

No. 22-704

In the Supreme Court of the United States

KATHERINE K. VIDAL, Under Secretary
of Commerce for Intellectual Property
and Director, United States Patent
and Trademark Office,
Petitioner,

v.

STEVE ELSTER,
Respondent.

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

**BRIEF OF RESPONDENT IN OPPOSITION
TO PETITION FOR WRIT OF CERTIORARI**

DEEPAK GUPTA
JONATHAN E. TAYLOR
Counsel of Record
GREGORY A. BECK
Gupta Wessler PLLC
2001 K Street NW
Suite 850 North
Washington, DC 20006
(202) 888-1741
jon@guptawessler.com

Counsel for Respondent

QUESTION PRESENTED

Section 2(c) of the Lanham Act prohibits federal registration of any trademark that “[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent,” or the name “of a deceased President of the United States during the life of his widow,” “except by the written consent of the widow.” 15 U.S.C. § 1052(c). The question presented is whether the U.S. Patent and Trademark Office violated the First Amendment when it applied section 2(c) to refuse registration of a political slogan on T-shirts that criticizes former President Trump without his consent.

TABLE OF CONTENTS

Question presentedi

Table of authoritiesiii

Introduction 1

Statement3

Reasons for denying the petition.....8

I. There is no circuit split8

II. The question presented is narrow, fact-specific,
and rarely presented.....10

III. This case is a poor vehicle to decide the
question presented13

IV. The Federal Circuit correctly held that the
First Amendment prohibits the PTO from
denying registration on the ground that a
trademark criticizes a former president14

Conclusion21

TABLE OF AUTHORITIES

Cases

<i>Aktieselskabet AF 21. November 2001 v. Fame Jeans Inc.</i> , 525 F.3d 8 (D.C. Cir. 2008)	9
<i>Allen v. Cooper</i> , 140 S. Ct. 994 (2020)	11
<i>American Steel Foundries v. Robertson</i> , 269 U.S. 372 (1926)	4
<i>Ayotte v. Planned Parenthood</i> , 546 U.S. 320 (2006)	13
<i>Binderup v. Attorney General United States of America</i> , 836 F.3d 336 (3d Cir. 2016)	12, 13
<i>Booking.Com B.V. v. United States Patent & Trademark Office</i> , 915 F.3d 171 (4th Cir. 2019)	9
<i>Central Hudson Gas & Electric Corp. v. Public Service Commission of New York</i> , 447 U.S. 557 (1980)	8
<i>Edenfield v. Fane</i> , 507 U.S. 761 (1993)	19
<i>FCC v. League of Women Voters</i> , 468 U.S. 364 (1984)	14
<i>Iancu v. Brunetti</i> , 139 S. Ct. 2294 (2019)	1, 4, 11, 14, 16, 19

<i>In re Adco Industries-Technologies, L.P.</i> , 2020 WL 730361 (T.T.A.B. 2020)	5, 20
<i>James Burrough Ltd. v. Sign of Beefeater, Inc.</i> , 540 F.2d 266 (7th Cir. 1976)	4
<i>Legal Services Corp. v. Velazquez</i> , 531 U.S. 533 (2001)	18
<i>Matal v. Tam</i> , 582 U.S. 218 (2017)	1, 3, 4, 5, 11, 14, 17, 18, 19, 21
<i>National Endowment for Arts v. Finley</i> , 524 U.S. 569 (1998)	17
<i>Reed v. Town of Gilbert</i> , 576 U.S. 155 (2015)	15
<i>Rust v. Sullivan</i> , 500 U.S. 173 (1991)	11, 17
<i>Sorrell v. IMX Health, Inc.</i> , 564 U.S. 552 (2011)	16
<i>SpeechNow.org v. Federal Election Commission</i> , 599 F.3d 686 (D.C. Cir. 2010)	12
<i>United States v. American Library Association, Inc.</i> , 539 U.S. 194 (2003)	17
<i>United States v. Sineneng-Smith</i> , 140 S. Ct. 1575 (2020)	11
Statutes	
15 U.S.C. § 1052	1, 5, 6, 15

15 U.S.C. § 1071	9
15 U.S.C. § 1114	4
15 U.S.C. § 1119	10
Other Authorities	
Paul R. Gugliuzza, <i>Rethinking Federal Circuit Jurisdiction</i> , 100 Geo. L.J. 1437 (2012)	9
Hearing on H.R. 4744 Before the Subcommittee on Trademarks of the House Committee on Patents, 76th Cong., 1st Sess. 18–21 (1939)	15
J. Thomas McCarthy & Dina Roumiantseva, <i>Divert all trademark appeals to the Federal Circuit? We think not</i> , 105 TMR 1275 (2015)	9
Tejas N. Narechania, <i>Certiorari in Important Cases</i> , 122 Colum. L. Rev. 923 (2022)	12
Trademark Manual of Examining Procedure (Oct. 2018)	6, 20

INTRODUCTION

In the past six years, this Court has already twice affirmed Federal Circuit decisions holding restrictions on trademark registration unconstitutional. In *Matal v. Tam*, the Patent and Trademark Office refused to register the name of the band “The Slants” based on section 2(a) of the Lanham Act, which barred registration of disparaging marks. 582 U.S. 218 (2017). And in *Iancu v. Brunetti*, the PTO denied registration to a clothing company called “FUCT” under a parallel provision of section 2(a) prohibiting registration of immoral or scandalous marks. 139 S. Ct. 2294 (2019). In each case, this Court concluded that the restriction significantly burdened private speech and violated the First Amendment.

Now the government asks the Court to again revisit the constitutionality of a restriction on trademark registration—this time to review an as-applied challenge to section 2(c)’s bar on marks “identifying a particular living individual” without that person’s written consent. 15 U.S.C. § 1052(c). Invoking a memorable exchange from a 2016 presidential debate, Steve Elster sought to register the mark “Trump too small” for use on T-shirts to convey a political message about the then-President of the United States and his policies. The PTO refused registration under section 2(c), and the Trademark and Trial Appeal Board upheld the refusal. The Board did so for a single reason: because the mark identified former President Donald Trump without his consent.

The Federal Circuit reversed. Noting that Mr. Elster’s trademark goes to “the heart of the First Amendment,” the court held that the government has no plausible “interest in restricting speech critical of government officials or public figures in the trademark

context.” Pet. App. 20a. It thus declared section 2(c) unconstitutional as applied to Mr. Elster’s mark, leaving open the question whether the provision could constitutionally be applied in other circumstances.

That narrow, case-specific holding satisfies none of this Court’s traditional criteria for certiorari. The government concedes that there is no circuit split: The decision below is the first and only decision by any court to evaluate section 2(c)’s constitutionality. Nor does the decision raise any important issue justifying this Court’s review. Unlike other cases in which the Court has reviewed decisions declaring federal statutes unconstitutional, this case involves a one-off as-applied constitutional challenge—one that turns on the unique circumstances of the government’s refusal to register a trademark that voices political criticism of a former President of the United States.

Recognizing this problem, the government pitches the case as an opportunity for the Court to resolve the broader question of whether “refusal of trademark registration should be treated, for First Amendment purposes, as a restriction on speech” or as a “condition on a government benefit.” Pet. 13. But even if the Court were interested in resolving that infrequently occurring question, this case would be a poor vehicle through which to do so. The Federal Circuit below independently evaluated section 2(c)’s constitutionality as a “government benefit” and concluded that it did not change the outcome. Indeed, the court held the government’s claimed interest insufficient to justify the restriction “under any conceivable standard of review.” Pet. App. 21a. This Court should at least wait to review the question in a case where the answer matters.

In any event, the Court has already rejected the government's position—repeatedly. In both *Tam* and *Brunetti*, a majority of the Court held that limits on trademark registration are restrictions on private speech that are subject to First Amendment scrutiny. As Justice Kennedy's concurring opinion in *Tam* explained, trademark registration is not a situation “where private speakers are selected for a government program to assist the government in advancing a particular message.” *Tam*, 582 U.S. at 253 (Kennedy, J., concurring). This Court need not revisit the question again.

Once it is established that the First Amendment applies, that is the end of the matter. Section 2(c) is so poorly tailored that it cannot survive any level of scrutiny. It purports to protect the right of privacy, yet it covers only “celebrities and world-famous political figures,” Appx6, and bestows special protection on the President of the United States alone—“the least private name in American life,” Pet. App. 13a. It also purports to protect the right of publicity under state law. But as this case makes plain, it instead targets speech that would not give rise to a right-of-publicity claim in any state. And although the purpose of trademark registration is to prevent source deception and confusion, section 2(c)'s only practical effect is to prohibit *non*-deceptive marks. It is hard to imagine a statute that is a poorer fit for its supposed purposes than section 2(c). This Court should deny the petition.

STATEMENT

1. The most basic function of a trademark is to identify “goods as the product of a particular trader” and protect “against the sale of another's product as his.” *Tam*, 582 U.S. at 224. But “trademarks often have an expressive content” as well, consisting of “catchy phrases that convey

a message.” *Id.* at 224, 239. For this reason, this Court held in *Tam* that “trademarks are private . . . speech,” and cannot be regulated without satisfying First Amendment scrutiny. *Id.* at 239.

Trademark owners have long had the right to enjoin the use of marks that are so similar “as to be likely to produce confusion.” *Am. Steel Foundries v. Robertson*, 269 U.S. 372, 381 (1926). This traditional state common-law right reflects a core purpose of trademark law: “to protect the consuming public from confusion” and deception, “concomitantly protecting the trademark owner’s right to a non-confused public.” *James Burrough Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 276 (7th Cir. 1976). It is also consistent with the “well settled” constitutional rule that “confusing” or “misleading” commercial speech is unprotected. *Tam*, 582 U.S. at 252 (Kennedy, J., concurring).

Federal law, too, seeks to advance this core purpose of trademark law. It provides a system for federal registration of trademarks, which “helps to ensure that trademarks are fully protected and supports the free flow of commerce.” *Id.* at 225. And it provides a cause of action to enjoin the unauthorized use of marks that are “likely to cause confusion” or “to deceive.” 15 U.S.C. § 1114(1)(a); *id.* § 1125(a)(1)(A).

Under the Lanham Act, “registration of a mark is not mandatory.” *Brunetti*, 139 S. Ct. at 2297. “The owner of an unregistered mark may still use it in commerce and enforce it against infringers.” *Id.* “But registration gives trademark owners valuable benefits.” *Id.* Among them: It serves “as constructive notice of the registrant’s claim of ownership,” and as “prima facie evidence of the validity of

the registered mark” and “the owner’s exclusive right to use” it. *Tam*, 582 U.S. 226–27.

The Lanham Act generally requires that these benefits be given to any mark for which registration is sought. But it includes several statutory exceptions, which the PTO has interpreted as categorically barring registration. 15 U.S.C. § 1052 (“No trademark . . . shall be refused registration . . . on account of its nature unless” it falls within an enumerated statutory exception.).

Some of these exceptions advance the core purpose of trademark law. Section 2(a) of the Lanham Act, for example, “directly furthers the goal of prevention of consumer deception in source-identifiers.” *In re Adco Indus.-Techs., L.P.*, 2020 WL 730361, at *13 (T.T.A.B. 2020). It covers marks that are “deceptive” or “falsely suggest a connection with persons” or “institutions.” 15 U.S.C. § 1052(a). Section 2(d) similarly targets marks that could “cause confusion” or “deceive.” *Id.* § 1052(d).

But other exceptions have different aims. Section 2(a) also excludes “immoral” or “scandalous” marks, and marks that “may disparage” people, “institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” *Id.* § 1052(a). Both this Court and the Federal Circuit invalidated these exceptions in *Tam* and *Brunetti*, in part because they went “much further than is necessary to serve” their purported purposes. *Tam*, 582 U.S. at 246. As Justice Alito explained in *Tam*, the disparagement provision would restrict a trademark stating that “James Buchanan was a disastrous president.” *Id.* Such a restriction is “far too broad” for a law limiting expression. *Id.*

The provision at issue here, section 2(c), also covers criticism of presidents. It excludes any mark that

“[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent,” as well as marks that include “the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.” 15 U.S.C. § 1052(c). Unlike section 2(a), this provision is not focused on trademarks that express a false or misleading connection with public figures. To the contrary, as interpreted by the PTO, its only practical effect is to cover truthful, non-misleading marks about “celebrities and world-famous political figures.” Appx6. Its apparent purpose in doing so “is to protect rights of privacy and publicity that living persons have in the designations that identify them.” Trademark Manual of Examining Procedure § 1206 (Oct. 2018), <https://perma.cc/V2JQ-WDAM>.

2. Steve Elster sought federal registration of the trademark “Trump too small” for use on shirts and hats. Appx1-2. As he explained to the PTO, the mark is “political commentary” targeted at now-former President Trump. Appx138. The mark criticizes Trump by using a double entendre, invoking a memorable exchange from a Republican presidential primary debate, while also expressing Elster’s view about “the smallness of Donald Trump’s overall approach to governing as president of the United States.” *Id.*

The PTO examiner found no conflicting marks that would bar registration under section 2(d). Appx40. Nevertheless, the examiner refused registration on two grounds. First, the examiner refused registration under section 2(c) because the mark includes Trump’s name without his consent. *Id.* Second, the examiner also refused registration under section 2(a) because the mark “may

falsely suggest a connection with Donald Trump.” Appx450. While acknowledging that “Donald Trump is not connected with” the critical T-shirts, the examiner concluded that he “is so well- known that consumers would presume a connection.” Appx450.

Elster appealed to the Trademark Trial and Appeal Board, which affirmed under section 2(c) without reaching the section 2(a) question. Appx11. The Board found it undisputed that the mark includes Trump’s name without his consent and applied section 2(c) on that basis alone. Appx4. The Board rejected Elster’s argument that the public “would not presume a connection” between Trump and the critical T-shirts, in part because Trump would never endorse such a message. *Id.* “Unlike Section 2(a)’s explicit statutory requirement that the matter in question ‘falsely suggest a connection,’” the Board wrote, section 2(c) “applies regardless of whether there is a suggested connection.” Appx6. Instead, the “key purpose of requiring the consent . . . is to protect rights of privacy and publicity that living persons have in the designations that identify them.” Appx2. Given that purpose, the Board concluded that the relevant question is not whether the public is confused, but only whether it “would perceive the name in the proposed mark as identifying a particular living individual.” Appx5–6. Because Trump “is extremely well known” and had not consented, nothing more was required. Appx6.

3. The Federal Circuit reversed. In a unanimous opinion, the court followed the opinions in *Tam* and *Brunetti* and held that “applying section 2(c) to bar registration of Elster’s mark unconstitutionally restricts free speech.” Pet. App. 2a.

The court first held that the statute was subject to at least intermediate scrutiny under *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, 447 U.S. 557, 566 (1980). Pet. App. 9a. In doing so, it rejected the government’s argument that a bar on trademark registration should be evaluated more deferentially because it is akin to the denial of a government subsidy or to a restriction in a nonpublic forum. Those arguments, the court concluded, find “little support in the Supreme Court’s opinions in *Tam* and *Brunetti*.” Pet. App. 5a–8a.

The court then applied the intermediate-scrutiny test to the record before it. In doing so, it noted that the “First Amendment interests here are undoubtedly substantial,” involving speech “otherwise at the heart of the First Amendment.” Pet. App. 9a, 11a. Those important interests are not “outweighed by the government’s substantial interest in protecting state-law privacy and publicity rights.” Pet. App. 10a. “[T]here can be no plausible claim,” the court explained, “that President Trump enjoys a right of privacy protecting him from criticism.” Pet. App. 11a. And the “right of publicity does not support a government restriction on the use of a mark because the mark is critical of a public official without his or her consent.” Pet. App. 15a. Although the government has an interest in preventing deceptive marks, there is “[n]o plausible claim” that Elster’s mark “suggests that President Trump has endorsed Elster’s product.” Pet. App. 14a.

REASONS FOR DENYING THE PETITION

I. There is no circuit split.

The government does not argue that the decision below implicates a circuit split. Nor could it: The Federal

Circuit’s decision is the first and only decision—in any court—to have considered section 2(c)’s constitutionality. The question has never arisen outside of this case.

The government (at 10) downplays the significance of the absence of a split, arguing that one is not “likely to emerge” because any party aggrieved by the PTO’s denial of registration under section 2(c) will likely appeal to the Federal Circuit. Unlike patents, however, Congress has not given the Federal Circuit exclusive appellate jurisdiction over trademark cases. *See* Paul R. Gugliuzza, *Rethinking Federal Circuit Jurisdiction*, 100 *Geo. L.J.* 1437, 1493 (2012). As a consequence, a large majority of trademark appeals are heard in the regional circuits, some of which have developed even “greater experience with trademark law” than the Federal Circuit. J. Thomas McCarthy & Dina Roumiantseva, *Divert all trademark appeals to the Federal Circuit? We think not*, 105 *Trademark Rep.* 1275, 1275, 1282 (2015). Circuit splits are common. *See id.* at 1280 & n.22 (identifying four circuit splits on trademark issues during a single term).

Although the government is correct that parties to a PTO proceeding have the *right* to appeal to the Federal Circuit, that is not their only option. They also can, and often do, seek review by filing a civil action in federal district court. *See* 15 U.S.C. § 1071(b)(1); *see, e.g., Booking.Com B.V. v. U.S. Patent & Trademark Office*, 915 F.3d 171 (4th Cir. 2019); *Aktieselskabet AF 21. November 2001 v. Fame Jeans Inc.*, 525 F.3d 8 (D.C. Cir. 2008). The Lanham Act “provides an independent civil action to cancel a completed trademark registration without first petitioning the PTO.” *Aktieselskabet*, 525 F.3d at 14. And district courts have “broad authority to

review trademark decisions,” “both before and after the registration of a mark.” *Id.* at 12.

Public figures aggrieved by the PTO’s registration of trademarks including their names would thus likely file suit in a district court that is not bound by Federal Circuit precedent. Moreover, a trademark registrant seeking to enforce the mark would have to move for an injunction in a district court, where the defendant could respond by arguing that the mark is unregistrable or asking for its cancellation. *See* 15 U.S.C. § 1119 (granting district courts authority to cancel registrations or “otherwise rectify the register”). In either case, an appeal of the district court’s decision would go to one of the regional circuits, which would be free to disagree with the Federal Circuit on the registrability of the mark and the constitutionality of section 2(c).

II. The question presented is narrow, fact-specific, and rarely presented.

A. The Federal Circuit’s decision is narrow and bound to the specific circumstances of this case. The decision holds only that section 2(c) is unconstitutional as applied to the trademark “Trump too small,” concluding that the government has no legitimate “interest in limiting speech on privacy or publicity grounds if that speech involves criticism of government officials.” Pet. App. 11a. As the government recognizes (at 10–11), these narrow facts rarely arise and may not arise again. This is the only case to have decided section 2(c)’s constitutionality, and the government admits (at 10) that it is “not aware of” any such cases currently pending. A decision by this Court would thus likely have little practical impact beyond this case.

The government argues that the decision below caused the PTO to temporarily “suspend[] action” on trademark applications that implicate section 2(c). Pet. 11. But to the extent that this temporary halt is a problem, it is one of the government’s own making. And it is unlikely to cause any real harm. As the government explains, the suspension is in effect only during “the Court’s disposition of this petition for a writ of certiorari.” *Id.* Denying certiorari is thus the most efficient way to allow the PTO to adopt the Federal Circuit’s holding and resume processing trademark applications under section 2(c). At this early stage, however, the PTO has yet to revise its manual or say how it will comply with the decision. If the issue arises again, this Court will have the opportunity to decide it at that time, with the benefit of a concrete PTO policy.

B. Although the government acknowledges that the decision below turns on the narrow facts of this case, it nevertheless asserts that certiorari is warranted because the decision declared a federal statute unconstitutional. “[W]hen a lower court has invalidated a federal statute,” the government argues, the Court’s “usual” course is to grant certiorari. *Brunetti*, 139 S. Ct. at 2298.

But *Brunetti* and the other cases on which the government relies involved *facial* invalidations of federal statutes. *See id.*; *Tam*, 852 U.S. 218; *United States v. Sineneng-Smith*, 140 S. Ct. 1575, 1581 (2020); *Allen v. Cooper*, 140 S. Ct. 994 (2020); *Rust v. Sullivan*, 500 U.S. 173, 191 (1991). As this Court has explained, facial invalidation “is strong medicine that is not to be casually employed.” *Sineneng-Smith*, 140 S. Ct. at 1581. The Court has thus called its review of such decisions “the gravest

and most delicate duty that th[e] Court is called on to perform.” *Rust*, 500 U.S. at 191.

The Federal Circuit, however, did not invalidate a federal statute. Rather, as the government acknowledges, it invalidated the PTO’s decision to refuse registration of Mr. Elster’s trademark—that is, the “*application* of a federal statute” to the specific facts of this case. Pet. 9. “It may be,” the court wrote, “that a substantial number of section 2(c)’s applications would be unconstitutional.” Pet. App. 19a. But the court expressly declined to decide that question. Instead, it limited its holding to the narrow issue of “whether the government has an interest in limiting speech on privacy or publicity grounds if that speech involves criticism of government officials—speech that is otherwise at the heart of the First Amendment.” Pet. App. 11a. As to all other applications, section 2(c) remains undisturbed.

This Court has never articulated a policy of always or presumptively granting certiorari in cases where, as here, a statute is held unconstitutional only as applied to the specific facts of a case. *See* Tejas N. Narechania, *Certiorari in Important Cases*, 122 Colum. L. Rev. 923, 931 n.33 (2022). Nor has it hesitated to deny the government’s petitions for certiorari in such cases. *See, e.g., SpeechNow.org v. Federal Election Comm’n*, 599 F.3d 686 (D.C. Cir. 2010) (en banc), *cert. denied*, 562 U.S. 1003 (2010) (holding that an application of 2 U.S.C. § 441a(a)(1)(C), a federal campaign-contribution requirement, violated the First Amendment); *Binderup v. Attorney Gen. U.S.*, 836 F.3d 336, 345 (3d Cir. 2016), *cert. denied sub nom. Sessions v. Binderup*, 137 S. Ct. 2323 (2017) (holding that an application of 18 U.S.C. § 922(g)(1),

the federal felon-in-possession statute, violated the Second Amendment).

That makes sense. Unlike a facial challenge, an as-applied challenge “does not contend that a law is unconstitutional as written but that its application to a particular person under particular circumstances deprived that person of a constitutional right.” *Binderup*, 836 F.3d at 345. It is “axiomatic that a ‘statute may be invalid as applied to one state of facts and yet valid as applied to another.’” *Ayotte v. Planned Parenthood*, 546 U.S. 320, 329 (2006). The impact of an as-applied decision is thus vastly more limited than a facial one. Moreover, multiple as-applied challenges can be brought against the same statute, each tied to the circumstances of a particular case. It would make little sense for this Court to grant review every time a court of appeals applies a statute to a new set of facts. Unlike cases in which federal statutes are facially invalidated, such fact-bound decisions do not presumptively involve “important” issues justifying this Court’s review. *See* S. Ct. R. 10(c).

III. This case is a poor vehicle to decide the question presented.

Recognizing the narrowness of the decision below, the government argues (at 12) that this Court should grant review to “determine[] the appropriate level of scrutiny under the First Amendment” for *other* restrictions on trademark registration. But this case is a poor vehicle to decide that question because, as the Federal Circuit concluded, the government’s purported interest in protecting public figures from critical trademarks fails “under any conceivable standard of review.” Pet. App. 20a.

This is not a case where the Court must speculate about whether a question is outcome determinative; the

decision below already explained that it is not. “[E]ven if a trademark were a government subsidy,” the Federal Circuit wrote, it would not mean that “First Amendment requirements are inapplicable.” Pet. App. 7a. “Elster’s mark is speech by a private party in a context in which controversial speech is part-and-parcel of the traditional trademark function, as the Supreme Court decisions in *Tam* and *Brunetti* attest.” *Id.* “Under such circumstances, the effect of . . . restrictions imposed with [a] subsidy must be tested by the First Amendment.” *Id.*; see *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 543, 547–48 (2001); *FCC v. League of Women Voters*, 468 U.S. 364, 396–97 (1984).

As in *Tam* and *Brunetti*, this Court “need not resolve” the standard of scrutiny in this case. *Tam*, 582 U.S. at 245. Even if the Court were to grant review, it would have little potential to change the outcome.

IV. The Federal Circuit correctly held that the First Amendment prohibits the PTO from denying registration on the ground that a trademark criticizes a former president.

A. In any event, the government is wrong (at 13) that section 2(c) “is not a restriction on speech.” That is the same argument that the government offered, and this Court rejected, in *Tam*. There, all eight participating Justices agreed that “[t]rademarks are private, not government, speech.” 582 U.S. at 240 (majority op.). Trademarks “do not simply identify the source of a product or service” but also often “have an expressive content” and can convey “powerful messages . . . in just a few words.” *Id.* The Court thus rejected application of a proposed framework that would “eliminate any First Amendment protection or result in highly permissive

rational-basis review.” *Id.* at 233. Two terms later, the Court reaffirmed this view in *Brunetti*. 139 S. Ct. at 2299.

While section 2(c) may not be viewpoint based, it is undeniably a content-based restriction on speech. As this Court has made clear: “Government regulation of speech is content based if a law applies to particular speech because of the topic discussed,” such as when a law “defin[es] regulated speech by particular subject matter.” *Reed v. Town of Gilbert*, 576 U.S. 155, 163 (2015). Section 2(c) is such a law. On its face, it requires a PTO examiner to assess the content of a mark to determine whether it “[c]onsists of or comprises a name . . . identifying a particular living individual,” or “the name . . . of a deceased President.” 15 U.S.C. § 1052(c). The law therefore “singles out specific subject matter for differential treatment, even if it does not target viewpoints within that subject matter.” *Reed*, 576 U.S. at 169. “That is a paradigmatic example of content-based discrimination.” *Id.*; accord *Tam*, 808 F.3d at 1335 (“It is beyond dispute that § 2(a) discriminates on the basis of content in the sense that it applies to particular speech because of the topic discussed.”). That alone “is sufficient to justify application of heightened scrutiny.” *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 571 (2011).

Indeed, the statute makes it virtually impossible to register a mark that expresses an opinion about a public figure—including a political message (as here) that is critical of the President of the United States. Congress enacted section 2(c) on the concern that the identities of presidents (and former presidents) would be used in what Congress considered to be degrading contexts. See Hearing on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong.,

1st Sess. 18–21 (1939) (statement of Rep. Rogers) (“Abraham Lincoln gin ought not to be used, but I would not say the use of G. Washington on coffee should not be permissible.”); *see also id.* (statement of Rep. Maroney) (“[W]e would not want to have Abraham Lincoln gin.”). That concern appears to be the only explanation for the provision’s extension to “a deceased President of the United States during the life of his widow”—a protection extended to no other deceased person. Pet. App. 9a.

The government also claims (at 15) that the PTO’s refusal to register Mr. Elster’s trademark is not a speech restriction because it “places no constraints on respondent’s freedom to use his chosen mark.” But as the Federal Circuit explained, “whether Elster is free to communicate his message without the benefit of trademark registration is not the relevant inquiry—it is whether section 2(c) can legally disadvantage the speech at issue here.” Pet. App. 5a–6a. “Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content.” *Sorrell*, 564 U.S. at 566. Thus, “the Government’s content-based burdens must satisfy the same rigorous scrutiny as its content-based bans.” *Id.*

As *Tam* and *Brunetti* make clear, denial of trademark registration burdens private speech because it “disfavors” particular marks. *Brunetti*, 139 S. Ct. at 2300. Federal registration “confers important legal rights and benefits on trademark owners who register their marks,” including by serving “as constructive notice of the registrant’s claim of ownership,” by making the mark incontestable after five years, and as “prima facie evidence of the validity of the registered mark” and “the owner’s exclusive right to use” it. *Id.* This Court thus held restrictions on trademark registration unconstitutional in both *Tam* and *Brunetti*,

even though the rejected applicants remained free to use the marks.

B. *Tam* and *Brunetti* also foreclose the government’s argument (at 13) that section 2(c) is a “condition on a government benefit” akin to a government subsidy. The cases on which the government relies “upheld the constitutionality of government programs that subsidized speech expressing a particular viewpoint.” *Tam*, 582 U.S. at 239. These cases hold that the government “can, without violating the Constitution, selectively fund a program to encourage certain activities it believes to be in the public interest, without at the same time funding an alternate program which seeks to deal with the problem in another way.” *Rust*, 500 U.S. at 193. This exception to heightened scrutiny “is necessary to allow the government to stake out positions and pursue policies.” *Tam*, 582 U.S. at 253 (Kennedy, J., concurring).

The plurality opinion in *Tam* squarely rejects application of that framework to restrictions on trademark registration, finding it to be “no difficult question.” 582 U.S. at 240. “Cases like *Rust* and *Finley* are not instructive,” Justice Alito wrote, because “federal registration of a trademark is nothing like the programs at issue in these cases.” *Id.* at 240–41. Unlike trademark registration, “the decisions on which the Government relies all involved cash subsidies or their equivalent.” *Id.*; see, e.g., *Rust*, 500 U.S. 173 (federal funding for private providers of family-planning services); *Nat’l Endowment for Arts v. Finley*, 524 U.S. 569 (1998) (federal grants to artists); *United States v. Am. Library Ass’n, Inc.*, 539 U.S. 194 (2003) (funding for public libraries). In contrast, the government “does not pay money to parties seeking registration of a mark.” *Tam*, 582 U.S. at 240 (plurality

op.). “Quite the contrary is true: An applicant for registration must pay the PTO.” *Id.*

Justice Kennedy’s concurring opinion also effectively rejected the government’s subsidy analogy. Trademark registration, he wrote, is not an example of the “narrow situation . . . where the government itself is speaking or recruiting others to communicate a message on its behalf,” or where “private speakers are selected for a government program to assist the government in advancing a particular message.” *Id.* at 1768 (Kennedy, J., concurring). Like the legal-services funding at issue in *Legal Services Corporation v. Velazquez*, trademark registration is not “government speech disseminated through private actors,” but rather “legal efforts to facilitate private speech itself.” 531 U.S. 533, 547 (2001).

If the government were correct, it would allow the PTO to restrict commentary on important public officials without articulating any legitimate reason for doing so. That, as the Court wrote in *Tam*, “would constitute a huge and dangerous extension of the government-speech doctrine.” 582 U.S. at 239. “[J]ust about every government service requires the expenditure of government funds.” *Id.* at 241. “If private speech could be passed off as government speech by simply affixing a government seal of approval, government could silence or muffle the expression of disfavored viewpoints.” *Id.* at 235. Thus, “Congress cannot recast a condition on funding as a mere definition of its program in every case, lest the First Amendment be reduced to a simple semantic exercise.” *Velazquez*, 531 U.S. at 547.

C. Certiorari is also unwarranted to address the government’s remaining argument: that “registration of marks like respondent’s” would “restrict the speech of

others.” Pet. 16–17. Registration would give Mr. Elster no power to prevent others from using “Trump too small” in day-to-day speech or political commentary. The only use of the mark he could prevent is as a source identifier on competing products—that is, competing T-shirts using his brand name in a confusing manner. And it “is well settled . . . that to the extent a trademark is confusing or misleading the law can protect consumers and trademark owners” without implicating the First Amendment. *Tam*, 582 U.S. at 252 (Kennedy, J., concurring). Were it otherwise, the constitutionality of the whole trademark system would be in doubt.

Even if the government were right about the existence of competing speech interests, intermediate scrutiny would still be the appropriate test. The test allows the government to assert this interest in defense of the law if it wants. Yet the government here did not do so, despite having the burden. *See Edenfield v. Fane*, 507 U.S. 761, 770–71 (1993). That isn’t surprising. There is no evidence that Congress, when it enacted the Lanham Act, wanted to encourage the proliferation of identical competing trademarks in the name of free speech. Had it intended to create that confusing free-for-all, it would have written a very different law. Instead, it chose to deny registration to certain “disfavor[ed]” categories, *Brunetti*, 139 S. Ct. at 2300, and to erect a regime in which “Make America Great Again” may be registered but not “Trump Too Small.” Because the Federal Circuit correctly held that no legitimate governmental interest supports drawing this distinction, this Court should deny certiorari.

D. At best, the government’s argument that this case involves “viewpoint-neutral” content discrimination, Pet. 12, is an argument for applying intermediate scrutiny—

not for applying no scrutiny at all. Because section 2(c) does not come close to satisfying even that level of review, it is unconstitutional as applied to the mark “Trump too small.”

It is of course true that, “to the extent a trademark is confusing or misleading,” the government “can protect consumers and trademark owners.” *Tam*, 582 U.S. at 252 (Kennedy, J., concurring). But section 2(c) does not prevent source confusion or false endorsement of goods. Just the opposite: Those concerns are separately prohibited by section 2(a)’s bar on marks that “falsely suggest a connection with persons, living or dead”—a provision aimed squarely at the “prevention of consumer deception.” *In re Adco Indus.-Techs., L.P.*, 2020 WL 730361, at *13. Unlike section 2(a), section 2(c) “applies regardless of whether there is a suggested connection” *at all*—let alone a misleading one. Appx6. The practical effect of section 2(c), then, is to target marks that do *not* confuse or mislead. The mark here is a case in point: No one would think that a product with the phrase “Trump too small” is coming from the former President himself.

The government does not claim otherwise. Instead, it argues that section 2(c) serves a different purpose: “to protect rights of privacy and publicity that living persons have in the designations that identify them.” Trademark Manual of Examining Procedure § 1206. As in *Tam*, however, the restriction “bears no plausible relation” to the government’s asserted goal. *Tam*, 582 U.S. at 253 (Kennedy, J., concurring). With respect to the right to privacy, the PTO interprets section 2(c) to protect only “celebrities and world-famous political figures,” Appx6—including the President of the United States, “the least private name in American life,” Pet. App. 13a. As for the

right of publicity, the government hasn't identified a single case "holding that public officials may restrict expressive speech to vindicate their publicity rights." Pet. App. 17a–18a. "In fact, every authority that the government cites reaches precisely the opposite conclusion, recognizing that the right of publicity cannot shield public figures from criticism." *Id.*

Nor does the government even attempt to show that section 2(c) is narrowly tailored to its claimed interest. A narrower restriction is readily available: Congress easily could have exempted political commentary from section 2(c)'s coverage—just like the state laws that the section is purportedly designed to protect. As Justice Alito noted in *Tam*, a restriction prohibiting registration of the mark "Buchanan was a disastrous president" would be "far too broad" to survive intermediate scrutiny. 582 U.S. at 246. Just so here.

CONCLUSION

This Court should deny the petition for certiorari.

Respectfully submitted,

DEEPAK GUPTA
JONATHAN E. TAYLOR
Counsel of Record

GREGORY A. BECK
Gupta Wessler PLLC
2001 K Street NW
Suite 850 North
Washington, DC 20006
(202) 888-1741
jon@guptawessler.com

April 25, 2023

Counsel for Respondent