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(Serial No. 85/472,044)

IN THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

IN RE SIMON SHIAO TAM

Appeal from the United States Patent and Trademark Office,
Trademark Trial and Appeal Board

EN BANC BRIEF FOR APPELLEE

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STATEMENT OF RELATED CASES

Appellee, the Director of the U.S. Patent and Trademark Office, is not aware of any other appeal from the Trademark Trial and Appeal Board in connection with this trademark application that has previously been before this or any other court. This case was decided by the panel on April 20, 2015, *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015) (Judges Lourie, Moore, and O'Malley), but that opinion was subsequently vacated and rehearing en banc was ordered, *In re Tam*, 600 F. App'x 775 (Apr. 27, 2015).

In re Brunetti, No. 2015-1109 (Fed. Cir., appendix filed June 11, 2015), is currently pending in this Court and involves the constitutionality of the portions of 15 U.S.C. § 1052(a) (“section 2(a)”) prohibiting registration of “scandalous” or “immoral” marks. Although this case concerns the portion of section 2(a) that addresses “disparag[ing]” marks, a decision in this case could potentially bear on Brunetti’s constitutional claims. In addition, in *Pro-Football, Inc. v. Blackhorse*, No. 1:14-cv-1043, 2015 WL 4096277 (E.D. Va. July 8, 2015), the Eastern District of Virginia upheld the constitutionality of the “disparag[ing]” provision of section 2(a). Any appeal in that case would be to the Fourth Circuit.

INTRODUCTION

The question in this case is whether the First Amendment requires Congress to open the Principal Register of the United States to trademarks that comprise racial slurs, and thereby embrace those racial slurs as instruments of federal law. Appellant Simon Shiao Tam is explicit about the breadth of his constitutional theory: According to Tam, if Congress wishes to create a federal trademark registration program at all, it must extend that program to the most vile racial epithets and images. Tam's brief provides a partial list of the racist terms that the U.S. Patent and Trademark Office (USPTO) would be required to record on its register if his constitutional theory were to prevail. *See* Appellant's En Banc Br. 12. We see no need to repeat that list here.

Tam'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 any congressional action. Indeed, for more than a century, trademarks proliferated in the United States without any federal trademark statute at all. Even today, no Act of Congress is required for a manufacturer, shop owner, or rock band to use its preferred trademark or to protect its mark in court from misappropriation by others.

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 federal benefits to every conceivable mark. The Lanham Act excludes from federal registration certain categories of marks whose enforcement Congress has not impeded, but has simply chosen not to underwrite in this fashion.

In this case, Tam contends that Congress's decision to bar the federal registration of trademarks comprising racial slurs and other disparaging marks in section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), violates his right to freedom of speech under the First Amendment. But section 2(a) does not in any way abridge Tam's speech. Rather, the statute limits the marks eligible for federal registration and for certain associated legal benefits that facilitate enforcement of the mark against infringers.

Nothing in the Constitution requires Congress to open the Principal Register of the United States to racial slurs—or religious insults, ethnic caricatures, misogynistic

images, or any other disparaging terms or logos—and thereby adopt such marks as affirmative instruments of federal law. The First Amendment limits Congress’s ability to restrict the expression of ideas, including the use of racial slurs. But it does not require Congress to *assist* those who seek to use racial epithets as trademarks in interstate commerce. And the First Amendment certainly does not put Congress to the choice of either eliminating the federal trademark registration program altogether or extending it to racial slurs.

Tam fails to articulate any coherent First Amendment theory that would require this Court to set aside the registration requirements established by Congress. Tam does not dispute that the Lanham Act leaves him free to choose and publicize the name he wants for his band and to protect any common-law trademark rights he has in that name. He identifies no limit that the federal trademark registration requirements place on his ability to express whatever message he wishes in his lyrics and marketing. He can advocate for or against any cause he desires, and he can use any racist term or imagery that he likes in doing so, regardless of the terms of the Lanham Act. What he cannot do is demand that the federal government assist him in that effort by inscribing a racial slur on the Principal Register of the United States.

STATEMENT OF THE ISSUE

Congress provided that disparaging trademarks, such as racial slurs, shall not be eligible for federal registration. 15 U.S.C. § 1052(a). The question presented is whether that congressional judgment violates the First Amendment.

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 Fed. Cas. 742 (D. Mass. 1844). In 1844, Justice Story described the basic principles of trademark infringement to be “very familiar to the profession,” and “not . . . susceptible of any judicial doubt.” *Taylor*, 23 Fed. 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 Trademark Cases*, 100 U.S. 82 (1879). The Supreme Court recognized, however, that “[t]he right to adopt and use a symbol or device to distinguish the goods or property made or sold by the person whose mark it is . . . has long been recognized by the common law.” *Id.* at 92.

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. 724.¹ 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. For a trademark registrant to take advantage of the benefits of federal registration, it was “the duty of the registrant to give notice to the public that a trade-mark is registered, either by affixing thereon the words ‘Registered in U.S. Patent Office,’ or abbreviated thus, ‘Reg. U.S. Pat. Off.,”’ or by putting that language on a label or package. *Id.* § 28, 33 Stat. at 730.

But certain types of marks could not be 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 726. Also prohibited from registration were marks “[c]onsist[ing] of or compris[ing] immoral or scandalous

¹ A second trademark statute had been passed in 1881, but it provided for the registration only of marks used in commerce with foreign countries or Indian tribes and not marks used in interstate commerce. Act of Mar. 3, 1881, ch. 138, 21 Stat. 502.

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 (Dec. Comm’r Pat. 1943).

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). This case concerns registration on the Principal Register.

In the context of enforcement proceedings, a federal trademark registration is *prima facie* evidence of the validity of the registered 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. 15 U.S.C. § 1157(b). 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 gives constructive nationwide notice of the registrant's claim of ownership of the mark. 15 U.S.C. § 1072. 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. The constructive notice provided by registration stands as a disincentive for others to use the mark even in areas geographically remote from the area where the mark has already been used. *See Dawn Donut Co. v. Hart's Food Stores, Inc.*, 267 F.2d 358, 362 (2d Cir. 1959) (citing 15 U.S.C. § 1072); *see also First Sav. Bank, F.S.B. v. First Bank Sys., Inc.*, 101 F.3d 645, 651 (10th Cir. 1996) (noting that nationwide scope of registered trademarks arises from “nationwide constructive notice to competing users”). Constructive notice also 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).

Congress provided a special cause of action for owners of federally registered marks to protect those marks and, in the case of the use of counterfeit marks, provided 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, the Lanham Act specifies other benefits to prevent the false or misleading identification of the source of goods or services. For example, Congress created a cause of action in federal court for false or deceptive representations about the origin of goods or services, which does not depend on federal registration. 15 U.S.C. § 1125(a). The Lanham Act also provides a right to prevent cybersquatters from misappropriating domain names containing trademarks. *Id.* § 1125(d).² And when a mark is famous, the owner is entitled to the same statutory damages as federally registered marks. *Id.* § 1125(c)(5).

² Tam asserts (Appellant’s En Banc Br. 10 n.2) that registration provides the rights against cybersquatters, but those rights do not depend on federal registration. *See* 15 U.S.C. § 1125(d)(2)(A)(i) (explaining that a mark’s owner may sue over a domain name if it is registered *or* otherwise protected under Lanham’s Act’s false designation or dilution provisions).

Like the 1905 Trademark Act, the Lanham Act prohibits federal registration—though not use—of certain types of marks, in addition to those likely to cause confusion with existing 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).

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). In particular, the en banc Court has directed the parties to address whether the First Amendment compels the USPTO to inscribe on its register marks that “may disparage . . . persons, living or dead.”

B. Facts and Prior Proceedings

1. USPTO Proceedings

Appellant Simon Shiao Tam seeks federal registration of the proposed mark THE SLANTS for “live performances by a musical band.” A23-36. He originally applied for federal registration in 2010, but abandoned that application and reapplied in 2011. Panel Op. 2. He based his application on his use of the mark in conjunction with his band since at least 2006. A24. The examining attorney at the USPTO refused registration under section 2(a), finding the mark disparaging (A37-206; A242-49; *see also* A298-309), and the Trademark Trial and Appeal Board affirmed (A1-17).

The Board applied a well-established two-part test. First, the Board ascertained “the likely meaning of the matter in question” in context. A8 (internal quotation marks omitted). Then, having concluded that the mark refers to identifiable persons, in this case persons of East Asian ancestry, the Board considered “whether that meaning may be disparaging to a substantial composite of the referenced group.” A8 (internal quotation marks omitted); *see In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) (same test).

The Board noted that the word “slant” has several definitions. When referring to people, it is defined to be “Offensive Slang Used as a disparaging term for a person of East Asian birth or ancestry.” A6 & n.7 (citing A219 (Tam presenting definition from American Heritage Dictionary)). In the context in which the band uses the term, the Board found that the likely meaning of THE SLANTS is that offensive slang usage. A10-11. The Board explained that Tam “actively seeks to associate his services with this meaning as a way to embrace this slang meaning and to ‘own’ the stereotype represented by THE SLANTS.” A11; *see also* A4; A130 (quoting Tam (who is also known as Simon Young (A5 n.5; A100)) as attempting “‘to reclaim [the slanted-eyes] stereotype and take ownership of it’”); A93; A52 (band’s website discussing that band name is based on being proud of Asian cultural heritage).

The Board next determined that the mark is disparaging to a substantial composite of the referenced group. A15-17. “The dictionary definitions, reference works and all other evidence unanimously categorize the word ‘slant,’ when meaning a

person of Asian descent, as disparaging.” A16; *see, e.g.*, A219 (“Offensive Slang” and “disparaging term”); A236 (“depreciative and offensive”); A53 (“derogatory”); A83; A168; A177; A197 (same); A75 (“pejorative”); A134-35 (included in list of “Ethnic Slurs”); A136 (“Offensive Slang” and “disparaging term”); A141 (same); A142 (“Offensive”); A145 (“derog and offensive”); A174 (included in “The Big Book of Being Rude”); A181-82 (using symbol that refers to “terms of contempt and derision . . . of strongest impact”); A194 (“Intended and perceived as derogatory. User is considered to be racially bigoted”); A48-49 (“derogatory,” “demeaning,” and a “racial slur[]” that “cripple[s] the spirit”). Given that consensus, along with record evidence that Asian individuals and groups object to the use of the term in the context of this particular band, the Board determined that the mark was disparaging to a substantial composite of Asian Americans. A16.

The Board also addressed Tam’s apparent “good intentions underlying his use of the term,” explaining that those good intentions were irrelevant to the analysis. A16-17. The Board reasoned that the band’s intent to “own” the stereotype is irrelevant to whether a substantial composite of the referenced group finds the term disparaging. A11. Quoting the examining attorney, the Board explained that, “while [Tam] may not find the term disparaging, [Tam] does not speak for the entire community of persons of Asian descent.” A16 (quoting A43).

Finally, following this Court’s precedents, the Board rejected Tam’s First Amendment challenge to the prohibition on federal registration of disparaging marks.

It explained that Tam’s “‘First Amendment rights would not be abridged by the refusal to register [his] mark’” because no conduct is proscribed and no tangible form of expression suppressed. A17 (quoting *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981)). “This case is solely about whether the applicant may ‘call upon the resources of the federal government’ to obtain federal registration of the mark on the Principal Register in order to assist applicant in enforcing the mark.” *Id.* (quoting *In re Fox*, 702 F.3d 633, 640 (Fed. Cir. 2012)). Because Tam’s mark is disparaging, the Board affirmed the refusal to register it. *Id.*

2. This Court’s Decision

Tam appealed the Board’s decision, and a panel of this Court affirmed. Panel Op. 1. The panel concluded that substantial evidence supports the Board’s determination that the mark THE SLANTS, in the context in which Tam uses it, refers to people of Asian descent. *Id.* at 5-7. Substantial evidence also supports the Board’s determination that “the mark THE SLANTS is likely offensive to a substantial composite of people of Asian descent.” *Id.* at 7. The panel noted that the definitions in evidence *universally* characterize the term as “disparaging, offensive, or an ethnic slur” when referring to people of Asian descent. *Id.* In addition, the record includes “a brochure published by the Japanese American Citizens League describing the term ‘slant,’ when used to refer to people of Asian descent, as a ‘derogatory term’ that is ‘demeaning’ and ‘cripple[s] the spirit.’” *Id.* (quoting A48-49).

The panel rejected Tam’s constitutional challenges under binding circuit precedent. As to Tam’s First Amendment claim, the panel followed this Court’s precedent in cases such as *In re McGinley*, 660 F.2d at 484; *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1374 (Fed. Cir. 1994); and *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003), in which the “scandalous” or “immoral” provisions of section 2(a) had been upheld as constitutional. Panel Op. 8-9. The panel likewise rejected Tam’s other constitutional challenges under binding precedent. *Id.* at 9-11.

In an “additional views” opinion, however, Judge Moore suggested that the Court should revisit *McGinley’s* holding on the constitutionality of section 2(a) under the First Amendment, particularly under the doctrine of “unconstitutional conditions.” *See generally* Additional Views of Judge Moore. This Court subsequently vacated the panel opinion and set the case for en banc consideration. Order, Sua Sponte Hearing En Banc (Apr. 27, 2015). The Court instructed the parties to submit briefing on whether section 2(a)’s bar on federal registration of disparaging marks violates the First Amendment. *Id.* at 2.

SUMMARY OF THE ARGUMENT

The provision at issue here does not restrict speech. The Lanham Act does not limit what Tam can name his band. It does not restrict how Tam may advertise, what songs he may sing, or what messages he may convey. And it does not prevent Tam from promoting his band with any racial slur or image he wishes.

Indeed, Tam does not suggest that the Lanham Act affirmatively restricts his speech. Instead, he mistakenly contends that the federal government has a constitutional obligation to aid him in enforcing his racially disparaging mark against commercial use by others. Nothing in the First Amendment compels Congress to do so. Congress has set up an optional federal registration scheme, and section 2(a) constitutes an exercise of Congress's broad authority to define the limits of a federal program. The Constitution does not preclude Congress from creating a federal trademark registration program without extending it to embrace racial epithets as commercial identifiers.

Federal law does not create trademarks or trademark rights, which arise through usage in commerce in connection with particular goods or services. Trademarks may be enforced under state law without reference to any Act of Congress, and may also be enforced in federal court even in the absence of federal registration. This case concerns only an optional federal trademark registration program that Congress created in 1905 to facilitate the enforcement of qualifying marks in interstate and foreign commerce. Federally registered marks are examined for eligibility by an expert federal agency; issued certificates in the name of the United States; published on the Principal Register of the United States; accepted as valid by federal agencies for purposes of federal law enforcement; afforded the benefit of certain presumptions in federal infringement litigation; and provided certain benefits in obtaining protection from foreign governments. In these and other ways, federal

trademark registration encourages the enforcement of qualifying marks as a means of enhancing the protection of consumers against confusion about the source (*e.g.*, the manufacturer or seller) of particular commercial goods and services. But Congress permissibly declined to include certain categories of marks in the federal trademark registration program.

Tam's arguments to the contrary advance no valid First Amendment claim. 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) (internal quotation marks omitted). Tam's contention that his band's commercial marketing efforts might be more successful if he received the benefits that attend federal trademark registration is therefore beside the point. 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 Tam's speech or conduct outside that registration program.

The Constitution does not require Congress to underwrite 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 United States Patent and Trademark Office. Nothing in section 2(a) limits Tam’s ability to use disparaging terms to express any message he wishes. But he 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. *Griffin v. Sec’y of Veterans Affairs*, 288 F.3d 1309, 1317 (Fed. Cir. 2002). 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, such as the drawbacks of reviewing constitutionality of a federal statute based on the limited record of a single case, preference for judicial restraint, and avoiding short-circuiting will of the people). 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) (citations and internal 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

THE FIRST AMENDMENT DOES NOT INVALIDATE CONGRESS'S PROHIBITION AGAINST FEDERAL REGISTRATION OF TRADEMARKS THAT DISPARAGE RACIAL GROUPS

A. Section 2(a) does not restrict speech.

Tam challenges Congress's determination that racist and other disparaging marks are ineligible for federal trademark registration. But this Court and its predecessor have properly recognized that "the refusal to register a mark does not proscribe any conduct or suppress any form of expression because it does not affect the applicant's right to use the mark in question." *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003); *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) ("[I]t is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed." (citation omitted)); *see also Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559, 578 n.9 (5th Cir. 2005) (adopting this Court's reasoning).

Instead of authorizing expressive activity, trademark law serves the important, but distinct, function of avoiding consumer confusion and preventing commercial actors from misappropriating the economic goodwill associated with a particular mark and its owner. In particular, the owner of a trademark generally may prohibit other manufacturers or sellers from using identical or similar marks to confuse or mislead consumers about the source of goods or services. The Lanham Act thus operates to "protect the public" by ensuring that a consumer "will get the product which it asks

for and wants to get,” and to protect the owners of marks who have invested “energy, time, and money” in a commercial product or service from having the goodwill they have developed “misappropriat[ed] by pirates and cheats.” S. Rep. No. 79-1333, at 3 (1946) (quoted in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 782 n.15 (1992) (Stevens, J., concurring)); see also *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854-55 n.14 (1982) (describing the goals of the Lanham Act as being the protection of the “goodwill” of owners and enabling “consumers . . . to distinguish among the goods of competing manufacturers”). Whether or not a term used as a trade name has a preexisting meaning, its use as a trade name “conveys information 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).

Tam does not and cannot contend that he needs a federally registered mark in order to engage in any expressive activity. Tam does not need federal trademark registration to use the name he chose for his band. Tam lawfully used the name he chose for his band and the mark at issue here in commerce, without federal trademark registration, at least as early as 2006, but did not apply for federal registration until 2010. A24; Panel Op. 2. Nor does Tam need federal registration to use his band (with which the mark is associated) as a platform for disseminating disparaging views, anti-disparaging views, or other views that he wishes to express. As a federal district court recently explained in upholding the prohibition on registration of disparaging marks, 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.” *Pro-Football, Inc. v. Blackhorse*, No. 1:14-cv-1043, 2015 WL 4096277, at *10 (E.D. Va. July 8, 2015). Analogizing to state laws governing official change-of-name requests, the court explained that the First Amendment is not offended by the denial of federal trademark registration for the same reason that state courts have perceived no First Amendment obstacle to denying requests by individuals seeking officially to adopt racist names: “the petitioner may continue to call themselves whatever they please.” *Id.* at *10 n.5; *see, e.g., Lee v. Ventura Cnty. Superior Court*, 9 Cal. App. 4th 510 (1992) (rejecting First Amendment challenge to state court’s denial of request to legally change name to a racial epithet, which did not affect common-law right to use that name); *see also National A-1 Adver., Inc. v. Network Solutions, Inc.*, 121 F. Supp. 2d 156, 177-78 (D.N.H. 2000) (finding that no tangible form of expression was suppressed by prohibition on certain words as second-level domain names because plaintiffs could use those words elsewhere in their URLs).

Unable to allege any actual *restriction* on his speech, Tam frames his First Amendment claim in terms far less direct. He suggests that Congress’s determination that disparaging marks may not be federally registered might discourage him from using such a mark to identify his band, because if he selected a non-disparaging mark, it might be easier to prevent other commercial entities from using confusingly similar marks. The nature of this asserted injury makes clear that Tam cannot identify any affirmative limitation that section 2(a) places on his ability to express his preferred

message. “What is at issue here is the registration of the [mark] and the benefits associated with registration, not the use of the mark[].” *Pro-Football*, 2015 WL 4096277, at *8.

What is more, section 2(a) of the Lanham Act does not deprive Tam of his ability to prevent competitors from using confusingly similar marks, even if he continues to use a disparaging term as the name for his band. The denial of federal trademark registration does not eliminate any common-law rights that might exist in the mark. *Aycock Eng’g, Inc. v. Airflite, Inc.*, 560 F.3d 1350, 1362 n.12 (Fed. Cir. 2009). Even in the absence of federal registration, “[o]ne who first uses a distinct mark in commerce . . . acquires rights to that mark.” *Be&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015). The owner thus “need not register his or her mark in accordance with the Lanham Act in order to use the mark in connection with goods or to seek to prevent others from using the mark.” *In re Int’l Flavors & Fragrances, Inc.*, 183 F.3d 1361, 1366 (Fed. Cir. 1999). Tam himself acknowledges that, in addition to relying on federal registration, “[i]ndividuals and entities interested in protecting their use of a trademark can seek the shelter of . . . various State statutes” and “the common law.” Appellant’s En Banc Br. 9.

Furthermore, Congress created in the Lanham Act a federal cause of action for causing likely confusion, mistake, or deception as to the source of goods or services in commerce, whether or not a federally registered mark is used. 15 U.S.C. § 1125(a); *see Two Pesos*, 505 U.S. at 768 (§ 1125(a) “protects qualifying unregistered trademarks”).

Congress also prohibited the importation of goods with confusing markings without regard to federal registration. 15 U.S.C. § 1125(b). Section 2(a) does not limit those rights. Although a plaintiff cannot premise an action under 15 U.S.C. § 1125(a) on the misappropriation of a source identifier that is not sufficiently distinctive to qualify for trademark protection, *see Two Pesos*, 505 U.S. at 768, relief under 15 U.S.C.

§ 1125(a) does not depend on satisfying the other criteria for federal trademark registration and, indeed, does not require that the plaintiff have a trademark at all.

Instead, the statute applies more generally to confusing or misleading identifications of source, including not only marks but also “description[s] of fact.” 15 U.S.C.

§ 1125(a)(1). Nothing in section 2(a) circumscribes or abridges any rights Tam may have under 15 U.S.C. § 1125(a).

In short, section 2(a) does not in any way limit Tam’s ability to identify his services in the manner he prefers, using his chosen mark. If he uses his preferred mark, he also retains any right he might have at common law to exclude others from using confusingly similar marks to identify goods or services in commerce. The prohibition on federal registration of disparaging marks therefore cannot plausibly be described as driving ideas or viewpoints from the marketplace. Rather, it reflects Congress’s judgment that a federal agency should not use its resources affirmatively to *promote* the use in commerce of racial slurs and similar disparagements as the means for avoiding confusion as to the source of goods or services. As discussed below, that judgment does not violate the First Amendment.

B. Congress has broad authority to define eligibility criteria for a government program.

1. Tam has no First Amendment right to government assistance in enforcing his disparaging mark as the means to avoid confusion with other commercial goods or services.

Trademark protection of source identifiers long predated congressional action in this area. Through the Lanham Act, Congress acted to supplement that common-law scheme by instructing the USPTO to examine marks, to determine whether they meet congressionally prescribed requirements, and then to include qualifying marks on the Principal Register. Registration on the Principal Register provides notice to third parties of the owner's claimed rights and facilitates enforcement of a mark against others who may use identical or confusingly similar marks in the marketplace.

Tam's constitutional challenge is premised on his view that because the federal government has elected to include certain marks on its Principal Register and facilitate their enforcement, it is constitutionally compelled to take these same actions to support his use of a disparaging mark. By Tam's lights, if Congress wished to create a trademark registration scheme applicable to the owners of any trademarks, it was constitutionally compelled to extend that scheme to entities that wish to use any term or image—including the most vile racial epithets—to identify their products or services. *See* Appellant's En Banc Br. 12 (partial listing of epithets that Tam alleges should be eligible for registration); *see also* Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be*, 22

Pepp. L. Rev. 1, 55-56 (1995) (listing disparaging trademarks). And to the extent that Tam’s arguments extend to the prohibition against registration of “immoral . . . or scandalous matter,” 15 U.S.C. § 1052(a), he also asserts that the USPTO is constitutionally compelled to record scandalous words and lewd photographs on its Principal Register, in order to facilitate the enforcement of those marks in commerce as well. *See, e.g.*, Appellant’s En Banc Br. 25 (arguing that it is not valid for the government to restrict registration of marks on the ground that they may cause offense).

The Constitution does not put Congress to the choice of either eliminating the federal trademark registration program altogether or extending it to embrace racial epithets and lewd photographs as commercial identifiers. While it is clear that Congress cannot proscribe the use of racial epithets to express ideas, it is equally well-settled that the Constitution does not confer a right to a federal subsidy encouraging their use in commerce. 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) (internal quotation marks omitted).

Applying this principle, in *Regan*, the Supreme Court upheld a provision that limited a tax exemption to entities that did not engage in lobbying. By denying the tax exemption, “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. 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, because although the

“State may have made childbirth a more attractive alternative, thereby influencing the woman’s decision, . . . it has imposed no restriction on access to abortions that was not already there”); *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 *Maher* and *Harris*); *Rust*, 500 U.S. at 192-93 (same).

The Court invoked the same principles more recently in *Davenport v. Washington Education Association*, 551 U.S. 177 (2007). That case involved 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. The Washington Supreme Court had declared the restriction invalid as a violation of the First Amendment, but the Supreme Court of the United States reversed. It emphasized that the State was under no obligation to allow public unions to collect and spend nonmembers’ money at all and 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. The Court observed that the “rationale of the general prohibition” on content-based regulations of speech “is that content discrimination raises the specter that the Government may effectively drive certain ideas or viewpoints from the marketplace.” *Id.* at 188 (internal quotation marks omitted). The Court stressed that, in “numerous situations in which that risk is inconsequential, . . . strict scrutiny is unwarranted.” *Id.* In particular, “the risk that content-based distinctions will

impermissibly interfere with the marketplace of ideas is sometimes attenuated when the government is acting in a capacity other than as regulator.” *Id.* It is therefore “well established that the government can make content-based distinctions when it subsidizes speech.” *Id.* at 188-89.

The Supreme Court reaffirmed these principles in *Ysursa v. Pocatello Education Association*, 555 U.S. 353 (2009). There, the Court upheld the State of Idaho’s prohibition on the use of payroll deductions from public employees to fund political activities. The Court recognized that “unions face substantial difficulties in collecting funds for political speech without using payroll deductions.” *Id.* at 359 (internal quotation marks omitted). But the Court observed that “the State is not constitutionally obligated to provide payroll deductions at all.” *Id.* “While publicly administered payroll deductions for political purposes can enhance the unions’ exercise of First Amendment rights, Idaho is under no obligation to aid the unions in their political activities. And the State’s decision not to do so is not an abridgment of the unions’ speech; they are free to engage in such speech as they see fit. They simply are barred from enlisting the State in support of that endeavor.” *Id.* “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 effect of the challenged provision on the plaintiff’s ability to speak 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 internal quotation marks omitted). Here, any obstacles to Tam’s expression are not of the government’s creation. Tam seeks federal registration to facilitate enforcement of his 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 Tam’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. Just as the states in *Davenport* and *Ysursa* were not constitutionally required to offer payroll deductions, Congress was not constitutionally compelled to provide for federal trademark registration at all. Congress did not violate the First Amendment by agreeing to register many—but not all—potential source identifiers.

It is no answer to suggest that the absence of federal registration for his mark might make it more difficult for Tam to express his message. The Supreme Court recognized in *Maher* and *Harris* that, as a practical matter, the government’s refusal to fund abortion would make it more difficult to obtain abortions. And the Court recognized in *Davenport* and *Ysursa* that, as a practical matter, the government’s refusal to provide a mechanism to assist unions in securing funds for political activities would

make it more difficult to engage in political speech. But the Court concluded that the government had no obligation to help the plaintiffs in those cases surmount those hurdles. Tam remains “free to engage in . . . speech as [he] see[s] fit”; he “simply [is] barred from enlisting the [United States] in support of that endeavor.” *See Ysursa*, 555 U.S. at 359; *see also In re Fox*, 702 F.3d 633, 640 (Fed. Cir. 2012) (noting that applicant whose registration is refused under section 2(a) “will remain free to use her mark in commerce,” but “will be unable . . . to call upon the resources of the federal government in order to enforce that mark”).

2. The government’s ability to define in section 2(a) the scope of its trademark registration program does not depend on the enumerated power on which Congress relied.

Tam mistakenly asserts that the government’s ability to define the scope of government programs applies only to congressional action taken under the Constitution’s Spending Clause. Appellant’s En Banc Br. 18-20. This argument confuses the question whether a federal statute is within Congress’s enumerated powers—not disputed here—with the question whether the First Amendment acts as an independent barrier to the challenged statutory provision. Conflating these questions has no basis in logic and would be inherently unworkable, particularly because the First Amendment applies not only to the federal government but also, through the Fourteenth Amendment, to the States, which need not premise their actions on the legislative powers granted to Congress.

Tam's Spending Clause theory is also incoherent on its own terms. Tam's argument suggests that Congress would have more latitude simply to give money to entities who identify their goods or services with non-disparaging trademarks than it does in determining whether to include marks on the Principal Register. 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.

It is therefore unsurprising that the Supreme Court's First Amendment jurisprudence has not differentiated between the receipt of government funds and the receipt of other assistance from the government. In *Davenport* and *Ysursa*, for example, the subsidy took the form of authorizing unions to collect mandatory fees from nonmembers. The provisions at issue therefore did not involve the expenditure of government funds at all. But the Court nonetheless applied *Regan*, noting that the "First Amendment does not require the government to enhance a person's ability to speak." *Davenport*, 551 U.S. at 190.

Moreover, to the extent that the expenditure of federal funds is a relevant criterion, it is satisfied here. There can be no dispute that the government expends resources in evaluating and registering marks and in including them on the Principal Register. These government functions are carried out using funds appropriated by Congress: the governing statute makes clear that, although the USPTO collects

money through user fees, those fees are deposited in the Treasury, and the agency may *expend* funds only “[t]o the extent and in the amounts provided in advance in appropriations Acts.” 35 U.S.C. § 42(c)(1)-(2). This Court and its predecessor have long recognized that section 2(a) represents “a judgment by the Congress that [certain] marks not occupy the time, services, and use of funds of the federal government.” *McGinley*, 660 F.2d at 486; *see also Fox*, 702 F.3d at 634 (same).³

Congress may make that judgment whether or not the USPTO collects fees to cover the costs of federal trademark registration. As already noted, those fees (like all governmental receipts, *see generally* 31 U.S.C. § 3302(b)) are deposited in the Treasury of the United States, and may be expended only as Congress appropriates. *See* 35 U.S.C. § 42(c)(1)-(2). Congress’s authority to determine how appropriated funds are expended does not on how the public funds at issue have been collected. *Cf.* U.S. Const. art. I, § 9, cl. 7. Tam 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.

Tam’s suggestion that “litigating the constitutionality of § 2(a) is more costly than simply adding THE SLANTS to the Register,” Appellant’s En Banc Br. 17 n.6,

³ This case is thus unlike *Satellite Broadcasting & Communications Ass’n of America v. FCC*, 146 F. Supp. 2d 803 (E.D. Va.), *aff’d*, 275 F.3d 337 (4th Cir. 2001), which involved a license that was automatically conferred by statute and thus did not involve “a benefit conferred through the expenditure of government funds,” *id.* at 829.

fundamentally misunderstands the nature of Congress’s authority to limit the scope of federal programs. The relevant point is that the government can elect to provide assistance and to expend its resources—here, the resources involved in examining and registering marks and recording them on the federal trademark register—as it sees fit. Indeed, Congress may elect not to fund a particular activity for entirely non-budgetary reasons. *See Rust*, 500 U.S. at 192-93 (“[T]he government may make a value judgment” and “implement that judgment by the allocation of public funds.” (internal quotation marks omitted)). The government was not compelled to demonstrate that funding counseling on abortion services would have been more costly than funding other counseling in *Rust*, or that the restrictions on the use of the payroll deduction in *Davenport* or *Ysursa* saved the government money.

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. Summum*, 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.”). And in any event, Tam’s argument about the federal resources implicated here accounts only for the costs associated with this case, and not the additional costs associated with registering other disparaging marks that he seeks to compel the USPTO to examine and include on the Principal Register.

3. The “unconstitutional conditions” doctrine does not apply here.

Tam is likewise mistaken in characterizing Congress’s prohibition on registering disparaging marks as an “unconstitutional condition.” Appellant’s En Banc Br. 20-22. The Supreme Court has explained that a limitation on the receipt of public benefits may constitute an unconstitutional condition 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 (emphasis in original). But Tam properly acknowledges that Congress may, consistent with the First Amendment, “define the limits of the government spending program.” Appellant’s En Banc Br. 21 (quoting *Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 133 S. Ct. 2321, 2328 (2013)). Congress may permissibly “specify the activities Congress wants to subsidize,” as long as it does not impose “conditions that seek to leverage funding to regulate speech outside the contours of the program itself.” *Agency for Int’l Dev.*, 133 S. Ct. at 2328; *see also Regan*, 461 U.S. at 545 (“The Code does not deny [the plaintiff] the right to receive deductible contributions to support its non-lobbying activity, nor does it deny [the plaintiff] any independent benefit on account of its intention to lobby.”).

Here, Congress has selected particular commercial activities to facilitate, and has not leveraged that assistance to regulate other speech. Although a commercial

actor must use an eligible mark as a source identifier to obtain federal trademark registration, section 2(a) does not require or preclude any other activity. In particular, it does not limit the manner in which Tam may express himself: he may use racial slurs, market his albums with racist imagery, and advocate for or against any cause without affecting his ability to federally register a trademark. He may even use a disparaging mark as a source identifier if he elects to do so, with no adverse consequence for any effort to register other trademarks that satisfy the statutory requirements. The only limitation at issue here relates to Tam's ability to compel the government to include on its Principal Register the very trademark that he seeks to register, which clearly is a provision limited to the confines of the particular federal program at issue.

Section 2(a) of the Lanham Act stands in sharp contrast to the sorts of requirements that courts have held to constitute unconstitutional conditions. In *Perry v. Sindermann*, 408 U.S. 593 (1972), for example, the Court held that the government had impermissibly sought to deny public employment to a college professor who had publicly criticized the college's policy in his capacity as a private citizen. Essential to that decision was the fact that the government penalized speech outside of the professor's capacity as a public employee. The Supreme Court has since made clear that employees generally have no First Amendment right to avoid employer discipline premised on statements made pursuant to their official duties. *Garvetti v. Ceballos*, 547 U.S. 410, 421 (2006).

In *Agency for International Development*, the Court held that the government had impermissibly sought to deny funding for programs combatting AIDS to domestic organizations who refused to adopt policies opposing prostitution and sex trafficking. In holding that condition impermissible, the Supreme Court emphasized that the restriction at issue affected not only the speech made in the context of the program, but also a participant's activities "on its own time and dime." *Agency for Int'l Dev.*, 133 S. Ct. at 2330. Here, section 2(a) relates only to the mark for which Tam wishes to obtain federal trademark registration; it does not affect what Tam may do entirely on his own time and dime.

Likewise, in *Autor v. Pritzker*, 740 F.3d 176 (D.C. Cir. 2014), the government had made registered lobbyists ineligible for membership on trade advisory committees. The D.C. Circuit concluded that the limitation could only be upheld if it satisfied a balancing test, *see Pickering v. Board of Educ.*, 391 U.S. 563 (1968), because the lobbying at issue would have been entirely separate from the advisory committee itself. But the court did not suggest that the government would be powerless to set the agenda for the committee's own meetings.

The Fifth Circuit's decision in *Department of Texas, Veterans of Foreign Wars v. Texas Lottery Commission*, 760 F.3d 427 (5th Cir. 2014) (en banc), did not involve a government benefit at all. There, the State of Texas had imposed a prohibition on gambling, with an exception for charitable bingo. *Id.* at 431. But charities that used the proceeds from their bingo games for political advocacy were ineligible for the

exception, and thus subject to the prohibition. The successful challengers to the state law were thus objecting to a prohibition on gambling that applied to them only because of their First Amendment activity, and the court agreed that it was unconstitutional. The distinction between that case and the federal trademark registration scheme is evident from the relief requested: in the Fifth Circuit case, the plaintiffs sought to operate a bingo game free from government intervention. Here, section 2(a) places no restriction on Tam's activities, which he is free to undertake without any restriction or interference. Instead, Tam seeks the benefits conferred by the federal trademark registration program, without regard to the lawful requirements that Congress imposed for such registration.

4. The Lanham Act has not created a forum for the expression of ideas and does not threaten to drive ideas or viewpoints from the marketplace.

The Supreme Court has also recognized First Amendment limitations when the government creates a forum for protected speech and then limits access to the forum. *See Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819 (1995). In *Rosenberger*, a public university created a limited public forum by supplying funds for the printing of student publications. The Supreme Court concluded that the University was unconstitutionally discriminating based on viewpoint, *id.* at 830-31, when it refused to provide funding to any student paper that “primarily promotes or manifests a particular belie[f] in or about a deity or an ultimate reality,” *id.* at 825 (quoting University guideline) (alteration in original).

The government has done nothing of the kind here. Federal trademark registration does not create a forum for the expression of ideas. 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 as to the source of the goods or services. 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. The availability of federal trademark registration may indirectly, at the margin, affect a commercial actor’s choice of a source identifier, but it does not create a forum for expressive activity; rather, trademark registration facilitates source identification by providing the owner of a trademark (*e.g.*, manufacturer or seller of goods and services in commerce) enhanced legal protections against use by others of identical or similar marks that are likely to cause consumer confusion.

In addition, the federal trademark registration program does not drive disfavored ideas or viewpoints from the marketplace. While supporting Tam’s position, amicus Pro-Football cogently explains that “[w]hile Section 2(a) deters the use of disparaging *marks*, it does not materially affect the overall use of offensive and disparaging *speech*.” Pro-Football Br. 29 (emphasis in original). And Tam correctly acknowledges that trademark law was designed to serve “commercial purposes,” Appellant’s En Banc Br. 14, and acknowledges that his use of his trademark is a form

of “commercial speech,” *id.* at 15. 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 being crushed by overbroad regulation.” *Bates v. State Bar*, 433 U.S. 350, 381 (1977).

The fundamental purpose of a trademark is to transmit a single message: the identity and desirability of the commodity on which the mark appears. *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.”). Tam does not and cannot suggest that he is unable to identify his goods and services in commerce.

To the degree that Tam seeks to express some message unrelated to the identity and desirability of his goods or services—a purpose that he appears to disclaim on appeal—he identifies no basis for compelling Congress to use federal trademark registration to facilitate the communication of such messages. Federal trademark registration is designed to facilitate the use of trademarks to identify the source of goods and services, and a trademark need not communicate other information. That is why a purely descriptive mark, which directly conveys only information about a product or service, is not inherently eligible for trademark protection, while a “fanciful” mark—“a word that is coined for the express purpose of functioning as a trademark” and conveys no information other than the source of

the product or service—is afforded strong trademark protection. 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 11:4 (4th ed. 2015); see also *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 429 n.10 (2003) (“The rule that arbitrary, coined or fanciful marks,” such as “Kodak” or “Mazda,” “should be given a much broader degree of protection . . . would appear to be entirely sound.”).

Section 2(a) thus stands in stark contrast to restrictions involving editorial or political judgments by the government that affect core speech. In *Bullfrog Films, Inc. v. Wick*, 847 F.2d 502 (9th Cir. 1988), the Ninth Circuit enjoined the implementing regulations for a treaty that compelled foreign countries to exempt movies of an “educational, scientific and cultural character” from import duties. *Id.* at 504. The court observed that the government had “gone so far as to deny certificates not only because certain views were assertedly missing, but also because viewpoints mentioned were, in the government’s editorial judgment, insufficiently highlighted.” *Id.* at 510.

Similarly, in *Legal Services Corp. v. Velazquez*, 531 U.S. 533 (2001), the Supreme Court considered 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.) (“In *Velazquez*, the Court concluded that a Government program of furnishing legal aid to the indigent 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)).

These cases suggest, at most, that the First Amendment limits the government’s ability to leverage its funding to exercise editorial control over artistic speech or advocacy. *But see National Endowment for the Arts v. Finley*, 524 U.S. 569, 572 (1998) (upholding scheme in which funding was allocated to artistic endeavors “taking into consideration general standards of decency and respect for the diverse beliefs and values of the American public” (quoting 20 U.S.C. § 954(d)(1))). Their reasoning does not extend to a provision that declines to facilitate the private enforcement of disparaging marks as source identifiers for goods and services in commerce, without restraining any private expression.

The facts of this case underscore that section 2(a) has neither the intention nor the effect of promoting any viewpoint or eliminating any viewpoint from the marketplace of ideas. Tam’s band does not seek to express an anti-Asian viewpoint; to the contrary, record evidence indicates that the band “want[ed] to take on these stereotypes that people have about us, like the slanted eyes, and own them.” A57. Section 2(a) applies the same way to this group’s effort to “take on . . . stereotypes” as it would to a group trying to foster or entrench stereotypes. Amicus ACLU, arguing

in support of Tam, is entirely correct when it observes: “That a single word can express multiple viewpoints is exemplified by this case. While some view the word ‘slants’ as degrading, others—namely Mr. Tam and his band—see the term as a means of empowerment.” ACLU Br. 15.

In other words, Section 2(a) is viewpoint neutral: it operates in the same way as to persons who would use the same disparaging term to promote diametrically opposed viewpoints. *See R.A.V. v. City of St. Paul, Minn.*, 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). And 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). The First Circuit has properly recognized, even in the context of a regulation that directly prohibits certain speech, that “guidelines prohibiting demeaning or disparaging ads are themselves viewpoint neutral,” because “the state is not attempting to give one group an advantage over another in the marketplace of ideas.” *Ridley v. Massachusetts Bay Transp. Auth.*, 390 F.3d 65, 90-91 (1st Cir. 2004).

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

The federal registration scheme is a voluntary government program focused on the creation of a Principal Register of Trademarks that businesses can use to ascertain whether marks they are considering for usage to identify their goods or services in interstate commerce are already in use by other businesses. See *In re Int'l Flavors & Fragrances, Inc.*, 183 F.3d at 1367. The First Amendment does not authorize Tam to exert control over the Register. To the contrary, the government has a legitimate interest in declining to use its resources in a manner that would encourage the use of offensive or disparaging marks.

The Supreme Court recently confirmed that private speakers cannot compel the government to publish material the government rejects, and that the government is entitled to dissociate itself from speech it finds odious. 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 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, Tam cannot force the government to register vile 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.” *Pro-Football*, 2015 WL 4096277, at *11.

In urging the contrary, Tam focuses on the privileges that he would obtain if the federal government registered his mark. But those privileges flow from the government’s actions. The government’s examination of the application provides evidence about the likelihood that the mark constitutes a valid source identifier and establishes a presumption of validity and the predicate for the federal cause of action

specifically premised on a registered mark. And the government's publication and issuance of a certificate for registration of the mark upon the Principal Register provides notice to other potential users and thus operates as "a means . . . to quiet title" in the mark, *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985), extinguishing defenses that are not asserted in a timely manner and providing for nationwide coverage of the mark. Tam has no legitimate claim to use those governmental resources in aid of his efforts to enforce his disparaging mark.

Tam cannot seriously dispute the government's legitimate interest in declining to expend its resources to facilitate the use of racial slurs as source identifiers in interstate commerce. In the context of race in particular (although, as noted, the statute is not limited to disparagement on the basis of race), it is well established that the government has a compelling interest in fostering racial tolerance. For example, the Supreme Court upheld a statute that withheld tax exemptions from private educational institutions that prohibited interracial dating, even though it was constrained to apply strict scrutiny because of the statute's effect on the exercise of religion. *Bob Jones Univ. v. United States*, 461 U.S. 574, 604 (1983). The Court concluded that the IRS had reasonably interpreted a statute providing tax exemptions to "charitable" institutions to apply only to those institutions that do not operate "contrary to established public policy." *Id.* at 586. While the First Amendment's Speech Clause would limit the government's ability to *restrict* speech that is contrary to

a policy of avoiding racial epithets, Congress has no constitutional obligation to *encourage* such speech.

Although the USPTO does not endorse any particular product, service, mark, or registrant, the government's publication of disparaging marks on its Principal Register would convey to the public that the United States regards racial slurs as appropriate source identifiers for goods and services in commerce. As discussed above, registrants are entitled and encouraged to mark their products (for example, with an ®) to show that they have been registered in the U.S. Patent and Trademark Office. "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." *Pro-Football*, 2015 WL 4096277, at *14. Furthermore, owners of applied-for or registered trademarks in the United States may request that the USPTO transmit their application to international bodies. *See* 15 U.S.C. § 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. The First Amendment does not compel the United States government to transmit applications for registration of racial slurs to foreign governments, or to encourage those governments to accept and rely on the USPTO's examination of such marks.

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. Tam asserts that, at common law, States enforced a number

of marks that most would today find offensive. Appellant’s En Banc Br. 12-13. But the cited opinions did not address whether disparaging or scandalous marks were entitled to protection at common law, and there is no indication that the issue was raised. See *Leidersdorf v. Flint*, 7 N.W. 252 (Wis. 1880); *Paddy’s Market Produce Dealers & Merchants Ass’n v. Lutus*, 7 N.Y.S. 676 (Sup. Ct. 1938); *McCann v. Anthony*, 21 Mo. App. 83 (1886). 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 Tam’s protected expression, Congress has wide latitude to define the scope of a federal program. But especially in light of the provision’s limited and indirect effect on Tam’s protected expression, the statute 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 Tam's interest in obtaining the aid of the federal government in enforcing a disparaging mark.

CONCLUSION

For the foregoing reasons, and for the reasons stated by the panel, the USPTO's refusal of registration should be affirmed.

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CERTIFICATE OF SERVICE

I hereby certify that on July 16, 2015, I electronically filed the foregoing with the Court's CM/ECF filing system, which constitutes service, pursuant to Fed. R. App. P. 25(c)(2), Fed. Cir. R. 25(a), and the Court's Administrative Order Regarding Electronic Case Filing 6(A) (May 17, 2012).

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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 11,722 words.

s/ Daniel Tenny _____
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