

No. 22-704

In the Supreme Court of the United States

KATHERINE K. VIDAL, Under Secretary of Commerce for
Intellectual Property and Director, United States Patent
and Trademark Office,

Petitioner,

v.

STEVE ELSTER,

Respondent.

On Writ of Certiorari to the
United States Court of Appeals for the Federal Circuit

BRIEF OF RESPONDENT

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*Christian Legal Society Chapter of the University of
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<i>Haelan Laboratory, Inc. v. Topps Chewing Gum, Inc.,</i> 202 F.2d 866 (2d Cir. 1953)	30
<i>Healy v. James,</i> 408 U.S. 169 (1972)	41
<i>Heffron v. International Society for Krishna Consciousness, Inc.,</i> 452 U.S. 640 (1981)	32
<i>Hill v. Colorado,</i> 530 U.S. 703 (2000)	21

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<i>Ibanez v. Florida Department of Business & Professional Regulation, Board of Accountancy</i> , 512 U.S. 136 (1994)	27
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<i>In re R.M.J.</i> , 455 U.S. 191 (1982)	34, 35
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<i>Pitt News v. Pappert,</i> 379 F.3d 96 (3d Cir. 2004)	42
<i>Qualitex Co. v. Jacobson Products Co.,</i> 514 U.S. 159 (1995)	5
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<i>White Coat Waste Project v. Greater Richmond Transit Co.</i> , 35 F.4th 179 (4th Cir. 2022)	37, 39
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<i>Ysursa v. Pocatello Education Association</i> , 555 U.S. 353 (2009)	37
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15 U.S.C. § 10575
15 U.S.C. § 10655
15 U.S.C. § 10725
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H.R. 6683, 70th Cong. (1928).....8
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Pub. L. No. 68-263, 43 Stat. 647 (1924)8

Other Authorities

Mark Bartholomew,
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Elena Kagan,
*The Changing Faces of First Amendment
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J. Thomas McCarthy & Roger R. Schechter, <i>The Rights of Publicity and Privacy</i> (2d ed. 2023)	30, 31
J. Thomas McCarthy, <i>McCarthy on Trademarks and Unfair Competition</i> (5th ed. 2023)	10, 11, 29, 30, 31, 36
Robert C. Post & Jennifer E. Rothman, <i>The First Amendment and the Right(s) of Publicity</i> , 130 Yale L.J. 86 (2020)	30
Restatement (Third) of Unfair Competition § 46 (1995)	29, 31, 35
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Trademark Manual of Examining Procedure (July 2022)	11, 21
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<i>Trade-Marks: Hearing on H.R. 5461 Before the Subcommittee On Trade-Marks, House Committee On Patents</i> , 77th Cong. (1941)	10
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Eugene Volokh, <i>Freedom of Speech and the Right of Publicity</i> , 40 Hous. L. Rev. 903 (2003).....	20

INTRODUCTION

This case marks the third time in six years that this Court must decide whether a statutory restriction on trademark registration satisfies the First Amendment. In the first two cases, the Court invalidated provisions of the Lanham Act barring registration of disparaging marks, *Matal v. Tam*, 582 U.S. 218 (2017), and immoral or scandalous marks, *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019). It did so because those provisions targeted private speech for disfavored treatment based on its message.

The provision here has the same provenance as those in *Tam* and *Brunetti*. It bars the registration of any mark “identifying a particular living individual” without their written consent—a prohibition that also extends, uniquely, to “a deceased President of the United States during the life of his widow.” 15 U.S.C. § 1052(c). As the drafter of this “names clause” candidly explained at the time, it was added because Congress found the “idea of prostituting great names by sticking them on all kinds of goods” to be “very distasteful,” and wanted “to prevent such outrages of the sensibilities of the American people.”

The clause has had its intended effect. It has been interpreted to apply primarily to “celebrities and world-famous political figures.” Pet. App. 28a. And, by requiring consent, it effectively precludes the registration of *any* mark that criticizes public figures—even as it allows them to register their own positive messages about themselves. So, under the clause, JOE 2020 has been registered, but not “No Joe in 2024.” HILLARY FOR AMERICA has also been registered. But not “Hillary for Prison 2016.” And BIDEN PRESIDENT is registered, while “Impeach 46” was denied.

This case involves another paradigmatic example. Invoking a memorable exchange from a 2016 presidential

debate, Steve Elster sought to register the words “Trump too small” for use on T-shirts, with an illustration of a mocking hand gesture, to convey a political message about former President Trump and his policies. But Elster could not secure consent. So his application was denied.

As the Federal Circuit correctly held, the names clause is unconstitutional as applied to the mark in this case. Its text imposes a content-based and speaker-based burden on speech. And its “purpose and practical effect” are likewise aimed at suppressing unwanted speech and skewing the debate about public figures. *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 565 (2011). For these reasons, heightened scrutiny is warranted. Here, the law cannot survive even intermediate scrutiny.

Rather than try to justify the law under scrutiny, the government devotes its brief to arguing that the clause does not restrict any speech, but simply imposes a condition on a benefit, and should therefore be evaluated under a “reasonable basis” test. That argument is wrong and should be rejected. But the Court need not do so because the clause is so indefensible that it fails any level of scrutiny. Even under a reasonableness standard, the government must put forth a justification, identify a real-world harm, and show that the measure it is defending is no broader than necessary and poses no risk of viewpoint discrimination. *See Nat’l Inst. of Fam. & Life Advoc. v. Becerra*, 138 S. Ct. 2361, 2377 (2018). The government has not done that. It identifies no real-world harm addressed by the clause. And it offers no defense of the clause’s improper censorial motive or viewpoint-based effects. Thus, consistent with *Tam* and *Brunetti*, and with the approach taken in *Becerra*, the Court may chart a narrow course and hold that this law fails any standard of review.

STATEMENT

I. Legal background

A. Trademarks' source-identifying function

The most basic function of a trademark is to “tell[] the public who is responsible for a product”—in other words, to identify a product’s source. *Jack Daniel’s Props., Inc. v. VIP Prod. LLC*, 599 U.S. 140, 146 (2023). “In serving that function, trademarks benefit consumers and producers alike.” *Id.* They ensure that, when consumers buy a COCA-COLA, pick up a copy of THE WALL STREET JOURNAL, or donate to the DEMOCRATIC NATIONAL COMMITTEE, they are getting what they want. By the same token, trademarks allow producers to build up, and to reap the benefits of, their own goodwill.¹

Yet trademarks often do “far ... more than identify a good or service.” *Tam*, 582 U.S. at 224. They often seek to “catch a consumer’s eye, appeal to his fancies, and convey every manner of message.” *Jack Daniel’s*, 599 U.S. at 146. Trademarks like JUST DO IT or THINK DIFFERENT are effective not simply because they inform consumers which company is responsible for the product (NIKE or APPLE would do that just fine), but because they communicate something about the beliefs, values, or ideals of those companies. The same goes for marks across a range of businesses—from for-profit media companies (ALL THE NEWS THAT’S FIT TO PRINT, FAIR & BALANCED, and DEMOCRACY DIES IN DARKNESS) to nonprofit groups (ALLIANCE DEFENDING FREEDOM, AMERICAN CIVIL

¹ This brief uses small caps when a trademark has been federally registered. In addition, unless otherwise noted, all internal quotation marks, citations, alterations, brackets, and ellipses have been omitted from quotations throughout this brief.

LIBERTIES UNION, and AMERICANS FOR PROSPERITY). In the marketplace for goods or services, no less than the “marketplace of ideas,” *Tam*, 583 U.S. at 252 (op. of Kennedy, J.), all sorts of “powerful messages” vie for our attention and favor, *id.* at 239 (op. of the Court). For that reason, this Court held in *Tam* that trademarks are private speech and receive First Amendment protection.

B. The focus on source confusion

Trademark law is primarily aimed at the source-identifying function of marks. It seeks, above all else, to eliminate “confusion about the source of a product,” so that “consumers can tell where goods come from” and the market can operate more efficiently. *Jack Daniel’s*, 599 U.S. at 147, 163. That’s always been the chief concern of trademark law: The right of trademark owners to enjoin the use of marks that are so similar “as to be likely to produce confusion,” *Am. Steel Foundries v. Robertson*, 269 U.S. 372, 381 (1926), was “long recognized by the common law and the chancery courts of England and of this country,” *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879). This traditional right is also consistent with the “well settled” constitutional rule that the government may prohibit “confusing” or “misleading” commercial speech. *Tam*, 582 U.S. at 252 (op. of Kennedy, J.); see *Jack Daniel’s*, 599 U.S. at 159 (“When a challenged trademark use functions as source-identifying, trademark rights play well with the First Amendment.”).

C. The Lanham Act and its registration system

“The foundation of current federal trademark law is the Lanham Act.” *Tam*, 582 U.S. at 224. “Though federal law does not create trademarks,” the Lanham Act plays an important “role in protecting them.” *B & B Hardware v. Hargis Indus.*, 575 U.S. 138, 142 (2015).

The foundation of that protection is the Act's registration system, which "helps to ensure that trademarks are fully protected and supports the free flow of commerce." *Tam*, 582 U.S. at 225. "The central purpose of trademark registration" is likewise "to facilitate source identification." *Id.* at 253 (op. of Kennedy, J.). While "not mandatory," *Brunetti*, 139 S. Ct. at 2297, "registration is significant" because "so many important rights attach" to it. *B & B Hardware*, 575 U.S. at 142, 160 (cleaned up); see *id.* at 142 (noting "seven ... procedural and substantive legal advantages of registration"). "Registration, for instance, serves as 'constructive notice of the registrant's claim of ownership' of the mark." *Id.* at 142 (quoting 15 U.S.C. § 1072). It is "prima facie evidence of the validity of the registered mark ... and of the owner's exclusive right to use the registered mark in commerce." *Id.* (quoting 15 U.S.C. § 1057(b)). And it "is a precondition for a mark to become 'incontestable,'" which is "a powerful protection." *Id.* at 159 (quoting 15 U.S.C. § 1065).

"Consistent with trademark law's basic purpose, the lead criterion for registration is that the mark in fact serve as a trademark to identify and distinguish goods." *Jack Daniel's*, 599 U.S. at 146. If it does so, and registration is sought, federal law generally requires that all the rights and benefits of registration be given. See *Brunetti*, 139 S. Ct. at 2298. Because "almost anything at all that is capable of carrying meaning" can function as a mark, *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995), "the Government has provided the benefits of federal registration to millions of marks identifying every type of product and cause"—with a "wide diversity of ... messages," *Tam*, 582 U.S. at 253 (op. of Kennedy, J.).

Like most general rules, however, the Lanham Act contains certain exceptions. *See* 15 U.S.C. § 1052. These statutory exceptions “direct[]” the Patent and Trademark Office to categorically refuse registration of certain marks. *Brunetti*, 139 S. Ct. at 2298.

Many of the exceptions advance the core purpose of the law. For instance, section 2(d) of the Lanham Act bars registration of “a mark that ‘so resembles’ another mark as to create a likelihood of confusion.” *Id.* (quoting 15 U.S.C. § 1052(d)). Section 2(e) bars registration of a mark that is “merely descriptive or deceptively misdescriptive” of goods. 15 U.S.C. § 1052(e). And section 2(a) bars registration of a “deceptive” mark or a mark that may “falsely suggest a connection with persons, living or dead, [or] institutions.” *Id.* § 1052(a). Each of these exceptions “directly furthers the goal of prevention of consumer deception in source-identifiers.” *In re Adco Indus.-Techs., L.P.*, 2020 WL 730361, at *13 (T.T.A.B. 2020).

D. The prohibitions on disparaging marks and on marks including the names of presidents and others

But the Lanham Act includes other exceptions that do not serve its core goal of preventing source confusion. Section 2(a)—in addition to its bar on deceptive marks—includes a bar on “immoral” or “scandalous” trademarks, and on marks that “may disparage” people, “institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” 15 U.S.C. § 1052(a). This Court invalidated these provisions in *Tam* and *Brunetti*, in part because they went “much further than is necessary to serve” their purported purposes. *Tam*, 582 U.S. at 246. As Justice Alito explained in *Tam*, the disparagement bar would restrict a trademark stating that “James Buchanan was a

disastrous president.” *Id.* Such a restriction is “far too broad” for a law limiting expression. *Id.*

The provision at issue here, section 2(c), also covers criticism of presidents. It bars any mark that “comprises a name ... identifying a particular living individual except by his written consent,” as well as marks that include “the name ... of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.” 15 U.S.C. § 1052(c). Unlike section 2(a), this names clause is not focused on marks that are false or misleading. Just the opposite: Given section 2(a), its only practical effect is to cover *non*-misleading marks.

**E. The history and purpose of the names clause:
to suppress “distasteful” speech and “prevent
such outrages of the sensibilities of the
American people”**

1. The history of the names clause shows that this is no accident. When Congress enacted the Trade Mark Act of 1905, a precursor to the Lanham Act, it provided for a more limited registration system and barred registering marks that could confuse or mislead, as well as marks that contained another living person’s portrait. Pub. L. No. 58-84, § 5, 58 Stat. 724, 725-26 (1905). The statute did not require consent to register a mark that included another person’s name. Nor did it prohibit using a president’s name.

The Patent Office, however, adopted a policy of refusing to register marks containing the name of a president. *See* Mark Bartholomew, *Trademark Morality*, 55 Wm. & Mary L. Rev. 85, 148 (2013) (discussing the Patent Office’s 1909 refusal to register a mark for Grover Cleveland cigars, despite his consent). As the agency explained in 1909: “To use the names of ex-Presidents of

the United States as trademarks tends to detract from the dignity of the high office which they have held, and for that reason it is believed that it is against public policy for the Patent Office to encourage such use of their names by allowing them to be registered as trademarks.” *Id.*

Four months after Woodrow Wilson’s death, in 1924, Congress began to embrace a similar view. It extended the portrait prohibition to cover deceased presidents during the lifetimes of their widows. Pub. L. No. 68-263, 43 Stat. 647 (1924). And, within a few years, early versions of what would later become the Lanham Act began to include a prohibition on using a president’s (and *only* a president’s) name. *See, e.g.*, H.R. 6683, 70th Cong. § 2(c) (1928). But the legislation stalled in Congress, and then went dormant. That began to change in 1938. After this Court’s decision in *Erie Railroad Co. v. Tompkins*, 304 U.S. 64 (1938), which abolished general federal common law, it became apparent that federal trademark law required a stronger, uniform statutory basis.

2. That’s when the names clause entered the picture. In 1938, Congress held a hearing on a new bill introduced by Representative Lanham. During the hearing, Lanham and Edward Rogers (the architect and primary drafter of the Lanham Act) expressed their view that the Trade Mark Act’s portrait prohibition “ought to be broadened” to “prevent the use of the name of the President or any other well-known American character.” *Trade-Marks: Hearing on H.R. 9041 Before the Subcomm. On Trade-Marks, H. Comm. On Patents*, 75th Cong. 79 (1938).²

² “Rogers is the man who actually wrote the language of the ... Lanham Act” and who “wrote all” “nineteen bills over the course of more than twenty years [preceding the Act].” Jessica Litman, *Keynote Address*, 39 *Cardozo Arts & Ent. L.J.* 855, 856 (2021).

They were candid about why. As Rogers put it: “The idea of prostituting great names by sticking them on all kinds of goods is very distasteful to me.” *Id.* The Commissioner of the Patent Office at the time agreed, describing the “shock to [his] sense of propriety to see liberty taken not only with the names of our Presidents, but with the names of celebrities of private life.” *Id.* Highlighting several recent examples of marks that used celebrity names in unflattering ways, he believed that the clause “should be broadened” to also “include national and international celebrities ... to prevent such outrages of the sensibilities of the American people.” *Id.* at 80. Immediately following this exchange, Lanham called for the prohibition to be “redrafted to accomplish the purposes that we all have in mind.” *Id.*

Rogers then produced a new version that included not only the names clause but also the disparagement clause found in section 2(a). *See* H.R. 4744, 76th Cong. § 2 (1939). Some thought that even these additions were too narrow. Thomas Robertson, a former patent commissioner, wanted the deceased-president clause to extend beyond the lifetime of the widow, so that there would be neither “Abraham Lincoln gin” nor “George Washington coffee.” *Trade-Marks: Hearing on H.R. 4744 Before the Subcomm. On Trade-Marks, H. Comm. On Patents, 76th Cong. 19 (1939).* But Rogers stated that, while he “quite agree[d] that Abraham Lincoln gin ought not be used,” he “would not say the use of G. Washington on coffee should not be permissible.” *Id.* So he kept the provision as is. Thus, under the revised bill, as Robertson observed, the disparagement clause would not automatically “cover the use of an ex-President’s name” in a trademark (like “George Washington coffee”). *Id.* at 21. But the names clause would—at least for so long as the president or his

widow had a dignitary interest in the use of his name. The clause ensured that, while he or his widow are living, a president's name would not be used on any trademark in any way in which they "might not desire it used." *Id.*

In short, as one scholar recently put it: "The [names clause] was adopted to preserve the dignity of those depicted without consent," including—for presidents—"the dignity of the deceased and their surviving family." Rothman, *Navigating the Identity Thicket: Trademark's Lost Theory of Personality, the Right of Publicity, and Preemption*, 135 Harv. L. Rev. 1271, 1308 (2022).

Not everyone supported the addition of the names clause. In 1941, a former First Assistant Examiner for Trademarks urged Congress to remove the clause because, "[w]hile portraits and signatures of particular individuals belong to such individuals they have no exclusive right to their names." *Trade-Marks: Hearing on H.R. 5461 Before the Subcomm. On Trade-Marks, H. Comm. On Patents, 77th Cong.* 216 (1941). Congress declined. The names clause became the law in 1946 when the Lanham Act was enacted. As a result, while section 2(a) prohibits using someone's name in a way that may "falsely suggest a connection," the names clause exists to go beyond that, sweeping in non-deceptive uses.

F. The PTO's interpretation of the names clause

Consistent with this history, the PTO has interpreted the names clause so that its only practical effect is to cover non-deceptive marks about "celebrities and world-famous political figures." Pet. App. 28a. The agency has explained that the clause serves to protect the "privacy" interest of these well-known individuals, *id.* at 57a—an interest that, as this Court has noted, concerns a person's "feelings or reputation," *Zacchini v. Scripps-Howard Broad. Co.*, 433

U.S. 562, 573 (1977); *see also* 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 28:6 (5th ed. 2023) (“The right to privacy protects against ... damage to human dignity” and “injury to the psyche.”).

Over time, the PTO has also begun to seize on another rationale—one that didn’t exist when the Lanham Act was enacted: protecting the modern right of publicity. *See Trademark Manual of Examining Procedure (TMEP)* § 1206, at 1200-211 (July 2022) (stating that the clause protects “privacy and publicity” rights). This right, in contrast to the right of privacy, “protects against commercial loss” from the commercial use of someone’s name. 5 *McCarthy on Trademarks* § 28:6.

II. Procedural background

A. Agency proceedings

This case is an example of the names clause in action. Steve Elster sought to register the trademark “Trump too small” for use on shirts and hats. Pet. App. 1a-2a. As he told the PTO, the phrase (which is accompanied by an illustration of a derogatory hand gesture) is “political commentary” targeted at former president Trump. Pet. App. 2a. The mark criticizes Trump by using a double entendre, invoking a widely publicized exchange from a 2016 Republican primary debate in which Trump commented about his anatomy, while also expressing Elster’s view about “the smallness of Donald Trump’s overall approach to governing as president of the United States.” Fed. Cir. App. 138.

The PTO examiner found no conflicting marks that would bar registration under section 2(d). Pet. App. 60a. Nevertheless, the examiner refused registration on two grounds: under section 2(c), because the mark includes

Trump's name without his consent, *id.* at 52a-59a, and under section 2(a), because the mark "may falsely suggest a connection with Donald Trump," *id.* at 33a-39a.

Elster appealed to the Trademark Trial and Appeal Board, which affirmed under section 2(c) without reaching the section 2(a) question. *Id.* at 22a-32a. The Board found it undisputed that the mark includes Trump's name without his consent, and applied section 2(c) on that basis. *Id.* at 25a. The Board rejected Elster's argument that the public would not be confused about the source of the message because Trump would obviously never endorse it. *Id.* at 26a. "Unlike Section 2(a)'s explicit statutory requirement that the matter in question 'falsely suggest a connection,'" the Board wrote, section 2(c) "applies regardless of whether there is a suggested connection." *Id.* at 27a. The "key purpose of requiring the consent ... is to protect rights of privacy and publicity that living persons have in the designations that identify them." *Id.* at 23a. Given that purpose, the Board concluded that the relevant question is not whether the public is confused, but whether it "would perceive the name in the proposed mark as identifying a particular living individual." *Id.* at 27a. Because Trump "is extremely well known" and had not consented, no more was required. *Id.* at 28a.

B. Federal Circuit proceedings

The Federal Circuit reversed. In a unanimous opinion, the court followed *Tam* and *Brunetti* and held that "applying section 2(c) to bar registration of Elster's mark unconstitutionally restricts free speech." *Id.* at 1a.

The court first held that the statute was subject to at least intermediate scrutiny under *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, 447 U.S. 557, 566 (1980). Pet App. 9a. In doing so, it

rejected the government’s argument that a trademark-registration bar should be evaluated more deferentially because it is akin to the denial of a government subsidy or to a restriction in a nonpublic forum. Those arguments, the court concluded, find “little support in the Supreme Court’s opinions in *Tam* and *Brunetti*.” *Id.* at 5a-8a.

The court then applied the intermediate-scrutiny test to the record before it. In doing so, it noted that the “First Amendment interests here are undoubtedly substantial,” involving speech “otherwise at the heart of the First Amendment.” *Id.* at 10-11a. Those important interests are not “outweighed” by any governmental interest in “protecting state-law privacy and publicity rights.” *Id.* at 11a. “[T]here can be no plausible claim,” the court explained, “that President Trump enjoys a right of privacy protecting him from criticism.” *Id.* at 12a. And the “right of publicity does not support a government restriction on the use of a mark because the mark is critical of a public official without his or her consent.” *Id.* at 16a. Although the government may prevent deceptive marks, there is “[n]o plausible claim” suggesting that “President Trump has endorsed Elster’s product.” *Id.* at 15a.

SUMMARY OF ARGUMENT

I.A. “Trademarks are private, not government, speech.” *Tam*, 582 U.S. at 239. So when a statute draws content- and speaker-based distinctions as to which marks are registerable, it must satisfy the First Amendment.

On its face, the names clause draws just those lines. It bars registering any mark that has a “name ... identifying a particular living individual” without written consent. 15 U.S.C. § 1052(c). As the government concedes, this text disfavors certain speech based on content. That alone “is sufficient to justify application of heightened scrutiny.”

Sorrell, 564 U.S. at 571. Yet the clause is also speaker-based. It allows public figures to use their names to promote messages about themselves—but no one else. And by requiring consent, the clause hands public figures what is akin to a heckler’s veto, allowing them to control the message conveyed about them on registered marks.

Because the names clause “on its face” “imposes a burden based on the content of speech and the identity of the speaker,” heightened scrutiny is warranted. *Id.* at 567.

B. The “purpose and practical effect” of the clause only reinforce the need for heightened scrutiny. *Id.* at 565.

Its purpose was to suppress unwanted speech. It was added to the statute alongside the disparagement clause, and to address the same concern. The Act’s drafters found the “idea of prostituting great names by sticking them on all kinds of goods” to be “very distasteful,” and wanted “to prevent such outrages of the sensibilities of the American people.” 75th Cong. 79-80. That rationale “strikes at the heart of the First Amendment.” *Tam*, 582 U.S. at 246 (op. of Alito, J.). “A speech burden based on audience reactions is simply government hostility ... in a different guise.” *Id.* at 250 (op. of Kennedy, J.). That improper censorial motive confirms the need for heightened scrutiny.

In its practical operation, moreover, the clause verges on viewpoint discrimination. Because no one would ever consent to the registration of speech that insults them, the clause effectively precludes the registration of *all* marks that disparage or criticize living people. That viewpoint-based effect only further reinforces the need for scrutiny.

C. But how much scrutiny? Under this Court’s cases, the answer is generally strict scrutiny. The speech at issue here, moreover, expresses a political opinion about a

former (and current candidate for) president, and is being regulated simply because it identifies him by name. So this is hardly a scenario where the Court should relax its guard. Ultimately, however, the Court need not decide whether strict scrutiny is appropriate because the law “cannot withstand even *Central Hudson* review.” *Id.* at 245 (op. of Alito, J.).

II. The government does not even attempt to show that the clause satisfies *Central Hudson* scrutiny. And it does not. No legitimate governmental interest justifies the law’s content- and speaker-based regulation of speech.

A. The government no longer asserts any interest in protecting the public’s sensibilities or shielding politicians from hurt feelings. It instead invokes the right of publicity as the clause’s main justification. But the privacy rationale cannot be so conveniently forgotten. That was the only rationale that was asserted, or even existed, when the clause was enacted. And the clause’s text only underscores Congress’s focus on dignitary harms. Like the right of privacy, but not publicity, the clause applies only during the lifetime of the person protected. The sole carve-out is for a president’s widow, which likewise sounds in dignitary concerns. The clause’s text and history therefore reveal an “impermissible purpose to burden disfavored speech,” which itself “render[s] it unconstitutional.” *Sorrell*, 564 U.S. at 566, 574-75.

B. The clause is also an astonishingly poor fit to serve any legitimate interest in protecting the right of publicity. In practice, the clause applies only to speech about well-known public figures that doesn’t confuse as to the source, isn’t deceptive, and doesn’t imply a false endorsement. The government cites no examples in which such speech has ever given rise to right-of-publicity liability. If

anything, the government does the opposite: It concedes that the right of publicity does not trump Elster’s First Amendment right to express his political message on T-shirts and as part of his brand name. Under *Central Hudson*, the government “cannot regulate speech that poses no danger to [its] asserted [] interest.” 447 U.S. at 565. The government has no legitimate interest in facilitating state tort law beyond what the First Amendment would allow. And a narrower restriction is readily available: Congress could have easily exempted political commentary from the clause—just like the state laws that it is purportedly designed to protect.

C. Nor can the clause be justified by any interest in protecting consumers from false or misleading speech. Its text applies to *all* uses of a particular person’s name, misleading or not. And its practical effect is to apply *only* to non-deceptive marks that do not risk source confusion.

III. Because the clause fails any heightened scrutiny, it is unconstitutional as applied here. The government may not avoid that outcome by arguing that the clause is a condition on a government benefit and is permissible so long as it is reasonable and viewpoint neutral.

That is for two reasons:

A. *First*, the government has not established that the clause is constitutional even under its preferred test. Under a reasonableness standard, the government must put forth a justification, identify a real-world harm, and show that the measure it is defending is no broader than necessary and poses no risk of viewpoint discrimination. The government has not carried that burden here. It does not identify any real-world harm addressed by the clause. And it offers no defense of the clause’s obviously improper censorial motive or its sweeping viewpoint-based effects.

B. *Second*, a reasonableness test is not the correct test for assessing the clause’s constitutionality in any event. It rests on the false premise that the clause restricts no speech because it does not prevent marks from being used. But whenever the government refuses to register a mark under the clause, it is imposing a “First Amendment burden” by denying protection to disfavored speech. *Tam*, 582 U.S. at 250 (op. of Kennedy, J.). Because “lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content,” this Court’s cases hold that the government’s “content-based burdens must satisfy the same rigorous scrutiny as its content-based bans.” *Sorrell*, 564 U.S. at 565-66.

The government offers no good reason to depart from this rule here. Its analogies to cases involving government subsidies or limited public forums are flawed and would apply equally to other registration systems like copyright. Its reliance on the exclusionary nature of trademarks is misguided and inconsistent with the statute’s broad pro-registration mandate. And its concerns about threatening other trademark-registration bars are vastly overstated.

ARGUMENT

The names clause is, on its face, a content-based and speaker-based regulation of speech. It was enacted to suppress speech that Congress deemed to be distasteful. And its effect has been to do exactly that: blocking registration of all marks that criticize public figures, while leaving those people free to register their own positive marks. For these reasons, the clause must be subjected to at least intermediate scrutiny. It cannot withstand such scrutiny, and the government does not argue otherwise.

Instead, the government tries to sidestep heightened scrutiny altogether. As it did in *Tam* and *Brunetti*, the

government tries to characterize restrictions on trademark registration as conditions on a government benefit. But the names clause is so indefensible that it cannot satisfy even the government's own proposed reasonableness test. So the Court need not definitively reject that test in this case. At any rate, it is not the correct test for assessing the regulation here—a clause that is facially content- and speaker-based, and that has an illegitimate motive and message-distorting effects.

I. Because the names clause imposes a content- and speaker-based burden on speech—and has the intent and effect of disfavoring ideas—it must be subjected to at least intermediate scrutiny.

Six years ago, this Court unanimously recognized that “trademarks are private, not government, speech.” *Tam*, 582 U.S. at 239. It thus held that Congress’s regulation of trademarks—including its decision of which messages to accept for registration and which to deny—implicates the First Amendment. *Id.* The Court rejected arguments that would have “either eliminate[d] any First Amendment protection or result[ed] in highly permissive rational-basis review.” *Id.* at 233; *see also id.* at 253 (op. of Kennedy, J.) (rejecting the argument that the registration system is categorically “exempt from the First Amendment”). Two years later, the Court reaffirmed this view in *Brunetti*. In both cases, the Court applied “rigorous constitutional scrutiny,” *id.* at 247 (op. of Kennedy, J.), and invalidated a registration bar that “disfavor[ed] certain ideas,” *Brunetti*, 139 S. Ct. at 2297 (immoral or scandalous marks); *Tam*, 582 U.S. at 223 (disparaging marks).

Under this Court’s precedents, the names clause must similarly be subjected to rigorous scrutiny. Even if the clause does not reveal the same “facial viewpoint bias” as

the clauses in *Tam* and *Brunetti*, 139 S. Ct. at 2300, its text “imposes a burden based on the content of speech and the identity of the speaker,” *Sorrell*, 564 U.S. at 567. And its “purpose and practical effect” are to suppress certain “disfavored” speech—messages about the president and other well-known figures that have not received their express approval. *Id.* at 565. “It follows that heightened judicial scrutiny is warranted.” *Id.*

A. On its face, the names clause is a content- and speaker-based regulation of speech—and an especially “constitutionally problematic” one.

By its plain terms, the names clause regulates speech based on its content. A speech regulation is content-based if it “discriminate[s] based on the topic discussed or the idea or message expressed.” *City of Austin, Tex. v. Reagan Nat’l Advert. of Austin, LLC*, 142 S. Ct. 1464, 1474 (2022). “That description applies to a law that singles out specific subject matter for differential treatment.” *Barr v. Am. Ass’n of Political Consultants, Inc.*, 140 S. Ct. 2335, 2346 (2020).

As the government concedes (at 22), the names clause is such a law. It expressly “defin[es] regulated speech by particular subject matter,” *Reed v. Town of Gilbert, Ariz.*, 576 U.S. 155, 163 (2015), requiring a PTO examiner to assess the content of a proposed mark to determine if it “[c]onsists of or comprises a name ... identifying a particular living individual,” or “the name ... of a deceased President of the United States during the life of his widow,” without their consent. 15 U.S.C. § 1052(c). If it does, registration is prohibited. “That is about as content-based as it gets.” *Barr*, 140 S. Ct. at 2346.

Nor is the disfavored topic unrelated to the expression of ideas. “Real people”—and the president especially—

“are important subjects of discussion.” Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 *Hous. L. Rev.* 903, 908 (2003). They are the focus of much “news reporting,” “movies,” “songs,” and (yes) “T-Shirts.” *Id.* “Short and symbolic messages”—like “phrases that can fit on bumper stickers” or clothing—are, if anything, “often more persuasive than longer and more explicit messages, because people are more likely to pay attention to them.” *Id.* at 910; *see Tam*, 582 U.S. at 239 (“Powerful messages can sometimes be conveyed in just a few words.”).

But speech about other people can be persuasive only if the audience knows who the speaker is talking about. Which usually requires identifying them—the very speech that the names clause disfavors. *See* *Motion Picture Ass’n Br. 8* (“There is no way to make ‘King Richard’ ... without referring to Richard Williams,” or “‘The People v. O.J. Simpson: American Crime Story’ without O.J. Simpson.”). Lin-Manuel Miranda, for example, could have named his musical anything, but he chose *HAMILTON: AN AMERICAN MUSICAL* for a reason. That trademark is now registered only because it does not refer to a “living individual,” 15 U.S.C. § 1052(c) (unlike “Clinton the Musical,” which was denied). So this is a topic that, in stark contrast to “vulgar terms,” is very much “needed to express an[] idea.” *See Brunetti*, 139 S. Ct. at 2303 (Alito, J., concurring).

And yet the clause does more than just “single out [a] topic or subject matter for differential treatment.” *City of Austin*, 142 S. Ct. at 1472. It also discriminates among speakers. It allows “a particular living individual” to use his or her name (or let someone else use it) in a registered mark by providing written consent. 15 U.S.C. § 1052(c) As interpreted by the PTO, this language permits people who have achieved “fame or public recognition” to register a

mark using the same word that is denied to everyone else, and even to express the same message. TMEP § 1206, at 1200-215. Former President Trump, for instance, has registered countless trademarks that contain his name. He could even, in theory, register the very mark in this case (or, in reality, register a mark conveying the opposite message), and the names clause would pose no barrier. That makes the clause speaker-based.

It is speaker-based in a particularly troubling way too. By mandating consent, the clause grants public figures what is in essence a “heckler’s veto”—the absolute right to decide whether speech about them can be registered as a trademark. *See Reno v. ACLU*, 521 U.S. 844, 880 (1997); *Motion Picture Ass’n Br. 4, 9* (highlighting the harms caused when public figures can “veto unflattering depictions, irrespective of whether they [a]re accurate or defamatory”). Such a blanket “governmental grant[] of power to private” people is “constitutionally problematic,” to say the least. *Hill v. Colorado*, 530 U.S. 703, 734 n.43 (2000). It would never fly as a requirement for news reporting, movies, books, or T-shirts, as the government admits. *Pet’r Br. 23*. If the government wants to insist on such a requirement here—to let politicians and public figures license the debate about them on registered marks—it is not too much to ask that the government defend the law under heightened scrutiny.

Nor does the clause impose only “an incidental burden on protected expression.” *Sorell*, 564 U.S. at 567. The clause “does not simply have an effect on speech, but is directed at certain content and is aimed at particular speakers.” *Barr*, 140 S. Ct. at 2347. And its effect on speech is “significant.” *B & B Hardware*, 575 U.S. at 142. Just as the advantages of registration are “substantial,”

id. at 159, so too are the disadvantages of denial. They are so substantial, in fact, that a rational commercial actor (particularly a small business owner) would be advised to steer clear of marks that have been placed off-limits for federal registration, and to instead choose different words to convey a different message. Because the clause “on its face” “imposes a burden based on the content of speech and the identity of the speaker,” heightened scrutiny is warranted. *Sorrell*, 564 U.S. at 567.

B. The names clause’s “purpose and practical effect” are to suppress unwanted speech.

“Any doubt” that heightened scrutiny is warranted “is dispelled” by the law’s “purpose and practical effect.” *Id.* at 564-65.

Purpose. Congress enacted the names clause because it wanted to discourage speech that it found be offensive. The legislative record makes this abundantly clear. The clause was added to the Lanham Act at the same time as the now-invalidated disparagement clause, to address the same concern. The statute’s drafters made it publicly known that they found the “idea of prostituting great names by sticking them on all kinds of goods” to be “very distasteful”—especially when it came to the president. 75th Cong. 79. They wanted “to prevent such outrages of the sensibilities of the American people.” *Id.* at 80.

So what did they do? They added the names clause and the disparagement clause to ensure that this objective would be achieved. They identified no other rationale. And no other rationale accounts for Congress’s decision, in the text, to extend special protection to the president alone.

It is difficult to imagine a rationale that more squarely collides with the First Amendment—or that more clearly

proves that the law is aimed at speech. *See Tam*, 582 U.S. at 246 (op. of Alito, J.). As Justice Kennedy explained in *Tam*, “a speech burden based on audience reactions is simply government hostility ... in a different guise.” *Id.* at 250. It is not for the government to “decide whether the relevant audience would find the speech offensive” and then seek to suppress the speech for that reason. *Id.*

This Court has repeatedly said the same. *See id.* at 244 (op. of Alito, J.) (“We have said time and again that the public expression of ideas may not be prohibited merely because the ideas are themselves offensive to some of their hearers.”) (citing cases); *id.* at 250 (op. of Kennedy, J.) (“[We have] long prohibited the government from justifying a First Amendment burden by pointing to the offensiveness of the speech to be suppressed.”); *see also*, e.g., *Texas v. Johnson*, 491 U.S. 397, 414 (1989) (“If there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.”). “Where the designed benefit of a content-based speech restriction is to shield the sensibilities of listeners, the general rule is that the right of expression prevails.” *United States v. Playboy Ent. Grp., Inc.*, 529 U.S. 803, 813 (2000); *see also Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, 502 U.S. 105, 118 (1991) (emphasizing the illegitimacy of “suppressing” protected speech “out of solicitude for the sensibilities of” listeners); *Hustler Mag., Inc. v. Falwell*, 485 U.S. 46, 55 (1988) (“The fact that society may find speech offensive is not a sufficient reason for suppressing it”; to the contrary, it “is a reason for according it constitutional protection.”). “Indeed, the point of all speech protection is to shield just those choices

of content that in someone's eyes are misguided, or even hurtful." *Snyder v. Phelps*, 562 U.S. 443, 458 (2011).

Such clear "evidence of an improper censorial motive" would independently justify heightened scrutiny. *Reed*, 576 U.S. at 165. But at the very least, it confirms the need for it. There is broad agreement on the Court that "facially content-based regulations of speech" must be subjected to heightened scrutiny if "there is any realistic possibility that official suppression of ideas is afoot." *Id.* at 182 (Kagan, J., concurring); *see id.* at 166 (op. of the Court) ("Strict scrutiny applies either when a law is content based on its face or when the purpose and justification for the law are content based."). Accordingly, if it is "realistically possible" that "subject-matter regulation" could "have the intent or effect of favoring some ideas over others," heightened scrutiny follows. *Id.* at 182-83 (Kagan, J., concurring). Here, Congress's intent to favor some ideas over others isn't just a "realistic possibility," but a historical reality. So even if there were an "exception for content discrimination that does not threaten censorship of ideas," *R.A.V. v. City of St. Paul*, 505 U.S. 377, 393 (1992), the names clause would not come within it.

Practical effect. Not surprisingly given its text and purpose, the clause has had message-distorting effects. In its "practical operation," the clause precludes *all* marks that disparage or criticize living public figures, who have no incentive to consent to the insult. *Id.* at 391; *see Jack Daniel's*, 599 U.S. at 161 ("Self-deprecation is one thing; self-mockery far less ordinary."). Even though the "market is well stocked with merchandise that disparages prominent figures," *Tam*, 582 U.S. at 247 (op. Alito, J.), and their "marks make up part of the expression of everyday life," *id.* at 252 (op. of Kennedy, J.), none of those

marks will ever be registered. And yet the clause allows public figures to register their own positive messages.

A few examples: BIDEN PRESIDENT was accepted for federal registration. But “Impeach 46” was denied under the names clause. Likewise, “JOE 2020” is registered, but not “No Joe in 2024.” HILLARY FOR AMERICA, too, was approved. But “Hillary for Prison 2016”? Denied. And while celebrity fanbases can register their celebrity-adoring names as trademarks (*e.g.*, SWIFTIES, ARNIE’S ARMY, and BEYHIVE), groups opposing presidential candidates have had their requests denied under the clause (*e.g.*, “Never Trumper”). That is the opposite of the First Amendment’s command.

This stark imbalance only reinforces the need for heightened scrutiny. By allowing presidents and other public figures to control the message conveyed about them in registered marks, the names clause “goes even beyond mere content discrimination” and verges on “viewpoint discrimination.” *Sorrell*, 564 U.S. at 565. It ensures that “public officials could be praised but not condemned,” and thus risks “distort[ing] the marketplace of ideas.” *Tam*, 582 U.S. at 249 (op. of Kennedy, J.). Further, it arms political figures with tools that have been used to silence criticism from ordinary Americans. *See* Eugene Volokh, *Donald Trump threatens to sue over StopTrump.us T-shirts—but he doesn’t have a case*, Wash. Post (Sept. 23, 2015), <https://perma.cc/C28F-NYZU> (discussing cease-and-desist letter that Trump sent to a “Stop Trump” T-shirt company, which told the company that “the name Trump® is protected by U.S. Trademark Registration” and “has been declared ‘incontestable’ by the [PTO]”).

In sum, even if the clause does not “on its face disfavor some ideas,” *Brunetti*, 139 S. Ct. at 2301, it was intended

to have—and has in fact had—exactly that effect. For that reason, too, heightened scrutiny is warranted.

C. The names clause must be subjected to at least intermediate scrutiny.

Taken together, these features are “sufficient to justify application of heightened scrutiny.” *Sorrell*, 564 U.S. at 571. Even if the clause does not prohibit speech outright, it “is designed to impose a specific, content-based burden on protected expression,” *id.* at 565, singling out unwanted speech for “unfavorable treatment,” *Barr*, 140 S. Ct. at 2347. And it does so by directly regulating speech—and speech only. When a law does that, it must be subjected to heightened scrutiny. *See Playboy Ent.*, 529 U.S. at 812 (“Content-based burdens must satisfy the same rigorous scrutiny as [] content based bans.”); *Simon & Schuster*, 502 U.S. at 115. “Lawmakers may no more silence unwanted speech by burdening its utterance than by censoring its content.” *Sorrell*, 564 U.S. at 566.

That is true regardless of whether the names clause technically rises to viewpoint discrimination. Viewpoint discrimination “is a more blatant and egregious form of content discrimination.” *Reed*, 576 U.S. at 168. “But it is well established that the First Amendment’s hostility to content-based regulation” is not limited “to restrictions on particular viewpoints.” *Id.* at 169. As this case shows, content-based laws can present “the same dangers” as viewpoint-based laws. *Id.* at 174 (Alito, J., concurring); *see also id.* at 176-77 (Breyer, J., concurring) (“Whenever government disfavors one kind of speech, it places that speech at a disadvantage, potentially interfering with the free marketplace of ideas.”). Subjecting such laws to heightened scrutiny “create[s] a buffer zone guaranteeing

that the government cannot favor or disfavor certain viewpoints.” *Id.* at 183 (Kagan, J., concurring).

That raises the question of what form of heightened scrutiny applies. Ordinarily a law that imposes content-based and speaker-based burdens on speech would be “presumptively invalid” and subjected to strict scrutiny. *Sorrell*, 564 U.S. at 571; *see, e.g., Turner Broad. Sys., Inc. v. FCC*, 512 U.S. 622, 642 (1994) (“[We] apply the most exacting scrutiny to regulations that suppress, disadvantage, or impose differential burdens upon speech because of its content.”); *Barr*, 140 S. Ct. at 2346 (“The Court’s precedents ... restrict the government from discriminating in the regulation of expression on the basis of the content of that expression,” requiring “strict scrutiny.”); *id.* at 2347 (“Laws favoring some speakers over others demand strict scrutiny when the legislature’s speaker preference reflects a content preference.”). And that general rule would seem to apply with special force here, where the speech expresses a political opinion about a former (and now current candidate for) president.³

This Court, however, had no need to apply strict scrutiny in *Tam* and *Brunetti*. So it left “open the question whether [intermediate scrutiny under] *Central Hudson* provides the appropriate test for deciding free speech

³ Applying strict scrutiny here would not threaten any of the core aspects of trademark law. As this Court has repeatedly explained, “false, deceptive, or misleading commercial speech”—including speech that risks confusion as to source—historically has not been protected. *Ibanez v. Fla. Dep’t of Bus. & Prof’l Regulation, Bd. of Accountancy*, 512 U.S. 136, 142 (1994); *see Tam*, 582 U.S. at 248, 252 (op. of Kennedy, J.) (noting that the government’s ability to “regulate or punish ... fraud” is “well established within our constitutional tradition,” as is its ability to “protect consumers and trademark owners” by prohibiting “confusing or misleading” marks).

challenges to [trademark] provisions.” *Tam*, 582 U.S. at 245 n.17 (op. of Alito, J.); *see id.* at 251 (op. of Kennedy, J).

Here, as in *Tam* and *Brunetti*, the Court need not resolve this dispute because “the outcome is the same.” *Sorrell*, 565 U.S. at 571. The names clause plainly fails strict scrutiny. But even if the Court were to apply *Central Hudson* scrutiny, the clause would still fail.

In fact, as we now show, the clause’s purpose is so illegitimate—and its fit with any legitimate purpose so poor—that it “does not pass strict scrutiny, or intermediate scrutiny, or even the laugh test.” *Reed*, 576 U.S. at 184 (Kagan, J., concurring). This Court could therefore rest its opinion on that basis, without making any pronouncement about the correct framework for assessing the constitutionality of the names clause or any other content-based ban on trademark registration.

II. The names clause cannot survive intermediate scrutiny because it advances no legitimate interest and is dramatically overbroad.

Central Hudson requires the government to “show at least that the statute directly advances a substantial governmental interest and that the measure is drawn to achieve that interest.” *Sorrell*, 565 U.S. at 572. And where, as here, the regulation “serves an end unrelated to consumer protection,” this Court “must review [it] ... with special care,” mindful that such a law will “rarely survive constitutional review.” ⁴⁴ *Liquormart v. Rhode Island*, 517 U.S. 484, 504 (1996) (plurality op.). The government’s burden is “heavy,” *id.* at 516, and requires actual evidence—not just “speculation or conjecture”—that “the harms it recites are real and that its restriction will in fact alleviate them to a material degree.” *Edenfield v. Fane*,

507 U.S. 761, 771 (1993). The government does not even try to satisfy its burden here, and it cannot do so.

A. The government does not even acknowledge—much less defend—the dignitary interests that motivated adoption of the names clause.

The Board below asserted both privacy and publicity interests as justifying application of the names clause to bar registration of Elster’s mark. Pet. App. 32a. The government then defended both interests on appeal, claiming a “substantial interest in protecting state-law privacy and publicity rights.” *Id.* at 11a. In this Court, however, the government now abandons its defense of the privacy interests on which Congress relied in enacting the clause, and instead stakes its case almost entirely on a purported interest in protecting the right of publicity.

The government’s shift in position is understandable. The right of privacy in this context is designed to prevent “injury to personal feelings caused by an unauthorized use of the plaintiff’s identity.” Restatement (Third) of Unfair Competition § 46, cmt. b (1995); see *Zacchini*, 433 U.S. at 573 (noting that the right of privacy concerns “feelings or reputation”); 5 *McCarthy on Trademarks* § 28:6 (“The right to privacy protects against ... damage to human dignity” and “injury to the psyche.”). As the Federal Circuit recognized, there is “no legitimate interest in protecting the privacy of ... the least private name in American life from any injury to his ‘personal feelings’ caused by the political criticism that Elster’s mark advances.” Pet. App. 13a.

But the privacy rationale cannot be so easily buried. “Unlike rational-basis review, the *Central Hudson* standard does not permit” the Court to “turn away if it appears that the [government’s] stated interests are not

the actual interests served by the restriction.” *Edenfield*, 507 U.S. at 768. Here, it is clear from the history that the clause “was adopted to preserve the dignity of those depicted without consent,” not to protect publicity rights. Rothman, *Navigating the Identity Thicket*, 135 Harv. L. Rev. at 1308. The right of publicity was not recognized until 1953—seven years after the Lanham Act’s passage—and was rarely invoked before the 1980s. See 5 *McCarthy on Trademarks* § 28:4; *Haelan Lab., Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953); Robert C. Post & Jennifer E. Rothman, *The First Amendment and the Right(s) of Publicity*, 130 Yale L.J. 86, 90 n.6 (2020). And what the history shows, the text confirms. The clause applies only during the life of the person sought to be protected—a limitation that makes sense under a privacy rationale, but not a publicity one. See 1 J. Thomas McCarthy & Roger R. Schechter, *The Rights of Publicity and Privacy* §§ 9:10, 9:18 (2d ed. 2023) (“Reputational or dignitary interests protected by ... privacy rights are personal and die with the person,” whereas the “vast majority” of states provide for publicity rights after death because they are “property rights.”). The clause also extends special protection to benefit a president’s widow—another textual clue that Congress was concerned about dignity, not publicity.

This mismatch “reflects [an] impermissible purpose to burden disfavored speech.” *Sorrell*, 564 U.S. 574-75. It exposes the law for what it is: an attempt to suppress “distasteful” speech. 75th Cong. 79. So even if the clause could conceivably be justified by a publicity interest (an issue we take up next), its true “purpose to suppress speech and its unjustified burdens on expression would render it unconstitutional.” *Sorrell*, 564 U.S. at 566.

**B. The government has no legitimate interest—
let alone a substantial interest—in
facilitating enforcement of the “right of
publicity” against political speech.**

1. Having abandoned the law’s actual rationale, the government goes all in on the “right of publicity.” Pet’r Br. 29. This right is generally defined as “the right of a person to control the commercial use of his or her identity.” *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 967 (10th Cir. 1996); see McCarthy, *The Rights of Publicity and Privacy* § 1:3. It “protects against commercial loss caused by appropriation of an individual’s personality for commercial exploitation.” 5 *McCarthy on Trademarks* § 28:6.

The government claims (at 29) that the purpose of the names clause “is grounded in [the] historical tradition” of the publicity right. But the government’s reliance on that tradition is misplaced. The right has never been applied to support a cause of action for criticism of a public figure. As the Federal Circuit pointed out, “no authority hold[s] that public officials may restrict expressive speech to vindicate their publicity rights.” Pet. App. 19a. “In fact, every authority that the government cite[d] reaches precisely the opposite conclusion, recognizing that the right of publicity cannot shield public figures from criticism.” *Id.*

Courts have reached this consensus for a variety of reasons, but chief among them is the First Amendment. See Restatement (Third) of Unfair Competition § 46, cmt. c. As courts have “unanimously” recognized, the state-law right of publicity must be “balanced against public rights of free access to socially and politically useful ideas.” 1 McCarthy, *The Rights of Publicity & Privacy* § 2:4; see, e.g., *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 931

(6th Cir. 2003); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1183-84 (9th Cir. 2001); *Cardtoons*, 95 F.3d at 969; *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989). And that “inherent tension between the right of publicity and the right of freedom of expression ... becomes particularly acute” in cases like this one, where “the person seeking to enforce the right is a ... famous person” subject to “scrutiny and comment in the public media.” *ETW Corp.*, 332 F.3d at 931. The right of publicity does not—and under our Constitution, cannot—extend so far as to stifle speech that contains “social commentary on public figures.” *Cardtoons*, 95 F.3d at 969; see *Heffron v. Int’l Soc’y for Krishna Consciousness, Inc.*, 452 U.S. 640, 647 (1981) (noting that speech doesn’t lose constitutional protection just because it’s “sold rather than given away”).

The government does not challenge the correctness of this consensus. Nor does it claim that Elster’s use of his mark violates Trump’s right to publicity. To the contrary, the government concedes that Trump could not invoke publicity rights to silence Elster’s speech. See Pet’r Br. 22-23. And elsewhere in its brief (at 25), the government asserts an interest in declining “to enhance [a person’s] ability to restrict the speech of others.”

But the problem for the government is that the right of publicity is *itself* an exclusionary intellectual-property right analogous to a trademark right. Cf. *Zacchini*, 433 U.S. at 576 (analogizing the right of publicity to copyright where person’s entire performance was copied). Like a trademark right, the right of publicity is a right to prohibit the speech of other people. So the only way that the names clause could “directly advance[]” an interest in protecting the right of publicity is if it, too, prohibits other people’s speech. See *Sorrell*, 565 U.S. at 572. Yet the government

concedes that prohibiting the speech at issue here (and innumerable other marks conveying similarly expressive, non-deceptive messages about public figures) would be unconstitutional. That is fatal to the government’s attempt to defend the law. There is no legitimate interest in facilitating the unconstitutional application of state law.

As for the government’s concerns about the speech-suppressive effects of registering Elster’s mark, we will say more about them later. For now, it suffices to note that the exclusionary right provided by trademark law—unlike the right of publicity—was well-settled at the Founding. *See In re Trade-Mark Cases*, 100 U.S. at 92. It therefore fits much more comfortably alongside the First Amendment than does the modern right of publicity. *Jack Daniel’s*, 599 U.S. at 159. By nevertheless preferring unconstitutional applications of the right of publicity to the customary consequences of a trademark, the government’s asserted interest is inconsistent with historical tradition.

2. *Central Hudson* also requires that the burden on speech “extend only as far as the interest it serves.” *Tam*, 582 U.S. at 245 (op. of Alito, J.). If the “interest could be served as well by a more limited” law, “the excessive restrictions cannot survive.” *Cent. Hudson*, 447 U.S. at 564. This rule “ensure[s] not only that the [asserted] interests are proportional to the resulting burdens placed on speech but also that the law does not seek to suppress a disfavored message.” *Sorrell*, 564 U.S. at 572.

The names clause is far too broad to serve any legitimate governmental interest in facilitating publicity rights. It applies primarily to speech about “celebrities and world-famous political figures,” Pet. App. 28a, which enjoys strong constitutional protection. And in practice, it

covers only speech that is not deceptive, does not imply a false endorsement, and does not confuse as to source. *See* 15 U.S.C. § 1052(a), (d). The government cites no cases in which this kind of speech gave rise to right-of-publicity liability. Under *Central Hudson*, the government “cannot regulate speech that poses no danger to [its] asserted ... interest.” 447 U.S. at 565. “The last thing we need, the last thing the First Amendment will tolerate, is a law that lets public figures keep people from mocking them.” *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1519 (9th Cir. 1993) (Kozinski, J., dissenting).

To be sure, Congress might “have addressed” genuine concerns with “a more coherent policy.” *Sorrell*, 564 U.S. at 573. For example, any interest in protecting against misappropriation of identity could be served, with far less impact on protected speech, by excluding marks that reference public figures (the opposite of how the PTO has interpreted the clause). “A statute of that type would present quite a different case from the one presented here.” *Id.* But Congress “did not enact a statute with that purpose or design.” *Id.* By instead barring all references to a living person—regardless of whether they violate any enforceable right of publicity—the clause is far “broader than reasonably necessary” to serve the government’s legitimate interests. *In re R.M.J.*, 455 U.S. 191, 203 (1982). As Justice Alito observed in *Tam*, a restriction barring the mark “Buchanan was a disastrous president” would be far too broad under *Central Hudson*. 582 U.S. at 246. A restriction barring “Trump too small” is just as overbroad.

C. The names clause regulates speech that is not realistically capable of misleading anyone.

Finally, the government weakly asserts (at 31) that the clause serves its interest in “not promoting misleading

or deceptive source-identifiers.” But the clause is not aimed at misleading marks. As the Board explained below: “Unlike Section 2(a)’s explicit statutory requirement that the matter in question ‘falsely suggest a connection,’” the names clause “applies regardless of whether there is a suggested connection” *at all*—much less a misleading connection. Pet. App. 27a; *see* Restatement (Third) of Unfair Competition § 47 cmt. a (1995). The PTO accordingly refuses registration of any mark that names a public figure, without any evidence of a false endorsement. *See In re Hoefflin*, 2010 WL 5191373, at *2 (T.T.A.B. 2010). And the bar extends even to “a deceased President of the United States,” for whom endorsement is impossible. The rock band THE REAGAN YEARS, for example, had their registration denied until Nancy Reagan’s death in 2016.

This case illustrates the clause’s ill fit with any anti-deception interest. The phrase “Trump too small” and the accompanying gesture literally belittle Trump, a message that no reasonable person would mistake as one that he would personally endorse. *See Jack Daniel’s*, 599 U.S. at 161 (“A parody is not often likely to create confusion.”).

The government concedes as much. It argues only (at 32-33) that the “class of marks” that the clause targets “pose[s] a particular risk of misleading consumers.” But this Court has repeatedly held that the mere possibility that commercial speech “may, under some circumstances, be deceptive” does not justify a blanket restriction on that speech. *Zauderer v. Office of Disciplinary Counsel of Supreme Court of Ohio*, 471 U.S. 626, 649 (1985); *see R.M.J.*, 455 U.S. at 203 (“[The government] may not place an absolute prohibition on ... potentially misleading information.”). The government may not restrict “truthful

and nondeceptive advertising simply to spare itself the trouble of distinguishing such advertising from false or deceptive advertising.” *Zauderer*, 471 U.S. at 646.

Misleading marks, moreover, “are already barred” by other provisions. Pet. App. 13a. As noted, section 2(a) bars registering “deceptive” marks and marks that “falsely suggest a connection with persons,” 15 U.S.C. § 1052(a), which encompasses false endorsements. 5 *McCarthy on Trademarks* § 13:35; *see also* 15 U.S.C. § 1052(d). So narrower laws aren’t just possible; they exist.

III. The names clause cannot be saved from unconstitutionality by characterizing it as a condition on a government benefit.

Because the names clause cannot satisfy any form of heightened scrutiny, the government makes no effort to show that it can. Instead, the government devotes all its energy to resisting the application of heightened scrutiny. It claims that it should be permitted to apply the clause’s full sweep—even if the fit is too poor to survive *Central Hudson*—on the theory that the clause is not a restriction on speech but simply a condition on a government benefit.

This argument gets the government nowhere. The government has not shown that the names clause is the type of reasonable, viewpoint-neutral law that it contends should be permissible. So the clause would fail even the government’s preferred test, making it unnecessary for this Court to resolve the parties’ dispute about the correct test to apply here. Should the Court reach the question, however, it should reject the government’s test.

A. The names clause is not a “reasonable, viewpoint-neutral” law, so it would fail even the government’s preferred test.

Under the government’s test, the constitutionality of the names clause turns on whether it is reasonable and viewpoint-neutral. But while the government has a lot to say about why it thinks this is the right test, it has little to say about what this test means or how to apply it here. And no wonder: The clause’s fit is so poorly tailored, its motive so illegitimate, and its effects so skewed that the clause could not withstand even this level of scrutiny.

1. The government locates its test in two lines of cases: those involving conditions on government subsidies and those involving restrictions on speech in a limited public forum. *See* Pet’r Br. 17, 28. But the subsidy cases on which the government relies apply a “rational basis” test—not a reasonableness test. *See Ysursa v. Pocatello Educ. Ass’n*, 555 U.S. 353, 359 (2009); *see also Regan v. Taxation With Representation of Washington*, 461 U.S. 540, 550 (1983) (upholding the law as “not irrational”). “Reasonableness demands more than a rational basis.” *White Coat Waste Project v. Greater Richmond Transit Co.*, 35 F.4th 179, 198 (4th Cir. 2022).

As for the limited-public-forum cases, they at least require speech restrictions to be both reasonable and viewpoint neutral. These two requirements are enforced by “taking into account the ... forum’s function and all the surrounding circumstances,” *Christian Legal Soc’y Chapter of the Univ. of Calif., Hastings Coll. of the L. v. Martinez*, 561 U.S. 661, 685 (2010), and by ensuring that “the purpose or effect of the” law is not “to stifle speech or make it ineffective,” *id.* at 706 (Kennedy, J., concurring). “The significance of the governmental interest must be

assessed in light of the characteristic nature and function of the particular forum involved.” *United States v. Kokinda*, 497 U.S. 720, 732 (1990).

Consistent with these rules, in a limited public forum, the government may sometimes prohibit speech on “a topic not encompassed within the purpose of the forum,” or prohibit a speaker from accessing the forum “if he is not a member of the class of speakers for whose especial benefit the forum was created.” *Cornelius v. NAACP Legal Def. & Educ. Fund, Inc.*, 473 U.S. 788, 806 (1985). But that is not what the names clause does. It deems speech about public figures to be an “includible subject” for registration, *id.*—but only if the public figure has approved the speech. And it imposes its restriction even on speakers for whose benefit the system was created (trademark holders).

In addition, the government “may not exclude speech where its distinction is not reasonable in light of the purpose served by the forum.” *Martinez*, 561 U.S. at 685. Given that other restrictions on trademark registration limit false endorsements and other forms of deceptive, confusing, or misleading marks, the only practical function of the names clause is to suppress non-deceptive speech about well-known public figures. For that reason, the names clause is inconsistent with the underlying purpose of trademark law—preventing source confusion—and hence unreasonable. *See Tam*, 582 U.S. at 253 (op. of Kennedy, J.); *cf. Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 570 U.S. 205, 214-15 (2013) (explaining that, even in government-subsidy cases, “conditions that seek to leverage [the subsidy] to regulate speech outside the contours of the program” are improper).

2. Further, “even a reasonable end must not be pursued by unreasonable means.” *White Coat Waste Project*, 35 F.4th at 199. The government “must draw a reasonable line.” *Minnesota Voters All. v. Mansky*, 138 S. Ct. 1876, 1888, 1892 (2018). A third category of cases unmentioned by the government shows what this means. Under *Zauderer*, disclosure requirements for commercial advertising are constitutional if they “are reasonably related to the [government’s] interest in preventing deception of consumers.” 471 U.S. at 651. In this context, reasonableness does not mean anything goes. The government “has the burden to prove that the [law] is neither unjustified nor unduly burdensome.” *Becerra*, 138 S. Ct. at 2377. It must show that the law “remed[ies] a harm that is potentially real not purely hypothetical,” that it “extend[s] no broader than reasonably necessary,” and that it does not “risk chilling protected speech.” *Id.*

The government has not carried this burden here. It identifies no real-world harm that the clause addresses. Nor does it explain how the clause is reasonably tailored to address any such harm. Although it asserts that the clause protects the right of publicity and guards against deception, it does not account for why the clause almost exclusively targets speech that could never give rise to liability for violating that right, or why the clause’s only practical effect is to prohibit registering non-deceptive marks. In short, the government has failed “to articulate [a] sensible basis” for its law. *Mansky*, 138 S. Ct. at 1888.

The government’s failure to make these showings means that it may not constitutionally apply the clause here. This “Court is the final arbiter of the question” of reasonableness and “owe[s] no deference” on the subject. *Martinez*, 561 U.S. at 686. Given the government’s failure,

this Court “need not decide whether the [reasonableness] standard applies.” *Becerra*, 138 S. Ct. at 2376-78. “Even under [this standard],” the law fails. *Id.* at 2377.

3. That is to say nothing of the separate requirement of viewpoint neutrality. As explained, the clause’s purpose and effect are to suppress disfavored speech. Enacting a law “for the purpose of suppressing the expression of a particular viewpoint is viewpoint discrimination.” *Martinez*, 561 U.S. at 736 (Alito, J., dissenting). But regardless of whether the clause technically qualifies as viewpoint-based, it implicates a similar set of concerns, which (at a minimum) renders it unreasonable. *See Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 831 (1995) (noting that the distinction between viewpoint discrimination and neutrality “is not a precise one”); *Brunetti*, 139 S. Ct. at 2313 (Sotomayor, J., concurring in part and dissenting in part) (same).⁴

Far from being “content discrimination that does not threaten censorship of ideas,” *R.A.V.*, 505 U.S. at 393, the clause poses “the same dangers as laws that regulate speech based on viewpoint.” *Reed*, 576 U.S. at 174 (Alito, J., concurring). It exerts a “distorting effect” on certain viewpoints (those critical of public figures), and “the purposes underlying” the clause only underscore its censorial aims. *See* Elena Kagan, *The Changing Faces of*

⁴ Citing the Federal Circuit’s decision, the government states (at 14) that Elster “agree[d] below” that the law “is not viewpoint-based.” But he did not agree. He just didn’t argue that it *is* viewpoint-based. That doesn’t preclude him from arguing now, in response to the government’s effort to defend the law, that the government has not shown that the law is reasonable and strictly viewpoint neutral. He argued below that the law has an improper motive and message-distorting effects, and that is unreasonable even under the government’s test. *See* Fed. Cir. Br. 3, 9, 17, 20, 34, 39 n.2, 48-49.

First Amendment Neutrality: R.A.V. v. St. Paul, Rust v. Sullivan, & the Problem of Content-Based Underinclusion, 1992 Sup. Ct. Rev. 29, 58, 64-65 (1992); see also *Cornelius*, 473 U.S. at 811 (noting that even the “existence of reasonable grounds for limiting access to a nonpublic forum ... will not save a regulation that is in reality a facade for viewpoint-based discrimination.”).

This Court in *Board of Regents of University of Wisconsin System v. Southworth*, for example, held that a university rule permitting students to defund registered groups by referendum would be unconstitutional. 529 U.S. 217, 224-25 (2000). “To the extent the referendum substitutes majority determinations for viewpoint neutrality,” the Court noted, “it would undermine the constitutional protection the [university’s] program requires.” *Id.* at 235. Such a rule would be “tantamount to establishing a majoritarian heckler’s veto.” *Martinez*, 561 U.S. at 736 n.10 (Alito, J., dissenting). The names clause—which requires the target of unwelcome speech to *approve* of it—makes the heckler’s veto the default rule. Outside a limited public forum, a law requiring a speech target’s approval would be a “form of prior restraint.” *Healy v. James*, 408 U.S. 169, 184 (1972). It is no more defensible here. “Many are those who must endure speech they do not like, but that is a necessary cost of freedom.” *Sorrell*, 564 U.S. at 575.

B. The government may not avoid heightened scrutiny by characterizing the names clause as a condition on a government benefit.

1. If the Court reaches the issue, it should reject the government’s proposed test. The test is premised on the idea that, when registration is denied under the names clause, “no speech is restricted,” because the registrant

“remains free to use the mark in commerce.” Pet’r Br. 16, 21. That premise is wrong.

The First Amendment’s protection against content-based regulations of speech is not limited to outright speech bans. It also prohibits laws that impose a “burden on speakers because of the content of their speech.” *Simon & Schuster*, 502 U.S. at 115. “When the purpose and design of a statute is to regulate speech by reason of its content, special consideration or latitude is not accorded to the Government merely because the law can somehow be described as a burden rather than outright suppression.” *Playboy Ent.*, 529 U.S. at 826; *see also Pitt News v. Pappert*, 379 F.3d 96, 111-12 (3d Cir. 2004) (Alito, J.) (“The threat to the First Amendment arises from the imposition of financial burdens that may have the effect of influencing or suppressing speech.”). “The distinction between laws burdening and laws banning speech is but a matter of degree,” so the rule is that “the Government’s content-based burdens must satisfy the same rigorous scrutiny as its content-based bans.” *Sorrell*, 564 U.S. at 565-66.

That rule fully applies here. Denying registration to a mark based on the content of the speech and the identity of the speaker imposes “a First Amendment burden,” *Tam*, 582 U.S. at 250 (op. of Kennedy, J.), and “disfavors” speech, *Brunetti*, 139 S. Ct. at 2297. That is all the more true here, given the law’s purpose and effect.

2. The government offers no sound reason to create an exception to this rule. As it did in *Tam*, the government tries to compare restrictions on trademark registration to cases involving government subsidies. Pet’r Br. 17-18. But “the federal registration of a trademark is nothing like the programs at issue in these cases,” all of which “involved

cash subsidies or their equivalent.” *Tam*, 582 U.S. at 240 (op. of Alito, J.). When the government pays people to speak, it may decide who gets the money. But trademark applicants send money to the government—not the other way around. *Id.* Or put differently: The government acts as a regulator, not a subsidizer. So these cases are “not instructive.” *See id.* at 240-41 (“No difficult question is presented here.”); *see also id.* at 253 (op. of Kennedy, J.).

The government’s union-dues cases are no more instructive. *See* Pet’r Br. 20-21 (relying on *Ysursa*, 555 U.S. 353, and *Davenport v. Washington Educ. Ass’n*, 551 U.S. 177 (2007)). They “occupy a special area of First Amendment case law,” and “are far removed from the registration of trademarks.” *Tam*, 582 U.S. at 241-42 (op. of Alito, J.) (“*Davenport* and *Ysursa* are akin to our subsidy cases”).

Nor is the trademark register a limited public forum. Pet’r Br. 18-19. As the government has itself told this Court, mark holders do not communicate with customers on the trademark register; they do so in commerce. *See* Reply Br. in *Tam* at 4 (“The government has not created a forum here. The Principal Register and Supplemental Register are not places for mark owners to express themselves.”); Tr. of Oral Argument in *Brunetti* at 27 (“[W]e don’t regard [trademark registration] as a limited public forum.”). “The register communicates not so much with [potential] customers but with potential infringers,” who “might otherwise be tempted” to “use the same mark.” *Id.* at 28.

These concessions are well taken. Trademarks exist to convey messages through commerce. In prohibiting registration of a mark, the government is not just prohibiting speech on a single government register, but

imposing a significant burden on speech between companies and potential customers across the marketplace. And if the registration system *were* a limited public forum, the same would have to be true of copyright—with potentially staggering implications.

3. Finally, the government identifies three aspects of trademark registration that, in its view, make heightened scrutiny unwarranted. Pet'r Br. 24-28. None is persuasive.

The “commercial” nature of trademarks is, at most, a reason to apply intermediate scrutiny—not a reason for no heightened scrutiny at all. *Id.* at 25. The same goes for the government’s concern about threatening other content-based registration bars. Many, if not most, of those registration bars are plainly constitutional under intermediate scrutiny (and indeed strict scrutiny). So even if the government’s concerns were legitimate, and “a law’s existence [could] be the source of its own constitutional validity,” *contra Friedman v. City of Highland Park, Ill.*, 784 F.3d 406, 409 (7th Cir. 2015), there would be no need to fashion a new test here. Intermediate scrutiny equips the government with leeway to impose reasonable restrictions on registration of trademarks.

The government’s sole remaining argument (at 25) is that heightened scrutiny is inappropriate because “the purpose and effect of federal trademark registration is to enhance the registrant’s ability to restrict the speech of others.” This argument fundamentally misapprehends both trademark registration and trademark law.

Congress created the registration system to provide notice to potential infringers and make it less likely that infringing or confusing marks would be used. Because exclusive rights in a trademark are created by use and not registration, denying registration to an otherwise valid

mark used in commerce deprives companies of this notice-giving function, and thus invites infringement and source confusion, not protected speech. Adopting a test that would encourage that outcome is far more “anomalous” than applying this Court’s ordinary test for content-based laws. *Contra* Pet’r Br. 25.

Indeed, the only speech that is restricted by Elster’s trademark is speech that would infringe his mark. And that speech is not protected. “A competitor’s use does not infringe a mark unless it is likely to confuse consumers,” *U.S. Pat. & Trademark Off. v. Booking.com B.V.*, 140 S. Ct. 2298, 2307 (2020), and the First Amendment does not protect confusing or misleading commercial speech. *See Jack Daniel’s*, 599 U.S. at 159; Br. for AIPLA 18-20. As a result, applying heightened scrutiny in this case will not prohibit any protected speech, and there is no reason to craft a new test just for bars on trademark registration.

CONCLUSION

This Court should affirm the judgment below.

Respectfully submitted,

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