

NO. 2014-1203

---

IN THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

---

IN RE: SIMON SHIAO TAM,

*Appellant*

---

Appeal from the United States Patent and Trademark Office,  
Trademark Trial and Appeal Board in No. 85472044

---

**BRIEF OF FIRST AMENDMENT LAWYERS ASSOCIATION  
AS *AMICUS CURIAE* IN SUPPORT OF SIMON SHIAO TAM**

---

Marc J. Randazza  
Randazza Legal Group  
3625 S. Town Center Drive  
Suite 150  
Las Vegas, NV 89135  
(702-) 420-2001

*Attorney for Amicus Curiae First Amendment Lawyers Association*

### CERTIFICATE OF INTEREST

Counsel for First Amendment Lawyers Association certifies the following:

1. The full name of every party or amicus curiae represented by me is:

First Amendment Lawyers Association

2. The name of the real party in interest (if the parties named in the caption are not the real parties in interest) represented by me is:

N/A

3. All parent corporations and any publicly held companies that own 10 percent or more of the stock of the party or amicus curiae represented by me are:

N/A

4. The names of all law firms and partners or associates that appeared for the party or amicus curiae now represented by me in the trial court or agency or are expected to appear in this court are:

Marc J. Randazza, Randazza Legal Group.

Marc J. Randazza  
Randazza Legal Group  
3625 S. Town Center Drive  
Suite 150  
Las Vegas, NV 89135  
(702-) 420-2001

Dated: June 18, 2015

Respectfully submitted

/s/ Marc J. Randazza

Marc J. Randazza

Attorney for Amicus

First Amendment Lawyers Association

**TABLE OF CONTENTS**

	<b>Page</b>
Table of Authorities.....	iv–v
Statement of Interest of Amicus Curiae.....	1
Summary of Argument.....	2
Argument.....	3
1.0 Introduction.....	3
2.0 Section 2(a) Is a Viewpoint-Based Restriction on Receipt of a Government Benefit in Violation of the Unconstitutional Conditions Doctrine Because It Prevents Registration of Trademarks Based on Their Content and Viewpoint.....	4
2.1 Trademarks are protected commercial speech.....	4
2.2 Trademark registration confers significant benefits, and Section 2(a) refusal can cause significant harm .....	6
2.3 Section 2(a) is a viewpoint-based restriction on protected speech .....	7
3.0 Section 2(a) Fails to Promote Any Substantial Government Interest.....	10
3.1 Discouraging the use of “immoral” or “scandalous” marks.....	10
3.2 Occupying the “time, services, and use of funds of the federal government” .....	11
3.3 Harmonizing state and federal law .....	12
3.4 Stamp of approval .....	13
4.0 Section 2(a) is Void for Vagueness .....	14
CONCLUSION.....	15
CERTIFICATE OF COMPLIANCE .....	17
CIRTIFICATE OF SERVICE.....	18

**TABLE OF AUTHORITIES**

<b>Cases</b>	<b>Page</b>
<i>Bad Frog Brewery v. New York State Liquor Authority</i> , 134 F.3d 87, 97 (2d Cir. 1998).....	3, 10, 12, 13
<i>Bolger v. Youngs Drug Products Corp</i> , 463 U.S. 60, 72 (1983). ....	11
<i>Burnwell v. Hobby Lobby</i> , 573 U.S.____, 134 S.Ct. 2751 (2014).....	5
<i>Central Hudson Gas &amp; Electric v. Public Service Commission</i> , 447 U.S. 557, 566 (1980).....	3
<i>Cohen v. California</i> , 403 U.S. 15, 25 (1971).....	3, 5, 11, 14, 15
<i>Doyle v. Continental Ins. Co.</i> , 94 U.S. 535, 543 (1876) .....	4
<i>Edenfield v. Fane</i> , 507 U.S. 762 (1993) .....	3, 7, 8, 10
<i>Florida Bar v. Went for It, Inc.</i> , 515 U.S. 618, 632 (1995).....	9, 10, 12
<i>Friedman v. Rogers</i> , 440 U.S. 1, 11 (1979).....	4
<i>Home Ins. Co. of New York v. Morse</i> , 87 U.S. 445, 451 (1871) .....	4
<i>In re Boulevard</i> , 334 F.3d 1336 (Fed. Cir. 2003).....	9, 14
<i>In re Mavety Media Group</i> , 33 F.3d 1367 (Fed. Cir. 1994).....	9, 14
<i>In re McGinley</i> , 660 F.3d 481, 484 (C.C.P.A. 1981).....	4, 6, 11, 13, 14
<i>In re Old Glory Condom Corp.</i> , 26 U.S.P.Q.2d 1216, 1219–20 (1993).....	13
<i>In re Tam</i> , No. 85472044 at 8 (Fed. Cir. Apr. 20, 2015) .....	6, 12
<i>Lawrence v. Texas</i> , 539 U.S. 558 (2003).....	10
<i>Miller v. California</i> , 413 U.S. 15 (1973).....	12, 14
<i>Renna v. County of Union</i> , 2014 U.S. Dist. LEXIS 74112 (N.J. 2014).....	6
<i>Roth v. United States</i> , 354 U.S. 476, 484 (1957).....	4, 14
<i>Rumsfeld v. Forum for Academic &amp; Institutional Rights</i> , 547 U.S. 47 (2006).....	4
<i>Simon &amp; Schuster v. New York State Crime Victims Bd.</i> , 502 U.S. 105, 115 (1991).....	7

*Thrifty Rent-a-Car System v. Thrift Cars, Inc.*, 831 F.2d 1177 (1987) ..... 6

*Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council*,  
425 U.S. 748, 762 (1976).....4, 5

*Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512 (1980)..... 6

**Statutes**

15 U.S.C. § 1052(a).....*passim.*

15 U.S.C. § 1057 ..... 6

15 U.S.C. § 1072 ..... 6

15 U.S.C. § 1121 ..... 6

15 U.S.C. § 1117 ..... 6

15 U.S.C. § 1124..... 6

**STATEMENT OF INTEREST OF AMICUS CURIAE<sup>1</sup>**

Amicus First Amendment Lawyers Association (“FALA”) is a national, non-profit organization of approximately 200 members who represent the vanguard of First Amendment lawyers. Its central mission is to protect and defend the First Amendment from attack by both private and public incursion. Founded in the late 1960s, *Amicus*’ membership has been involved in many landmark cases defining the legal status of adult entertainment, including *United States v. Stevens*, 559 U.S. \_\_\_, 130 S.Ct. 1577 (2010); *Ashcroft v. Free Speech Coalition*, 535 US. 234 (2002); *United States v. Playboy Entertainment Group*, 529 U.S. 803 (2000); *Toffoloni v. LFP Publishing Group LLC*, 40 Media L. Rep. 1681, \_\_\_F.3d\_\_\_ (11th Cir. 2012); *United States v. Extreme Associates, Incorporated*, 431 F.3d 150 (3d Cir. 2005); *United States v. Stagliano et al.*, 693 F. Supp. 2d 25 (D.D.C. 2010); *United States v. Little*, 2008 WL 2959751 (M.D. Fla. 2008); *alameda Books v. City of Los Angeles*, 222 F.3d 719 (9th Cir. 2000), *rev’d*, 535 U.S. 425 (2002), and *United States v. Investment Enterprises*, 10 F.3d 263 (5th Cir. 1993).

FALA’s members often represent adult entertainment companies’ interests in trademark matters, which underlies this suit. The instant dispute concerns the constitutionality of Lanham Act § 2(a). This question is central to the demonstrated interests and activities of FALA’s membership. FALA therefore has both a substantial interest in the subject matter and significant knowledge that the Court should find useful in evaluating the future of Section 2(a).

---

<sup>1</sup> The First Amendment Lawyers Association submits this brief as an *amicus curiae* pursuant to Fed. R. App. Pro. 29(a) and Circuit Rule 29(c). No party or party’s counsel authored the brief in whole or in part or contributed money intended to fund preparing or submitting it and no person other than *amicus curiae* contributed money intended to fund its preparation or submission.

### **SUMMARY OF ARGUMENT**

The rehearing of this appeal is constrained to the sole issue of the constitutionality of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a). This provision of the Lanham Act violates the First Amendment of the United States Constitution in that it is a viewpoint-based restriction on protected commercial speech because it deprives citizens of a federal benefit based on both the content and the viewpoint of their speech. No articulable substantial government interest exists to justify this restriction. Even if such an interest did exist, Section 2(a) is not sufficiently narrowly tailored to materially advance the interest.

## ARGUMENT

### 1.0 Introduction

The unconstitutional restrictions on trademarks containing “immoral . . . or scandalous matter; or matter which may disparage” imposed by Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), impede trademark applicants from receiving the benefits of federal trademark registration. This section restricts rights protected under the First Amendment. Though trademarks are limited in their ability to be “distasteful,” at least compared the copyrightable works, the ones that are potentially “immoral” or “scandalous” still embody the notion that “one man’s vulgarity is another’s lyric.” *Cohen v. California*, 403 U.S. 15, 25 (1971). Trademarks convey the kind of speech the First Amendment wishes to circulate into the “marketplace of ideas;” trademark holders have financial incentives to make their name acceptable to the public, and the public has the power to reject those trademarks. *See Edenfield v. Fane*, 507 U.S. 762 (1993). By limiting this speech, and imposing unconstitutional conditions to the registration and enforcement of “immoral and “scandalous” words, Section 2(a) limits free speech and commercial expression.

“Minimal information, conveyed in the context of a proposal of commercial transaction suffices to invoke the protection for commercial speech articulated in *Central Hudson*.” *Bad Frog Brewery v. New York State Liquor Authority*, 134 F.3d 87, 97 (2d Cir. 1998). The Supreme Court in *Central Hudson* determined that where speech is protected, the court must determine “whether the asserted government interest is substantial . . . whether the regulation directly advances the government interest asserted, and whether it is not more extensive than is necessary to serve that interest.” *Central Hudson Gas & Electric v. Public Service Commission*, 447 U.S. 557, 566 (1980). Section 2(a) violates the First Amendment because it is a viewpoint-based restriction on protected speech that does not advance any substantial government interest.

## **2.0 Section 2(a) Is a Viewpoint-Based Restriction on Receipt of a Government Benefit in Violation of the Unconstitutional Conditions Doctrine Because It Prevents Registration of Trademarks Based on Their Content and Viewpoint**

Under the unconstitutional conditions doctrine, the government may not condition the availability of a government benefit on an individual's agreement to surrender a constitutional right. *See Home Ins. Co. of New York v. Morse*, 87 U.S. 445, 451 (1871); *Doyle v. Continental Ins. Co.*, 94 U.S. 535, 543 (1876); *Rumsfeld v. Forum for Academic & Institutional Rights*, 547 U.S. 47 (2006). Trademark registration is designed to provide government benefits to trademark registrants. *See In re McGinley*, 660 F.2d 481, 486 n.12 (1981) (“What is denied are the benefits provided by the Lanham Act which enhance the value of a mark.”). As a viewpoint-based restriction on protected speech, Section 2(a) violates this doctrine.

### **2.1 Trademarks are protected commercial speech**

The First Amendment protects “[a]ll ideas having even the slightest redeeming social importance.” *Roth v. United States*, 354 U.S. 476, 484 (1957). This includes commercial speech, which proposes a commercial transaction. *See Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748, 762 (1976). Trademarks are commercial speech because they convey messages about the type, cost, and quality of the products or services associated with the mark. *See Friedman v. Rogers*, 440 U.S. 1, 11 (1979). Trademarks help consumers identify the quality of a certain good or service so the consumer can choose whether or not to repeat their purchasing experience. “Society [] has a strong interest in the free flow of commercial information, both because the efficient allocation of resources depend upon informed consumer choices,” and because such information is of general public interest. *Id.* Thus, protection of trademarks supports not only the speaker, but also the consumer’s right to “receive information and ideas.” *See Virginia State Bd.*, 425 U.S. at 756.

In *Virginia State Bd.*, the Virginia Consumer Council argued for limiting price advertising for pharmacies because it had an interest in maintaining professionalism in the pharmacy industry. The Court denied this argument, stating that any pharmacist acting against his customers' interest would not only lose his license, but customers would likely stop going to that pharmacist. *Id.* The First Amendment "is designed and intended to remove governmental restraints from the arena of public discussion, putting the decision as to what views shall be voiced largely into the hands of each of us." *Cohen v. California*, 403 U.S. 16 (1971). Trademarks are one of the simplest places to apply this kind of societal control. Like consumers who choose a pharmacist who has their interests in mind, consumers who do not approve of the name or message sent by a trademark will refrain from patronizing that company. But the government should not place an unconstitutional condition on the registration and enforcement of otherwise valid trademark rights.

Additionally, trademarks provide consumers with information concerning the ideals and philosophical underpinnings of a company. "Advertising, however tasteless and excessive it sometimes may seem, is nonetheless dissemination of information," and this information can be vital to consumers in determining what companies to purchase from. *Virginia State Bd.*, 425 U.S. at 765. Trademark holders and company owners use trade names and businesses to promote their personal views and make those views known to their customers. *See e.g. Burnwell v. Hobby Lobby*, 573 U.S. \_\_\_, 134 S.Ct. 2751 (2014).

Trademarks are speech protected by the First Amendment. Aside from protecting the public from trademarks that are deceptive or concern unlawful activity, the PTO's refusal of a mark under Section 2(a) and the impairment of the right to enforce the rights under such marks, amounts to a restraint on protected speech that requires substantial justification. No such justification exists here.

## **2.2 Trademark registration confers significant benefits, and Section 2(a) refusal can cause significant harm.**

Trademark registration is not a frivolous act, as suggested by the court in *In re McGinley*, which stated that “refusal to register [an applicant’s] mark does not affect his right to use it.” *In re McGinley*, 660 F.3d 481, 484 (C.C.P.A. 1981). The Lanham Act provides numerous statutory benefits to registered marks not similarly conferred by non-registered or state registered marks. For example, a certificate of federal registration (1) is prima facie evidence of validity (15 U.S.C. §1057); (2) provides constructive notice of trademark ownership (*Id.*, § 1072); (3) provides protection from certain state requirements for displaying marks (*Id.*, § 1121); (4) allows recovery of statutory damages and attorney fees (*Id.*, §1117); and (5) provides the ability to prevent importation of infringing goods (*Id.*, § 1124). Aside from the explicit benefits provided by the Lanham Act, registration is likely to increase income from trademark licensing and helps to generate nation-wide goodwill for the product or service.

Since many state trademark laws imitate the Lanham Act, an unsuccessful trademark applicant will likely not receive these benefits under state law, either. *See In re Tam*, No. 85472044 at 8 (Fed. Cir. Apr. 20, 2015) (Moore, J.). Using a mark without registration only permits protected use within the owner’s geographic area, and thus the unregistered trademark holder is subject to competition avoided by trademark registrants. *See, e.g. Thrifty Rent-a-Car System v. Thrift Cars, Inc.*, 831 F.2d 1177 (1987); *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512 (1980).

Despite the many benefits it provides, the Lanham Act is not, in practice, a purely benevolent statute for trademark applicants. Refusal under Section 2 of the Lanham Act can serve as a scarlet letter that precludes enforceability of the mark even under Section 43(a), which protects unregistered marks. *See Renna v. County of Union, N.J.*, 2014 U.S. Dist. LEXIS 74112 at \*26-27 (finding that mark found unregistrable due to Lanham Act Section 2(b) was not entitled to protection under Section 43(a));

*and see In re Fox*, 702 F.3d 633, 640 (Fed. Cir. 2012) (subsequent to refusing registration of COCK SUCKER mark on Section 2(a) grounds, stating that the applicant “will be unable, however, to call upon the resources of the federal government in order to enforce the mark”). The stigma that attaches to an unsuccessful applicant is relevant because “a statute is presumptively inconsistent with the First Amendment if it imposes a financial burden on speakers because of the content of their speech.” *Simon & Schuster v. New York State Crime Victims Bd.*, 502 U.S. 105, 115 (1991). Refusals increase costs to trademark applicants seeking to register or use allegedly “immoral” or “scandalous” trademarks; they may endure the cost of a federal registration application, state registration application, appeals, cost in changing their logo or business name to comply with Section 2(a), and costs of the complete strip of trademark eligibility.

Individuals and businesses refrain from using certain terms as trademarks for fear the PTO might see the terms as immoral, scandalous, or derogatory, in violation of section 2(a). Such self-censorship narrows the spectrum of speech in the public marketplace. For these reasons, Section 2(a) denies government benefits and places monetary and legal burdens on applicants with allegedly “immoral” or “scandalous” marks in violation of the First Amendment.

### **2.3 Section 2(a) is a viewpoint-based restriction on protected speech.**

Section 2(a) is a restriction based on the content of an applicant’s trademark. An impossible to quantify “value” to society provided by the mark should not be relevant to the government’s circumvention of First Amendment protection, as

the commercial marketplace, like other spheres of our social and cultural life, provides a forum where ideas and information flourish. Some of the ideas and information are vital, some of slight worth. But the general rule is that the speaker and the audience, not the government, assess the value of the information presented.

*Edenfield v. Fane*, 507 U.S. 761, 767 (1993).

In *Edenfield*, the Court determined that a rule prohibiting CPAs from engaging in in-person solicitation, as applied, violated the First Amendment, finding that the law threatened access to accurate commercial information. *Id.* at 777. Similarly, Section 2(a) restricts consumers' access to accurate commercial information about the business the trademark is affiliated with, as well as to any additional speech conveyed by the trademark itself. As with anyone exercising their First Amendment rights, trademark holders should be permitted to engage in commercial speech with consumers potentially interested in their products or associated ideas.

*In re Fox* tells us that trademarks are protected by the First Amendment, and that Section 2(a) is a viewpoint-based restriction on such protected speech. In that case, the Federal Circuit determined that the mark "COCKSUCKER" for rooster-shaped chocolate lollipops was "scandalous" under Section 2(a). *In re Fox*, 702 F.3d at 639–40. In its decision, the court determined that in addition to satisfying the definitions of scandalous, if a mark has *any* "vulgar" meaning it is *per se* scandalous. *Id.* at 635. Thus, the court applied Section 2(a) to determine whether the "public will assign" a scandalous meaning to the mark even if the mark is a double entendre. *Id.* at 636. The applicant in *In re Fox* wanted to use the mark "COCKSUCKERS" as a joke, playing off the multiple definitions of the words and their literal meaning as applied to her actual product, rooster lollipops. *Id.* By using an exact definition, the court removed all possible humor from the name. One does not look at the mark "Cocksuckers" and think "that is quite humorous because it is in reference to 'one who performs an act of fellatio,'" as the court suggested. *See id.* at 635. Instead, it is inherently humorous because we live in a society with "taboo" statements that are not inherently unacceptable.

This decision, and the court's reasoning therein, establishes that trademarks possess elements of speech beyond merely identifying the source of goods and

services; indeed, how could speech that merely identifies the source of goods or services be “vulgar” at all, such that it could offend the sensibilities of the PTO? The only effect of Section 2(a) is for the PTO to make a determination that certain terms, which express particular viewpoints about particular subjects, are off-limits.

In a similar case, the Federal Circuit determined “jack-off” to be an immoral and scandalous term in *In re Boulevard*, despite evidence showing that the term was neither. 334 F.3d 1336 (Fed. Cir. 2003). The court interpreted *In re Mavety Media Group*, 33 F.3d 1367 (Fed. Cir. 1994), to say that dictionary definitions alone were insufficient to determine whether a mark was “scandalous,” except where there is only one pertinent meaning as applied to the trademark at issue. *Boulevard*, 334 F3d at 1340. The applicants had provided evidence “to show that the term . . . is not immoral or scandalous,” but the court found that the declarations in the record “consist[ed] mainly of the personal opinions of the declarants as to the offensiveness of the term.” *Id.* at 1341. Once it determined that “masturbation” was *the* definition of the term “jack-off,” the court found the term to be offensive and ignored all evidence to the contrary as “wholly irrelevant.” *Id.* at 1343. The court picked one definition of the term “jack-off,” decided it was “offensive,” and then withheld a federal benefit to the applicant based on the viewpoint towards a sexual topic expressed by the applicant’s trademark. This is not the kind of determination that courts or the PTO make only when feeling especially authoritarian; this is a determination that *any* trademark examiner *must* make when choosing to refuse registration on Section 2(a) grounds. There simply is no viewpoint-neutral, much less content-neutral, way to refuse registration based on Section 2(a).

Because Section 2(a) limits this transfer of information based on the viewpoint expressed by a trademark, it regulates protected speech. In light of this, Section 2(a) must be “narrowly tailored” to serve a substantial government interest. *Florida Bar v. Went for It, Inc.*, 515 U.S. 618, 632 (1995). It is not.

### **3.0 Section 2(a) Fails to Promote Any Substantial Government Interest.**

Under First Amendment jurisprudence, the requirement of a substantial government interest “is not satisfied by mere speculation or conjecture; rather, a governmental body seeking to sustain a restriction on commercial speech must demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree.” *Florida Bar v. Went for It, Inc.*, 515 U.S. at 628. Instead, trademarks can facilitate societal change by “providing a forum where ideas and information flourish. . . . [where] the audience, not the government, assess[es] the value of the information presented.” *Edenfield*, 507 U.S. at 1798. “Laws restricting commercial speech . . . need only be tailored in a reasonable manner to serve a substantial state interest.” *Id.*; see also, *Bad Frog* 134 F.3d at 98. The PTO has not historically articulated any interest that can justify the existence of Section 2(a), and no such interest is even conceivable.

#### **3.1 Discouraging the use of “immoral” or “scandalous” marks.**

Section 2(a) is a viewpoint-based restriction on speech that the government finds “immoral.” The U.S. Supreme Court has stated in no uncertain terms that “[t]he fact that a State’s governing majority has traditionally viewed a particular practice as immoral is not a sufficient reason for upholding a law prohibiting the practice.” *Lawrence v. Texas*, 539 U.S. 558 (2003). While *Lawrence* dealt with an anti-sodomy law, its reasoning is just as applicable to Section 2(a); the PTO cannot use “morality” to justify the selective restriction and governmental discouragement of protected speech on the basis of its content or message.

The registration and operation of trademarks does not implicate more valid concerns such as the privacy or physical safety of consumers, either. The court in *Florida Bar v. Went for It, Inc.* accepted the government’s interest in protecting individuals’ privacy as a reason to uphold a 30-day solicitation ban for personal injury attorneys because the attorneys had a business incentive to seek out persons who had

been in accidents. This interest in privacy was sufficient to sustain a restriction on commercial speech. The general consuming public, however, has a choice to purchase from the trademark holder, and the mere registration of an “offensive” trademark can in no way invade the privacy of individuals, just as a jacket stating “fuck the draft” does not invade the privacy of people in a public space. *See Cohen*, 403 U.S. 15. Rather, consumers have a greater ability to “avoid further bombardment of their sensibilities” by not only “simply averting their eyes,” but by denying a certain company their business. *Id.* at 21. A “short, though regular, journey from mail box to trash can” has been found to be an acceptable burden under the Constitution. *Bolger v. Youngs Drug Products Corp.*, 463 U.S. 60, 72 (1983). In *Bolger*, the Court held that the intrusion of mail for contraceptives into one’s home was acceptable and could not be constitutionally banned. How, then, could the registration of an “immoral” or “scandalous” display in an advertisement or a storefront be so invasive as to justify a restraint on protected speech? Avoiding going to an offensive store, calling for their services, or searching for them on the Internet is not a significant burden the court need relieve the public of.

### **3.2 Occupying the “time, services, and use of funds of the federal government”**

Courts have previously attempted to justify Section 2(a) under the reasoning that this provision reflects “a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.” *McGinley*, 660 F.2d at 486. This reasoning, as with much of *McGinley*, collapses under scrutiny. As the dissent in that case pointed out, “[m]ore public funds are being expended in the prosecution of this appeal than would ever result from the registration of the mark.” *See McGinley*, 660 F.2d at 487 (Judge Rich dissenting). Even if Congress’ supposed rationale was sufficient justification for the restrictions on protected speech created by Section 2(a), the supposed cost-saving purpose of this provision has never been borne

out by reality. The time and consideration it takes to determine whether a mark is “immoral” or “scandalous” is burdensome on the PTO, the courts, and mark owners. Opinions on issues of morality change almost daily and also depend on geographic standards, a trait that Section 2(a) shares with determinations on whether speech is “obscene.”<sup>2</sup> Thus, a determination of “immorality” or “scandalousness” under Section 2(a) is not one that can easily be made based on “history, consensus, and simple common sense.” *Florida Bar*, 515 U.S. at 628.

Further, “a prohibition that makes only a minute contribution to the advancement of a state interest can hardly be considered to have advanced the interest to a material degree.” *Bad Frog*, 134 F.3d at 99. Thus, even if Section 2(a) did manage to net the PTO some small savings, this would be insufficient to justify the Section’s existence, as the government must show that “the harms it recites are real and that its restriction will in fact alleviate them to a *material degree*.” *Id.* (emphasis in original).

### **3.3 Harmonizing state and federal law**

Some courts have stated that the government has a substantial interest in harmonizing federal trademark law with state law, which generally contains provisions similar to Section 2(a). *See In re Tam*, No. 85472044 21–22 (Fed. Cir. Apr. 20, 2015) (Judge Moore) (discussing state case law barring vulgar and misleading marks). This argument, however, puts the cart before the horse. Most state trademark law is modeled after the Lanham Act, not vice versa. Further, there is no indication that these laws could not be easily changed. General changes to the Lanham Act do not commonly frustrate the government’s goal in promoting national harmony. In *Bad Frog Brewery*, the government proposed a similar interest in “promoting national

---

<sup>2</sup> While obscene speech is not afforded protection under the First Amendment, it is difficult to conceive of a trademark that could be considered legally obscene by today’s sexually liberal common community standards. *See Miller v. California*, 413 U.S. 15 (1973).

uniformity” among liquor laws when the New York State Liquor Authority denied approval for a liquor label depicting a frog with his middle finger up. The court there stated, “it is questionable whether a restriction on offensive labels serves any of [the] statutory goals.” *Id.* at 93. Similarly, the PTO states that it seeks to maintain similarity between the Lanham Act and the mirroring state laws. This proposed justification of Section 2(a) is circular, as an unconstitutional federal statute cannot point to similar state statutes to justify its existence. If Section 2(a) is found unconstitutional, then every state in the Union will very quickly remove sections of their respective trademark laws equivalent to Section 2(a).

### **3.4 Stamp of approval**

Another suggested government interest in Section 2(a) is that Section 2(a) prevents the public from assuming the PTO approves of “immoral” trademarks. *See In re McGinley*, 660 F.2d at 844. The government does not, however, have any issue archiving copyrightable works that many find distasteful. This is not colonial England, where citizens had to receive permits to publish their speech. People do not assume that someone can say something only with the government’s consent and approval. The same logic applies to the conferral of government benefits for purposes that are wholly unrelated to the content of the benefited speech. Trademark law exists to improve the experience of customers in the marketplace, not to protect people from “immoral” or “scandalous” speech.

But this is beside the point, as there is no guesswork involved in whether the PTO expresses approval of a trademark’s message by granting registration. The PTO explicitly denies any approval of the message conveyed by a trademark. *See In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219–20 (“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”). Moreover, just as “the mere presumed presence of unwitting listeners or viewers does not serve automatically to justify curtailing all

speech capable of giving offense” (*Cohen*, 403 U.S. at 21), the mere presumed presence of people who erroneously consider trademark registration as a government stamp of approval does not justify curtailing all possibly “immoral” or “scandalous” speech.

#### **4.0 Section 2(a) is Void for Vagueness.**

The multitude of Section 2(a) cases show that Section 2(a) does not convey “sufficiently definite warning as to the proscribed conduct when measured by common understanding and practices,” as required by the Constitution. *Roth v. United State*, 354 U.S. 467, 491 (1957). In applying Section 2(a), “[t]he determination that a mark comprises scandalous matter is a conclusion of law based upon underlying factual inquiries.” *In re Mavety Media Group*, 33 F.3d 1367, 1371 (Fed. Cir. 1994). In *In re Mavety*, the court noted that there needs to be information about the view of a “substantial composite of the general public, the context of the relevant marketplace, or contemporary attitudes.” *Id.* at 1373. Additionally, the court stated, “we must be mindful of ever-changing social attitudes and sensitivities.” *Id.* at 1371. This standard is similar to the standard for assessing obscenity, but addresses protected speech. *Cf. Miller v. California*, 413 U.S. 15 (1973). Though *McGinley* specifically rejected this comparison, the Supreme Court has used obscenity law to show that speech enjoys full First Amendment protection where it does not fall under unprotected or significantly less protected categories of speech. *See Cohen v. California*, 403 U.S. at 20.

To prove that a mark is scandalous, one “must demonstrate that the mark is ‘shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; giving offense to the conscience or moral feelings; or calling out for condemnation,” but “a showing that a mark is vulgar is sufficient to establish that it consists of or comprises immoral or scandalous matter within the meaning of section 1052(a).” *In re Fox*, 702 F.3d 633, 635 (Fed. Cir. 2012). This standard is said to be “determined from the standpoint of a substantial composite of the general public, and in the context of contemporary attitudes.” *Id.*; *In re Boulevard*, 334 F.3d 1336 (Fed. Cir.

2003). However, in reality it is very often determined by the personal sensibilities of a single examining attorney. “Vulgar” is a separately defined term and is not even included among the many definitions provided for “scandalous,” yet it appears to have the same legal effect as determining that a term is “scandalous.” *See id.* This confusing mess of terminology unerringly causes the registrant to take a wild guess as to which words the PTO will determine to be “scandalous.” The terms bandied about by the PTO and the courts most certainly do not “inform the ordinary person” whether their trademark will be refused registration. *Cf. Cohen*, 403 U.S. at 19.

### CONCLUSION

The court and the PTO cannot suppress trademarks without also suppressing the ideas they provide. *See Cohen*, 403 U.S. at 26. Trademarks provide information to potential consumers, ranging from commercial information about their goods and services to information pertaining to company values, beliefs, and ideas. Therefore, the government cannot use Section 2(a)’s restriction on “immoral . . . or scandalous matter; or matter which may disparage,” to suppress the protected speech encompassed by trademarks without adequate justification. While a an unsuccessful trademark applicant may indeed continue to use a mark refused registration on Section 2(a) grounds, the value of that mark is hobbled and unenforceable, thereby making it less attractive and causing applicants to self-censor their use of potentially “immoral” or “scandalous” marks. This removes such speech from the marketplace of ideas, leaving only speech that the PTO finds appropriate and refuses significant rights of enforcement. Section 2(a) is thus an affront to the First Amendment. It does not advance any substantial government interest, and is not narrowly tailored to serve any interest the government ever has, or ever could, put forth to justify it. Courts have allowed Section 2(a) to exist unquestioned for far too long. It is unconstitutional and has done great harm to the marketplace of ideas for decades. Section 2(a) delendum est!

DATED: June 18, 2015

RANDAZZA LEGAL GROUP

By: /s/ Marc J. Randazza \_\_\_\_\_

Marc J. Randazza

Randazza Legal Group

3625 S. Town Center Drive

Suite 150

Las Vegas, NV 89135

(702-) 420-2001

### **CERTIFICATE OF COMPLIANCE**

This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B). The brief contains 5,659 words, excluding the parts of the brief exempted by Federal Rule of Appellate Procedure 32(a)(7)(B)(iii).

This brief complies with the typeface requirements of Federal Rule of Appellate Procedure 32(a)(5) and the type style requirements Federal Rule of Appellate Procedure 32(a)(6). The brief has been prepared in a proportionally spaced typeface in 14-point Garamond font.

By: /s/ Marc J. Randazza  
Marc J. Randazza  
Randazza Legal Group  
3625 S. Town Center Drive  
Suite 150  
Las Vegas, NV 89135  
(702-) 420-2001

June 18, 2015

**CERTIFICATE OF SERVICE**

I hereby certify that on the 18th day of June, 2015, I filed the foregoing Brief of *Amicus Curiae* First Amendment Lawyers Association using the Court's CM/ECF system, which will provide notification to all registered users.

/s/ Marc J. Randazza

Marc J. Randazza

Attorney for *Amicus Curiae*

First Amendment Lawyers Association