

No. 22-704

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In The  
**Supreme Court of the United States**

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KATHERINE K. VIDAL, UNDER SECRETARY OF  
COMMERCE FOR INTELLECTUAL PROPERTY  
and DIRECTOR, UNITED STATES PATENT  
AND TRADEMARK OFFICE,

*Petitioner,*

v.

STEVE ELSTER,

*Respondent.*

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**On Writ Of Certiorari To The  
United States Court Of Appeals  
For The Federal Circuit**

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**BRIEF OF *AMICUS CURIAE*  
MATTHEW A. HANDAL  
IN SUPPORT OF NEITHER PARTY**

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**CORPORATE DISCLOSURE STATEMENT**

*Amicus* is an individual and has no parent corporation or corporate stock.

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**INTEREST OF *AMICUS***<sup>1</sup>

*Amicus* Matthew Handal owns pending trademark applications at the United States Patent and Trademark Office (“PTO”) for marks that include the word “Trump.”

Four of his marks have been refused registration under Section 2(c) of the Lanham Act, 15 U.S.C. §1052(c), and the refusals have been appealed to the Trademark Trial and Appeal Board (“TTAB”) where they are now pending: MAKE AMERICA GREAT AGAIN DUMP TRUMP! 2020, SN 88931066; MAKE AMERICA GREAT AGAIN DUMP TRUMP! 2020, SN 88936129; DUMP TRUMP AND LOCK HIM UP, SN 90340590; and INDICT THE TRUMP ORGANIZATION, SN 90340613. *Amicus*’ fifth application is pending examination at the PTO: INDICT 45, SN 90434555.

*Amicus* has an interest in the constitutionality of Section 2(c) being decided correctly on a record that properly presents the issue.<sup>2</sup>



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<sup>1</sup> No counsel for a party authored this brief in whole or in part and no such counsel or party made a monetary contribution intended to fund the preparation or submission of this brief.

<sup>2</sup> Although the mark in question specifically concerns President Donald J. Trump, the constitutional issue presented applies to all marks containing references to political figures of any political party or affiliation.

**STATUTORY PROVISIONS AT ISSUE**

The relevant portions of Sections 2(a) and (c) of the Lanham Act, 15 U.S.C. Sections 1052(a) and (c) provide as follows:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises . . . deceptive, . . . or matter which may . . . falsely suggest a connection with persons, living or dead, . . .

. . . .

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.

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**SUMMARY OF ARGUMENT**

The Court should remand to the Federal Circuit with instructions to affirm the refusal to register the trademark in question under the Lanham Act, Section 2(a)'s False Association Clause, 15 U.S.C. §1052(a).



There were two independent grounds cited for refusing the trademark application in this case. The False Association refusal was ignored by the parties on appeal to the Federal Circuit. However, because the Examining Attorney's determination of a false association was supported by substantial evidence, that ground is sufficient to affirm the refusal of the trademark application. Given the existence of the False Association refusal, it was not necessary for the Federal Circuit to consider the constitutionality of Section 2(c)'s requirement for the consent of a living individual.

Section 2(c), as applied to marks that comment on political figures, is viewpoint discrimination. Should this Court reach the merits of the constitutionality of Section 2(c), *Amicus* argues that Section 2(c)'s consent requirement is an unconstitutional restriction on speech when applied to trademarks criticizing political figures. Political figures will provide consent to register trademarks controlled by them; obviously, those trademarks will be positive. Political figures will overwhelmingly *never* consent to the registration of critical trademarks. Their ability to withhold consent in order to prevent registration effectively limits speech, because it is necessary to name (or clearly identify) the political figure in the mark when commenting about him or her. Therefore, as applied, Section 2(c) gives politicians an effective veto over political speech (positive or negative) concerning themselves.

This Court's ruling on Section 2(c) will have broader implications than its effect on Elster's singular trademark application. It is clear that there are many ways to express support or disapproval of political

figures, including expressive branding on goods or services. For example, blogs exist that refer to a politician (as in the case of *Amicus*' trademark applications), as do books, bumper stickers, buttons, hats, posters, signs and t-shirts (as in the case of Elster's applications). If Section 2(c) is constitutional, then the First Amendment likely will not preclude a politician from using the civil tort of Right of publicity to enjoin any use of his or her name on goods or services, and thus, suppress political speech.

The Government's "conditions on government benefits" argument fails because trademark registration is a system of registration, not a "government benefit." Just as with the registration of boats, copyrights, marriages and real estate, the purpose of the registry is to give notice. The issuance of a certificate confirming inclusion on a database is not a "government benefit." Trademark registration gives notice and creates presumptions that are recognized in courts. Those rights and presumptions are very important, but they are created by the Lanham Act. They are not a "government benefit" created by the PTO.

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## ARGUMENT

### **I. THE FALSE ASSOCIATION CLAUSE IS A SUFFICIENT STATUTORY GROUND TO REFUSE REGISTRATION OF THE TRADE-MARK.**

The PTO's Examining Attorney refused registration of the mark TRUMP TOO SMALL on two separate

grounds. In addition to refusing registration under Section 2(c) because the mark uses the name of a living individual without his consent, the PTO also refused registration for the mark under the False Association Clause of Section 2(a) because the PTO found the trademark created a false association.

The false association refusal is sufficient to refuse the application. Therefore, it was unnecessary to decide whether Section 2(c) is also a ground to refuse Elster's trademark application. Regardless of what this Court decides about Section 2(c), Elster's trademark application should be refused under the False Association Clause.

Initially, on February 19, 2018, the application was refused only under Section 2(c) in a Non-Final Office Action, because the mark includes the name of a living individual without his consent.<sup>3</sup> Pet. App. 60a–64a. The refusal was twice repeated, once on July 30, 2018, in a Non-Final Office Action (Pet. App. 52a–59a) and again on February 25, 2019, in a Denial of Applicant's Request for Reconsideration. Elster appealed to the TTAB.

After the appeal to the TTAB was filed, the Examining Attorney requested remand, which was granted. In a new Office Action dated June 24, 2019, the Examining Attorney added the additional and independent ground for refusing the application: that the proposed

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<sup>3</sup> As mentioned at Pet. 6 n. 2, the administrative record in this case is available at the PTO, *Trademark Status & Document Retrieval* (“TSDR”), <https://tsdr.uspto.gov> (search for PTO SN 87749230).

trademark created a false association with Mr. Trump, in violation of the False Association Clause of Section 2(a). Pet. App. 41a–51a. On September 9, 2019, in response to the new Office Action, Elster argued that his trademark did not create a false association and that the False Association Clause was unconstitutional as applied. However, Elster submitted no evidence to rebut the Examining Attorney’s evidence about a false association. Thus, the evidence was undisputed. Elster only disputed the conclusion to be drawn from the undisputed evidence.

In a Final Office Action issued October 7, 2019, the refusals under *both* the False Association Clause and Section 2(c) were maintained by the PTO (Pet. App. 33a–40a), and the matter was returned to the TTAB.

Upon appeal to the TTAB, Elster argued that the False Association Clause was unconstitutional and also that his trademark did not create a false association. [Elster’s] Supplemental Brief, TTABVUE, 87749230 (Dkt. 16). Elster repeated the arguments in his Reply Brief (Dkt. 20).

The TTAB affirmed the refusal based solely on Section 2(c). Pet. App. 22a–32a. The TTAB, having affirmed the refusal under Section 2(c), did “not reach the refusal to register under Section 2(a)’s false association clause.” Pet. App. 32a. The TTAB chose not to determine whether substantial evidence supported the refusal on the grounds of false association.

In the Federal Circuit, neither party chose to address whether the false association refusal was supported by substantial evidence. Elster did concede that

the False Association Clause was constitutional: “Because the business name was deceptive, it could be denied registration under section 2(a) without raising First Amendment concerns.” Reply Brief, CAFC Dkt. 40 at ECF page 24 (brief page 18).

The Federal Circuit was aware of the false association refusal because this *Amicus* filed an *amicus* brief, bringing it to the Court of Appeals’ attention. *See Amicus Brief*, CAFC Dkt. 23. The Federal Circuit acknowledged that it was ignoring this statutory ground for deciding the case, in footnote 3 of its opinion:

We note that the Board did not address the examiner’s rejection of Elster’s proposed mark on section 2(a) grounds, and the government on appeal similarly did not raise section 2(a) as an alternative basis for affirming the Board’s decision.

Pet. App. 15a n. 3.

The Federal Circuit, *sua sponte* (that is, without the argument being advanced by any party and without discussing the standard of review of administrative agencies’ factual findings), rejected the Examining Attorney’s finding that the mark TRUMP TOO SMALL created a false association with President Trump: “No plausible claim could be or has been made that the disputed mark suggests that President Trump has endorsed Elster’s product.” Pet. App. 15a. The Court of Appeals did not explain why it ignored the Examining Attorney’s finding below or whether such finding was supported by substantial evidence.

The Examining Attorney’s determination that the mark TRUMP TOO SMALL could create a false association is reasonable. Traditionally, the Republican Party has stood for small government. Presumably, President Trump and some of his supporters think his views are exactly the right size, i.e., the government’s involvement in matters on taxes, education, health care, and other issues should be “small.” For those persons, the TRUMP TOO SMALL mark could create a false association. The TRUMP TOO SMALL mark is not so clearly critical of President Trump that it negates a possible false association.<sup>4</sup>

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<sup>4</sup> Why the Federal Circuit ignored the Examining Attorney’s determination that the trademark created a false association does not matter. The likely explanation, however, is that the Federal Circuit was improperly influenced by the sample t-shirt submitted to the PTO by Elster (but never properly submitted as part of his application) on September 9, 2019. The front graphic states “Trump Too Small” with a picture of a hand; on the back, it states “Trump’s Package Is Too Small. Small on the environment . . .” etc. See *supra*, n. 3, TSDR, Response to Office Action, September 9, 2019, pp. 12–13.

There are multiple reasons why that t-shirt is not justification for the Federal Circuit’s improper decision. First, if the phrase TRUMP TOO SMALL is registered as a standard character trademark, devoid of any stylized element (which is how Elster applied to register it), there is no requirement that Elster use the graphic of the hand or the additional words seen on the back of the t-shirt. A standard character trademark registration would give Elster the right to use TRUMP TOO SMALL by itself. The PTO properly considered the trademark *as applied for*, and whether the trademark *as applied for* could create a false association.

Second, if the additional words and graphics seen on the shirt (which are not part of the trademark and not required to be used)

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are, in fact, used on a t-shirt sold under this mark, the public might, at least if they read and understood the words, including the writing on the back, assume the t-shirt was anti-Trump and therefore, would not think President Trump endorsed such t-shirt. This is assuming they took the time to read the back of the t-shirt, and assuming that they ever knew about the referenced verbal exchange about hand size from the 2016 presidential campaign debate. All of this does assume that they remembered such exchange years later, when seeing a TRUMP TOO SMALL brand t-shirt. (Trademark registrations are valid for ten years and can be renewed.)

Third, Elster's submission of his t-shirt (with the anti-Trump language) was never properly submitted as a specimen of use of the trademark. The way to submit such a specimen is via the filing of the PTO's Statement of Use/Amendment to Allege Use form during the examination process. Had Elster filed the correct form, the PTO would have rejected the sample as merely demonstrating ornamental use of the phrase, and not properly reflecting use of TRUMP TOO SMALL as a brand name/trademark. The photograph of the t-shirt shows that TRUMP TOO SMALL is *not* on the neck label (as can be seen if the individual photograph is downloaded from TSDR). On t-shirts, the trademark (or brand name) usually is displayed on the neck label (think CHAMPION, HANES, NIKE or whomever makes the t-shirt). The PTO does not accept large graphics on the front of t-shirts as evidence of trademark use, because the public considers a large graphic on the front of a t-shirt to be decorative or "ornamental." For example, a picture of an animal or a flower on a t-shirt does not function as a trademark. However, if the graphic or phrase is small on the left pocket, then it might function as a trademark (for example, the LACOSTE ALLIGATOR).

Finally, a careful examination of the t-shirt photo shows that the graphic is photoshopped onto the t-shirt. The t-shirt in the photo has wrinkles; the writing does not. The PTO does not accept photoshopped specimens because they are not actual products being used in commerce.

The Federal Circuit's disregard of the Section 2(a) False Association finding in order to reach the constitutional issue was a mistake, regardless of the reason for such disregard.

Accordingly, in addition to the evidence being undisputed by the parties, the record supports the False Association Clause refusal. The parties, the TTAB and the Federal Circuit all chose to reach the far more intellectual and interesting issue raised by the application of Section 2(c). But this case should have been decided on the statutory false association issue. The record shows that the Examining Attorney's refusal due to false association is, in the case of the mark TRUMP TOO SMALL, supported by substantial evidence.

Should it be necessary for this Court to decide the constitutionality of Section 2(c), it should do so in a case where the trademark does not create a false association.<sup>5</sup>

## **II. PARTIES CANNOT WAIVE STATUTORY GROUNDS THAT ARE A BASIS TO AVOID CONSTITUTIONAL ISSUES.**

The parties asked the Court of Appeals to decide a constitutional issue by purposefully ignoring the alternative, statutory ground with undisputed evidence for refusal of the trademark application in question.

It is a well-established principle governing the prudent exercise of this Court's jurisdiction that normally the Court will not decide a

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<sup>5</sup> For example, the PTO did not raise a False Association refusal as to *Amicus*' application to register the trademark DUMP TRUMP AND LOCK HIM UP, 90340590. Thus, the Section 2(c) issue will be the sole issue in such matter.



constitutional question if there is some other ground upon which to dispose of the case.

*Escambia County, Fla. v. McMillan*, 466 U.S. 48, 51 (1984).

*Amicus* suggests that this Court should remand so the trademark application can be refused under Section 2(a) for false association.<sup>6</sup> “This non-constitutional issue must be met at the outset, because the case must be decided on a non-constitutional issue, if the record calls for it, without reaching constitutional problems.” *Communist Party of United States v. Subversive Activities Control Board*, 351 U.S. 115, 122 (1956).

If the Court decides the Section 2(c) issue on the merits, what will be the ultimate outcome of this case? The false association refusal was never decided on the merits. Thus, the Examining Attorney’s false association refusal still stands. And because Elster did not submit any evidence to contradict the Examining Attorney’s evidence, that finding appears to be supported by substantial evidence. Upon remand, the false association refusal still stands because it was never overturned by either the TTAB or the Federal Circuit. This Court’s decision on the constitutionality of Section 2(c) may be a merely advisory ruling if Elster’s application

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<sup>6</sup> *Amicus* suggests that the constitutionality of Section 2(c) should be deferred until the question arises in a case with a record that properly presents the issue (for example, a case where a mark is refused registration under Section 2(c) that contains such plain criticism of a political figure that no reasonable person would think the subject of the criticism could possibly have endorsed it and therefore there is no False Association refusal).

is still ultimately refused on the false association ground.

Accordingly, this Court should remand with instructions to refuse Elster's application due to the un rebutted false association refusal. This Court should wait to decide the constitutionality of Section 2(c) in a case that clearly presents that issue.

### **III. SECTION 2(c) IS UNCONSTITUTIONAL AS APPLIED TO CRITICAL POLITICAL SPEECH.**

#### **A. SECTION 2(c) IS INCONSISTENT WITH THE PURPOSE OF THE LANHAM ACT.**

The core purpose of the Lanham Act is to prevent consumer confusion and to foster the free flow of commerce by granting rights to trademark owners. *Matal v. Tam*, 582 U.S. 218 (2017) ("*Tam*"). Some provisions in the Lanham Act are not related to that core purpose, such as the Disparagement Clause and the Scandalous and Immoral Clauses. The former was held unconstitutional in *Tam*, while the latter two were held unconstitutional in *Iancu v. Brunetti*, 588 U.S. \_\_\_ (2019) ("*Brunetti*").

Section 2(c) has no function relating to the purpose of the Lanham Act that is not already adequately performed by the Deception and False Association Clauses

of Section 2(a).<sup>7</sup> This is demonstrated by analyzing marks that name a public official and determining when they are subject to Section 2(a) and/or Section 2(c). For example, consider marks that contain the term TRUMP:

Marks that contain the term TRUMP, but do not refer to President Trump, such as LOVE TRUMPS ALL: Neither Section 2(a) nor Section 2(c) apply, because “trump” in this context clearly means “to overcome.”

Marks that express positive or ambiguous opinions about President Trump: Section 2(a) applies. The TRUMP TOO SMALL trademark in this case falls into this category, for the reasons discussed above.

Marks that unambiguously express negative opinions about President Trump, such as *Amicus*' mark DUMP TRUMP AND LOCK HIM UP: Section 2(a) should not apply, because no reasonable person would think that President Trump was associated with or consented to such a mark.

In summary, Section 2(c) serves no confusion-preventing purpose beyond what is already covered by the Deception and False Association Clauses of Section 2(a). Those clauses, as illustrated by this case, are sufficient to prevent any deception or false association. Given the foregoing, what purpose does Section 2(c)

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<sup>7</sup> The PTO applies a four factor test for false association. *Piano Factory Grp., Inc. v. Schiedmayer Celesta GmbH*, 11 F.4th 1363, 1377 (Fed. Cir. 2021); *see also* TMEP § 1203.03(b)(i).

serve? It serves only to suppress negative speech about a political figure. As such, Section 2(c) constitutes a Free Speech restriction that no governmental interest can trump.

### **B. SECTION 2(c) IS VIEWPOINT DISCRIMINATION.**

Section 2(c) is always viewpoint discrimination when applied to trademarks referring to a politician.

The politician will consent only to applications filed with his or her permission. No trademark application critical of a politician has ever received the consent of that politician. And there never will be. Accordingly, in practice, Section 2(c) gives the politician a veto over all expressive trademarks. This is clearly viewpoint discrimination: trademarks approved by the politician are approved; neutral or negative trademarks are refused due to lack of consent. Viewpoint always will be the test for approval or refusal.

### **C. CIVIL LAW MUST GIVE WAY TO FREE SPEECH.**

#### **1. *Sullivan* Prohibits Public Figures from Using Civil Law to Restrict Criticism of Official Conduct.**

This Court has repeatedly held that Free Speech requires limitations on substantive civil law when civil law is used to suppress speech critical of public figures. *See generally New York Times Co. v. Sullivan*, 376 U.S.

254 (1964). The Court in *Sullivan* referred to the “ob-  
solete doctrine that the governed must not criticize  
their governors.” *Id.* at 272. The underlying rationale  
for *Sullivan* is explained in the Court’s quotation of  
*Coleman v. MacLennan*, 78 Kan. 711, 724 (1908):

It is of the utmost consequence that the people  
should discuss the character and qualifica-  
tions of candidates for their suffrages. The im-  
portance to the state and to society of such  
discussions is so vast, and the advantages  
derived are so great, that they more than  
counterbalance the inconvenience of private  
persons whose conduct may be involved, and  
occasional injury to the reputations of individ-  
uals must yield to the public welfare, although  
at times such injury may be great. The public  
benefit from publicity is so great, and the  
chance of injury to private character so small,  
that such discussion must be privileged.

*Sullivan*, 376 U.S. at 281.

Especially pertinent to Section 2(c), the Court  
said, “[P]ublic men are, as it were, public property,”  
“discussion cannot be denied, and the right, as well as  
the duty, of criticism must not be stifled.” *Id.* at 268.  
The *Sullivan* Court held that public figures *cannot* use  
civil law to suppress speech about themselves. The fun-  
damental principle reaffirmed by *Sullivan* is that:

[A]ction brought by a public official against  
critics of his official conduct, abridges the  
freedom of speech and of the press that is

guaranteed by the First and Fourteenth Amendments.

*Id.* at 268.

The difference between *Sullivan* and this case is that, in *Sullivan*, the public figure had to take proactive action by filing a lawsuit, while in cases involving Section 2(c) the public figure can merely refuse to act (i.e., by withholding consent) and let the PTO prohibit the registration of the trademark. This is a distinction without a difference. In either case, the political speech is significantly burdened.

If Section 2(c) serves to prohibit criticism of a politician in connection with his official conduct, then, just as in *Sullivan*, it abridges the Freedom of Speech.

## **2. *Sullivan* Established that No Civil Statute or Tort May Be Used to Suppress Criticism of Political Figures.**

This Court, rather than leaving *Sullivan* as an outlier, has instead applied it in every situation in which public figures have attempted to suppress criticism. *See, e.g., Time, Inc. v. Hill*, 385 U.S. 374 (1967) (extending *Sullivan* to false light invasion of privacy, requiring the public figure to prove actual malice); *see also Hustler Magazine v. Falwell*, 485 U.S. 46 (1988) (actual malice was required for intentional infliction of emotional distress claims asserted by a public figure).

The closest analogous civil tort to Section 2(c) is the Right of publicity. Petitioner avoids any substantive discussion of *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 968 (10th Cir. 1996) by putting it into a string cite. Pet. Brief, 38. In *Cardtoons*, the Tenth Circuit addressed the interaction between Free Speech and the Right of publicity. The court held that Right of publicity must give way to Free Speech when the public figure seeks to use the Right of publicity to prevent social commentary.

Since celebrities will seldom give permission for their identities to be parodied, granting them control over the parodic use of their identities would not directly provide them with any additional income. It would, instead, only allow them to shield themselves from ridicule and criticism.

*Cardtoons*, 95 F.3d at 974.

There is simply no constitutionally-sound basis to allow public figures to suppress expressive trademarks about themselves when there is no false association. The principle in *Sullivan* applies to Section 2(c): Section 2(c) is invalid when applied to marks that comment on political figures.

### **3. Section(c) Substantially Burdens Discussion About Political Figures.**

Trademarks can clearly serve as a form of public discussion. The government has previously argued that refusal of registration does not prohibit use of

the underlying mark and therefore, it does not matter if the Lanham Act's provisions are otherwise unconstitutional. This Court has twice rejected that argument in *Tam* and in *Brunetti*.

Without a PTO registration, an applicant cannot obtain the priority of an intent-to-use application or establish nationwide constructive first use. Without the enjoyment of federal registration, starting a brand or using a trademark is substantially more difficult and riskier.<sup>8</sup> Accordingly, denial of registration is a constitutionally significant undue burden on speech.

#### **4. The Prohibition of Use of the Political Figure's Name in a Trademark is Tantamount to Prohibition of Use.**

In order to engage in a discussion about a political figure, one must refer to him or her. But under Section 2(c), all trademarks referring to any candidate for office are prohibited (unless the candidate approves). How do you critique a political figure or a government official as part of your expressive trademark if the listener does not know to whom you are referring? It is obviously necessary to mention or refer to the subject

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<sup>8</sup> It is obvious that the Unconstitutional Conditions Doctrine applies because the value of federal registration is so important, that denial of a registration is constitutionally significant. The best analogy is that a federal registration is like speaking at Speakers' Corner in Hyde Park. A common law right of ownership is more like being allowed to speak only in a far corner of the park, behind the restrooms.



of the discussion. That is why *Amicus*' marks mention President Trump by name. It is functionally impossible to discuss President Trump without making it clear that he is the individual to whom the discussion refers.

There is no alternative to using the political figure's name or other reference to him or her. The PTO has interpreted Section 2(c) to prohibit not only the use of President Trump's name, but also anything that refers to him. For example, trademark applications referring to "45" (given that President Trump was the 45th president) are refused. All references, direct or indirect, to the public figure are prohibited by Section 2(c), under the PTO's interpretation.

Section 2(c) prohibits not only critical discussion of a public official, but *any* discussion of him at all in expressive trademarks. All discussion in trademarks, whether positive (unless the exact message approved by the official), negative or neutral, is prohibited without the public official's consent, which is never given for critical trademarks. Section 2(c) grants the public official absolute control over any discussion of him or his conduct in office through expressive trademarks.

### **5. The Constitutionality of Section 2(c) Affects the Right to Distribute Products or Services Critical of a Political Figure.**

This Court's ruling on the constitutionality of Section 2(c) has broad implications. Section 2(c) is roughly equivalent to the civil Right of publicity which

prohibits the use of a person’s name, image or personality without his or her permission. The Tenth Circuit in *Cardtoons* recognized a Free Speech exception to the Right of publicity for social commentary. If Free Speech protects social commentary, as in *Cardtoons*, then it applies equally to political commentary in this case. In the political context, products (or services) that use or refer to a politician’s name to provide commentary include, without limitation, books, blogs (as in the case of *Amicus*’ trademark applications), bumper stickers, buttons, hats, pet waste bags, posters, signs, t-shirts (as in the case of Elster’s applications) and toilet paper.<sup>9</sup>

If Section 2(c) and the Right of publicity do not have an exception for political speech, then a politician could prohibit the manufacture or sale of bumper stickers, hats, posters, t-shirts, etc. that support or oppose him or her. Likewise, unless there is a Free Speech exception, unauthorized biographies or other books using a politician’s name or photograph would be a violation of the Right of publicity. To avoid eviscerating the First Amendment, there must be an equivalent exception for political figures in Section 2(c).

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<sup>9</sup> For example, see DUMPS FOR TRUMP (SN 87/154712) for “plastic bags for disposing of pet waste” and JOE AND THE HO HARRIS 2020 (SN 90/018775) for “Political slogan, bumper stickers, signs, flags, window stickers or decals.” Both of these trademark applications were refused registration under Section 2(c).

#### **IV. SECTION 2(c) DOES NOT SURVIVE EITHER STRICT OR INTERMEDIATE SCRUTINY.**

In the event that this matter is not otherwise resolved, then the questions become what level of scrutiny to apply and whether Section 2(c) survives such scrutiny.

The Court in *Tam* could not agree on the level of scrutiny: strict or intermediate. In *Brunetti*, the Court did not even use the word “scrutiny.” Regardless, Section 2(c) is invalid under either level of scrutiny. Accordingly, it may not matter whether the level is strict or intermediate, because the outcome is the same.

##### **A. SECTION 2(c) FAILS STRICT SCRUTINY.**

Section 2(c) restricts speech based on content. The Government restricts speech based on content when “a law applies to particular speech because of the topic discussed or the idea or message expressed.” *Reed v. Town of Gilbert*, 576 U.S. 155, 163 (2015). To be content-neutral, the regulation must be “applicable to all speech irrespective of content.” *Consolidated Edison Co. v. Public Svc. Comm’n*, 447 U.S. 530, 536 (1980).

There is no neutrality of content when the only trademarks excluded are the those to which the political figure chooses not to consent.

Nor is Section 2(c) narrowly drawn. It covers a broad swath of “high-value” or “core” speech. To be narrowly drawn, Section 2(c) would have to be limited only

to trademarks that are deceptive or clearly create a false association; and in which event, Section 2(c) serves no purpose for the Lanham Act beyond those addressed by the Deception and False Association Clauses.

**B. SECTION 2(c) DOES NOT SURVIVE INTERMEDIATE SCRUTINY.**

*Amicus* contends that *Reed* implicitly overruled *Central Hudson Gas & Electric Corp. v. Public Service Commission*, 447 U.S. 557 (1980) as to “content-based regulations of speech” because *Reed* applied strict scrutiny to such regulations. At a minimum, *Reed* implicitly limited *Central Hudson* to purely commercial transactions, such as offers to sell.

However, if it were to be determined that intermediate scrutiny is the appropriate level to apply in this instance, Section 2(c) is still unconstitutional. Under *Central Hudson*, a restriction on speech must serve “a substantial interest,” and it must be “narrowly drawn.” This means, among other things, that “[t]he regulatory technique may extend only as far as the interest it serves.” *Tam*, 582 U.S. at 245 (Alito, J.) (plurality) (citations omitted, quoting *Central Hudson*, 447 U.S. at 564-65).

Here, there is neither empirical support nor sound reasoning for Section 2(c)’s requirement for written consent beyond the prevention of deception already addressed in Section 2(a). Prevention of deception or false association is a valid government interest when such

an interest actually exists. But Section 2(c) goes far beyond preventing deception or false association and gives the public figure a means to deny registration to marks when no deception or false association is possible. For example, no reasonable person could believe that President Trump approves of DUMP TRUMP or INDICT 45 as the name of a blog (as in the case of *Amicus*' pending trademark applications). Deception and false association with President Trump are not plausible with *Amicus*' marks.

The Government has no legitimate interest in protecting the privacy of President Trump because he is a public figure. Further, there can be no legitimate interest in protecting President Trump's Right of publicity when the marks in question comment on his public actions. In other words, if use is allowed, then there is no governmental interest in prohibiting registration.

The statute, in order to be narrowly drawn, would need to exclude public figures. Accordingly, Section 2(c) does not survive intermediate scrutiny.<sup>10</sup>

### **C. SECTION 2(c)'S PROHIBITION OF CRITICISM CHILLS SPEECH.**

The Government argues that allowing registrations of critical trademarks would "chill speech." Pet. Brief, 39. This is a non-issue as the Government

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<sup>10</sup> It is not necessary to address here potential government reasons for rational basis scrutiny because the Supreme Court has always rejected such arguments as applied to the Lanham Act.

acknowledges: “To be sure, that speech-impairing effect is a usual and ordinarily unproblematic consequence of federal trademark registration, and of trademark-protection laws more generally.” *Id.*

The question here is not whether political slogans or the name of political figures can be registered; they can be. Mr. Trump owns dozens of registrations for his name. Other political slogans have been registered or applied for (and would have been granted had the applicant proceeded), as a few examples demonstrate.

<b>CANDIDATE</b>	<b>SLOGAN PHRASE</b>	<b>OWNER</b>
McCain	COUNTRY FIRST, 3760150	Country First Political Action Committee
Bush, Jeb	JEB!, 86505773	BHAG, LLC ( <i>See, “Why Does Jeb Bush Have a Mysterious Shell Company?” Mother Jones, June 29, 2015.</i> ) (abandoned)
Carson	BEN CARSON FOR PRESIDENT 2016, 4903153	Carson America, Inc.
Trump (2016)	MAKE AMERICA GREAT AGAIN, 5885602	Donald J. Trump for President, Inc.

Trump (2020)	KEEP AMERICA GREAT, 87305551	Donald J. Trump for President (allowed, then abandoned)
Bloomberg	MIKE FOR PRESIDENT 2020, 88704463	Mike Bloomberg 2020, Inc. (abandoned, did not reply to an Office Action)

As this Court recognized, trademarks providing political and social commentary are registerable. *Tam*, 582 U.S. at 236 n. 9-14. No one suggests that such trademarks should be refused because they “chill” speech. Nor is there any empirical evidence that granting registrations for political and social commentary has chilled speech in the past chilled. Accordingly, registering trademarks critical of political figures will expand, rather than chill speech.

The “chilling” argument is even less applicable in the Section 2(c) context. Trademarks approved by political figures are registrable, because they give consent to their own applications. The question here is whether critical trademarks must also be allowed. The Government does not argue that registering positive trademarks chills speech. So how can the registration of critical messages incrementally chill speech? It is the *refusal* to register critical trademarks that “chills” speech, by making it more difficult for persons to use such marks.

The Government does not explain how the speculation about the “chilling” of speech justifies the denial of the Free Speech rights of those seeking to register

trademarks. Is that allegedly a “compelling government interest”? It is difficult to see how such speculation is relevant to the issues to be decided by this Court.

## **V. TRADEMARK REGISTERS ARE REGISTRIES, NOT A GOVERNMENT BENEFIT.**

The Government repeats arguments that were either explicitly or implicitly rejected in *Brunetti*. These include government benefit, government subsidy, government speech (which the Government now refers to as the “‘appearance’ of official endorsement”), that refusal of registration is allegedly not sufficiently important to raise constitutional issues, and the assertion that the trademark register is a forum. None of these arguments have ever been accepted by a majority of the Court. These issues are discussed in the Federal Circuit’s opinion below, in *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) and *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017), as well as in the Respondent’s Brief in this Court in *Brunetti*, 18-302, at pages 24 to 30. Accordingly, it is unnecessary to repeat the explanation for the rejection of those arguments here. The Government’s “condition on a government benefit” is really nothing more than a different name for its government



subsidy<sup>11</sup> and government program<sup>12</sup> arguments that were rejected in *Tam*.<sup>13</sup>

The Government tries to distinguish *Tam* and *Brunetti*, primarily by relying on concurring opinions in *Brunetti*, but it is difficult to see how the Disparagement, Scandalous and Immoral Clauses in Section 2(a) are not “conditions on a government benefit” while Section 2(c) allegedly is. A trademark registration is either a government benefit or it is not. The specific reasons for refusing an application (Section 2(a) or Section 2(c)) cannot convert some registrations into government benefits and not others. Either all registrations are government benefits or no registrations are. There is no logical reason why some of the Section 2 subsections

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<sup>11</sup> “The federal registration of a trademark is nothing like the programs at issue in these cases. The PTO does not pay money to parties seeking registration of a mark. Quite the contrary is true: An applicant for registration must pay the PTO. . . .” *Tam*, 582 U.S. at 240 (Alito, J.) (plurality opinion).

<sup>12</sup> “Finally, the Government urges us to sustain the disparagement clause under a new doctrine that would apply to ‘government-program’ cases. For the most part, this argument simply merges our government-speech cases and the previously discussed subsidy cases in an attempt to construct a broader doctrine that can be applied to the registration of trademarks.” *Tam*, 582 U.S. at 241 (Alito, J.) (plurality opinion).

<sup>13</sup> Justice Alito’s opinion in *Tam* was joined by between four and eight justices, depending on the section. There is an interesting legal question about the precedential value of opinions when there is no absolute majority. The application of the Marks Rule (based upon *Marks v. United States*, 430 U.S. 188 (1977)) to *Tam* is discussed in the Respondent’s Brief in *Brunetti*, 18-302, at pages 50–66.

and clauses should be considered “conditions on government benefits” and others not.

Use of a trademark is of value, but federal registration does not grant or create the right to use a trademark. Federal registration is not a precondition for use of a trademark. Thus, federal registration is not a “government benefit” because it does not grant the right to use a trademark.

Granting a trademark registration does not grant any financial benefit, i.e., the registrant does not receive money or property from the government. Nor does the registrant avoid expense (such as using the employer’s mail system). The registrant does not receive any license to operate a business (such as radio broadcasting, carrying passengers, selling pharmaceuticals), mine on federal land, cut timber, or use water from federal projects.

What does a federal trademark registration grant? A registration gives constructive notice and creates legal presumptions about priority of use and exclusive right to use a trademark. In other words, a registration just creates legal presumptions that are recognized in court. Those presumptions are not a government benefit. Furthermore, these legal presumptions were created by Congress in 1946 when it enacted the Lanham Act, not when the PTO grants a registration.

The only possible “benefit” that the PTO creates with registration is the issuance of a certificate confirming the inclusion in the database, which is too tangential and insubstantial to be a “benefit.” The

trademark would be included in the database even if the trademark stopped issuing certificates (and in fact, the PTO no longer issues paper certificates unless specifically requested and a fee is paid).

The Government's argument also fails for the further reason that the PTO's Principal Register and Supplemental Register are registries (or to use more modern parlance, databases). These Registers merely list trademarks that meet the requirements for inclusion on the list. Many Government registries or databases exist.<sup>14</sup> When a deed is accepted for recordal, the purpose is to give notice. The recordal itself is not a "government benefit." When a trademark is registered, the purpose is to give notice. Mere inclusion in a database is not a "government benefit."

Acceptance of the Government's argument would allow governments to refuse to record information for reasons that otherwise would violate the First Amendment. Local governments could refuse recordal of documents relating to, for example, Planned Parenthood, the National Rifle Association, religious organizations

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<sup>14</sup> The Government has many other databases: businesses approved for Government contracts (System for Award Management), drugs (FDA Data Files, Food & Drug Administration), motor carriers (Unified Registration System, Federal Motor Carrier Safety Administration), nonprofit organizations (Tax Exempt Organization Search, Internal Revenue Service), and names of vessels (National Vessel Documentation Center, U.S. Coast Guard). Is merely listing an organization or the name of a boat a "benefit" that allows the government to ignore the First Amendment? Or to require that the organization or boat be renamed in order to be included on the database?

or social organizations, based upon the local government's social agendas and preferences.

And even if a trademark registration were a government benefit, the Unconstitutional Conditions Doctrine would apply. The Unconstitutional Conditions Doctrine stands for the principle that the Government may not condition the availability of a government benefit on an individual's agreement to forego the exercise of such a right. The Government cannot improperly "leverage its power to award subsidies on the basis of subjective criteria into a penalty on disfavored viewpoints." *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 587 (1998); see also *Speiser v. Randall*, 357 U.S. 513, 518 (1958) ("[t]o deny [a benefit] to claimants who engage in certain forms of speech is in effect to penalize them for such speech"). In this case, the Government argues that one has to forego one's Free Speech right to criticize political figures in order to get a trademark registration. That is an unconstitutional condition, even if the Government's condition on a government benefit argument had merit. That means one can never get a trademark registration that criticizes a political figure unless the political figure improbably agrees to such critique.

In short, trademark registration is a registration, not a government benefit that can be granted or withheld based upon otherwise unconstitutional reasons.



**CONCLUSION**

This case is not ripe for consideration of the issue of whether Section 2(c) is constitutional because the trademark application was refused on another ground: the False Association Clause of Section 2(a). If an application is refused on one ground (False Association Clause), it is pointless to consider whether it should also be allowed or refused on another ground (Section 2(c)). This Court should remand to the Federal Circuit, with instructions that the Federal Circuit affirm the refusal to register the trademark TRUMP TOO SMALL pursuant to the False Association Clause.

If the Court reaches the constitutionality of Section 2(c) as applied to trademarks critical of political figures, this Court's precedents are clear that civil law cannot be used to prohibit speech critical of political figures. The Government's claim that Section 2(c) is a "condition on a government benefit" is incorrect as the trademark registries are databases, not government benefits.

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Respectfully submitted,

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