

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

*ON WRIT OF CERTIORARI
TO THE UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT*

REPLY BRIEF FOR THE PETITIONER

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v.

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REPLY BRIEF FOR THE PETITIONER

Section 1052(c) of Title 15 provides in pertinent part that a trademark shall be refused registration if it “[c]onsists of or comprises a name * * * identifying a particular living individual except by his written consent.” 15 U.S.C. 1052(c). Throughout his brief, respondent characterizes that clause as “suppressing” speech. Resp. Br. 2; see, *e.g.*, *id.* at 7, 14, 19, 23, 30, 33, 38, 40. But the living-individual clause does not “silence,” “burden,” or otherwise restrict speech. *Id.* at 2, 25. It merely establishes a condition on the government-conferred benefits that flow from federal trademark registration. And unlike the provisions held invalid in *Matal v. Tam*, 582 U.S. 218 (2017), and *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019), the living-individual clause is viewpoint-

neutral and applies without regard to any ideas or opinions that a mark might convey.

When Congress places a viewpoint-neutral condition on a government benefit, the First Amendment does not require heightened scrutiny. And heightened scrutiny is particularly unwarranted in the context of viewpoint-neutral trademark-registration criteria. Because registration gives the mark owner additional tools to restrict the speech of others, denial of registration may enhance overall free-speech rights. Accordingly, the First Amendment requires only that the living-individual clause be “reasonable.” *Ysursa v. Pocatello Educ. Ass’n*, 555 U.S. 353, 355 (2009). Because the clause readily satisfies that standard, and because respondent has no First Amendment right to the government’s assistance in restricting his competitors’ speech, the judgment of the court of appeals should be reversed.

A. Section 1052(c)’s Living-Individual Clause Is A Condition On A Government Benefit, Not A Restriction On Speech

As our opening brief explains (at 16-21), this Court has long distinguished restrictions on speech (which generally are subject to heightened scrutiny) from conditions on government benefits (which generally are not). Respondent contends that the living-individual clause falls in the former category because denial of federal trademark registration “burden[s]” speech. Resp. Br. 42 (citation omitted). The only specific practical disadvantage he identifies, however, is that “Congress created the registration system to provide notice to potential infringers,” and that “denying registration to an otherwise valid mark used in commerce deprives companies of this notice-giving function, and thus invites infringement and source confusion.” *Id.* at 44-45.

Under the Lanham Act, 15 U.S.C. 1051 *et seq.*, one benefit of federal registration is that the mark is included on an official United States Patent and Trademark Office (USPTO) publication (the Principal Register) that others can consult to determine whether their own (actual or contemplated) marks would infringe an existing mark. Respondent is correct that an intended consequence of such notice is to deter infringing activities.¹ In denying respondent the benefit of that notice-giving function, however, the government has simply declined to assist respondent by communicating to the world a message—that respondent’s mark is entitled to trademark protection, and that others who use it in commerce risk liability for infringement—that might indirectly boost respondent’s commercial prospects by dissuading competitors from using TRUMP TOO SMALL or a similar slogan. The living-individual clause does “not prevent [respondent] from using the phrase ‘Trump Too Small’ in any way he cho[oses], either as a trademark on shirts or in any other medium.” 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 13:37.50 (5th ed. 2023) (McCarthy).

To be sure, a law can “burden” speech without “ban[ning]” it “outright.” Resp. Br. 42 (citation omitted). In *United States v. Playboy Entertainment Group, Inc.*, 529 U.S. 803 (2000), for example, the Court applied heightened scrutiny to a law that “burden[ed]” speech by limiting the transmission of certain content on tele-

¹ Federal registration of a trademark provides the mark owner other benefits as well, including that the owner of a registered mark can invoke certain presumptions in infringement suits. Gov’t Br. 4. And while registration is not a prerequisite to trademark protection or infringement remedies, the Lanham Act creates a cause of action specific to infringement of a registered mark. 15 U.S.C. 1114(1).

vision. *Id.* at 812. And in *Simon & Schuster, Inc. v. Members of the N.Y. State Crime Victims Board*, 502 U.S. 105 (1991), the Court applied heightened scrutiny to a law that “burden[ed]” speech by taking away “all of the speaker’s speech-derived income.” *Id.* at 115-116. While the laws at issue in those cases stopped short of “complete[ly] prohibiti[ng]” free speech, they still “restrict[ed]” its exercise. *Playboy*, 529 U.S. at 811-812; see *Simon & Schuster*, 502 U.S. at 124 (Kennedy, J., concurring in the judgment). Denial of federal trademark registration, however, imposes no analogous restriction. Respondent’s focus on the government’s failure to provide him affirmative assistance (in the form of a warning to potential infringers) simply underscores the fact that, when the USPTO refuses to register a mark, “[n]o speech is being restricted; no one is being punished.” *Brunetti*, 139 S. Ct. at 2303 (Roberts, C.J., concurring in part and dissenting in part).

In that respect, the living-individual clause is no different from the conditions on government benefits that this Court has previously upheld in cases such as *Regan v. Taxation With Representation of Washington*, 461 U.S. 540 (1983); *Cornelius v. NAACP Legal Defense & Educational Fund, Inc.*, 473 U.S. 788 (1985); and *Ysursa*, *supra*. Gov’t Br. 16-21. Respondent observes (Br. 42-44) that those cases involved different *types* of government benefits. As our opening brief explains (at 34-36), however, the Court’s decisions in those cases turned not on the precise nature of the government benefits at issue, but on the principle that, while the First Amendment “protects the right to be free from government abridgment of speech,” it does not confer an affirmative right to governmental assistance in speaking. *Ysursa*, 555 U.S. at 358; see *Cornelius*, 473 U.S. at 809 (“The First

Amendment does not demand unrestricted access to a nonpublic forum merely because use of that forum may be the most efficient means of delivering the speaker's message."); *Regan*, 461 U.S. at 549-550 (“[A]lthough government may not place obstacles in the path of a person’s exercise of freedom of speech,’ * * * the Constitution ‘does not confer an entitlement to such funds as may be necessary to realize all the advantages of that freedom.’”) (brackets, citation, and ellipsis omitted). The same principle applies here. See *Brunetti*, 139 S. Ct. at 2317 (Sotomayor, J., concurring in part and dissenting in part).

A condition on federal trademark registration might still raise First Amendment concerns if Congress sought to “leverage” the benefits of registration “to regulate speech outside the contours of the program itself.” *Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 570 U.S. 205, 214-215 (2013) (*AOSI*); see *Rust v. Sullivan*, 500 U.S. 173, 196 (1991) (noting concerns raised when Congress “condition[s] the receipt of a benefit * * * on the relinquishment of a constitutional right”). That concern would exist, for example, if the statute denied registration of *any* trademark for respondent’s wares because he was marketing shirts with the TRUMP TOO SMALL slogan. The living-individual clause does not operate in that manner, however, but simply “define[s] the limits” of the federal trademark-registration program by identifying categories of marks that may not be registered. *AOSI*, 570 U.S. at 214. Respondent therefore could sell shirts emblazoned with his preferred slogan, while using and registering a *different* mark to identify himself as the source of the goods. Gov’t Br. 23-24; cf. *Regan*, 461 U.S. at 545 (explaining that, in denying tax-exempt status to organiza-

tions that engaged in substantial lobbying, Congress had “not den[ied] a benefit to a person because he exercises a constitutional right,” but had “merely refused to pay for the lobbying out of public moneys”).²

B. Section 1052(c)’s Living-Individual Clause Is Viewpoint-Neutral

Even as a condition on a government benefit, the living-individual clause would be subject to heightened scrutiny if it discriminated based on viewpoint. Gov’t Br. 35-36. Although respondent did “not press[] th[e] argument” in the court of appeals, C.A. Oral Argument at 46:29-46:32; see Pet. App. 5a, he now contends (Br. 40) that the living-individual clause is viewpoint-based. That argument lacks merit.

1. As our opening brief explains (at 14-15), the living-individual clause is viewpoint-neutral on its face. The clause directs the USPTO to consider only (1) whether a mark consists of or comprises “a name * * * identifying a particular living individual,” and (2) if so, whether

² Although the trademark-registration criteria in 15 U.S.C. 1052 turn on the content of the relevant mark, other trademark-registration criteria do not. For example, applicants must provide specified information about their actual or intended use of their mark in commerce, 15 U.S.C. 1051(a)(2)-(3) and (b)(2)-(3); must provide “specimens or facsimiles of the mark as used,” 15 U.S.C. 1051(a)(1); see 15 U.S.C. 1051(d)(1); and (if registration is allowed) must submit periodic affidavits attesting to continuing use of the mark in commerce, together with prescribed fees, 15 U.S.C. 1058. If one of those registration criteria were the subject of a constitutional challenge, a court would not ask whether the requirement could permissibly be imposed on the general public or on all commercial businesses. Rather, the court would assess whether the challenged requirement was a reasonable condition that applicants must satisfy to obtain the benefits associated with federal trademark registration. There is no reason for a different approach here.

that individual has given “written consent” to registration. 15 U.S.C. 1052(c). It does not matter “whether the use of [the] name is flattering, critical or neutral,” 2 McCarthy § 13:37.50, or why the individual’s written consent is lacking. Indeed, respondent appears to accept that the living-individual clause “does not reveal the same ‘facial viewpoint bias’ as the clauses in *Tam* and *Brunetti*,” Resp. Br. 18-19 (citation omitted), and “does not ‘on its face disfavor some ideas,’” *id.* at 25 (citation omitted).

2. The principal justifications for the living-individual clause also are viewpoint-neutral. As our opening brief explains (at 28-33), the clause serves (a) the government’s interest in not promoting a form of commercial appropriation (*i.e.*, the use of an unconsenting individual’s name for another’s commercial gain); (b) the government’s interest in avoiding the appearance that it endorses such commercial appropriation; and (c) the government’s interest in not promoting potentially misleading or deceptive source identifiers. None of those interests depends on the ideas or opinions that such a mark might convey. Accordingly, the living-individual clause “is justified without reference to the * * * viewpoint” respondent seeks to express. *Christian Legal Soc’y Chapter of the Univ. of Cal., Hastings Coll. of the Law v. Martinez*, 561 U.S. 661, 696 (2010) (brackets and citation omitted).

Respondent contends (Br. 22-24, 40-41) that Congress enacted the living-individual clause for a viewpoint-based purpose. But the only evidence he offers for that assertion consists of statements made by individual legislators and other participants during hearings preceding the Lanham Act’s enactment. Resp. Br. 9-10, 22-24. This Court has previously declined to rely on such state-

ments to “void a statute” under the First Amendment, explaining that “[w]hat motivates one legislator to make a speech about a statute is not necessarily what motivates scores of others to enact it.” *United States v. O’Brien*, 391 U.S. 367, 384 (1968); see *City of Renton v. Playtime Theatres, Inc.*, 475 U.S. 41, 47-48 (1986). Such caution is especially warranted here because (a) the comments on which respondent relies were made many years before the Lanham Act was enacted, and (b) most of those comments implicated distinct statutory language covering marks that contain the names of “deceased President[s]” rather than “particular living individual[s].” 15 U.S.C. 1052(c).

In any event, the legislative history that respondent cites does not suggest that the enacting Congress sought to suppress viewpoints critical of public officials. In discussing proposed trademark-registration criteria, Edward Rogers, a lawyer who had drafted the proposed legislation but who was not a Member of Congress, stated that he found “very distasteful” the “idea of prostituting great names by sticking them on all kinds of goods.” *Hearings on H.R. 9041 Before the Subcomm. on Trade-Marks of the House Comm. on Patents*, 75th Cong., 3d Sess. 79 (1938) (*1938 Hearings*). Rogers expressed similar disapproval of “attempt[s] to give vicarious credit to goods by putting a great man’s name on them.” *Id.* at 81. Representative Lanham stated that he did “not believe that George Washington should have his name bandied around on every commonplace article that is in ordinary use.” *Id.* at 80. To the extent those statements reflected a concern for the “dignity” of prominent individuals, Resp. Br. 10 (citation omitted), the perceived threat to dignity lay not in the expression of any critical views *about* those persons, but in the non-

consensual linkage between their names and a potentially diverse range of commercial products.

The specific examples of potentially objectionable trademarks that were referenced during the pre-Lanham Act congressional hearings reinforce this inference. Respondent cites (Br. 9) statements by the then-Commissioner of the Patent Office expressing concern about attempts to register “the name of Knute Rockne for whisky” and “the name of the Duchess of Windsor for brassieres and ladies’ underwear.” *1938 Hearings* 79. Other hearing participants expressed opposition to the use of “Benjamin Harrison’s name” as “a trade-mark on any article, device, or merchandise,” and to the hypothetical trademarks “Abraham Lincoln gin” and “George Washington coffee.” *Hearings on H.R. 4744 Before the Subcomm. on Trade-Marks of the House Comm. on Patents*, 76th Cong., 1st Sess. 19 (1939); see Resp. Br. 9. None of those examples involved actual or hypothetical trademarks that criticized the named individuals. Rather, the hearing participants found those marks to be inappropriate because they linked consenting individuals to commercial undertakings in order to elevate the manufacturers’ products.

3. Respondent contends (Br. 14) that the living-individual clause’s written-consent requirement gives the clause a “viewpoint-based effect.” Respondent argues that, “[b]ecause 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.” *Ibid.*; see *id.* at 1, 24-25.

This Court has rejected such a “differential impact” theory of viewpoint discrimination. *Christian Legal Soc’y*, 561 U.S. at 696. Under this Court’s precedents,

a law that is viewpoint-neutral on its face and in the purposes it serves “is deemed neutral,” even if it has “an incidental effect” on some “messages but not others.” *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989). Thus, even assuming that “no one would ever consent to the registration of speech that insults them,” Resp. Br. 14, the living-individual clause is still viewpoint-neutral. Unlike the provision held invalid in *Brunetti*, see 139 S. Ct. at 2300-2301, the living-individual clause does not require any government official to differentiate between favored and disfavored messages. The fact that certain individuals may have their “own viewpoint-based objections” to the registration of marks that are critical of them does not amount to “viewpoint *discrimination*” by the government. *Christian Legal Soc’y*, 561 U.S. at 696 (citation omitted).

Respondent’s disparate-impact theory of viewpoint discrimination has potentially far-reaching implications, since various trademark-law criteria are likely to have some *correlation* with the viewpoints that particular marks express. The critical viewpoint that respondent’s mark expresses, for example, supports the court of appeals’ determination that the mark does not falsely “suggest[] that President Trump has endorsed [respondent’s] product.” Pet. App. 15a. That correlation does not render 15 U.S.C. 1052(a)’s false-suggestion clause viewpoint-discriminatory. A court likewise may consider “a trademark’s expressive message”—in conjunction with the premise that commercial actors rarely mock their own products—in determining whether a parodic mark is likely to confuse consumers about the source of goods. *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1591-1592 (2023). The fact that mocking or critical facsimiles are less likely to be mis-

taken for the original trademark owner’s merchandise does not render the likelihood-of-confusion inquiry viewpoint-discriminatory. And the Lanham Act provision that governs infringement of a registered trademark refers specifically to actions taken “without the consent of the registrant.” 15 U.S.C. 1114(1). A prediction that registrants will more readily consent to flattering than to unflattering uses of their marks would provide no basis for treating that provision as viewpoint-discriminatory.

There are many reasons that written consent under the living-individual clause might be absent, and the named individual’s own viewpoint-based objection to a critical mark is only one of them. Even when a mark’s message is complimentary or neutral, named individuals might withhold consent in order to avoid any possible misperception that they are associated with the relevant goods, or to prevent their names from being exploited for another’s commercial gain. Under the living-individual clause, the USPTO has refused registration of many marks expressing positive messages about the living individuals they identified because no written consent from those individuals was on record. See, *e.g.*, U.S. Trademark Application Serial Nos. 90226753 (WELCOME PRESIDENT BIDEN), 97171152 (BETTER WITH BIDEN), 86728410 (I STUMP FOR TRUMP), 86761097 (IN TRUMP WE TRUST). Many marks that have been refused registration for lack of written consent do not express any viewpoint at all. See, *e.g.*, *In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d 1629, 2015 WL 496132, at *1 (T.T.A.B. Jan. 30, 2015) (ROYAL KATE); *In re Hoefflin*, 97 U.S.P.Q.2d 1174, 2010 WL 5191373, at *1 (T.T.A.B. Dec. 10, 2010) (OBAMA PAJAMA). And in other cases, written consent

might be lacking simply because the applicant for registration never sought to obtain it. The living-individual clause's written-consent requirement thus has resulted in refusals to register critical, complimentary, and neutral marks alike.

C. Section 1052(c)'s Living-Individual Clause Is Not Subject To Heightened First Amendment Scrutiny

As a viewpoint-neutral condition on a government benefit, the living-individual clause is not subject to strict or intermediate First Amendment scrutiny. Gov't Br. 16-21. Such scrutiny would be particularly unwarranted since federal trademark registration would enhance respondent's ability to restrict the speech of others. *Id.* at 24-28. Respondent's attempts to justify heightened scrutiny lack merit.

1. The content-based nature of the living-individual clause does not trigger heightened scrutiny

Like Section 1052's other trademark-registration criteria, the living-individual clause requires the USPTO to examine a mark's content to determine whether the mark may be registered. Gov't Br. 27. Respondent views (Br. 2, 19) that fact as a sufficient reason to apply heightened scrutiny. But "content discrimination" does not trigger heightened scrutiny when, as here, a law operates as a condition on a government benefit, rather than as a restriction on speech. *Davenport v. Washington Educ. Ass'n*, 551 U.S. 177, 188 (2007). "Accordingly, it is well established that the government can make content-based distinctions when it subsidizes speech." *Id.* at 188-189. It "is also black-letter law" that, in operating a limited public forum, the government "can exclude speakers on the basis of their subject matter." *Id.* at 189. And it is well settled that the government can

draw “distinction[s]” based on “content” in “declin[ing] to assist [union] speech.” *Ysursa*, 555 U.S. at 360-361.

All of the decisions on which respondent relies (Br. 13-14, 19-22, 26-28) involved restrictions on speech, not conditions on government benefits. See, e.g., *Reed v. Town of Gilbert*, 576 U.S. 155, 159 (2015) (applying heightened scrutiny to a statute that “prohibit[ed] the display of outdoor signs”); *Sorrell v. IMS Health Inc.*, 564 U.S. 563-564 (2011) (applying heightened scrutiny to a law that imposed “content- and speaker-based restrictions on the sale, disclosure, and use of prescriber-identifying information”); *Reno v. ACLU*, 521 U.S. 844, 880 (1997) (invalidating a statute that “prohibit[ed] the dissemination of indecent messages”); *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 561 (1980) (applying heightened scrutiny to a “restrict[ion]” on “commercial speech”). When the government restricts speech based on content, heightened scrutiny is generally warranted. *Davenport*, 551 U.S. at 188. But a more deferential standard applies when, as here, “the government is acting in a capacity other than as regulator.” *Ibid.*

A more deferential standard is particularly appropriate in the present statutory context. As our opening brief explains (at 27-28), content-based distinctions are an “inherent and inescapable” part of any trademark-registration program. *Perry Educ. Ass’n v. Perry Local Educators’ Ass’n*, 460 U.S. 37, 49 (1983). And Section 1052 draws such distinctions only for a narrow commercial purpose: the registration of source identifiers. Gov’t Br. 25-26. “[T]he risk that content-based distinctions will impermissibly interfere with the marketplace of ideas” therefore is especially “attenuated” here. *Davenport*, 551 U.S. at 188.

Respondent further contends (Br. 20-21) that the living-individual clause “discriminates among speakers,” since living individuals can register trademarks containing their own names while denying the same benefit to others. But because the living-individual clause establishes a condition on a government benefit, rather than restricting any person’s speech, the fact that the clause differentiates among potential registrants does not trigger heightened scrutiny. See, *e.g.*, *Perry*, 460 U.S. at 49 (“Implicit in the concept of the nonpublic forum is the right to make distinctions in access on the basis of subject matter and speaker identity.”). And with respect to registration of a trademark that contains an identified living individual’s name, it was wholly rational for Congress to give greater rights to *that individual* than to other potential registrants.

2. *The purpose of the living-individual clause is not a basis for heightened scrutiny*

Respondent argues that heightened scrutiny is warranted on the ground that Congress enacted the living-individual clause to “suppress unwanted speech.” Resp. Br. 22 (emphasis omitted). But as explained above, the clause does not suppress speech; it merely imposes a condition on a government benefit. See pp. 2-6, *supra*. The constitutionality of the living-individual clause turns on what it actually does, not on whether some “legislator” could have “made a ‘wiser’ speech about it.” *O’Brien*, 391 U.S. at 384.

In any event, respondent identifies no evidence that an illicit legislative motive prompted Congress to enact the living-individual clause. As explained above, some participants in the pre-Lanham Act congressional hearings viewed marks that contain unconsenting individuals’ names as “distasteful” or inappropriate. See pp. 8-9,

supra. But where Congress prefers for viewpoint-neutral reasons that merchants eschew particular types of trademarks, it may permissibly decline to assist such marks. If Congress determined that use of “obscene, vulgar, or profane” trademarks should be discouraged, it could permissibly enact a “viewpoint-neutral” bar on the registration of such marks, so as to “refrain[] from lending [the government’s] ancillary support to” them. *Brunetti*, 139 S. Ct. at 2317 (Sotomayor, J., concurring in part and dissenting in part); see *id.* at 2303-2304 (Roberts, C.J., concurring in part and dissenting in part). Likewise here, if Congress viewed the use of marks that commercially exploit an unconsenting individual’s name as undesirable, it could permissibly enact a viewpoint-neutral bar on federal registration of such marks, so as to avoid lending the government’s assistance to them.

Conditions on government benefits often reflect such viewpoint-neutral policy judgments, which have never been treated as a basis for heightened scrutiny. See, e.g., *Christian Legal Soc’y*, 561 U.S. at 683 (recognizing that the government may use subsidies as a “carrot”); *Rust*, 500 U.S. at 192-193 (recognizing that the government may use “the allocation of public funds” to “encourage[]” activities “it believes to be in the public interest”) (citation omitted). Neither the prospect that the living-individual clause will reduce the use of unconsenting individuals’ names as trademarks, nor the possibility that some Members of the enacting Congress viewed that result as desirable, converts the clause into a restriction on speech. See *Ysursa*, 555 U.S. at 360 n.2 (“A decision not to assist fundraising that may, as a practical matter, result in fewer contributions is simply not the same as directly limiting expression.”); *Rust*,

500 U.S. at 193 (“A refusal to fund protected activity, without more, cannot be equated with the imposition of a ‘penalty’ on that activity.”) (citation omitted). That is particularly so because, even if the living-individual clause encourages respondent to choose a different *trademark*, it would not meaningfully deter him from selling goods that bear his protected *expression*. See Gov’t Br. 23-24; pp. 5-6, *supra*.

3. *The practical effect of the living-individual clause undermines, rather than supports, respondent’s argument for heightened scrutiny*

Respondent argues that heightened scrutiny is warranted because the living-individual clause “ensures that ‘public officials could be praised but not condemned.’” Resp. Br. 25 (citation omitted). Specifically, respondent contends that, by requiring consent, the clause gives public figures a “heckler’s veto,” *id.* at 21, which they can use “to silence criticism from ordinary Americans,” *id.* at 25. But the living-individual clause does not allow anyone to silence anyone else’s speech. When individuals withhold consent to the registration of marks that identify them by name, the only effect is to deny the benefits that come with registration. That denial does not affect the owner’s freedom to use the mark or to engage in any expression.

Indeed, heightened scrutiny is particularly unwarranted given the specific nature of the benefits that federal trademark registration confers. As our opening brief explains (at 25, 39-40), registration bolsters mark owners’ rights to restrict others’ speech by enhancing the owners’ ability to prevent infringement of their marks. Respondent correctly observes (Br. 45) that “the First Amendment does not protect confusing or misleading commercial speech.” But the living-individual

clause leaves respondent free to use and register a *different* mark for his shirts, thereby invoking trademark law's protections against source confusion while allowing others to express their political views. See pp. 5-6, 16, *supra*. If the practical concern is the “silenc[ing]” of “criticism from ordinary Americans,” Resp. Br. 25, the registration of respondent's mark would increase that risk. “[R]egistration granted to one party may well inhibit all others from expressing the same thoughts, at least on goods of the same type.” 1 J. Thomas McCarthy & Roger E. Schechter, *The Rights of Publicity and Privacy* § 6:151 (2d ed. 2023) (McCarthy & Schechter).

Respondent's discussion of a “cease-and-desist letter that Trump sent to a ‘Stop Trump’ T-shirt company” in 2015 illustrates the point. Resp. Br. 25 (citation omitted). Respondent cites that letter as a purported example of the living-individual clause “arm[ing] political figures with tools that have been used to silence criticism from ordinary Americans.” *Ibid.* But the 2015 cease-and-desist letter did not invoke the living-individual clause. Rather, the letter accused the T-shirt company of infringing “Trump®,” which “is protected by U.S. Trademark Registration” and “has been declared ‘incontestable’ by the [USPTO].” *Ibid.* (citation omitted). The letter simply highlights that it is the registration of a mark, not the refusal to register it, that can have the effect of restricting speech.³

³ The article that respondent cites, published the day after the cease-and-desist letter was sent, concluded that Donald Trump's presidential campaign (for the 2016 election) had no meritorious legal objection to the T-shirt company's sale of the shirts. 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/9K4K-8K4K>.

**D. Congress Acted Reasonably In Denying The Benefits Of
Registration To Marks Covered By The Living-Individual
Clause**

Because the First Amendment does not require heightened scrutiny here, the living-individual clause need only have a “reasonable” basis. *Brunetti*, 139 S. Ct. at 2317 (Sotomayor, J., concurring in part and dissenting in part); see Gov’t Br. 17, 28. Respondent urges (Br. 2, 35-36, 39-40) this Court to apply a standard of reasonableness drawn from *National Institute of Family & Life Advocates v. Becerra*, 138 S. Ct. 2361 (2018) (*NIFLA*), and *Zauderer v. Office of Disciplinary Counsel of the Supreme Court of Ohio*, 471 U.S. 626 (1985). But those decisions involved laws that restricted the freedom of speech by “compelling individuals to speak a particular message.” *NIFLA*, 138 S. Ct. at 2371; see *Zauderer*, 471 U.S. at 650-653. Denial of federal trademark registration, by contrast, neither prevents respondent from selling his shirts nor requires him to make any additional statements he would prefer not to make. *NIFLA* and *Zauderer* therefore are inapposite here. Instead, the applicable standard of reasonableness comes from this Court’s decisions involving conditions on government benefits, which require that the condition have a reasonable (or rational) basis. See *Ysursa*, 555 U.S. at 355; *Cornelius*, 473 U.S. at 808; *Regan*, 461 U.S. at 550.

cc/C28F-NYZU. *Inter alia*, the article expressed the view that the Trump campaign could not prevail in any trademark-infringement suit because “no reasonable person would assume that ‘StopTrump’ T-shirts are authorized by Trump himself.” *Ibid.*; see pp. 10-11, *supra*. That argument would not be available, however, if respondent obtained federal registration of his mark and a competitor sold shirts emblazoned with TRUMP TOO SMALL or a similar slogan.

1. The living-individual clause reasonably serves the government's interest in declining to reward commercial appropriation of an unconsenting individual's name

As our opening brief explains (at 28-29), using another individual's name for commercial purposes without that individual's consent has long been viewed as a form of commercial appropriation. The government therefore may reasonably decline to "give aid and comfort" to those engaging in such appropriation. *Brunetti*, 139 S. Ct. at 2303-2304 (Roberts, C.J., concurring in part and dissenting in part). Respondent's contrary arguments lack merit.

a. Respondent contends that the government's asserted interest in not promoting the commercial appropriation of an unconsenting individual's name does not reflect the living-individual clause's "actual rationale." Resp. Br. 31; see *id.* at 29-30. But as explained above, the legislative history suggests that such commercial appropriation was Congress's concern. See pp. 8-9, *supra*. In any event, under the rational-basis standard, the question is whether any reasonable justification for the law exists, not what Congress actually had in mind. See *FCC v. Beach Commc'ns, Inc.*, 508 U.S. 307, 315 (1993) (explaining that, under rational-basis review, "it is entirely irrelevant for constitutional purposes whether the conceived reason for the challenged distinction actually motivated the legislature").

Respondent is also wrong in asserting (Br. 29) that the government has "abandone[d] 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." As our opening brief explains (at 28-29), the commercial

exploitation of an individual's identity without that individual's consent has long been viewed as a violation of both privacy and publicity interests. "Privacy" and "publicity" simply describe the different harms—personal and proprietary—that such commercial appropriation may cause. See W. Page Keeton et al., *Prosser and Keeton on the Law of Torts* 854 (5th ed. 1984) (explaining that the appropriation of a person's identity can harm both "personal" and "proprietary" interests). Whether those harms are framed in terms of "privacy" or "publicity," their underlying source is the same: the use of an unconsenting individual's identity for another's commercial gain. See 1 McCarthy & Schechter § 1:23 (explaining that Prosser viewed the tort of "appropriation" as "protecting both a commercial and a personal dignity interest, no matter what label was attached").

b. Respondent contends that the right of publicity "has never been applied to support a cause of action for criticism of a public figure," Resp. Br. 31, and that the "government cites no cases in which this kind of speech gave rise to right-of-publicity liability," *id.* at 34. But the current litigation is not a "cause of action for criticism of a public figure," *id.* at 31, and a decision in the government's favor would not subject respondent to "liability," *id.* at 34. Rather, this litigation commenced when respondent sought judicial review of a USPTO decision that did not limit respondent's ability to market his shirts or otherwise to convey his chosen message, but simply denied him the benefits associated with federal trademark registration.

Respondent also contends (Br. 31-33) that the First Amendment would protect him from any liability that state law might impose for selling shirts with his pre-

ferred slogan. But even assuming that is true, it is beside the point. The question here is not whether the First Amendment protects his speech from government interference; it is whether he has an affirmative right to government assistance in speaking. *Ysursa*, 555 U.S. at 358. The answer is no. “The Government has no constitutional duty to subsidize an activity merely because the activity is constitutionally protected.” *Rust*, 500 U.S. at 201. The Court has thus repeatedly upheld program conditions that specifically excluded political speech from eligibility for government benefits. Gov’t Br. 37-38; see *Ysursa*, 555 U.S. at 355; *Davenport*, 551 U.S. at 182; *Cornelius*, 473 U.S. at 795; *Regan*, 461 U.S. at 542.

c. Respondent argues that the USPTO has interpreted the living-individual clause “so that its only practical effect” is to cover “marks about ‘celebrities and world-famous political figures.’” Resp. Br. 10 (citation omitted). That is incorrect. To determine whether the clause applies to a particular mark, the USPTO asks whether “the public would perceive the name in the proposed mark as identifying a particular living individual.” Pet. App. 27a. That test may be satisfied even when marks identify “lesser-known figures.” *Hoefflin*, 2010 WL 5191373, at *2. In order for such marks to be registered, those lesser-known figures must provide their written consent. See, e.g., U.S. Trademark Application Serial Nos. 88290882 (COURTNEY MALONE PHOTOGRAPHY), 87566849 (MOBILE MAI’S); *Reed v. Bakers Eng’g & Equip. Co.*, 100 U.S.P.Q. 196, 1954 WL 5348, at *5 (P.T.O. 1954) (REED REEL OVEN); cf. 1 McCarthy & Schechter § 1:3 (“The right of publicity is not merely a legal right of the ‘celebrity,’ but is a right inherent to everyone to control the commercial use of identity and persona.”).

2. *The living-individual clause reasonably serves the government's interest in not associating itself with commercial appropriation of an unconsenting individual's name*

As our opening brief explains (at 30-31), the government has a reasonable interest in not associating itself with marks that commercially exploit an unconsenting individual's identity. The Court has relied on similar associational interests in upholding other government-benefit conditions against First Amendment challenges. See *Ysursa*, 555 U.S. at 359; *Cornelius*, 473 U.S. at 809; cf. *Brunetti*, 139 S. Ct. at 2303 (Roberts, C.J., concurring in part and dissenting in part); *id.* at 2317 (Sotomayor, J., concurring in part and dissenting in part). Respondent does not address the government's associational interest, which provides an independently sufficient basis for the living-individual clause. See *Beach Commc'ns*, 508 U.S. at 315 (explaining that, on rational-basis review, those challenging the "rationality" of the statute "have the burden 'to negative every conceivable basis which might support it'") (citation omitted).

3. *The living-individual clause reasonably serves the government's interest in not promoting marks that risk confusion about an individual's affiliation with a product*

Finally, as our opening brief explains (at 31-33), the government has a reasonable interest in not promoting potentially misleading or deceptive source identifiers. Respondent asserts that a different Lanham Act provision—Section 1052(a)'s false-suggestion clause—separately addresses misleading marks by barring the registration of marks that "falsely suggest a connection" with a particular individual. 15 U.S.C. 1052(a); see Resp. Br. 35. But when a mark identifies a particular

individual by name, there is a distinctive risk that the public will perceive an affiliation between the individual and the product being marketed. See 1 McCarthy & Schechter § 4.24 (giving the example of a magazine advertisement run “without permission” by the Ajax Coffee Co. “featuring a photo of [a] Justice and reading: ‘Justice Zelda Zak judges hard cases every day, but our coffee tasters have to make just as difficult distinctions in selecting only the finest coffee beans for Ajax Coffee’”).

The living-individual clause thus complements the false-suggestion clause by creating a more specific rule to address the risk of misattribution: If the named individual has not provided consent, registration must be refused. That bright-line rule allows named individuals to decide whether they are willing to tolerate the risk of being perceived as affiliated with the products. Respondent is therefore wrong in suggesting that the living-individual clause does not serve the “goal of preventing source confusion,” Resp. Br. 6, and that “its only practical effect is to cover *non*-misleading marks,” *id.* at 7.

* * * * *

For the foregoing reasons and those stated in our opening brief, the judgment of the court of appeals should be reversed.

Respectfully submitted.

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Solicitor General

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