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Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	79164635
LAW OFFICE ASSIGNED	LAW OFFICE 114
MARK SECTION	
MARK FILE NAME	http://tmng-al.uspto.gov/resting2/api/img/79164635/large
STANDARD CHARACTERS	NO
USPTO-GENERATED IMAGE	NO
ARGUMENT(S)	
Legal argument is attached.	
EVIDENCE SECTION	
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DESCRIPTION OF EVIDENCE FILE	legal argument and government's letter brief in In Re Brunetti
SIGNATURE SECTION	
RESPONSE SIGNATURE	/ft/
SIGNATORY'S NAME	Frank Terranella
SIGNATORY'S POSITION	Attorney for owner, NY Bar member
SIGNATORY'S PHONE NUMBER	2129499022
DATE SIGNED	05/12/2016
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	YES
FILING INFORMATION SECTION	
SUBMIT DATE	Thu May 12 10:20:15 EDT 2016

TEAS STAMP	USPTO/RFR-XXX.XX.XX.XX-20 160512102015903590-791646 35-55037d728844cbd9da653c 5165679bf8cd25bb49ea78949 d02d69a8ca44d1d659-N/A-N/ A-20160512101607649682

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Request for Reconsideration after Final Action

To the Commissioner for Trademarks:

Application serial no. **79164635** (Stylized and/or with Design, see http://tmng-al.uspto.gov/resting2/api/img/79164635/large) has been amended as follows:

ARGUMENT(S)
In response to the substantive refusal(s), please note the following:

Legal argument is attached.

EVIDENCE
Evidence in the nature of legal argument and government's letter brief in In Re Brunetti has been attached.
Original PDF file:
evi_216759226-20160512101607649682_._Ceno_request_for_reconsideration.pdf
Converted PDF file(s) (1 page)
Evidence-1
Original PDF file:
evi_216759226-20160512101607649682_._Brunetti.pdf
Converted PDF file(s) (6 pages)
Evidence-1
Evidence-2
Evidence-3
Evidence-4
Evidence-5
Evidence-6

SIGNATURE(S)
Request for Reconsideration Signature
Signature: /ft/ Date: 05/12/2016
Signatory's Name: Frank Terranella
Signatory's Position: Attorney for owner, NY Bar member

Signatory's Phone Number: 2129499022

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the owner's/holder's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the owner/holder in this matter: (1) the owner/holder has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the owner/holder has filed a power of attorney appointing him/her in this matter; or (4) the owner's/holder's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79164635
Internet Transmission Date: Thu May 12 10:20:15 EDT 2016
TEAS Stamp: USPTO/RFR-XXX.XX.XX.XX-20160512102015903
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Section 2(a) is Unconstitutional

On December 22, 2015, the United States Court of Appeals for the Federal Circuit ruled that "the disparagement proscription of § 2(a) is unconstitutional." While the court's holding does not extend specifically to the scandalousness proscription of § 2(a), the court noted in footnote 1 that "other portions of § 2 may likewise constitute government regulation of expression based on message, such as the exclusions of immoral or scandalous marks" and would likewise be unconstitutional. See *In Re Simon Shiao* Tam, 808 F.3d 1321, 117 USPQ2d 1001 (Fed. Cir. 2015)

And in fact the U.S. Department of Justice has acknowledged in its letter brief of January 21, 2016 (see attached) that "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. ... the reasoning of *Tam* requires the invalidation of Section 2(a)'s prohibition against registering scandalous and immoral marks as well." *In re Brunetti*, No. 2015-1109

In light of the ruling in *Tam* and the position of the U.S. Department of Justice, the USPTO issued Examination Guide 01-16 on March 10, 2016 where it announced that the USPTO will be suspending action on pending applications involving marks subject to a Section 2(a) refusal until all appeals of *Tam* are exhausted. The applicant requests suspension in accord with the reasoning of Examination Guide 01-16.

However, if the applicant's request for suspension is not granted, the applicant is prepared to proceed with its contention that Section 2(a) is unconstitutional based on the ruling in *In Re Simon Shiao* Tam, 808 F.3d 1321, 117 USPQ2d 1001 (Fed. Cir. 2015).

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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,

BENJAMIN C. MIZER
Principal Deputy Assistant Attorney General

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JANUARY 2016

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
JOSHUA M. SALZMAN