TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In re Registration No. 2,569,766
Registered: May 14, 2002
For Mark: Chief Wahoo Design

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PEOPLE NOT MASCOTS, INC., ANTHONY MENESS, SHYANNE MENESS, FEATHER SHENDO, ROBERT ROCHE, SUNDANCE, JEANNINE WITHROW, ROSE ROUBIDEAUX, CLIFFORD A. TAHSLER, WENONAH GREGG, RAYMOND MOODY, DEREK WITHROW, PAUL WITHROW and O.T. WILLIAMS,

Petitioners,

v.

CLEVELAND INDIANS BASEBALL COMPANY LP and CLEVELAND INDIANS BASEBALL COMPANY, INC.,

Registrants.

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Cancellation No. 92063171 - 76211115

**APPENDIX TO REGISTRANTS' MOTION TO DISMISS OR SUSPEND THE PROCEEDING**

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January 21, 2016

Mr. Daniel E. O'Toole
Clerk
United States Court of Appeals
for the Federal Circuit
717 Madison Place NW
Washington DC 20005

Re: In re Brunetti, Case No. 2015-1109
Appellant Erik Brunetti's Letter Brief (per the order of December 22, 2015)

Dear Mr. Toole:

This letter contains the additional briefing concerning the impact of the *en banc* decision in *In re Tam*, Case No. 14-1203 (all page references are to the majority opinion), as requested by the Court's order of December 22, 2015.

## Short Answer

Applicant Erik Brunetti submits that scandalous marks[1] should be treated the same as disparaging marks. Therefore, all the reasons given in *Tam*, about why Section 2(a)'s prohibition of the registration of disparaging marks are also applicable to scandalous marks.

[1] This letter refers to "scandalous" marks since that is the statutory term. As argued in Brunetti's briefs, Section 2(a) prohibits registration of scandalous marks; it does not prohibit registration of marks that are vulgar but not scandalous. However, in this case, the PTO refused Brunetti's mark because it was vulgar but did not attempt to show it was scandalous. Either way, Section 2(a) is unconstitutional. And if Section 2(a) prohibits the registration of marks that are vulgar but not scandalous, then the case for unconstitutionality is even stronger.

The *Tam* Decision Applies to Scandalous Marks

"The government cannot refuse to register disparaging marks because it disapproves of the expressive messages conveyed by the marks." *Tam*, 4. A mark is scandalous only if it conveys a message. It follows that the refusal to register a scandalous mark is unconstitutional for the same reasons as the prohibition of disparaging marks: government disapproval of expressive messages conveyed by marks is not a constitutionally valid reason to refuse registration. This really is all that needs to be said.

Section 2(a)'s Prohibition of Scandalous Marks is Unconstitutional

Under the Strict Scrutiny Standard

Like disparagement, the "scandalous" provision in Section 2(a) discriminates based on disapproval of the message. It is not content neutral. Specifically, it is not viewpoint neutral. Instead, it is always viewpoint discriminatory.

The discussion in *Tam*, starting at page 17, refers generally to "any governmental regulation that burdens private speech based on disapproval of the message conveyed." "It is beyond dispute that Section 2(a) discriminates on the basis of content in the sense that it 'applies to particular speech because of the topic discussed.'" *Tam*, 18-19. "[E]very rejection under the disparagement provision is a message-based denial of other-available legal rights." Footnote 5 at 20. For both "disparagement" and "scandalous," it is the content that causes the refusal (or cancellation). The principle is the same for both. It follows that Section 2(a)'s prohibition of scandalous marks is also unconstitutional.

Are there other bases for distinguishing *Tam*'s holding as to disparaging marks from scandalous marks? The test for determining disparaging is slightly different than scandalous. The former only requires "may disparage;" scandalous is not qualified by "may." That is not a valid basis to distinguish these two prongs of Section 2(a). The PTO has to determine the opinions of a group to see if a mark is disparaging or scandalous. The affected group is different: for disparagement it is the group disparaged, for scandalous it is the entire public that is considered. The "legal significance of viewpoint discrimination is the same whether the government disapproves of the message or claims that some part of the populace will disapprove of the message." *Tam*, 21. As noted in *Tam*, "[l]isteners' reaction to speech is not a content-neutral basis for regulation." *Tam*, 19, citing *Forsyth Cty. v. Nationalist Movement*, 505 U.S. 123, 134 (1992). So for either prong, it does not matter whether the group is large or small. For both prongs, the unpopularity of the speech with a majority or with a minority, or with the government itself, is not a valid ground to penalize such speech.

Section 2(a)'s prohibition of scandalous marks always is a regulation of speech based upon the content of that speech. It follows from *Tam*, that Section 2(a) is also unconstitutional as to the prohibition of scandalous marks.

## Government's Defense of Section 2(a)

What does the government say in support of the constitutionality of Section 2(a) as to scandalous marks? In its brief in this case, the government refused to say anything in response to Brunetti's constitutional arguments. In oral argument, the government evaded the panel's specific questions about how *Tam* would affect this case. So Brunetti has no idea what, if any arguments, the government will make. Since the Court ordered that these letter briefs be exchanged simultaneously,

Brunetti cannot respond to whatever the government might say. If the government merely argues that *Tam* was incorrectly decided and that it plans to file for certiorari, that does not need any response from Brunetti. But if the government does come up with some colorable argument as to the constitutionality of Section 2(a) as to scandalous marks, then fairness requires that Brunetti be given an opportunity to respond, especially since the government refused to make its arguments at the proper time: in the briefs and at oral argument.

The government defended Section 2(a) in its statements in its *en banc* brief in *Tam*, arguing that the government ought to be allowed to prevent the registration of "'the most vile racial epithets,' 'religious insults,' 'ethnic caricatures,' and 'misogynistic images.'" *Tam*, 50. As the *en banc* panel held in *Tam*, that is no justification for Section 2(a)'s prohibition of disparaging marks. Brunetti submits that, by analogy to that holding, there is no governmental interest in preventing vulgarity in the nation. That is the whole point of freedom of expression. And Section 2(a) has not and cannot prevent vulgar humor or vulgarity in general in the nation, so that is an impossible quest.

The argument that the government is not prohibiting speech was rejected by *Tam*. "The distinction between laws burdening and laws banning speech is but a matter of degrees." *Tam*, 18. The discrimination against marks with unpopular messages is identical for both disparaging and scandalous marks: the lack of constructive nationwide use, the inability to obtain a constructive first-use date under Section 1(b), the lack of presumptions under Sections 15 and 33, are all of such importance that they strongly discourage the adoption of marks with disfavored content. So this is not a basis for distinguishing *Tam* from this case.

The discussion of why the government speech and the government spending doctrines are not applicable was well covered in *Tam* and there is nothing about those doctrines that would be different

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