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BY EMAIL (mrazavi@inta.org)

Mayza Razavi, Esq.
International Trademark Association
655 Third Avenue
New York, NY 10017

Re: Amicus Request - In re Simon Shiao Tam

Dear Ms. Razavi:

We represent Simon Tam, appellant in the Federal Circuit Court of Appeals docket number 2014-1203. It is an appeal from a decision of the Trademark Trial and Appeal Board, Serial Number 85/472,044 affirming the refusal of the Patent and Trademark Office to allow the registration of the trademark THE SLANTS for "entertainment in the nature of live performances by a musical band" in International Class 41 (the "Mark"). The Mark was refused registration under § 15 U.S.C. 1052(a), also known as "Section 2(a)" of the Lanham Act.

The case was argued before a panel of the Circuit court on January 9, 2015, which affirmed the decision of the TTAB by order dated April 20, 2015. Shortly thereafter, however, a "sua sponte request for a poll whether to consider this case en banc in the first instance" was made by the court and, by order dated April 27, 2015, the April 20th affirmance was vacated, the appeal reinstated, and an en banc hearing was set on the basis of new briefing and oral argument as to the single issue of the constitutionality of Section 2(a). Appellant's en banc brief is due 45 days from the date of the April 27th order. The court specifically provided that briefs of amici curiae "will be entertained . . . without consent and leave of court" provided they comply with all applicable rules.

INTA's involvement as an amicus is appropriate because of its stature as the definitive voice of the trademark bar and, in particular, of the right of the holders of trademark rights to maximize their ability under the law to secure those rights, including through registration as provided under the Lanham Act. The Supreme Court's recent decision in B&B Hardware, in fact, made a specific point of rejecting the suggestion – which is the premise of *In re McGinley*, 660 F.2d 481 (CCPA 1981) – that trademark registration is a merely ministerial governmental act:

> Hargis also contends that the stakes for registration are so much lower than for infringement that issue preclusion should never apply to TTAB decisions. Issue preclusion may be inapt if "the amount in controversy in the first action [was] so small in relation to the amount in controversy in the second that preclusion would be plainly unfair." Restatement (Second) of Judgments §28, Comment j, at 283–284. After all, "[f]ew . . . litigants would spend $50,000 to defend a $5,000 claim." Wright & Miller §4423, at 612. Hargis is wrong, however, that this exception to issue preclusion applies to every registration. To the contrary: When registration is opposed, there is good reason to think that both sides will take the matter seriously.
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> The benefits of registration are substantial. Registration is "prima facie evidence of the validity of the registered mark," 15 U. S. C. §1057(b), and is a precondition for a mark to become "incontestable," §1065. Incontestability is a powerful protection. See, e.g., *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc*., 469 U. S. 189, 194 (1985) (holding that an incontestable mark cannot be challenged as merely descriptive); see also id., at 193 (explaining that "Congress determined that . . . 'trademarks should receive nationally the greatest protection that can be given them'" and that "[a]mong the new protections created by the Lanham Act were the statutory provisions that allow a federally registered mark to become incontestable" (quoting S. Rep. No. 1333, 79th Cong., 2d Sess., 6 (1946))).
>
> The importance of registration is undoubtedly why Congress provided for de novo review of TTAB decisions in district court. It is incredible to think that a district court's adjudication of particular usages would not have preclusive effect in another district court. Why would unchallenged TTAB decisions be different? Congress' creation of this elaborate registration scheme, with so many important rights attached and backed up by plenary review, confirms that registration decisions can be weighty enough to ground issue preclusion.

This matter is the ideal opportunity for INTA to urge the Federal Circuit to be guided by these words, to overturn *In re McGinley* and to invalidate Section 2(a) with regard to disparaging marks on First Amendment grounds.

The effect of such a ruling for the trademark practice, and for trademark owners, can only be salutary. INTA's leadership is aware of the lack of predictability and consistency with respect to how the PTO applies the "disparagement" prohibition of Section 2(a). The TTAB's ruling in *Blackhorse* magnified those concerns, severely handicapping the ability of counsel and trademark owners to rely on the legal status of their intellectual property assets even after the passage of decades.

There will be understandable concern, perhaps, for the views of constituent groups who represent, or, we say respectfully, purport to represent affected groups. Yet it may be increasingly impossible to satisfy every possible offended constituency while advocating for the

rights of those whose rights are affected, including INTA's members and other trademark owners and prospective registrants. Indeed, one of the troubling aspects of the Office Action refusing registration to Simon Shao Tam for THE SLANTS was its repeated reference to **his** personal status as an Asian American and the relationship between his ethnic identity and his application to register the Mark. It would only benefit trademark owners, applicants and the trademark regime in general for the PTO to remove itself entirely from this entire field of inquiry, and no organization is better suited to make this argument, we believe, than INTA.

Please let us know if we can be of further consistent with respect to this matter. We have included as enclosures copies of all the relevant papers, as required under INTA's application guidelines.

Very truly yours,

RONALD D. COLEMAN

Enclosure

cc: Christina J. Hieber, Esq. (USPTO)