

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 WRIT OF CERTIORARI TO THE UNITED STATES
COURT OF APPEALS FOR THE FEDERAL CIRCUIT

**AMICUS CURIAE BRIEF OF THE INTERNATIONAL
TRADEMARK ASSOCIATION IN
SUPPORT OF PETITIONER**

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The International Trademark Association (“INTA”) submits this brief in support of Petitioner Katherine K. Vidal, and urges reversal of the decision below in *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022).

INTERESTS OF THE AMICUS CURIAE

Founded in 1878 as the United States Trademark Association, INTA is a not-for-profit organization dedicated to the advancement of trademarks and related intellectual property principles as essential elements of trade and commerce. With more than 6,500 member organizations from 185 countries, and representing tens of thousands of trademark owners, professionals, and members of the academic community, INTA’s members share the goals of fostering fair competition and informed decisions by consumers.¹

For decades, INTA has provided recommendations and assistance to legislators in connection with almost all major federal trademark and related legislation. In addition, INTA’s members frequently are plaintiffs, defendants, and advisors in legal actions under the Lanham Act, including actions involving the intersection of free speech, trademark, privacy and publicity rights.

INTA is interested in the development of clear, consistent, and equitable principles of trademark law.

¹ Pursuant to Supreme Court Rule 37.6, the undersigned counsel confirms that no counsel for a party authored the brief in whole or in part and no such counsel or a party made a monetary contribution intended to fund the preparation or submission of the brief, nor did any person or entity, other than the amicus curiae, its members, or its counsel, make any such a monetary contribution to the preparation or submission of the brief.

Accordingly, INTA has participated as *amicus curiae* in numerous cases on significant Lanham Act issues, including the recent cases of *Iancu v. Brunetti*, 588 U.S. ___, 139 S. Ct. 2294 (2019) and *Matal v. Tam*, 582 U.S. 218 (2017), which also relate to the intersection of the First Amendment and the trademark registration process.²

² Cases in which INTA has filed amicus briefs since 2000 include: *Jack Daniel's Props., Inc. v. VIP Prods., LLC*, 599 U.S. ___, 143 S. Ct. 1578 (2023); *Abitron Austria GmbH v. Hetronic Int'l, Inc.*, No. 21-1043, 600 U.S. ___ (June 29, 2023); *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 591 U.S. ___, 140 S. Ct. 2298 (2020); *Romag Fasteners, Inc. v. Fossil, Inc.*, 590 U.S. ___, 140 S. Ct. 1492 (2020); *Peter v. NantKwest, Inc.*, 589 U.S. ___, 140 S. Ct. 365 (2019); *Iancu v. Brunetti*, 588 U.S. ___, 139 S. Ct. 2294 (2019); *Mission Prod. Holdings, Inc. v. Tempnology, LLC*, 587 U.S. ___, 139 S. Ct. 1652 (2019); *Matal v. Tam*, 582 U.S. 218 (2017); *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138 (2015); *Hana Fin., Inc. v. Hana Bank*, 574 U.S. 418 (2015); *POM Wonderful LLC v. Coca-Cola Co.*, 573 U.S. 102 (2014); *Herb Reed Enters., LLC v. Florida Ent. Mgmt., Inc.*, 574 U.S. 815 (2014); *Already, LLC v. Nike, Inc.*, 568 U.S. 85 (2013); *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23 (2003); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003); *Traffix Devices, Inc. v. Mktg. Displays, Inc.*, 532 U.S. 23 (2001); *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205 (2000); *Crocs, Inc. v. Effervescent, Inc.*, No. 2022-2160 (Fed. Cir. pending); *Vans, Inc. v. MSCHF Prod. Studio, Inc.*, No. 22-1006 (2d Cir. pending); *LTTB LLC v. Redbubble, Inc.*, 840 F. App'x 148 (9th Cir. 2021); *Ohio State Univ. v. Redbubble, Inc.*, 989 F.3d 435 (6th Cir. 2021); *Ferring Pharms., Inc. v. Watson Pharms., Inc.*, 765 F.3d 205 (3d Cir. 2014); *Christian Louboutin S.A. v. Yves Saint Laurent Am. Holding, Inc.*, 696 F.3d 206 (2d Cir. 2012); *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144 (4th Cir. 2012); *Fleischer Studios, Inc. v. A.V.E.L.A., Inc.*, 654 F.3d 958 (9th Cir. 2011) (on rehearing); *Starbucks Corp. v. Wolfe's*

footnote continued on next page...

INTA’s principal interest in this case is to ensure that the United States Patent and Trademark Office (“USPTO”) and courts consistently apply the statutory rights provided by Congress to register and protect the rights of trademark owners and to carefully balance those rights with individuals’ rights of free speech, privacy and publicity.

SUMMARY OF THE ARGUMENT

Respondent, Steven Elster, applied in 2018 to register the mark TRUMP TOO SMALL in the USPTO based on a stated intent to use the mark in commerce on shirts. An examining attorney in the USPTO refused registration under Section 2(c) of the Lanham Act, 15 U.S.C. § 1052(c)), which, in relevant part, authorizes refusal of registration where a claimed mark “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.” Respondent unsuccessfully appealed to the USPTO’s Trademark Trial and Appeal Board (“TTAB”), after which the United States Court of Appeals for the Federal Circuit reversed, finding that as applied to Mr. Elster’s claimed mark, Section 2(c) violated the First Amendment. *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022).

The Federal Circuit applied heightened scrutiny to the USPTO’s refusal to register Mr. Elster’s TRUMP TOO SMALL trademark on the basis that Section 2(c) is a content-based restriction of speech. It held that

Borough Coffee, Inc., 588 F.3d 97 (2d Cir. 2009); and *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252 (4th Cir. 2007).

the application of Section 2(c) to Mr. Elster’s application did not survive such scrutiny “because the government does not have a privacy or publicity interest in restricting speech critical of government officials or public figures in the trademark context—at least absent actual malice, which is not alleged here. *Id.* at 1339. INTA respectfully submits that the Federal Circuit erred in applying that heightened level of scrutiny and that Section 2(c) passes Constitutional review for four principal reasons.

First, Section 2(c) does not create any significant or undue restriction on speech. As this Court recently held in *Jack Daniels Properties, Inc. v. VIP Products, LLC*, 143 S. Ct. 1578, 1584 (2023), “...the owner of even an unregistered trademark can ’use [the mark] in commerce and enforce it against infringers.” (quoting *Iancu v. Brunetti*, 139 S. Ct. at 2297). Moreover, the First Amendment interests are tempered where, as here, a party “uses a trademark in the way the Lanham Act most cares about: as a designation of source for [the user’s] own goods.” 143 S. Ct. at 1587. In this instance, Mr. Elster has not even attempted yet to use his mark in commerce. Rather, he claims at most only a bona fide intent to use the mark someday. Because Section 2(c) does not restrict his right to engage in future speech, it should not be subjected to heightened scrutiny under the First Amendment.

Second, unlike the provisions struck down in *Iancu v. Brunetti*, 588 U.S. ___, 139 S. Ct. 2294 (2019) and *Matal v. Tam*, 582 U.S. 218 (2017), Section 2(c) is a viewpoint-neutral element of the registration program established by Congress. Accordingly, this Court’s decisions in *Tam* and *Brunetti* are not

controlling here. In this case, the USPTO and TTAB applied the statute in an entirely viewpoint neutral manner. As a result, the Court can find that it only needs to have a “reasonable” basis to survive the present challenge. In the alternative, if the Court does conclude that some heightened scrutiny is appropriate, it should be no higher than intermediate scrutiny because trademarks are commercial speech.

Third, Congress has a substantial basis to regulate registration of trademarks that appropriate and trade upon the names and associated publicity rights of recognized individuals. This Court held in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 566 (1977), that such rights are an important counterweight to be balanced against First Amendment interests. The Federal Circuit, however, incorrectly equated the right of publicity to a right against false endorsement, which not only misstates the law but would render Section 2(c) duplicative of Section 2(a) of the Lanham Act, which bars registration of marks that falsely imply an association with others.

Fourth, like other viewpoint neutral restrictions on trademark registrations, Section 2(c) refusals permit more speech, not less. Indeed, because the principal benefit of federal registration is the presumptive right to exclude third parties from use of a registered mark, granting registration to Mr. Elster of the phrase TRUMP TOO SMALL may well have the opposite effect of limiting speech by emboldening Mr. Elster to threaten claims of infringement against third parties wishing to use similar terms in actual political speech.

ARGUMENT

I. SECTION 2(C) DOES NOT RESTRICT SPEECH.

Federal trademark registration is not government permission for speech. It is a system for indexing and organizing trademarks and provides certain benefits to both brand owners and consumers. Section 2(c) is simply a mechanism to ensure that, during the registration process, other parties' rights of publicity are not violated. The USPTO's rejection of Mr. Elster's trademark application has not burdened his free speech rights and does not warrant elevated scrutiny under this Court's First Amendment jurisprudence.

A. The Purpose of the Trademark Registration System is to Identify the Source of Goods and Services and to Avoid Consumer Confusion.

The primary role of a trademark is to identify and distinguish the source of goods or services. With roots in common law and equity, trademark protection serves the dual goals of protecting mark owners and consumers by: (1) "secur[ing] to the owner of the mark the goodwill of her business"; and (2) "protect[ing] the ability of consumers to distinguish among competing producers." *U.S. Pat. & Trademark Off. v. Booking.com, B. V.*, 591 U.S. ___, 140 S. Ct. 2298, 2302 (2020) (internal quotation marks and citation omitted). Courts view these functions as deserving of protection. 1 J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 3:2 (5th ed. 2023) (hereinafter "MCCARTHY")

The Lanham Act, enacted in 1946, generally does not create substantive trademark rights. Rather, the Lanham Act provides a system of federal registration

and enforcement for trademark rights that arise at common law. *See Tam*, 582 U.S. at 224. By providing trademark owners with federal causes of action and instituting a uniform system of trademark registration, the Lanham Act furthers the goals of safeguarding against unfair competition and preventing fraud and deception on a national scale. 15 U.S.C. § 1127; *see also Tam*, 582 U.S. at 225 (“[F]ederal registration helps to ensure that trademarks are fully protected and supports the free flow of commerce.”); *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985) (“The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.”).

Trademark protection is premised on the notion that trademarks—whether words, names, symbols, phrases, or more—“can help distinguish a particular artisan’s goods from those of others.” *Tam*, 582 U.S. at 223 (citation omitted). Registration confers valuable legal rights and benefits on trademark owners. In particular, registration on the principal register:

- (1) Trademark protection is premised on the notion that trademarks—whether words, names, symbols, phrases, and more—“can help distinguish a particular artisan’s goods from those of others.” *Tam*, 582 U.S., at 223 (internal quotation marks and citation omitted). Registration confers valuable legal rights and benefits on trademark owners. In particular, registration on the principal register: serves as constructive notice of the registrant’s claim of ownership of the mark; (2) is prima facie

evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate; and (3) can make a mark incontestable once a mark has been registered for five years.

Tam, 582 U.S. at 226-227 (internal quotation marks and citations omitted).

With one exception that is relevant here, a trademark is generally registrable “if it is ‘used in commerce.’” *Iancu v. Brunetti*, 139 S. Ct. at 2298 (quoting 15 U.S.C. § 1051(a)(1)). Section 2 of the Lanham Act prescribes, however, several statutory bars on registration. 15 U.S.C. § 1052(a)-(e). For example, the Lanham Act also directs the USPTO to refuse registration of any mark that is “merely descriptive” or “deceptively misdescriptive” of the goods and services with which the mark is used. 15 U.S.C. § 1052(e). The USPTO also must not register any mark that “so resembles” another mark “as to be likely . . . to cause confusion, or to cause mistake, or to deceive.” 15 U.S.C. § 1052(d). Other prohibitions on registration include marks that contain “the flag or coat of arms or other insignia of the United States,” 15 U.S.C. § 1052(b), and, as relevant here, marks that contain “a name, portrait, or signature identifying a particular living individual” without that person’s consent, 15 U.S.C. § 1052(c). *See* 3 MCCARTHY § 19:75. These prohibitions all serve important policy goals.

B. Fair Use and First Amendment Doctrines Allow Registered Marks to be Used in Speech.

Even if a mark becomes federally registered, the exclusive right to use that term is not absolute. Indeed, the Lanham Act has several “built-in mechanisms” to ensure that registration of marks and enforcement of trademark rights are carried out in a manner consistent with the First Amendment. *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 970 (10th Cir. 1996). For example, the prohibition on registration or use of marks that are likely to cause confusion with other marks is entirely congruent with the First Amendment. As this Court has long held, “[t]he government may ban forms of communication more likely to deceive the public than to inform it” *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 563-564 (1980). As a result, “[f]alse, deceptive, or misleading advertising” is “subject to restraint.” *In re R.M.J.*, 455 U.S. 191, 200 (1982). *See also Ibanez v. Florida Dep’t of Bus. & Pro. Regul.*, 512 U.S. 136, 142 (1994) (“[F]alse, deceptive, or misleading commercial speech may be banned.”).

Trademark law includes fair use defenses to ensure that trademark law does not unduly burden free speech. For example, the statutory fair use defense permits would-be infringers to use descriptive terms to describe their own goods and services, even if those terms are registered by others. *See* 15 U.S.C. § 1115(b)(4). The statutory fair use defense provides a complete defense to infringement even where the plaintiff has proven that “some degree of confusion” is likely to result from the defendant’s use. *KP*

Permanent Make-Up, Inc. v. Lasting Impression I, Inc., 543 U.S. 111, 123-124 (2004).

And the nominative fair use defense permits use of a trademark to refer to another brand owner's goods or services in some circumstances, such as an advertiser comparing its products to those of a competitor. *See New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992) (“[N]ominative use of a mark—where the only word reasonably available to describe a particular thing is pressed into service—lies outside the strictures of trademark law: Because it does not implicate the source-identification function that is the purpose of trademark, it does not constitute unfair competition; such use is fair because it does not imply sponsorship or endorsement by the trademark holder.”). This defense is premised on the “serious First Amendment concerns” that enjoining such use of another's trademark might “interfere with truthful communication between buyers and sellers in the marketplace.” *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1176 (9th Cir. 2010).

Another example of accommodating free speech rights is *Rogers v. Grimaldi*, 875 F.2d 994 (2d Cir. 1989), and its progeny. The *Rogers* cases hold that a heightened threshold for trademark infringement is necessary to balance the First Amendment rights of authors to title their works, and the trademark rights of brand owners. *Rogers*, 875 F.2d at 998. Weighing in on use of a person's name in a movie title, the Second Circuit held that the titles of artistic works do not infringe trademark rights “unless the title has no artistic relevance to the underlying work whatsoever, or, if it has some artistic relevance, unless the title

explicitly misleads as to the source or the content of the work.” *Id.* Recently, in *Jack Daniel’s Properties Inc.*, 143 S. Ct. at 1587, the Court expressly refrained from ruling on the validity of the *Rogers* test, but acknowledged they have “confined it “to similar cases, in which a trademark is used not to designate a work’s source, but solely to perform other expressive functions.” *Id.* at 1587.

Thus, when viewed in the context of the entire Lanham Act and the jurisprudence on the intersection of the statute with free speech rights, the benefits of federal registration are structured and have consistently been construed to be tempered by the First Amendment right to use marks in the free flow of ideas and expression.

C. Section 2(c) Does Not Restrict Speech Because Registration is Not Required to Acquire Trademark Rights or to Speak.

“Registration of a mark is not mandatory. The owner of an unregistered mark may still use it in commerce and enforce it against infringers.” *See Iancu v. Brunetti*, 139 S. Ct. at 2297. Indeed, Section 43(a), 15 U.S.C. § 1125(a), of the Lanham Act creates a federal cause of action for trademark infringement of unregistered trademarks. *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) (“Section 43(a) prohibits a broader range of practices than does § 32, which applies to registered marks, but it is common ground that § 43(a) protects qualifying unregistered trademarks”) (internal quotation marks and citation omitted). Moreover, “an unregistered trademark can be enforced under state common law, or if it has been registered in a State, under that

State’s registration system.” *Matal v. Tam*, 582 U.S. at 226.

Without any registration requirement, trademark rights flow from use of a trademark in commerce as a source identifier. *See* 3 MCCARTHY § 19:3. Therefore, “failure to successfully register does not disturb existing state or federal unregistered rights in a mark.” *Id.*; *see also Brunetti*, 139 S. Ct., at 2303 (“Whether . . . marks can be registered does not affect the extent to which their owners may use them in commerce to identify goods.”) (Roberts, C.J., concurring in part, dissenting in part).

Because refusal of registration does not impact whether or how a trademark can be used, the Lanham Act’s statutory bars on registration have a minimal, if any, effect on speech. This is because “[n]o speech is being restricted; no one is being punished.” *Id.* Thus, Section 2(c) of the Lanham Act does not restrict speech because mark owners enjoy complete freedom to *use* marks that contain the name of a living person without that person’s consent (subject of course to the risk of suit by the person); owners of such marks are “merely denied certain additional benefits associated with federal trademark registration.”³ *Id.* Because Section 2(c) does not restrict speech, it should not be subjected to heightened scrutiny under the First Amendment.

³ Indeed, in this case, rather than filing an ITU application signifying his future intention to use TRUMP TOO SMALL as a source identifier for apparel, Respondent could have commenced use of the mark, thereby building up common law rights (if applicable) based on his actual use of the mark in commerce.

II. SECTION 2(C) IS VIEWPOINT NEUTRAL AND SHOULD NOT BE SUBJECT TO HEIGHTENED SCRUTINY.

First Amendment law employs complex “tiers of scrutiny.” To resolve the question presented, the Court should identify the appropriate level of scrutiny to apply to Section 2(c).

Viewpoint-based laws are generally subject to strict scrutiny. *Reed v. Town of Gilbert*, 576 U.S. 155, 159 (2015). Viewpoint discrimination is a particularly egregious form of content discrimination. *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995). Under strict scrutiny, Courts tend to strike down viewpoint-based laws. *Reed v. Town of Gilbert*, 576 U.S., at 163 (stating that viewpoint-based laws are analyzed under and strict scrutiny and are “presumptively unconstitutional”).

In contrast, viewpoint-neutral laws qualify for significantly less rigorous levels of review and are often upheld. *See, e.g., Ward v. Rock Against Racism*, 491 U.S. 781, 798 (1989) (holding that content-neutral laws must be narrowly tailored to serve a legitimate government interest, but it need not be the least restrictive means of serving the interest).

However, heightened scrutiny is not required where “the regulation does not in fact regulate expression in any sense known to violate First Amendment law. 1 R. Smolla & M. Nimmer, *Freedom of Speech* § 2:64 (3d ed. 2023) (collecting cases and explaining the tiers of scrutiny).

A. Section 2(c) is Viewpoint Neutral and Strict Scrutiny is Unwarranted.

“The principal inquiry in determining content neutrality . . . is whether the government has adopted a regulation of speech because of disagreement with the message it conveys.” *Ward v. Rock Against Racism*, 491 U.S., at 791; *Reed v. Town of Gilbert*, 576 U.S., at 163. “A regulation that serves purposes unrelated to the content of expression is deemed neutral, even if it has an incidental effect on some speakers or messages but not others.” *Ward v. Rock Against Racism*, 491 U.S. at 791. Laws that “confer benefits or impose burdens on speech without reference to the ideas or views expressed are in most instances content neutral.” *Turner Broad. Sys., Inc. v. F.C.C.*, 512 U.S. 622, 643 (1994).

Section 2(c) is not viewpoint based because it is agnostic to the message conveyed or the view expressed. Congress did not enact Section 2(c) to limit criticism of public figures. The purpose of the statute is to harmonize trademark law with a person’s right of privacy and publicity. *University of Notre Dame Du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1376, n. 8 (recognizing the link between Section 2(c) and the right to privacy); *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 539 (1987) (recognizing the importance of preventing source deception through misuse of the “Olympic” mark).

Trademark examiners at the USPTO are directed to invoke Section 2(c) regardless whether the mark or phrase in a trademark application is political, religious, or ideological, and regardless whether the

mark or slogan contains criticism or praise. For example, Section 2(c) would bar registration regardless of the mark was REPUBLICANS FOR TRUMP, JESUS FOR TRUMP, or DEMOCRACY FOR TRUMP. And a person seeking a trademark on TRUMP TOO HANDSOME just as it bars TRUMP TOO SMALL.

To conclude that Section 2(c) is viewpoint neutral is consistent with the Court's precedents. *See City of Austin v. Reagan Nat'l Advert. of Austin, LLC*, 596 U.S. ___, 142 S. Ct. 1464, 1472 (2022) (A regulation that prohibited increasing the degree of nonconformity of any off-premises advertisements was content neutral because it did not have discriminatory classifications for specific kinds of messages.). *Hill v. Colorado*, 530 U.S. 703, 719–720 (2000) (ordinance that prohibited all protests around abortion clinics was content neutral because the government applied it to all protests regardless of their message); *but see Boos v. Barry*, 485 U.S. 312, 321 (1988) (law prohibiting the display of signs that criticized foreign governments within a certain distance of embassies was content-based).

B. This Case Is Distinguishable from *Tam* and *Brunetti*.

Section 2(c) is fundamentally different from the restrictions on registration that were presented in *Tam* and *Brunetti*. In *Tam*, the Court determined the disparagement provision was viewpoint discriminatory because this clause involved analyzing if a trademark would give offense. *Matal v. Tam*, 582 U.S. 218, 243 (2017). “Giving offense is a viewpoint.” *Id.* In *Brunetti*, the Court determined the immoral or

scandalous bar to a trademark in Section 2(a) was viewpoint based because government disapproval of offensive messages is viewpoint discrimination. *Brunetti*, 139 S. Ct. at 2299. Section 2(c), however, is easily distinguishable from *Tam* and *Brunetti* because it applies without regard to all viewpoints, including TRUMP TOO HANDSOME and TRUMP TOO SMALL. The court need not apply heightened scrutiny as it did in *Tam* and *Brunetti*.

Because Section 2(c) of the Lanham Act is a viewpoint neutral law and does not restrict speech, the Court can find that it only needs to have a “reasonable” basis to survive the present challenge.

C. At Most, the Court Should Apply Intermediate Scrutiny to Evaluate the Constitutionality of Section 2(c).

Despite the reasons that heightened scrutiny may not be necessary in this case, if the Court does conclude that some heightened scrutiny is appropriate, it should be no higher than intermediate scrutiny.

Although the Court in *Tam* declined to determine if trademarks were commercial speech, *Tam*, 582 U.S. at 245, previous Court decisions have held indicated that trademarks are indeed commercial speech. *See, e.g., San Francisco Arts & Athletics, Inc.*, 483 U.S. at 535 (1987) (stating that a statute protecting the “Olympic” mark applies to commercial speech and commercial speech “receives a limited form of First Amendment protection”) (citation omitted); *Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (observing that trade name protections involve “a form of commercial speech and nothing more”). The Constitution affords

“a lesser protection to commercial speech than to other constitutionally guaranteed expression.” *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 562-563 (1980). Commercial speech, the offspring of economic self-interest, is a hardy breed of expression that is not particularly susceptible to being crushed by regulation. *Id.* at 564 n. 6.

III. SECTION 2(C) SERVES SUBSTANTIAL INTERESTS.

Regardless of the level of scrutiny applied to Section 2(c), the statute serves several important government interests, and should be upheld.

A. Section 2(c) Protects the Rights of Publicity and Privacy, Which Have Already Been Held to be Substantial Government Interests.

In *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 566 (1977), this Court rejected the argument that the First Amendment immunized a broadcaster from damages for violating plaintiff’s state law right of publicity as part of a newscast. The Court explained that “the State’s interest in permitting a ‘right of publicity’ is in protecting the proprietary interest of the individual in his act in part to encourage such entertainment.” *Id.* at 573. To be sure, the narrow issue there was whether the news organization was entitled to broadcast the performer’s entire act without compensation (not whether it could report on the performance at all and not the bare use of his name). But the Court held that:

Ohio’s decision to protect petitioner’s right of publicity here rests on more than a desire to

compensate the performer for the time and effort invested in his act; the protection provides an economic incentive for him to make the investment required to produce a performance of interest to the public. This same consideration underlies the patent and copyright laws long enforced by this Court.

Id. at 576. The Court went on to note that:

“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.' Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.”

Id. (quoting *Mazer v. Stein*, 347 U.S. 201, 219 (1954)).

The same philosophy animates the Lanham Act. In *San Francisco Arts and Athletics v. United States Olympic Committee*, 483 U.S. 522, 531 (1987), this Court recognized that “[n]ational protection of trademarks is desirable . . . because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of good reputation.” (quoting *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985)). In the Lanham Act, 15 U.S.C. § 1051 *et seq.*, Congress established a system for protecting such trademarks.”

In *San Francisco Arts and Athletics*, the United States Olympic Committee sought to enjoin a nonprofit's use of the term "Gay Olympic Games" to promote an athletic event. As acknowledged here by

the Federal Circuit, *In re Elster*, 26 F.4th 1328, 1336 (Fed. Cir. 2022), the Court in *San Francisco Arts and Athletics* held that it was valid for Congress to determine that these “unauthorized uses, even if not confusing, nevertheless may harm the USOC by lessening the distinctiveness and thus the commercial value of the mark,” such that the statute was consistent with the First Amendment. *San Francisco Arts & Athletics*, 483 U.S. at 539-41.

“[A]ll states recognize some aspect of the right of privacy, either at common law or by statute.” J. Thomas McCarthy & R. Schechter, *RIGHTS OF PUBLICITY AND PRIVACY* § 1:2 (2023). Moreover, [o]ver 30 states recognize a right of publicity for living persons, either at common law or by statute. *Id.* Thus, in enacting Section 2(c), Congress has a substantial interest in safeguarding these important state rights, just as this Court recognized in 1977 in *Zacchini*.

The Federal Circuit here based its conclusion that there was no compelling state interest in protecting the right of publicity on two main premises. The first was that no “claim is made here that President Trump's name is being misappropriated in a manner that exploits his commercial interests or dilutes the commercial value of his name, an existing trademark, or some other form of intellectual property.” *Elster*, 26 F.4th at 1336.

The basis for this first assumption is plainly incorrect. As this Court recently acknowledged in *Jack Daniels Properties, Inc. v. VIP Products, LLC*, 143 S. Ct. 1578, 1583 (2023), the very purpose of claiming trademark rights is principally commercial

to identify source of origin. The Court thus declined even to reach the accused infringer's First Amendment defense (under *Rogers v. Grimaldi*, 875 F. 2d 994 (2d Cir. 1989)), *because the* defendant claimed the accused use was a trademark itself. Said the Court: "Without deciding whether Rogers has merit in other contexts, we hold that it does not when an alleged infringer uses a trademark in the way the Lanham Act most cares about: as a designation of source for the infringer's own goods." *Jack Daniel's Props.*, 143 S. Ct. at 1587. The Court went on: "When, instead, the use is 'at least in part' for 'source identification'—when the defendant may be 'trading on the good will of the trademark owner to market its own goods'—*Rogers* has no proper role." *Jack Daniels Props.*, 143 S. Ct. at 1589 (citation omitted).

Not only is Mr. Elster claiming exclusive rights to use of the term "Trump Too Small" as a source designation, if he simply wanted to engage in political speech, he would not need to claim trademark rights, much less seek registration. Indeed, although the Federal Circuit held that "[t]he 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," *Elster*, 26 F.4th at 1337, the case at hand entails no restriction whatsoever on Mr. Elster's use of the claimed mark; rather, it merely precludes him from preemptively staking a claim to the *exclusive* right to use the mark sometime in the future. He can still use the mark as an unregistered trademark, or in non-trademark ways such as decoratively on apparel, or on a political advocacy website.

The Federal Circuit also made unwarranted assumptions (unsupported by the record) as to how Mr. Elster might someday use the slogan “Trump Too Small.” Because Mr. Elster filed merely an intent to use application, supported by no evidence of actual use, the record simply does not permit any conclusions as to how he might someday use the phrase.

The second basis for the Federal Circuit decision entailed distinguishing *Zacchini*, where (the Federal Circuit argued) “[t]he government, in protecting the right of publicity, also has an interest in preventing the issuance of marks that falsely suggest that an individual, including the President, has endorsed a particular product or service.” *Elster*, 26 F.4th at 1336. However, the court said the “situation here” was unlike *Zacchini* because “[n]o plausible claim could be or has been made that the disputed mark suggests that President Trump has endorsed Elster's product.” *Id.*

However, laying aside that the Federal Circuit again made assumptions outside the record as to how Mr. Elster might someday use TRUMP TO SMALL in commerce, the right of publicity is not so-limited. For example, the Restatement (Second) of Torts § 652(C)(b) (Am. L. Inst. 1977), identifies the elements as follows (with no mention of false endorsement): “The common form of invasion of privacy under the rule here stated is the appropriation and use of the plaintiff's name or likeness to advertise the defendant's business or product, or for some similar commercial purpose.” False endorsement is not an element of the tort. Although some right of publicity cases also involve false endorsement claims, many do

not. Indeed, the cases cited by the Federal Circuit, *Elster*, 26 F.4th at 1337-1338, acknowledge this fact. See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 967 (10th Cir. 1996) (“Although publicity rights are related to laws preventing false endorsement, they offer substantially broader protection.”); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 25 Cal. 4th 387, 394, 21 P.3d 797, 801 (2001) (the lithographs and T-shirts at issue in this case “did not constitute an advertisement, endorsement, or sponsorship of any product,” and the balancing First Amendment interests versus right of publicity favored the private right and the consent of the owner); *Titan Sports, Inc. v. Comics World Corp.*, 870 F.2d 85, 88 (2d Cir. 1989) (“While one who is a public figure or is presently newsworthy may be the proper subject of news or informative presentation, the privilege does not extend to commercialization of his personality through a form of treatment distinct from the dissemination of news or information.”) (citation omitted).

Equally (if not more) important, these cases all involved threatened injunctions against actual use in commerce, not mere registration—much less an application for registration based only on a bare claim of intent to use the mark sometime in the future. The highly fact specific nature of assessing false endorsement is absent in the case of Mr. Elster, who has done nothing more than announce his intent to use the phrase “Trump Too Small,” without any indication of how he may do that.

To the extent any such false endorsement issues arise in the context of trademark examinations in the

USPTO, the Federal Circuit held that interests such as Mr. Trump’s would be protected adequately in the registration process by Section 2(a) which bars registration of subject matter that “falsely suggest a connection with persons, living or dead.” However, the suggestion that Congress included Section 2(c) in a manner entirely duplicative of Section 2(a) would violate basic rules of statutory interpretation. *See, e.g., Bailey v. United States*, 516 U.S. 137, 146 (1995) (“We assume that Congress used two terms because it intended each term to have a particular, nonsuperfluous meaning.”)

In furtherance of supporting rights of publicity, Section 2(c) creates a system for preventing unauthorized uses of individual names. Without that system, public and newsworthy figures—including like Sully Sullenberger, Jane Goodall, or the Justices of this Court—would have to monitor the USPTO to determine if an opportunist is claiming the exclusive right to use in commerce his or her name.

B. Section 2(c) Furthers Government Interests in Promoting Consistency in the Trademark Application Examination.

As discussed *supra*, Section 2(c) is viewpoint neutral. Regardless of the content or meaning of the applicant’s mark (*e.g.*, whether it supports or criticizes any particular political viewpoint), if it has a living person’s name in it, then the person’s authorization is required for registration. If the Federal Circuit decision is affirmed, however, then Examiners would need to make difficult and subjective determinations about the applicant’s intent and whether the applied-for mark contains

political speech or concerns a matter of public importance. Those determinations are inherently nuanced, subjective and require information not currently collected in the trademark application process. By converting the Section 2(c) examination from a viewpoint neutral to viewpoint dependent determination, Examining Attorneys would be forced to make difficult and often subjective determinations that would lead to inconsistent and unpredictable applications of the law. This is contrary to the government's substantial interests in having predictable and non-arbitrary examinations. *See, e.g., Iancu v. Brunetti*, 139 S. Ct. 2294, 2300-2301 (2019) (providing examples of inconsistent applications of bar on registration of scandalous and immoral marks). Maintaining consistent, workable and predictable trademark examinations is an important state interest.

This important state interest of removing highly subjective determinations from the examination procedure is consistent with INTA's amicus positions in *Tam* and *Brunetti*. In those cases, INTA supported striking down the viewpoint discriminatory restrictions that prohibited the registration of disparaging, immoral or scandalous marks. In those cases, among other arguments, INTA argued that the subjective nature of determining whether marks are immoral, for example, is too subjective and leads to unpredictable and arbitrary outcomes for applicants. This unpredictability increases costs and creates uneven results.

C. Section 2(c) Does Not Burden Speech More Than Necessary.

The second prong of intermediate scrutiny asks whether the law substantially burdens “more speech than is necessary to further the government’s legitimate interests.” *Packingham v. North Carolina*, 582 U.S. 98, 112 (2017) (Alito, J., concurring) (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 798-799 (1989)) (citing *McCullen v. Coakley*, 573 U. S. 464, 486 (2014)). Like other viewpoint neutral restrictions on trademark registrations, Section 2(c) refusals permit more speech, not less. That is because the Federal trademark registration system grants a limited monopoly in a term, phrase, logo, or other source identifiers. Allowing registrants to obtain that limited monopoly for marks that contain individuals’ names without their permission will have the opposite effect of empowering such registrants to chill political or other important speech. For example, if Mr. Elster had exclusive trademark rights in TRUMP TOO SMALL for apparel, then others who seek to make similar political speech by using the phrases TRUMP TOO BIG or BIDEN TOO SMALL on apparel would be subject to a colorable threat of liability under the Lanham Act. Indeed, a primary purpose of the trademark registry is to provide third parties with notice of what speech may infringe the trademarks of others.

IV. APPLYING HEIGHTENED SCRUTINY TO SECTION 2(C) WOULD SUBJECT OTHER VIEWPOINT NEUTRAL RESTRICTIONS VULNERABLE TO CONSTITUTIONAL ATTACK

Even though this is an as-applied constitutional challenge, the Federal Circuit left open the possibility that the Section 2(c) is overboard on its face. *Elster*, 26 F.4th at 1339. Subjecting Section 2(c) to strict scrutiny on its face, opens the door to constitutional challenges of other important viewpoint neutral restrictions to registration that are found in Section 2. The Lanham Act directs the USPTO to “refuse[] registration” of, among others, marks that are deceptive, Section 2(a); marks containing a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, Section 2(b); marks that so resemble other marks that they are likely to cause confusion, Section 2(d); and marks that are merely descriptive, Section 2(e)(1). Each of these serve important government interests of preventing the grant of exclusive rights and preventing consumer confusion or even deception. If these provisions are subject to heightened scrutiny, especially when the marks contain political speech, then they become vulnerable to Constitutional attack. That would cast a dark cloud of doubt over the federal trademark registry that its past practice would be radically upended.

CONCLUSION

For the reasons stated above, Section 2(c) as applied and on its face, is not an unconstitutional restriction of speech. Accordingly, INTA urges this Court to reverse the Federal Circuit’s ruling and

reinstate the TTAB finding that Mr. Elster's application should be refused in accordance with Section 2(c).

Respectfully submitted,

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