

No. 22-704

IN THE
Supreme Court of the United States

KATHERINE 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

BRIEF OF THE MOTION PICTURE ASSOCIATION,
INC. AS *AMICUS CURIAE* IN SUPPORT OF
NEITHER PARTY

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INTEREST OF *AMICUS CURIAE*¹

Amicus curiae the Motion Picture Association, Inc. (“MPA”) is a not-for-profit trade association founded in 1922. The MPA serves as the voice and advocate of the film and television industry, advancing the business and art of storytelling, protecting the creative and artistic freedoms of storytellers, and supporting the creative ecosystem that brings entertainment and inspiration to audiences worldwide.

The MPA’s member companies are Paramount Pictures Corporation, Sony Pictures Entertainment Inc., Universal City Studios LLC, Walt Disney Studios Motion Pictures, Warner Bros. Entertainment Inc., and Netflix Studios, LLC. These companies and their affiliates are the leading producers and distributors of filmed entertainment in the United States through the theatrical and home entertainment markets. Indeed, the MPA’s members create thousands of films and television shows that entertain, educate, and inform the public.

This case concerns a First Amendment challenge to the Lanham Act’s bar on registering a trademark for “a name . . . identifying a particular living individual except by his written consent.” 15 U.S.C. § 1052(c). In arguing in favor of the constitutionality of this provision, the government contends that Section 1052(c) “serves in

¹ Pursuant to this Court’s Rule 37.6, counsel for *amicus curiae* certifies that this brief was not authored in whole or in part by counsel for any party and that no person or entity other than *amicus curiae*, its members, or its counsel has made a monetary contribution intended to fund the preparation or submission of this brief.

part to protect the same interests that traditionally have underlain the rights of privacy and publicity that living persons have in the designations that identify them.” Pet. 5. The government claims that the “right of publicity,” which “is generally understood to bar the appropriation for commercial purposes of a person’s identity without his consent,” is “widely recognized under state statutes and at common law.” Pet. 5 n.1.

The scope of the right of publicity is of great interest to the MPA’s members. In telling stories, filmmakers frequently draw upon actual events and people, as storytellers have done throughout history. They craft docudramas, which dramatize historical events; historical fiction, in which real people and events serve as a backdrop for a fictional story; and fictional works inspired by real people. Many of the greatest movies of all time are inspired by real events and real people—classics such as “Raging Bull,” “Patton,” “The Right Stuff,” and “Schindler’s List,” among countless others. Like all expressive works that the MPA’s members create, such films are fully protected by the First Amendment.

The MPA’s members often are the targets of right-of-publicity lawsuits brought by individuals who were depicted in, or who claim to have inspired characters in, films and television shows created by the MPA’s members. Although lower courts have repeatedly held that such lawsuits are barred by the First Amendment, plaintiffs continue to bring them, and the ensuing litigation can be protracted and expensive.

In resolving this case, this Court may opine on the relationship between the First Amendment and right-

of-publicity claims. The MPA has a strong interest in ensuring that the First Amendment provides robust protection against right-of-publicity claims seeking to silence its members' creative expression.

SUMMARY OF ARGUMENT

The MPA submits this brief because the Court may address in this case an issue of great importance to the MPA's members: the relationship between the First Amendment and the right-of-publicity tort. If the Court reaches that issue, it should state that the First Amendment does not permit a plaintiff to bring a right-of-publicity claim based on allegations that the plaintiff's name or likeness was used in an expressive work.

This case presents the question whether 15 U.S.C. § 1052(c), which provides that registration will be refused if it "[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent," violates the First Amendment as applied to the trademark registration for TRUMP TOO SMALL. The government contends that Section 1052(c)'s limitation on trademark registration is a condition on a government benefit, while respondent contends that Section 1052(c) is a restriction on speech. The MPA takes no position on which party's contention is correct, and therefore takes no position on the ultimate disposition of this case.

If the Court concludes that Section 1052(c) restricts speech, however, it may address whether or when a person's right-of-publicity interests outweigh a trademark applicant's First Amendment rights. The MPA has a significant stake in that issue, given that its

members are frequently the target of lawsuits in which individuals claim their rights of publicity are infringed when they are depicted in movies and television shows.

In the context of expressive works, the First Amendment must prevail over the right of publicity. Many of the greatest movies of all time depict or are inspired by real people and events. The art of storytelling requires the ability to depict actual people and actual events. The First Amendment protects those works with full force.

If people could wield the right of publicity as a veto against their depiction in expressive works, then filmmakers would be required to obtain the consent of every living person they portray on film, likely by paying them for the privilege. Some individuals wouldn't grant permission at any price, rendering certain works about real people impossible to make. Or they might grant permission only on the condition that they are portrayed in a positive light, meaning that expressive works based on true stories would be confined to the bland, the known, and the uncontroversial. Public figures effectively would have the power to veto unflattering depictions, irrespective of whether they were accurate or defamatory. Culture and literature would be poorer as a result.

Lower courts will look closely at this Court's description of the relationship between the right of publicity and the First Amendment. Regardless of how this case comes out, the Court should make clear that the right of publicity cannot be used to silence or deter the creation of expressive works.

ARGUMENT

I. This Case May Require the Court to Opine on an Issue of Great Importance to Filmmakers: The First Amendment’s Limits on the Right-of-Publicity Tort.

This case may require the Court to opine on the relationship between the right-of-publicity tort and the First Amendment. The Court should make clear that in the context of expressive works—whether political or otherwise—the First Amendment prevails.

Respondent Elster seeks to register the mark TRUMP TOO SMALL, based on his use of the mark in commerce on shirts. The Patent and Trademark Office refused registration under 15 U.S.C. § 1052(c), which provides that registration will be refused if it “[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent.” The Federal Circuit ruled that Section 1052(c), as applied here, violated the First Amendment because it suppressed Elster’s political speech.

As framed by the parties, the constitutionality of Section 1052(c) turns on whether a bar on trademark registration is a “condition on a government benefit or a simple restriction on speech.” *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019). The government contends that Section 1052(c) is a mere condition on a government benefit; it points out that the “owner of the mark remains free to use the mark in commerce” and is merely denied the “ancillary benefits that come with registration.” Pet. 14 (internal quotation marks omitted). By contrast, Elster responds that “denial of

trademark registration burdens private speech because it ‘disfavors’ particular marks,” BIO 16. The MPA takes no position on whether bars on trademark registrations are conditions on government benefits or restrictions on speech, and hence takes no position on who should prevail in this case.

In the MPA’s view, however, *if* the Court treats trademark registration as a restriction on speech, *then* Elster must prevail. The government appears to agree that the right of publicity cannot overcome a speaker’s First Amendment right to criticize the President. That is true as far as it goes: politicians certainly cannot invoke the right of publicity to silence political speech. But the First Amendment’s scope vis-à-vis the right of publicity is significantly broader. The First Amendment outweighs the right of publicity when a speaker is using a person’s name or likeness for any expressive purpose—not merely for a political purpose. That principle applies whether the person whose name is publicized is a public figure or not.

The Court has not addressed a First Amendment case involving the right of publicity for nearly a half century. Thus, lower courts analyzing right-of-publicity issues will be sure to read the Court’s opinion closely. In describing the balance between the right of publicity and the First Amendment, the Court should avoid any implication that the First Amendment protects only political speech.

II. In Right-of-Publicity Cases, the First Amendment Protects *All* Expressive Speech, Not Just Political Speech.

In telling stories, filmmakers frequently draw upon actual events and people. They depict historical events in docudramas, craft historical fiction in which fictional and real characters interact, and tell fictional stories inspired by the present and past. Such films are protected by the First Amendment. As lower courts have uniformly held for decades, Plaintiffs may not rely on the right of publicity as a basis for silencing expressive works. The right of publicity tort does not extend that far; if it did, it would violate the First Amendment.

A. Filmmakers rely on real people and events to tell stories.

Throughout history, writers have relied on real-life events to create great works of literature. Some writers have dramatized public figures and famous events—nearly every character in Shakespeare’s histories such as the *Richard* and *Henry* plays correspond to real people, and there was a real Macbeth who inspired Shakespeare’s version of the story. Others have drawn on their own life experiences—Mark Twain admitted that Huckleberry Finn was based on one of his own childhood friends.

Filmmakers have frequently drawn on that time-honored artistic tradition. Many of the greatest films and television shows of all time have been inspired by actual people and events. This is not a surprise: many

great stories cannot be told unless they are grounded in the real world.

Some films dramatize real historical people and events. Think “King Richard,” “The Social Network,” “Richard Jewell,” “United 93,” “Erin Brockovich,” “13 Hours: The Secret Soldiers of Benghazi,” and “American Sniper.” These movies are artistically significant precisely *because* they depict real people with remarkable stories. There is no way to make “King Richard” or “The Social Network” without referring to Richard Williams or Mark Zuckerberg. The same goes for many classic television shows—one could not have “The Crown” without the Queen and King Charles III, or “The People v. O.J. Simpson: American Crime Story” without O.J. Simpson.

Other films are “historical fiction”—they use real events and depict historical figures against the backdrop of a fictional story. “Once Upon a Time in Hollywood” and “The Big Short” are examples of this genre. For movies of this type, the use of real people and events is essential. For example, “Once Upon a Time in Hollywood” would be a completely different movie if it did not depict the Manson Family. The juxtaposition of the Manson Family’s real story with the film’s fictional characters was a crucial aspect of the film. “The Big Short” also blends real people with fictional characters: Michael Burry, a central character in the film, is based on a real person named Michael Burry, while Jared Vennett, another central character, is fictional. Going back further in time, “All the President’s Men” depicts Watergate a mere four years after those events occurred.

Still other movies and television shows are fictional, but inspired by real people. “Primary Colors” is inspired by Bill Clinton; “The Devil Wears Prada” is inspired by Anna Wintour; “Citizen Kane” is inspired by William Randolph Hearst; “Orange is the New Black” is based on an author’s memoir of her actual year in federal prison. It is difficult to imagine how the film industry could function if filmmakers could not tell stories inspired by real people. Life experience is the wellspring of creativity.

Sometimes, filmmakers enter into consulting services agreements with people they portray. But not always; the law doesn’t require them to enter into any agreement in order to tell a story about or depict persons involved in actual events. Filmmakers frequently make films about controversial subjects, or present critical perspectives on those they depict, with no involvement (or, with the involvement of some, but not all) of the people they depict. “The Social Network,” for instance, is an iconic movie precisely because it is not a Mark Zuckerberg-approved puff piece about Facebook’s creation. In such cases, filmmakers present nuanced perspectives on real-world events that they would have to censor, or which would not be told, if the consent of the persons depicted was required. Artistic freedom requires the ability to portray real people *without* giving those people veto power over the content of the art.

B. The First Amendment protects filmmakers' right to rely on real people and events to tell stories.

Movies that are inspired by real people and events, like any other movies, are protected by the First Amendment.

Movies are expressive speech fully protected by the First Amendment. As this Court made clear over 70 years ago, “[i]t cannot be doubted that motion pictures are a significant medium for the communication of ideas.” *Joseph Burstyn, Inc. v. Wilson*, 343 U.S. 495, 501 (1952). “They may affect public attitudes and behavior in a variety of ways, ranging from direct espousal of a political or social doctrine to the subtle shaping of thought which characterizes all artistic expression.” *Id.* “The importance of motion pictures as an organ of public opinion is not lessened by the fact that they are designed to entertain as well as to inform.” *Id.*

A crucial component of the First Amendment right to make a movie is the right to refer to and depict actual people and events. The state-law right-of-publicity tort cannot be used to punish filmmakers for exercising their constitutional right to tell stories.

The Restatement’s description of the right-of-publicity tort reflects that principle. According to the Restatement, “[o]ne who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability.” *Restatement (Third) of Unfair Competition* § 46 (1995). But the Restatement makes clear that the right-of-publicity tort

is subject to a significant limitation: it does not apply to “the use of a person’s identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.” *Id.* § 47.

As the Restatement explains, that limitation is rooted in the First Amendment:

The right of publicity as recognized by statute and common law is fundamentally constrained by the public and constitutional interest in freedom of expression. The use of a person’s identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person’s right of publicity. The scope of the activities embraced within this limitation on the right of publicity has been broadly construed. Thus, the use of a person’s name or likeness in news reporting, whether in newspapers, magazines, or broadcast news, does not infringe the right of publicity. The interest in freedom of expression also extends to use in entertainment and other creative works, including both fiction and nonfiction. The use of a celebrity’s name or photograph as part of an article published in a fan magazine or in a feature story broadcast on an entertainment program, for example, will not infringe the celebrity’s right of publicity. Similarly, the right of publicity is not infringed by the dissemination of an unauthorized print or broadcast biography. Use of another’s identity in a novel, play, or motion picture is also not ordinarily an infringement. The fact that the

publisher or other user seeks or is successful in obtaining a commercial advantage from an otherwise permitted use of another's identity does not render the appropriation actionable.

Id. § 47, cmt. c.

The McCarthy treatise similarly explains that the right to tell a person's story without that person's consent is a crucial component of the freedom of speech:

If the law mandated that the permission of every living person . . . must be obtained to include mention of them in news and stories, both in documentary and docudrama telling, then they would have the right to refuse permission unless the story was told "their way." That would mean that those who are the participants in news and history could censor and write the story and their descendants could do the same. This would be anathema to the core concept of free speech and a free press.

2 Thomas J. McCarthy, *Rights of Publicity & Privacy* § 8:64 (2d ed. 2023).

Thus, the government's acknowledgement that the "the First Amendment largely precludes public figures from invoking common-law rights of privacy or publicity to prevent others from speaking about them," Pet. Reply 11, is correct—but it does not go far enough. The First Amendment provides blanket protection against right-of-publicity claims arising from any expressive work, whether political or not, and whether the individual subject to the publicity is a public figure or not.

Lower courts have consistently safeguarded filmmakers' expressive rights against right-of-publicity claims, either by construing the right-of-publicity tort narrowly to avoid any risk of a constitutional clash, or by directly holding that the application of the right-of-publicity tort violates the First Amendment.

In several cases, courts have held that the right-of-publicity tort, by its terms, does not extend to allegations that a name or likeness was used in an expressive work. For instance, in *Tyne v. Time Warner Entertainment Co., L.P.*, 901 So. 2d 802 (Fla. 2005), the Florida Supreme Court held that the tort did not apply to depictions of real people in "The Perfect Storm," a film that dramatized the disappearance of a fishing vessel and crew during a powerful storm. The plaintiffs, the children of those who died during the storm, sued under Florida's statutory version of the right-of-publicity tort. *Id.* at 805. Emphasizing its "obligation to give a statute a constitutional construction where such a construction is possible," the court held that Florida's statute did not cover "publications, including motion pictures, which do not directly promote a product or service." *Id.* at 810.

Likewise, in *Matthews v. Wozencraft*, 15 F.3d 432 (5th Cir. 1994), the Fifth Circuit rejected the claims of a corrupt former police officer who alleged that a novel and film had been based on his life. The court held that Texas's version of the right-of-publicity tort did not apply when the defendant was "simply converting factual events that happen to include Matthews into fiction." *Id.* at 437.

In other cases, courts have held that right-of-publicity claims were barred by the First Amendment.

In *de Havilland v. FX Networks, LLC*, 21 Cal. App. 5th 846 (2018), the California Court of Appeal held that the First Amendment barred a right-of-publicity claim arising from a television miniseries depicting actress Olivia de Havilland. The docudrama series, entitled “Feud: Bette and Joan,” depicted the lives of film stars Bette Davis and Joan Crawford, along with their contemporaries, including actress Olivia de Havilland. *Id.* at 850. Disliking her character’s use of profanity in the series, Ms. de Havilland sued under California’s right-of-publicity statute, seeking to enjoin distribution of the series and to recover money damages. *Id.* The court observed that this legal theory “would render actionable all books, films, plays, and television programs that accurately portray real people.” *Id.* It concluded that the “First Amendment does not permit this result.” *Id.*

Similarly, in *Sarver v. Chartier*, 813 F.3d 891 (9th Cir. 2016), the Ninth Circuit held that the First Amendment barred a right-of-publicity suit seeking to impose liability on the creators of the film “The Hurt Locker.” The plaintiff was a former Army sergeant who claimed that the movie was based on his life and experiences in Iraq. *Id.* at 896. The Ninth Circuit concluded that “*The Hurt Locker* is speech that is fully protected by the First Amendment, which safeguards the storytellers and artists who take the raw materials of life — including the stories of real individuals, ordinary or extraordinary — and transform them into art, be it articles, books, movies, or plays.” *Id.* at 905.

In *Montgomery v. Montgomery*, 60 S.W.3d 524 (Ky. 2001), the Supreme Court of Kentucky applied the same

principles in a case concerning the use of a person’s name in a music video. The court emphasized that “the right of publicity is fundamentally constrained by federal and state constitutional protection of the freedom of expression,” and that “the music video in question is protected free expression.” *Id.* at 528-29. Although the music video was commercial in nature, “the commercial nature of music videos does not deprive them of constitutional protection.” *Id.* at 529. “The fact that a person’s likeness is used in a constitutionally-protected work to create or enhance profits does not make the use actionable.” *Id.*

This unbroken line of lower-court cases establishes that the right-of-publicity tort does not apply to expressive works and, whatever the outcome here, is precedent that should be preserved. The First Amendment protects artists’ right to create works that incorporate the experiences of real people.

To be sure, the First Amendment does not insulate artists from all liability related to the portrayal of real people. Public figures, for example, 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.’” *Counterman v. Colorado*, 143 S. Ct. 2106, 2115 (2023) (quoting *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 280 (1964)). But the First Amendment emphatically protects “truthful . . . statements about public officials and figures”—even if they are “reputation-damaging.” *Id.* at 2118. And even as to speech that does not address public figures, courts must “must consider the prospect of chilling non-

threatening expression, given the ordinary citizen’s predictable tendency to steer wide of the unlawful zone.” *Id.* at 2116 (alterations and internal quotation marks omitted). Filmmakers and other artists need breathing space to create artistic works about or inspired by actual people, and that breathing space requires exempting creators of expressive works from right-of-publicity liability.

C. This Court’s Decision in *Zacchini* Addresses a Fundamentally Different Type of Right-of-Publicity Claim.

This Court’s decision in *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562 (1977), does not undermine the conclusion that the First Amendment bars right-of-publicity claims against expressive works.

Mr. Zacchini was an entertainer who performed a “human cannonball’ act in which he is shot from a cannon into a net some 200 feet away.” *Id.* at 563. A reporter filmed this performance, which lasted fifteen seconds, and the film clip was aired on the nightly news. *Id.* at 564. Zacchini sued, alleging infringement of his “right to the publicity value of his performance.” *Id.* at 565 (quotation marks omitted).

This Court held that the First Amendment did not bar Zacchini’s suit. Crucial to the Court’s reasoning was that Zacchini was *not* merely alleging misappropriation of his identity, but instead misappropriation of his entire act. The Court emphasized that the State had an interest “in protecting the proprietary interest of the individual in his act in part to encourage such entertainment.” *Id.* at 573. It emphasized that Zacchini

“does not merely assert that some general use, such as advertising, was made of his name or likeness; he relies on the much narrower claim that respondent televised an entire act that he ordinarily gets paid to perform.” *Id.* at 573 n.10. The Court explained that “[t]he broadcast of a film of [Zacchini’s] entire act poses a substantial threat to the economic value of that performance”: “[t]he effect of a public broadcast of the performance is similar to preventing petitioner from charging an admission fee.” *Id.* at 575-76.

As this reasoning made clear, the claim asserted by Zacchini is very different from the right-of-publicity claims asserted by plaintiffs claiming their identity was misused by filmmakers. Zacchini was not claiming that his *personal* right to publicize *his identity* was infringed. Instead, he contended that, in his capacity as an event producer who staged entertainment, his right to publicize *his act* at all was misappropriated. Although his act happened to involve himself being launched from the cannon, his argument would be identical if he launched, say, an animal from the cannon rather than himself. In that scenario, too, the “effect of a public broadcast of the performance is similar to preventing petitioner from charging an admission fee.” *Id.*

Zacchini therefore supports a distinct line of cases establishing that the producer of an entertainment event, such as a sports event, has the right to license the right to broadcast the event, and an unauthorized person cannot surreptitiously film the event and put it on television. *See, e.g., Wis. Interscholastic Athletic Ass’n v. Gannett Co.*, 658 F.3d 614, 624, 628 (7th Cir. 2011) (observing that a “producer of the entertainment,” such

as “the NFL, FIFA, or the NCAA,” “normally signs a lucrative contract for exclusive, or semi-exclusive, broadcast rights for the performance,” and that “*Zacchini* makes clear that the producer of entertainment is entitled to charge a fee in exchange for consent to broadcast”).

Zacchini has no bearing, however, on whether a plaintiff may exercise a *personal* right of publicity so as to silence expressive works. As to that question, lower courts are uniform: the First Amendment protects expressive works. *See, e.g., Sarver*, 813 F.3d at 905 (distinguishing *Zacchini* where “[n]either the journalist who initially told Sarver’s story nor the movie that brought the story to life stole Sarver’s ‘entire act’ or otherwise exploited the economic value of any performance or persona he had worked to develop”).

III. If Section 1052(c) Restricts Speech, it Violates the First Amendment.

As noted above, the MPA takes no position on whether the Lanham Act’s registration bars should be cast as conditions on a benefit or restrictions on speech. If they are restrictions on speech, however, they violate Elster’s First Amendment right.

TRUMP TOO SMALL is political speech: it criticizes then-President, and now-candidate, Donald Trump. Therefore, President Trump’s right of publicity cannot restrict Elster’s right to say TRUMP TOO SMALL.

Even if Elster’s proposed registration did not name a politician, the right of publicity still would not outweigh the right to use a person’s name, so long as that use was not purely for commercial purposes. If a person

sought to obtain a mark on MUSK’S CARS ROCK—or MUSK’S CARS STINK—the First Amendment would offer just as much protection as it does to TRUMP TOO SMALL. As long as the message is expressive, the First Amendment does not allow it to be silenced via the right of publicity.

Of course, the First Amendment runs both ways: trademark *holders* cannot restrict *defendants* from exercising their own constitutional rights. This Court has recently stated that “[t]he trademark law generally prevails over the First Amendment” when “another’s trademark (or a confusingly similar mark) is used without permission” as a means of “source identification.” *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1590-91 (2023) (quotation marks omitted). But when the use of the mark performs “some other expressive function,” the First Amendment comes into play. *Id.* at 1587. Thus, if someone said “TRUMP TOO SMALL” in an effort to criticize the President, President Trump could not silence him by means of a right-of-publicity action—but Elster also could not silence the speaker by means of a trademark-infringement action.

This case, however, does not require consideration of constitutional protections for trademark *defendants*; it addresses only trademark *registrants*. And, insofar as the denial of a registration is a restriction on speech, the right of publicity cannot outweigh Elster’s right to speak.

If the Court’s opinion in this case addresses the scope of First Amendment limitations on the right of publicity, it will likely prove influential in future lower-court

proceedings. The Court should take care to accurately describe the First Amendment's breadth in this area. It should hold that when expressive works are involved, the right of publicity gives way to the First Amendment.

CONCLUSION

Regardless of who prevails in this case, the Court should make clear that the right of publicity cannot be used to silence or deter production of expressive works.

Respectfully submitted,

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