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 Writ of Certiorari to the United States Courts of Appeals for the Federal Circuit

BRIEF OF *AMICI CURIAE* FOUNDATION FOR INDIVIDUAL RIGHTS AND EXPRESSION AND MANHATTAN INSTITUTE IN SUPPORT OF RESPONDENT

JT MORRIS
FOUNDATION FOR INDIVIDUAL RIGHTS AND EXPRESSION
700 Pennsylvania Ave., SE
Suite 340
Washington, D.C. 20003

ILYA SHAPIRO
MANHATTAN INSTITUTE
52 Vanderbilt Ave.
New York, NY 20017

CHRISTOPHER G. MICHEL
Counsel of Record
ALEX VAN DYKE
QUINN EMANUEL URQUHART & SULLIVAN, LLP
1300 I Street, N.W.
Suite 900
Washington, D.C. 20005
(202) 538-8000
christophermichel@quinnemanuel.com

TODD ANTEN
JESSICA A. ROSE
QUINN EMANUEL URQUHART & SULLIVAN, LLP
51 Madison Avenue, 22nd Fl.
New York, NY 10010

Counsel for Amici Curiae

QUESTION PRESENTED

Section 1052(c) of Title 15 provides in pertinent part that a trademark shall be refused registration if it "[c]onsists of or comprises a name * * * identifying a particular living individual except by his written consent." 15 U.S.C. 1052(c). The question presented is as follows:

Whether the refusal to register a mark under Section 1052(c) violates the Free Speech Clause of the First Amendment when the mark contains criticism of a government official or public figure.

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

INTEREST OF *AMICI CURIAE* 1

INTRODUCTION AND SUMMARY OF ARGUMENT.....2

ARGUMENT 5

I. The First Amendment Prohibits De Facto And De Jure Viewpoint Discrimination.....7

II. Section 1052(c)'s Consent Requirement Causes De Facto Viewpoint Discrimination Because It Disfavors Critical Trademarks.....9

III. Section 1052(c)'s Viewpoint Discrimination Creates Serious First Amendment Harms 14

CONCLUSION.....19

ADDENDUM.....1a

TABLE OF AUTHORITIES

Page(s)

Cases

Animal Legal Defense Fund v. Kelly,
9 F.4th 1219 (10th Cir. 2021) 8

Ariz. Free Enter. Club's Freedom Club PAC v. Bennett,
564 U.S. 721 (2011).....13

Bridges v. California,
314 U.S. 252 (1941).....15

Cardtoons, L.C. v. Major League Baseball Players Ass'n,
95 F.3d 959 (10th Cir. 1996).....10

Cohen v. California,
403 U.S. 15 (1971).....10

Counterman v. Colorado,
143 S. Ct. 2106 (2023).....17

Cox v. Louisiana,
379 U.S. 536 (1965).....16

FEC v. Cruz,
142 S. Ct. 1638 (2022).....13

First Nat. Bank of Boston v. Bellotti,
435 U.S. 765 (1978).....9

Gertz v. Robert Welch, Inc.,
418 U.S. 323 (1974).....4, 16

Iancu v. Brunetti,
139 S. Ct. 2294 (2019).....2, 3, 6, 7, 8, 14, 16

Jack Daniel's Props., Inc. v. VIP Prods. LLC,
599 U.S. 140 (2023).....4, 10, 17

Major League Baseball Players Ass'n v. Chisena,
2023 WL 2986321 (T.T.A.B. Apr. 12, 2023).....18

Matal v. Tam,
582 U.S. 218 (2017).....2, 3, 5, 6, 8, 14, 16–18

McCullen v. Coakley,
573 U.S. 464 (2014).....9

N.Y. Times Co. v. Sullivan,
376 U.S. 254, 280 (1964).....17

In Re Nieves & Nieves LLC,
113 U.S.P.Q.2d 1629 (T.T.A.B. 2015).....14, 18

Perry Ed. Assn. v. Perry Local Educators' Assn.,
460 U.S. 37 (1983).....7

R.A.V. v. City of St. Paul,
505 U.S. 377 (1992).....2, 8, 9

Reed v. Town of Gilbert,
576 U.S. 155 (2015).....9

Rosenberger v. Rector & Visitors of Univ. of Va.,
515 U.S. 819 (1995).....7

Rust v. Sullivan,
500 U.S. 173 (1991).....6

Shurtleff v. City of Boston,
142 S. Ct. 1583 (2022).....7

Sorrell v. IMS Health Inc.,
564 U.S. 552 (2011).....2, 9

Speech First, Inc. v. Sands,
69 F.4th 184 (4th Cir. 2023).....2, 8

Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.,
703 F.2d 1372 (Fed. Cir. 1983).....15

Upper Skagit Indian Tribe v. Lundgren,
138 S. Ct. 1649 (2018).....6

Watson v. City of Memphis,
373 U.S. 526 (1963).....16

Yee v. City of Escondido,
503 U.S. 519 (1992).....7

Constitutional Provisions and Statutes

U.S. Const. Amend. I 7

15 U.S.C. § 1052(a).....3, 8, 13, 17

15 U.S.C. § 1052(c) 1–7, 10, 11, 13–19

15 U.S.C. § 1052(d).....3, 13, 18

Other Authorities

Forbes, *The Ten Most Valuable Trademarks* (June 15, 2011), bit.ly/44GbVHq 5

Google, *From the garage to the Googleplex*, bit.ly/460skIa 5

Samuel F. Ernst, *Trump Really Is Too Small: The Right to Trademark Political Commentary*, 88 BROOK. L. REV. 839, 869 (2023) 18

William Shakespeare, *Romeo and Juliet* 5

INTEREST OF *AMICI CURIAE*[*]

The Foundation for Individual Rights and Expression (FIRE) is a nonpartisan, nonprofit organization. FIRE's mission is to defend the rights of all Americans to free speech and free thought—the most essential qualities of liberty. Since 1999, FIRE has successfully defended expressive rights through public advocacy, targeted litigation, and *amicus curiae* participation, including challenges to content- and viewpoint-based laws and policies. FIRE has filed *amicus* briefs in this Court in cases involving the First Amendment's protection of trademarks and the viewpoint-discriminatory nature of statutory consent provisions. *See, e.g.*, *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 599 U.S. 140 (2023); *Mazo v. Way*, No. 22-1033.

The Manhattan Institute is a nonprofit public policy research foundation whose mission is to develop and disseminate new ideas that foster economic choice and individual responsibility. To that end, it has historically sponsored scholarship supporting the rule of law and opposing government overreach, including in the marketplace of ideas.

The statutory provision at issue in this case, 15 U.S.C. § 1052(c), implicates the First Amendment's protection of free speech and contains a viewpoint-discriminatory consent provision. *Amici* urge the Court to hold that the provision is unconstitutional.

---

[*] Pursuant to Rule 37.6, *amici* affirm that no counsel for a party authored this brief in whole or in part, and that no person other than *amici* or its counsel contributed money intended to fund preparing or submitting this brief.

INTRODUCTION AND SUMMARY OF ARGUMENT

This Court has twice recently held that statutory provisions barring trademark registration based on viewpoint-based criteria violate the First Amendment. *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Matal v. Tam*, 582 U.S. 218 (2017). The bar at issue in this case, 15 U.S.C. § 1052(c), suffers the same infirmity. By precluding the registration of trademarks that contain (among other things) a living person's name—*except by his written consent*—Section 1052(c) effectively favors speech that flatters or praises a named person while disfavoring speech that criticizes or parodies that person. Section 1052(c) accordingly operates as the kind of "happy-talk clause" that this Court has previously invalidated as impermissible viewpoint discrimination. *Tam*, 582 U.S. at 246 (opinion of Alito, J.). This Court can affirm the decision below on that same straightforward basis.

To be sure, the viewpoint discrimination in Section 1052(c) arises from the provision's "practical operation," rather than its text alone. *R.A.V. v. City of St. Paul*, 505 U.S. 377, 391 (1992). But this Court has never held that such a distinction makes a difference. *Id.*; *see Sorrell v. IMS Health Inc.*, 564 U.S. 552, 571 (2011). Viewpoint discrimination "can be *de facto* as well as *de jure*." *Speech First, Inc. v. Sands*, 69 F.4th 184, 221 (4th Cir. 2023) (Wilkinson, J., dissenting).

The facts of this case illustrate Section 1052(c)'s viewpoint-discriminatory effect. Respondent Elster sought to register the trademark TRUMP TOO SMALL—intended as irreverent political criticism of the

former President—for use on t-shirts.[1] Pet. App. 2a. Applying Section 1052(c), the U.S. Patent and Trademark Office (USPTO) rejected registration of that mark because former President Trump did not consent. Yet dozens of trademarks using the former President's name *favorably* have been registered with his consent. *See* Addendum, *infra*, 2a–5a. Section 1052(c) thus does precisely what this Court has held a trademark-registration bar may not: it "allows registration of marks when their messages accord with, but not when their messages defy" a given viewpoint. *Brunetti*, 139 S. Ct. at 2300.

Indeed, favoring positive rather than negative messages about a named person is Section 1052(c)'s *only* meaningful function. Other provisions of the Lanham Act independently ensure that trademarks creating a false association with a named person or deception as to a product's source cannot be registered. *See* 15 U.S.C. § 1052(a), (d). All that Section 1052(c) does is equip named persons with the unilateral power to veto the registration of trademarks that they dislike. That "is the essence of viewpoint discrimination." *Tam*, 582 U.S. at 249 (Kennedy, J., concurring in part and concurring in the judgment).

In some ways, Section 1052(c)'s viewpoint-discriminatory effect is even more troubling than that of the provisions struck down in *Tam* and *Brunetti*. As a practical matter, Section 1052(c) applies almost exclusively to public figures, the only people who will be

---

[1] All references to trademarks in this brief appear in small-cap font. Registrations and applications referred to in this brief and the Addendum are available by searching the U.S. Patent and Trademark Office database, http://tmsearch.uspto.gov.

identifiable based on the use of their names in a registered trademark. The provision thus confers heightened protection against criticism on those with the greatest capacity to respond—precisely the opposite of the usual First Amendment rule. *See, e.g.*, *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 342 (1974).

Section 1052(c), moreover, vests the power to veto disfavored trademarks in a *single person*—unlike the provisions in *Tam* and *Brunetti*, which were predicated on objections from the referenced group or society at large. And allowing self-interested individuals to veto trademarks they dislike while approving those they prefer does nothing to further the Lanham Act's "basic purpose" of helping consumers "identify and distinguish goods." *Jack Daniel's Props., Inc. v. VIP Prod. LLC*, 599 U.S. 140, 146 (2023) (citation omitted). Section 1052(c)'s consent provision is a tool for reputation management, not source identification.

Invalidating Section 1052(c) based on viewpoint discrimination would unify rather than destabilize this Court's First Amendment and trademark precedents. In virtually any other context, it would be unthinkable for Congress to favor speech only if the subject of the speech approves. "If you don't have something nice to say, don't say anything at all" may be good advice for making friends. But as this Court made clear in *Tam* and *Brunetti*, that principle cannot govern trademark registration. This Court should confirm the fundamental rule against viewpoint discrimination in this area for a third time by affirming the decision below.

ARGUMENT

"What's in a name?"[2] Potentially $44.3 billion.[3] That which we call GOOGLE by any other name would not be as valuable. In addition to identifying the source of its products, the company's trademark conveys key "expressive content"—specifically, "a message" about the vast range of information available through its search engine.[4] *Tam*, 582 U.S. at 239. Such trademarks are everywhere. Sometimes their messages are so obvious that they are easy to miss: BURGER KING sells burgers, not paddleboards. And sometimes their messages are more powerfully expressive: JUST DO IT; MAKE AMERICA GREAT AGAIN. Trademarks thus fall squarely within the First Amendment's ambit. *See id.*

In this case, the Federal Circuit held that the USPTO violated the First Amendment when it declined to register the trademark TRUMP TOO SMALL under 15 U.S.C. § 1052(c), which bars registration of a trademark that "[c]onsists of ... a name ... identifying a particular living individual except by his written consent." As it did in *Tam* and *Brunetti*, the Government asks this Court to reverse on the ground that declining to register a trademark does not restrict speech but merely denies the applicant a government

---

[2] William Shakespeare, *Romeo and Juliet* act 2, sc. 2.

[3] Forbes, *The Ten Most Valuable Trademarks* (June 15, 2011), bit.ly/44GbVHq.

[4] The name Google is "a play on the mathematical expression for the number 1 followed by 100 zeros [googol] and aptly reflected [Google's founders'] mission 'to organize the world's information and make it universally accessible and useful.'" Google, *From the garage to the Googleplex*, bit.ly/460skIa.

benefit. The third time is not the charm for that strained position. As persuasively explained by Respondent here, and by four Justices in *Tam*, trademark registration is "nothing like" the monetary subsidies or other benefits that the Government claims are analogous. *Tam*, 582 U.S. at 240 (opinion of Alito, J.); *see* Resp. Br. 41–45. And given the broad flexibility that the Government has to define the scope of federal benefit programs, *see, e.g.*, *Rust v. Sullivan*, 500 U.S. 173, 192–95 (1991), treating trademark registration as the equivalent of a subsidy would vest the Government with a dangerous degree of discretion over ideas and expression, *see Tam*, 582 U.S. at 241 (opinion of Alito, J.).

As in *Tam* and *Brunetti*, however, this Court need not grapple with the "notoriously tricky question of constitutional law" presented by the Government's argument. *Tam*, 582 U.S. at 239 (opinion of Alito, J.); *see Brunetti*, 139 S. Ct. at 2298–99. The Court can instead affirm the Federal Circuit's decision striking down Section 1052(c) on another ground: "[i]t too disfavors certain ideas." *Brunetti*, 139 S. Ct. at 2297. Because Section 1052(c)'s "trademark registration bar is viewpoint-based, it is unconstitutional" under the same principles that this Court applied in *Tam* and *Brunetti*. *Id.* at 2299.[5]

---

[5] Although the Federal Circuit did not rely on viewpoint discrimination in striking down Section 1052(c), this Court has "discretion to affirm on any ground supported by the law and the record that will not expand the relief granted below." *Upper Skagit Indian Tribe v. Lundgren*, 138 S. Ct. 1649, 1654 (2018). Because Respondent has squarely raised the claim that Section 1052(c) violates the First Amendment, other arguments in support of that claim—including that Section 1052(c) embodies

I. The First Amendment Prohibits De Facto And De Jure Viewpoint Discrimination

The First Amendment provides that "Congress shall make no law ... abridging the freedom of speech." The most "blatant" and "egregious" way in which the government violates that prohibition is by discriminating against private speech because of the viewpoint it espouses. *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995). Indeed, "[v]iewpoint discrimination is censorship in its purest form." *Perry Ed. Assn. v. Perry Local Educators' Assn.*, 460 U.S. 37, 62 (1983) (Brennan, J., dissenting). It is accordingly a "core postulate of free speech law" that the "government may not discriminate against speech based on the ideas or opinions that it conveys." *Brunetti*, 139 S. Ct. at 2299; *see Shurtleff v. City of Boston*, 142 S. Ct. 1583, 1587 (2022) ("When the government encourages diverse expression … the First Amendment prevents it from discriminating against speakers based on their viewpoint."); *Rosenberger*, 515 U.S. at 828 ("Discrimination against speech because of its message is presumed to be unconstitutional.").

This Court has addressed the intersection of the First Amendment's ban on viewpoint discrimination and trademark registration restrictions twice in the past six years. In *Tam*, the Court held that the Lanham Act provision prohibiting the registration of trademarks that "disparage ... or bring ... into

---

impermissible viewpoint discrimination—are properly before the Court. *See Yee v. City of Escondido*, 503 U.S. 519, 534–35 (1992); *see also* Resp. Br. 40–41 (discussing the viewpoint-discriminatory aspects of Section 1052(c)'s consent provision).

contempt[ ] or disrepute" any "persons, living or dead," 15 U.S.C. § 1052(a), impermissibly discriminated on the basis on viewpoint, *see Tam*, 582 U.S. at 239–43 (opinion of Alito, J.); *id.* at 247–54 (Kennedy, J., concurring in part and concurring in the judgment). In *Brunetti*, the Court held that a neighboring provision of the Lanham Act prohibiting the registration of "immoral" or "scandalous" trademarks, 15 U.S.C. § 1052(a), violated the First Amendment for the same reason, *see Brunetti*, 139 S. Ct. at 2297. The upshot of both opinions was thus clear: in the area of trademark registration, "[t]he government may not discriminate against speech based on the ideas or opinions it conveys." *Id.* at 2299.[6]

Often such viewpoint discrimination is apparent from the text of a law itself, as in *Tam* and *Brunetti*. But viewpoint discrimination can also arise from a statute's "practical operation." *R.A.V.*, 505 U.S. at 391. "[I]t can be *de facto* as well as *de jure*." *Speech First*, 69 F.4th at 221 (Wilkinson, J., dissenting); *see, e..g.*, *Animal Legal Defense Fund v. Kelly*, 9 F.4th 1219, 1232–33 (10th Cir. 2021) (invalidating a law because it was "viewpoint discriminatory in operation").

This Court has repeatedly recognized as much. In *R.A.V.*, for example, the Court struck down an ordinance that prohibited "'fighting words' that insult, or provoke violence, 'on the basis of race, color, creed, religion or gender,'" in part because "[i]n its practical

---

[6] The government can favor particular viewpoints when it is speaking for itself. *See Tam*, 582 U.S. at 234–35. But the Court has rejected the argument that trademark registration implicates government speech. *Id.* at 235–39.

operation … the ordinance goes even beyond mere content discrimination, to actual viewpoint discrimination." 505 U.S. at 391. Under the law, "[o]ne could hold up a sign saying, for example, that all 'anti-Catholic bigots' are misbegotten; but not that all 'papists' are, for that would insult and provoke violence 'on the basis of religion.'" *Id.* at 391–92; *see also Sorrell*, 564 U.S. at 571 (invalidating a law that was, "in practice, viewpoint discriminatory").

Elsewhere, too, the Court "ha[s] recognized that … subject-matter restrictions, even though viewpoint-neutral on their face, may 'suggest[ ] an attempt to give one side of a debatable public question an advantage in expressing its views to the people.'" *Reed v. Town of Gilbert*, 576 U.S. 155, 182 (2015) (Kagan, J., concurring in the judgment) (quoting *First Nat. Bank of Boston v. Bellotti,* 435 U.S. 765, 785 (1978)). Thus, even facially neutral laws may "have the intent or effect of favoring some ideas over others," and "[w]hen that is realistically possible … [the Court] insist[s] that the law pass the most demanding constitutional test." *Id.* at 182–83; *see, e.g.*, *McCullen v. Coakley*, 573 U.S. 464, 497 (2014) (Scalia J., concurring in the judgment) (concluding that an abortion clinic buffer-zone law was viewpoint-based because clinics could exclude speech hostile to abortion but allow for speech affirming abortion by its employees).

II. Section 1052(c)'s Consent Requirement Causes De Facto Viewpoint Discrimination Because It Disfavors Critical Trademarks

The text of Section 1052(c) alone does not discriminate against viewpoints in the way that the restrictions in *Tam* and *Brunetti* did. But its consent

requirement—which Congress enacted at the same time as the provisions invalidated in *Tam* and *Brunetti*—nonetheless violates the First Amendment by discriminating against certain viewpoints in effect.

Here's how. Under Section 1052(c), trademarks that flatter or promote a named person will often be registered by the USPTO because that named person will provide the statutorily required consent. For example, the trademarks TRUMP TOWER, SUCCESS BY TRUMP, and TRUMP ONE have been registered with former President Trump's consent. But proposed trademarks that criticize or mock a named person will far less often be registered by the USPTO because the named person will almost certainly not consent. For instance, the USPTO has denied applications to register the proposed marks DUMP TRUMP AND LOCK HIM UP, TRUMP CHUMP, and (here) TRUMP TOO SMALL.

Those results are the inevitable product of common sense and human nature. Empowered with "control over the parodic [or critical] use of their identities," it is only natural that most people would "use that power to suppress criticism." *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 975 (10th Cir. 1996); *cf. Jack Daniel's*, 599 U.S. at 153 ("[C]onsumers are not so likely to think that the maker of a mocked product is itself doing the mocking.").[7]

---

[7] Perhaps some idiosyncratic individuals (or those with a unique commitment to free speech) may consent to the registration of marks that use their name in a way that many would consider critical or negative. After all, "one man's vulgarity is another's lyric." *Cohen v. California*, 403 U.S. 15, 25 (1971). But that hypothetical exception does not disprove the rule that

Indeed, that is precisely how Section 1052(c) has operated. To take just one example, the following table compares trademarks that the USPTO has registered and has rejected using the name of former President Barack Obama.[8] The left column lists *all* the registered trademarks that use the former President's last name, and the right column lists just *some* of the marks that were rejected on Section 1052(c) grounds because they do the same:

Former President Barack Obama

Registered by USPTO	Rejected by USPTO (examples)
• INAUGURATION OF PRESIDENT AND VICE PRESIDENT 2009 OBAMA BIDEN • OBAMA FOUNDATION • THE BARACK OBAMA FOUNDATION	• ABO ANYBODY BUT OBAMA • BEAT OBAMA • DOES OBAMACARE? • GET OBAMA PACKIN' • IT'S OBAMA'S FAULT… • KNOWBAMA NOBAMA • OBAMA (DIDN'T) CARE • OBAMA PRESIDENCY SURVIVOR • OBAMA TRAUMA • OBAMA! I WANT MY COUNTRY BACK • OBAMA, YOU'RE FIRED!

Section 1052(c) favors (even if imperfectly) proposed marks that are positive.

[8] The lists of marks registered by the USPTO in this brief include marks that were subsequently cancelled.

Registered by USPTO	Rejected by USPTO (examples)
	• OBAMADONTCARE • OVERPASSES FOR OBAMA'S IMPEACHMENT • SWAP-O-BAMA • THIS COUNTRY BELONGS TO GOD NOT TO OBAMA • "WE WANTED CHANGE, NOW WE HAVE AN OBAMANATION" • WHEN OBAMA STARTS TALKIN HIS IQ STARTS DROPPIN

The difference is impossible to miss. In the left column are three registered trademarks that use the former President's name in a positive or neutral way; they communicate that former President Obama was inaugurated and does charity work. But there are no registered marks embodying critical uses of his name—and the right column shows that the dearth is not for a lack of applications. That pattern is hardly unique. An addendum to this brief contains similar tables comparing the registered and rejected uses of President Biden's and former President Trump's last names in trademarks.

By requiring the consent of a person named in a trademark as a precondition to registration, Section 1052(c) incorporates an inherent bias against critique and disproportionately burdens critical messages. And there is nothing partisan about the provision's

viewpoint discrimination. BIDEN TOO OLD would be rejected for the same reasons as TRUMP TOO SMALL, while BIDEN PRESIDENT has been registered (with his consent). That Section 1052(c) bars such core electoral messages is powerful evidence that it departs sharply from the First Amendment, which "has its fullest and most urgent application precisely to the conduct of campaigns for political office." *FEC v. Cruz*, 142 S. Ct. 1638, 1650 (2022) (citation omitted); *see, e.g.*, *Ariz. Free Enter. Club's Freedom Club PAC v. Bennett*, 564 U.S. 721, 755 (2011) ("'[T]here is practically universal agreement that a major purpose of' the First Amendment 'was to protect the free discussion of governmental affairs,' 'includ[ing] discussions of candidates.'" (citation omitted)).

Moreover, bias against critical trademarks is *all* that Section 1052(c) accomplishes, because other provisions of the Lanham Act separately prevent registration of trademarks that "falsely suggest a connection with persons" or "cause confusion … mistake, or … dece[ption]" about the source of a good. 15 U.S.C. § 1052(a), (d). Those provisions ensure that, for example, a private individual with no connection to the former President cannot register TRUMP FOR PRESIDENT, TRUMP COUNTRY CLUB, or similar hypothetical marks that use the former President's name to create a false association with him or confusion about whether he is the source of a good. Section 1052(c) thus has no independent role to play in barring the registration of such marks. Section 1052(c) serves only to allow named persons to veto the registration of non-deceptive trademarks that they do not like (*e.g.*, those that criticize them). That is paradigmatic viewpoint discrimination.

In sum, the effect of Section 1052(c) is to prevent the registration of "derogatory" trademarks, while permitting the registration of "positive" ones. *Brunetti*, 139 S. Ct. at 2299. That is the same problem that led the Court to invalidate the trademark-registration bars at issue in *Tam* and *Brunetti*. *Id.* The same result should follow here, and for the same reason. "By mandating positivity," Section 1052(c) threatens to "silence dissent and distort the marketplace of ideas." *Tam*, 582 U.S. at 249 (Kennedy, J., concurring in part and concurring in the judgment). If the First Amendment protects registration "of a trademark saying: 'James Buchanan was a disastrous president,'" *id.* at 246 (opinion of Alito, J.), it must protect registration of a trademark similarly criticizing his living successors.

III. Section 1052(c)'s Viewpoint Discrimination Creates Serious First Amendment Harms

Although the case could end there, Section 1052(c) has other problems that make its viewpoint discrimination particularly troubling.

First, Section 1052(c) will typically bar only the registration of trademarks that refer to public officials and other public figures. Trademarks that do not implicate anyone specific (*e.g.*, ASK CHRIS, owned by *Los Angeles Magazine*) will escape Section 1052(c)'s registration bar because they do not "identify[]" a person as required by the statutory text. 15 U.S.C. § 1052(c). Thus, Section 1052(c) will protect almost exclusively those names that are so well known that mentioning them in a trademark identifies them. *See, e.g.*, *In Re Nieves & Nieves LLC*, 113 U.S.P.Q.2d 1629, at *12 (T.T.A.B. 2015) ("A consent is

required only if the individual bearing the name in the mark … is so well known that the public would reasonably assume a connection between the person and the goods or services; or … the individual is publicly connected with the business in which the mark is used."); Pet. App. 21a & n.6. That means Section 1052(c) not only has the effect of disfavoring trademarks that *criticize*, it disfavors only those trademarks that criticize *public figures*—a "prized American privilege" at the heart of the First Amendment's protection. *Bridges v. California*, 314 U.S. 252, 270 (1941).

In fact, such extra protection for public figures is just what some members of Congress intended when passing Section 1052(c). At least three members of the 1939 House subcommittee that discussed Section 1052(c) concurred that the law ought to prohibit registration of "Abraham Lincoln gin" as a disparaging use of a president's name. *See Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1379 (Fed. Cir. 1983) (showing the representatives contrasting "Abraham Lincoln gin" as an "abuse[]" of the name with "George Washington coffee" as a potentially "legitimate use").[9] The result is a provision that inverts the normal hierarchy of First Amendment protections: it gives criticism of Presidents the least First Amendment protection, criticism

[9] It is forgivable today to miss how "Abraham Lincoln gin" could be disparaging, especially now that the Mount Vernon Ladies' Association of the Union has itself trademarked GEORGE WASHINGTON STRAIGHT RYE WHISKEY. But it is easy to think of modern-day products that might have a connotation as negative as gin apparently did to Congress in 1939. *Cf. Jack Daniel's*, 599 U.S. at 148–49.

of public figures the second least protection, and criticism of private people the most. *See Gertz*, 418 U.S. at 342. Such an upside-down approach subverts the prized American privilege to criticize public figures and cannot stand up to the First Amendment.

Second, Section 1052(c) provides public figures with the ultimate heckler's veto by outsourcing trademark registration decisions to them alone. Public figures can singlehandedly prevent others from criticizing them through the registration of powerfully expressive trademarks simply because "of hostility to their assertion." *Cox v. Louisiana*, 379 U.S. 536, 551 (1965) (quoting *Watson v. City of Memphis*, 373 U.S. 526, 535 (1963)). But this Court has "said time and again that 'the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.'" *Tam*, 582 U.S. at 244 (opinion of Alito, J.) (citation omitted); *see id.* at 250 (Kennedy, J., concurring in part and concurring in the judgment) ("The Government may not insulate a law from charges of viewpoint discrimination by tying censorship to the reaction of the speaker's audience.").

If anything, Section 1052(c)'s provision of a veto to the named person in a registered trademark makes it even more troubling than the Lanham Act provisions invalidated in *Tam* and *Brunetti*. Those provisions barred registration only when objections arose from a "substantial composite of the referenced group," *Tam*, 582 U.S. at 228 (disparaging trademarks), or "'most members' of society," *Brunetti*, 139 S. Ct. at 2301 (immoral or scandalous trademarks). The First Amendment concerns raised by those provisions are only magnified in Section 1052(c), which allows

registration to be barred based on the opinion of just *one* person—and often opinions of those wielding government power, including Presidents, who wield executive power over the USPTO. *See, e.g.*, *Tam*, 582 U.S. at 253–54 (Kennedy, J., concurring in part and concurring in the judgment) ("A law that can be directed against speech found offensive to some portion of the public can be turned against minority and dissenting views to the detriment of all."); *cf. Jack Daniel's*, 599 U.S. at 164 (Sotomayor, J., concurring) (expressing concern that "[w]ell-heeled brands … would be handed an effective veto over mockery").

Finally, Section 1052(c) imposes those serious costs on free expression without producing any meaningful benefits for society in return. If Section 1052(c) were invalidated, individuals whose names are used in trademark registrations would still have many protections against abuse, including the backstops of defamation and misappropriation. *See, e.g.*, *Counterman v. Colorado*, 143 S. Ct. 2106, 2115 (2023) (explaining that public figures may sue for defamation so long as they can prove that a depiction was false and that "the speaker acted with 'knowledge that [such depiction] was false or with reckless disregard of whether it was false or not.'" (quoting *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 280 (1964))).

Even more pertinent here, individuals named in registered trademarks retain protection from other Lanham Act provisions. As noted above, Section 1052(a) prohibits the registration of marks that consist of matter that is "deceptive" or "falsely suggest[s] a connection with persons." 15 U.S.C. § 1052(a). And Section 1052(d) prohibits the registration of marks

that are likely "to cause confusion, or to cause mistake, or to deceive." 15 U.S.C. § 1052(d).

To see those protections in action, consider the USPTO's decision not to register the mark ROYAL KATE for a jewelry company. Under Section 1052(c), the USPTO faced the question of whether that mark used Kate Middleton's name without her consent. But without needing to answer that question, the USPTO decided to deny registration under Section 1052(a), which bars registration of a mark that "falsely suggest[s] a connection with persons, living or dead." *In re Nieves*, 113 U.S.P.Q.2d 1629, at *12.

That decision was consistent with the First Amendment because the Government has a "well settled" interest in protecting consumers from source confusion or deception. *Tam*, 582 U.S. at 252 (Kennedy, J., concurring in part and concurring in the judgment). And the decision protected Kate Middleton from having consumers mistakenly believe that she had launched, approved, sponsored, or otherwise was affiliated with, that jewelry company. *See* Samuel F. Ernst, *Trump Really Is Too Small: The Right to Trademark Political Commentary*, 88 BROOK. L. REV. 839, 869 (2023); *see also Major League Baseball Players Ass'nv. Chisena*, 2023 WL 2986321, at *28 (T.T.A.B. Apr. 12, 2023) (concluding that an applicant could not register the mark HERE COMES THE JUDGE—regarding major league baseball player Aaron Judge—because of likelihood of confusion under Section 1052(d), without addressing Section 1052(c)).

By contrast, there is no danger of the public drawing a connection between former President Trump and the mocking mark TRUMP TOO SMALL or the

countless other marks that one might imagine to criticize or poke fun at public officials and figures. Invalidating Section 1052(c) would thus vindicate first principles of free expression without undermining the significant public interests animating trademark law.

CONCLUSION

The Court should affirm the judgment below by holding that Section 1052(c) violates the First Amendment by permitting viewpoint discrimination.

Respectfully submitted.

JT MORRIS
FOUNDATION FOR INDIVIDUAL RIGHTS AND EXPRESSION
700 Pennsylvania Ave., SE
Suite 340
Washington, DC 20003

ILYA SHAPIRO
MANHATTAN INSTITUTE
52 Vanderbilt Ave.
New York, NY 20017

CHRISTOPHER G. MICHEL
Counsel of Record
ALEX VAN DYKE
QUINN EMANUEL URQUHART & SULLIVAN, LLP
1300 I Street, N.W.
Suite 900
Washington, D.C. 20005
(202) 538-8000
christophermichel@quinnemanuel.com

TODD ANTEN
JESSICA A. ROSE
QUINN EMANUEL URQUHART & SULLIVAN, LLP
51 Madison Avenue, 22nd Fl.
New York, NY 10010

Counsel for Amici Curiae

September 12, 2023

ADDENDUM

President Joe Biden

Registered by USPTO	Rejected by USPTO (examples)
• BIDEN PRESIDENT • INAUGURATION OF PRESIDENT AND VICE PRESIDENT 2009 OBAMA BIDEN	• 2024: JUST "BIDEN" MY TIME • ABANDON BIDEN • BIDEN BUCKS • BIDEN MY TIME, #TRUMP 2024 • BIDEN THE BEAVER REBUILDING THE SWAMP • BLAME IT ON BIDEN • BLAMEITONBIDEN.COM • BOGUS JOE BIDEN, BOGUS JOE • BUCK DOE BIDEN • HIDIN' FROM BIDEN • LEAVE BIDEN BEHIND • MAKING AMERICA WEAK AGAIN BIDEN HARRIS • TALIBIDEN • WHAT AM I DOING HERE? PRESIDENT JOE BIDEN

Former President Donald Trump

Registered by USPTO (examples)	Rejected by USPTO (examples)
• ALBEMARLE ESTATE AT TRUMP WINERY • ALBEMARLE ESTATE TRUMP ESTATE COLLECTION • DONALD TRUMP • DONALD TRUMP THE FRAGRANCE • EMPIRE BY TRUMP • GOTRUMP • PURELY TRUMP • SUCCESS BY TRUMP • T TRUMP • T TRUMP HOLLYWOOD • T TRUMP TOWER TAMPA A DONALD J. TRUMP SIGNATURE PROPERTY • THE SPA AT TRUMP • THE DONALD J. TRUMP SIGNATURE COLLECTION • THE ESTATES AT TRUMP NATIONAL GOLF CLUB • THE RESIDENCES AT TRUMP NATIONAL GOLF CLUB • THE RIVER WALK SHOPS AT TRUMP INTERNA-TIONAL	• # TRUMP YOU ARE D!! • DOGALD TRUMP • DONALD TRUMP BARF BAG • DRAIN THE TRUMP • DUMP TRUMP AND LOCK HIM UP • DUMP TRUMP IN 2020 #DUMPTRUMPIN2020 • GOLDEN CALF TRUMP STATUE • MAKE AMERICA GREAT AGAIN KICK TRUMP OUT • MAKE THE PRESIDENCY TRUMP-FREE AGAIN • MY DOG IS SMARTER THAN YOUR TRUMP VOTER • POST TRUMPMATIC STRESS DISORDER • STOMP TRUMP • THIS NATION IS IN THE DUMP BECAUSE OF TRUMP • TRUMP CHUMP • TRUMP IS ROOTIN' FOR PUTIN

Registered by USPTO (examples)	Rejected by USPTO (examples)
• THE TRUMP NETWORK • THE TRUMP ORGANIZATION • THE TRUMP SHUTTLE • THE TRUMP SPA • THE TRUMP SPA AT MAR A LAGO • THE TRUMP WORLD TOWER • THE TRUMP WORLD TOWER AT UNITED NATIONS PLAZA • TRAVEL TRUMP STYLE • TRUMP • TRUMP AIRLINES • TRUMP ATTACHÉ • TRUMP CARD • TRUMP CASINO • TRUMP CONCIERGE SERVICE • TRUMP ENTERTAINMENT RESORTS • TRUMP FINANCIAL • TRUMP GO TRUMP.COM TRAVEL TRUMP STYLE • TRUMP GOLF LINKS • TRUMP GRANDE OCEAN RESORT & RESIDENCES	• TRUMP LIED THOUSANDS DIED • TRUMP THE MENTAL ATHLETE • TRUMP THE PRESIDENT OF THE COMMUNIST PARTY OF AMERICA • TRUMP TOO SMALL • TRUMP U R FIRED! C YA DON'T WANNA B YA! BECAUSE BLACK LIVES DO MATTER! • TRUMP YOU'RE FIRED!!! • UN-TRUMP-AMERICA • WANTED! TRUMP!

Registered by USPTO (examples)	Rejected by USPTO (examples)
• TRUMP HOLLYWOOD • TRUMP HOME • TRUMP HOTELS • TRUMP ICE • TRUMP INSTITUTE • TRUMP INTERNATIONAL GOLF CLUB • TRUMP INTERNATIONAL HOTEL & TOWER • TRUMP INTERNATIONAL HOTEL FT. LAUDERDALE • TRUMP INTERNATIONAL PLAZA • TRUMP LAS OLAS BEACH RESORT • TRUMP MARINA • TRUMP MARINA HOTEL CASINO • TRUMP MODEL MANAGEMENT • TRUMP MORTGAGE • TRUMP NATIONAL GOLF CLUB • TRUMP NEW WORLD RESERVE • TRUMP OCEAN CLUB • TRUMP OFFICE • TRUMP ON THE OCEAN	

Registered by USPTO (examples)	Rejected by USPTO (examples)
• TRUMP ONE • TRUMP PALACE • TRUMP PARK • TRUMP PARK AVENUE • TRUMP PLACE • TRUMP PLAZA • TRUMP ROYALE • TRUMP SOHO • TRUMP STEAKS • TRUMP TAJ MAHAL CASINO-RESORT • TRUMP TOWER AT CITY CENTER • TRUMP TOWER • TRUMP TOWERS • TRUMP TYCOON • TRUMP UNIVERSITY • TRUMP WORLD • TRUMP WORLD'S FAIR • TRUMP'S AMERICAN PALE ALE • TRUMP'S GOLDEN LAGER	