

No. 15-1311

In the Supreme Court of the United States

PRO-FOOTBALL, INC., PETITIONER

v.

AMANDA BLACKHORSE, ET AL.

*ON PETITION FOR A WRIT OF CERTIORARI
BEFORE JUDGMENT TO THE UNITED STATES
COURT OF APPEALS FOR THE FOURTH CIRCUIT*

BRIEF FOR THE UNITED STATES IN OPPOSITION

IAN HEATH GERSHENGORN
*Acting Solicitor General
Counsel of Record*

BENJAMIN C. MIZER
*Principal Deputy Assistant
Attorney General*

DOUGLAS N. LETTER
MARK R. FREEMAN
DANIEL TENNY
JOSHUA M. SALZMAN
Attorneys

*Department of Justice
Washington, D.C. 20530-0001
SupremeCtBriefs@usdoj.gov
(202) 514-2217*

QUESTIONS PRESENTED

Section 2(a) of the Lanham Act, 15 U.S.C. 1052(a), provides that no trademark shall be refused registration on account of its nature unless, *inter alia*, it “[c]onsists of * * * matter which may disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” The questions presented are as follows:

1. Whether the disparagement provision in 15 U.S.C. 1052(a) is facially invalid under the Speech Clause of the First Amendment.

2. Whether the disparagement provision in 15 U.S.C. 1052(a) is unconstitutionally vague, in violation of the Speech Clause of the First Amendment and the Due Process Clause of the Fifth Amendment.

3. Whether the cancellation of petitioner’s registrations, on the ground that the challenged marks were ineligible for federal registration under 15 U.S.C. 1052(a) at the time they were registered, violates petitioner’s rights under the Due Process Clause.

TABLE OF CONTENTS

	Page
Opinions below	1
Jurisdiction	1
Statement	1
Argument.....	9
Conclusion	23

TABLE OF AUTHORITIES

Cases:

<i>Aaron v. Cooper</i> , 357 U.S. 566 (1958)	10
<i>B & B Hardware, Inc. v. Hargis Indus., Inc.</i> , 135 S. Ct. 1293 (2015)	2, 3
<i>Boulevard Entm't, Inc., In re</i> , 334 F.3d 1336 (Fed. Cir. 2003)	20
<i>Chevron U.S.A. Inc. v. NRDC</i> , 467 U.S. 837 (1984).....	14
<i>Clinton v. Jones</i> , 520 U.S. 681 (1997)	14
<i>Coleman v. Paccar Inc.</i> , 424 U.S. 1301 (1976).....	10
<i>Cutter v. Wilkinson</i> , 544 U.S. 709 (2005)	14
<i>Geller, In re</i> , 751 F.3d 1355 (Fed. Cir. 2014), cert. denied, 135 S. Ct. 944 (2015)	19
<i>Gratz v. Bollinger</i> , 539 U.S. 244 (2003)	17
<i>Grutter v. Bollinger</i> , 539 U.S. 306 (2003).....	17
<i>J.C. Eno (U.S.) Ltd. v. Coe</i> , 106 F.2d 858 (D.C. Cir. 1939)	21
<i>Lebanese Arak Corp., In re</i> , 94 U.S.P.Q.2d 1215, 2010 WL 766488 (T.T.A.B. 2010).....	14
<i>National Endowment for the Arts v. Finley</i> , 524 U.S. 569 (1998).....	19
<i>P. A. B. Produits et Appareils de Beaute v. Satinine Societa in Nome Collettivo di S.A. e. M. Usellini</i> , 570 F.2d 328 (C.C.P.A 1978)	21

IV

Cases—Continued:	Page
<i>Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.</i> , 469 U.S. 189 (1985).....	2
<i>Rust v. Sullivan</i> , 500 U.S. 173 (1991)	7
<i>Shinnecock Smoke Shop, In re</i> , 571 F.3d 1171 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010)	20
<i>Tam, In re</i> , 808 F.3d 1321 (Fed. Cir. 2016), petition for cert. pending, No. 15-1293 (filed Apr. 20, 2016).....	8, 10, 11
<i>Trade-Mark Cases</i> , 100 U.S. 82 (1879).....	2
<i>Two Pesos, Inc. v. Taco Cabana, Inc.</i> , 505 U.S. 763 (1992).....	2
<i>United States v. Booker</i> , 543 U.S. 220 (2005)	16
<i>United States v. Eight Thousand Eight Hundred & Fifty Dollars (\$8,850) in U.S. Currency</i> , 461 U.S. 555 (1983)	22
<i>United States v. Fanfan</i> , 542 U.S. 956 (2004).....	16
<i>Walker v. Texas Div., Sons of Confederate Veterans, Inc.</i> , 135 S. Ct. 2239 (2015).....	7

Constitution, statutes, regulations and rules:

U.S. Const.:	
Amend. I.....	<i>passim</i>
Amend. V.....	<i>passim</i>
Act of July 5, 1946 (Lanham Act), ch. 540, 60 Stat. 427 (15 U.S.C. 1051 <i>et seq.</i>)	3
Tit. I, § 14(c), 60 Stat. 433.....	22
15 U.S.C. 1051(a)	3
15 U.S.C. 1052.....	4
15 U.S.C. 1052(a)	<i>passim</i>
15 U.S.C. 1052(c)	14
15 U.S.C. 1057(b).....	3

Statutes, regulations and rules—Continued:	Page
15 U.S.C. 1064.....	4, 16, 20
15 U.S.C. 1064(3)	20, 22
15 U.S.C. 1065.....	3
15 U.S.C. 1067.....	22
15 U.S.C. 1071(a)	4
15 U.S.C. 1071(b).....	4, 6, 22
15 U.S.C. 1072.....	3
15 U.S.C. 1115(a)	3
15 U.S.C. 1115(b).....	3
15 U.S.C. 1125(a)	3
15 U.S.C. 1125(b).....	3
15 U.S.C. 1125(d).....	3
15 U.S.C. 1127.....	2
28 U.S.C. 2101(e)	10
28 U.S.C. 2403(a)	6
37 C.F.R. 2.111-2.136.....	22
Sup. Ct. R.:	
Rule 10(a)	15
Rule 11.....	10
 Miscellaneous:	
1 Anne Gilson LaLonde, <i>Gilson on Trademarks</i> (2016).....	3
Stephen M. Shapiro et al., <i>Supreme Court Practice</i> (10th ed. 2013)	17
U.S. Patent and Trademark Office, <i>Official United States Patent and Trademark Office Statement on the Trademark Trial and Appeal Board’s (TTAB) Decision in Blackhorse v. Pro Football, Inc. (TTAB Cancellation No. 92046185)</i> , http://go.usa.gov/c7Dz4 (last visited June 24, 2016)	5, 12, 22

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OPINIONS BELOW

The opinion of the district court (Pet. App. 1a-89a) is reported at 112 F. Supp. 3d 439. The opinion of the Trademark Trial and Appeal Board (Pet. App. 92a-362a) is reported at 111 U.S.P.Q.2d 1080.

JURISDICTION

The district court's judgment was entered on July 8, 2015. Petitioner filed a notice of appeal on August 4, 2015, Pet. App. 90a-91a, and the appeal remains pending in the court of appeals, see *Pro-Football, Inc. v. Blackhorse*, No. 15-1874 (4th Cir.). The petition for a writ of certiorari before judgment was filed on April 25, 2016. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1) and 2101(e).

STATEMENT

Five individual Native Americans (the individual respondents) petitioned the United States Patent and

Trademark Office (PTO) to cancel the federal registrations of six trademarks used by petitioner to designate its professional football services in commerce. The individual respondents contend that the challenged marks, each of which contains the term “Redskins,” were improperly registered under 15 U.S.C. 1052(a), which precludes federal registration of trademarks that “disparage * * * persons, living or dead, institutions, beliefs, or national symbols.”

The PTO granted the cancellation petition, Pet. App. 92a-362a, and the district court affirmed, *id.* at 1a-89a. Petitioner appealed, raising a variety of statutory, constitutional, and equitable issues. The appeal has been fully briefed and is awaiting oral argument in the Fourth Circuit. Petitioner now seeks a writ of certiorari before judgment.

1. A trademark is a “word, name, symbol, or device” used by a person “to identify and distinguish his or her goods” or services in commerce and “to indicate the source of the goods” or services. 15 U.S.C. 1127. “[T]rademarks desirably promote competition and the maintenance of product quality.” *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193 (1985). Trademark law also protects the public by preventing competing merchants from using confusingly similar marks to mislead consumers about the source of the goods and services they purchase. See, *e.g.*, *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 774 (1992).

Federal law does not create trademarks or trademark rights. See, *e.g.*, *Trade-Mark Cases*, 100 U.S. 82, 92 (1879). Trademark rights arise through use of a mark in commerce in connection with particular goods

and services. 1 Anne Gilson LaLonde, *Gilson on Trademarks* § 3.02[2][a] (2016). The holder of a trademark may use and enforce his mark without federal registration. See *B & B Hardware, Inc.*, 135 S. Ct. at 1299.

As a supplement to common-law protection, Congress has created a federal trademark-registration system and has provided mark owners with federal remedies against infringement, dilution, and unfair competition. See Act of July 5, 1946 (Lanham Act), ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*). Federal registration confers certain benefits on trademark owners who register their marks. See *B & B Hardware, Inc.*, 135 S. Ct. at 1300. For example, registration provides prima facie evidence of the owner's exclusive right to use the mark in connection with certain goods or services in commerce. 15 U.S.C. 1057(b), 1115(a). Registration also provides constructive notice of the registrant's claim of ownership of the mark. 15 U.S.C. 1072. After a trademark has been registered for five years, the owner's right to use the mark becomes "incontestable" and may be challenged only on limited grounds. 15 U.S.C. 1065, 1115(b). But many of the federal remedies created by the Lanham Act are available to owners of all marks, without regard to registration. See 15 U.S.C. 1125(a) (federal cause of action for representations about the origin of goods or services that are likely to confuse consumers); 15 U.S.C. 1125(b) (importation ban); 15 U.S.C. 1125(d) (remedy for cybersquatting).

To obtain federal registration, the trademark owner submits an application to the PTO. 15 U.S.C. 1051(a). The PTO is not required to register every mark for which an application is filed. Rather, Con-

gress directed the PTO to “refuse[] registration” of certain categories of marks “on account of [their] nature.” 15 U.S.C. 1052. This case concerns one of those categories—marks consisting of or comprising “matter which may disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” 15 U.S.C. 1052(a).

A third party may “[a]t any time” petition to cancel registration of a mark that was previously registered in violation of Section 1052(a). 15 U.S.C. 1064. A registration is subject to cancellation on this ground only if it was ineligible for registration at the time it originally was registered. *Ibid.* Cancellation petitions are adjudicated by the Trademark Trial and Appeal Board (Board). A party aggrieved by the Board’s decision may seek judicial review in the Federal Circuit, see 15 U.S.C. 1071(a), or file a civil action in federal district court, see 15 U.S.C. 1071(b).

2. Petitioner is a professional football team known as the “Washington Redskins.” Pet. App. 4a. The team has used the name “Redskins” since 1933. *Ibid.* After using the name for more than three decades, the team sought federal registration of a mark consisting of the term “Redskins,” and the PTO registered the mark in 1967. *Id.* at 5a. Between 1974 and 1990, petitioner registered five additional related marks, all containing the term “Redskins.” *Ibid.*

In 2006, the individual respondents filed a petition to cancel the registrations for petitioner’s six marks. Pet. App. 8a. They contended that the term “Redskins” is disparaging to a substantial composite of

Native Americans, and that it was so at the time the marks were registered. *Id.* at 9a.¹

3. The Board granted the petition for cancellation, Pet. App. 92a-362a, concluding that the record evidence establishes that the registrations “must be cancelled because they were disparaging to Native Americans at the respective times they were registered,” *id.* at 93a. The Board explained that petitioner’s marks refer to Native Americans, *id.* at 113a, 162a, 173a-174a, and it concluded, based on the record evidence (consisting of expert testimony, exhibits, reports, dictionary definitions, and other materials), that the marks were disparaging to a substantial composite of such people at the time of registration, *id.* at 118a, 161a, 174a-178a. In so holding, the Board emphasized that petitioner could continue to use the marks in commerce without the benefits of federal registration. *Id.* at 93a, 117a n.44. The Board also rejected petitioner’s laches defense. *Id.* at 181a-187a.

The PTO did not immediately cancel the registrations. Rather, the PTO directed that “[t]he registrations will not appear in the USPTO’s records as cancelled until after any judicial review is completed.” See PTO, *Official United States Patent and Trademark Office Statement on the Trademark Trial and Appeal Board’s (TTAB) Decision in Blackhorse v. Pro Football, Inc. (TTAB Cancellation No. 92046185)*

¹ This is the second petition filed with the PTO seeking cancellation of petitioner’s registrations. In 1992, seven Native Americans filed a petition for cancellation of the marks; the Board granted the petition, but the court of appeals ultimately concluded that the petition was barred by laches. See Pet. App. 96a-98a (summarizing that litigation).

(PTO Statement on *Blackhorse* Cancellation), <http://go.usa.gov/c7Dz4> (last visited June 24, 2016).

4. As authorized by the Lanham Act, 15 U.S.C. 1071(b), petitioner sought judicial review of the Board's cancellation decision by filing suit in federal district court against the private respondents. Pet. App. 9a. Petitioner asserted a variety of statutory, constitutional, and equitable claims, including that the Board had erred in concluding that the marks were disparaging at the time of registration; that Section 1052(a)'s disparagement provision violates the First Amendment both facially and as applied; that the cancellation of petitioner's registrations violates due process and effects an unconstitutional taking; and that the individual respondents' claims are barred by laches. C.A. App. 37-55 (complaint). The United States intervened in the case to defend the constitutionality of Section 1052(a). Pet. App. 10a; see 28 U.S.C. 2403(a).

The parties filed cross-motions for summary judgment on both the constitutional and non-constitutional issues. Pet. App. 1a-2a. Petitioner urged the district court to decide the case on statutory or laches grounds in order to avoid addressing the constitutional issues. See C.A. App. 117 (petitioner's summary-judgment brief); see also *id.* at 42 (complaint).

5. The district court granted summary judgment to the individual respondents and the United States. Pet. App. 1a-89a. The court first rejected petitioner's facial and as-applied First Amendment challenges to Section 1052(a). *Id.* at 17a-37a. The court explained that Section 1052(a) "do[es] not burden, restrict, or prohibit [petitioner's] ability to use the marks," *id.* at 18a, and that Congress's "decision not to subsidize the

exercise of a fundamental right does not infringe the right,” *id.* at 34a (citations omitted). Relying on this Court’s decisions in *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015), and *Rust v. Sullivan*, 500 U.S. 173 (1991), the district court concluded that Section 1052(a) is consistent with the First Amendment because “the federal government may determine the contents and limits of programs that it creates and manages.” Pet. App. 23a; see *id.* at 24a-37a. Like the Board, the court emphasized that petitioner is “free to use [its] marks” without federal registration. *Id.* at 36a; see *id.* at 13a-14a.

The district court rejected petitioner’s argument that Section 1052(a) is unconstitutionally vague. Pet. App. 37a-42a. The court explained that Section 1052(a) provides fair notice of its scope because the term “disparaging” has been defined by numerous dictionaries, *id.* at 39a-40a; that the PTO has provided guidance on its meaning, *id.* at 40a-41a; and that petitioner was “fully on notice” when it registered the marks that the marks contain disparaging material, *id.* at 41a-42a. The court also rejected petitioner’s due process and takings claims, explaining that, although petitioner has a cognizable property interest in its marks, it does not have such an interest in government registration of the marks. *Id.* at 43a.

Turning to petitioner’s non-constitutional arguments, the district court concluded, based on its own review of the record, that petitioner’s marks were disparaging to a substantial composite of Native Americans at the time of registration, and that the registrations therefore were properly cancelled under Section 1052(a). Pet. App. 44a-83a. The court also rejected petitioner’s laches defense. The court ex-

plained that the individual respondents had not unreasonably delayed in seeking cancellation, *id.* at 84a-85a, and that laches should not apply in any event because of the public interest implicated by the cancellation decision, *id.* at 85a-86a.

6. Petitioner appealed. Pet. App. 90a-91a; see *Pro-Football, Inc. v. Blackhorse*, appeal pending, No. 15-1874 (4th Cir. filed Aug. 6, 2015). Petitioner's Fourth Circuit briefs renewed most of the arguments that petitioner had presented to the district court, namely that (1) Section 1052(a) violates the First Amendment, facially and as applied, Pet. C.A. Br. 13-33; (2) Section 1052(a) is unconstitutionally vague, *id.* at 33-41; (3) cancellation of petitioner's registrations violates petitioner's due process rights because the marks were registered decades ago, *id.* at 42-45; (4) petitioner's marks were not disparaging at the time they were registered, *id.* at 51-62; and (5) laches bars the cancellation petition, *id.* at 62-64. Petitioner also argued for the first time on appeal that Section 1052(a) prohibits registration only of marks that disparage individual persons, not of marks that disparage entire groups such as Native Americans. *Id.* at 46-48.

Briefing in the court of appeals was completed in March 2016, and the parties are awaiting an order calendaring the case for oral argument. See Pet. 10. The case remains on the Fourth Circuit's active docket.

7. After petitioner filed its appeal, the en banc Federal Circuit held in a different case that Section 1052(a)'s disparagement provision is facially unconstitutional under the First Amendment. See *In re Tam*, 808 F.3d 1321, 1327-1328 (2016) (en banc), petition for cert. pending, No. 15-1293 (filed Apr. 20, 2016). The

government has filed a petition for a writ of certiorari seeking review of that decision. That petition presents a single question: whether the disparagement provision in 15 U.S.C. 1052(a) is facially invalid under the Speech Clause of the First Amendment. Pet. at I, *Lee v. Tam*, No. 15-1293 (filed Apr. 20, 2016).

ARGUMENT

Petitioner seeks a writ of certiorari before judgment, asking this Court to address its First Amendment, vagueness, and due process claims before the court of appeals has had any opportunity to do so. The Court should reject that extraordinary request. Although the first question presented (whether Section 1052(a) is facially invalid under the Speech Clause) is important and warrants this Court's review, the government's pending certiorari petition in *Lee v. Tam*, petition for cert. pending, No. 15-1293 (filed Apr. 20, 2016), presents the same question in a case where the en banc Federal Circuit has thoroughly considered and addressed the issue. A grant of certiorari before judgment would be particularly unwarranted because petitioner has raised a variety of non-constitutional challenges to the Board's cancellation decision, and a ruling favorable to petitioner on one of those grounds would obviate the need to decide the First Amendment issue in this case. Petitioner provides no sound reason to deviate from this Court's usual practice of deferring any review until the court of appeals has issued its decision.

The second and third questions in the petition also do not warrant this Court's review. The district court correctly rejected petitioner's arguments on those issues; there is no disagreement among the circuits on

either question; and the third question is a case-specific one.

1. Although this Court has statutory authority to review a case “before judgment has been rendered in the court of appeals,” 28 U.S.C. 2101(e), “the exercise of such power by the Court is an extremely rare occurrence,” *Coleman v. Paccar Inc.*, 424 U.S. 1301, 1304 n.* (1976) (Rehnquist, J.) (in chambers). See, e.g., *Aaron v. Cooper*, 357 U.S. 566, 567 (1958) (the “power of the Court to [grant certiorari before judgment] has been exercised but rarely”). To obtain a writ of certiorari before judgment, the petitioner must make “a showing that the case is of such imperative public importance as to justify deviation from normal appellate practice and to require immediate determination in this Court.” Sup. Ct. R. 11. Petitioner has not made such a showing in this case.

a. Although the first question presented is important and warrants this Court’s review, there is no need for the Court to “deviat[e] from normal appellate practice” (Sup. Ct. R. 11) because the question is presented in the pending certiorari petition in *Tam*, *supra* (No. 15-1293). *Tam* is the appropriate vehicle for the Court to consider whether Section 1052(a)’s disparagement provision violates the First Amendment. As the government’s petition in *Tam* explains, the en banc Federal Circuit decided the First Amendment question on the merits, after full briefing and argument. Numerous amici curiae filed briefs in the court of appeals, and the judges on the en banc court issued five separate opinions.² *Tam* agrees that certiorari

² See *In re Tam*, 808 F.3d 1321, 1327-1358 (Fed. Cir. 2016) (en banc) (concluding that Section 1052(a) is an impermissible viewpoint-based restriction on speech), petition for cert. pending, No.

should be granted in his case. See Resp. Br. at 1, 10-13, *Tam*, *supra* (No. 15-1293). Because the Court already has before it a suitable vehicle for addressing the constitutionality of Section 1052(a)'s disparagement provision, there is no need to grant certiorari before judgment in this case.

b. Petitioner would suffer no prejudice by litigating this case in the court of appeals before seeking review (if necessary) in this Court. If this Court grants certiorari in *Tam*, petitioner can file a brief as amicus curiae setting forth its arguments on the First Amendment issue. If the Court upholds the Federal Circuit's decision, petitioner will receive the full benefit of that ruling. If this Court instead concludes, as the government has argued, that the disparagement provision of Section 1052(a) is not facially unconstitutional under the First Amendment, petitioner will be free to press its other constitutional and non-constitutional arguments.

If the Court denies the petition for a writ of certiorari in *Tam*, petitioner may litigate this case in the court of appeals and then (if necessary) seek review in

15-1293 (filed Apr. 20, 2016); *id.* at 1358-1363 (O'Malley, J., concurring) (concluding that Section 1052(a)'s disparagement provision is facially unconstitutional under the First Amendment and impermissibly vague); *id.* at 1363-1374 (Dyk, J., concurring in part and dissenting in part) (concluding that Section 1052(a) is facially constitutional because registration is a government benefit that reasonably may be denied to disparaging marks, but finding the statute unconstitutional as applied); *id.* at 1374-1376 (Lourie, J., dissenting) (concluding that Section 1052(a) is constitutional because it does not prohibit any speech but instead denies the benefits of registration to certain speech); *id.* at 1376-1382 (Reyna, J., dissenting) (concluding that Section 1052(a)'s disparagement provision is a permissible regulation of commercial speech).

this Court of any adverse Fourth Circuit rulings. And because the PTO has stayed the cancellation of petitioner's registrations until all appellate proceedings (including any review by this Court) have concluded, see PTO Statement on *Blackhorse* Cancellation, petitioner will suffer no prejudice during the pendency of its Fourth Circuit appeal. Petitioner evidently does not believe that time is of the essence, since it did not seek expedition in the Fourth Circuit, and it filed its petition for certiorari before judgment more than four months after the Federal Circuit's en banc decision in *Tam* and more than eight months after filing its notice of appeal.

c. Petitioner has raised a variety of non-constitutional arguments that, if accepted by the court of appeals, would obviate the need to consider the First Amendment issue (and other constitutional issues) in this case. Thus, petitioner has argued that Section 1052(a) does not apply here because, on the record in this case, none of its marks was disparaging to a substantial composite of Native Americans at the time they were originally registered. Pet. C.A. Br. 51-62; Pet. C.A. Reply Br. 25-31. Petitioner also contends that the district court used the wrong legal standard to determine whether a mark is "disparag[ing]" within the meaning of Section 1052(a), Pet. C.A. Br. 45-51, and that Section 1052(a) does not apply to disparagement of groups, such as Native Americans, but only to disparagement of particular individuals, *id.* at 46-48.³ Petitioner further contends that

³ Petitioner did not present that argument to the Board or the district court but instead raised it for the first time in the court of appeals. See Pet. C.A. Br. 46 (acknowledging that it did not present argument to district court); Pet. 25 (same). Indeed, petitioner

the equitable doctrine of laches bars the individual respondents' cancellation petition. *Id.* at 62-64. If the court of appeals accepts any of these arguments, or agrees with petitioner on its vagueness argument or case-specific due process claim, it will not need to decide the First Amendment issue.

Throughout this litigation, petitioner has urged the courts below to avoid addressing the First Amendment issue by deciding this case on statutory or laches grounds. In the district court, petitioner invoked the doctrine of constitutional avoidance and explained that the court “need not even address” the constitutional claims if it determined that petitioner’s marks were not “disparaging” within the meaning of Section 1052(a), C.A. App. 117, or if it concluded that the cancellation petition is barred by laches, *id.* at 42 n.6. In the court of appeals, petitioner has urged the court to avoid the First Amendment issue by deciding the case on a newly asserted statutory ground (that Section 1052(a) does not apply to disparagement of groups). See Pet. C.A. Reply Br. 21 (contending that “[c]onstitutional avoidance requires the[] [court of appeals] to decide whether § [1052(a)] applies to groups, regardless of waiver”); Pet. C.A. Br. 46.⁴

expressly stipulated in the district court to the legal test that it now challenges. See C.A. App. 2118 (petitioner’s summary-judgment brief).

⁴ Petitioner states that “Tam has never made the argument” that Section 1052(a) applies only to marks that disparage individuals. Pet. 25. That statement was accurate when the petition in this case was filed. Since that time, however, Tam has filed his response to the government’s petition for certiorari. In that response, Tam argues that “the statutory phrase ‘persons, living or dead’ [in Section 1052(a)] refers solely to natural and juristic persons, not to non-juristic collective entities like racial or ethnic

Petitioner’s constitutional-avoidance arguments are for the most part consistent with this Court’s long-standing reluctance “to decide any constitutional question in advance of the necessity for its decision,” *Clinton v. Jones*, 520 U.S. 681, 690 n.11 (1997) (citations omitted), but they highlight the unsuitability of this case for the extraordinary step of granting certiorari before judgment. That is particularly true of petitioner’s contention (Pet. 24-25) that Section 1052(a) applies only to marks that disparage individuals, an argument that petitioner did not make in the district court (see Pet. 25) and that accordingly has not been addressed by either of the courts below. See *Cutter v. Wilkinson*, 544 U.S. 709, 718 n.7 (2005) (“[W]e are a court of review, not of first view.”).⁵

groups.” Resp. Br. at 14, *Tam*, *supra* (No. 15-1293); see *id.* at 17-21. If this Court grants certiorari in *Tam* and agrees with petitioner’s view that principles of constitutional avoidance supersede usual rules of waiver and forfeiture, it can consider that statutory argument as a possible alternative ground for affirmance in *Tam*.

⁵ In any event, petitioner’s statutory argument is wrong: Section 1052(a) refers to a mark that disparages “persons,” 15 U.S.C. 1052(a), and Native Americans are “persons.” The Board has held that “persons” includes an ethnic group, see *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 2010 WL 766488, at *2-*3 (T.T.A.B. 2010), and that reasonable construction of the statute is entitled to deference, see *Chevron U.S.A. Inc. v. NRDC*, 467 U.S. 837, 843-844 (1984). That construction makes particular sense in the context of the disparagement clause as a whole, which refers to disparagement of “persons, living or dead, institutions, beliefs or national symbols,” 15 U.S.C. 1052(a); Congress’s inclusion of “institutions,” “beliefs,” and “national symbols” makes clear that the provision is not limited to individual persons. Indeed, if Congress had intended the disparagement clause only to reach particular individuals, it would have said so, as it did in Section 1052(c). See 15 U.S.C. 1052(c) (prohibiting registration of a mark that consists of “a

d. None of petitioner’s arguments justifies the extraordinary step of granting certiorari before judgment.

Petitioner contends (Pet. 10) that certiorari before judgment is warranted because this case is an “essential companion” to *Tam*. But the fact that the two cases raise the same First Amendment issue does not justify immediate review in this case. Because the Court generally exercises its certiorari jurisdiction to consider recurring questions of prospective significance, see Sup. Ct. R. 10(a), a question this Court chooses to review often is simultaneously presented in other pending cases. Even when two (or more) circuits have actually decided the same issue, the Court’s usual practice is to grant plenary review in only one case and then hold other petitions raising the issue to be governed by the rule established in the granted case. Because the Fourth Circuit has not yet issued a decision in this case, the appropriate course is not to hold the petition for certiorari before judgment but to deny it, thereby allowing petitioner’s appeal to proceed in the usual course without impairing petitioner’s ability to benefit from any favorable ruling the Court might issue in *Tam*.

Contrary to petitioner’s contention (Pet. 13-16), the fact that this case involves cancellation of a previously registered trademark (rather than an initial refusal to register) does not justify reviewing this case along with *Tam*. The First Amendment issue common to the two cases is a facial challenge to an Act of Congress, and resolution of that issue does not depend on the particular factual circumstances of a given case.

name, portrait, or signature identifying a *particular living individual*” (emphasis added)).

The statutory analysis is the same in both the cancellation and initial registration contexts because cancellation of a trademark registration under Section 1052(a) is permissible only if the mark was erroneously registered (*e.g.*, was disparaging) at the time of its original registration. See 15 U.S.C. 1064.

Contrary to petitioner's suggestion (Pet. 14), the government's interest in dissociating itself from disparaging marks is as strong in the cancellation context as in the initial registration context. And Congress's decision to authorize cancellation only of marks that were disparaging when issued reflects a reasonable and constitutionally permissible effort to avoid disrupting settled expectations. In any event, petitioner's argument that cancellation of a previously registered trademark raises distinct constitutional concerns should be presented in the first instance to the court of appeals.

Petitioner notes (Pet. 11-13) that, on a handful of occasions, this Court has granted certiorari before judgment in order to review a case as a companion to another case. Petitioner cites just two examples from the past 50 years, and those cases involved factors that are not present here. For example, as a companion to *United States v. Booker*, 543 U.S. 220 (2005) (No. 04-404), this Court granted certiorari before judgment in *United States v. Fanfan*, 542 U.S. 956 (2004) (No. 04-105), to consider two questions about the constitutionality of the United States Sentencing Guidelines. The Acting Solicitor General urged the Court to grant certiorari before judgment in *Fanfan* so that the Court would have a decision to review on the second question (severability); the court of appeals in *Booker* had remanded on that issue rather than

deciding it on the merits. Pet. at 8, *Fanfan, supra* (No. 04-105). The government sought to “protect against any possibility that later impediments to review in one or the other case might prevent timely resolution” of the second question because “thousands—or even tens of thousands—of criminal sentences” would be affected by the Court’s decision. *Id.* at 8-10. No similar exigency exists here.

In *Gratz v. Bollinger*, 539 U.S. 244 (2003) (No. 02-516), the Court granted certiorari before judgment to consider the case in tandem with *Grutter v. Bollinger*, 539 U.S. 306 (2003) (No. 02-241), where the two cases had been argued to the en banc Sixth Circuit on the same day and had overlapping parties, and where resolution of the constitutional question depended on the particular features of university admission policies, making it important to have “a broader spectrum [of features] and more substantial record” to decide the issues. Pet. at 14-16, *Gratz, supra* (No. 02-516). In this case, by contrast, the two cases are distinct; resolution of the First Amendment issue does not depend on particular facts; and it may be unnecessary to decide the First Amendment issue at all in this case. Many decades ago, the Court somewhat more frequently granted certiorari before judgment in cases that presented the same legal question as an already-granted case. See Stephen M. Shapiro et al., *Supreme Court Practice* § 4.20, at 288 (10th ed. 2013) (collecting examples). But in recent years, the Court has utilized this practice much less frequently, and for good reason: it preempts the work of the courts of appeals and expends this Court’s limited resources on duplicative issues whose resolution might have proved

unnecessary if the usual appellate process had been allowed to run its course.

Finally, petitioner argues (Pet. 25-31) that it is better situated than Tam to litigate the First Amendment issue. But Tam litigated his case through the court of appeals, and the five opinions issued by the judges of the Federal Circuit express a wide range of views and demonstrate that the question presented in the government's certiorari petition in *Tam* was fully aired before that court. If this Court grants that petition, petitioner can supplement Tam's arguments by filing an amicus brief in support of Tam (as it did at the en banc and certiorari stages in *Tam*). Petitioner's confidence in its own attorneys' litigation skills provides no reason to take the extraordinary step of granting certiorari before judgment.

2. Certiorari before judgment likewise is not warranted with respect to the second and third questions presented.

a. Petitioner's claim that Section 1052(a) is unconstitutionally vague does not warrant certiorari before judgment. No court of appeals has held that Section 1052(a)'s disparagement clause is impermissibly vague. Section 1052(a) does not prohibit speech or impose any civil or criminal penalties, but simply precludes the federal government from providing a certain type of assistance to marks that are disparaging. See Pet. App. 13a-16a; see also *id.* at 18a ("cancellations do not burden, restrict, or prohibit [petitioner]'s ability to use the marks").

When a statute neither prohibits nor penalizes speech, but simply confers benefits on speakers whose expression satisfies certain criteria, the vagueness standard is relaxed because there is less concern

about chilling speech. See *National Endowment for the Arts v. Finley*, 524 U.S. 569, 588-589 (1998). Under that relaxed standard, the Court has upheld even criteria that are “undeniably opaque” because “in the context of selective subsidies,” “the consequences of imprecision are not constitutionally severe.” *Ibid.* Denial or cancellation of a trademark registration does not trigger civil or criminal penalties, and mark owners are free to use and enforce their marks (as petitioner did from 1933 to 1967) even if the marks are unregistered or unregistrable.

The term “disparage” in Section 1052(a) has been given a settled legal meaning, applying to any mark that “slight[s], deprecate[s], degrade[s], or affect[s] or injure[s] by unjust comparison.” *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) (citations omitted; brackets in original), cert. denied, 135 S. Ct. 944 (2015). In applying that standard to determine whether particular marks are registrable, the PTO does not allow its examiners to rely on their own subjective views, but rather directs them to consider whether record evidence establishes that a “substantial composite of the referenced group” would find the mark disparaging. *Ibid.* Because the agency uses an objective, established test for disparagement, the contours of which have been explored and elaborated in published administrative and judicial decisions, the public has fair notice as to the standards for, and evidence relevant to, determining which marks are unregistrable.

Petitioner also contends (Pet. 18) that Section 1052(a) is arbitrarily enforced, citing instances in which superficially similar marks were treated differently during registration. But analysis of whether a mark is disparaging requires consideration of the

mark’s meaning in relation to the particular goods and services for which registration is sought and the context in which the mark is used. See *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003). For example, if the PTO approved use of the term “redskin” on a mark also bearing an image of red-skinned potatoes, its decision would not be logically inconsistent with its determination that the marks at issue here are disparaging.

In any event, the PTO examines more than 300,000 trademark applications each year. If an individual employee improperly allows a mark to be registered or improperly refuses registration, “such errors do not bind the USPTO to improperly register” or refuse similar marks in the future. *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1174 (Fed. Cir. 2009), cert. denied, 558 U.S. 1149 (2010). Indeed, the statutory provision permitting cancellation “[a]t any time” (15 U.S.C. 1064) reflects Congress’s recognition that registration errors occasionally occur.

b. Petitioner’s claim that cancellation of its marks violated its due process rights likewise does not warrant certiorari before judgment.⁶ That challenge

⁶ Petitioner suggests that the focus on disparagement as of the time of initial registration reflects a PTO policy choice. See, e.g., Pet. 15 (stating that “it is beyond the pale for the PTO to register a mark * * * but reserve the right to reverse course and cancel the registration at any time”). The Lanham Act, however, defines the circumstances under which cancellation petitions may be filed. The Act authorizes the filing of such a petition more than five years after a trademark was registered if, *inter alia*, the mark’s “registration was obtained * * * contrary to the provisions of * * * subsection (a) * * * of section 1052 of this title.” 15 U.S.C. 1064(3). That language unambiguously focuses the inquiry on whether the mark was disparaging (or otherwise unregistrable

raises no legal issue of general importance, but instead is a fact-specific claim premised on the length of time that elapsed between the registration of the marks at issue and the Board's cancellation decision. Petitioner does not identify any court of appeals decision that has addressed a due process challenge under similar circumstances. Indeed, petitioner told the Fourth Circuit that the circumstances of the cancellation in this case are unique. Pet. C.A. Br. 2.

Petitioner cites (Pet. 22) two decisions, one from 1939 and one from 1978, but neither involved a due process challenge based on the length of time that had elapsed between registration and cancellation. In *J.C. Eno (U.S.) Ltd. v. Coe*, 106 F.2d 858 (D.C. Cir. 1939), the court of appeals held that a lawsuit seeking cancellation could not proceed if the owner of the mark was not a party. *Id.* at 860. No analogous issue is presented here, since petitioner was a party to the Board proceeding and instituted the district-court lawsuit. *P. A. B. Produits et Appareils de Beaute v. Satinine Societa in Nome Collettivo di S.A. e. M. Usellini*, 570 F.2d 328 (C.C.P.A 1978), is similarly inapposite. The court in that case held that, when a cancellation petition alleged abandonment on the ground that the mark had not been used for two years immediately before the filing of the petition, the petitioner could not meet its burden of proving non-use by relying on time *after* the petition was filed. *Id.* at 332-334. This case does not concern cancellation based on non-use.

In any event, petitioner's due process argument lacks merit. The Lanham Act provides (and has provided since the initial registration of petitioner's

under Section 1052(a)) when "registration was obtained," *i.e.*, at the time of initial registration.

marks) that federal registration was subject to cancellation “[a]t any time” if the mark was originally registered in error. 15 U.S.C. 1064(3); see Lanham Act, Tit. I, § 14(c), 60 Stat. 433. Because petitioner was on notice that its registrations could be cancelled, it cannot claim unfair surprise from the Board’s reexamination of the propriety of its initial trademark registrations. Any property interest implicated by cancellation is further limited because the mark owner may still use the marks to identify its goods and retains its common-law rights.

Petitioner contends (Pet. 21) that it has been deprived of the right to a hearing at a “meaningful time,” but the decision it cites recognized that due process concerns are substantially relaxed where there has been no pre-hearing deprivation of liberty or property. See *United States v. Eight Thousand Eight Hundred & Fifty Dollars (\$8,850) in U.S. Currency*, 461 U.S. 555, 563-564 (1983). Here, petitioner has been afforded not just one pre-deprivation hearing, but several. Petitioner participated in a full evidentiary hearing before the Board, where the individual respondents bore the burden of proof. See 15 U.S.C. 1067; 37 C.F.R. 2.111-2.136. Pursuant to 15 U.S.C. 1071(b), petitioner then filed suit in federal district court to challenge the Board’s decision, and petitioner subsequently appealed to the Fourth Circuit. Although petitioner lost before the Board and the district court, the cancellations will not take effect until all judicial review has been completed. See PTO Statement on *Blackhorse* Cancellation. Petitioner therefore has received, and will receive, ample process before its registrations are cancelled.

CONCLUSION

The petition for a writ of certiorari before judgment should be denied.

Respectfully submitted.

IAN HEATH GERSHENGORN
Acting Solicitor General
BENJAMIN C. MIZER
*Principal Deputy Assistant
Attorney General*
DOUGLAS N. LETTER
MARK R. FREEMAN
DANIEL TENNY
JOSHUA M. SALZMAN
Attorneys

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