No. 22-704

In the Supreme Court of the United States

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

Petitioner,

v.

STEVE ELSTER,

Respondent.

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

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

JT MORRIS
FOUNDATION FOR INDIVIDUAL RIGHTS AND

LYA SHAPIRO
MANHATTAN INSTITUTE .

QUESTION PRESENTED

Section 1052(c) of Title 15 provides in pertinent part that a trademark shall be refused registration if it “

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INTEREST OF *AMICI CURIAE*[*]

The Foundation for Individual Rights and Expression (FIRE) is a nonpartisan, nonprofit organization. FIRE's mission is to defend the rights of all Americans to free speech and free thought—the most essential qualities of liberty. Since 1999, FIRE has successfully defended expressive rights through public advocacy, targeted litigation, and *amicus curiae*

INTRODUCTION AND SUMMARY OF ARGUMENT

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

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

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

former President—for use on t-shirts.[1] Pet. App. 2a. Applying Section 1052(c), the U.S. Patent and Trademark Office (USPTO) rejected registration of that mark because former President Trump did not consent. Yet dozens of trademarks using the former President's name *favorably* have been registered with his consent. *See*

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

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

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

ARGUMENT

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

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benefit. The third time is not the charm for that strained position. As persuasively explained by Respondent here, and by four Justices in *Tam*, trademark registration is "nothing like" the monetary subsidies or other benefits that the Government

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

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

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

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[6] The government can favor particular viewpoints when it is speaking for itself. *See Tam*, 582 U.S. at 234–35. But the Court has

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

Elsewhere, too, the Court "ha[s] recognized that … subject-matter restrictions, even though viewpoint-neutral on their face, may 'suggest[ ] an attempt to give one side of a debatable public question an advantage in expressing its views to the people.'" *Reed v. Town of Gilbert*, 576 U.S. 155, 182 (2015) (Kagan, J., concurring in the judgment) (quoting *First Nat. Bank of Boston v. Bellotti*, 435 U.S. 765, 785 (1978)). Thus, even facially neutral laws may "have the intent or effect of favoring some ideas over others," and "[w]hen that is realistically possible … [the Court] insist[s] that the law pass the most demanding constitutional test." *Id.* at 182–83; *see, e.g.*, *McCullen v. CoakCT Tw* [illegible]

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

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

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

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

viewpoint discrimination. BIDEN TOO OLD would be rejected for the same reasons as TRUMP TOO SMALL, while BIDEN PRESIDENT

required only if the individual bearing the name in the mark … is so well known that the public would reasonably assume a connection between the person and the goods or services; or … the individual is publicly connected with the business in which the mark is used.")

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

Second, Section 1052(c) provides public figures with the ultimate heckler's veto by outsourcing trademark registration decisions to them alone. Public figures can singlehandedly prevent others from criticizing them through the registration of powerfully expressive trademarks simply because "of hostility to their assertion."

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

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

That decision was consistent with the First Amendment because the Government has a "well settled" .

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

CONCLUSION

The Court should affirm the judgment below

ADDENDUM

President Joe Biden

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

Former President Donald Trump

Registered by USPTO (examples)	Rejected by USPTO (examples)
• ALBEMARLE ESTATE AT TRUMP WINERY • ALBEMARLE ESTATE TRUMP ESTATE COLLECTION • DONALD TRUMP • DONALD TRUMP THE FRAGRANCE • EMPIRE BY TRUMP • GOTRUMP • PURELY TRUMP • SUCCESS BY TRUMP • T TRUMP • T TRUMP HOLLYWOOD • T TRUMP TOWER TAMPA A DONALD J. TRUMP SIGNATURE PROPERTY • THE SPA AT TRUMP • THE DONALD J. TRUMP SIGNATURE COLLECTION • THE ESTATES AT TRUMP NATIONAL GOLF CLUB • THE RESIDENCES AT TRUMP NATIONAL GOLF CLUB • THE RIVER WALK SHOPS AT TRUMP INTERNA-TIONAL	• # TRUMP YOU ARE D!! • DOGALD TRUMP • DONALD TRUMP BARF BAG • DRAIN THE TRUMP • DUMP TRUMP AND LOCK HIM UP • DUMP TRUMP IN 2020 #DUMPTRUMPIN2020 • GOLDEN CALF TRUMP STATUE • MAKE AMERICA GREAT AGAIN KICK T

Registered by USPTO (examples)	Rejected by USPTO (examples)
• TRUMP ONE • TRUMP PALACE • TRUMP PARK • TRUMP PARK AVENUE • TRUMP PLACE • TRUMP PLAZA • TRUMP ROYALE • TRUMP SOHO • TRUMP STEAKSR TUMP6 • TRUMP TAJ R TRUMPR	

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