

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; COURTNEY TSOTIGH,

Defendants-Appellees,

UNITED STATES OF AMERICA,

Intervenor-Appellee.

On Appeal from the United States District Court
for the Eastern District of Virginia

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TABLE OF CONTENTS

| | <u>Page(s)</u> |
|---|----------------|
| INTRODUCTION | 1 |
| STATEMENT OF THE ISSUES..... | 3 |
| STATEMENT OF THE CASE..... | 3 |
| A. The Origins of Trademark Protection..... | 3 |
| 1. Common Law and Early Statutes..... | 3 |
| 2. The Lanham Act | 5 |
| B. Cancellation Procedures..... | 9 |
| C. Facts and Prior Proceedings..... | 10 |
| 1. Prior Proceedings | 10 |
| 2. District Court Proceedings | 11 |
| SUMMARY OF ARGUMENT..... | 15 |
| STANDARD OF REVIEW | 16 |
| ARGUMENT | 17 |
| I. The First Amendment does not compel the government to offer federal registration for disparaging trademarks..... | 17 |
| A. The Lanham Act does not restrict Pro-Football’s ability to express any message | 18 |
| B. Pro-Football has no First Amendment right to government assistance in enforcing its disparaging marks | 22 |
| 1. Congress has broad authority to define eligibility criteria for a federal program..... | 22 |

- 2. Limitations on trademark registration do not impermissibly distort the marketplace of ideas28
- 3. Ineligibility for federal registration is not a “burden” on speech.....32
- 4. The “unconstitutional conditions” doctrine does not apply here34
- C. The United States has a legitimate interest in limiting federal trademark registration to marks that are not disparaging.....36
- II. Pro-Football’s claims premised on the Due Process Clause are without merit43
 - A. Section 2(a) is not unconstitutionally vague43
 - B. The passage of time did not render cancellation unconstitutional.....48
- III. Pro-Football’s objections to the USPTO’s constructions of the Lanham Act should be rejected50
 - A. Section 2(a)’s disparagement provision applies to racial groups and does not require evidence from particular individuals50
 - B. The USPTO appropriately addresses disparagement from the views of a substantial composite, which is not necessarily a majority, of the referenced group.....52
- CONCLUSION55
- CERTIFICATE OF SERVICE
- CERTIFICATE OF COMPLIANCE

TABLE OF AUTHORITIES

| Cases: | <u>Page(s)</u> |
|--|-----------------------|
| <i>Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.</i> , 133 S. Ct. 2321 (2013)..... | 16, 34 |
| <i>Almy v. Sebelius</i> , 679 F.3d 297 (4th Cir. 2012)..... | 46, 47 |
| <i>American Freedom Def. Initiative v. Massachusetts Bay Transp. Auth.</i> , 781 F.3d 571 (1st Cir. 2015), <i>cert. denied</i> , 2016 WL 100366 (U.S. Jan. 11, 2016) | 40, 41 |
| <i>Bates v. State Bar</i> , 433 U.S. 350 (1977)..... | 31 |
| <i>Blackhorse v. Pro-Football, Inc.</i> , 111 U.S.P.Q.2d 1080, 2014 WL 2757516 (T.T.A.B. 2014)..... | 10, 11 |
| <i>Bolger v. Youngs Drug Prods. Corp.</i> , 463 U.S. 60 (1983)..... | 37 |
| <i>Broadrick v. Oklahoma</i> , 413 U.S. 601 (1973)..... | 16, 17 |
| <i>Brown v. Town of Cary</i> , 706 F.3d 294 (4th Cir. 2013), <i>abrogated on other grounds by</i> <i>Reed v. Town of Gilbert</i> , 135 S. Ct. 2218 (2015)..... | 45 |
| <i>Central Hudson Gas & Electric Corp. v. Public Service Commission</i> , 447 U.S. 557 (1980)..... | 42, 43 |
| <i>Chevron U.S.A. Inc. v. Natural Res. Def. Council, Inc.</i> , 467 U.S. 837 (1984)..... | 51 |
| <i>City of Lakewood v. Plain Dealer Publ’g Co.</i> , 486 U.S. 750 (1988)..... | 44 |
| <i>Cold War Museum, Inc. v. Cold War Air Museum, Inc.</i> , 586 F.3d 1352 (Fed. Cir. 2009)..... | 47 |
| <i>Davenport v. Washington Education Association</i> , 551 U.S. 177 (2007)..... | 24, 26 |

| | |
|---|----------------|
| <i>Eldred v. Ashcroft</i> , 537 U.S. 186 (2003)..... | 30 |
| <i>Ex parte Summit Brass and Bronze Works, Inc.</i> , 59 U.S.P.Q. 22, 1943 WL 8300 (Dec. Comm’r Pat. 1943)..... | 5 |
| <i>FCC v. Fox Television Stations, Inc.</i> , 132 S. Ct. 2307 (2012)..... | 43 |
| <i>Forsyth Cty. v. Nationalist Movement</i> , 505 U.S. 123 (1992)..... | 32 |
| <i>Friedman v. Rogers</i> , 440 U.S. 1 (1979)..... | 21 |
| <i>Grayned v. City of Rockford</i> , 408 U.S. 104 (1972)..... | 43 |
| <i>Harjo v. Pro-Football, Inc.</i> , 50 U.S.P.Q.2d 1705, 1999 WL 375907 (T.T.A.B. 1999), <i>rev’d</i> , 284 F. Supp. 2d 96 (D.D.C. 2003), <i>remanded on other grounds</i> , 415 F.3d 44 (D.C. Cir. 2005)..... | 49, 53 |
| <i>Harris v. McRae</i> , 448 U.S. 297 (1980)..... | 23 |
| <i>In re Boulevard Entm’t</i> , 334 F.3d 1336 (Fed. Cir. 2003)..... | 46 |
| <i>In re Dr Pepper Co.</i> , 836 F.2d 508 (Fed. Cir. 1987)..... | 51 |
| <i>In re Geller</i> , 751 F.3d 1355 (Fed. Cir. 2014), <i>cert. denied sub nom.</i> <i>Geller v. Patent & Trademark Office</i> , 135 S. Ct. 944 (2015)..... | 8, 44, 45 |
| <i>In re Heeb Media LLC</i> , 89 U.S.P.Q.2d 1071, 2008 WL 5065114 (T.T.A.B. 2008)..... | 8, 41 |
| <i>In re International Flavors & Fragrances, Inc.</i> , 183 F.3d 1361 (Fed. Cir. 1999)..... | 13, 14, 20, 48 |
| <i>In re Lebanese Arak Corp.</i> , 94 U.S.P.Q.2d 1215, 2010 WL 766488 (T.T.A.B. 2010)..... | 51 |

| | |
|--|--|
| <i>In re Loew's Theatres, Inc.</i> , 769 F.2d 764 (Fed. Cir. 1985) | 54 |
| <i>In re Mavety Media Group Ltd.</i> , 33 F.3d 1367 (Fed. Cir. 1994) | 8, 45, 47 |
| <i>In re McGinley</i> , 660 F.2d 481 (C.C.P.A. 1981), <i>abrogated on other grounds by</i> <i>In re Tam</i> , 808 F.3d 1321 (Fed. Cir. 2015) | 52, 53 |
| <i>In re Old Glory Condom Corp.</i> , 26 U.S.P.Q.2d 1216, 1993 WL 114384 (T.T.A.B. 1993) | 39, 46 |
| <i>In re Pacer Tech.</i> , 338 F.3d 1348 (Fed. Cir. 2003) | 53, 54 |
| <i>In re Riverbank Canning Co.</i> , 95 F.2d 327 (C.C.P.A. 1938) | 5 |
| <i>In re Shinnecock Smoke Shop</i> , 571 F.3d 1171 (Fed. Cir. 2009) | 46 |
| <i>In re Tam</i> , 808 F.3d 1321 (Fed. Cir. 2015) | 19, 25, 26, 27, 28, 30, 34, 36, 37, 41, 46 |
| <i>In re Trade-Mark Cases</i> , 100 U.S. 82 (1879) | 4 |
| <i>Legal Services Corp. v. Velazquez</i> , 531 U.S. 533 (2001) | 31 |
| <i>Maher v. Roe</i> , 432 U.S. 464 (1977) | 23 |
| <i>Mathews v. Eldridge</i> , 424 U.S. 319 (1976) | 48, 49 |
| <i>Minneapolis Star & Tribune Co. v. Minnesota Comm'r of Revenue</i> , 460 U.S. 575 (1983) | 32, 33 |
| <i>Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.</i> , 316 U.S. 203 (1942) | 21 |

| | |
|---|------------------------|
| <i>Multi-Channel TV Cable Co. v. Charlottesville Quality Cable Corp.</i> , 65 F.3d 1113 (4th Cir. 1995)..... | 16 |
| <i>National Endowment for the Arts v. Finley</i> , 524 U.S. 569 (1998)..... | 43, 44 |
| <i>Obergefell v. Hodges</i> , 135 S. Ct. 2584 (2015)..... | 45 |
| <i>Ohio State Conference of NAACP v. Husted</i> , 768 F.3d 524 (6th Cir. 2014), <i>vacated</i> , No. 14-3877, 2014 WL 10384647 (6th Cir. Oct. 1, 2014)..... | 50 |
| <i>Park N Fly, Inc. v. Dollar Park & Fly, Inc.</i> , 469 U.S. 189 (1985)..... | 6, 33 |
| <i>Perini Corp. v. Perini Constr., Inc.</i> , 915 F.2d 121 (4th Cir.1990)..... | 53 |
| <i>Perry v. McDonald</i> , 280 F.3d 159 (2d Cir. 2001)..... | 40 |
| <i>Pitt News v. Pappert</i> , 379 F.3d 96 (3d Cir. 2004)..... | 33 |
| <i>Pleasant Grove City v. Summum</i> , 555 U.S. 460 (2009)..... | 27 |
| <i>R.A.V. v. City of St. Paul</i> , 505 U.S. 377 (1992)..... | 40 |
| <i>Regan v. Taxation With Representation of Wash.</i> , 461 U.S. 540 (1983)..... | 12, 16, 22, 23, 24, 25 |
| <i>Retail Servs. Inc. v. Freebies Publ'g</i> , 364 F.3d 535 (4th Cir. 2004)..... | 6 |
| <i>Ridley v. Massachusetts Bay Transp. Auth.</i> , 390 F.3d 65 (1st Cir. 2004)..... | 41 |
| <i>Rosenberger v. Rector & Visitors of the Univ. of Va.</i> , 515 U.S. 819 (1995)..... | 28, 29 |

| | |
|--|--------------------------------|
| <i>Rust v. Sullivan</i> , 500 U.S. 173 (1991)..... | 12, 23, 24, 28, 29, 34, 35, 36 |
| <i>Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.</i> , 502 U.S. 105 (1991)..... | 32 |
| <i>Sorrell v. IMS Health Inc.</i> , 131 S. Ct. 2653 (2011)..... | 32 |
| <i>Swatch AG v. Beehive Wholesale, LLC</i> , 739 F.3d 150 (4th Cir. 2014)..... | 9 |
| <i>Taylor v. Carpenter</i> , 23 F. Cas. 742 (D. Mass. 1844)..... | 3 |
| <i>Thomson v. Winchester</i> , 36 Mass. (19 Pick.) 214 (1837)..... | 3 |
| <i>Town of Greece v. Galloway</i> , 134 S. Ct. 1811 (2014)..... | 45 |
| <i>Two Pesos, Inc. v. Taco Cabana, Inc.</i> , 505 U.S. 763 (1992)..... | 19 |
| <i>United States v. Eight Thousand Eight Hundred & Fifty Dollars (\$8850) in U.S. Currency</i> , 461 U.S. 555 (1983) | 49 |
| <i>United States v. American Library Ass'n</i> , 539 U.S. 194 (2003)..... | 31 |
| <i>United States v. Stevens</i> , 559 U.S. 460 (2010)..... | 17 |
| <i>United States v. Williams</i> , 553 U.S. 285 (2008)..... | 44 |
| <i>Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.</i> , 455 U.S. 489 (1982)..... | 43 |
| <i>Walker v. Texas Div., Sons of Confederate Veterans, Inc.</i> , 135 S. Ct. 2239 (2015)..... | 27, 37, 38 |
| <i>Washington State Grange v. Washington State Republican Party</i> , 552 U.S. 442 (2008)..... | 17 |

Williams-Yulee v. Florida Bar,
135 S. Ct. 1656 (2015)..... 41, 42

Wilson v. Mitchell,
250 F.3d 388 (6th Cir. 2001).....48

Ysursa v. Pocatello Education Association,
555 U.S. 353 (2009)..... 24, 28

Treaty:

Paris Convention for the Protection of Industrial Property,
July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 7, 39

Statutes:

Act of Feb. 20, 1905 (1905 Trademark Act), ch. 592, 33 Stat. 724 4, 5

Act of July 5, 1946 (Lanham Act), ch. 540, 60 Stat. 4275

Lanham Act, 15 U.S.C. § 1051 *et seq.*:

15 U.S.C. § 1052.....7

15 U.S.C. § 1052(a)3, 8, 35, 40, 50, 52

15 U.S.C. § 1052(b).....8

15 U.S.C. § 1052(c) 8, 51

15 U.S.C. § 1057(a)5

15 U.S.C. § 1057(b).....6

15 U.S.C. § 1064.....9

15 U.S.C. § 1064(3)..... 10, 53, 54

15 U.S.C. § 1065.....6

15 U.S.C. § 1067.....49

| | |
|--|-----------|
| 15 U.S.C. § 1071(a)..... | 9 |
| 15 U.S.C. § 1071(b)..... | 9, 11, 49 |
| 15 U.S.C. § 1071(b)(2)..... | 9 |
| 15 U.S.C. § 1072..... | 6 |
| 15 U.S.C. § 1091..... | 5 |
| 15 U.S.C. § 1111..... | 6 |
| 15 U.S.C. § 1115(b)..... | 6 |
| 15 U.S.C. § 1117..... | 7 |
| 15 U.S.C. § 1117(a)..... | 19 |
| 15 U.S.C. § 1124..... | 7 |
| 15 U.S.C. § 1125(a)..... | 7, 12 |
| 15 U.S.C. § 1125(a)(1)..... | 19 |
| 15 U.S.C. § 1125(b)..... | 19 |
| 15 U.S.C. § 1125(c)(5)..... | 7, 19 |
| 15 U.S.C. § 1125(c)(6)..... | 6 |
| 15 U.S.C. § 1125(d)..... | 7, 19 |
| 15 U.S.C. § 1127..... | 51 |
| 15 U.S.C. § 1141b..... | 7, 39 |
| Pub. L. 79-489, 60 Stat. 427 (1946)..... | 10 |
| 28 U.S.C. § 2403(a)..... | 11 |
| 35 U.S.C. § 42(c)(1)..... | 27 |
| 35 U.S.C. § 42(c)(2)..... | 27 |
| Tex. Transp. Code Ann. § 504.801(c)..... | 37 |

Regulation:

37 C.F.R. §§ 2.111-2.13649

Legislative Material:

*Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the
H. Comm. on Patents, 76th Cong. (1939)*.....52

Other Authorities:

Jasmine Abdel-khalik, *To Live in in-“Fame”-y: Reconceiving Scandalous Marks
As Analogous to Famous Marks*, 25 *Cardozo Arts & Ent. L.J.* 173 (2007)6

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(4th ed. 2015)53

INTRODUCTION

Plaintiff-Appellant Pro-Football, Inc., presents an unusual First Amendment argument in this case. It does not identify any message that the Lanham Act prevents it from expressing, or indeed any restriction on its speech at all. Instead, Pro-Football asserts that if Congress wished to create a federal trademark registration program to facilitate the enforcement of any trademarks, it was constitutionally compelled to extend that program to include any term or image—including racial epithets—that could be used to identify products or services.

Pro-Football's argument rests on a fundamental misunderstanding of the nature of trademarks and role of federal trademark registration. Trademarks identify the source of goods or services in commerce. Trademark law, in turn, prohibits commercial actors from misappropriating the goodwill associated with a mark by using an identical or similar mark to confuse or mislead consumers.

Federal law does not create trademarks or trademark rights. Trademarks arise under the common law, without regard to congressional action, and may be protected in court against misappropriation by others without need for federal registration. Indeed, Pro-Football used versions of the marks at issue here to designate its services in commerce for more than thirty years prior to seeking federal registration.

Since 1905, however, Congress has offered an optional program of federal trademark registration to facilitate the enforcement of qualifying marks in interstate commerce. Federally registered marks are examined for eligibility by an expert federal

agency; issued certificates in the name of the United States; published in the Principal Register of the United States; accepted as valid by federal agencies for purposes of federal law enforcement; and afforded the benefit of certain presumptions in federal infringement litigation. In these and other ways, Congress intended federal registration to facilitate and encourage the enforcement of qualifying marks.

From the beginning, however, Congress has declined to extend these supplemental federal benefits to every conceivable mark. Section 2(a) of the Lanham Act excludes from federal registration certain categories of marks whose enforcement Congress has not impeded, but has simply chosen not to facilitate in the same manner. That choice is well within Congress's discretion. The First Amendment limits Congress's ability to restrict the expression of ideas, including the use of racial epithets. But nothing in the Constitution compels Congress to open the Principal Register of the United States to racial slurs—or religious insults, ethnic caricatures, or other disparaging terms or logos—and thereby adopt such marks as affirmative instruments of federal law.

The district court thus correctly rejected Pro-Football's First Amendment argument. Pro-Football is free to mark its stadium and team uniforms with a racially disparaging term, and to encourage consumers to associate that term with its entertainment services, if it wishes. But Congress is not required to assist it in that effort.

STATEMENT OF THE ISSUES

Congress provided that trademarks that “may disparage . . . persons, living or dead,” shall not be eligible for federal registration. 15 U.S.C. § 1052(a). This brief addresses (1) whether that congressional judgment violates the First Amendment or the Fifth Amendment, and (2) whether the U.S. Patent and Trademark Office (USPTO) acted arbitrarily or capriciously in construing the statute to encompass racial slurs that a substantial composite, though not necessarily a majority, of the referenced racial group regards as disparaging.

STATEMENT OF THE CASE

A. The Origins of Trademark Protection

1. Common Law and Early Statutes

Trademarks are a creation of the common law and long predate any congressional efforts to facilitate the enforcement of such marks in interstate commerce. From the early days of the Republic, even in the absence of any registration scheme, state and federal courts recognized actions against merchants who misled or confused consumers about the source of their commercial goods and services, and thus misappropriated the goodwill of other merchants. *See, e.g., Thomson v. Winchester*, 36 Mass. (19 Pick.) 214 (1837); *Taylor v. Carpenter*, 23 F. Cas. 742 (D. Mass. 1844). In 1844, Justice Story described the basic principles of trademark infringement as “very familiar to the profession,” and “not . . . susceptible of any judicial doubt.” *Taylor*, 23 F. Cas. at 744.

Congress began legislating in this area in the late nineteenth century. Congress enacted a nationwide system of federal trademark registration in 1870, which was invalidated as beyond Congress's enumerated powers because it reached the intrastate use of trademarks. *See In re Trade-Mark Cases*, 100 U.S. 82 (1879). The Supreme Court recognized, however, that “[t]he right to adopt and use a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is . . . has been long recognized by the common law.” *Id.* at 92. This “exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement.” *Id.*

In February 1905, Congress enacted the 1905 Trademark Act, adding federal trademark registration to existing common-law and state protections. Act of Feb. 20, 1905, ch. 592, 33 Stat. 724. The 1905 Trademark Act explained that a federal trademark application, once examined, would receive a certificate of registration “issued in the name of the United States of America, under the seal of the Patent Office” and recorded in the Patent Office. *Id.* § 11, 33 Stat. at 727.

But Congress provided that certain types of marks could not be federally registered, “on account of [their] nature.” 1905 Trademark Act, § 5, 33 Stat. at 725. Marks ineligible for registration included those likely to deceive purchasers; those “consist[ing] of or compris[ing] the flag or coat of arms or other insignia of the United States, . . . or of any State or municipality, or of any foreign nation”; and those consisting of the portrait of a living individual, without the person's consent. *Id.*

§ 5(b), 33 Stat. at 725. Also prohibited from registration were marks “[c]onsist[ing] of or compris[ing] immoral or scandalous matter.” *Id.* § 5(a), 33 Stat. at 725. Although the 1905 Trademark Act did not contain a provision specifically mentioning disparaging marks, the Patent Office refused federal registration for certain denigrating marks under the more general prohibition against “immoral” or “scandalous” marks. *See, e.g., In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938); *Ex parte Summit Brass and Bronze Works, Inc.*, 59 U.S.P.Q. 22, 1943 WL 8300 (Dec. Comm’r Pat. 1943).¹

2. The Lanham Act

In 1946, Congress enacted the Lanham Act, 15 U.S.C. § 1051 *et seq.*, which, with some changes, remains in force today. *See* Act of July 5, 1946, ch. 540, 60 Stat. 427. Like the 1905 Trademark Act, the Lanham Act provides that a federal registrant receives a certificate of registration “issued in the name of the United States of America, under the seal of the [USPTO].” 15 U.S.C. § 1057(a). Registered trademarks are recorded in the USPTO’s Principal Register, or, in certain circumstances not relevant here, in a Supplemental Register. *See id.* (Principal Register); *id.* § 1091 (Supplemental Register).

¹ The 1905 Trademark Act’s “scandalous registration prohibition had . . . roots in the pre-existing common law.” Jasmine Abdel-khalik, *To Live in in-“Fame”-y: Reconceiving Scandalous Marks As Analogous to Famous Marks*, 25 *Cardozo Arts & Ent. L.J.* 173, 195 (2007); *see* 3 William Henry Browne, *A Treatise on the Law of Trademarks* 465 (1873) (“To be a ‘lawful trade-mark,’ the emblem must not transgress the rules of morality or public policy.”).

Federal registration affords a trademark owner certain benefits. In enforcement proceedings, a federal trademark registration is prima facie evidence of the validity of the mark, the ownership of the mark, and the owner's exclusive right to use the mark in connection with the identified goods or services in commerce, though each of those things can be proven without registration. 15 U.S.C. § 1057(b).² Once the federal government has registered a mark, others cannot assert, under state law, that the use of that mark dilutes their own marks. *See id.* § 1125(c)(6).

Federal registration provides constructive nationwide notice of the registrant's claim of ownership of the mark. 15 U.S.C. § 1072. Constructive notice provides the registrant with what the Supreme Court has described as “a means . . . to quiet title in the ownership of his mark,” precluding certain (but not all) challenges to the mark unless they are brought within five years of registration. *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985); *see* 15 U.S.C. §§ 1065, 1115(b) (precluding certain challenges to the mark after five years). A federal registrant may give constructive notice that his mark is registered—and thus qualify for certain monetary remedies—by displaying with the mark either “Registered in U.S. Patent and Trademark Office,” or “Reg. U.S. Pat. & Tm. Off.,” or simply “®.” *Id.* § 1111.

Congress provided a cause of action for owners of federally registered marks to protect against confusion and, in the case of the use of counterfeit marks, provided

² This presumption is “neutralized” upon the adverse party's production of evidence in rebuttal. *See Retail Servs. Inc. v. Freebies Publ'g*, 364 F.3d 535, 542-43 (4th Cir. 2004).

for statutory damages. 15 U.S.C. § 1117. Congress further provided a mechanism for registrants to record their registrations with U.S. Customs and Border Protection as an additional line of defense against importation of goods bearing infringing marks beyond simply bringing an action for trademark infringement after importation. *Id.* § 1124. Additionally, various international agreements provide a simplified process for recognition and protection in overseas markets of marks that are registered in the United States. *See id.* § 1141b (Madrid Protocol); Paris Convention for the Protection of Industrial Property art. 6*quinquies*, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305.

Whether or not the aggrieved party has a federally registered trademark, however, the Lanham Act provides federal remedies for the false or misleading identification of the source of goods or services. For example, Congress created a cause of action in federal court, without regard to federal registration, for false or deceptive representations about the origin of goods or services that are likely to confuse consumers. 15 U.S.C. § 1125(a). Section 1125(a) is routinely used to enforce unregistered trademarks in federal court. The Lanham Act also provides, without regard to federal registration, a right to prevent cybersquatters from misappropriating internet domain names containing trademarks. *Id.* § 1125(d). And when an unregistered mark is famous, the owner is entitled to the same statutory damages applicable to federally registered marks. *Id.* § 1125(c)(5).

Like the 1905 Trademark Act, the Lanham Act prohibits federal registration—though not use—of certain types of marks. 15 U.S.C. § 1052. Among other things, it

prohibits registering flags or other official insignia; or the name, portrait, or signature of a particular living person without consent. *Id.* § 1052(b), (c). It also prohibits registration of scandalous marks. *Id.* § 1052(a).

This case concerns the Lanham Act's prohibition on the registration of marks consisting of or comprising "matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." 15 U.S.C. § 1052(a).

The USPTO and the Federal Circuit have applied a two-part test to determine whether a mark "may disparage." The test considers (1) the likely meaning of the matter in question; and (2) if that meaning is found to refer to identifiable persons (including groups of persons), institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group. *See In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014). What comprises a "substantial composite" of a referenced group is a question of fact, and a substantial composite need not necessarily be a majority of the group. *See, e.g., In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, at *5 (T.T.A.B. 2008); *cf. In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (discussing "substantial composite" in context of section 2(a)'s prohibition on scandalous matter).

B. Cancellation Procedures

The Lanham Act provides that a third party may at any time bring a petition to cancel registration of a mark that has been registered in violation of section 2(a). 15 U.S.C. § 1064. A trademark registration is subject to cancellation on these grounds only if it was ineligible for registration at the time that it was registered. *See id.* Thus, a registration may be cancelled on the ground that a mark is disparaging only if it was disparaging to a substantial composite of the referenced group at the time of its original registration.

A cancellation petition is heard by the Trademark Trial and Appeal Board, a tribunal within the USPTO. Any party to the cancellation proceeding may either appeal the Board's decision directly to the United States Court of Appeals for the Federal Circuit, 15 U.S.C. §1071(a), or bring an inter partes civil action in United States District Court against the adverse party in the cancellation proceeding, 15 U.S.C. § 1071(b). In a district court proceeding under section 1071(b), the parties are allowed to supplement the record with materials that were not before the Board, and the facts to which the new evidence relate are then decided de novo by the district court. *See Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 155 (4th Cir. 2014) (“The district court has authority independent of the PTO to grant or cancel registrations.”). The USPTO is not automatically made a party to inter partes actions, though it has a statutory right to intervene. *See* 15 U.S.C. § 1071(b)(2). Instead of intervening in every case to address factual questions based on a new record

developed in district court, the Director's usual practice, absent unusual circumstances, is to leave it to private parties to litigate the case on the merits.

C. Facts and Prior Proceedings

1. Prior Proceedings

The Washington football team at issue here has been known as “the Redskins” since 1933. Mem. Op. & Order 4 [JA ____]. After more than three decades of using the mark, Pro-Football applied for the benefits of federal registration, and in 1967, the USPTO registered the mark and published it in the USPTO's Principal Register. *Id.* Between 1974 and 1990, Pro-Football sought and obtained registration of five additional related marks. *Id.* At the time that Pro-Football sought registration of each of these six marks (collectively, the Redskins Marks), the Lanham Act provided that federal registration was subject to cancellation “[a]t any time” if a mark had been erroneously registered despite being ineligible under section 2(a). *See* 15 U.S.C. § 1064(3); *see* Pub. L. 79-489, tit. I, § 14, 60 Stat. 427, 433 (1946).

In 2006, Amanda Blackhorse and four other individuals (collectively, the Blackhorse Defendants), filed a petition with the USPTO seeking to cancel the registrations of the Redskins Marks. In 2014, the Board granted the petition for cancellation. *See Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 2014 WL 2757516 (T.T.A.B. 2014). The Board held, “based on the evidence properly before [it], that these registrations must be cancelled because they were disparaging to Native Americans at the respective times they were registered.” *Id.* at *1. The Board's

decision noted that the ruling “concern[ed] only the statutory right to *registration*” and would not impact Pro-Football’s “right to *use*” the marks. *Id.*

2. District Court Proceedings

Pro-Football brought suit in the United States District Court for the Eastern District of Virginia, challenging the Board’s decision that the marks should be cancelled. *See* 15 U.S.C. 1071(b). In addition to challenging the USPTO’s assessment of the evidence, Pro-Football argued that the provision of the Lanham Act barring registration of disparaging marks violates the First Amendment and the Fifth Amendment. The USPTO did not intervene to address the evidence submitted in district court, but the United States intervened to defend the constitutionality of section 2(a). *See* 28 U.S.C. § 2403(a).

On cross-motions for summary judgment, the district court held that the registrations were properly cancelled and that section 2(a) is not unconstitutional. The court began its analysis by “highlight[ing] what is at issue in this case—trademark registration, not the trademarks themselves.” Mem. Op. & Order 11 [JA ____]. The court emphasized that “Federal law does not create trademarks,” that “use of a mark in commerce, by itself, creates a host of common law rights,” and that “regardless of [the district court’s] ruling, [Pro-Football] can still use the Redskins Marks in commerce.” Mem. Op. & Order 11-12 [JA ____]. Thus, the “case does not concern a statute that prohibits or penalizes any speech.” *Id.* at 15 [JA ____]. The statute “does not restrict the public debate on public issues as the mark owner is still able to use the

mark in commerce.” *Id.* at 17 [JA ____]. Moreover, the Lanham Act even “contain[s] a cause of action for the enforcement of unregistered trademarks.” *Id.* at 12 [JA ____] (citing 15 U.S.C. § 1125(a)).

Against this backdrop, the district court concluded that the government’s decision not to promote the use of disparaging marks in commerce was a valid exercise of the government’s power to determine the contents and limits of its programs. Mem. Op. & Order 26-30 [JA ____-____]. The court applied Supreme Court case law recognizing that a “legislature’s decision not to subsidize the exercise of a fundamental right does not infringe the right.” *Id.* at 27 [JA ____] (quoting *Rust v. Sullivan*, 500 U.S. 173, 193 (1991) (quoting *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540, 549 (1983))). Here, “Congress has decided that marks that ‘may disparage’ shall not receive the benefits of federal registration,” and because Congress may “determine the contents and limits of that program,” Congress was “within its power to do so.” *Id.* at 28 [JA ____]. The district court also recognized that when the government “exercise[s] editorial discretion over what is published in the Official Gazette of the PTO and in the Principal Register,” it engages in government speech, not a restriction on private speech. *Id.* at 22 [JA ____]. Because “[p]articipation in the program is not compulsory” and “mark owners are free to use marks that ‘may disparage’ outside of the federal trademark registration program,” the court held that the First Amendment poses no bar to Congress’s decision to limit the class of marks

whose use in commerce would be promoted through federal registration. *Id.* at 29 [JA ____].

The district court further held that section 2(a) is not unconstitutionally vague either on its face or as applied to Pro-Football. The court held that because section 2(a) does not prohibit speech or impose criminal or civil penalties, a relaxed standard for vagueness is applicable. Mem. Op. & Order 31 [JA ____]. Applying that framework, the district court held that because section 2(a) provides “fair warning” and the USPTO has advised the public of the provision’s scope through published guidelines, Pro-Football’s facial challenge must fail. Mem. Op. & Order 31 [JA ____]. And because several dictionaries before and during the time Pro-Football obtained its registrations stated that “redskin” is an offensive term,” Pro-Football’s as-applied challenge fails as well. *Id.* at 34 [JA ____].

The district court also rejected Pro-Football’s final constitutional argument, holding that cancellation of the Redskins Marks did not violate due process. Mem. Op. & Order 35 [JA ____]. The court recognized that “the Federal Circuit [has] held that a trademark registration (as opposed to the underlying trademark) does not constitute a property interest under the Fifth Amendment.” *Id.* (citing *In re*

International Flavors & Fragrances, Inc., 183 F.3d 1361, 1366 (Fed. Cir. 1999)). In light of that holding, the district court found that the due process claim must fail.³

The district court then applied the established two-part test—agreed upon by the parties—to determine whether the Redskins Marks “may disparage.” Specifically, as framed by Pro-Football, the test is “(1) What is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the goods and services identified in the registrations? (2) Is the meaning of the marks one that may disparage Native Americans?” Pro-Football Mem. in Support of Cross-Mot. for Summ. J. 26 (Dkt. 100) [JA ____]. In the district court, Pro-Football made no argument that disparagement under section 2(a) is limited to identifiable individuals and cannot be applied to racial groups. *See id.* at 26-40 [JA____-____].

The court determined that the Blackhorse Defendants must show “that the marks ‘may disparage’ a ‘substantial composite’ of Native Americans. A substantial composite is not necessarily a majority.” Mem. Op. & Order 36 [JA ____] (citations omitted); *see also id.* at 41, 60-61, 63 [JA ____, ____-____, ____]. The court concluded that the Blackhorse Defendants had satisfied that standard, and entered judgment against Pro-Football.

³ In district court, Pro-Football also brought a takings claim, which the district court rejected for substantially the same reason as the due process claim. Mem. Op. & Order 35 [JA ____]. Pro-Football has not pressed that claim on appeal.

SUMMARY OF ARGUMENT

Pro-Football does not seriously argue that section 2(a) of the Lanham Act restricts its speech or prevents it from expressing any message. Nor could it. As the district court explained, section 2(a) does not restrict Pro-Football's ability to use its marks, express any idea, or participate in any public debate.

As Pro-Football properly acknowledges, moreover, the function of trademarks is to associate goods and services in commerce with a particular commercial actor, and the value of a trademark arises from its association with goods and services of a certain quality. Nothing in section 2(a) prevents Pro-Football from using its marks for these purposes. Indeed, Pro-Football used versions of the same marks to identify its services for more than thirty years before seeking federal registration. Pro-Football does not suggest that its freedom of expression was impaired during that period. Fanciful analogies to limitations on copyright registration, parade permits, or other forms of core expression only underscore the absence of any allegation that the Lanham Act prevents Pro-Football from expressing any message.

Instead, Pro-Football contends that the federal government has a constitutional obligation to *assist* the team in enforcing its particular marks against others by opening the federal trademark registration program to racially disparaging terms. Nothing in the First Amendment compels Congress to do so. Federal trademark registration confers valuable benefits to mark owners. But the Supreme Court has squarely “reject[ed] the notion that First Amendment rights are somehow not fully realized

unless they are subsidized by the State.” *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540, 546 (1983) (quotation marks omitted). Nor is it an “unconstitutional condition” for Congress to prohibit federal registration of disparaging marks. The Supreme Court recently reiterated that the unconstitutional conditions doctrine is implicated only if Congress seeks to leverage federal benefits or subsidies to regulate constitutionally protected conduct *outside* of the federal program in question. *See Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 133 S. Ct. 2321, 2328 (2013). Here, section 2(a) of the Lanham Act merely identifies the marks eligible for optional federal registration, without imposing any limitation on speech or conduct outside that program.

The Constitution does not require Congress to promote the commercial use of racist, misogynist, or bigoted terms and imagery in interstate commerce—let alone to record them on the government’s Principal Register and certify their registration under the official seal of the USPTO. Nothing in section 2(a) limits Pro-Football’s ability to use disparaging terms to express any message it wishes. But Pro-Football may not compel the federal government to participate in that effort.

STANDARD OF REVIEW

This Court reviews the constitutionality of an Act of Congress *de novo*. *Multi-Channel TV Cable Co. v. Charlottesville Quality Cable Corp.*, 65 F.3d 1113, 1123 (4th Cir. 1995). Facial invalidation under the First Amendment is “strong medicine” that should be employed “sparingly and only as a last resort.” *Broadrick v. Oklahoma*, 413

U.S. 601, 613 (1973); see *Washington State Grange v. Washington State Republican Party*, 552 U.S. 442, 450-51 (2008) (listing reasons why facial challenges are disfavored). To prevail in a facial challenge to an Act of Congress, a plaintiff normally must show that “no set of circumstances exists under which [the challenged law] would be valid or that the statute lacks any plainly legitimate sweep.” *United States v. Stevens*, 559 U.S. 460, 472 (2010) (citation and quotation marks omitted); see also *Washington State Grange*, 552 U.S. at 449 (plaintiff in facial challenge must show that the challenged law “is unconstitutional in all of its applications”).

ARGUMENT

I. The First Amendment does not compel the government to offer federal registration for disparaging trademarks.

Section 2(a) of the Lanham Act does not prevent Pro-Football from using its marks or restrict its speech in any way. Rather, section 2(a) reflects Congress’s choice not to extend the supplementary benefits of federal trademark registration to every conceivable mark that may be lawfully used in commerce. Because the First Amendment does not compel the government to facilitate the enforcement of disparaging terms as trademarks, the judgment of the district court should be affirmed.

A. The Lanham Act does not restrict Pro-Football's ability to express any message.

If Pro-Football wishes to use a racially disparaging term to identify its goods and services in commerce, nothing in the Lanham Act prohibits it from doing so.

Pro-Football does not seriously argue otherwise.

Pro-Football does not need federal trademark registration to identify its services with the term "Redskins." Trademarks are not created by federal law; they arise under the common law without regard to congressional action. Thus, Pro-Football lawfully used the name Redskins for more than thirty years before 1967, when it first sought federal registration of a mark incorporating that name.

Appellant's Br. 8.

Pro-Football does not suggest that its freedom of speech was somehow impaired before it sought federal trademark registration. Nor does Pro-Football contend that it was disabled from participating in any public debate during those three decades. Neither Pro-Football's subsequent application for federal trademark registration, nor the USPTO's cancellation of that registration in this case, has in any way affected Pro-Football's ability to continue using its marks or express particular ideas. The district court thus properly explained that section 2(a) "does not restrict the public debate on public issues as the mark owner is still able to use the mark in commerce." Mem. Op. & Order 17 [JA ____].

Far from restricting Pro-Football's ability to use its marks, Congress has affirmatively provided in the Lanham Act a federal cause of action that can be used even by holders of unregistered marks to protect those marks against consumer confusion. 15 U.S.C. § 1125(a)(1); see *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (explaining that section 1125(a) “protects qualifying unregistered trademarks”). Pro-Football acknowledges that this provision “may protect its marks in certain contexts regardless of the outcome here.” Appellant's Br. 19.

Congress has also prohibited the importation of goods bearing confusing markings without regard to federal registration. 15 U.S.C. § 1125(b). It has provided federal protections against cybersquatting on unregistered marks. See *id.* § 1125(d) (creating civil action for cybersquatting by “the owner of a mark,” without regard to federal registration). It has permitted awards of treble damages for the infringement of unregistered trademarks. *Id.* § 1117(a) (authorizing a district court to remedy “a violation of section 1125(a)” by awarding “any sum above the amount found as actual damages, not exceeding three times such amount”).⁴ For marks that are famous—as Pro-Football contends its marks are here, see Appellant's Br. 24—Congress has also authorized statutory damages without regard to federal registration. See 15 U.S.C. § 1125(c)(5). And Congress has left unaffected any trademark rights available under

⁴ The Federal Circuit majority in *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), erroneously stated that registration is necessary to prevent cybersquatting or to collect treble damages. See *id.* at 1343. Those statements are contradicted by the text of the statute.

state law. *See In re International Flavors & Fragrances, Inc.*, 183 F.3d 1361, 1368 (Fed. Cir. 1999).

Pro-Football thus cannot identify any respect in which the Lanham Act restricts its ability to use its preferred marks or express any idea. Its freedom of speech is no more impaired now than it was in 1933, when it first chose the name for its team.

Pro-Football's First Amendment claim is especially perplexing because Pro-Football fails even to identify the message that, in its view, the cancellation of its federal trademark registration prevents it from expressing. Pro-Football insists that “[c]riticizing and demeaning something is a viewpoint” that trademarks are entitled to express. Appellant's Br. 15. But Pro-Football does not suggest that it actually *wants* to criticize or demean anyone—or, for that matter, that it wishes to express any other message on a question of public significance. To the contrary, Pro-Football argues that “[i]t is simply a historical accident that the Team is the Washington Redskins rather than any other Native American sports mascot.” Appellant's Br. 59.

According to Pro-Football, the expressive purpose of the marks at issue here is merely to “signal the source and quality of entertainment services.” Appellant's Br. 13-14. That is, indeed, the fundamental purpose of a trademark: to communicate the identity and desirability of the commodity on which the mark appears. Trademarks operate to identify the source of goods and services in commerce, and their communicative value arises “only because of the associations that grow up over time

between the name and a certain level of price and quality of service.” *Friedman v. Rogers*, 440 U.S. 1, 15-16 (1979); see *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) (“Whatever the means employed, the aim is the same—to convey through the mark, in the minds of potential customers, the desirability of the commodity upon which it appears.”). Thus, for example, while “HERSHEY’S . . . signal[s] a certain quality of chocolate,” Appellant’s Br. 13, precisely the same function could have been served if Hershey’s had selected another name.

Nothing in section 2(a) restricts Pro-Football’s ability to signal the source and quality of its services. Pro-Football does not need a federally registered mark—let alone a federally registered mark featuring a racially disparaging term—to designate its services in interstate commerce. Pro-Football admits as much in emphasizing that it used the name Redskins as a trademark for decades before seeking federal registration, Appellant’s Br. 8; in contending that it selected the name as a “historical accident,” *id.* at 59; in asserting that its marks are now famous among consumers of the relevant services, *id.* at 24; and in recognizing that section 1125(a), the Lanham Act’s cause of action for unregistered marks, “may protect its marks in certain contexts regardless of the outcome here,” *id.* at 19. As these contentions make clear, Pro-Football’s marks “signal the source and quality of [its] entertainment services” in commerce today, just as they did in 1966, irrespective of federal registration. *Id.* Pro-

Football's interest in expressing that basic associative message consequently provides no basis for a First Amendment challenge to section 2(a).

B. Pro-Football has no First Amendment right to government assistance in enforcing its disparaging marks.

For the reasons discussed above, section 2(a) does not restrict Pro-Football's ability to express any idea or viewpoint. Rather, section 2(a) reflects Congress's judgment that a federal agency should not use its resources affirmatively to *promote* the use of racial slurs and similar disparagements as identifiers of goods or services in commerce. That judgment does not violate the First Amendment.

1. Congress has broad authority to define eligibility criteria for a federal program.

While it is clear that Congress cannot prohibit the public from using disparaging and scandalous terms to express ideas, it is equally well-settled that the Constitution does not confer a right to a federal subsidy encouraging their use. The Supreme Court has squarely "reject[ed] the notion that First Amendment rights are somehow not fully realized unless they are subsidized by the State." *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540, 546 (1983) (quotation marks omitted).

Applying this principle, in *Regan*, the Supreme Court upheld a provision that denied a tax exemption to entities that engaged in lobbying. By denying the tax exemption, the Court explained, "Congress ha[d] not infringed any First Amendment rights or regulated any First Amendment activity. Congress ha[d] simply chosen not to pay for . . . lobbying." *Regan*, 461 U.S. at 546. The Court rejected any suggestion

that, even when core political speech was at issue, “strict scrutiny applies whenever Congress subsidizes some speech, but not all speech,” stressing that “[t]his is not the law.” *Id.* at 548.

Similarly, in *Rust v. Sullivan*, 500 U.S. 173 (1991), the Supreme Court upheld “Department of Health and Human Services (HHS) regulations which limit the ability of Title X fund recipients to engage in abortion-related activities.” *Id.* at 177-78. The Court confirmed that “[t]he Government can, without violating the Constitution, selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternative program which seeks to deal with the problem in another way.” *Id.* at 193. “In so doing,” the Court explained, “the Government has not discriminated on the basis of viewpoint; it has merely chosen to fund one activity to the exclusion of the other.” *Id.*

The Court’s conclusion drew on case law recognizing that “[t]here is a basic difference between direct state interference with a protected activity and state encouragement of an alternative activity consonant with legislative policy.

Constitutional concerns are greatest when the State attempts to impose its will by force of law; the State’s power to encourage actions deemed to be in the public interest is necessarily far broader.” *Maher v. Roe*, 432 U.S. 464, 474-76 (1977)

(footnote omitted) (concluding that Medicaid funds need not be made available for abortions, despite recognized constitutional right to an abortion); *see also Harris v.*

McRae, 448 U.S. 297, 318 (1980) (“Whether freedom of choice that is constitutionally

protected warrants federal subsidization is a question for Congress to answer, not a matter of constitutional entitlement.”); *Regan*, 461 U.S. at 549-50 (relying on *Maber* and *Harris*); *Rust*, 500 U.S. at 192-93 (same).

In *Davenport v. Washington Education Association*, 551 U.S. 177 (2007), the Supreme Court applied these principles to a First Amendment challenge to a Washington State statute regulating the ability of public unions to spend funds collected from nonmembers for election-related purposes. In upholding the restriction, the Supreme Court emphasized that the State was under no obligation to allow public unions to collect and spend nonmembers’ money at all. *See id.* at 189. The Court thus held that the First Amendment was not offended by the State’s choice, in offering that option, to constrain the union’s discretion in expending the funds. *See id.* at 189-90.

Similarly, in *Ysursa v. Pocatello Education Association*, 555 U.S. 353 (2009), the Supreme Court upheld the State of Idaho’s prohibition on the use of payroll deductions from public employees to fund political activities. The Court observed that “the State is not constitutionally obligated to provide payroll deductions at all.” *Id.* at 359. “Given that the State ha[d] not infringed the unions’ First Amendment rights,” the Supreme Court upheld the ban on political payroll deductions on the ground that the State could “demonstrate a rational basis to justify” it. *Id.*

The Supreme Court has thus repeatedly made clear—in cases where the challenged provision’s effect on the ability to express a message was much more direct

than in this case—that “although government may not place obstacles in the path of a person’s exercise of freedom of speech, it need not remove those not of its own creation.” *Regan*, 461 U.S. at 549-50 (brackets, ellipsis, and quotation marks omitted). Here, any obstacles to expression are not of the government’s creation. Pro-Football seeks federal registration to facilitate enforcement of its mark against others who might use identical or similar marks that create a likelihood of confusion as to the source of goods or services in commerce. To the extent that potential misleading use of similar marks by other commercial actors places obstacles in the path of Pro-Football’s expression, those obstacles are attributable to those other actors, and not to the United States. The United States has no constitutional obligation to remove those obstacles.

A recent Federal Circuit decision striking down section 2(a)’s bar on the registration of disparaging marks, *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), failed to appreciate the salience of these principles and, thus, misapprehended the applicable First Amendment framework for analyzing a challenge to section 2(a). The Federal Circuit’s basic error in *Tam* was treating section 2(a) as though it imposed an affirmative limitation on expression. *See id.* at 1368-69 (Dyk, J., concurring in part and dissenting in part). From that premise, the court reasoned that the provision was invalid because it could not survive strict scrutiny. The *Tam* court did not suggest that section 2(a) would fail constitutional scrutiny if judged instead under the framework laid out by the Supreme Court in the cases we rely upon here—the framework the

district court correctly applied. *See* Mem. Op. & Order 27 [JA ____]. Rather, it refused to apply that framework.

Neither the *Tam* majority nor Pro-Football's brief identifies any principled reason why section 2(a), which does not restrict any speech, should be analyzed under First Amendment principles developed to address such restrictions. Rather, like the challenged provisions in *Rust*, *Ysursa*, and similar cases, section 2(a) defines eligibility criteria for a discretionary government benefit. Pro-Football offers a scattershot response to those cases, noting that some involved financial subsidies, some involved government employment, and some involved communicating information pertaining to the government's own program. Appellant's Br. 29-31; *see also Tam*, 808 F.3d at 1351-55. But Pro-Football provides no adequate response to the principle that emerges from those cases. As the Supreme Court explained in *Davenport*, in "numerous situations" that do not "raise[] the specter that the Government may effectively drive certain ideas or viewpoints from the marketplace," heightened First Amendment scrutiny is inappropriate. *Davenport*, 551 U.S. at 188 (quotation marks omitted).

Pro-Football's contrary argument suggests that Congress would have more latitude simply to give money to entities that identify their goods or services with non-disparaging trademarks, or to provide them with preferential access to government property in order to express their views, than it does in determining whether to include marks on the Principal Register. *See* Appellant's Br. 31. It is difficult to

imagine a constitutional basis for such a distinction. Congress has at least as much discretion to determine which terms and symbols should be registered and published by a federal agency as it would to determine which private entities should receive federal funds, or to “control use of government property,” *Tam*, 808 F.3d at 1353.

Moreover, to the extent that the expenditure of federal funds is a relevant criterion, it is satisfied here. Although the USPTO collects money through user fees, those fees are deposited in the Treasury, and the agency may expend funds in connection with the registration process only “[t]o the extent and in the amounts provided in advance in appropriations Acts.” 35 U.S.C. § 42(c)(1), (2). Pro-Football cannot seriously contend that the statute at issue here would be constitutional if Congress had supplemented with general revenues the fees that the USPTO collects, but that the statute violates the First Amendment because the USPTO funds its relevant activities solely with those fees. The Supreme Court recently confirmed that the net impact of a program on government finances does not drive First Amendment analysis. *See Walker v. Texas Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2252 (2015) (“[I]f the city in [*Pleasant Grove City v. Sumnum*, 555 U.S. 460 (2009),] had established a rule that organizations wishing to donate monuments must also pay fees to assist in park maintenance, we do not believe that the result in that case would have been any different.”).

Pro-Football insists that the provision at issue here could have the chilling effect of discouraging the use of disparaging marks. *See* Appellant’s Br. 18. But that

argument could be leveled at any government subsidy of speech: the provision at issue in *Regan* could have been said to chill investment in lobbying, and the spending restriction in *Rust* was plainly intended to discourage abortion-related activities. A marginal shift in incentives “is commonly the effect of the denial of subsidies, as the Supreme Court has recognized.” *Tam*, 808 F.3d at 1370 (Dyk, J., concurring in part, dissenting in part). But that “does not turn a subsidy provision into a regulatory provision, so long as the subsidy is not designed to limit speech outside of the subsidized program.” *Id.* Here, Pro-Football remains “free to engage in . . . speech as [it] see[s] fit”; it “simply [is] barred from enlisting the [United States] in support of that endeavor.” *See Ysursa*, 555 U.S. at 359.

2. Limitations on trademark registration do not impermissibly distort the marketplace of ideas.

Pro-Football does not advance its argument by invoking fanciful hypotheticals involving content-based denials of parade permits, copyright registrations, or other matters far afield from the provision at issue. The Supreme Court has expressly acknowledged that the principles upon which we rely here may apply differently, or may not apply at all, in circumstances where government action is likely to have a profound effect on core First Amendment expression. In *Rust*, for example, the Supreme Court observed that government has less latitude when its subsidy takes the form of access to a public forum, or an ability to speak within a public university. 500 U.S. at 199-200; *see also Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819

(1995) (First Amendment constraints on selective funding for student newspapers at universities).

But the Supreme Court has stressed that this exception applies only in narrow circumstances and that the “general rule” is that “the Government may choose not to subsidize speech.” *Rust*, 500 U.S. at 200. In *Rust* itself, the Court observed that the exclusion of abortion services from a family-planning program could in theory affect doctor-patient relationships, which might enjoy enhanced First Amendment protection. *See id.* But because a lack of funding for abortion-related services did not “significantly impinge upon the doctor-patient relationship,” the Court held that “the general rule that the Government may choose not to subsidize speech applie[d] with full force.” *Id.*

That “general rule” also applies with full force here. There is no serious contention in this case (and certainly no evidence) that section 2(a) threatens to drive political and artistic views from the marketplace of ideas. As already explained, the federal trademark registration program does not in any way prevent commercial actors from using their preferred marks or enforcing them against others who use identical or confusingly similar marks. Nor are trademarks plausibly described as a traditional forum for free speech, akin to a college campus or newspaper. As Pro-Football itself recognizes, the function of trademarks is simply to identify goods and services in commerce and distinguish them from those of others. For that reason, many of the

most valuable trademarks—such as Exxon or Google—comprise arbitrary or fanciful terms with no preexisting meaning to consumers.

Pro-Football underscores the error of its analysis when it equates a refusal to register a trademark with a hypothetical denial of copyright protection to disparaging books. Appellant’s Br. 4; *see also Tam*, 808 F.3d at 1347 (stating that government’s argument would suggest that “the government would be free to regulate the content, viewpoint, and messages of registered copyrights”). As the Supreme Court has stressed, copyright is “the engine of free expression” because “[b]y establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas.” *Eldred v. Ashcroft*, 537 U.S. 186, 219 (2003). For First Amendment purposes, an author’s desire to publish certain ideas without being subject to indiscriminate theft of intellectual property cannot plausibly be equated with a commercial actor’s desire to identify goods and services in commerce using a disparaging mark—let alone a mark that, according to Pro-Football, signifies nothing but a “historical accident.” Appellant’s Br. 59.

Moreover, the trademark registration program operates in the sphere of commercial speech. “The marketplace of ideas differs dramatically from the marketplace of goods and services.” *Tam*, 808 F.3d at 1379 (Reyna, J., dissenting). The Supreme Court has recognized that, because commercial speech is “linked to commercial well-being, it seems unlikely that such speech is particularly susceptible”

to incidental chill. *Bates v. State Bar*, 433 U.S. 350, 381 (1977). That observation seems particularly apt in the context of a National Football League team.

This case thus bears no resemblance to *Legal Services Corp. v. Velazquez*, 531 U.S. 533 (2001), upon which Pro-Football relies. There, the Supreme Court invalidated a provision that prohibited attorneys who received funds from the government-funded Legal Services Corporation from making arguments on behalf of clients—whether with government funds or other funds—that challenged existing welfare laws. The Court concluded that the restriction “distorts the legal system by altering the traditional role of the attorneys,” and “sifts out cases presenting constitutional challenges in order to insulate the Government’s laws from judicial inquiry.” *Id.* at 544, 546; *see also United States v. American Library Ass’n*, 539 U.S. 194, 213 (2003) (plurality op.) (noting that the program at issue in *Velazquez* “differed from the program in *Rust* ‘[i]n th[e] vital respect’ that the role of lawyers who represent clients in welfare disputes is to advocate *against* the Government, and there was thus an assumption that counsel would be free of state control”) (alterations and emphasis in original).

The trademark registration program presents no similar threat. With or without the federal trademark registration program, manufacturers and sellers will market their goods and services, use source identifiers in connection with those goods and services, and rely on trademark rights to prevent others from using marks that are likely to cause consumer confusion. Indeed, that was the state of the law for the first

century of the Nation's history, when trademark law was exclusively a branch of the common law of unfair competition. There is no basis for concluding that the government has impermissibly distorted the marketplace of ideas by supplementing that common-law scheme with a federal trademark registration program that facilitates the enforcement of marks that satisfy statutory requirements.

3. Ineligibility for federal registration is not a “burden” on speech.

Pro-Football mistakenly relies on cases in which governments have placed affirmative burdens on speech. In *Sorrell v. IMS Health Inc.*, 131 S. Ct. 2653 (2011), on which Pro-Football heavily relies, the Supreme Court considered a state statute that prohibited health insurers from providing pharmaceutical companies with access to information for marketing purposes. *Id.* at 2660. Absent the state statute, the pharmaceutical companies could have developed marketing materials based on these records, and their ability to speak was curtailed as a result of the state enactment. The state statute thus did not concern the denial of governmental assistance, but rather involved a *prohibition* that impeded the ability to convey a particular message. Pro-Football's reliance on cases involving taxes, fees, and various other affirmative burdens on speech is misplaced for the same reason. See *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123 (1992) (fees for parades varied based on message); *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Bd.*, 502 U.S. 105 (1991) (confiscation of proceeds of sales of book); *Minneapolis Star & Tribune Co. v. Minnesota*

Comm'r of Revenue, 460 U.S. 575 (1983) (tax on paper and ink with effect limited to certain newspapers); *Pitt News v. Pappert*, 379 F.3d 96 (3d Cir. 2004) (restrictions on advertising alcohol).

Pro-Football can draw analogies to these cases only by describing the failure of the United States to assist its trademark enforcement as a burden on its expression. Pro-Football asserts that its expression is “burden[ed],” for example, because for marks that are unregistered, “U.S. Customs may not stop importation of goods that bear infringing marks.” Appellant’s Br. 18. Pro-Football mistakenly equates Congress’s judgment that employees of the United States should not use public resources to enforce disparaging marks at the border with an affirmative restriction on speech. And Pro-Football remains free to sue in U.S. courts to stop sales of such goods.

The other “burdens” that Pro-Football describes similarly reflect the absence of benefits conferred using government resources. Pro-Football complains that, without federal registration, it will not have the benefit of “constructive nationwide notice of ownership,” Appellant’s Br. 18, and the consequent opportunity “to quiet title” in its marks by extinguishing certain defenses, *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985). These are benefits that flow from the USPTO’s examination and publication of registered marks in the Principal Register. In the same vein, Pro-Football objects that, without federal registration, its marks will not enjoy a presumption of validity. Appellant’s Br. 18. Yet that presumption, which

assists a mark owner in proving an element of the federal cause of action for infringement of registered marks, reflects the benefits of the government's examination and publication of the mark. Pro-Football is not constitutionally entitled to "a government-bestowed collection mechanism for enforcing trademarks." *Tam*, 808 F.3d at 1369 (Dyk, J., concurring in part, dissenting in part).

4. The "unconstitutional conditions" doctrine does not apply here.

Pro-Football properly acknowledges that Congress may, consistent with the First Amendment, "define the limits of the government's spending program" by "specify[ing] the activities Congress wants to subsidize." Appellant's Br. 32 (quoting *Agency for Int'l Dev. v. Alliance for Open Soc'y Int'l, Inc.*, 133 S. Ct. 2321, 2328 (2013)). Here, "Congress wants to subsidize" particular types of marks that identify goods and services in commerce, and does not wish to subsidize disparaging marks.

Pro-Football mistakenly contends that Congress has improperly sought to "leverage funding to regulate speech outside the contours of the program itself." Appellant's Br. 32 (quoting *Agency for Int'l Dev.*, 133 S. Ct. at 2328). The Supreme Court has explained that a limitation on the receipt of public benefits may constitute an unconstitutional condition only where "the Government has placed a condition on the *recipient* of the subsidy rather than on a particular program or service, thus effectively prohibiting the recipient from engaging in the protected conduct outside the scope of the federally funded program." *Rust*, 500 U.S. at 197. The restriction on

the expenditure of Title X funds at issue in *Rust* was permissible because it “distinguish[ed] between a Title X *grantee* and a Title X *project*,” placing restrictions only on the “*project’s* activities, and leav[ing] the grantee unfettered in its other activities.” *Id.* at 196 (emphasis in original).

Section 2(a) is likewise a limitation on the trademark registration program, and not a limitation on participants in that program. The statute defines which marks are eligible for federal registration, and which are not, solely by reference to the actual marks sought to be registered. Nothing in section 2(a) ascribes any consequence to speech or conduct by the applicant outside the program. Thus, Pro-Football is free to use a disparaging mark as a source identifier if it wishes to do so, while still retaining the ability to register other marks that are not disparaging. The only limitation at issue here relates to Pro-Football’s ability to compel the government to record in its Principal Register a trademark *that itself comprises* a disparaging racial slur. *See* 15 U.S.C. § 1052(a) (“No trademark . . . shall be refused registration on the principal register on account of its nature unless it . . . [c]onsists of or comprises . . . matter which may disparage . . .”). Section 2(a) thus defines the scope of the federal registration program itself, without reference to or limitation on Pro-Football’s speech or conduct outside that program.

Pro-Football’s contrary assertion is premised on its view that the “contours of the program here” should be defined, not by the actual contours of the federal registration program, but rather by “the two purposes of registration” as described in

a Senate Report. Appellant's Br. 32. That contention is untenable. It is the terms of the statute that Congress enacted, and not a summary of the program's key functions in the legislative history, that defines the contours of the federal program. Congress has created a program in which certain marks are eligible for registration and others are not, and those eligibility criteria define the scope of the program, just as the prohibition on using funds on abortion defined the scope of the family-planning program in *Rust*. See *Rust*, 500 U.S. at 194 ("Within far broader limits than petitioners are willing to concede, when the Government appropriates public funds to establish a program it is entitled to define the limits of that program."); see also *Tam*, 808 F.3d at 1371 (Dyk, J., concurring in part, dissenting in part) (noting that in *Regan* the refusal of tax exemption for organizations that engaged in lobbying was upheld "not because it was related in some way to the goals of 501(c)(3) tax exemption, but rather because the condition . . . did not leverage funds outside of the nonprofit structure") (quotation marks omitted).

C. The United States has a legitimate interest in limiting federal trademark registration to marks that are not disparaging.

There is no dispute that the government has a legitimate interest in creating a federal trademark registration program. Pro-Football extols the virtues of federal registration, highlighting the benefits that it confers on commercial actors who seek to identify their goods and services in commerce and to enforce their marks against other commercial actors. See, e.g., Appellant's Br. 18. Having created such a program,

the government also has a legitimate interest in encouraging the use of non-disparaging marks, rather than allowing that program to be used to increase the likelihood that “underrepresented groups in our society” will be “bombarded with demeaning messages in commercial advertising.” *Tam*, 808 F.3d at 1364 (Dyk, J., concurring in part, dissenting in part).⁵

In addition, Congress may legitimately exercise control over the Principal Register of the United States. The Supreme Court recently confirmed that the government may object to publishing material that might offend members of the public. In *Walker*, the Court considered a program that allowed nonprofit organizations to propose specialty license-plate designs to the State of Texas. Vehicle owners paid fees to fund the program, which was a net revenue-raiser for the State. *Walker*, 135 S. Ct. at 2252. The Texas Department of Motor Vehicles Board could refuse an application for such a plate, however, “if the design might be offensive to any member of the public.” *Id.* at 2245 (quoting Tex. Transp. Code Ann. § 504.801(c)). The Board accepted the vast majority of specialty plates that were proposed, including “the name of a high school, a fraternity or sorority, the Masons, the Knights of Columbus, the Daughters of the American Revolution, a realty company, a favorite soft drink, a favorite burger restaurant, and a favorite NASCAR driver.” *Id.* at 2255 (Alito, J., dissenting). But the Board rejected a specialty plate

⁵ In *Bolger v. Youngs Drug Prods. Corp.*, 463 U.S. 60 (1983), the government did not assert an interest in avoiding having its program coopted as a mechanism for racial disparagement.

proposed by the Sons of Confederate Veterans, who had sponsored a license plate bearing the Confederate battle flag.

The Supreme Court rejected a First Amendment challenge to the Board's action. The Court explained that "government statements (and government actions and programs that take the form of speech) do not normally trigger the First Amendment rules designed to protect the marketplace of ideas." *Walker*, 135 S. Ct. at 2245-46. The Court held that "just as Texas cannot require [the Sons of Confederate Veterans] to convey the State's ideological message, [the Sons of Confederate Veterans] cannot force Texas to include a Confederate battle flag on its specialty license plates." *Walker*, 135 S. Ct. at 2253 (internal quotation marks and citation omitted). Here, similarly, Pro-Football cannot force the government to register racial epithets, which would then be included "in the Official Gazette of the PTO and the Principal Register in order to inform the public of marks registered with the federal government." Mem. Op. & Order 18 [JA ____].

Pro-Football misunderstands the district court's reasoning when it insists that the trademark registration program does not "transform[] private speech into government speech." Appellant's Br. 27. No one is suggesting that Pro-Football's use of its trademark is government speech. As the district court repeatedly emphasized, "[w]hat is at issue here is the registration of the [mark] and the benefits associated with registration, not the use of the mark[]." Mem. Op. & Order 13 [JA ____]; *see also id.* at 16 [JA ____] ("Pro-Football's "ability to use the . . . mark is

unaffected.”); *id.* at 16 [JA ____] (“the speech itself is uninhibited”); *id.* at 17 [JA ____] (“the mark owner is still able to use the mark in commerce”). This case cannot plausibly be analogized to the denial of permits for “unpopular rallies,” Appellant’s Br. 28, which would directly affect the ability to engage in political speech.

The determination whether to register the mark, unlike Pro-Football’s use of the mark, does reflect on the government. The USPTO has made quite clear that it does not endorse any particular product, service, mark, or registrant. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1993 WL 114384, at *5 n.3 (T.T.A.B. 1993) (“Just as the issuance of a trademark registration by this Office does not amount to a government endorsement of the quality of the goods to which the mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a ‘good’ one in an aesthetic, or any analogous, sense.”). But Congress has made choices about how to use government resources, and the government issues registration certificates in the name of the United States and communicates the fact of registration to other countries. *See* Mem. Op. & Order 24 [JA ____] (“When the symbol for a federally registered trademark, ®, is affixed to a mark, it is a declaration by the federal government that it has approved that mark.”); 15 U.S.C. § 1141b (Madrid Protocol providing for transmittal of registration information); Paris Convention for the Protection of Industrial Property art. 6*quinqüies*, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 (providing for transmittal of certificates of registration to other countries). Pro-Football acknowledges that excluding a mark from the

registration program conveys a governmental message of disapproval, complaining that the government's decision to cancel Pro-Football's marks "tarnishes the Team's name." Appellant's Br. 44.

Accepting the validity of Congress's interest in encouraging the use of non-disparaging marks to identify goods and services in commerce would not require this Court to presume that Congress could condition trademark registration on taking a particular side in a politically charged debate, *see* Appellant's Br. 40. Congress did not focus section 2(a) on a particular favored or disfavored group, instead adopting a general policy in support of trademarks that do not "disparage . . . persons, living or dead." 15 U.S.C. § 1052(a). As Pro-Football recognizes, "[t]he mark-owner's intent and views are irrelevant" to this standard, Appellant's Br. 34, and the statute is thus viewpoint neutral, *see R.A.V. v. City of St. Paul*, 505 U.S. 377, 391 (1992) (noting that viewpoint discrimination would not arise if a statute prohibited "odious racial epithets," which "would be prohibited to proponents of all views"; such a prohibition becomes viewpoint based only if certain words are prohibited on only one side of a debate); *Perry v. McDonald*, 280 F.3d 159, 170 (2d Cir. 2001) (ban on profanities is viewpoint neutral). The First Circuit has properly recognized, even in the context of a regulation that directly prohibits certain speech, that a prohibition on "demeaning or disparaging" advertisements is viewpoint neutral because it does not constitute "an attempt by the government 'to give one group an advantage over another in the marketplace of ideas.'" *American Freedom Def. Initiative v. Massachusetts Bay Transp. Auth.*,

781 F.3d 571, 582 (1st Cir. 2015), *cert. denied*, 2016 WL 100366 (U.S. Jan. 11, 2016) (quoting *Ridley v. Massachusetts Bay Transp. Auth.*, 390 F.3d 65, 91 (1st Cir. 2004)). The notion that the government discriminates on the basis of viewpoint in refusing to promote the use of disparaging marks is particularly problematic in the context of trademarks, which are designed to promote products and not to demean them.⁶

Pro-Football lists numerous marks that it asserts the government would not wish to promote. *See, e.g.*, Appellant's Br. 24 & n.4. It is unclear whether Pro-Football means to suggest that those marks were registered in error or whether it means to contend that section 2(a) is underinclusive. The former contention would plainly provide no basis for striking down the statute on its face. And to the extent that Pro-Football means to suggest that Congress could not prohibit registration of immoral, deceptive, scandalous, and disparaging marks unless it also prohibited registration of some other unspecified category of marks (and also took actions in entirely unrelated areas, *see* Appellant's Br. 25), it ignores the principle that "the First Amendment imposes no freestanding underinclusiveness limitation." *Williams-Yulee v. Florida Bar*, 135 S. Ct. 1656, 1668 (2015) (internal quotation marks omitted). The

⁶ That section 2(a) is viewpoint neutral is confirmed by the fact that the USPTO denies registration of ethnic slurs even when registration is sought by individuals seeking to use the slur in a positive, rather than disparaging, manner. *See, e.g., In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071, 2008 WL 5065114, at *8 (T.T.A.B. 2008) (denying registration of slur "Heeb" when sought by Jewish magazine); *Tam*, 808 F.3d 1321 (denying registration of slur "Slants" to Asian-American rock band).

government “need not address all aspects of a problem in one fell swoop; policymakers may focus on their most pressing concerns.” *Id.*

The federal government also has a legitimate interest in allowing States to make their own determinations about whether trademarks should be unenforceable on grounds of public policy. It is unclear whether common-law courts would have enforced marks that were determined to be disparaging. *See* 3 William Henry Browne, *A Treatise on the Law of Trade-Marks* 464-65 (1873) (noting “a rule of universal application” that trademarks “must not transgress the rules of morality or public policy” and thus that trademarks that blaspheme religious objects would not be recognized). Had Congress elected to confer federal registration on disparaging marks, it would have superseded efforts by any States that may have wished to decline to recognize marks that contravened their own public policy. Given that such marks may not be entered on the federal registry, States remain free to recognize them, or not recognize them, as they see fit. The First Amendment did not compel Congress to override state prerogatives in this area.

These interests are more than adequate to justify section 2(a)’s prohibition against registration of marks that disparage persons. As discussed above, because there is no restriction on Pro-Football’s use of the mark or protected expression, Congress has wide latitude to define the scope of a federal program. But in any case, the provision would withstand scrutiny even if the standard applicable to restrictions on commercial speech set out in *Central Hudson Gas & Electric Corp. v. Public Service*

Commission, 447 U.S. 557 (1980), were thought to apply. The government interests supporting section 2(a) easily outweigh Pro-Football's interest in obtaining the aid of the federal government in enforcing a disparaging mark.

II. Pro-Football's claims premised on the Due Process Clause are without merit.

A. Section 2(a) is not unconstitutionally vague.

1. Pro-Football cites no case in which a statute has been invalidated on vagueness grounds in remotely comparable circumstances to those presented here. Instead, Pro-Football's vagueness challenge principally draws on cases in which conduct was affirmatively prohibited and violators were subject to civil or criminal penalties. *See FCC v. Fox Television Stations, Inc.*, 132 S. Ct. 2307, 2317 (2012); *see also Village of Hoffman Estates v. Flipside, Hoffman Estates, Inc.*, 455 U.S. 489, 499 (1982); *Grayned v. City of Rockford*, 408 U.S. 104, 107-08 (1972).

As the Supreme Court has explained, the constitutional standard set out in those cases does not apply where, as here, no such penalties are at issue. In *National Endowment for the Arts v. Finley*, 524 U.S. 569 (1998), the Supreme Court considered a condition on a government grant program that was "undeniably opaque," and observed that if the provision's terms "appeared in a criminal statute or regulatory scheme, they could raise substantial vagueness concerns." *Id.* at 588. The Court specifically "recognize[d], as a practical matter, that artists may conform their speech to what they believe to be the decisionmaking criteria in order to acquire funding,"

but concluded that because the government was not making any conduct unlawful, “the consequences of imprecision are not constitutionally severe.” *Id.* at 589. Here, similarly, there are no civil or criminal penalties associated with the denial or cancellation of trademark registration. *See* Mem. Op. & Order 31 [JA ____].

Pro-Football similarly errs in relying on First Amendment principles addressing a circumstance in which a government official had discretion to determine which speech will be permitted and which will be prohibited. *See City of Lakewood v. Plain Dealer Publ’g Co.*, 486 U.S. 750, 769-72 (1988). “Vagueness doctrine is an outgrowth not of the First Amendment, but of the Due Process Clause of the Fifth Amendment.” *United States v. Williams*, 553 U.S. 285, 304 (2008). But those principles are inapposite here in any event; as discussed above, the trademark registration program does not prohibit or authorize any speech.

2. In any case, section 2(a) is not vague under any standard of review. The term “disparage” has been given a settled legal meaning, namely, whether the mark “dishonor[s] by comparison with what is inferior, 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), *cert. denied sub nom. Geller v. Patent & Trademark Office*, 135 S. Ct. 944 (2015) (alterations in original). And in applying this definition to determine whether a mark is registrable, the USPTO does not allow its examiners to rely on their own subjective preferences and impressions, but rather hinges the disparagement analysis on the objective fact of whether evidence shows a “substantial composite of the referenced

group” would find the mark disparaging. *See id.* Because the agency uses an objective, established test for disparagement, the public has fair notice as to which marks may be found to be unregistrable.⁷

Any remaining vagueness concerns are resolved by the fact that the USPTO’s determination of whether a mark is disparaging is subject to judicial review, where the question whether a mark is disparaging is treated as “a conclusion of law based upon underlying factual inquiries.” *Geller*, 751 F.3d at 1358. When the USPTO denies registration without a factual showing that the mark meets the objective standards for refusal of registration under section 2(a), its determination will be set aside. *See In re Mavety Media Grp.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994). The USPTO has thus adopted “adequate standards to guide” its application of section 2(a) and render those determinations “subject to effective judicial review,” which is enough to resolve any vagueness concerns. *Brown v. Town of Cary*, 706 F.3d 294, 306 (4th Cir. 2013) (“[T]he vagueness doctrine does not prevent governments from regulating vague concepts—it only requires that they provide some guidance for citizens to understand the reach of a law’s application.”), *abrogated on other grounds by Reed v. Town of Gilbert*, 135 S. Ct. 2218 (2015).

⁷ Pro-Football’s contention that the term “disparage” is unconstitutionally vague is further undercut by the fact that the Supreme Court has twice recently treated “disparagement” as a legally significant concept. *See Obergefell v. Hodges*, 135 S. Ct. 2584, 2602 (2015) (striking down bans on same-sex marriage because such bans “disparage” same-sex couples); *Town of Greece v. Galloway*, 134 S. Ct. 1811, 1822 (2014) (legislative prayer does not violate Establishment Clause where the prayer does not “disparage any other, faith or belief”).

3. Pro-Football also argues that section 2(a) is arbitrarily enforced, citing instances in which superficially similar marks have met different fates before the USPTO. *See also Tam*, 808 F.3d at 1342 & n.7; *id.* at 1361-63 (O'Malley, J., concurring). But analysis of whether a mark is disparaging requires consideration of the full context in which the mark is used. For example, were the USPTO to approve use of the term "Redskin" on a mark also bearing an image of red-skinned potatoes, it would not necessarily reflect on whether the marks at issue here are disparaging. It is for precisely this reason that the Federal Circuit has agreed with the USPTO that "each application" must be decided "on its own merits." *In re Boulevard Entm't*, 334 F.3d 1336, 1343 (Fed. Cir. 2003). In addition, because disparagement is judged as of the time of the application, different outcomes for marks using similar terms may also sometimes be explained by changes in contemporary attitudes. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1993 WL 114384, at *4 (T.T.A.B. 1993) (recognizing "what was [once] considered scandalous as a trademark . . . may no longer be considered so, given the changes in societal attitudes").

In any case, the USPTO examines more than 300,000 trademarks applications each year and if disparaging marks are occasionally improperly registered or refused by an examiner (and therefore, absent an appeal, opposition, or cancellation proceeding, not subject to higher levels of administrative or judicial review), "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); *see also Almy*

v. Sebelius, 679 F.3d 297, 310-11 (4th Cir. 2012) (holding that agency is not bound by decisions of lower-level adjudicators). The fact that the USPTO adjudicates applications using a standard, publicly disclosed, and objective test, and issues determinations that are subject to judicial review, is more than enough to refute any claim of constitutional infirmity.

Applicants are further protected by the USPTO's practice of resolving questionable applications "in favor of the applicant on the theory that any person believed damaged by the registration would have the opportunity to oppose registration." *Mavety Media Grp.*, 33 F.3d at 1374. Pro-Football asserts that this practice somehow renders section 2(a) more constitutionally suspect. *See* Appellant's Br. 40-41. But it is difficult to fathom how the program is rendered unconstitutionally unfair to applicants by the fact that the agency errs on the side of applicants, and will only cancel a mark if a challenger who must carry the burden of proof, *see Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1356 (Fed. Cir. 2009), succeeds in showing that the mark was ineligible for registration as of the time the mark was registered.

Pro-Football also alleges that inconsistency might arise because marks that are no longer considered disparaging can nevertheless be cancelled if they were disparaging at the time of registration. Appellant's Br. 25-26. In such circumstances, the mark owner could re-register the mark once it is no longer disparaging. And Congress reasonably declined to allow the cancellation of marks that were not

disparaging at the time of registration to avoid disrupting settled expectations, which Pro-Football itself recognizes as a legitimate concern, *see* Appellant's Br. 42.

B. The passage of time did not render cancellation unconstitutional.

Pro-Football fares no better in urging that the cancellation violated the Due Process Clause because of the amount of time that elapsed between registration and cancellation. Like the vagueness challenge, this assertion fails to come to grips with the limited consequences of cancellation. Whether or not Pro-Football is correct that the deprivation here is sufficient to trigger the Due Process Clause at all, it is beyond serious dispute that any property interest implicated is slight, because Pro-Football “may still use the marks to identify its goods” and “still retains all common law rights associated with trademark use and ownership,” *International Flavors & Fragrances*, 183 F.3d at 1368; *see Mathews v. Eldridge*, 424 U.S. 319, 335 (1976) (demands of due process depend on “the private interest that will be affected by the official action”).

Pro-Football contends that the Lanham Act's cancellation provision offends due process because it imposes no deadline by which a party challenging a mark under section 2(a) must commence suit. But Pro-Football cites no case holding that a statute of limitations is a constitutional requirement. Even criminal statutes may impose no statute of limitations at all, allowing defendants to be tried, convicted, and imprisoned decades after the crime, without offending due process. *Cf. Wilson v. Mitchell*, 250 F.3d 388, 396-97 (6th Cir. 2001) (defendant tried for murder 23 years

after the crime). And here, Pro-Football's claims of prejudice ring particularly hollow because Pro-Football has known for decades that the propriety of its marks was controverted and thus had notice that it might need to preserve evidence. *See, e.g., Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1999 WL 375907 (T.T.A.B. 1999), *rev'd*, 284 F. Supp. 2d 96 (D.D.C. 2003), *remanded on other grounds*, 415 F.3d 44 (D.C. Cir. 2005).

The cases upon which Pro-Football relies stand for the very different proposition that due process concerns may arise from a substantial delay between the deprivation of a liberty or property interest and the opportunity to contest that deprivation at a hearing. *See United States v. Eight Thousand Eight Hundred & Fifty Dollars (\$8850) in U.S. Currency*, 461 U.S. 555, 564 (1983) (distinguishing the speed with which the government must provide process to “a claimant whose property has been seized” from a “suspect who has not been indicted [and] retains his liberty” pending further government action); *Mathews*, 424 U.S. at 333 (noting “dispute centers upon what process is due *prior* to the initial termination of benefits”) (emphasis added). Here, Pro-Football is being afforded not just one pre-deprivation hearing, but several. First, Pro-Football participated in a full evidentiary hearing before a panel of independent administrative trademark judges, where the challengers to the mark bore the burden of proof. *See* 15 U.S.C. § 1067; 37 C.F.R. §§ 2.111-2.136. Then, Pro-Football exercised its right to de novo judicial review on the merits. 15 U.S.C. § 1071(b). Having lost both in both of those fora, Pro-Football still enjoys the

benefits of registration while it is exercising its right to appeal to this Court.

Appellant's Br. 10.

III. Pro-Football's objections to the USPTO's constructions of the Lanham Act should be rejected.

A. Section 2(a)'s disparagement provision applies to racial groups and does not require evidence from particular individuals.

Pro-Football mistakenly contends that section 2(a)'s disparagement provision applies only to the disparagement of specific, identifiable individuals. Pro-Football properly concedes that this argument was "not raised below." Appellant's Br. 46. Indeed, Pro-Football stipulated to the proper legal test in the district court. Pro-Football Mem. of Law in Supp. of Mot. for Summ. J. 26 (Dkt. No. 100) [JA ____]. That test asked whether the mark may disparage Native Americans. *Id.* There is no basis for Pro-Football's view that this Court should overlook its clear waiver under the doctrine of constitutional avoidance. *Cf. Ohio State Conference of NAACP v. Husted*, 768 F.3d 524, 552 (6th Cir. 2014) (explaining that argument for constitutional avoidance was raised for the first time on appeal and forfeited), *vacated on other grounds*, No. 14-3877, 2014 WL 10384647 (6th Cir. Oct. 1, 2014).

Pro-Football's argument also fails on the merits. The statute prohibits registration of marks that "may disparage . . . persons, living or dead, institutions, beliefs, or national symbols." 15 U.S.C. § 1052(a). There are five living "persons" who brought this suit and allege that they and others in their racial group are

disparaged by Pro-Football's marks. The Trademark Trial and Appeal Board has construed the statute to apply in these circumstances. *See, e.g., In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 2010 WL 766488, at *2-3 (T.T.A.B. 2010). The Board's construction of the statute it is charged with administering is reasonable and entitled to deference. *See Chevron U.S.A. Inc. v. Natural Res. Def. Council, Inc.*, 467 U.S. 837 (1984); *In re Dr Pepper Co.*, 836 F.2d 508, 510 (Fed. Cir. 1987) (according *Chevron* deference to Board interpretation of trademark law).

The Lanham Act does not compel the Board to adopt Pro-Football's illogical view that the statute prohibits registration only of marks that disparage specific individuals or corporations, and not of marks that disparage groups of individuals. Pro-Football's reliance on 15 U.S.C. § 1127, which defines the term "person" for purposes of establishing which entities can apply for registration, is misplaced. That provision authorizes entities to apply for registration only if they are "capable of suing and being sued in a court of law." *Id.* But the fact that entities incapable of filing suit to enforce a trademark are ineligible to apply for registration has no bearing on whether racial slurs may be registered marks.

Moreover, elsewhere in section 2, Congress prohibited registration of any mark that "identif[ies] a *particular* living individual except by his written consent." 15 U.S.C. § 1052(c) (emphasis added). If the unqualified phrase "persons, living or dead" means "particular persons," then the term "particular" in section 2(c) would be superfluous. The statements from the congressional hearing that Pro-Football quotes (*see*

Appellant's Br. 47) concerned the intersection of section 2(a) with section 2(c). It is therefore unsurprising that they discussed "particular living individual[s]." *Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents, 76th Cong., at 18-20 (1939).*

Relatedly, Pro-Football contends that the statute requires "actual disparagement." Appellant's Br. 50-51. The USPTO agrees that there is no requirement that the applicant *intend* to disparage, and that a speculative possibility of disparagement does not suffice. But Pro-Football is mistaken to the extent that it suggests that section 2(a) requires evidence that specific individuals were "actually disparaged." It is hard to imagine what evidence would meet that burden. The agency could not plausibly demand a declaration from an individual (who might be dead, *see* 15 U.S.C. § 1052(a)) that he "felt disparaged" by being called an obviously disparaging name.

B. The USPTO appropriately addresses disparagement from the views of a substantial composite, which is not necessarily a majority, of the referenced group.

The USPTO has also reasonably interpreted the statute to apply when a "substantial composite" of the referenced group, which need not be a majority, would find the term disparaging. The statute does not give a standard for determining whether a mark "may disparage." Since 1981, the USPTO, supported by the Federal Circuit, has assessed whether a mark is "scandalous" by analyzing the views of a substantial composite, but not necessarily a majority, of the general public. *See In re*

McGinley, 660 F.2d 481, 485 (C.C.P.A. 1981), *abrogated on other grounds by Tam*, 808 F.3d 1321. And the USPTO has applied the standard at issue here for disparaging marks since 1999. *Harjo*, 50 U.S.P.Q.2d 1705, 1999 WL 375907, at *34. The USPTO's longstanding, reasonable interpretation is entitled to deference.

The USPTO's interpretation is consonant with other consumer-perception standards in trademark law, which are assessed based on less than a majority of the consumers at issue. *See, e.g., Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 127 (4th Cir.1990) (for likelihood of confusion, requiring that an appreciable number of ordinarily prudent consumers will likely be confused); 6 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 32:188 (4th ed. 2015) (surveys showing 25-50% support a likelihood of confusion are sufficient); *id.* at § 32:190 (supporting same standard for proving secondary meaning). There is no basis for Pro-Football's view that Congress required a different mode of analysis in this context.⁸

Pro-Football also does not explain how the USPTO could be expected to ascertain whether a majority of the referenced group finds a mark disparaging. For other consumer-focused tests in trademark law, the Federal Circuit has upheld the USPTO's conclusion that the agency does not have the resources to conduct market surveys and is not required to do so. *See, e.g., In re Pacer Tech.*, 338 F.3d 1348, 1351

⁸ The only area in trademark law where a showing of the view of a majority of the affected group is required is in connection with a genericness defense, where the statute specifically refers to the "*primary* significance of the registered mark to the relevant public," 15 U.S.C. § 1064(3) (emphasis added).

(Fed. Cir. 2003); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 768 (Fed. Cir. 1985). The district court thus properly recognized that to determine “whether a mark ‘may disparage,’ the [USPTO] does not, and practically cannot, conduct a poll to determine the views of the referenced group.” Mem. Op. & Order 41 [JA ____].

Particularly because no survey is required, it is not clear what Pro-Football means when it insists that the USPTO must rely on the views of a “*representative* sample or *cross-section* of the referenced group.” Appellant’s Br. 50. The district court was correct that those with “non-mainstream” views can form a substantial composite for the same reasons that a substantial composite need not necessarily be a majority. *See* Mem. Op. & Order 59 [JA ____].

As a fallback, Pro-Football alleges a distinction between ex parte registration proceedings and cancellation proceedings “where long established and valuable rights may be involved.” Appellant’s Br. 49. But cancellation is appropriate when “registration was obtained . . . contrary to the provisions of” section 2(a), 15 U.S.C. § 1064(3), so there is no statutory basis for Pro-Football’s apparent view that the legal test for eligibility for registration depends upon the procedural posture of the case. In addition, in cancellation proceedings, where the relevant time frame is the time of registration, a concurrent survey would be impossible if the cancellation proceeding occurs later than the registration.

CONCLUSION

For the foregoing reasons, the district court's judgment should be affirmed insofar as it rejected Pro-Football's constitutional challenges, and Pro-Football's arguments that the USPTO has misinterpreted section 2(a) should be rejected.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on February 4, 2016, I electronically filed the foregoing brief with the Clerk of this Court by using the appellate CM/ECF. The participants in the case are registered CM/ECF users and service will be accomplished by the appellate CM/ECF system.

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CERTIFICATE OF COMPLIANCE

I certify that the foregoing brief complies with the requirements of Federal Rule of Appellate Procedure 32(a). This brief contains 13,698 words.

s/ Joshua M. Salzman

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