

IN THE UNITED STATES DISTRICT COURT  
FOR THE EASTERN DISTRICT OF VIRGINIA  
ALEXANDRIA DIVISION

PRO-FOOTBALL, INC.,

Plaintiff,

v.

AMANDA BLACKHORSE, MARCUS  
BRIGGS-CLOUD, PHILLIP GOVER,  
JILLIAN PAPPAN and COURTNEY  
TSOTIGH,

Defendants.

Civil Action No.: 1:14-cv-1043-GBL-IDD

**DEFENDANTS' REBUTTAL MEMORANDUM IN SUPPORT OF THEIR  
CROSS-MOTION FOR SUMMARY JUDGMENT ON COUNTS 3 THROUGH 6**

Jesse A. Witten (*pro hac vice*)  
Jeffrey J. Lopez (VA Bar No. 51058)  
Adam Scott Kunz (VA Bar No. 84073)  
Tore T. DeBella (VA Bar No. 82037)  
Jennifer T. Criss (VA Bar No. 86143)  
DRINKER BIDDLE & REATH LLP  
1500 K Street, N.W., Suite 1100  
Washington, D.C. 20005-1209  
Telephone: (202) 842-8800  
Facsimile: (202) 842-8465  
Jesse.Witten@dbr.com  
Jeffrey.Lopez@dbr.com  
Adam.Kunz@dbr.com  
Tore.DeBella@dbr.com  
Jennifer.Criss@dbr.com

*Counsel for Defendants Amanda Blackhorse,  
Marcus Briggs-Cloud, Phillip Gover, Jillian  
Pappan and Courtney Tsoitigh*

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## **INTRODUCTION**

PFI's opposition to Defendants' Motion for Summary Judgment on Counts 3-6 ignores numerous arguments and key authorities that eviscerate PFI's Constitutional claims.

In its First Amendment argument, PFI ignores Supreme Court and Fourth Circuit case law stating that trademark law is an exception to – and in tension with – the First Amendment; trademark law is not a device for promoting speech. *See infra* at Part I.A. In addition, PFI does not dispute that the Government has an interest in dissociating itself from speech that may disparage Americans, and provides no evidence to counter the finding that this interest is real and substantial such that Section 2(a) is a permissible regulation of commercial speech. *See* Part I.D.

PFI's void-for-vagueness argument fails under the applicable lenient standard of review in *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569 (1998). *See infra* at Part II.A. PFI also seeks to minimize the Supreme Court's decision in *Marsh v. Chambers*, 463 U.S. 783 (1983), claiming the Court used "disparage" only "in passing." In fact, the Court employed "disparage" to set the standard for legislative prayer under the Establishment Clause. *See infra* at Part II.C.

None of PFI's Constitutional claims has merit and Defendants are entitled to summary judgment on Counts 3 through 6.

## **RESPONSE TO PFI'S STATEMENT OF ADDITIONAL MATERIAL FACTS**

1. Every dictionary in the record agrees that the word "redskin" refers to North American Indians; both before and during the period 1967-1990, dictionaries contained usage labels such as "offensive slang," "usually offensive," "usually taken to be offensive," "considered offensive," and "contemptuous" that were included with the definition. *See, e.g.*, [Dkt. 99-1], [Dkt. 72-6 – 72-11]. PFI has consistently associated the team with Native Americans and with Native American imagery and themes. Two of PFI's marks contain express Indian imagery, and PFI has used its marks in connection with Indian imagery and themes (*e.g.*, helmet image,

cheerleader and marching band uniforms, and fight song lyrics). *See* [Dkt. 71] at 27-29, 33; [Dkt. 72-3] at Nos. 4-8; [Dkt. 74-6 – 74-9]. In addition, the public and the media understand the team name to refer to Native Americans. *See* [Dkt. 75-24 – 75-29].

2. At least as early as 1972, PFI was aware of Native American opposition to the name “Redskins.” In 1972, Leon Cook, President of the National Congress of American Indians and other Indian leaders – including LaDonna Harris, the wife of a United States Senator – met with the PFI President to demand a change in the team name. [Dkt. 71] at 17-19; [Dkt. 73-26]. The next day, the PFI President wrote to NFL Commissioner Pete Rozelle to inform him that he had met with a “delegation of American Indian leaders who are vigorously objecting to the continued use of the name Redskins” and who had “cogently” expressed their position. [Dkt. 73-27].

**RESPONSE TO PFI’S “GUIDING PRINCIPLES OF TRADEMARK LAW”**

PFI asserts that the “may disparage” prohibition of Section 2(a) is the only bar to federal registration based on the *content* of a trademark. [Dkt. 119] at 4 (“Unlike the rest of Section 2, this particular bar to registration – which did not exist prior to 1946 – uniquely reflects federal oversight of a mark’s *content* rather than *function*.”). This is inaccurate. Other provisions of Section 2 also restrict registration based on the content of the trademark.

Section 2(a) contains a separate prohibition on “immoral” and “scandalous” matter, a content based limitation which also existed in the predecessor statute to the Lanham Act. Act of Feb. 20, 1905, ch. 592, 33 Stat. 724 §5(a) (barring registration of mark that “[c]onsists of or comprises immoral or scandalous matter”); Act of Mar. 19, 1920, ch. 104, 41 Stat. 533 (specifically preserving exceptions in §5 of 1905 Act). Section 2(a) also bars registration of trademarks that contain matter that bring persons into “contempt or disrepute.” 15 U.S.C. § 1052(a). In addition, Section 2(b) prohibits registration of any matter that “consists of or



comprises the flag or coat of arms of other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.” 15 U.S.C. § 1052(b). And Section 2(c) prohibits registration of the name, portrait or signature of a living individual without the person’s consent. 15 U.S.C. § 1052(c).

These provisions all prohibit registration based on a mark’s content – even if that content serves a source identifying function and would not cause confusion with marks owned by others. *Contrast* [Dkt. 119] at 7 (“Marks that would be registered but for Section 2(a): (1) serve source-identifying functions; and (2) are not misleading or confusingly similar with other marks.”) PFI’s assertion that the “may disparage” prohibition places a “unique” restriction on content misstates the Lanham Act and inaccurately characterizes the “may disparage” provision as different in kind from other limits on registrability. [Dkt. 119] at 4.

## ARGUMENT

### **I. CANCELLATION OF PFI’S REGISTRATIONS DOES NOT VIOLATE THE FIRST AMENDMENT**

#### **A. Section 2(a) Does Not Restrict PFI’s First Amendment Rights.**

PFI asserts that “Defendants do not contest that PFI has a First Amendment right to use its trademarks, and that enforcement of Section 2(a) burdens that speech.” [Dkt. 119] at 17. That is not correct. Defendants never suggested that Section 2(a) burdens PFI’s speech (and PFI cites nothing to support its assertion). In fact, Defendants argued expressly to the contrary. [Dkt. 106] at 7-15. Defendants agree that PFI has a First Amendment right to use its trademarks, but Section 2(a) does not burden PFI’s speech. *See In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (holding that refusal to register a trademark did not violate First Amendment because trademark owner was free to use its trademarks however it wished).

Rather, it is PFI's ability to enjoin others from using those words and symbols that is theoretically affected by cancellation of its registrations.<sup>1</sup> The right to enjoin others from speaking is not a First Amendment right, however. As Defendants have pointed out ([Dkt. 106] at 8), the Supreme Court has explained that trademark law injunctions are a permissible restriction of the commercial speech rights of the public. *See S. F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 534-40 (1987); *see also CPC Int'l, Inc. v. Skippy, Inc.*, 214 F.3d 456, 461-62 (4th Cir. 2000) (vacating trademark injunction due to free speech concerns); *Lamparello v. Fallwell*, 420 F.3d 309, 313 (4th Cir. 2005) (noting tension between trademark law and First Amendment). In *San Francisco Arts*, the Supreme Court described the right to enforce a trademark not as a First Amendment right of the trademark-owner, but as a common law and statutory right that passes muster as a permissible restriction on commercial speech rights of the public. *See S. F. Arts*, 483 U.S. at 534-37; *see also Bd. Of Trs. v. Fox*, 492 U.S. 469, 476 (1989) (citing *San Francisco Arts* as example of case analyzing constitutionality of government regulation of commercial speech). The Lanham Act was adopted pursuant to Congress's Constitutional power to regulate interstate commerce, not to protect First Amendment rights of trademark owners. *See Playboy Enters. v. Netscape Commc'ns. Corp.*, 354 F.3d 1020, 1024 n.11 (9th Cir. 2004). PFI ignores this history. [Dkt. 119] at 18.

The only case PFI cites in response is *Sambo's Rests., Inc. v. City of Ann Arbor*, 663 F.2d 686 (6th Cir. 1981). [Dkt. 119] at 18. That case, however, did not hold that the right to exclude

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<sup>1</sup> A registration can help a trademark owner obtain an injunction by creating evidentiary presumptions of validity, ownership and the exclusive right to use a mark in commerce. *See* 15 U.S.C. §§ 1057(b), 1115(a). For a trademark that is as well-known as "Washington Redskins," these presumptions are of little value; no one can deny knowledge of these famous trademarks. PFI can enforce these marks without these presumptions. *See Teaching Co. Ltd. Partnership v. Unapix Entertainment, Inc.*, 87 F.Supp.2d 567, 575 (E.D. Va. 2000) (enforcing unregistered mark)

others from using one's trademark is a right protected by the First Amendment. Rather, the Sixth Circuit held that under the First Amendment, a city could not bar a restaurant from calling itself "Sambo's" and from posting exterior signage with its trademarked name. *Id.* at 695. In *Sambo's*, the city threatened the restaurant with sanctions and even criminal prosecution if it posted "Sambo's" on an exterior sign. *Id.* at 688. Here, by contrast, there is no dispute that PFI can use its trademarks however it wishes even if its registrations are cancelled.

PFI also asserts that the USPTO could not deny a trademark registration that included the name of a political party solely because it disagrees with the party's platform. [Dkt. 119] at 18. That may be so, but it is not the First Amendment that restricts the Government from doing so. Depending on the facts and circumstances presented, other Constitutional protections, *e.g.*, the Equal Protection and Due Process Clauses, might prevent the Government from acting in such a discriminatory fashion. *See Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 598 n. 3 (1998) (Scalia, J., concurring) (stating that while the Constitution would prevent the Government from acting to promote Republican candidates, this "does not have anything to do with the First Amendment"); *Pleasant Grove City v. Summum*, 555 U.S. 460, 481-82 (2009) (Stevens, J., concurring) (stating that Equal Protection Clause and, in some instances, the Establishment Clause – but not the speech provisions of the First Amendment – preclude Government from expressing offensive or partisan messages).<sup>2</sup>

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<sup>2</sup> PFI also asserts that the Government cannot deny copyright protection to a book that expresses an unpopular view. [Dkt. 119] at 18. If so, it is not the First Amendment that poses that bar but other Constitutional limits on Government action. As with trademark law, the right to bar others from using copyrighted matter is an exception to the First Amendment that arises under copyright law; it is not a First Amendment right. *See Golan v. Holder*, 132 S.Ct. 873, 876 (2012) ("[S]ome restriction on expression is the inherent and intended effect of every grant of copyright"); *SunTrust Bank v. Houghton Mifflin Co.*, 268 F.3d 1257, 1263 n.12 (11th Cir. 2001)

Finally, PFI asserts that the speech rights of others are not infringed by the “right to exclude inherent in trademark ownership” because “[t]rademark rights *generally* are enforced only against deceptive or misleading commercial speech (which is not protected by the First Amendment) and attempts to enforce marks against non-commercial uses are *generally* barred by the First Amendment.” [Dkt. 119] at 18 (emphasis added). The qualifying word “generally” betrays PFI’s argument. In fact, trademark injunctions can be obtained against non-misleading and non-deceptive commercial speech. Indeed, in its opening brief, PFI raised concern that cancelling its registrations could lead to increased “unlicensed” and “diluting” uses of its trademarks, and not merely to increased deceptive or misleading uses. [Dkt. 56] at 16. Furthermore, non-commercial speech by the public has also been enjoined by trademark enforcement notwithstanding the First Amendment. *See, e.g., Radiance Found., Inc. v. NAACP*, 25 F. Supp. 3d 865, 901-02 (E.D. Va. 2014) (injunction against calling the NAACP the “National Association for the Abortion of Colored People” to protest NAACP’s collaboration with Planned Parenthood), *on appeal*, No. 14-1568 (4th Cir.). And as a practical matter, in *Lamparello*, 420 F.3d at 313, the Fourth Circuit noted that “social and commercial discourse” can be chilled or even rendered “impossible” by the mere threat of an infringement lawsuit.

Because cancellation of PFI’s registrations would not affect PFI’s First Amendment speech rights – but only its ability to limit the speech of others – Defendants are entitled to summary judgment on Count 3.

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(“While the First Amendment disallows laws that abridge the freedom of speech, the Copyright Clause calls specifically for such a law”).

**B. Section 2(a) Does Not Impose An “Unconstitutional Condition” On Obtaining A Trademark Registration.**

As Defendants have explained, the Lanham Act established permissible conditions on participation in the Government’s registration program. [Dkt. 106] at 9-12.<sup>3</sup> Defendants explained that under *Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 133 S.Ct. 2321, 2330 (2013) (“*Open Society*”), the Section 2(a) restrictions define the limits of the Government program and do not seek to leverage private speech outside the program.

PFI responds first by asserting that *Open Society* applies only in cases of Government financial subsidies, and that the registration program is not a subsidy program. [Dkt. 119] at 13-15. PFI cites the ACLU’s *amicus* brief as support for its assertion that the USPTO expends no public funds in evaluating and approving marks, but relies solely on user application fees. [Dkt. 119] at 15. But, the unconstitutional conditions inquiry does not turn on whether a Government program is funded via general revenues of the Treasury or through a special fund collected from applicants to the Government program. *See, e.g., Johanns v. Livestock Mktg. Ass’n*, 544 U.S. 550, 562-67 (2005) (holding that beef promotion program was Government speech even though it was funded by “a targeted assessment on beef producers, rather than by general revenues”).

The funding source is immaterial to the relevant fact that the Government provides something valuable in the form of a registration. According to PFI, a registration confers “many crucial benefits” to the owner of a trademark. [Dkt. 119] at 1. Trademark owners that seek registrations obviously value the registration more than their application fee.

PFI cites *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533 (2001), to argue that the Government cannot impose a condition on recipients of federal funds when those funds are

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<sup>3</sup> Defendants initially made this argument in the context of the Government speech doctrine, which PFI notes is a “related” “doctrine.” [Dkt. 119] at 13 n.19.

intended to facilitate private speech.<sup>4</sup> [Dkt. 119] at 15-16. There is no such blanket legal rule. As Defendants have explained, in *Rust v. Sullivan*, 500 U.S. 173 (1991), the Court held that a Government program may impose speech conditions on a program participant. [Dkt. 106] at 10-11. The Supreme Court’s recent decision in *Open Society* sets the framework to analyze the permissibility of a condition for participation in a Government program.

As Defendants have explained, under *Open Society*, Section 2(a) defines the registration program, but does not limit or restrict a trademark owner’s speech. [Dkt. 106] at 11-12; *Open Society*, 133 S.Ct. at 2330. PFI’s argument that Section 2(a) runs afoul of *Open Society* is strained. [Dkt. 119] at 16-17. PFI contends that it cannot have “one trademark on the federal trademark register that complies with section 2(a) but then use a different mark on the same product in commerce.” *Id.* at 17. That is just an indirect way of complaining that the Lanham Act contains bars to registration. The relevant question under *Open Society* is whether, when the Government issues a trademark registration, it compels the trademark owner to speak or to refrain from speaking in any way. The answer to that question is “no.” PFI can continue to disparage anyone it wants, using any words or symbols it chooses, without losing the ability to register marks that do not themselves contain matter that may disparage.

Finally, PFI states that, because of Section 2(a), businesses might avoid marks that may disparage, as a result of a “chilling” effect that causes “self-censorship.” [Dkt. 119] at 11. However, tailoring speech to respond to regulatory incentives is not self-censorship or chilling.

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<sup>4</sup> *Velazquez* held that the federal government cannot restrict the advocacy message of Legal Services lawyers who received federal funding when representing low-income clients. The restrictions in *Velazquez* threatened not only the individual speech rights of funding recipients, but were designed to distort the judicial system by limiting communication between attorneys and their indigent clients and by insulating unconstitutional laws from legitimate legal challenges. *See Velazquez*, 531 U.S. at 547-48.

PFI conflates benefits and burdens; the content-based registration provisions of the Lanham Act (*see supra* at Part I.A) may offer benefits for marks that satisfy the criteria for registration, but they do not burden the use of marks that are not eligible for registration.

**C. Issuing and Cancelling Trademark Registrations Fall Within The Government Speech Doctrine.**

PFI argues that the issuance and cancellation of trademark registrations, and adding marks to or removing them from the Government's Principal Register, do not amount to Government speech because the action "impacts" PFI's speech. [Dkt. 119] at 18-19. But PFI cites no decision applying an "impact" test. PFI also contends that the Government speech doctrine does not apply because the relevant speech to consider is PFI's use of its trademarks, rather than USPTO's registration issuance or cancellation. *Id.* In fact, the adoption and use of trademarks and the USPTO's publication or removal from the Principal Register are separate and distinct events. Here, PFI used "redskins" and certain of its marks for decades before seeking registration and may continue to do so even after cancellation.

*Pleasant Grove City v. Summum*, 555 U.S. 460 (2009), illustrates that issuing or cancelling registration certificates are instances of Government speech. In *Summum*, a private party applied to a city to include its monument in a city park where the city placed private monuments. The Court held that the city's rejection of the party's monument was Government speech exempt from the First Amendment, even though the city's speech took the form of merely rejecting the monument. Likewise, it is Government speech when the USPTO selects or rejects trademarks from inclusion in its trademark registries.

PFI also misapplies the four-factor test for Government speech set forth in *Sons of Confederate Veterans, Inc. v. Comm'r of the Va. Dept. of Motor Vehicles*, 288 F.3d 610, 618 (4th Cir. 2002) ("SCV"). [Dkt. 119] at 19-20. As to the first SCV factor, PFI argues that the "central

purpose” of the registration system is to facilitate private use of trademarks. *Id.* at 19. This is erroneous. The stated objective of the Lanham Act is not to facilitate private expression of speech, but to advance traditional governmental objectives of consumer protection and the protection of private property. *See* [Dkt. 106] at 13. PFI’s reliance on *ACLU v. Tata*, 742 F.3d 563, 572-73 (4th Cir. 2014), is misplaced. In *Tata*, a license plate case, the court specifically found that the legislative history of the North Carolina statute “indicates that the specialty license plate program was intended to be a forum for private expression of interests.” *Id.* at 572.

PFI next argues that the second *SCV* factor, “editorial control,” favors PFI’s position because the decisions made by the USPTO in processing trademark applications are not substantive. [Dkt. 119] at 19. Even if that were true (which it is not), “substantive” involvement by the government in crafting the message is not the test. The issue is whether the government “effectively controls” the messages communicated by exercising “final approval authority” over their selection. *Summum*, 555 U.S. at 473. The Supreme Court’s decision in *Summum* supersedes *SCV* and *Planned Parenthood of S.C. Inc. v. Rose*, 361 F.3d 786 (4th Cir. 2004), the two cases cited by PFI. [Dkt. 119] at 19 n.24. The monuments on display in *Summum* did not originate with Pleasant Grove City (most were donated by private parties), nor did the city modify them in a substantive way prior to display. *Id.* at 464. The city only “selected those monuments that it wants to display for the purpose of presenting the image of the City that it wishes to project” and “expressly set forth the criteria it will use in making future selections.” *Id.* at 473.

Regarding the third *SCV* factor (identity of the literal speaker), PFI likens trademark registrations to license plates but ignores crucial distinctions between the two. [Dkt. 119] at 20. Trademark registration certificates are “issued in the name of the United States of America,



under the seal of the United States Patent and Trademark Office, and shall be signed by the Director . . .” and are kept in the USPTO offices. 15 U.S.C. § 1057(a). Trademark registration certificates, unlike license plates, are documents created for use in federal lawsuits to prove infringement – and when they are introduced into evidence, their purpose is to convey certain Government-backed evidentiary presumptions for courts to accept as true. [Dkt. 106] at 14; *Am. Online, Inc. v. AT&T Corp.*, 243 F.3d 812, 818 (4th Cir. 2001).

The fourth *SCV* factor (ultimate responsibility for the speech) also favors Defendants. Congress enacted the Lanham Act, including the numerous criteria for registration eligibility, and the USPTO is responsible for applying the criteria and maintaining the Principal Register. [Dkt. 106] at 14. PFI ignores this point and makes only passing reference to this factor.

Finally, PFI misstates the position taken by the United States when it asserts that “the U.S. does not even believe that the speech here is its own – it argues that the use of registered trademarks is a ‘hybrid’ of private and government speech because the government has a ‘role’ in registration.” [Dkt. 119] at 20. In fact, the Government merely noted that the court need not reach the question of whether registrations are Government speech, because the restrictions on registrability do not discriminate against any viewpoint. [Dkt. 109] at 17 n. 23. The United States’ discussion of hybrid speech is only offered as an alternative argument, in case the Court finds that the federal registration program constitutes mixed speech. *Id.* at 17 (“*If Analyzed Under the Fourth Circuit’s Treatment of Hybrid Speech as Occurring in a Limited Public Forum, Section 2(a) is Constitutional*”) (emphasis added).

**D. Even If Section 2(a) Restricted Private Speech, It Would Be A Valid Regulation Of Commercial Speech.**

PFI contends that Section 2(a) is not a permissible regulation of commercial speech because it does not advance a “substantial” Government interest. Defendants, however, have

explained that (among other substantial interests), the Government has a substantial interest in dissociating itself from commercial trademarks that may disparage fellow Americans, especially those that may disparage based on ethnicity or race. [Dkt. 106] at 16. PFI tries to distinguish the cases Defendants cited ([Dkt. 106] at 16) on grounds that the courts did not apply legal tests that required a finding of “substantial” interest. [Dkt. 119] at 23 & n.29. This effort fails. In *Bd. of Trs. v. Mayor & City Council of Balt.*, 562 A.2d 720, 754 (Md. 1989), the Court found the interest to be “profound,” and in *Air Transp. Ass’n of Am. v. City & Cnty. of San Francisco*, 992 F. Supp. 1149, 1164 (N.D. Cal. 1998), the Court described such an interest as “strong.” Not surprisingly, PFI has failed to cite authority that the Government lacks a substantial interest in dissociating itself from offensive messages. [Dkt. 119] at 22-23.

There can be no dispute that the Government has a substantial interest in dissociating from speech that may disparage. Racism and ethnic discrimination have been terrible facts of American history and contemporary American life, including in the context of trademarks. As PFI states, prior to the Lanham Act “[t]rademarks including slurs or racial epithets were regularly enforced,” as businesses used racist words and images to sell their products. [Dkt. 119] at 9 n.12 (citing “N\*gg\*r-Hair Smoking Tobacco,” “Paddy’s Market” and “Old Coon”). Defendants have provided other examples of pre-Lanham Act registration applications for racist trademarks (*e.g.*, “N\*gg\*r Head Brand”). *See* [Dkt. 118-2] Exh. 5. As noted above, trademark registration certificates are “issued in the name of the United States of America, under the seal of the United States Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon.” 15 U.S.C. § 1057(a). Through the certificates, the USPTO expresses an official opinion that marks are valid. *See Am. Online, Inc.*, 243 F.3d at 818. The Government thus has a substantial interest in dissociating from trademarks that contain matter

that may disparage. *See Fla. Bar v. Went for It*, 515 U.S. 618, 628 (1995) (substantial interest can be demonstrated by history, analogy, or common sense).<sup>5</sup>

PFI also argues that this Court should not consider whether the Government has a substantial interest in dissociating itself from marks that may disparage because Defendants and the United States have argued that Section 2(a) is a permissible condition for registration and/or an example of Government speech. [Dkt. 119] at 22-23. Parties, however, are permitted to assert alternative arguments (and even advance positions that may be contradictory). *See Fed. R. Civ. P.* 8(d)(3). Defendants' other arguments concern whether PFI's speech is actually abridged, while Defendants' commercial speech argument explains that even if Section 2(a) is viewed as regulating PFI's speech, it is a permissible commercial speech regulation.

## **II. SECTION 2(A) IS NOT UNCONSTITUTIONALLY VAGUE**

### **A. A Lenient Standard Of Review Applies.**

PFI's assertion that the "Court is to apply a heightened standard to determine whether Section 2(a) is unconstitutionally vague" ([Dkt. 119] at 28) is based on cases that either predate the Supreme Court decision in *NEA v. Finley* or that are readily distinguishable. In *Finley*, the Supreme Court applied a lenient standard for vagueness, specifically differentiating statutes that determine eligibility for a government benefit (lenient review) from statutes that impose a criminal sanction or civil liability for speech (stricter review). *See Finley*, 524 U.S. at 588-89.

As *Finley* notes, "the consequences of imprecision are not constitutionally severe" when the government bestows benefits on favored speech instead of imposing criminal or civil punishment

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<sup>5</sup> PFI does not argue that Defendants have failed to show that the harm in the Government's associating with speech that may disparage is real. It argues that "the U.S." has failed to show real harm as to certain other of the Government's substantial interests, but apparently does not dispute that there is a real harm in the Government associating itself with marks that may disparage. [Dkt. 119] at 23. In any event, the discussion above regarding pre-Lanham Act racist trademarks shows that the harm is real.

due to a person's speech. *Id.* at 589.

Thus, PFI's reliance on *Bullfrog Films, Inc. v. Wick*, 847 F.2d 502 (9th Cir. 1988) is in vain because *Bullfrog* was subsequently contradicted by *Finley*. [Dkt. 119] at 28-29. The post-*Finley* cases cited by PFI are distinguishable because they involve statutes that impose criminal or civil liability or punishment. In *FCC v. Fox TV Stations, Inc.*, 132 S. Ct. 2307 (2012), the Court considered a statute declaring that anyone who "utters any obscene, indecent, or profane language by means of radio communication shall be fined . . . or imprisoned not more than two years, or both." *FCC v. Fox*, 132 S. Ct. at 2312; 18 U.S.C. § 1464. Likewise, *Reno v. ACLU*, 521 U.S. 844 (1997), involved a criminal statute. In *Ctr. For Individual Freedom, Inc. v. Tennant*, 706 F.3d 270 (4th Cir. 2013), the Fourth Circuit considered a challenge to a state campaign finance statute by organizations that "feared prosecution" under a statute that empowered state prosecutors to "punish" "offenders." *Id.* at 275, 293.

Here, as in *Finley*, PFI faces no risk of criminal or civil liability or punishment, so a lenient void for vagueness standard applies.

**B. PFI Cannot Maintain A Facial Challenge To Vagueness.**

In *Wash. State Grange v. Wash. State Repub. Party*, 552 U.S. 442 (2008), the Court explained that it has used two different standards to determine a facial Constitutional challenge to a statute: "Under *United States v. Salerno*, 481 U. S. 739 (1987), a plaintiff can only succeed in a facial challenge by 'establish[ing] that no set of circumstances exists under which the Act would be valid,' *i.e.*, that the law is unconstitutional in all of its applications. *Id.*, at 745. While some Members of the Court have criticized the *Salerno* formulation, all agree that a facial challenge must fail where the statute has a 'plainly legitimate sweep.'" *Grange*, 552 U.S. at 449

(internal quotation omitted).<sup>6</sup> The distinction is not meaningful here. Under either standard, PFI cannot maintain a facial challenge. *See id.* There can be no dispute that the “may disparage” prong of Section 2(a) has a plainly legitimate sweep, and PFI has not argued otherwise. In fact, PFI does not state what standard applies in a facial challenge.

**C. Section 2(a) Provides Notice Of Its Requirements.**

PFI downplays important authority demonstrating that the term “disparage” is not unconstitutionally vague. As Defendants explained, in *Marsh v. Chambers*, 463 U.S. 783, 794-95 (1983), the Supreme Court used “disparage” to set the test to determine whether legislative prayer violates the Establishment Clause. [Dkt. 106] at 20. PFI asserts that the Court “used the word ‘disparage’ in passing.” [Dkt. 119] at 31 n.46. That is not so; it is the key sentence in *Marsh* and sets the standard for legislatures to follow when creating prayer opportunities. Indeed, the Fourth Circuit upheld a Virginia county’s written policy adopting the *Marsh* rule that no legislative invocation may “disparage any . . . faith or belief.” *Simpson v. Chesterfield Cnty. Bd. of Supervisors*, 404 F.3d 276, 278 (4th Cir. 2005); *see also Greece v. Galloway*, 134 S Ct. 1811, 1823-24 (2014) (applying *Marsh* disparagement test).

In addition, PFI ignores *Ridley v. Mass. Bay Transp. Auth.*, 390 F.3d 65, 74 (1st Cir. 2004), in which the First Circuit held that “disparage” as used in a transit authority policy barring offensive bus advertisements was not void for vagueness. [Dkt. 106] at 20 (discussing *Ridley*).

PFI asserts that the word “disparage” is necessarily “subjective.” [Dkt. 119] at 30. But, where there is an issue as to whether matter in a mark may disparage, it is not because there is

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<sup>6</sup> The criticism of Salerno apparently refers to a three-Justice plurality opinion in *City of Chi. v. Morales*, 527 U.S. 41, 55 n. 22 (1999). PFI inaccurately asserts that this was an opinion of the Court, rather than of the three Justices in the plurality. [Dkt. 119] at 29 n.41. PFI also makes the remarkable assertion that *Grange* “does not apply when First Amendment rights are implicated” even though *Grange* was itself a First Amendment case. *Id.*

doubt as to what “disparage” means; rather, the determination of whether matter may disparage can be fact-sensitive and individual Examining Attorneys may not always have the facts available when making registration decisions. That may well have been the case here where the USPTO Examining Attorneys who initially approved “redskin” marks for registration presumably lived in the Washington, D.C. area and may not have been aware of how the term “redskin” has been used against Indians. Unlike front-line Examining Attorneys, the TTAB decides whether matter may disparage based on a developed factual record where parties present evidence, documents and testimony.

**D. Section 2(a) Does Not Authorize Arbitrary and Discriminatory Enforcement.**

PFI argued that inconsistent Examining Attorney decisions mean that the “may disparage” language of Section 2(a) authorizes and encourages arbitrary and discriminatory enforcement. [Dkt. 56] at 21. Defendants have explained that inconsistent determinations by frontline Government employees acting without the benefit of a full factual record do not establish that the statute authorized arbitrary and discriminatory enforcement. [Dkt. 106] at 23-24. Defendants also pointed out that the examples of potential inconsistency all occurred at the Examining Attorney level and that “PFI has identified no inconsistencies in decisions of the TTAB.” *Id.* PFI asserts that “Defendants are wrong – examples for HEEB, SQUAW and REDSKINS were final decisions of the TTAB.” [Dkt. 119] at 32. In fact, Defendants were right. There were no inconsistencies in decisions of the TTAB. For Heeb, Squaw and Redskins, the TTAB’s decisions may disagree with Examining Attorney decisions but not with other decisions of the TTAB.

**E. Section 2(a) Is Not Vague As Applied To PFI’s Marks.**

PFI claims that it did not have notice that its marks “may disparage” Native Americans. [Dkt. 119] at 33. The record is clear that PFI has known since at least 1972 of actual controversy

among Native Americans regarding its team name, as evidenced by: (1) the 1972 meeting between the PFI President of NCAI and other Native American leaders (including leaders of AIM and the wife of a United States senator); (2) the letter from the PFI President to the NFL Commissioner stating that he had met with a “delegation of American Indian leaders who are vigorously objecting to the continued use of the name Redskins” and who had “cogently” expressed their position; (3) acknowledgment of the controversy in a 1972 game program; and (4) reporting of the controversy in multiple news articles in 1971-72, some of which quoted the PFI President. *See* [Dkt. 71] at 16-20; [Dkt 72-5; 73-25 – 73-27; 73-29 – 73-35]. And even if PFI lacked actual notice, it should have known that “redskin” may disparage because dictionary definitions from before 1967 through 1990 have stated that “redskin” is “offensive slang,” “usually offensive,” “usually taken to be offensive,” “considered offensive,” and “contemptuous.” *See supra* at 1; [Dkt. 72-6 – 72-11].

PFI also provides other examples of trademarks that contain “redskin” that Examining Attorneys approved for registration before 1990. [Dkt. 119] at 35-36. Since the *Harjo* petition was filed and additional evidence provided to the USPTO regarding “redskin,” the USPTO has not issued any further registrations for marks that use “redskin” in reference to a Native American. That is not a sign of inconsistency.<sup>7</sup>

PFI lists three occasions between 2009 and 2012 where Examining Attorneys refused registration of marks that contain “redskin” because of a possibility of confusion with PFI’s trademarks, without also citing Section 2(a) as a basis for refusal. [Dkt. 119] at 36. No inference can be drawn, however, from a rejection made on alternative, incurable grounds. *See* [Dkt. 120-

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<sup>7</sup> PFI cites an example of a mark using “redskins” that was registered since 1990, but that mark made clear that the word “redskins” was being used to describe the red-skinned peanuts sold under the mark and did not refer to Native Americans. *See* [Dkt. 119] at 36 n. 52; [Dkt. 120-14].

9 – 120-11]. Had the applicants continued to prosecute these applications, the Examining Attorneys could have raised disparagement in a Supplemental Office Action; they did not waive Section 2(a) as a basis for refusal. *See* Trademark Manual of Examining Procedure § 711.02.

To sustain a vagueness challenge PFI would have to prove a “pattern of discriminatory enforcement.” *See Wag More Dogs*, 680 F.3d 359, 372 (4th Cir. 2012). PFI has failed to do so. Any change in the USPTO’s treatment of marks containing “redskins” is the result of additional information coming to the USPTO’s attention since the filing of the Harjo petition. Examining Attorneys cannot always collect all available and relevant evidence before reaching their decisions. *Glendale Int’l Corp. v. United States PTO*, 374 F. Supp. 2d 479, 486 (E.D. Va. 2005).

That Examining Attorneys approved marks containing “redskin” until 1990 does not mean that Section 2(a) is vague or arbitrarily applied; it means only that Examining Attorneys did not reject these marks until third-party challenges raised the issue and provided additional information to the USPTO. The 1996 registrations that PFI describe ([Dkt. 119] at 35-36) fit this pattern: an examining attorney initially approved marks for publication, learned of Native American opposition, considered additional information about “redskin,” and then concluded that “redskin” may disparage and reversed the initial decision.

This is not a case of the USPTO applying a vague law, but of the USPTO occasionally acting with an incomplete factual record.

### **III. PFI CANNOT ENJOIN A PURPORTED TAKING**

This Court cannot grant PFI the relief it seeks (to prevent the cancellation of its registrations) under the Takings Clause for numerous reasons.

First, this Court lacks jurisdiction to grant PFI declaratory relief. The case PFI cites, *In re Chateaugay*, 163 B.R. 955 (S.D.N.Y. 1993), *aff’d* 53 F.3d 478 (2d Cir. 1995), to assert a right to seek declaratory relief instead of monetary compensation does not apply to the facts of this



case. The Supreme Court has made clear that *In re Chateaugay* and similar cases that allowed declaratory relief only stand for a narrow exception to the general rule that the exclusive remedy for a taking is compensation under the Tucker Act. *E. Enters. v. Apfel*, 524 U.S. 498, 521-22 (1998). A party can seek declaratory judgment only where monetary compensation would be a meaningless remedy, such as when a regulation does not burden the plaintiff's property but rather mandates a direct transfer of funds to a third party. *See id.* PFI has not alleged any facts to support an assertion that financial compensation would not be an adequate remedy.

Second, as Defendants have pointed out, PFI's Takings claim is superfluous. [Dkt. 106] at 27 & n.5. If the Court rules in favor of Defendants on the other counts, then no Taking will have occurred because PFI was not entitled to the registrations in the first place. *See Henry v. Jefferson Cnty Comm'n*, 637 F.3d 269, 277 (4th Cir. 2011). On the other hand, if the Court were to rule in favor of PFI on the other counts, then the marks would not be cancelled and so no Taking would occur. PFI does not address this logical flaw in Count 5.

Third, PFI concedes that a registration is not "property" (see [Dkt. 119] at 39 n.60), and instead asserts that its trademarks will be taken. But cancellation of the registrations does not constitute the "functional equivalent" of a total deprivation of its trademark rights necessary to establish a Taking. PFI asserts that cancelling the registration "significantly imped[es] its right to exclude" but provides no supporting facts, let alone any quantification of the supposed loss of value of its trademarks. [Dkt. 119] at 40. PFI can still bring actions for injunctions and damages for infringement of unregistered marks. *See Visa, U.S.A., Inc. v. Birmingham Trust Nat'l Bank*, 696 F.2d 1371, 1375 (Fed. Cir. 1982); 15 U.S.C. § 1125(a).

#### **IV. CANCELLATION OF THE REGISTRATIONS DOES NOT VIOLATE PFI'S DUE PROCESS RIGHTS**

PFI has conceded that a trademark registration is not "property," [Dkt. 119] at 39 n.60.

Yet, PFI alleges that it has been deprived of the marks themselves. [Dkt. 119] at 38. PFI has not been deprived of its marks, however; PFI can enforce its unregistered trademarks, license them and sell them. *See, e.g. Teaching Co.*, 87 F.Supp.2d at 575. Because there has been no deprivation of property, Defendants are entitled to summary judgment on Count 6, PFI's Due Process claim.

PFI asserts that the passage of time violated its due process rights, but exaggerates when it refers to the USPTO not taking action after 80 years. [Dkt. 119] at 42. PFI has been defending continuous challenges to its registrations since 1992, which was only two years after the most recent registration. But more significantly, PFI has not demonstrated any prejudice. It merely asserts that it "[relied] on the absence of a suit" and incurred substantial prejudice. [Dkt. 119] at 42. This does not suffice to prove a Due Process violation. *See United States v. Wilson*, 316 F.3d 506, 510 (4th Cir. 2003); *Jones v. Angelone*, 94 F.3d 900, 909 (4th Cir. 1996) ("Vague and conclusory allegations of prejudice resulting from the passage of time and the absence of witnesses are insufficient to constitute a showing of actual prejudice.") (internal quote omitted).

PFI has had a chance to be heard at a meaningful time. The hearing occurred before the registrations were cancelled, and the cancellations are suspended while it argues its case before this court. *Contrast Armstrong v. Manzo*, 380 U.S. 545, 551-52 (1965) (Due Process violated where party denied hearing until *after* adverse judgment was entered); *Goldberg v. Kelly*, 397 U.S. 254, 267-68 (1970) (Due Process violation where hearing too soon for party to prepare defense).

### **CONCLUSION**

For the foregoing reasons and for the reasons stated in the United States' briefs, Defendants' Motion should be granted, and Plaintiff's Motion should be denied.

Dated: April 14, 2015.

Respectfully submitted,

/s/ Jeffrey J. Lopez

Jesse A. Witten (*pro hac vice*)  
Jeffrey J. Lopez (VA Bar No. 51058)  
Adam Scott Kunz (VA Bar No. 84073)  
Tore T. DeBella (VA Bar No. 82037)  
Jennifer T. Criss (VA Bar No. 86143)  
DRINKER BIDDLE & REATH LLP  
1500 K Street, N.W., Suite 1100  
Washington, D.C. 20005-1209  
Telephone: (202) 842-8800  
Facsimile: (202) 842-8465  
Jesse.Witten@dbr.com  
Jeffrey.Lopez@dbr.com  
Adam.Kunz@dbr.com  
Tore.DeBella@dbr.com  
Jennifer.Criss@dbr.com

*Counsel for Defendants Amanda Blackhorse,  
Marcus Briggs-Cloud, Phillip Gover, Jillian  
Pappan and Courtney Tsotigh*

**CERTIFICATE OF SERVICE**

I hereby certify that on this 14th day of April, 2015, the foregoing pleading or paper was filed and served electronically by the Court's CM/ECF system upon all registered users in this action.

/s/ Jeffrey J. Lopez  
Jeffrey J. Lopez  
DRINKER BIDDLE & REATH LLP  
1500 K Street, N.W., Suite 1100  
Washington, D.C. 20005-1209  
Telephone: (202) 842-8800  
Facsimile: (202) 842-8465  
Email: Jeffrey.Lopez@dbr.com

*Counsel for Defendants Amanda Blackhorse,  
Marcus Briggs-Cloud, Phillip Gover, Jillian  
Pappan and Courtney Tsotigh*