—solely because it disagrees with the ideas expressed

in a book, even though books can be published without a copyright. Trademarks are entitled to the same First Amendment protection when, as here, the financial advantages of registration are denied on the basis of viewpoint.

Section 2(a)'s unconstitutionality is further exacerbated by the vague subjectivity of its language, which produces arbitrary and capricious results. The same marks have been accepted for some applicants but rejected for others in identical contexts. For example, the PTO denied the registration of the word MADONNA for wine as scandalous;³ yet later found no Section 2(a) violation when granting the registration of a trademark for the sale of MADONNA wine.⁴

As exemplified by this case, moreover, a trademark can be lawfully registered for decades but cancelled abruptly as public opinion shifts. Section 2(a) thus fails to put speakers on notice not only of what expressions the government may disapprove today, but also of what it may decide to disapprove years from now. The First Amendment prohibits the government from granting and denying public benefits in such a capricious manner.

This Court should issue a narrow ruling that strikes down those portions of Section 2(a) of the Lanham Act that prohibit registration of “immoral,” “scandalous,” or “disparag[ing]” marks.

³ *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938) (affirming rejection of mark for use on wines as scandalous).

⁴ Registration No. 3,545,635.

ARGUMENT

I. Section 2(a) impermissibly burdens private speech by predicating significant federal benefits on the viewpoint expressed by a trademark.

The district court reasoned that the Lanham Act does not implicate the First Amendment because the denial or cancellation of trademark registration “do[es] not burden, restrict, or prohibit [a person’s] ability to use the marks.” *Blackhorse*, 2015 WL 4096277 at *9. This was erroneous for two reasons. It was factually incorrect because the denial of registration *does* substantially burden a person’s ability to use a mark by depriving the mark of important legal protections, as discussed below. It was legally incorrect because the assumption that outright censorship—that is, a complete prohibition on the use of a mark—is the only government action that implicates the First Amendment ignores decades of settled constitutional law.

Trademarks are the private expression of their owners. The government does not own, advertise, or market Coca-Cola, iPhones, or the Tar Heels. The core purpose of the First Amendment is to prevent the government from abusing its power to regulate private speech. The government cannot shield its actions from First Amendment scrutiny simply by recording private expression on a list and calling that list “government speech.” If publishing a list of trademarks in a register entitles the government to deny registration free from First Amendment scrutiny, then publishing a list of parade permits or a list of churches in a register

would entitle the government to deny parade permits or tax-exempt status free from First Amendment scrutiny. That argument refutes itself.

a. Trademarks are private speech, and granting or denying registration of trademarks is regulation of private expression.

Trademarks are a marketing tool used to identify or brand a product or organization, but many trademarks also express a message. Indeed, the two are often inextricably intertwined. Trademark applicants frequently propose marks explicitly intended to define a group identity,⁵ engage in parody,⁶ convey artistic ideas,⁷ or express a political opinion.⁸ Indeed, trademark law has long recognized the intersection of trademarks and expressive speech. *See e.g.*, 15 U.S.C. §

⁵ For example, “American Civil Liberties Union” and “ACLU” are federally registered trademarks that, among other things, convey a message about the values and identity of the organization filing this brief.

⁶ *See Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007) (concluding that the trademark for “Chewy Vuitton” dog toys was “a comment on the rich and famous, on the LOUIS VUITTON name and related marks, and on conspicuous consumption in general”).

⁷ *See Rogers v. Grimaldi*, 875 F.2d 994, 998 (2nd Cir. 1989) (noting that film titles are “of a hybrid nature, combining artistic expression and commercial promotion”).

⁸ One notable example concerns an Asian American rock band that “reappropriated” the word “slant,” a racial slur used against members of their community, by naming themselves “The Slants.” Despite the band’s intent to drain the slur of its derogatory power, the PTO denied trademark registration for that name on disparagement grounds. The band is currently appealing their case. *In re Tam*, 785 F.3d 567 (Fed. Cir.) *reh’g en banc granted, opinion vacated*, 600 F. App’x 775 (Fed. Cir. 2015). *See also In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008) (rejecting the proposed trademark “Heeb” as used for a magazine that focuses on Jewish culture and is marketed to young Jewish people).

1125(c)(3) (providing a complete fair-use defense to dilution liability for marks that serve as parody, criticism, or commentary); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894 (9th Cir. 2002) (protecting the use of a trademarked term in a literary title from liability under the Lanham Act); *see also, e.g., United States v. Alvarez*, 132 S. Ct. 2537, 2554–55 (2012) (Breyer, J., concurring) (comparing trademark-infringement requirements to other government restrictions on expressive activity, such as perjury or impersonation). Whatever the expressive goal, it is the trademark owners who are speaking, not the government.

The conclusion that trademarks are private speech is not only supported by logic, it is also supported by the Supreme Court's recent ruling in *Walker v. Tex. Div., Sons of Confederate Veterans*. In rejecting the claim that Texas had created a private speech forum through its specialty license plate program, the Supreme Court considered three factors: i) whether the state or private speakers have historically used license plates to convey messages; ii) with whom license plate designs are identified in the public mind; and iii) who maintained direct control over the designs. Applying that test to Texas's specialty license plate regime, the Court ruled those license plates have historically conveyed the state's message, that they are closely identified with the state, and that the state controlled their designs. 135 S. Ct. at 2248–50.

Here, those factors lead to the opposite conclusion. First, the government has never purported to convey a message through a trademark. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d at *5 n.3 (rejecting the notion that registration constitutes the government's endorsement of the mark or the product to which it is affixed). If trademarks' messages were properly attributed to the government, GIVE JESUS A CHANCE⁹ and EVERYBODY MUST GET DRONED¹⁰ would certainly be cause for concern. Second, the public undoubtedly identifies trademarks with the markholder or its product, and not with the government. For example, LEGOS,¹¹ KLEENEX,¹² and HERSHEY'S¹³ automatically conjure images of plastic blocks, tissues, and chocolates, which have nothing to do with the government. Finally, the trademark registrant maintains final control over the mark's design; the PTO has no design role whatsoever. In sum, the *Walker* factors all demonstrate that trademarks are private speech. The granting or cancellation of such private speech demands First Amendment scrutiny.

b. Section 2(a) impermissibly mandates viewpoint discrimination.

Section 2(a) violates the First Amendment because it burdens expressive speech by denying significant government benefits on the basis of the viewpoint

⁹ Registration No. 86,556,400.

¹⁰ Registration No. 86,677,133.

¹¹ Registration No. 4,395,578.

¹² Registration No. 4,715,059.

¹³ Registration No. 4,529,672.

that the speech expresses. Viewpoint-based discrimination against private speech always receives strict scrutiny and is always presumptively unconstitutional. *See, e.g., Child Evangelism Fellowship of Md., Inc. v. Montgomery Cty. Pub. Sch.*, 457 F.3d 376, 384 (4th Cir. 2006). This presumption applies even when the government uses viewpoint as a justification not to *ban* private speech but to disadvantage it, encumber it, or refuse to fund it. *See infra* at I.C.

The plain language of Section 2(a) *requires* viewpoint discrimination. Its prohibition of registration for “immoral,” “scandalous,” and “disparag[ing]” trademarks is aimed at avoiding controversy—any determination under the section explicitly turns on whether the public (or some fraction of it) would consider a mark offensive. Thus, Section 2(a) codifies a heckler’s veto, as this case illustrates. *See, e.g., Texas v. Johnson*, 491 U.S. 397, 414 (1989) (“the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable”); *Coates v. Cincinnati*, 402 US 611, 615 (1971) (“public intolerance or animosity cannot be the basis for abridgment of these constitutional freedoms”). In requiring the denial of registration of any mark that “disparages” any group or institution, but not those that praise them, Section 2(a) engages in classic viewpoint discrimination.¹⁴

¹⁴ Viewpoint-based burdens on private speech are presumptively unconstitutional in their own right. However, the result is identical even if the Court should choose to apply a forum-based analysis. Government viewpoint

The Court has also shown disfavor to government attempts to “drive certain ideas or viewpoints from the marketplace...The First Amendment presumptively places this sort of discrimination beyond the power of the government.” *Simon & Schuster, Inc. v. Members of New York State Crime Victims Bd.*, 502 U.S. 105, 116 (1991). Yet that is precisely the purpose and effect of Section 2(a)—to create a market economically hostile to ideas that the government disfavors at a particular point in time.¹⁵ Such heavy-handed manipulation of the marketplace of ideas lies beyond the government’s power.

discrimination is never permitted in a forum for private speech, regardless of the nature of the forum. *See, e.g., Good News Club v. Milford Cent. Sch.*, 533 U.S. 98, 107 (2001). This is consistent with the Court’s statement that the analysis in *Walker* (a forum-based case) is not intended to cover situations, like this, in which “private parties, and not only the government, used the system to communicate.” *Walker*, 135 S. Ct. at 2252.

¹⁵ That trademarks often appear in the commercial marketplace does not change the analysis. The commercial speech doctrine applies to “expression related *solely* to the economic interests of the speaker and its audience.” *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 561 (1980) (emphasis added). As noted above, many trademarks do far more than propose or promote a financial transaction, including *amici*’s registered trademark (ACLU®). However, even if this Court should disagree, the result under the First Amendment remains the same: purely commercial speech is protected by the First Amendment from viewpoint discrimination by the government. *See Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653, 2667 (2011); *R.A.V. v. City of St. Paul, Minn.*, 505 U.S. 377, 389 (1992) (“a State may not prohibit only that commercial advertising that depicts men in a demeaning fashion”).

c. The denial of trademark registration is a burden on speech.

The benefits of trademark registration are substantial. *See Blackhorse*, 2015 WL 4096277 at *7 (listing benefits including incontestability and proof of ownership). As Judge Moore noted in her supplemental opinion in the Federal Circuit, the “benefits [of a trademark]—unavailable in the absence of federal registration—are numerous, and include both substantive and procedural rights.” *In re Tam*, 785 F.3d at 575 (Moore, J., additional views), *opinion vacated*, 600 F. App’x 775.

While it is true that the PTO’s decision does not prohibit Pro-Football from continuing to use the word “Redskins,” the denial of trademark protection has tangible economic consequences. Government action implicates the First Amendment not only when it directly prohibits speech, but also when it creates a financial disincentive to engage in speech. *See, e.g., Simon & Schuster*, 502 U.S. at 115 (“A statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech.”); *Rosenberger v. Rector and Visitors of the University of Virginia*, 515 U.S. 819 (1995) (state refusal to fund private publication because of its religious viewpoint violates First Amendment).

For example, a state may not require a convicted criminal who writes a book about his crimes to turn over profits to the victim, as in *Simon & Schuster*, nor may

it impose a sales tax on some magazines but exempt “religious, professional, trade, and sports journals,” *Ark. Writers’ Project, Inc. v. Ragland*, 481 U.S. 221, 229–30 (1987). *See also Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134–35, (1992) (striking down ordinance that permitted county to charge controversial speakers for extra police protection because “[s]peech cannot be financially burdened, any more than it can be punished or banned, simply because it might offend a hostile mob”); *Am. Communications Ass’n v. Douds*, 339 U.S. 382, 402 (1950) (“[U]nder some circumstances, indirect ‘discouragements’ undoubtedly have the same coercive effect upon the exercise of First Amendment rights as imprisonment, fines, injunctions, or taxes.”). *See infra* at section II (discussing the unconstitutional conditions doctrine).

As the benefits of trademark registration are both uncontested and significant, and as Section 2(a) targets private speech, the denial of a trademark on viewpoint-based grounds implicates the First Amendment.

II. Section 2(a) places an unconstitutional condition on the receipt of valuable government benefits.

In addition to violating the fundamental rule against viewpoint discrimination, Section 2(a) also violates the “unconstitutional conditions” doctrine. That doctrine “holds that the government ‘may not deny a benefit to a person on a basis that infringes his constitutionally protected . . . freedom of speech’ even if he has no entitlement to that benefit.” *Bd. of Cty. Comm’rs*,

Wabaunsee Cty. v. Umbehr, 518 U.S. 668, 674 (1996) (citing *Perry v. Sindermann*, 408 U.S. 593, 597 (1972)).

The doctrine had its genesis in *Speiser v. Randall*, 357 U.S. 513, 519 (1958), where California denied a veterans' tax exemption to a veteran who would not sign a McCarthy-era loyalty oath. The Supreme Court recognized that denying a benefit based on the recipient's viewpoint (in that case, a refusal to express a politically popular opinion) violated the First Amendment. The same reasoning applies here.

In a parallel case currently under advisement before the Court of Appeals for the Federal Circuit,¹⁶ the government defends Section 2(a) by arguing that it does not impose an unconstitutional condition, but instead represents a decision by the government to further its own programmatic goals. To be sure, the government may restrict its financial support to further its own programs even when those programs are themselves viewpoint-based. *See, e.g., Rust v. Sullivan*, 500 U.S. 173

¹⁶ In its now-vacated panel opinion in *In re Tam*, the court noted the precedential case *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981), which held that the expenditure of the federal government's "time" and "services" to confer the benefits of trademark registration placed the Lanham Act beyond the First Amendment's reach. 785 F.3d at 572, *opinion vacated*, 600 F. App'x 775 (Fed. Cir. 2015). As explained in Judge Moore's separate opinion, that analysis is incorrect. *In re Tam*, 785 F.3d at 573–74 (Moore, J., additional views), *opinion vacated*, 600 F. App'x 775. Under that reasoning, the government could deny parade permits to those with disfavored viewpoints on ground it costs money to administer the permitting process.

(1991). However, this doctrine does not allow the government to claim private speech as its own in order to avoid constitutional scrutiny.

The Supreme Court has marked the point at which the government crosses the constitutional line. While the government may fund private speakers to communicate the government's preferred messages, and may deny government funds to private speakers that will not use those funds to communicate the government's preferred messages, the government lacks the power to disadvantage private speech with which it disagrees, even when the private speaker receives government funds for other purposes. As the Court explained:

Neither the latitude for government speech nor its rationale applies to subsidies for private speech in every instance, however. As we have pointed out, “[i]t does not follow . . . that viewpoint-based restrictions are proper when the [government] does not itself speak or subsidize transmittal of a message it favors but instead expends funds to encourage a diversity of views from private speakers.” *Rosenberger*, [515 U.S. at 834].

Legal Servs. Corp. v. Velazquez, 531 U.S. 533, 541–42 (2001).

The trademark registry comprises precisely that “diversity of views from private speakers.” The plain text of Section 2(a) demonstrates Congress’s intent to provide general access to owners of valid trademarks. *See* 15 U.S.C. § 1052(a) (“No trademark shall be refused registration on the Principal Register on account of its nature unless” it falls into certain enumerated categories.); *see also Bongrain Int’l (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479, 1485 (Fed. Cir. 1987)

(“One of the policies sought to be implemented by the [Lanham] Act was to encourage the presence on the register of trademarks of as many as possible of the marks in actual use.”). By providing a generally available program for registering private trademarks, Section 2(a) affirmatively encourages a diversity of private viewpoints to be expressed, *except* in the proscribed categories.

The registration of trademarks does not turn this regulation of private speech into government speech. Indeed, the Supreme Court has explicitly cautioned against blurring this line to the detriment of free expression principles. “Congress cannot recast a condition on funding as a mere definition of its program in every case, lest the First Amendment be reduced to a simple semantic exercise.” *Velazquez*, 531 U.S. at 547. Permitting the government to claim private trademarks as its own speech would exemplify such semantics.

III. Section 2(a) is unconstitutionally vague and overbroad.

The Constitution prohibits vague regulations of speech because ambiguous terms create a risk of arbitrary enforcement and self-censorship. *See FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012) (“A fundamental principle in our legal system is that laws which regulate persons or entities must give fair notice of conduct that is forbidden or required.”); *Grayned v. City of Rockford*, 408 U.S. 104, 108–09 (1972) (holding that courts must consider whether the “law impermissibly delegates basic policy matters to policemen, judges, and juries for

resolution on an ad hoc and subjective basis, with the attendant dangers of arbitrary and discriminatory applications.”).

The Supreme Court has repeatedly emphasized that the vagueness doctrine is most critical in the First Amendment context because speakers “sensitive to the perils posed by . . . indefinite language[] avoid the risk . . . only by restricting their conduct to that which is unquestionably safe.” *Baggett v. Bullitt*, 377 U.S. 360, 372 (1964); *see also Reno v. American Civil Liberties Union*, 521 U.S. 844, 871 (1997) (“The vagueness of [a content-based regulation of speech] raises special First Amendment concerns because of its obvious chilling effect.”). The requirement of clarity is at its height when the government is regulating speech. *Hoffman Estates v. Flipside, Hoffman Estates*, 455 U.S. 489, 499 (1982) (“If . . . the law interferes with the right of free speech or of association, a more stringent vagueness test should apply.”); *Keyishian v. Bd. of Regents*, 385 U.S. 589, 604 (1967) (“Because First Amendment freedoms need breathing space to survive, government may regulate in the area only with narrow specificity.”) (quoting *NAACP v. Button*, 371 U.S. 415, 432–33 (1963)).¹⁷

¹⁷ Contrary to the district court’s assertion, *see Blackhorse*, 2015 WL 4096277 at *18, Section 2(a) is not an economic regulation subject to a “relaxed vagueness review standard.” It burdens protected speech (see *supra* at I.A); as such, it is entitled to exacting vagueness review.

Section 2(a) provides little guidance to the PTO as to the meaning of its terms, leading to a long line of arbitrary and contradictory decisions. The legislative history of the Lanham Act provides no further explanation. The Trademark Manual of Examining Procedure concedes that “[t]here is little legislative history concerning the intent of Congress with regard to the provision,” Trademark Manual of Examining Procedure (TMEP) § 1203.01.¹⁸ While it is sometimes the case that “[a] term that appears vague on its face may derive much meaningful content from the purpose of the Act, its factual background, and the statutory context,” *Thomas v. Union Carbide Agric. Products Co.*, 473 U.S. 568, 593 (1985) (citation omitted), such purpose, background, or context is entirely absent in the Lanham Act. The lack of clear standards is exemplified by the PTO’s long history of bizarre and contradictory decisions: The *very same* terms are frequently granted registration in one case and denied in another with no seeming continuity of logic.

For example, the PTO registered “WANKER” for use on beer,¹⁹ but rejected it for use on clothing,²⁰ with no clear difference in meaning. Likewise, “TITMOUSE”

¹⁸ Available at <http://www.uspto.gov/trademark/guides-and-manuals/tmep-archives>.

¹⁹ Registration No. 2,036,108.

²⁰ U.S. Trademark Application Serial No. 78,610,369 (filed April 16, 2005).

was rejected for use on computer cursor control devices,²¹ but “TITMOUSEINC.” is a registered mark used for animation production services.²² There are countless examples of such irregularities. *Compare* MADONNA, *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938) (affirming rejection of mark for use on wines as scandalous), *with* MADONNA, Registration No. 3,545,635 (accepted for use on wine); PUSSY POWER, U.S. Trademark Application Serial No. 77,387,209 (filed February 2, 2008) (rejected for use for entertainment services), *with* PUSSYPOWERREVOLUTION, Registration No. 4,507,246 (accepted for use on clothing); COCAINE, U.S. Trademark Application Serial No. 78,829,207 (filed March 3, 2006) (rejected for use on soft drinks and energy drinks), *with* COCAINE, Registration No. 1,340,874 (accepted for use on clothing); CUM, U.S. Trademark Application Serial No. 78,059,173 (filed April 19, 2001) (rejected for use on perfume), *with* CUM, Registration No. 1,044,903 (accepted for “no description entered”); UPPITY NEGRO, U.S. Trademark Application Serial No. 86,053,392 (filed August 31, 2013) (rejected on grounds other than Section 2(a) for use on apparel and mugs) *with* UPPITY NEGRO, U.S. Trademark Application Serial No. 78,312,525 (filed October 12, 2003) (rejected for use on apparel as a “matter that may disparage or bring into contempt or disrepute

²¹ U.S. Trademark Application Serial No. 78,954,967 (filed August 18, 2006).

²² Registration No. 4,624,689.

African-Americans”); THE COMPLETE A**HOLE’S GUIDE TO . . ., U.S. Trademark Application Serial No. 76,351,811 (filed December 21, 2001) (rejected for use on series of books providing information relating to advice, counseling, self-help, and humor), *with* MANAGING YOUR INNER A**HOLE, U.S. Trademark Application Serial No. 85,711,056 (filed August 23, 2012) (accepted for use on books on the development of emotional intelligence—not registered on other grounds); BIGCOCK, U.S. Trademark Application Serial No. 85,418,794 (filed September 9, 2011) (rejected for use on energy drinks), *with* ONEFOOTCOCK, Registration No. 4,544,038 (accepted for use on alcoholic beverages); MESSIAS, *In re Sociedade Agricola E. Comercial Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. 275 (T.T.A.B. 1968) (rejected for use on wine and brandy), *with* IL MESSIA, Registration No. 4,093,035 (accepted for use on wine).

The patchwork nature of such decisions means that no trademark applicant can ever be on notice as to what words or ideas will trigger PTO rejection.²³ The absence of guidance has forced both the PTO and the courts to turn instead to a

²³ The PTO’s only effort to avoid such inconsistencies is the requirement that an examining attorney who believes a pending trademark is scandalous or disparaging must “consult with his or her supervisor” if she believes, “for whatever reason, that a mark may be considered to comprise such matter,” in order to “ensure consistency in examination with respect to immoral or scandalous matter.” TMEP § 1203.01. But this procedural step does little to ensure that the PTO applies Section 2(a)’s standards consistently, as the examples cited above demonstrate. There is little doubt that the only consistent result of the application of the disparagement clause is inconsistency.

random sampling of dictionaries to meet the statutory requirement. Examiners have no choice but to consult niche dictionaries to search out disqualifying insults due to the constantly evolving nature of language. As the TTAB has noted, “what was considered scandalous as a trademark or service mark twenty, thirty or fifty years ago may no longer be considered so, given the changes in societal attitudes.” *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d at *4.²⁴ Even if it were true that “immoral” or “scandalous” could be given a suitable definition based on dictionary entries, what *qualifies* as “immoral” or “scandalous” cannot, and no reliable indicia exist to make such a determination or to alert the public to what is and what is not acceptable in the eyes of the PTO—or what will no longer be acceptable in twenty, thirty, or fifty years. As this case demonstrates, a mark may be cancelled decades after its initial use. Those who wish to register an expressive mark must therefore make their best guess about how to survive the ever-shifting gauntlet of Section 2(a)’s moral judgment—by self-censoring.²⁵

²⁴ In this case, a term that was not viewed as scandalous in the recent past has now become so, at least in the eyes of the PTO and the ACLU—although obviously not yet in the eyes of many sports fans. The evolving nature of language guarantees that under Section 2(a), some trademark holders will be deprived of valuable property rights as public opinion shifts. The First Amendment forbids the government from granting or withholding benefits because a private speaker chooses *not* to evolve. The NAACP should not lose its trademark because “Colored” has become a generally disfavored appellation.

²⁵ As the inconsistencies in registrations and denials demonstrate—even as applied to the very same words—it would be nearly impossible to predict with

The PTO's inconsistent application of Section 2(a) therefore has a chilling effect on the registration of trademarks, which are protected speech. It is reasonable to assume that a musical band would think twice before choosing a potentially race-reappropriating name after learning of The Slants' rejection, and a sports team would think twice before adopting a cultural mascot after learning about the cancellation of the instant trademarks. More broadly, those choosing expressive trademarks are likely to steer far away from anything remotely controversial. If a group fears that its preferred method of self-identification will be denied federal trademark protection by the government's invocation of Section 2(a)—now or someday in the future—it will be less likely to adopt that name, at least in part because the associative value of the trademark itself is lessened when it is unlikely that a group will be able to protect its exclusive use of that mark. The First Amendment was intended to prevent the government from exercising this kind of influence over the marketplace of ideas. If a judgment is to be made regarding the suitability or sensitivity of particular trademark, it should be made by the marketplace itself. A trademark holder who misunderstands the marketplace may suffer the business consequences, but it has no First Amendment claim.

The district court also erred in denying appellant's vagueness challenge on the ground that "PFI cannot show that Section 2(a) is unconstitutional in all of its

confidence whether any potentially sexual or racial trademark would be permitted at any given point in time. *See supra* at 16–17.

applications.” This analysis ignores the Supreme Court’s recent decision in *Johnson v. United States*, 135 S. Ct. 2551 (2015). In that case, the Court held that the residual clause of the Armed Career Criminal Act, which allowed increased sentences for repeat offenders, was unconstitutionally vague. *Id.* at 2557. Justice Scalia, writing for an 8-1 majority, explicitly rejected the dissent’s contention that a law must be vague in all of its applications in order to be invalidated. *Id.* at 2561 (“It seems to us that the dissent’s supposed requirement of vagueness in all applications is not a requirement at all, but a tautology: If we hold a statute to be vague, it is vague in all its applications.”). The Court stated that its prior “holdings squarely contradict the theory that a vague provision is constitutional merely because there is some conduct that clearly falls within the provision’s grasp.” *Id.* (emphasis removed). Accordingly, appellant need not “demonstrate that every conceivable set of words, symbols, or combination thereof would be invalid under Section 2(a).” *Blackhorse*, 2015 WL 4096277 at *18. It is enough that the PTO has no means of understanding how many people comprise a “substantial composite” of a certain group, or what constitutes “disparaging,” “scandalous,” or “immoral” marks. Laws or regulations that are impermissibly vague must be invalidated. *Fox*, 132 S. Ct. at 2317.²⁶

²⁶ The Court has also examined statutes that vest unbridled discretion to regulate speech under the Due Process Clause. “It is a basic principle of due process that an enactment is void for vagueness if its prohibitions are not clearly defined.”

The terms of Section 2(a) have resulted in a heavy-handed and counterproductive PTO decision-making process. The disparagement clause is both set in stone, concretizing archaic notions of propriety and stopping progressive social movements in their tracks, *and* ephemeral: What may be deemed acceptable today may become disparaging tomorrow, depending on the PTO's perception of social mores. As such, Section 2(a) is impermissibly vague and grants government power to regulate without sufficient guidance, resulting in inconsistent and unconstitutional administrative action. This Court should not allow such a law to continue discriminating against constitutionally protected speech.

IV. A finding that Section 2(a) is facially unconstitutional would not significantly alter the landscape of trademark law.

A finding of unconstitutionality in this case requires only a narrow remedy that will not create an upheaval in trademark law. Indeed, a finding for Washington's team would cause immeasurably less mischief in the PTO and the courts than Section 2(a) already causes by imposing what amounts to a heckler's veto against controversial or potentially controversial trademarks.

As noted above, terms sometimes considered "disparaging" and "scandalous" by the PTO are in fact granted trademarks, albeit in an inconsistent

Grayned, 408 U.S. at 108. As noted above, the requirement of clarity is especially stringent when a law interferes with First Amendment rights. *See Keyishian*, 385 U.S. at 604. The Constitution requires the government to define restrictions on speech with clarity *both* to ensure procedural fairness and to avoid chilling speech.

fashion. *See supra* at III. Thus, as a practical matter, striking down Section 2(a)'s moralistic exclusions will not result in such trademarks being registered for the first time.

As a legal matter, vindicating appellants' constitutional claims requires only a holding that the term "disparage" in Section 2(a) is unenforceable, as that was the ground upon which the PTO and the district court found appellant's trademarks invalid. The remainder of Section 2(a) will not thereby become unenforceable, because the unconstitutional term can be severed. *See Regan v. Time, Inc.*, 468 U.S. 641, 653 (1984) ("the presumption is in favor of severability."). However, *amici* urge the Court to make plain that the terms "immoral," "scandalous," "contempt," and "disrepute" suffer from the same constitutional infirmity as "disparage," and could just as easily form the basis for cancelling the appellant's trademarks. As cancellation based on those terms would be equally unconstitutional, each of those terms should be held unconstitutional and severed from Section 2(a).

Moreover, eliminating the subjective and viewpoint-based terms from Section 2(a) will bring trademark law more closely in compliance with copyright and patent practice. *See Jendi B. Reiter, Redskins and Scarlet Letters: Why "Immoral" and "Scandalous" Trademarks Should Be Federally Registrable*, 8 Fed. Cir. B.J. 191, 200 (1976) (noting that mere offensiveness is no bar to

copyright protection, and that courts have been increasingly wary of denying patents on the basis of vague moral standards); *see also, e.g., Ex parte Murphy*, 200 U.S.P.Q. (BNA) 801, 802–03 (1977) (reversing the immorality-based rejection of a patent for a slot machine).

In no other area of doctrine do the courts permit the government to engage in this kind of standardless, *ad hoc* regulation of speech based on its perceived morality or offensiveness. Nor should this Court permit the impermissible viewpoint discrimination mandated by the language of Section 2(a).

CONCLUSION

For the above reasons, this Court should reverse the judgment of the district court.

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CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of FED. R. APP. P. 32(a) because it contains 6617 words, excluding the parts of the brief exempted by FED. R. APP. P.32(a)(7)(B)(iii).
2. This brief complies with the typeface requirements of FED. R. APP. P. 32(a)(5) and the type-style requirements of FED. R. APP. P. 32(a)(6) because it has been prepared in a proportionally spaced typeface using Microsoft Word 2010 in 14-point Times New Roman.

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