

No. \_\_\_\_\_

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**In the Supreme Court of the United States**

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PAMELA GELLER AND ROBERT B. SPENCER,  
*Petitioners,*

v.

UNITED STATES PATENT AND TRADEMARK OFFICE,  
*Respondent.*

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*On Petition for Writ of Certiorari to the United States  
Court of Appeals for the Federal Circuit*

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**PETITION FOR WRIT OF CERTIORARI**

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## **QUESTIONS PRESENTED**

Petitioners' application to trademark "STOP THE ISLAMISATION OF AMERICA" was denied as disparaging based on the United States Patent and Trademark Office's assessment of the viewpoint of Petitioners' political speech generally related to Islam and not how a substantial composite of the referenced group understood the meaning of the mark itself, thereby creating a chilling effect on core political speech.

1. May the United States Patent and Trademark Office refuse a trademark registration for a mark because the Office understands the mark to be disparaging in violation of § 2(a) of the Trademark Act based upon the Office's interpretation of the viewpoint of the trademark applicant's political speech related tangentially to the subject of the mark?

2. Did the court of appeals err by utilizing a standard of review for the "ultimate registrability" of Petitioners' mark that (a) conflicts with the standard utilized by the majority of circuits that have addressed this issue, and (b) is both illogical in theory and muddled in practice?

**PARTIES TO THE PROCEEDING**

The Petitioners are Pamela Geller and Robert B. Spencer.

The Respondent is the United States Patent and Trademark Office.

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**PETITION FOR WRIT OF CERTIORARI**  
**OPINIONS BELOW**

The opinion of the court of appeals appears at App. 1-14 and is reported at 751 F.3d 1355. The opinion of the Trademark Trial and Appeal Board appears at App. 15-55 and can be found at 2013 TTAB LEXIS 67 (Trademark Trial & App. Bd. Feb. 7, 2013).

**JURISDICTION**

The judgment of the court of appeals was entered on May 13, 2013. App. 1. This petition was filed on August 11, 2014. The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

**STATUTORY AND CONSTITUTIONAL  
PROVISIONS INVOLVED**

Section 2(a) of the Trademark Act provides that the United States Patent and Trademark Office may refuse an application when the trademark “[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 Free Speech Clause of the First Amendment provides, “Congress shall make no law . . . abridging the freedom of speech.” U.S. Const. amend. I.

**STATEMENT OF THE CASE**

Petitioners filed the STOP THE ISLAMISATION OF AMERICA (“Mark”) Mark Registration Application with the United States Patent and Trademark Office (“PTO”) on February 21, 2010. App. 15-16. The PTO

refused to register the Mark based upon its view that the meaning of the Mark “consists or includes matter which may disparage or bring into contempt persons, institutions, beliefs or national symbols” in violation of § 2(a) of the Trademark Act, 15 U.S.C. § 1052(a). App. 16.

The decision of the PTO was timely appealed to the Trademark Trial and Appeal Board (“Board”). The Board upheld the PTO’s refusal to register the Mark by interpreting the viewpoint of Petitioner’s political speech indirectly related to the Mark in such a way that “Islamisation” was understood to mean all things Islamic.<sup>1</sup> The essence of the logic of the Board is that Islamisation means all things Islamic and “Stop” in the context of services (*i.e.*, educating the public about terrorism) related to the Mark disparages Muslims because together they suggest Islam should be “stopped” due to its connection with terrorism. App. 18-20.

The Board also found that there was evidence that “Islamisation” carries a second meaning—the meaning advanced by Petitioners through the Mark.<sup>2</sup> Petitioners have argued consistently that Islamisation has only one meaning in public discourse and in the context of the use of the Mark. Specifically, the Mark does not mean all things Islamic but rather a very

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<sup>1</sup> The Board and the parties treated “Islamisation” with the letter “s” and “Islamization” with the letter “z” as alternative spellings of the same word. App. 2.

<sup>2</sup> The PTO and the Board considered the word “Islamize” to be the verb form of “Islamisation.” App. 18 (citing to the record located at App. 192).

dangerous politicization of Islam where Islamic law supplants secular constitutional law and civil liberties in political society and creates the ideological breeding ground for what is commonly referred to as “Islamic terrorism,” or what might be more accurately termed “terrorism carried out in the name of Islam.” App. 24-29 (citing to the record located in relevant part at App. 45-191). The Board concluded that even this meaning disparages advocates of political Islam, typically referred to as Islamists, because not all Islamists engage in or advocate terrorism. App. 38-43 (citing to the record located in relevant part at App. 45-191).<sup>3</sup>

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<sup>3</sup> Petitioners argued before the PTO and the Board that *the Mark itself* (aside from the free speech issue presented here by the government’s denial of a trademark based upon an applicant’s political views tangentially related to the Mark) is protected speech under the First Amendment, either as commercial speech or as political speech, the latter of which “rest[s] on the highest rung of the hierarchy of First Amendment values.” *See NAACP v. Claiborne Hardware Co.*, 458 U.S. 886, 913 (1982); *see also id.* (“[Speech] concerning public affairs is more than self-expression; *it is the essence of self-government*”) (citations omitted) (emphasis added). App. 44. By restricting Petitioners’ speech via the Mark predicated upon some perceived, yet undocumented harm to some ambiguous group’s reputation based upon the content and viewpoint of the speech, the PTO is engaging in an unlawful and unconstitutional infringement of Petitioners’ free speech rights. *See, e.g., Lamb’s Chapel v. Ctr. Moriches Union Free Sch. Dist.*, 508 U.S. 384, 394 (1993) (“The principle that has emerged from [Supreme Court] cases is that the First Amendment forbids the government to regulate speech in ways that favor some viewpoints or ideas at the expense of others.”).

Petitioners, however, recognize that the Federal Circuit has, on several occasions, rejected the notion that an applicant for a trademark registration has a First Amendment claim when the USPTO rejects a mark based on its viewpoint. *See, e.g., In re Blud.*

Petitioners timely appealed the Board's decision to the United States Court of Appeals for the Federal Circuit. App. 4. The court of appeals upheld the substance and logic of the Board's opinion. In so doing, the court applied the "substantial evidence" standard, rather than a *de novo* review, to test whether the Board's interpretation of the viewpoint of Petitioners' political speech published at their website, together with anonymous comments posted on Petitioners' blog, supplied a meaning of Islamisation that disparaged the referenced group. App. 5 (framing the "Discussion" section as an analysis of "substantial evidence"); App. 8-9 (applying the "substantial evidence" standard to assess Petitioners' viewpoint in "Mosque Manifesto" essay" located at App. 192-99); App. 12-13 (applying the "substantial evidence" standard to determine that the political meaning of Islamisation is disparaging). Neither the Board nor the court of appeals cited to any actual evidence that a substantial composite of the referenced group would be disparaged by the Mark itself or even by the use of the Mark in the marketplace.

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*Entm't*, 334 F.3d 1336, 67 U.S.P.Q.2D 1475 (Fed. Cir. 2003). As a result, Petitioners did not raise the issue before the court of appeals. However, given the commercial and legal importance of statutory trademark protection in the modern context, Petitioners believe the Federal Circuit is wrong.

## REASONS FOR GRANTING THE PETITION

The Court should grant this Petition for two reasons. One, in this case of first impression<sup>4</sup>, the Federal Circuit sought to discern whether the Mark would be understood as disparaging not by evidence of how a substantial composite of the referenced group understood the mark but by distilling and parsing the viewpoint of Petitioner's political speech regarding matters only tangentially related to the Mark *itself*. Given the national importance of the Federal Circuit's approach to trademark law and to trademarks simply, if this use of the trademark applicant's political speech retains the force of law, the Federal Circuit will have effectively placed its imprimatur on the PTO's leveraging of the applicants' commercial interest in trademark protection to chill the applicant's speech on sensitive political, social, and religious subjects that only tangentially implicate the mark's meaning.

Two, the Federal Circuit's standard of review on the question of the ultimate registrability of a mark is both confused in practice and at odds with the majority of courts of appeals that have ruled on the matter. This circuit split and the Federal Circuit's muddled approach to the standard of review has existed for more than three decades, and it allows the PTO and the Board to disallow trademark applications without actually articulating whether the ruling is based on a factual determination (*i.e.*, subject to the substantial

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<sup>4</sup> As noted below, this case was the Federal Circuit's first opportunity to address the provision prohibiting marks that may disparage persons, institutions, beliefs, or national symbols under § 2(a) of the Trademark Act.

evidence standard on appeal) or on a legal conclusion (*i.e.*, subject to the appellate court's *de novo* review). The results on appeal tend to carry over from the Board's ambiguity with very little coherent distinction between factual and legal determinations, resulting in a somewhat meaningless standard of review.

In sum, both the Federal Circuit's application of trademark law itself and the standard of review it applied have produced a result whereby Petitioners' trademark application was denied as disparaging not based upon *evidence* from a substantial composite of the referenced group but based upon the *viewpoint* of Petitioners' political speech. Thus, the Federal Circuit has entered a decision in conflict with decisions of other United States courts of appeals and has decided an important question of federal law that has not been, but should be, settled by this Court. *See* Sup. Ct. R. 10(a) &(c).

**I. The Federal Circuit's Use of the Viewpoint of an Applicant's Political Speech to Define the Mark Violates this Court's First Amendment Precedent and Will Chill Political Speech of Trademark Applicants Touching upon Sensitive Religious, Political, and Social Issues.**

The Federal Circuit recognized that the instant case was one of first impression. App. 5-6. The case marked the Federal Circuit's first foray into the thicket of § 2(a) of the Trademark Act's provision prohibiting registration if the mark "may disparage a person, institution, belief, or national symbol." 15 U.S.C. § 1052(a). Section 2 requires the PTO to register all distinguishing marks unless the mark fits into one or

more of the prohibited categories set out in the subsections of § 2. Consequently, the Federal Circuit understands that the PTO has a *prima facie* burden to meet if it rejects a mark in an *ex parte* proceeding. *See, e.g., In re Mavety Media Grp.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (reiterating the PTO’s initial burden under § 2(a)); *In re Blvd. Entm’t*, 334 F.3d 1336, 1340 (Fed. Cir. 2003) (explaining the PTO’s initial burden to show vulgarity under § 2(a)); *In re Pacer Tech.*, 338 F.3d 1348, 1350 (Fed. Cir. 2003) (rebutting a *prima facie* showing in a lack of distinctiveness case returns the burden to PTO); *In re Becton, Dickinson & Co.*, 675 F.3d 1368, 1374 (Fed. Cir. 2012) (rebutting § 2(e)(5) *prima facie* showing with “competent evidence,” which is a preponderance of evidence); *In re Gyulay*, 820 F.2d 1216, 1217 (Fed. Cir. 1987) (failing to provide any rebuttal evidence to counter § 2(e)(1) *prima facie* showing). Thus, in context, § 2(a) reads as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after



one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [19 U.S.C. § 3501(9)]) enters into force with respect to the United States.

15 U.S.C. § 1052(a). Because this case marks the Federal Circuit's first decision on how to analyze a refusal to register based on disparagement, and because the court expressly applied a viewpoint-centric analysis to determine if the Mark had a disparaging meaning, this case stands to establish dangerous precedent for all future trademark applications and challenges touching upon politically, socially, and religiously sensitive issues.

To set the stage for its ultimate conclusion, the court adopted a two-step analysis set out by the Board in this case and in prior cases and followed by at least one district court. App. 5-6. That two-step analysis first seeks to determine the meaning of the mark and then to rule on whether that meaning disparages a "substantial composite of the referenced group." The court articulates this analysis as follows:

- (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.

App. 6 (citing *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1210, 1217 (T.T.A.B. 2010); *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1740–41 (T.T.A.B. 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 124 (D.D.C. 2003)).

The Federal Circuit also recognizes that if a mark has two possible meanings at the first level of the analysis, both meanings proceed to the second level of the analysis where the Board or the reviewing court asks how a substantial composite of the referenced group perceives the mark. App. 10-11, 29; *see also In re Mavety Media Grp.*, 33 F.3d at 1371 (“In the absence of evidence as to which of these definitions the substantial composite would choose, the PTO failed to meet its burden of proving that Mavety’s mark is within the scope of § 1052(a) prohibition.”).

In the case at bar, while the Board and the court of appeals found that the term “Islamisation” has two meanings (one as all things Islamic and the other as political Islam’s process to create a sectarian political order based upon Islamic law), both found that the “more reflective meaning” of the Mark was directed at all things Islamic. App. 6-11. As such, the second prong of the two-part disparagement analysis was rather facile: a mark calling for the “stop[ping]” of all things Islamic and tying all things Islamic to terrorism would, the Board presumed, disparage a substantial composite of Muslims. App. 11-12. The Board and the court also allowed the second meaning urged by Petitioners—the political meaning—to proceed to the

second part of the two-part analysis and similarly found the Mark disparaging by concluding that not all Islamists are terrorists or advocates of terrorism and thus the Mark would disparage these non-violent Islamists who advocate for a peaceful subversion of our constitutional republic. App. 12-13. We will treat this aspect of the Federal Circuit’s ruling in Part II below, which discusses more fully the second reason the Court should grant this petition.

In the context of discerning which of the two dictionary definitions—one pointing to the religious meaning and one to the political—was “more reflective of the public’s understanding of the meaning” of the Mark, the Board and the court of appeals turned to articles and anonymous blog comments published at Petitioners’ website and determined that Petitioners intended the Mark to apply to all things Islamic and thus to all Muslims. App. 7-10 (citing to the articles, essays, and blog comments at App. 193-212).

To begin with, there is no question that these articles and even the anonymous blog comments are political speech entitled to special protection under the First Amendment. *See Connick v. Myers*, 461 U.S. 138, 145 (1983) (“[T]he Court has frequently reaffirmed that speech on public issues occupies the ‘highest rung of the hierarchy of First Amendment values,’ and is entitled to special protection.”) (quoting *NAACP v. Claiborne Hardware Co.*, 458 U.S. 886, 913 (1982)); *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 269 (1964) (“The general proposition that freedom of expression upon public questions is secured by the First Amendment has long been settled by our decisions.”).

Moreover, the Board's and the court's parsing of Petitioners' political speech went to the core of its protected status: what viewpoint were Petitioners imparting to the public about Islam? Was the viewpoint one opposing all Muslims all the time, or was the viewpoint more focused on opposing an ideologically driven political system which seeks to subvert our constitutional republic built upon individual liberty and equality before the law?

In other words, rather than rely upon how the public might have understood *the Mark itself*—such as through survey evidence and other objective measures or actually determining how the term Islamisation is used in public discourse by the general public—the court of appeals has put its imprimatur on a definitional examination that allows a governmental agency to examine and parse the viewpoint of the applicant's political speech generally related to the subject of the mark (or only arguably related to the mark's subject) to determine if the mark itself has a disparaging meaning. Thus, by denying the speaker trademark protection for a mark based on the viewpoint of her political speech that is only tangentially (if at all) related to the mark is ultimately punishing that speech. *R.A.V. v. St. Paul*, 505 U.S. 377, 386-92 (1992) (holding that the government may not “impose special prohibitions on those speakers who express views on disfavored subjects” or on the basis of “hostility—or favoritism—towards the underlying message expressed”); *Lamb's Chapel*, 508 U.S. 384, 394 (1993) (“[T]he First Amendment forbids the government to regulate speech in ways that favor some viewpoints or ideas at the expense of others.”). The chilling effect of this viewpoint-centered analysis of a

trademark applicant's political speech is obvious. *See generally Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 835-36 (1995) (recognizing the “danger . . . to speech from the chilling of individual thought and expression”).

Trademark registration is important to anyone seeking to protect commercially valuable goods or services. Thus, to deny this valuable benefit based on the government's determination of the viewpoint of an applicant's political speech, as the Federal Circuit has done here, is to allow government censors to punish that speech. And wielding this power is particularly dangerous to First Amendment freedoms when done so in the context of a determination of disparagement—an inherently vague notion that does not fit within any of the historical exceptions to the First Amendment's protection of free speech. *See, e.g., United States v. Stevens*, 559 U.S. 460, 468-69 (2010) (“From 1791 to the present, however, the First Amendment has permitted restrictions upon the content of speech in a few limited areas, and has never include[d] a freedom to disregard these traditional limitations. These historic and traditional categories long familiar to the bar—including obscenity, defamation, fraud, incitement, and speech integral to criminal conduct—are well-defined and narrowly limited classes of speech, the prevention and punishment of which have never been thought to raise any Constitutional problem.”) (quoting *Chaplinsky v. New Hampshire*, 315 U.S. 568, 571-72 (1942)) (citations and quotation marks omitted).

A poignant example of the court's viewpoint-centric analysis of Petitioner's political speech to arrive at the

conclusion that the Mark should be understood to mean that all things Islamic should be stopped, and without regard to how the public actually understands the term Islamisation simply or in context of the Mark itself, is the following excerpt from the court's opinion:

The first essay [the Board] discuss[es] is titled “[Stop the Islamisation of America] Mosque Manifesto: All Mosques are Not Created Equal, A Handy Guide to Fighting the Muslim Brotherhood.” [citing to App. 193]. Appellants characterize this essay as merely opposing “Islamist Muslim Brotherhood groups” that “use mosque-building as a political tool to accomplish Islamisation.” Appellants’ Br. at 14. This is an overly narrow interpretation of the “Mosque Manifesto” essay, which provides tips for opposing “huge monster mosque[s]” proposed in people’s communities. [citing to App. 194]. Although portions of the essay refer to political forces such as the Muslim Brotherhood, the article as a whole implicates Islam more generally. *See, e.g.*, [citing to App. 196-97] (quoting a source that “80% of American mosques were controlled by ‘extremists’”); [citing to App. 193] (“As we have been reminded time after time after grisly Islamic terror plots have been exposed, there is always a mosque, and the imprimatur of a cleric, behind every operation.”). Taken generally, as Appellants do, mosques in this country are respectable and respected community religious institutions. Substantial evidence supports the Board’s finding that the “Mosque Manifesto” essay advocates suppression

of the Islamic faith, taught and practiced in those places of prayer.

App. 8-9. Whatever one might say of the Board's and the Federal Circuit's rendering of Petitioners' viewpoint expressed in this article—a rendering subject to at least serious challenge—the use of an interpretation of a trademark applicant's political viewpoint to determine how the public understands the Mark is dubious at best and at worst a tool to punish and chill Petitioners' political speech.

This case provides the Court with a singularly unique opportunity to inform the Federal Circuit and the Board that the First Amendment does not abandon trademark applicants at the door of the PTO. For this reason alone, we would ask the Court to grant this petition.

## **II. The Federal Circuit's Standard of Review, which Is at Odds with a Majority of the Circuits that Have Addressed the Issue, Is Ambiguous in Theory and Incoherently Applied in Practice, Rendering It Meaningless.**

The Federal Circuit has set out its formal articulation of the standard of review of a Board decision on several occasions and repeated that articulation in the instant case almost verbatim:

The determination that a mark may be disparaging “is a conclusion of law based upon underlying factual inquiries.” *Cf. In re Mavety*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (applying that standard with respect to whether a mark is “scandalous” under § 2(a)). The Board's factual

findings are reviewed for substantial evidence, “while its ultimate conclusion as to registrability is reviewed *de novo*.” *In re Fox*, 702 F.3d 633, 637 (Fed. Cir. 2012).

App. 6.

We note at the outset that the Federal Court’s precedent makes clear that a determination of disparagement as a legal question (reviewed *de novo*) based upon underlying factual inquiries (tested by the substantial evidence standard) flows from the fact that the Federal Circuit had earlier concluded that the “likelihood of confusion” determination under § 2(d) is a conclusion of law and that § 2(a)’s scandalous determination should similarly be considered a question of law. *In re Mavety Media Grp.*, 33 F.3d at 1371 (concluding that “[t]he determination that a mark comprises scandalous matter is a conclusion of law based upon underlying factual inquiries” and citing to *Frederick Gash, Inc. v. Mayo Clinic*, 461 F.2d 1395, 1397 (C.C.P.A. 1972) for the proposition that “[t]he inquiry under [15 U.S.C. § 1052(a)] is similar to that under . . . 15 U.S.C. § 1052(d), which is likelihood of confusion of the marks as applied to the respective goods and/or services” and also to *Weiss Assocs., Inc. v. HRL Assocs. Inc.*, 902 F.2d 1546, 1547-48 (Fed. Cir. 1990) for the proposition that “[t]he likelihood of confusion is a question of law to be decided by the court”).

We also note that the Federal Circuit’s rule that the determination of disparagement is a question of law is not a separate rule from, but only buttressed by, the separately stated rule that the question of ultimate registrability is a question of law reviewed *de novo*.



This is self-evidently so because under § 2(a) the determination of scandalousness and disparagement, like the determination of likelihood of confusion under § 2(d), are by the operation and structure of the statute “ultimate” questions of whether the mark may be registered.

Finally, we note that the Federal Circuit’s view that these ultimate questions of registrability are issues of law to be reviewed *de novo* is at odds with a majority of the courts of appeals that have addressed this issue, and that this split among the circuits, with the most important of these circuits, the Federal Circuit, occupying a decidedly minority view, has existed for more than three decades. *See Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d at 116-17 (providing a thoroughgoing discussion of the circuit split). Most of the circuit courts conclude that a likelihood-of-confusion analysis (whether under § 2(d) or in an infringement case) is one of fact. *See Aktiebolaget Electrolux v. Armatron Int’l, Inc.*, 999 F.2d 1, 4 (1st Cir. 1993); *Am. Home Prods. Corp. v. Barr Labs., Inc.*, 834 F.2d 368, 370 (3d Cir. 1987) (providing rationale for rule that likelihood of confusion is a question of fact); *Pizzeria Uno Corp. v. Temple*, 747 F.2d 1522, 1526-27 (4th Cir. 1984); *Marathon Mfg. Co. v. Enerlite Prods. Corp.*, 767 F.2d 214, 217 (5th Cir. 1985); *Scandia Down Corp. v. Euroquilt, Inc.*, 772 F.2d 1423, 1428 (7th Cir. 1985) (“the question of likelihood of confusion is all fact and no law”); *Mut. of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398 (8th Cir. 1987); *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1355 (9th Cir. 1985) (“The issue of likelihood of confusion is a mixed question which appears to be predominantly factual in nature.”). The Federal Circuit is joined by the Second and Sixth

Circuits in concluding that registrability is ultimately a question of law with underlying questions of fact. *Hasbro, Inc. v. Lanard Toys, Ltd.*, 858 F.2d 70, 75-76 (2d Cir. 1988) (“In reviewing the magistrate’s determinations . . . , each specific finding is subject to a clearly erroneous standard, but the ultimate determination of the likelihood of confusion is a legal issue subject to *de novo* appellate review.”); *Jet, Inc. v. Sewage Aeration Sys.*, 165 F.3d 419, 422 (6th Cir. 1999) (“Likelihood of confusion is a mixed question of fact and law. After a bench trial, we review a trial court’s underlying factual findings for clear error but review *de novo* whether these facts indicate a likelihood of confusion.”) (citation omitted).

The problem with the Federal Circuit’s articulation of the standard of review is that it is ambiguous, logically at odds with the nature of the determination under review, and incoherently applied in practice. Thus, while we are told that the determination of disparagement is ultimately a legal question to be reviewed *de novo*, we are also told that this legal conclusion is predicated upon underlying factual determinations. App. 6. However, nowhere in the Federal Circuit’s jurisprudence, or elsewhere, are we told what these underlying factual inquiries are or how they are distinguished from the ultimate question of disparagement (or for that matter any question of ultimate registrability). *See Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d at 119-36 (providing a careful analysis of what the Board claimed were its factual determinations that the Washington Redskins logo was disparaging of a substantial composite of Native Americans, and finding instead that the Board’s

findings were not fact-based but predicated upon innuendo and assumption).

Indeed, if one were to consider the two-part analysis for disparagement set out and purportedly followed by the court of appeals in this case (and discussed above in Part I), one would be forced to conclude that the Federal Circuit's articulation of the standard of review is wrong simply and that the majority of the circuits are correct.

As a reminder, the two-part analysis applied in these cases requires the court to first determine the meaning of the mark and specifically whether the mark refers to "identifiable persons, institutions, beliefs or national symbols." App. 5. The second part of the Federal Circuit's two-part analysis requires the court to determine as a matter of law if the mark is disparaging to a "substantial composite of the referenced group." App. 5-6.

Notwithstanding the Federal Circuit's rule that "ultimate registrability" is a *de novo* legal review, it is rather obvious that the determination of disparagement and of registrability is a fact-based inquiry: how does any substantial composite of the referenced group understand the mark? By the very nature of the inquiry, the court must have evidence before it of the views of some substantial composite of the referenced group. This is an evidentiary inquiry not a legal one.

Moreover, we know from precedent that a substantial composite is not necessarily a majority, but neither is it co-equal with the views of a given panel of

the Federal Circuit, the Federal Circuit *en banc*, or even the Board. As the Federal Circuit itself explains:

The PTO has the burden of proving that a trademark falls within a prohibition of § 1052. In order to prove that Mavety's mark BLACK TAIL is scandalous, the PTO must demonstrate that the mark is "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation." The PTO must consider the mark in the context of the marketplace as applied to only the goods described in Mavety's application for registration. Furthermore, whether the mark BLACK TAIL, including innuendo, comprises scandalous matter is to be ascertained (1) from "the standpoint of not necessarily a majority, but a substantial composite of the general public," and (2) "in the context of contemporary attitudes."

Therefore, even if the members of this panel personally find the mark BLACK TAIL disgustingly scandalous, the legal conclusion that a trademark comprises scandalous matter must derive from the perspective of the substantial composite. To be sure, appellate judges are a part of the composite of the general public, but they represent only a tiny fraction of the whole, which necessarily encompasses a wondrous diversity of thought. Although constantly at odds, progressive views and conservative or traditional thinking participate alike in the formation of the composite of the

general public. While we recognize the inherent difficulty in fashioning a single objective measure like a substantial composite of the general public from the myriad of subjective viewpoints, we are duty bound to apply the standard set forth by our predecessor court.

In addition, we must be mindful of ever-changing social attitudes and sensitivities. Today's scandal can be tomorrow's vogue. Proof abounds in nearly every quarter, with the news and entertainment media today vividly portraying degrees of violence and sexual activity that, while popular today, would have left the average audience of a generation ago aghast. To appreciate the extreme changes in social mores over time, one need only glance at a historical survey of Board decisions regarding refusals to register marks containing particular words deemed scandalous.

*In re Mavety Media Grp.*, 33 F.3d at 1371.

Thus, the requirement to determine disparagement by examining a "substantial composite of the referenced group" suggests by its own terms that the inquiry is a factual or empirical one. This, of course, fits the view of a majority of the circuits but contradicts the minority holding of the Federal Circuit that the determination is ultimately a legal inquiry. Logically, and given today's fleeting trends and social attitudes buffeted here and there with the help of social media tsunamis, one might argue that a far better standard of review would neither claim disparagement to be determined ultimately as a matter of law or purely fact-based. *Id.* ("[W]e must be mindful of ever-

changing social attitudes and sensitivities. Today’s scandal can be tomorrow’s vogue.”). Indeed, given social media’s impact on the acceleration of the rate of change in social attitudes, if the inquiry were simply factual as some circuits hold, trademark registrability would be an ever-shifting and entirely transient statutory right subject to the day’s survey of any given “substantial composite of the referenced group.” *See, generally*, Philip N. Howard & Muzammil M. Hussain, *Democracy’s Fourth Wave?: Digital Media and the Arab Spring* (Oxford Univ. Press 2013).

The more prudent and logical approach would be to blend the circuit split into a two-step analysis. Specifically, once the meaning was determined by objective factual evidence (evidence that is unrelated to the political writings and viewpoint of the applicant) during the first part of the two-part analysis, the court would proceed to the second part of the analysis to ask the question if the mark, given the range of possible meanings, is disparaging to a substantial composite of the referenced group. But unlike the current approach taken by the circuits—that is, treating the inquiry as either factual (the majority view) or ultimately legal (the Federal Circuit’s view), the better approach is to treat the inquiry in two stages. The first stage of the inquiry of this disparagement analysis would ask whether the mark is objectively disparaging—or, put another way, does the mark have the objective potential of being understood as disparaging. This would be a legal question for the court to review *de novo*. *See, e.g., Harlow v. Fitzgerald*, 457 U.S. 800, 815-19 (1982) (explaining in the context of qualified immunity for governmental actors that the objective test is undertaken as a matter of law versus the

subjective test requiring an intensive factual inquiry); *Anderson v. Creighton*, 483 U.S. 635, 641 (1987) (following *Harlow*).

Only after determining that a mark was objectively disparaging (*i.e.*, that it had the objective potential of carrying a disparaging meaning), would the court reach the second step of the second part of the two-part analysis: does a “substantial composite of the referenced group” consider the mark to be disparaging in fact. This latter inquiry is a subjective inquiry of the referenced group which makes it an empirical or factual examination and thus one based upon evidence and uniquely within the province of the fact finder and thus subject to the more deferential substantial evidence standard used for appellate review of an agency’s factual findings. *See generally Dickinson v. Zurko*, 527 U.S. 150, (1999) (providing a thorough discussion of the distinction between the substantial evidence standard and the clearly erroneous standard and rationale for that difference).

This blending of the circuit split solves two problems. First, it prevents irrational or obviously transient views of disparagement, even if held by a substantial composite of the referenced group, from preventing registration. Second, it forces the Federal Circuit to recognize that the determination of the views of a substantial composite of a specifically referenced group is not a legal analysis but a factual one better left to the fact finder. At the same time, as we saw in *Pro-Football, Inc. v. Harjo*, this clear-headed distinction between a legal, objective inquiry versus a factual, subjective examination would encourage the Federal Circuit and the Board to pay special attention

to actual empirical facts and not innuendo and assumption.

In contrast to our proposed solution, the instant case is a study in the confused and rather incoherent application of the Federal Circuit's purported *de novo* review of the legal conclusion of whether the mark is disparaging and ultimately registrable. At each stage of its analysis to determine whether the Mark was disparaging, the panel simply asked whether the Board had "substantial evidence" (the far more deferential standard applicable to a weighing of the factual evidence by the Board) rather than conducting a legal and *de novo* review, as required by the Federal Circuit's rule that disparagement is a legal analysis demanding *de novo* review.

Thus, when the panel concluded that the Board correctly determined that Petitioners' political meaning of Islamisation would disparage peaceful Islamists, the court applied the more deferential substantial evidence standard when it should have applied the stricter *de novo* review: "Substantial evidence supports the Board's finding that Appellants' mark is also disparaging in the context of the political meaning of Islamisation." App. 12. What renders this confusion by the panel incoherent is that nowhere did the Board actually provide any evidence that a substantial composite of all Muslims or a substantial composite of peaceful Islamists would be disparaged by any meaning of Islamisation. More particularly, the Board's conclusions about disparagement were based upon how it felt Muslims might react to the religious and political meanings of the word Islamisation and quite explicitly not based upon any actual empirical or fact-based



evidence. The court of appeals in turn purportedly was applying a legal analysis using *de novo* review but instead applied the substantial evidence standard to a Board decision that relied on no evidence, but rather legal conclusions about how the Board thought Muslims might react. *See In re Mavety Media Grp.*, 33 F.3d at 1371 (stating that “even if the members of this panel personally find the mark . . . disgustingly scandalous, the legal conclusion that a trademark comprises scandalous matter must derive from the perspective of the substantial composite” and noting that “appellate judges . . . represent only a tiny fraction of the whole”).

Even more to the point, had the Federal Circuit applied the approach suggested here to the question of whether the Mark’s political meaning could, as a matter of law, disparage non-violent advocates of Islamisation, the court would have had to determine objectively whether it is possible to “disparage” a political actor who seeks, even if non-violently, to render our constitutional republic into a sectarian Islamic state. *See Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d at 124 (accepting the Board’s definition of disparagement as something that may “dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison”). The court of appeals undertook no such objective review even though it asserted that its determination of disparagement was ultimately a matter of law and reviewed *de novo*. Petitioners suggest that a court would be hard-pressed to conclude that a mark that opposed a political movement that sought to subvert the Constitution could disparage the subverters.

Further, the court would have had to review *de novo* and rule as a matter of law on the question of whether the Mark disparages those who advocate a non-violent form of Islamisation simply because the Mark includes educational services pointing to the truth recognized in the record and by the court that violent jihad arises out of the ideological breeding ground of the Islamisation movement. App. 23 (referencing the Board’s ruling, which in turn references congressional testimony at App. 25-28; 39-41). Instead, the court of appeals simply glossed over this analysis to conclude as a *factual* matter that any reference to terrorism by the services associated with the Mark would disparage non-violent advocates of Islamisation.<sup>5</sup>

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<sup>5</sup> As pointed out by Petitioners in their briefing below, the federal courts also seem to be clear about the meaning of Islamization and the Islamists’ violent agenda. See, e.g., *Makir-Marwil v. United States AG*, 681 F.3d 1227, 1230 (11th Cir. 2012) (“The [State Department’s 2007] Country Report [on Sudan] notes that the ruling party ‘originally came to power with a goal of Islamization, treated Islam as the state religion,’ and ‘restricted Christian activities.’”); *Presbyterian Church of Sudan v. Talisman Energy, Inc.*, 453 F. Supp. 2d 633, 677 (S.D.N.Y. 2006) (“Moreover, the plaintiffs acknowledge that not all Government attacks were even connected to the oil industry. According to the plaintiffs’ experts, the Government’s aggression in the south was also part of a long-term plan of “islamization” and “jihad.”); *Boumediene v. Bush*, 553 U.S. 723, 827 (2008) (“America is at war with radical Islamists.”) (Scalia, J., dissenting). Federal courts have also expressly recognized that Muslims oppose the Islamist agenda of Islamization to overthrow secular rule only to replace it with an Islamist state. See, e.g., *Bouchikhi v. Holder*, 676 F.3d 173, 175 (5th Cir. 2012) (“Bouchikhi is a native and citizen of Algeria. He is a Muslim imam. He believes in democratic government, and he disapproves of the present Algerian regime because of its failure to permit democracy. As a moderate Muslim, Bouchikhi opposes

It is time for this Court to resolve the circuit split over the appellate review of ultimate registrability—including the determination of whether the mark is disparaging, scandalous, or likely to cause confusion. In each of these cases, the inquiry should require an initial legal determination *de novo* whether the mark even has the objective potential to be violative of § 2(a) or (d). Then, and only after the objective threshold is satisfied, would the court turn to the empirical evidence relied upon by the Board utilizing the more deferential substantial evidence standard to determine if a substantial composite of the referenced group

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the mistreatment of non-Muslims and the use of violence to establish an Islamist state.”). Moreover, the federal courts’ recognition of the violence of the Islamist agenda is not new. *See In re Ross*, 140 U.S. 453, 463 (1891) (“After the rise of Islamism, and the spread of its followers over eastern Asia and other countries bordering on the Mediterranean, the exercise of this judicial authority became a matter of great concern. The intense hostility of the people of Moslem faith to all other sects, and particularly to Christians, affected all their intercourse, and all proceedings had in their tribunals. Even the rules of evidence adopted by them placed those of different faith on unequal grounds in any controversy with them. For this cause, and by reason of the barbarous and cruel punishments inflicted in those countries, and the frequent use of torture to enforce confession from parties accused, it was a matter of deep interest to Christian governments to withdraw the trial of their subjects, when charged with the commission of a public offence, from the arbitrary and despotic action of the local officials.”). Among the literally hundreds of federal court cases referencing “Islamization” or “Islamism” or “Islamist,” none of those cases stand for the proposition that the meaning of any of those words used by Muslims or non-Muslims carries a meaning different from that argued by Petitioners herein or that such use is disparaging to any substantial composite of any referenced group.

subjectively understood the mark to be scandalous, disparaging, or likely to confuse. This rather straightforward blend of the three-decades old circuit split would at once resolve the split by splitting the difference and rendering the entire process far more coherent and thus predictable.

### CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted,

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