

No. 14-175

In the Supreme Court of the United States

PAMELA GELLER AND ROBERT B. SPENCER,
PETITIONERS

v.

PATENT AND TRADEMARK OFFICE

*ON PETITION FOR A WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT*

BRIEF FOR THE RESPONDENT IN OPPOSITION

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QUESTIONS PRESENTED

The Lanham Act prohibits the federal registration of any trademark that “[c]onsists of or comprises * * * matter which may disparage * * * persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” 15 U.S.C. 1052(a). The United States Patent and Trademark Office’s Trademark Trial and Appeal Board (Board) determined that this provision barred the registration of petitioners’ mark, “STOP THE ISLAMISATION OF AMERICA,” which petitioners intended to use in connection with “providing information regarding understanding and preventing terrorism.” Pet. App. 2 (footnote and brackets omitted). The questions presented are as follows:

1. Whether the Board erred in considering the context in which petitioners’ mark was used on petitioners’ website in determining the mark’s meaning.
2. Whether the court of appeals erred in reviewing the Board’s ultimate conclusion as to registrability de novo and its subsidiary factual findings for substantial evidence.

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OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1-14) is reported at 751 F.3d 1355. The opinion of the Trademark Trial and Appeal Board (Pet. App. 15-44) is not published in the *United States Patents Quarterly* but is available at 2013 WL 2365001.

JURISDICTION

The judgment of the court of appeals was entered on May 13, 2014. The petition for a writ of certiorari was filed on August 11, 2014. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

STATEMENT

1. In the Trademark Act of 1946 (Lanham Act), 15 U.S.C. 1051 *et seq.*, Congress created a comprehensive national system for the registration of trade-

marks and the protection of marks against infringement, dilution, and unfair competition. Although a person may acquire common-law rights in a trademark through the use of the mark in commerce, federal law confers certain additional benefits on trademark owners who register their marks with the United States Patent and Trademark Office (PTO). See *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 209 (2000).

Under the Lanham Act, a person who has a “bona fide intention * * * to use a trademark in commerce” may apply to the PTO to register the mark on the PTO’s “principal register.” 15 U.S.C. 1051(b)(1). The application must include a description of the goods or services in connection with which the applicant intends to use the mark. 15 U.S.C. 1051(b)(2); 37 C.F.R. 2.32(a)(6) and (c). Registration, if approved by the PTO, operates as “prima facie evidence * * * of the [registrant’s] exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the [registration] certificate, subject to any conditions or limitations stated in the certificate.” 15 U.S.C. 1057(b); see 15 U.S.C. 1115(a).

The Lanham Act makes certain marks ineligible for registration. For example, the PTO may not register a mark that is “deceptive” or “merely descriptive” of the goods at issue, and may not register a mark consisting of the name or portrait of a living person without that person’s consent. 15 U.S.C. 1052(a), (c) and (e). In addition, the PTO may not register any mark that “[c]onsists of or comprises * * * matter which may disparage * * * persons, living or dead, institu-

tions, beliefs, or national symbols, or bring them into contempt, or disrepute.” 15 U.S.C. 1052(a).

2. In February 2010, petitioners filed an application in the PTO to register the mark “STOP THE ISLAMISATION OF AMERICA.” Pet. App. 2 (footnote omitted). Petitioners identified the service in connection with which they sought registration as “providing information regarding understanding and preventing terrorism.” *Ibid.* (brackets omitted). The PTO examining attorney refused registration, concluding that Section 1052(a) barred registration of petitioners’ mark because the mark disparaged Muslims. *Ibid.*

The PTO’s Trademark Trial and Appeal Board (Board) affirmed in a non-precedential opinion. Pet. App. 15-44. The Board applied the two-step test articulated in *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2010), for determining whether a mark is disparaging to a religious or other non-commercial group. That test asks:

- 1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
- 2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

Pet. App. 17 (quoting *Lebanese Arak*, 94 U.S.P.Q.2d (BNA) at 1217). Petitioners agreed that *Lebanese Arak* established the governing standard. *Id.* at 18.

At the first step of the *Lebanese Arak* inquiry, the Board cited several dictionaries that define “Islamize” in a manner indicating that the term “Islamisation” “would be generally understood to mean ‘converting or conforming to Islam.’” Pet. App. 18-19.¹ In light of that definition, the Board concluded that the mark STOP THE ISLAMISATION OF AMERICA “would be understood to mean that action must be taken to cease, or put an end to, converting or making people in America conform to Islam.” *Id.* at 20. The Board further concluded that, when used in connection with petitioners’ services—“providing information regarding understanding and preventing terrorism”—the mark would convey that “the conversion or conformance to Islam must be stopped in order to prevent * * * terrorism.” *Ibid.*

As required by *Lebanese Arak*, the Board also considered the manner in which petitioners’ mark “is or will be used in the marketplace in connection with [petitioners’] services.” Pet. App. 20; see *Lebanese Arak*, 94 U.S.P.Q.2d (BNA) at 1217. The Board observed that several essays posted on petitioners’ website—essays that were “featured immediately underneath the website’s STOP THE ISLAMIZATION OF AMERICA banner”—reflected the theme that “the spread of Islam in America is undesirable and must be stopped.” Pet. App. 21 (footnote omitted). Anti-Islamic comments posted by readers of the website were to the same effect. *Id.* at 22-24. The Board ascribed less probative value to the reader comments than to the articles themselves, but noted that the

¹ As petitioners note (Pet. 2 n.1), it has been accepted throughout this case that “Islamisation” and “Islamization” are synonymous and can be used interchangeably.

comments “provide[d] additional insight into the public’s perception of and reaction to” petitioners’ mark and further confirmed that the mark would be understood as opposing the spread of the Islamic religion. *Ibid.*

Petitioners argued that the term “Islamisation” does not refer to the religion of Islam in general or to the conversion of individuals to the Islamic faith. Pet. App. 24-25. Instead, they maintained that it is a “term of art” referring to a “political-legal movement to convert a society or politic into a political society predicated upon and governed by Islamic law.” *Id.* at 25. The Board recognized that petitioners’ proposed meaning was consistent with a secondary dictionary definition of “Islamize,” which is “to cause people, institutions, or countries to follow Islamic law.” *Id.* at 24-25 (citation omitted). The Board also acknowledged that petitioners had provided examples of law review articles and congressional testimony using the word “Islamisation” in that narrower political sense. *Id.* at 25-29. The Board noted, however, that those sources were intended for limited audiences and were not widely available, and thus were not necessarily reflective of the general public’s understanding of the word. *Id.* at 29. Nevertheless, the Board concluded that “Islamisation” could have the narrower meaning that petitioners identified, “at least to academic, professional, legal and religious experts.” *Ibid.*

The Board considered both potential meanings of the mark at the second step of the *Lebanese Arak* inquiry, which asks whether the mark “may be disparaging to a substantial composite of the referenced group.” Pet. App. 17; see *id.* at 30. Petitioners conceded that “the referenced group” in this case was

American Muslims, and the Board therefore asked “whether either meaning of the mark is disparaging to a substantial composite of * * * Muslims in America.” *Id.* at 30.

The Board determined that, under the more general meaning of “Islamisation,” petitioners’ mark would be disparaging because it would “create[] a direct association of Islam and its followers with terrorism.” Pet. App. 33. The Board confirmed that conclusion with newspaper articles and other evidence demonstrating that “the majority of Muslims are not terrorists and are offended by being associated as such.” *Id.* at 34; see *id.* at 34-37.

The Board also concluded that petitioners’ mark would be disparaging even if their proposed narrower definition of “Islamisation” were the only meaning of that term. Pet. App. 38-43. The Board cited evidence that many Muslims who subscribe to the political objective of adopting Islamic law do not support terrorism. *Id.* at 38-41. The Board also noted that, in light of the connection between the word “Islamisation” and the Islamic religion, the use of petitioners’ mark “in connection with services to provide information regarding understanding and preventing terrorism” would “create[] an association with terrorism that would be disparaging to a substantial composite of Muslims whether or not they embrace Islamization” in petitioners’ narrow, political sense of the word. *Id.* at 41; see *id.* at 32 (noting the “confusing overlap in terminology” between “Islam,” “Islamism,” and “Islamization”).

3. The court of appeals affirmed. Pet. App. 1-14. Borrowing the standard of review that the court has applied to the Board’s determination that a mark is

ineligible for registration because it contains “scandalous matter,” 15 U.S.C. 1052(a), the court stated that “[t]he determination that a mark may be disparaging ‘is a conclusion of law based upon underlying factual inquiries.’” Pet. App. 6 (quoting *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994)). The court therefore reviewed the Board’s factual findings for substantial evidence and its ultimate conclusion regarding registrability de novo. *Ibid.* The court also noted the parties’ agreement that the two-step *Lebanese Arak* test established the proper standard for determining whether petitioners’ mark was disparaging under Section 1052(a). *Id.* at 5-6.

With respect to the first step of the test, the court of appeals rejected petitioners’ contention that the sole meaning of “Islamisation” is the narrow, political definition petitioners had advanced before the Board. Pet. App. 6-11. The court observed that numerous dictionary definitions supported the Board’s finding that “Islamisation” refers to any spreading of the religion of Islam. *Id.* at 7. The court also agreed with the Board that articles and comments from petitioners’ own website confirmed that, in the context of petitioners’ services, the mark would be understood to convey opposition to the spread of Islam in general, and not merely opposition to the adoption of Islamic law. *Id.* at 7-10.

At the second step of the inquiry, the court of appeals noted petitioners’ concession that, if the term “Islamisation” is understood to encompass any spreading of the religion of Islam, their mark is disparaging to Muslims. Pet. App. 11-12. The court also upheld the Board’s determination that the mark is disparaging even under petitioners’ preferred con-

struction of the term. *Id.* at 12-13. The court noted that petitioners' own evidence established that "[t]he political meaning of Islamisation does not require violence or terrorism." *Id.* at 13. The court therefore upheld the Board's determination that "associating peaceful political Islamisation with terrorism would be disparaging to a substantial composite of American Muslims." *Ibid.*

ARGUMENT

Petitioners contend (Pet. 5-27) that the Board erred in considering the content of their website in determining the likely meaning of their mark, and that the court of appeals applied the wrong standard of review to the Board's decision. The court of appeals correctly upheld the Board's determination that petitioners' mark is ineligible for registration under 15 U.S.C. 1052(a), and its decision does not conflict with any decision by this Court or another court of appeals. In any event, this case would not be an appropriate vehicle in which to consider the questions presented. Petitioners forfeited the arguments on which they now rely by failing to make them in the court of appeals, and petitioners would not be entitled to relief even if they prevailed on the questions they seek to raise in this Court. Further review is not warranted.

1. Petitioners argue (Pet. 6-14) that the Board violated the First Amendment and penalized them for "the viewpoint of [their] political speech" by considering articles and comments on their website in determining how their mark would be understood in context. Pet. 11. Petitioners forfeited that argument by failing to raise it below. In any event, the Board acted properly in considering the website evidence, and pe-

titioners do not suggest that the decision below implicates any disagreement among the courts of appeals. Any error was harmless, moreover, because the Board and the court of appeals would have reached the same result even without considering the website evidence.

a. In the court of appeals, petitioners challenged the Board's finding as to the likely meaning of their mark, and they argued that the evidence from their website did not support the Board's conclusions. Pet. C.A. Br. 11-18; Pet. C.A. Reply Br. 6-20. Petitioners did not argue, however, that the Board's consideration of the website evidence raised any First Amendment problem. *Ibid.* Accordingly, the court of appeals did not consider the issue. See Pet. App. 5-14. Petitioners' attempt to raise a First Amendment challenge for the first time in their petition is barred by this Court's "traditional rule" that "precludes a grant of certiorari * * * when the question presented was not pressed or passed upon below." *United States v. Williams*, 504 U.S. 36, 41 (1992) (citation and internal quotation marks omitted); see, e.g., *United States v. United Foods, Inc.*, 533 U.S. 405, 417 (2001).²

² Petitioners raised a separate constitutional challenge during the proceedings before the Board, arguing that the statutory ban on registration of disparaging trademarks, 15 U.S.C. 1052(a), violates the First Amendment. Pet. App. 44. Petitioners abandoned that argument in the court of appeals, however, and they do not raise it in this Court. See Pet. 3 n.3. In any event, every court of appeals to consider the issue has held that the PTO's refusal to register a mark does not abridge the applicant's First Amendment rights. See *Test Masters Educ. Servs., Inc. v. Singh*, 428 F.3d 559, 578 n.9 (5th Cir. 2005), cert. denied, 547 U.S. 1055 (2006); *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).

b. In any event, petitioners' challenge to the Board's use of the website evidence lacks merit. The Board considered material from petitioners' website for two purposes, both entirely proper. First, petitioners' website, like any other published work, is probative of how the term "Islamisation" is used in public discourse. Petitioners have argued that "the term 'Islamisation' has *only* been used in the public domain to refer to a political and military process replacing civilian laws with Islamic religious law." Pet. C.A. Br. 13 (emphasis added). The Board appropriately pointed out that the term is used in a broader manner on petitioners' own website, to suggest that stopping "Islamisation" is equivalent to stopping the spread of Islam itself. Pet. App. 7-8, 10; see *id.* at 23 (noting that website comments "reflect the public's association of 'Islamization' with 'Islam'") (footnote omitted).

Second, and more fundamentally, the website evidence was relevant to situating petitioners' mark in its marketplace context. An application for trademark registration is not evaluated in a vacuum, but rather in the context of the intended use of the mark. An application must include a description of the goods or services in connection with which the applicant uses or intends to use the mark. 15 U.S.C. 1051(a)(2) and (b)(2); see 37 C.F.R. 2.32(a)(6) and (c). Registration, if approved by the PTO, operates as *prima facie* evidence of the registrant's "exclusive right to use the registered mark in commerce *on or in connection with the goods or services specified in the [registration] certificate.*" 15 U.S.C. 1057(b) (emphasis added); see 15 U.S.C. 1115(a). The Board therefore was justified in examining petitioners' website for "insight into

the public's perception of and reaction to [petitioners'] mark and services as used in the marketplace." Pet. App. 10.

The policy of evaluating trademarks in the specific context of the goods or services with which they are to be used pre-dates the Lanham Act, see, e.g., *In re Riverbank Canning Co.*, 95 F.2d 327, 329 (C.C.P.A. 1938), and has been applied to Section 1052(a) determinations since the statute's adoption, see, e.g., *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1341 (Fed. Cir. 2003); *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227, 227-228 (Pat. Office 1951). There is good reason for this context-sensitive approach. Because a single word can have multiple meanings, the meaning that the public will ascribe to a particular mark may often depend on the context in which the mark appears. See, e.g., *Order Sons of Italy in Am. v. Memphis Mafia Inc.*, 52 U.S.P.Q.2d (BNA) 1364, 1368-1369 (T.T.A.B. 1999) (holding that, although the word "Mafia" typically refers to "a secret organization of Italian origin engaged in criminal activities," it would not have that meaning in the mark "THE MEMPHIS MAFIA," which was to be used in connection with "talks relating to music personalities"); see also 1 Anne Gilson LaLonde, *Gilson on Trademarks* § 3.04[6][a][i][B][I], at 3-140 (2014) ("Context is vital" in determining "the likely meaning of a * * * mark.").

Petitioners therefore are wrong in insisting (Pet. 11) that the Board should have focused only on "how the public might have understood *the Mark itself*," without regard to the services identified in the application and petitioners' actual use of the mark in the marketplace. Petitioners themselves previously

acknowledged—both before the Board and in the court of appeals—that the meaning of their mark should be determined based in part on “the manner in which the mark is used in the marketplace in connection with the[ir] goods or services.” Pet. App. 5 (quoting *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1217 (T.T.A.B. 2010)); see *id.* at 17-18. Indeed, petitioners emphasized in the court of appeals that “a term that has multiple meanings must be understood * * * in context of how it is used in the marketplace of ideas relevant to the mark.” Pet. C.A. Br. 12. That is precisely why the Board considered the articles on petitioners’ website, which comprise petitioners’ services and which were displayed “immediately underneath the website’s STOP THE ISLAMIZATION OF AMERICA banner.” Pet. App. 21 (footnote omitted).³

Petitioners are also wrong to assert (Pet. i, 6-14) that their application was denied based on the viewpoint of their political speech. If the mark that petitioners sought to register had lacked disparaging potential, nothing in the Board’s decision suggests that their application could have been denied based on petitioners’ speech about Muslims. Rather, as required by Section 1052(a), the Board determines whether specific *marks* are disparaging as used in their marketplace context, not whether *applicants* have en-

³ Petitioners argue (Pet. 11) that the Board could have sought survey evidence as to how the public understands the mark. But “[t]he practicalities of the limited resources available to the PTO are routinely taken into account in reviewing its administrative action,” and “[t]he PTO does not have means to conduct a marketing survey” in *ex parte* trademark-registration proceedings. *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 768 (Fed. Cir. 1985).

gaged in other speech that might be deemed disparaging.

In this case, the Board did not deny registration because of “the viewpoint of [petitioners’] political speech related tangentially to the subject of the mark.” Pet. i. Instead, the Board considered evidence from the website only to decide which of two possible meanings the word “Islamisation” would likely be given by a person who encountered petitioners’ mark in its marketplace context. Pet. App. 18-24. “The First Amendment * * * does not prohibit the evidentiary use of speech,” even in a criminal case where it is introduced “to establish the elements of a crime or to prove motive or intent.” *Wisconsin v. Mitchell*, 508 U.S. 476, 489 (1993). Similarly here, the First Amendment did not prohibit the Board’s “evidentiary use” of petitioners’ website to determine how a member of the public would understand the term “Islamisation” in the context where petitioners’ mark was used.

c. Petitioners also fail to show that the question presented arises with any frequency, let alone that it has divided the circuits.⁴ Indeed, petitioners acknowledge (Pet. 6) that this case was one of “first impression.” The Lanham Act has prohibited federal registration of disparaging trademarks since the statute’s

⁴ Issues of trademark registrability can be heard in any court of appeals. Although most challenges to the PTO’s refusals to register trademarks are brought as direct appeals in the Federal Circuit, see 15 U.S.C. 1071(a), challenges to such denials may also be brought via a civil action in a federal district court, see 15 U.S.C. 1071(b), and appeals in such cases are heard in the regional circuits. Cf. 28 U.S.C. 1295 (giving the Federal Circuit exclusive jurisdiction over appeals in patent cases, but not in trademark cases).

enactment in 1946. See Act of July 5, 1946, Pub. L. No. 79-489, § 2(a), 60 Stat. 428. The fact that no court of appeals has addressed the application of that prohibition until now is sufficient reason by itself to deny further review.

d. Finally, this case would be a poor vehicle for deciding the question presented because the disputed website material did not affect the outcome below. The Board and the court of appeals considered the website evidence only in determining that the word “Islamisation” may be understood as referring to the religion of Islam generally. Pet. App. 7-10, 20-24. That conclusion was also supported by multiple dictionary definitions in the record, to which petitioners did not object. *Id.* at 7-8, 18-20. In any event, both the Board and the court of appeals concluded (without any reliance on the website materials) that the mark would be disparaging even under petitioners’ preferred narrower definition of “Islamisation.” *Id.* at 12-13, 38-43.

2. The court of appeals held that the Board’s ultimate determination regarding registrability is a legal conclusion reviewed de novo, while the Board’s underlying factual findings are reviewed for substantial evidence. Pet. App. 6. Petitioners contend (Pet. 14-27) that the court’s articulation of the applicable standard of review is erroneous and conflicts with decisions of other circuits. Petitioners failed, however, to present that argument below. In addition, the circuit conflict that petitioners describe does not involve determinations of disparagement, but rather a different statutory question that is not presented here. In any event, the choice between the competing standards of review would not affect the outcome of this case because the

court upheld the Board's decision despite applying the *less* deferential of the two standards. Finally, there is no merit to petitioners' contention that the Board should have applied a novel *substantive* standard for disparagement that might in turn have called for a different standard of review.

a. Petitioners forfeited their challenge to the standard of review applied by the court of appeals by failing to advocate a different standard below. Indeed, petitioners expressly "agree[d]" that the Board's ultimate determination regarding disparagement is a question of law reviewed *de novo* while its underlying factual findings are reviewed for substantial evidence. Pet. C.A. Reply Br. 5 (citing PTO C.A. Br. 14-15). Petitioners' failure to raise the issue in the court of appeals is by itself a sufficient reason to deny review.

b. As petitioners explain (Pet. 15-18), a circuit split exists concerning the appropriate standard of review in a different category of trademark cases: those involving the likelihood of confusion between parties' marks under 15 U.S.C. 1052(d), 1114(1), and 1125(a). The circuits are divided over whether a likelihood-of-confusion determination should be reviewed as a pure question of fact, as the majority of circuits have held, or as a legal conclusion resting on subsidiary findings of fact, as three other circuits have held.⁵ That split

⁵ Compare, *e.g.*, *Dorpan, S.L. v. Hotel Meliá, Inc.*, 728 F.3d 55, 64 (1st Cir. 2013); *American Home Prods. Corp. v. Barr Labs., Inc.*, 834 F.2d 368, 370-371 (3d Cir. 1987); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1526 (4th Cir. 1984); *Chappell v. Goltsman*, 197 F.2d 837, 839 (5th Cir. 1952); *AutoZone, Inc. v. Strick*, 543 F.3d 923, 929 (7th Cir. 2008); *Kemp v. Bumble Bee Seafoods, Inc.*, 398 F.3d 1049, 1053-1054 (8th Cir. 2005); *Drexel Enters., Inc. v.*

has existed for decades, and this Court has repeatedly declined requests to address it.⁶

Even if the Court were inclined to resolve the issue now, this case would not be an appropriate vehicle in which to do so because it does not involve a likelihood-of-confusion determination. Petitioners do not contend that the circuits have reached inconsistent outcomes regarding the standard of review that applies to disparagement determinations under Section 1052(a). To the contrary, it appears that no other court of appeals has addressed the issue. See pp. 13-14, *supra*.

c. This case does not implicate the circuit conflict for an additional reason. The court of appeals treated the Board's "determination that a mark may be disparaging" as "a conclusion of law based upon underlying

Richardson, 312 F.2d 525, 528 (10th Cir. 1962), and *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 973 (11th Cir. 1983), with *Plus Prods. v. Plus Disc. Foods, Inc.*, 722 F.2d 999, 1004-1005 (2d Cir. 1983); *WSM, Inc. v. Tennessee Sales Co.*, 709 F.2d. 1084, 1086 (6th Cir. 1983), and *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1569 (Fed. Cir. 1983).

⁶ See, e.g., *Caught-On-Bleu, Inc. v. Anheuser-Busch, Inc.*, 544 U.S. 920 (2005); *Merriam-Webster, Inc. v. Random House, Inc.*, 513 U.S. 1190 (1995); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 510 U.S. 908 (1993); *Murphy v. Provident Mut. Life Ins. Co.*, 502 U.S. 814 (1991); see also *McMonagle v. Northeast Women's Ctr., Inc.*, 493 U.S. 901, 904 (1989) (White, J., dissenting) (noting three other occasions on which the Court declined to review the question). The existence of this circuit split has been noted in the briefing in *Hana Financial, Inc. v. Hana Bank*, cert. granted, No. 13-1211 (June 23, 2014), which presents the distinct question whether a jury, when one is empaneled, or a district judge should determine whether use of an older mark may be tacked to a newer one for purposes of determining priority. See Br. in Opp. at 12-13 & n.2, *Hana Fin., supra* (No. 13-1211).

ing factual inquiries.” Pet. App. 6 (quoting *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994)). The court stated that “[t]he Board’s factual findings are reviewed for substantial evidence, ‘while its ultimate conclusion as to registrability is reviewed de novo.’” *Ibid.* (quoting *In re Fox*, 702 F.3d 633, 637 (Fed. Cir. 2012)). In declining to treat the Board’s ultimate disparagement finding as one of fact, the court applied the *less* deferential of the two standards that have been used in the likelihood-of-confusion context. There is consequently no possibility that the court’s adoption of the competing standard of review would have caused the court to overturn the Board’s decision or otherwise have benefitted petitioners.

Accordingly, petitioners do not argue that the court of appeals should have reviewed the Board’s ultimate decision for substantial evidence. Instead, petitioners contend (Pet. 21-27) that the Board and the court of appeals should have added a new *substantive* element to the disparagement inquiry—an element that in their view would then have been subject to de novo review. Petitioners assert that, before determining whether a mark “may be disparaging to a substantial composite of the referenced group,” Pet. App. 5-6 (quoting *Lebanese Arak*, 94 U.S.P.Q.2d (BNA) at 1217), the Board should have asked “whether the mark is objectively disparaging.” Pet. 21. Petitioners further assert (Pet. 21) that this threshold “objective” inquiry would have presented a question of law subject to de novo review on appeal. But petitioners cite no authority supporting their novel “objective” test for disparagement, and they did not urge either the Board or the court of appeals to conduct such an inquiry. To the contrary, petitioners “agree[d]” in both

tribunals that “the proper inquiry was set forth by the Board in *In re Lebanese Arak*.” Pet. App. 5; accord *id.* at 18.

In any event, the Board’s conclusion that petitioners’ mark is disparaging was correct and would have been upheld under any standard. At the first step of the *Lebanese Arak* inquiry, the court of appeals upheld the Board’s conclusion that the term “Islamisation” in petitioners’ mark would be understood to refer to the religion of Islam in general, not just the political advocacy of Islamic law. Pet. App. 6-11. That determination was not affected by petitioners’ claimed error regarding the standard of review, which focuses exclusively on the second step of the *Lebanese Arak* inquiry. See Pet. 18-27. Petitioners “conceded at oral argument that their mark is disparaging under a religious meaning of Islamisation,” Pet. App. 12, and they have never argued that Section 1052(a) permits the registration of a mark that is found under the first step of *Lebanese Arak* to have two likely meanings, one of which is disparaging.

CONCLUSION

The petition for a writ of certiorari should be denied.

Respectfully submitted.

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