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January 21, 2016

Daniel E. O'Toole
Clerk, United States Court of Appeals
for the Federal Circuit
717 Madison Place, N.W.
Washington, D.C. 20439

By CM/ECF

Re: *In re Brunetti*, No. 2015-1109

Dear Mr. O'Toole:

Pursuant to this Court's order of December 22, 2015, we respectfully submit this letter brief regarding the impact of this Court's decision in *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), on the above-captioned case. In particular, as instructed by the Court, we address whether, in light of the *Tam* decision, there is any basis for treating the portion of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), that bars registration of immoral and scandalous trademarks differently from the portion of Section 2(a) that bars registration of disparaging marks, which was held in *Tam* to be facially unconstitutional. Although a court could draw constitutionally significant distinctions between these two parts of Section 2(a), we do not believe,

given the breadth of the Court's *Tam* decision and in view of the totality of the Court's reasoning there, that there is any longer a reasonable basis in this Court's law for treating them differently. We therefore agree that the proper disposition of this case under the law of this Court is to vacate and remand the Board's decision for further proceedings, as in *Tam*, because the reasoning of *Tam* requires the invalidation of Section 2(a)'s prohibition against registering scandalous and immoral marks as well.

The United States believes that *Tam* was wrongly decided and is considering whether to seek review of that decision in the Supreme Court. Among other things, we maintain that the federal trademark registration program does not restrict speech, but rather subsidizes and encourages the use of certain marks in commerce. The government's refusal to subsidize certain types of marks comports with the First Amendment. *See, e.g.*, *Rust v. Sullivan*, 500 U.S. 173 (1991); *see also Tam*, 808 F.3d at 1368-72 (Dyk, J., concurring in part and dissenting in part). Under this framework, both challenged provisions of Section 2(a) withstand constitutional scrutiny. We recognize, however, that *Tam* rejected that framework (among other holdings); that *Tam* constitutes the law of this Circuit; and that we are thus foreclosed from renewing that argument here in defense of Section 2(a)'s prohibition on registration of scandalous and immoral marks.

The United States does not concede, moreover, that any challenged provision in *Tam* or in this case would need to be invalidated even if that framework were rejected. This Court's opinion in *Tam*, however, went significantly beyond rejecting

that framework, and after careful review of the Court's entire opinion, we do not believe that Section 2(a)'s prohibition on registration of scandalous and immoral marks can withstand challenge under the current law of this Circuit.

We note that, if *Tam* had been decided on narrower grounds, the disparagement provision and the scandalousness provision would not necessarily rise or fall together, as the arguments relevant to the two provisions are distinct in some respects. For example, this Court stated in *Tam* that Section 2(a)'s disparagement provision "denies registration only if the message received [by the referenced group] is a negative one. Thus, an applicant can register a mark if he shows it is perceived by the referenced group in a positive way, even if the mark contains language that would be offensive in another context." *Tam*, 808 F.3d at 1337. The Court concluded that the disparagement provision unconstitutionally discriminates on the basis of viewpoint. *See generally id.* at 1335-37. The United States disagrees with that conclusion, but even accepting it as the law of this Circuit, that aspect of the Court's reasoning would not necessarily carry over to Section 2(a)'s bar on registering scandalous and immoral marks. Likewise, the government's interest in refusing federal registration of scandalous trademarks, such as those that are profane or sexually explicit, may differ in some ways from its interest in refusing federal registration of disparaging trademarks. *See, e.g.*, *City of Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 49 (1986); *F.C.C. v. Pacifica Found.*, 438 U.S. 726, 746-47 (1978).

In recognizing the import of this Court's *Tam* decision as a matter of circuit precedent, the government has not determined against defending the constitutionality of any provision of Section 2(a). *Cf.* 28 U.S.C. § 530D. We reserve the prerogative of the Solicitor General to seek review of this Court's decisions, both here and in *Tam*, in the Supreme Court. If the Solicitor General does seek Supreme Court review, the government may argue that, under reasoning less sweeping than that adopted in *Tam*, the bar on registration of scandalous and immoral marks would survive even if the bar on registration of disparaging marks were held invalid (or vice versa). For purposes of this Court's review of Mr. Brunetti's challenge, however, we acknowledge that this Court has spoken.

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on January 21, 2016, I electronically filed the foregoing with the Clerk of the Court by using the appellate CM/ECF system. I certify that the participants in the case are registered CM/ECF users and that service will be accomplished by the appellate CM/ECF system.

s/ Joshua M. Salzman
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