

No. 22-704

In The
Supreme Court of the United States

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

Petitioner,

v.

STEVE ELSTER,

Respondent.

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

**BRIEF OF
AMICUS CURIAE MATTHEW A. HANDAL
IN SUPPORT OF PETITION
FOR A WRIT OF CERTIORARI AND
SUGGESTING *PER CURIAM* REMAND**

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CORPORATE DISCLOSURE STATEMENT

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

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INTEREST OF *AMICUS*¹

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 at the PTO: INDICT 45, SN 90434555.

If the constitutionality of Section 2(c) must be reached someday, it should be decided only when it is necessary to do so and on a record that properly presents the issue.



¹ In compliance with Rule 37.2, *Amicus* notified counsel for the parties more than ten days before this brief’s due date, of his intention to file this brief. Pursuant to Supreme Court Rule 37.6, the *Amicus* states that no counsel for any party authored this brief in whole or in part and that no party, counsel for a party, entity or person, aside from *Amicus* and his counsel, made any monetary contribution toward the preparation or submission of this brief.

SUMMARY OF ARGUMENT

The Court should grant certiorari and then remand *per curiam* to the Federal Circuit for affirmance of the refusal to register the trademark in question under Section 2(a)'s False Association Clause, 15 U.S.C. §1052(a).²

The record has an undisputed statutory ground for refusing to register the trademark in question: the False Association Clause of Section 2(a) of the Lanham Act. The parties did not dispute that the False Association Clause applied as a factual matter. Upon appeal to the Federal Circuit, the Applicant (the Respondent herein) abandoned his argument that Section 2(a) was unconstitutional. Accordingly, it was undisputed that Section 2(a) was factually applicable and that such refusal was constitutional. Section 2(a) would have been a sufficient ground to refuse the application in question. It was unnecessary to reach the issue of the constitutionality of Section 2(c) as applied to marks that contain speech critical of government officials or public figures.

The Federal Circuit chose to virtually ignore the undisputed Section 2(a) statutory ground for refusal of the application, and instead chose to only consider the constitutionality of Section 2(c). The Federal Circuit summarily concluded that “no plausible claim could be . . . made that the disputed mark suggested that

² As used herein, “Section 2(a)” is used to refer only to the False Association Clause of that subsection. Section 2(a) has other provisions, but they are not relevant to this case.

President Trump has endorsed [respondent's] product." Pet. App. 15a. But the Court of Appeals did not say why it chose, *sua sponte*, to ignore the administrative agency's finding that the mark created a false association. Neither party disputed the factual determination that the mark TRUMP TOO SMALL created a false association in violation of Section 2(a). Accordingly, the Section 2(a) refusal was grounds to affirm the refusal without reaching the constitutionality of Section 2(c).

As this Court has written: "It is a well established principle governing the prudent exercise of this Court's jurisdiction that normally the Court will not decide a 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).

Thus, this Court could avoid deciding the constitutionality of Section 2(c) as applied to the trademark application in this case.



STATUTORY PROVISIONS AT ISSUE

This matter involves Sections 2(a) and (c) of the Lanham Act, 15 U.S.C. Section 1052(a) and (c).

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, . . . 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.



**REASON FOR GRANTING CERTIORARI
AND REMANDING *PER CURIAM***

**I. IT IS UNDISPUTED THAT A STATUTORY
GROUND EXISTS TO REFUSE REGISTRA-
TION OF THE TRADEMARK: SECTION
2(a)'s PROHIBITION OF TRADEMARKS
THAT CREATE A FALSE ASSOCIATION**

The PTO refused registration for the mark TRUMP TOO SMALL under the False Association Clause of Section 2(a) because it was found by the PTO to create a false association as well as under Section 2(c) because it uses the name of a living individual without his consent. When the Applicant abandoned its challenge to the PTO's refusal of his application under Section 2(a), that ground for refusal remained – and still remains – undisputed and, therefore, valid.

The undisputed refusal of the application under Section 2(a) is sufficient ground upon which to resolve this case, without invoking the need to determine the constitutionality of Section 2(c).

The PTO's Examining Attorney refused registration of the mark TRUMP TOO SMALL on two separate and independent grounds. 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. 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 on February 25, 2019 in a Denial of Applicant's Request for Reconsideration.³ The Applicant appealed to the TTAB.

After the appeal to the TTAB was filed, the Examining Attorney requested remand on May 31, 2019,⁴ which was granted. In another Office Action dated June 24, 2019, the Examining Attorney added the additional new and independent ground of Section 2(a) for refusing registration, asserting that the applied-for trademark created a false association with Donald J. Trump. Pet. App. 41a – 51a. On September 9, 2019, in response to the Office Action, the Applicant did not dispute the PTO's factual contention that his mark created a false association; he only argued that Section

³ 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).

⁴ See *supra*, n. 3.

2(a) was unconstitutional.⁵ In a Final Office Action issued October 7, 2019, the refusals under *both* Section 2(a) and 2(c) were maintained by the PTO (Pet. App. 33a – 40a), and the matter was returned to the TTAB.

The TTAB affirmed the refusal solely based on Section 2(c). Pet. App. 22a – 32a. Without explanation, it chose not to consider the Section 2(a) ground for refusal. Pet. App. 33a.

Before the Federal Circuit, Applicant conceded that Section 2(a) is 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). Given that the factual basis for the False Association refusal under Section 2(a) was never disputed, and that the challenge to Section 2(a) was abandoned, there is sufficient basis to affirm the refusal. If an application is refused on one ground (Section 2(a), false association), it does not matter whether it should or should not be refused on a separate, independent ground (Section 2(c), name of living individual). One basis for refusal is enough for the refusal to stand.

In the Federal Circuit, both the Applicant and the PTO asked for a determination of the constitutionality of Section 2(c) but both ignored the undisputed Section 2(a) ground for the refusal. The Federal Circuit was aware of the issue because this *Amicus* filed an *amicus*

⁵ See *supra*, n. 3.

brief, bringing this issue to the Court of Appeals' attention. *See Amicus* Brief, CAFC Dkt. 23. The Federal Circuit acknowledged that it was ignoring this non-constitutional basis for deciding the case. In footnote 3 of its opinion, it wrote:

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*, and without discussing the standard of review of administrative agency factual findings, rejected the Examining Attorney's finding that the TRUMP TOO SMALL trademark created a false association with Mr. 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 did not explain why it ignored the undisputed finding below. Nor did the court address the standard of deference to be given to the Examining Attorney's findings.

The Examining Attorney's finding that the mark TRUMP TOO SMALL could create a false association, in addition to being undisputed, is entirely plausible. Traditionally, the Republican Party has stood for small government. Presumably, some Trump supporters think Trump's views are the right size, i.e., the federal

government involvement with issues concerning the environment, health care, immigration, and others 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 Trump that it prevents any possibility of a false association.⁶ Accordingly, in addition to being undisputed

⁶ Why the Federal Circuit improperly rejected the undisputed factual finding of a false association does not matter. The likely explanation is that the Federal Circuit was influenced by the sample t-shirt submitted to the USPTO by the Applicant 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, there is no requirement that Applicant 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 Applicant 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 contained on the specimen (which are not part of the trademark) 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 Trump endorsed such t-shirt. Assuming they took the time to read the back of the t-shirt. Assuming that they ever knew about the referenced verbal exchange from the 2016 presidential campaign debate. Assuming they remembered the exchange years later when seeing a TRUMP TOO SMALL brand t-shirt. (Trademark registrations are valid for ten years, and can be renewed.)

by the parties, the record supports the refusal under Section 2(a) due to a false association.

Since the factual basis for the Section 2(a) refusal was undisputed and the constitutionality of Section 2(a) was never disputed upon appeal, that should have been sufficient grounds to affirm the refusal of the application.

Third, Applicant'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 specimen is the PTO's Statement of Use/Amendment to Allege Use form. Had Applicant 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 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 (think the LACOSTE ALLIGATOR).

Finally, a careful examination of the t-shirt shows the graphic is photoshopped on. The t-shirt 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 basis for such disregard.

II. PARTIES CANNOT WAIVE STATUTORY GROUNDS THAT WOULD GIVE A COURT A BASIS TO AVOID DECIDING CONSTITUTIONAL ISSUES

The parties asked the Court of Appeals to decide a constitutional issue by purposefully ignoring the undisputed statutory ground for refusal of the trademark application in question. This Court's views are:

It is a well established principle governing the prudent exercise of this Court's jurisdiction that normally the Court will not decide a 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 not unnecessarily decide the constitutionality of Section 2(c). Because this Court is being asked to hold Section 2(c) unconstitutional as applied, if the refusal is affirmed based upon Section 2(a), then this specific as-applied challenge need not be decided at all.⁷ “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).

⁷ The constitutionality of Section 2(c) might or might not arise in a later case. That cannot now be predicted with certainty. *Amicus* suggests that the question should be deferred until and unless the constitutionality of such statute cannot be avoided and/or, as is equally important, it arises in a case with a record that properly presents the issue.

The Court should consider what happens, given this record, if it holds Section 2(c) unconstitutional as applied. The matter will be remanded back to the PTO. The PTO's determination that the application must be refused due to Section 2(a) still stands. The application will be refused under Section 2(a). The Court's decision on Section 2(c) will have been pointless because the application is still refused.

◆

CONCLUSION

This case is not ripe for consideration of the issue of whether Section 2(c) is constitutional. The False Association Clause of Section 2(a) is an undisputed ground for affirming the refusal of the application in this case. This Court should grant certiorari, and then remand *per curiam* to the Federal Circuit with instructions that the Federal Circuit affirm the refusal to register the trademark TRUMP TOO SMALL pursuant to Section 2(a) since that ground for refusal is not disputed either factually or legally by the parties.

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