Challenges to "Plain Meaning"

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It is difficult to see any ambiguity in Lanham Act § 2(b)

Lanham Act § 2(b) provides that a trademark may not be registered if it "[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or *municipality*, or of any foreign nation, or any simulation thereof." (Emphasis added.)

A least three U.S. municipalities have nevertheless registered their city seals: Atlanta, in 2006; Scottsdale, in 2007; and the Town of Miami Lakes Florida, in 2008. *See* In re The Government of the District of Columbia, 2012 WL 423804 at *11 (TTAB) (DC). At least two have since been refused in cases of first impression. *See id*. at *14 and In re City of Houston 2012 WL 423805 at *9 (TTAB) (Houston). Moreover, both have filed for review in the Federal Circuit. *See* Appellees' brief in the DC appeal, 2012 WL 6655892 at *5 (PTO Brief) ("The Director is aware of another appeal currently pending…, In re City of Houston…, that similarly involves a challenge to a refusal to register a municipal insignia.").

Neither city disputes that the applied-for mark is its official seal. *See DC* at * 11 and *Houston* at *7. DC seeks to register its seal for use in selling, e.g., tie tacks, holders for desk accessories, mugs, and clothes, whereas Houston seeks to register its seal for use in association with municipal services. That one set of applications is for goods and the other is for services has no apparent bearing on either opinion.

Only one prior opinion of the board has much bearing on the central issue. It concludes that the insignia used by the National Park Service, unlike seals applicants seek to register, was not an emblem akin to the U.S. flag or Great Seal but rather was "used to identify a service or facility of the Government." *See DC* at * 9 and *Houston* at *6.

Both opinions were issued Jan. 18, 2012, and are precedential. The board refers to *DC* in its shorter *Houston* opinion. *See Houston* at *3 ("As explained at greater length in *District of Columbia*, we find the [statutory] language… to be plain and clear on its face."). Although plain meaning, alone, might have resolved both cases, it did not. Parallel outcomes seem aptly summarized in the PTO brief cited above. First, "The TTAB found several flaws in the District's labyrinthine primary theory: that Congress enacted § 5 of the 1905 Act and later § 2(b) of the Lanham Act with the intent to be consistent with the Paris Convention…." Second, it "rejected the District's arguments based on language in the legislative history of § 5 the 1905 Act indicating that Congress generally intended § 5 to permit the registration of all marks which could be the subject of a trademark. The TTAB found that such a general expression of intent cannot override the clear and express terms of the statutory language, which prohibits the registration of some categories of marks." Third, it rejected an argument that § 2(b) "not be read to prohibit registration by a governmental authority of its own official insignia." Fourth, it rejected an unfair discrimination argument based on "registration to three marks comprising official seals of municipalities." Finally the board rejected an extension of the last argument couched in terms of the Fifth Amendment. *PTO Brief* at 7-8.

The last two arguments imply that, if an examiner registers a mark despite an unambiguous statutory prohibition, the board is compelled to follow suit. *But see* In re Wilson, 57 U.S.P.Q.2d 1863, 1871 (TTAB 2001) ("[T]he Board is not bound by prior decisions of [examiners]."). Indeed, even if the TTAB initially agrees, it need not do so forever. Thus, "that… some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases." In re Boulevard Entm't, Inc., 334 F.3d 1336, 1343 (Fed. Cir. 2003). Moreover, of course, the court need not defer.

When issues are ones of fact, however, the court may well consider examiners' prior decisions. *See, e.g.*, In re Cortright, 165 F.3d 1353, 1358-59 (Fed. Cir. 1999), where the court considered previously allowed patent claims to assess the meaning of a verb. Having done so, the court concluded, "one of ordinary skill would not construe 'restoring hair growth' to mean 'returning the user's hair to its original state,' as the board required. To the contrary, … one of ordinary skill would construe this phrase as meaning that the claimed method increases the amount of hair grown on the scalp but does not necessarily produce a full head of hair." *Id*. at 1359.

The first two challenges noted above apparently support the third. One might well doubt that Congress intended to forbid cities from registering their own seals as marks. Yet the board finds nothing in the legislative history, much less the Paris convention, to support a contrary view. Moreover, because an exception "could easily have been written… [w]e accordingly presume that Congress intended the prohibition on registration of official insignia to apply universally, without regard to the identity of the applicant." *Houston* at *5. *See also DC* at *10.

If a rabbit can be extracted from any hat, that's the one. But, if the court agrees that the plain meaning of § 2(b) leads to absurd results, what advantages will appellants secure?

Presumably, DC foresees a licensing scheme equivalent to that for "NYPD," registered in several classes of goods licensed for sale at http://www.nypd.com/. Federal registration would be required neither for such purposes nor to prevent domestic misrepresentations of source or sponsorship under § 43(a)(1)(A). Assuming foreign markets for its tie tacks and the like, it would, however, help secure foreign trademark registrations.

Yet, given the distance to any state, much less international, border, it is difficult to discern advantages to Houston from federal registration of its seal for utilities and other municipal

services listed in its two applications. On the contrary, licensing opportunities, as well as the threat of source or sponsorship misrepresentations for such services, seem strikingly limited.

Assuming potential merit to federal trademark registrations of city seals, it is surprising that a prohibition apparently went unchallenged for roughly a century. It also seems surprising that cities didn't long ago seek legislative relief. If applying the "plain meaning" of § 2(b) leads to absurd results, an easily drafted amendment should have been introduced. Indeed, H.R. 6215, proposing an amendment to § 43(c)(6), was introduced July 26th, 2012, and became law October 5th, slightly over two months later.