
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*

BRIEF FOR THE PETITIONER

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QUESTION PRESENTED

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). The question presented is as follows:

Whether the refusal to register a mark under Section 1052(c) violates the Free Speech Clause of the First Amendment when the mark contains criticism of a government official or public figure.

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No. 22-704

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BRIEF FOR THE PETITIONER

OPINIONS BELOW

The opinion of the court of appeals (Pet. App. 1a-21a) is reported at 26 F.4th 1328. The decisions of the United States Patent and Trademark Office's Trademark Trial and Appeal Board (Pet. App. 22a-32a) and examining attorney (Pet. App. 33a-40a, 41a-51a, 52a-59a, 60a-64a) are unreported.

JURISDICTION

The judgment of the court of appeals was entered on February 24, 2022. A petition for rehearing was denied on August 31, 2022 (Pet. App. 65a-66a). On November 18, 2022, the Chief Justice extended the time within which to file a petition for a writ of certiorari to and including December 29, 2022. On December 20, 2022, the

Chief Justice further extended the time to and including January 27, 2023, and the petition was filed on that date. The petition for a writ of certiorari was granted on June 5, 2023. The jurisdiction of this Court rests on 28 U.S.C. 1254(1).

**CONSTITUTIONAL AND STATUTORY
PROVISIONS INVOLVED**

The First Amendment provides in pertinent part that “Congress shall make no law * * * abridging the freedom of speech.” U.S. Const. Amend. I.

Section 1052 of Title 15 of the United States Code provides in pertinent part:

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

* * * * *

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

15 U.S.C. 1052. Other statutory provisions are reproduced in an appendix to this brief. App., *infra*, 1a-21a.

STATEMENT

A. Legal Background

1. A trademark is a “word, name, symbol, or device” that a person uses or intends to use “to identify and distinguish his or her goods” from “those manufactured or sold by others and to indicate the source of the goods.” 15 U.S.C. 1127. A “trademark’s ‘primary’ function” is

“to identify the origin or ownership of the article to which it is affixed.” *Jack Daniel’s Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1583 (2023) (citation omitted); see *Wal-Mart Stores, Inc. v. Samara Bros.*, 529 U.S. 205, 212 (2000) (explaining that the “predominant function” of a trademark is “source identification”). Thus, “whatever else it may do, a trademark is not a trademark unless it identifies a product’s source” and “distinguishes that source from others.” *Jack Daniel’s*, 143 S. Ct. at 1583.

At common law, “[o]ne who first uses a distinct mark in commerce * * * acquires rights to that mark.” *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015). “Those rights include preventing others from using the mark.” *Ibid.*; see *K Mart Corp. v. Cartier, Inc.*, 485 U.S. 176, 185 (1988) (“Trademark law, like contract law, confers private rights, which are themselves rights of exclusion.”). The owner of a mark thus enjoys the “exclusive” right to use it in commerce. *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251, 259 (1916).

To exclude others from using the mark, its owner may bring an infringement action under state or federal law. See *Matal v. Tam*, 582 U.S. 218, 225-226 (2017); 15 U.S.C. 1114(1)(a) (cause of action for infringement of federally registered marks); 15 U.S.C. 1125(a) (cause of action for infringement of marks that are not federally registered). “Infringement law protects consumers from being misled by the use of infringing marks and also protects producers from unfair practices by an imitating competitor.” *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (citation and internal quotation marks omitted).

2. Under the Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*), the United States Patent and Trademark Office (USPTO) “administers a federal registration system for trademarks.” *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019). “Registration of a mark is not mandatory,” but it “gives trademark owners valuable benefits.” *Ibid.*; see 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 19:9 (5th ed. 2023) (McCarthy) (listing benefits). Those benefits help owners enforce their rights against infringers. See *Jack Daniel’s*, 143 S. Ct. at 1584. For example, registration serves as nationwide “constructive notice of the registrant’s claim of ownership,” 15 U.S.C. 1072, “which forecloses some defenses in infringement actions,” *Brunetti*, 139 S. Ct. at 2298. Registration is “prima facie evidence of the validity of the registered mark,” “of the registrant’s ownership of the mark, and of the registrant’s exclusive right to use the registered mark in commerce.” 15 U.S.C. 1115(a); see 15 U.S.C. 1057(b). Registration can be used to stop the importation of goods that bear an infringing mark. 15 U.S.C. 1124. And after the “registered mark has been in continuous use for five consecutive years,” the owner’s right to use the mark can become “incontestable,” except on certain grounds. 15 U.S.C. 1065 (2018 & Supp. III 2021), 1115(b).

To obtain the benefits of registration, a person who uses or intends to use a trademark in commerce applies to register the mark on the USPTO’s “principal register.” 15 U.S.C. 1051(a)(1) and (b)(1); see 35 U.S.C. 2(a)(1). The application must include a description of “the goods in connection with which the mark is used” or is intended to be used. 15 U.S.C. 1051(a)(2); see 15 U.S.C. 1051(b)(2). If the USPTO concludes that the criteria for registration are satisfied, the agency issues the owner a certifi-

cate of registration “in the name of the United States of America.” 15 U.S.C. 1057(a). The owner then “may give notice that his mark is registered by displaying with the mark the words ‘Registered in U.S. Patent and Trademark Office’ or ‘Reg. U.S. Pat. & Tm. Off.’ or the letter R enclosed within a circle, thus ®.” 15 U.S.C. 1111.

Only marks that satisfy the statutory criteria can be registered. “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*, 143 S. Ct. at 1583 (quoting 3 McCarthy § 19:10); see 15 U.S.C. 1127; USPTO, *Trademark Manual of Examining Procedure (TMEP)* § 1202.04 (July 2022). In addition, the Lanham Act directs the USPTO to “refuse[] registration” of, among others, marks that are deceptive, 15 U.S.C. 1052(a); marks containing a flag, coat of arms, or insignia of the United States, a State, or a foreign nation, 15 U.S.C. 1052(b); marks that so resemble other marks that they are likely to cause confusion, 15 U.S.C. 1052(d); and marks that are merely descriptive, 15 U.S.C. 1052(e)(1).

This case concerns a Lanham Act provision codified at 15 U.S.C. 1052(c), which directs the USPTO to refuse registration of a mark that “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.” Since 1946, the federal trademark-registration program has barred the registration of a mark that consists of or comprises such a name. Lanham Act § 2(c), 60 Stat. 428; cf. Act of Feb. 20, 1905, ch. 592, § 5(b), 33 Stat. 726 (providing that “no portrait of a living individual may be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing”).

B. Proceedings Below

1. In 2018, respondent applied for federal registration of the mark TRUMP TOO SMALL based on an asserted intent to use the mark in commerce on shirts. Pet. App. 22a & n.1; see 15 U.S.C. 1051(b). “The mark consists of standard characters, without claim to any particular font style, size, or color.” Pet. App. 70a.¹

A USPTO examining attorney refused registration under Section 1052(c). Pet. App. 52a-59a. The examining attorney explained that “the use of the name ‘TRUMP’ in the proposed mark would be construed by the public as a reference to Donald Trump” and that, without then-President Trump’s written consent, registration had to be refused. *Id.* at 58a; see *id.* at 53a-56a. The examining attorney further explained that Section 1052(c) was meant to “protect rights of privacy and publicity that living persons have in the designations that identify them.” *Id.* at 57a.

Respondent appealed to the USPTO’s Trademark Trial and Appeal Board (Board), but at the examining attorney’s request, the Board suspended the appeal and remanded to the examining attorney for further examination. See Pet. App. 23a n.2, 33a; 37 C.F.R. 2.142(f)(6). The examining attorney then found that registration should also be refused under 15 U.S.C. 1052(a), which bars the registration of marks that “falsely suggest a connection with persons, living or dead.” *Ibid.*; see Pet. App. 39a.

The Board affirmed the refusal of registration under Section 1052(c). Pet. App. 22a-32a. The Board agreed with the examining attorney that respondent’s mark

¹ The administrative record in this case is available at USPTO, *Trademark Status & Document Retrieval (TSDR)*, <https://tsdr.uspto.gov> (search for U.S. Serial No. 87749230).

“comprises the name of President Donald Trump without his written consent.” *Id.* at 32a. The Board also rejected respondent’s contention that the refusal to register his mark violated his right to free speech under the First Amendment. *Id.* at 29a-32a. The Board explained that Section 1052(c) is “not [a] direct restriction[] on speech,” but rather “only set[s] criteria for trademark registration.” *Id.* at 30a. The Board also emphasized that Section 1052(c) applies “regardless of the viewpoint conveyed by the proposed mark.” *Id.* at 31a. Having affirmed the refusal to register under Section 1052(c), the Board found it unnecessary to “reach the refusal to register under Section [1052(a)’s] false association clause.” *Id.* at 32a.

2. The court of appeals reversed. Pet. App. 1a-21a. The court held that “applying [Section 1052(c)] to bar registration of [respondent’s] mark unconstitutionally restricts free speech in violation of the First Amendment.” *Id.* at 1a.

The court of appeals acknowledged that Section 1052(c) “does not involve viewpoint discrimination.” Pet. App. 5a. The court also recognized that Section 1052(c) “does not prevent [respondent] from communicating his message outright.” *Id.* at 6a. The court nevertheless viewed Section 1052(c) as a “content-based restriction[]” that is subject to “strict” or “intermediate” scrutiny under the First Amendment. *Id.* at 9a. In the court’s view, the application of Section 1052(c) to respondent’s mark did not survive such scrutiny “because the government does not have a privacy or publicity interest in restricting speech critical of government officials or public figures in the trademark context—at

least absent actual malice, which is not alleged here.”
Id. at 20a.²

3. The court of appeals denied rehearing en banc.
 Pet. App. 65a-66a.

SUMMARY OF ARGUMENT

The Lanham Act directs the USPTO to refuse registration of a mark that “[c]onsists of or comprises a name * * * identifying a particular living individual” without “his written consent.” 15 U.S.C. 1052(c). The court of appeals held that the USPTO’s refusal to register a mark under Section 1052(c) violates the First Amendment when the mark contains criticism of a government official or public figure. That holding was erroneous. Both on its face and as applied to the mark at issue here, Section 1052(c) does not restrict speech, but simply imposes a reasonable, viewpoint-neutral condition on the benefits available under the federal trademark-registration program.

A. This Court’s decisions in *Matal v. Tam*, 582 U.S. 218 (2017), and *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019), are not controlling here. *Tam* and *Brunetti* involved statutory bars on trademark registration that this Court found unconstitutional because they discriminated based

² The court of appeals noted that the Board had not addressed the examining attorney’s refusal of registration under Section 1052(a), and that the government had not raised Section 1052(a) “as an alternative basis for affirming the Board’s decision.” Pet. App. 15a n.3. The court nevertheless rejected the possibility of upholding the examining attorney’s decision based on “an interest in preventing the issuance of marks that falsely suggest that an individual * * * has endorsed a particular product or service.” *Id.* at 15a. The court explained that “[n]o plausible claim could be * * * made that the disputed mark suggests that President Trump has endorsed [respondent’s] product.” *Ibid.*

on viewpoint. Section 1052(c), in contrast, undisputedly “does not involve viewpoint discrimination.” Pet. App. 5a. This case therefore presents an issue that *Tam* and *Brunetti* left open: “how to evaluate viewpoint-*neutral*” bars on trademark registration under the First Amendment. *Brunetti*, 139 S. Ct. at 2302 n.* (emphasis added).

B. This Court’s First Amendment precedents have long distinguished restrictions on speech (which are subject to heightened scrutiny) from conditions on government benefits (which are not). That distinction follows from the text of the Amendment, which prohibits laws “*abridging* the freedom of speech.” U.S. Const. Amend. I (emphasis added). It also reflects the recognition that, “when the government is acting in a capacity other than as regulator,” the “risk” that its actions “will impermissibly interfere with the marketplace of ideas is sometimes attenuated.” *Davenport v. Washington Educ. Ass’n*, 551 U.S. 177, 188 (2007).

As a viewpoint-neutral bar on federal trademark registration, Section 1052(c) is a condition on a government benefit, not a restriction on speech. Refusal of registration under Section 1052(c) does not limit the rights of trademark owners to use their marks in commerce or to engage in whatever speech they wish. The only effect of the refusal is to deny an owner the benefits—*i.e.*, additional mechanisms to prevent use of the same mark by competitors—that federal registration provides.

Because Section 1052(c) does not restrict speech, heightened scrutiny is unwarranted. Three additional aspects of federal trademark registration reinforce that conclusion. First, the purpose and effect of federal trademark registration is to enhance the mark owner’s ability to prevent others’ use of the mark—and thus to restrict others’ speech. Second, because conveying a

message is only incidental to a mark's primary source-identification function, the risk that decisions refusing registration will distort the broader marketplace of ideas is highly attenuated. Third, the use of content-based criteria to determine whether particular marks may be registered is an inherent aspect of any trademark-registration program, and heightened scrutiny would threaten to invalidate that defining characteristic.

Because heightened scrutiny is unwarranted, the First Amendment inquiry turns on whether Section 1052(c) has a reasonable basis. The justifications for Section 1052(c) easily meet that standard. 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 may reasonably decline to reward, or to associate itself with, such appropriation of another's identity. The unauthorized use of someone else's name also risks confusion about a product's source. Because Section 1052(c) is a reasonable, viewpoint-neutral condition on federal trademark registration, it does not violate the First Amendment.

C. The court of appeals erred in holding Section 1052(c) unconstitutional as applied to marks that criticize a government official or public figure. That holding rested on the court's view that Section 1052(c) is a restriction on speech, and the errors in the court's reasoning are apparent once Section 1052(c) is correctly understood to be a condition on a government benefit.

Congress has made enhanced enforcement mechanisms available to the owners of registered marks, thereby assisting the owners' ability to prevent use of their marks by others. Congress has broad latitude, however, to limit the availability of those enforcement

mechanisms through viewpoint-neutral registration criteria. The anomalous effect of the court of appeals' decision is to vest respondent with a First Amendment *right* to prevent others from speaking and to obtain the government's assistance in that endeavor, notwithstanding Congress's decision to exclude respondent's own mark from eligibility for the benefits that federal registration confers. And it is particularly strange to treat the political character of respondent's message as a factor supporting that result.

ARGUMENT

THE TRADEMARK-REGISTRATION BAR IN 15 U.S.C. 1052(c) IS CONSTITUTIONAL ON ITS FACE AND AS APPLIED

For more than 75 years, Congress has directed the USPTO to refuse the registration of trademarks that use the names of particular living individuals without their written consent. 15 U.S.C. 1052(c). That viewpoint-neutral bar operates not as a restriction on speech, but as a condition on the benefits that federal trademark registration provides. Because the government may reasonably decline to reward or associate itself with the use of marks that commercially appropriate someone else's identity, Section 1052(c) is consistent with the First Amendment.

A. Because Section 1052(c) Is Viewpoint-Neutral, *Tam* And *Brunetti* Are Not Controlling Here

During the past decade, this Court has twice addressed the constitutionality of statutory bars on federal trademark registration. See *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Matal v. Tam*, 582 U.S. 218 (2017). In both of those cases, the Court concluded that the provisions at issue violated the First Amendment. See *Brunetti*, 139 S. Ct. at 2297. It did so, however, on the

ground that those provisions discriminated based on viewpoint, *ibid.*, without deciding “how to evaluate viewpoint-*neutral*” bars on trademark registration, *id.* at 2302 n.* (emphasis added). Because Section 1052(c) is viewpoint-neutral, this Court’s decisions in *Tam* and *Brunetti* are not controlling here.

1. *Tam* involved an application for federal registration of the mark THE SLANTS. 582 U.S. at 228. The USPTO refused registration, citing the Lanham Act’s bar on registering marks that “disparage” any “persons, living or dead.” 15 U.S.C. 1052(a); see *Tam*, 582 U.S. at 228-229. Although the “eight-Justice Court divided evenly between two opinions,” “all the Justices agreed on two propositions.” *Brunetti*, 139 S. Ct. at 2298-2299. First, if the disparagement bar was viewpoint-based, it was unconstitutional because it could not survive heightened scrutiny under the First Amendment. See *Tam*, 582 U.S. at 223, 243-247 (Alito, J.); *id.* at 247, 251-253 (Kennedy, J.). And second, “the disparagement bar was viewpoint-based.” *Brunetti*, 139 S. Ct. at 2299; see *Tam*, 582 U.S. at 223, 243 (Alito, J.); *id.* at 248-251 (Kennedy, J.). Those two holdings taken together were sufficient to decide the case.

The eight-Justice Court otherwise “could not agree” on an “overall framework” for determining the constitutionality of statutory bars on federal trademark registration. *Brunetti*, 139 S. Ct. at 2298. “In particular, no majority emerged to resolve whether a Lanham Act bar is a condition on a government benefit or a simple restriction on speech.” *Id.* at 2298-2299. The Court in *Tam* thus “left open” the question “of how exactly the trademark registration system is best conceived under [the Court’s] precedents.” *Id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part); see *Tam*, 582

U.S. at 244 & n.16 (Alito, J.) (“leav[ing] open” the question whether viewpoint-neutral criteria could be “saved” by analyzing federal registration as a “type of government program in which some content- and speaker-based restrictions are permitted”); *id.* at 252 (Kennedy, J.) (leaving open “the question of how other provisions of the Lanham Act should be analyzed under the First Amendment”).

2. In *Brunetti*, this Court addressed a First Amendment challenge to another statutory bar on federal trademark registration. *Brunetti* involved an application for federal registration of the mark FUCT for use on clothing. 139 S. Ct. at 2297. The USPTO refused registration, citing the Lanham Act’s bar on registering marks that consist of or comprise “immoral” or “scandalous matter.” 15 U.S.C. 1052(a); see *Brunetti*, 139 S. Ct. at 2298. The Court held that the “immoral or scandalous” registration bar was “viewpoint-based,” *Brunetti*, 139 S. Ct. at 2299, and therefore violated the First Amendment “for the same reason” as the disparagement bar that had been held invalid in *Tam*, *id.* at 2297. As in *Tam*, that holding made it unnecessary for the Court to “say anything about how to evaluate viewpoint-neutral restrictions on trademark registration.” *Id.* at 2302 n.*.

Justice Alito concurred, writing separately to emphasize that the Court’s decision did “not prevent Congress from adopting a more carefully focused statute that precludes the registration of marks containing vulgar terms that play no real part in the expression of ideas.” *Brunetti*, 139 S. Ct. at 2303 (Alito, J., concurring). Three other Justices dissented in part. In their view, “the ‘scandalous’ portion of the provision” at issue could have been construed to “bar only marks that of-

fend because of their mode of expression—marks that are obscene, vulgar, or profane.” *Id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part); see *id.* at 2304 (Breyer, J., concurring in part and dissenting in part); *id.* at 2311 (Sotomayor, J., concurring in part and dissenting in part). Based on that narrowing construction, the dissenters would have upheld the bar on registration of “scandalous” marks as a viewpoint-neutral provision that “merely denied certain additional benefits associated with federal trademark registration.” *Id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part); see *id.* at 2304, 2306 (Breyer, J., concurring in part and dissenting in part); *id.* at 2316-2318 (Sotomayor, J., concurring in part and dissenting in part).

3. Here, unlike in *Tam* and *Brunetti*, the challenged Lanham Act provision undisputedly “does not involve viewpoint discrimination.” Pet. App. 5a; see *ibid.* (noting respondent’s agreement below that Section 1052(c) is not viewpoint-based). Section 1052(c) directs the USPTO to refuse registration of marks that consist of or comprise “a name, portrait, or signature identifying a particular living individual except by his written consent.” 15 U.S.C. 1052(c). Whether a particular person’s consent is required depends on “whether the mark would be recognized and understood by the public as identifying the person.” *Martin v. Carter Hawley Hale Stores, Inc.*, 206 U.S.P.Q. 931, 1979 WL 24811, at *2 (T.T.A.B. Dec. 12, 1979) (citation omitted). If evidence shows that the mark would be so perceived, and if the person has not given written consent to the mark’s registration, Section 1052(c) directs the USPTO to refuse registration, “regardless of the viewpoint conveyed by the proposed mark.” Pet. App. 31a; see 2 McCarthy § 13:37.50 (explaining that the applicability of Section

1052(c) does not depend on “whether the use of [the] name is flattering, critical or neutral”).

This case illustrates the viewpoint-neutral application of Section 1052(c). The USPTO first determined that respondent’s mark included a name that “the public would view” as “the name of a particular living individual.” Pet. App. 28a; see *id.* at 25a-29a. That proposition is not controverted. Indeed, respondent’s stated objective in fashioning the mark—to communicate a critical message about the former President—depends on the public recognizing and understanding the word “TRUMP” in the mark to refer to that specific individual.

Having concluded that respondent’s mark “identif[ies]” former President Trump within the meaning of Section 1052(c), the USPTO then determined that the record contained no written consent from him. Pet. App. 26a. The USPTO therefore refused registration under Section 1052(c). *Id.* at 32a. At no point in reaching that decision did the USPTO consider “the ideas or opinions” that respondent’s mark might convey. *Brunetti*, 139 S. Ct. at 2299.

Because Section 1052(c) does not discriminate based on viewpoint, this Court’s decisions in *Tam* and *Brunetti* are not controlling here. Instead, this case presents the question that the Court left open in *Tam* and *Brunetti*: how a viewpoint-neutral bar on federal trademark registration should be evaluated under the First Amendment, including whether it should be considered “a condition on a government benefit or a simple restriction on speech.” *Brunetti*, 139 S. Ct. at 2299; see *id.* at 2302 n.*.

B. Section 1052(c) Is Consistent With The First Amendment

The First Amendment states that “Congress shall make no law * * * abridging the freedom of speech.”

U.S. Const. Amend. I. In determining whether a particular law “abridg[es]” the freedom of speech, *ibid.*, this Court has distinguished restrictions on speech (which are subject to heightened scrutiny) from conditions on government benefits (which are not). As a bar on federal trademark registration, Section 1052(c) falls within the latter category. And because Section 1052(c) is a reasonable, viewpoint-neutral condition on registration, it is consistent with the First Amendment.

1. Because Section 1052(c) is a viewpoint-neutral condition on a government benefit, not a restriction on speech, heightened scrutiny is unwarranted

When federal trademark registration is refused under Section 1052(c), no speech is restricted; the refusal results only in the withholding of certain benefits without regard to viewpoint. The First Amendment accordingly does not require heightened scrutiny. The particular nature of the benefits that flow from federal trademark registration makes such scrutiny especially inappropriate in this context.

a. This Court has declined to apply heightened scrutiny to viewpoint-neutral conditions on government benefits

This Court’s First Amendment precedents have long distinguished restrictions on speech from conditions on government benefits. That distinction follows from the text of the Amendment, which prohibits laws “*abridging* the freedom of speech.” U.S. Const. Amend. I (emphasis added); see *Ysursa v. Pocatello Educ. Ass’n*, 555 U.S. 353, 355 (2009). It also reflects the recognition that, “when the government is acting in a capacity other than as regulator,” the “risk” that its actions “will impermissibly interfere with the marketplace of ideas is

sometimes attenuated.” *Davenport v. Washington Educ. Ass’n*, 551 U.S. 177, 188 (2007); cf. *Maher v. Roe*, 432 U.S. 464, 476 (1977) (“Constitutional concerns are greatest when the State attempts to impose its will by force of law; the State’s power to encourage actions deemed to be in the public interest is necessarily far broader.”).

While restrictions on speech generally are subject to heightened scrutiny under the First Amendment, see, e.g., *Reed v. Town of Gilbert*, 576 U.S. 155, 163 (2015), conditions on government benefits generally are not, see, e.g., *Regan v. Taxation With Representation of Washington*, 461 U.S. 540, 549 (1983). Instead, the government may place viewpoint-neutral conditions on the availability of a benefit so long as those conditions are “reasonable.” *Ysursa*, 555 U.S. at 355; see *Brunetti*, 139 S. Ct. at 2317 (Sotomayor, J., concurring in part and dissenting in part). That principle is reflected in multiple lines of this Court’s precedent.

One line of precedent involves conditions on government monetary subsidies. When confronted with constitutional challenges to such conditions, the Court has emphasized the distinction between restrictions on constitutionally protected activities and mere refusals to subsidize them. See, e.g., *National Endowment for the Arts v. Finley*, 524 U.S. 569, 587-588 (1998) (recognizing that “the Government may allocate competitive funding according to criteria that would be impermissible were direct regulation of speech or a criminal penalty at stake”); *Rust v. Sullivan*, 500 U.S. 173, 193 (1991) (recognizing the “basic difference between direct state interference with a protected activity and state encouragement of an alternative activity consonant with legislative policy”) (citation omitted). Those decisions reflect the understanding that, because the “refusal to fund

protected activity, without more, cannot be equated with the imposition of a ‘penalty’ on that activity,” *Rust*, 500 U.S. at 193 (citation omitted), “a legislature’s decision not to subsidize the exercise of a fundamental right * * * is not subject to strict scrutiny,” *Regan*, 461 U.S. at 549.

In *Regan*, for example, the Court upheld a statute that denied tax-exempt status to organizations that engaged in substantial lobbying. 461 U.S. at 542 & n.1, 545-546, 548-551. An organization had claimed that “Congress’s decision not to subsidize its lobbying violate[d] the First Amendment.” *Id.* at 545. The Court declined to apply strict scrutiny, explaining that “Congress ha[d] not infringed any First Amendment rights or regulated any First Amendment activity,” but rather “ha[d] simply chosen not to pay for [the organization’s] lobbying.” *Id.* at 546; see *id.* at 548 (rejecting the suggestion that “strict scrutiny applies whenever Congress subsidizes some speech, but not all speech”). The Court then rejected the organization’s First Amendment challenge, finding it “not irrational” for Congress to have declined to subsidize the organization’s lobbying efforts. *Id.* at 550.

A second line of precedent involves conditions on access to limited public forums (also known as nonpublic forums). The Court has held that “a government entity may create a forum that is limited to use by certain groups or dedicated solely to the discussion of certain subjects.” *Pleasant Grove City v. Summum*, 555 U.S. 460, 470 (2009). There are various kinds of limited public forums, which provide access to different kinds of benefits. See, e.g., *Christian Legal Soc’y Chapter of the Univ. of Cal., Hastings Coll. of the Law v. Martinez*, 561 U.S. 661, 669-670 (2010) (describing a forum whose ben-

efits included “use” of a “name and logo”); *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 830 (1995) (recognizing that some forums may exist “more in a metaphysical than in a spatial or geographic sense”). When conditions on access have been challenged, the Court has distinguished such conditions from “prohibition[s]” and has declined to apply heightened scrutiny. *Christian Legal Soc’y*, 561 U.S. at 683; see *id.* at 687 n.17 (emphasizing “the distinction between state *prohibition* and state *support*”). Instead, the Court has held that such conditions satisfy the First Amendment so long as they are “reasonable and viewpoint neutral.” *Id.* at 679; see *Perry Educ. Ass’n v. Perry Local Educators’ Ass’n*, 460 U.S. 37, 49 (1983).

In *Cornelius v. NAACP Legal Defense & Educational Fund, Inc.*, 473 U.S. 788 (1985), for instance, this Court considered “whether the Federal Government violate[d] the First Amendment when it exclude[d] legal defense and political advocacy organizations from participation in the Combined Federal Campaign (CFC or Campaign), a charity drive aimed at federal employees.” *Id.* at 790. The Court explained that, because the CFC was “a nonpublic forum,” *id.* at 806—which “by definition is not dedicated to general debate or the free exchange of ideas,” *id.* at 811—the First Amendment required only that the government identify “reasonable” justifications for the challenged denial of access, *id.* at 808 (emphasis omitted). The Court concluded that “the Government does not violate the First Amendment when it limits participation in the CFC in order to minimize disruption to the federal workplace, to ensure the success of the fundraising effort, or to avoid the appearance of political favoritism without regard to the viewpoint of the excluded groups.” *Id.* at 813.

A third line of decisions has involved conditions on a specific type of government assistance to public-sector labor unions. See *Ysursa, supra*; *Davenport, supra*. The relevant governmental bodies in those cases had not transferred to the unions any of the government's own money. Rather, they had created mechanisms to facilitate the unions' collection of funds from government employees, while limiting the ways in which those mechanisms could be used.

Davenport, for example, involved the state-conferred power of public-sector unions "to charge government employees agency fees." 551 U.S. at 187-188. The plaintiff union challenged a state statute that imposed a "condition" on that "power" by "prohibiting expenditure of a nonmember's agency fees for election-related purposes unless the nonmember affirmatively consent[ed]." *Id.* at 184. The union argued that the statute "unconstitutionally dr[ew] distinctions based on the content of the union's speech." *Id.* at 188. This Court disagreed, concluding that "the statute, rather than suppressing union speech, simply declined to assist that speech by granting the unions the right to charge agency fees for election activities." *Ysursa*, 555 U.S. at 361; see *Davenport*, 551 U.S. at 189-190. The Court therefore found strict scrutiny inapplicable and upheld the challenged law as a "reasonable, viewpoint-neutral limitation" on a "state-bestowed entitlement." *Davenport*, 551 U.S. at 189.

The Court in *Ysursa* similarly declined to apply strict scrutiny to a condition on government assistance—there, the "use" of "government payroll mechanisms for the purpose of obtaining funds for expression." 555 U.S. at 355. The case involved a state law that authorized deductions from a public employee's wages to pay union dues, but prohibited such payroll deductions for a

union’s political activities. *Ibid.* The Court held that this content-based “limitation” on the “use” of “government payroll mechanisms” did not violate the First Amendment. *Ibid.* The Court explained that, because the statute did “not suppress political speech but simply decline[d] to promote it through public employer checkoffs for political activities,” *id.* at 361, strict scrutiny was unwarranted, see *id.* at 355, 358-359. Requiring only “a rational basis to justify the ban on political payroll deductions,” the Court found the statute “justified by the State’s interest in avoiding the reality or appearance of government favoritism or entanglement with partisan politics.” *Id.* at 359.

b. Section 1052(c) is a viewpoint-neutral condition on a government benefit, not a restriction on speech

Section 1052(c) does not restrict speech. Rather, it simply withholds specific benefits that Congress has chosen to confer on the owners of federally registered trademarks. Under this Court’s precedents, heightened scrutiny is therefore unwarranted.

i. When the USPTO refuses to register a particular trademark, “[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). The trademark owner remains free to use the mark in commerce unless some *other* provision of law restricts or prohibits its use. See *Tam*, 582 U.S. at 225 (“Without federal registration, a valid trademark may still be used in commerce.”); *Brunetti*, 139 S. Ct. at 2303 (Roberts, C.J., concurring in part and dissenting in part) (explaining that whether certain “marks can be registered does not affect the extent to which their owners may use them in commerce to identify goods”); *id.* at 2317 (Sotomayor, J., concurring in part and dissenting in part)

(explaining that an owner “can use, own, and enforce his mark regardless of whether it has been registered”). Refusal of registration under Section 1052(c) thus does not divest the mark owner of whatever rights the owner would otherwise possess to use the individual’s name without that person’s consent. See *Brunetti*, 139 S. Ct. at 2305 (Breyer, J., concurring in part and dissenting in part) (observing that “the statute does not bar anyone from speaking”).

The fact that the USPTO refused to register respondent’s mark based on its content—*i.e.*, because the mark “[c]onsists of or comprises a name * * * identifying a particular living individual” without “his written consent,” 15 U.S.C. 1052(c)—does not alter that analysis. The USPTO’s refusal of registration does not prevent respondent from using his mark to identify his goods and distinguish them from the goods of others—for example, by putting the mark on his shirts’ tags. Nor does the refusal of registration prevent respondent from using the same phrase in any other way—for example, by putting the words in large letters across the front of his shirts to communicate his intended political message. Respondent is just as free to use his mark and to speak those words as he would be if the mark were registered.

ii. The only effect of Section 1052(c) is to deny owners of a specified type of mark “certain additional benefits associated with federal trademark registration.” *Brunetti*, 139 S. Ct. at 2303 (Roberts, C.J., concurring in part and dissenting in part); see *id.* at 2316-2317 (Sotomayor, J., concurring in part and dissenting in part). Those benefits include “additional protections against infringers,” *id.* at 2316 (Sotomayor, J., concurring in part and dissenting in part), that would make it easier for owners to enforce their exclusive rights and prevent

others from using their marks, see p. 4, *supra*. Withholding those benefits does not limit respondent's own freedom to use his mark or to engage in whatever speech he wishes.

To be sure, given the potential benefits of federal trademark registration, the owner of an unregistrable mark may feel "indirect pressure" to use an alternative mark that would satisfy the Lanham Act's registration criteria. *Christian Legal Soc'y*, 561 U.S. at 682. But this Court has repeatedly declined to equate such indirect pressure with the "direct restrictions on expression" that warrant heightened scrutiny. *Ysursa*, 555 U.S. at 360 n.2; see *ibid.* ("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."); *Christian Legal Soc'y*, 561 U.S. at 683 (distinguishing "dangling the carrot of subsidy" from "wielding the stick of prohibition"); *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).

It also bears emphasis that, even to the extent Section 1052(c) gives respondent a practical incentive to choose a different *trademark*, that provision does not meaningfully discourage respondent from engaging in his preferred political *speech*. Consistent with the government's position in this case, respondent could sell shirts emblazoned with the slogan "TRUMP TOO SMALL," while using (*e.g.*, on the shirts' labels) and potentially registering a *different* mark to identify himself as the source of the goods. Under that approach, respondent could not invoke the Lanham Act provisions governing infringement of registered trademarks to prevent others from selling shirts with the same slogan. But he could still

engage in the same political advocacy; the alternative trademark would protect whatever goodwill he ultimately accumulated as a desired source of specific goods; and the registrability of the alternative trademark would not be affected by respondent's use of an unconsenting individual's name as part of the political message on his shirts. That approach is consistent with the values and policy objectives that both trademark law and the First Amendment are intended to serve.

iii. Section 1052(c) thus operates as a viewpoint-neutral condition on a government benefit, not as a restriction on speech. For that reason, heightened scrutiny is unwarranted. See *Brunetti*, 139 S. Ct. at 2316-2317 (Sotomayor, J., concurring in part and dissenting in part). Here, as in the cases discussed above, "Congress has not infringed any First Amendment rights or regulated any First Amendment activity." *Regan*, 461 U.S. at 546. Congress has simply chosen to withhold "certain benefits, useful in infringement litigation," *Jack Daniel's Props., Inc. v. VIP Prods. LLC*, 143 S. Ct. 1578, 1584 (2023)—leaving respondent (and everyone else) free to engage in whatever speech is otherwise permitted by law.

c. The nature of the benefits that federal trademark registration provides makes heightened scrutiny particularly unwarranted

The fact that Section 1052(c) is a viewpoint-neutral condition on a government benefit, not a restriction on speech, is by itself a sufficient basis for declining to apply heightened scrutiny here. In addition, however, the specific nature of the benefits that federal trademark registration provides makes heightened scrutiny particularly anomalous in this setting. Three aspects of fed-

eral trademark registration reinforce the conclusion that heightened scrutiny is unwarranted.

First, the purpose and effect of federal trademark registration is to enhance the registrant’s ability to restrict the speech of others. As noted, a trademark gives its owner “rights of exclusion”—*i.e.*, rights to prevent others from using the mark. *K Mart Corp. v. Cartier, Inc.*, 485 U.S. 176, 185 (1988); see p. 3, *supra*. Federal trademark registration bolsters those rights by, for example, providing nationwide “constructive notice of the registrant’s claim of ownership,” 15 U.S.C. 1072; serving as prima facie evidence of the registrant’s “exclusive right to use the registered mark in commerce,” 15 U.S.C. 1115(a); and furnishing a basis for stopping the importation of goods that bear an infringing mark, 15 U.S.C. 1124. See p. 4, *supra*.

Such benefits promote the owner’s *own* use of the mark only indirectly, by enhancing the owner’s ability to prevent *others* from using it. Thus, “the net effect is that the registration 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). Given the exclusionary purpose and effect of federal trademark registration, it would be anomalous to subject viewpoint-neutral decisions *refusing* registration to heightened scrutiny under the First Amendment.

Second, a “trademark’s ‘primary’ function” is a commercial one: to “tell[] the public who is responsible for a product.” *Jack Daniel’s*, 143 S. Ct. at 1583 (citation omitted); see *San Francisco Arts & Athletics, Inc. v. United States Olympic Comm.*, 483 U.S. 522, 535 (1987) (characterizing the use of the word “Olympic” to induce

the sale of goods or services as “commercial speech”). A mark’s potential to “convey [a] message” is incidental to that function. *Jack Daniel’s*, 143 S. Ct. at 1583. Accordingly, “the lead criterion for registration is that the mark ‘in fact serve as a “trademark” to identify and distinguish goods.’” *Ibid.* (quoting 3 McCarthy § 19:10). If what the applicant seeks to register “fails to function as a mark,” it cannot be registered, regardless of any message it would otherwise convey. *TMEP* § 1202.04; see *D.C. One Wholesaler, Inc. v. Chien*, 120 U.S.P.Q.2d 1710, 2016 WL 7010638, at *7 (T.T.A.B. Nov. 9, 2016) (finding that “I ♥ DC” did not function as a mark for bags, clothing, and other goods because the phrase “does not create the commercial impression of a source indicator, even when displayed on a hangtag or label”).

Because conveying a message is only incidental to “what a trademark is and does,” *Jack Daniel’s*, 143 S. Ct. at 1583, any “risk” that decisions refusing registration “will impermissibly interfere with the marketplace of ideas” is highly “attenuated,” *Davenport*, 551 U.S. at 188. Even in cases involving actual speech restrictions, the Court has applied less demanding scrutiny where commercial speech is involved. See *San Francisco Arts & Athletics*, 483 U.S. at 535 (“Commercial speech ‘receives a limited form of First Amendment protection.’”) (citation omitted). A trademark’s commercial function likewise reinforces the suitability of more deferential review when, as here, the government has merely refused to provide a benefit on viewpoint-neutral grounds. And as explained above, respondent’s intent to sell products bearing the name of an unconsenting individual does not prevent him from registering, as a source identifier for those goods, a *different* mark that satisfies the Lanham Act’s registration criteria. See pp. 23-24, *supra*.

Third, the use of content-based criteria to determine which marks may be registered is an “inherent and inescapable” part of any trademark-registration program. *Perry*, 460 U.S. at 49. If the federal government is to maintain such a program at all, the USPTO must be able to distinguish what is registrable from what is not, based at least in part on the content of particular marks. See *Brunetti*, 139 S. Ct. at 2306 (Breyer, J., concurring in part and dissenting in part) (observing that rules “governing trademark registration ‘inevitably involve content discrimination’”) (citation omitted). Thus, each of Section 1052’s registration criteria references the content of the mark that the applicant seeks to register. See, e.g., 15 U.S.C. 1052(a) (mandating refusal of registration of “deceptive” marks); 15 U.S.C. 1052(b) (mandating refusal to register marks that consist of or comprise “the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof”); 15 U.S.C. 1052(d) (mandating refusal to register marks that are likely “to cause confusion”); 15 U.S.C. 1052(e) (mandating refusal to register marks that are “merely descriptive”).

In reviewing First Amendment challenges to conditions on access to limited public forums, this Court has recognized that application of strict scrutiny “would, in practical effect, invalidate a defining characteristic of [such] forums—the State may ‘reserve them for certain groups.’” *Christian Legal Soc’y*, 561 U.S. at 681 (brackets and citation omitted). Likewise here, across-the-board application of heightened scrutiny to content-based trademark-registration criteria, including registration criteria that are viewpoint-neutral, would threaten to invalidate a defining characteristic of any trademark-registration program. Just as content-based distinctions

are “[i]mplicit in the concept of the nonpublic forum,” *Perry*, 460 U.S. at 49, so too are they intrinsic to any trademark-registration program. For that reason as well, heightened scrutiny is particularly unwarranted. See *United States v. American Library Ass’n*, 539 U.S. 194, 204-205 (2003) (plurality opinion) (finding “heightened judicial scrutiny” “incompatible” with the “content-based judgments” that a public library must make “in selecting the material it provides to its patrons”).

2. Congress acted reasonably in denying the benefits of federal trademark registration to the marks covered by Section 1052(c)

Because Section 1052(c) is a viewpoint-neutral condition on a government benefit, and because the nature of federal trademark registration renders heightened scrutiny particularly unwarranted, Section 1052(c) need only have a “reasonable” basis. *Brunetti*, 139 S. Ct. at 2317 (Sotomayor, J., concurring in part and dissenting in part); see *Ysursa*, 555 U.S. at 355; *Cornelius*, 473 U.S. at 808; *Regan*, 461 U.S. at 550; p. 17, *supra*. The government’s justifications readily satisfy that standard.

a. A name is an identifier that belongs to the individual it identifies. See 1 *McCarthy & Schechter* § 2:5 (“There is probably nothing so strongly intuited as the notion that our identities are ours.”). Commercial actors who use marks that include another individual’s name, without that individual’s consent, thus exploit something that is not theirs, for their own commercial benefit. See W. Page Keeton et al., *Prosser and Keeton on the Law of Torts* § 117, at 851-852 (5th ed. 1984) (Keeton).

Such use of another individual’s identity has long been viewed as a form of commercial appropriation. See *John Anthony, Inc. v. Fashions by John Anthony, Inc.*, 209 U.S.P.Q. 517, 1980 WL 39056, at *10 (T.T.A.B. Dec.

30, 1980). Courts and commentators originally regarded such appropriation as an “invasion of privacy.” Keeton § 117, at 851. But over time, the unlicensed use of another person’s name or likeness for commercial purposes came to be viewed as a violation of “the right of publicity”—“the inherent right of every human being to control the commercial use of his or her identity.” 1 McCarthy & Schechter § 1.3; see *id.* § 1.4 (describing the development of “legal recognition of publicity and privacy rights”).

b. Section 1052(c) is grounded in that historical tradition. See *In re Hoefflin*, 97 U.S.P.Q.2d 1174, 2010 WL 5191373, at *1 (T.T.A.B. Dec. 10, 2010) (explaining that Section 1052(c) was “intended to protect the intellectual property right of privacy and publicity that a living person has in his/her identity”); *Martin*, 1979 WL 24811, at *2 (explaining that Section 1052(c) was “intended to protect one who, for valid reasons, could expect to suffer damage from another’s trademark use of his name”). Unlike its historical antecedents, however, Section 1052(c) does not *prohibit* the use of marks that consist of or comprise a name identifying a particular living individual without that individual’s consent. Rather, Congress has simply determined that the government should “refrain[] from lending its ancillary support” to the use of such marks. *Brunetti*, 139 S. Ct. at 2317 (Sotomayor, J., concurring in part and dissenting in part). As explained above, registration enhances the trademark owner’s ability to prevent competing uses of the owner’s mark by, *inter alia*, invoking more favorable rules of decision in any infringement litigation. See p. 4, *supra*. Congress’s decision to withhold those advantages for marks covered by Section 1052(c) respects the values that historically have underlain common-law rights of publicity, without imposing any restriction on speech.

c. Congress also may legitimately decide that the government should not associate itself with marks that commercially exploit an unconsenting individual's identity. To be sure, "[t]rademarks are private, not government, speech." *Tam*, 582 U.S. at 239. But the government's association with a registered mark is an integral feature of the trademark-registration program.

The USPTO records registered marks on the agency's official register and lists them in official government publications. See 15 U.S.C. 1051(a)(1), 1057(a), 1062, 1091; USPTO, *Trademark Official Gazette*, <https://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog>. The agency also issues, "in the name of the United States," 15 U.S.C. 1057(a), certificates of registration that are transmitted to other countries and to the World Intellectual Property Organization to facilitate registration and enforcement abroad, see Paris Convention for the Protection of Industrial Property art. 6^{quinquies}, *done* July 14, 1967, 21 U.S.T. 1643-1645, 828 U.N.T.S. 331, 333; see also 15 U.S.C. 1141b (Madrid Protocol). And mark owners may "give notice" that their marks are registered by displaying them with the ® symbol or with "the words 'Registered in U.S. Patent and Trademark Office' or 'Reg. U.S. Pat. & Tm. Off.'" 15 U.S.C. 1111.

In other cases involving conditions on government benefits, this Court has recognized a government's reasonable interest in avoiding not just the "reality," but also the "appearance," of official endorsement. *Ysursa*, 555 U.S. at 359. In *Ysursa*, for example, the Court held that the State's "ban on political payroll deductions" was "justified by the State's interest in avoiding the reality or appearance of government favoritism or entanglement with partisan politics." *Ibid.* In *Cornelius*, the

Court similarly held that the exclusion of political advocacy organizations from a nonpublic forum could be justified by an interest in “avoiding the appearance of political favoritism.” 473 U.S. at 809.

A similar interest justifies the refusal to register marks that consist of or comprise names identifying particular living individuals without those individuals’ consent. Although the government’s association with a registered mark does not convert that mark into government speech, the public may still perceive that association as evidence of government approval—particularly when the ® symbol (or similar notation) appears next to the mark. And while some risk of that perception is an inherent consequence of a functional registration program, Congress may reasonably draw the line at efforts to assert an exclusive right in an unconsenting person’s name. Cf. *Brunetti*, 139 S. Ct. at 2303 (Roberts, C.J., concurring in part and dissenting in part) (recognizing that the government “has an interest in not associating itself with trademarks whose content is obscene, vulgar, or profane”); *id.* at 2317 (Sotomayor, J., concurring in part and dissenting in part) (“Apart from any interest in regulating commerce itself, the Government has an interest in not promoting certain kinds of speech, whether because such speech could be perceived as suggesting governmental favoritism or simply because the Government does not wish to involve itself with that kind of speech.”).

d. Finally, the government has a reasonable interest in not promoting “misleading or deceptive source-identifiers.” *In re ADCO Indus. – Techs., L.P.*, 2020 U.S.P.Q.2d 53786, 2020 WL 730361, at *13 (T.T.A.B. Feb. 11, 2020). Marks that consist of or comprise names “identifying * * * particular living individual[s],” 15

U.S.C. 1052(c), often may be perceived as suggesting those individuals' sponsorship of or affiliation with the relevant commercial goods. By making registration contingent on the identified individual's consent, Section 1052(c) ensures that consumers will not draw that inference in error.

To be sure, Section 1052(a) separately directs the USPTO to refuse registration of marks that consist of or comprise "matter which may * * * falsely suggest a connection with persons, living or dead." 15 U.S.C. 1052(a). And the USPTO often invokes Section 1052(a) alongside Section 1052(c) in refusing registration of marks that include the names of particular living individuals without their consent. See, *e.g.*, *ADCO*, 2020 WL 730361, at *4-*9; *In re Sauer*, 27 U.S.P.Q.2d 1073, 1993 WL 236534, at *2-*3 (T.T.A.B. Apr. 23, 1993) (invoking both Section 1052(a) and Section 1052(c) as bases for refusing registration of a mark containing BO, used in connection with a sports ball that "appears to be a combination of a baseball and a football," because use of the mark would create the impression that Bo Jackson, a famous athlete who played both football and baseball, was associated with the goods). But those decisions simply show that the use of such names often does create "source deception." *ADCO*, 2020 WL 730361, at *13. Source identification is a trademark's primary function, see *Jack Daniel's*, 143 S. Ct. at 1583, and the government may reasonably decline to promote a class of marks that risk undermining that function.

As the court below recognized, the specific message about former President Trump that respondent's own slogan conveys would not likely lead consumers to infer the former President's sponsorship or affiliation here. See Pet. App. 15a ("No plausible claim could be or has

been made that the disputed mark suggests that President Trump has endorsed [respondent’s] product.”). In the mine run of its applications, however, Section 1052(c) usefully complements Section 1052(a) by identifying a class of marks that pose a particular risk of misleading consumers about the source of goods. And even where such confusion is demonstrably unlikely, Section 1052(c) reasonably furthers the distinct governmental interests described above. See pp. 28-31, *supra*.

C. The Court Of Appeals Erred In Declaring Section 1052(c) Unconstitutional As Applied To Marks That Criticize Government Officials Or Public Figures

The court below held that Section 1052(c) violates the First Amendment as applied to a category of marks—those that contain “speech critical of government officials or public figures.” Pet. App. 20a. That holding rested, however, on the court’s erroneous view that Section 1052(c) is a restriction on speech. Because Section 1052(c) does not restrict speech, the court’s as-applied holding has no sound basis.

1. The court of appeals erred in characterizing Section 1052(c) as a restriction on speech

At the outset of its decision, the court of appeals characterized Section 1052(c) as a restriction on speech. See Pet. App. 1a, 5a-10a. That characterization then drove the rest of the court’s analysis. The court found heightened scrutiny to be appropriate on the theory that Section 1052(c) was a “content-based restriction[.]” on speech, *id.* at 9a; it framed the issue under heightened scrutiny as whether the government has a sufficient “interest in limiting speech” that “involves criticism of government officials,” *id.* at 11a; and it ultimately concluded that the government “does not have”

a sufficient “interest in restricting speech critical of government officials or public figures in the trademark context,” *id.* at 20a.

As explained above, however, Section 1052(c) does not impose a restriction on speech, but instead establishes a condition on “the ancillary benefits that come with [federal trademark] registration.” *Brunetti*, 139 S. Ct. at 2317 (Sotomayor, J., concurring in part and dissenting in part). The court of appeals’ erroneous premise led it to apply the wrong framework for evaluating a viewpoint-neutral bar on trademark registration.

The court of appeals’ stated reasons for treating Section 1052(c) as a restriction on speech do not withstand scrutiny. The court stated that Section 1052(c) “disfavors” marks that include a name identifying a particular living individual without that individual’s consent. Pet. App. 5a-6a (citation omitted). But the only “disadvantage” that the court identified was the denial of the benefits that come with federal trademark registration. *Id.* at 6a. The court did not identify any respect in which Section 1052(c) restricts speech. To the contrary, the court acknowledged that the provision “does not prevent [respondent] from communicating his message outright.” *Ibid.*

The court of appeals also dismissed as irrelevant this Court’s decisions applying First Amendment principles to conditions on government subsidies and conditions on access to limited public forums. Pet. App. 6a-8a. The court of appeals was correct in observing that the benefits of federal trademark registration are not precisely equivalent to the benefits that were at issue in those prior cases. Those decisions did not turn, however, on the exact nature of the benefits that particular govern-

ment programs conferred. Rather, they turned on the nature of the right that the First Amendment protects.

By its terms, “[t]he First Amendment prohibits government from ‘abridging the freedom of speech.’” *Ysursa*, 555 U.S. at 355. By contrast, when the government decides to subsidize or otherwise affirmatively assist particular types of private communication, its refusal to assist *other* speech is ordinarily constitutional so long as its selection criteria are reasonable and viewpoint-neutral. See, e.g., *id.* at 358 (explaining that, while “[t]he First Amendment * * * protects the right to be free from government abridgment of speech,” the government “is not required to assist others in funding the expression of particular ideas”). The precedents discussed at pp. 16-21, *supra*, thus are not properly understood to establish discrete, ad hoc exceptions to the First Amendment’s literal command. Rather, the Court has adhered to the Amendment’s plain text by applying, to a variety of government benefits and programs, the same basic distinction between governmental *abridgment* of free-speech rights and the government’s *failure to assist* private expression.

To be sure, this Court has applied a different analytic framework, and more demanding First Amendment scrutiny, to laws that discriminate based on *viewpoint*. See, e.g., *Rosenberger*, 515 U.S. at 829 (“Viewpoint discrimination is * * * an egregious form of content discrimination.”). In particular, the Court has treated governmental viewpoint discrimination as “presumptively unconstitutional,” *Brunetti*, 139 S. Ct. at 2299 (citation omitted), even when the government employs viewpoint-based criteria solely to determine whether to assist particular speech. See, e.g., *Christian Legal Soc’y*, 561 U.S. at 679 (recognizing that any condition on access to a lim-

ited public forum “must be reasonable and viewpoint neutral”). The Court’s decisions in *Tam* and *Brunetti* ultimately turned on the particularly disfavored character of viewpoint-based laws. See *Brunetti*, 139 S. Ct. at 2302 n.* (declining to “say anything about how to evaluate viewpoint-neutral restrictions on trademark registration” because the provision at issue in that case was not viewpoint-neutral); pp. 11-14, *supra*.

By contrast, where, as here, the government’s decision whether to assist a particular speaker is governed by viewpoint-neutral criteria, the Court has viewed refusals to provide varied forms of assistance as fundamentally different from restrictions on speech. See pp. 16-21, *supra*. The Lanham Act’s registration scheme provides “an opportunity to include one’s trademark on a list and thereby secure the ancillary benefits that come with registration.” *Brunetti*, 139 S. Ct. at 2317 (Sotomayor, J., concurring in part and dissenting in part). Section 1052(c) makes those benefits unavailable for a specified class of marks, but it does not discriminate based on viewpoint, and it does not limit anyone’s right to speak. See *id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part) (explaining that the Lanham Act’s bar on registration of “scandalous” marks “merely denie[s] certain additional benefits associated with federal trademark registration”). The court of appeals therefore erred in characterizing Section 1052(c) as a restriction on speech and in subjecting it to heightened scrutiny.

2. *Because Section 1052(c) does not restrict speech, the court of appeals’ as-applied holding finds no footing in the First Amendment*

As explained above, the court of appeals found Section 1052(c) unconstitutional as applied to marks that

criticize government officials or public figures because the court viewed that provision as restricting private speech. When Section 1052(c) is properly viewed as a condition on a government benefit, the errors in the court's reasoning and as-applied holding are apparent.

a. In support of its as-applied holding, the court of appeals emphasized the importance of “speech concerning public affairs,” and specifically speech involving “criticism of government officials.” Pet. App. 10a-11a (citation omitted). Such speech indisputably lies “at the heart of the First Amendment.” *Id.* at 11a. But while “[t]he First Amendment prohibits government from ‘abridging the freedom of speech,’” it “does not confer an affirmative right” to government assistance, even for speech concerning public affairs or criticizing government officials. *Ysursa*, 555 U.S. at 355.

The decisions discussed above reflect that principle. The parties who challenged conditions on government benefits in *Regan*, *Cornelius*, *Davenport*, and *Ysursa* were engaged in political speech. See *Ysursa*, 555 U.S. at 355 (“political speech”); *Davenport*, 551 U.S. at 182 (“influenc[ing] an election” or “operat[ing] a political committee”) (citation omitted); *Cornelius*, 473 U.S. at 795 (“political activity or advocacy, lobbying, or litigation”) (citation omitted); *Regan*, 461 U.S. at 542 (“attempting to influence legislation”). The Court in those cases did not question the plaintiffs’ right to engage in their preferred speech without government interference. Yet the Court in each case held that, consistent with the First Amendment, the relevant federal or state actor could reasonably “decline[] to promote that speech.” *Ysursa*, 555 U.S. at 355; see *Davenport*, 551 U.S. at 190 (citing *Regan* for the principle that the “First Amendment does not require the government to

enhance a person’s ability to speak”); *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 546 (rejecting the “notion that First Amendment rights are somehow not fully realized unless they are subsidized by the State”) (citation omitted). The Court so held even though the laws at issue, unlike Section 1052(c), specifically excluded political speech from government benefits. See *Ysursa*, 555 U.S. at 356; *Davenport*, 551 U.S. at 182; *Cornelius*, 473 U.S. at 795; *Regan*, 461 U.S. at 542.

b. The court of appeals also relied on various lower-court decisions that have addressed the extent to which the First Amendment protects the use of another person’s identity without that person’s consent. Pet. App. 16a-19a. Each of those decisions, however, addressed the constitutionality of *restrictions* on such use. See *Hart v. Electronic Arts, Inc.*, 717 F.3d 141, 148-149 (3d Cir. 2013), cert. dismissed, 573 U.S. 989 (2014); *ETW Corp. v. Jireh Publ’g, Inc.*, 332 F.3d 915, 937 (6th Cir. 2003); *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 968 (10th Cir. 1996); *Titan Sports, Inc v. Comics World Corp.*, 870 F.2d 85, 87-88 (2d Cir. 1989); *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 804 (Cal. 2001), cert. denied, 534 U.S. 1078 (2002); *Lohan v. Take-Two Interactive Software, Inc.*, 97 N.E.3d 389, 393-394 (N.Y. 2018); *Paulsen v. Personality Posters, Inc.*, 299 N.Y.S.2d 501, 508-509 (Sup. Ct. 1968). Whatever the merits of those decisions, they shed no meaningful light on the constitutionality of Section 1052(c), which is not a restriction on speech, but a condition on a government benefit. See, e.g., *Rust*, 500

U.S. at 201 (“The Government has no constitutional duty to subsidize an activity merely because the activity is constitutionally protected.”).

c. Finally, the court of appeals expressed the view that “the right of publicity cannot shield public figures from criticism.” Pet. App. 19a. But Section 1052(c) does not shield anyone from criticism since the USPTO’s refusal of registration does not constrain respondent’s ability to engage in any form of public commentary.

In fact, it is the *registration* of marks like respondent’s—not the *refusal* to register them—that would potentially “chill speech.” Pet. App. 8a (citation omitted). After all, a trademark gives its owner the right to “prevent[] others from using the mark.” *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015). And registration bolsters those “rights of exclusion,” *K Mart Corp.*, 485 U.S. at 185, by giving owners “additional protections against infringers,” *Brunetti*, 139 S. Ct. at 2316 (Sotomayor, J., concurring in part and dissenting in part); see p. 25, *supra*.

Thus, while the court of appeals expressed concern about respondent’s free-speech right to criticize public officials, the court’s decision makes it easier for individuals like respondent to invoke federal enforcement mechanisms to restrict the speech of others. To be sure, that speech-impairing effect is a usual and ordinarily unproblematic consequence of federal trademark registration, and of trademark-protection laws more generally. Cf. pp. 3-4, *supra*. It would be anomalous to conclude, however, that respondent has a First Amendment *right* to restrict others’ speech and to obtain the government’s assistance in that endeavor, notwithstanding Congress’s decision to exclude respondent’s mark from eligibility for federal registration. And it is

particularly strange to treat the political nature of respondent’s message as a factor *supporting* his claim to such a right. See 1 McCarthy & Schechter § 6:151 (“The irony of th[e] [Federal Circuit’s] ruling [in this case] is that it means that no one else can put the same or similar message on a shirt without risking potential liability for trademark infringement. * * * This appears to be suffocating the First Amendment in the name of saving it.”). Because Section 1052(c) does not abridge respondent’s freedom of speech, and because the First Amendment does not confer any right to restrict the speech of his competitors, the court’s as-applied holding has no sound basis in the Constitution.

CONCLUSION

The judgment of the court of appeals should be reversed.

Respectfully submitted.

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APPENDIX

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APPENDIX

1. 15 U.S.C. 1051 provides:

Application for registration; verification

(a) Application for use of trademark

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director, and such number of specimens or facsimiles of the mark as used as may be required by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify that—

(A) the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(1a)

(D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall—

(i) state exceptions to the claim of exclusive use; and

(ii) shall¹ specify, to the extent of the verifier's knowledge—

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(b) Application for bona fide intention to use trademark

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration

¹ So in original. The word "shall" probably should not appear.

of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Director.

(2) The application shall include specification of the applicant's domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify—

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be entitled to use the mark in commerce;

(B) the applicant's bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and

(D) that, to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

Except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Director. The Director shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(c) Amendment of application under subsection (b) to conform to requirements of subsection (a)

At any time during examination of an application filed under subsection (b), an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a).

(d) Verified statement that trademark is used in commerce

(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as used in commerce as may be required by the Director and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce and those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to

registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered.

(2) The Director shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Director may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Director shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Director shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for

the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Director that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

(e) Designation of resident for service of process and notices

If the applicant is not domiciled in the United States the applicant may designate, by a document filed in the United States Patent and Trademark Office, the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with that person or mailing to that person a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, or if the registrant does not designate by a document filed in the United States Patent and Trademark Office the name and address of a person resident in the United States on whom may be served notices or process in proceedings affecting the mark, such notices or process may be served on the Director.

(f) Third-party submission of evidence

A third party may submit for consideration for inclusion in the record of an application evidence relevant to

a ground for refusal of registration. The third-party submission shall identify the ground for refusal and include a concise description of each piece of evidence submitted in support of each identified ground for refusal. Not later than 2 months after the date on which the submission is filed, the Director shall determine whether the evidence should be included in the record of the application. The Director shall establish by regulation appropriate procedures for the consideration of evidence submitted by a third party under this subsection and may prescribe a fee to accompany the submission. If the Director determines that the third-party evidence should be included in the record of the application, only the evidence and the ground for refusal to which the evidence relates may be so included. Any determination by the Director whether or not to include evidence in the record of an application shall be final and non-reviewable, and a determination to include or to not include evidence in the record shall not prejudice any party's right to raise any issue and rely on any evidence in any other proceeding.

2. 15 U.S.C. 1052 provides:

Trademarks registrable on principal register; concurrent registration

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

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead,

institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 3501(9) of title 19) enters into force with respect to the United States.

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

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

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive: *Provided*, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such

marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this chapter; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947, in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 1054 of this title, (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before December 8, 1993.

A mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be refused registration only pursuant to a proceeding brought under section 1063 of this title. A registration for a mark which would be likely to cause dilution by blurring or dilution by tarnishment under section 1125(c) of this title, may be canceled pursuant to a proceeding brought under either section 1064 of this title or section 1092 of this title.

3. 15 U.S.C. 1057 provides:

Certificates of registration

(a) Issuance and form

Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the United

States Patent and Trademark Office, and shall be signed by the Director or have his signature placed thereon, and a record thereof shall be kept in the United States Patent and Trademark Office. The registration shall reproduce the mark, and state that the mark is registered on the principal register under this chapter, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the United States Patent and Trademark Office, and any conditions and limitations that may be imposed in the registration.

(b) Certificate as prima facie evidence

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

(c) Application to register mark considered constructive use

Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing—

- (1) has used the mark;
- (2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or
- (3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) of this title to register the mark which is pending or has resulted in registration of the mark.

(d) Issuance to assignee

A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the United States Patent and Trademark Office. In case of change of ownership the Director shall, at the request of the owner and upon a proper showing and the payment of the prescribed fee, issue to such assignee a new certificate of registration of the said mark in the name of such assignee, and for the unexpired part of the original period.

(e) Surrender, cancellation, or amendment by owner

Upon application of the owner the Director may permit any registration to be surrendered for cancellation, and upon cancellation appropriate entry shall be made in the records of the United States Patent and Trademark Office. Upon application of the owner and payment of the prescribed fee, the Director for good cause may permit any registration to be amended or to be disclaimed in part: *Provided*, That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the records of the United States Patent and Trademark Office and upon the certificate of registration.

(f) Copies of United States Patent and Trademark Office records as evidence

Copies of any records, books, papers, or drawings belonging to the United States Patent and Trademark Office relating to marks, and copies of registrations, when authenticated by the seal of the United States Patent and Trademark Office and certified by the Director, or in his name by an employee of the Office duly designated by the Director, shall be evidence in all cases wherein the originals would be evidence; and any person making application therefor and paying the prescribed fee shall have such copies.

(g) Correction of United States Patent and Trademark Office mistake

Whenever a material mistake in a registration, incurred through the fault of the United States Patent and Trademark Office, is clearly disclosed by the records of the Office a certificate stating the fact and nature of such mistake shall be issued without charge and recorded and a printed copy thereof shall be attached to each printed copy of the registration and such corrected registration shall thereafter have the same effect as if the same had been originally issued in such corrected form, or in the discretion of the Director a new certificate of registration may be issued without charge. All certificates of correction heretofore issued in accordance with the rules of the United States Patent and Trademark Office and the registrations to which they are attached shall have the same force and effect as if such certificates and their issue had been specifically authorized by statute.

(h) Correction of applicant's mistake

Whenever a mistake has been made in a registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the Director is authorized to issue a certificate of correction or, in his discretion, a new certificate upon the payment of the prescribed fee: *Provided*, That the correction does not involve such changes in the registration as to require republication of the mark.

4. 15 U.S.C. 1065 provides:

Incontestability of right to use mark under certain conditions

Except on a ground for which application to cancel may be filed at any time under paragraphs (3), (5), and (6) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the owner to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided*, That—

- (1) there has been no final decision adverse to the owner's claim of ownership of such mark for such goods or services, or to the owner's right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the United States Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Director within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and other matters specified in paragraphs (1) and (2) hereof; and

(4) no incontestable right shall be acquired in a mark which is the generic name for the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Director within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Director shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

5. 15 U.S.C. 1072 provides:

Registration as constructive notice of claim of ownership

Registration of a mark on the principal register provided by this chapter or under the Act of March 3, 1881,

or the Act of February 20, 1905, shall be constructive notice of the registrant's claim of ownership thereof.

6. 15 U.S.C. 1111 provides:

Notice of registration; display with mark; recovery of profits and damages in infringement suit

Notwithstanding the provisions of section 1072 of this title, a registrant of a mark registered in the Patent and Trademark Office, may give notice that his mark is registered by displaying with the mark the words "Registered in U.S. Patent and Trademark Office" or "Reg. U.S. Pat. & Tm. Off." or the letter R enclosed within a circle, thus ®; and in any suit for infringement under this chapter by such a registrant failing to give such notice of registration, no profits and no damages shall be recovered under the provisions of this chapter unless the defendant had actual notice of the registration.

7. 15 U.S.C. 1115 provides:

Registration on principal register as evidence of exclusive right to use mark; defenses

(a) Evidentiary value; defenses

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this chapter and owned by a party to an action shall be admissible in evidence and shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered

mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b), which might have been asserted if such mark had not been registered.

(b) Incontestability; defenses

To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 1114 of this title, and shall be subject to the following defenses or defects:

- (1) That the registration or the incontestable right to use the mark was obtained fraudulently; or
- (2) That the mark has been abandoned by the registrant; or

(3) That the registered mark is being used by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or

(4) That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 1057(c) of this title, (B) the registration of the mark under this chapter if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 1062 of this title: *Provided, however,* That this defense or defect shall apply only for the area in which such continuous prior use is proved; or

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this chapter or publication under subsection (c) of section 1062 of this title of the registered mark of the registrant, and not abandoned: *Provided, however,* That this defense or defect shall

apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or

(7) That the mark has been or is being used to violate the antitrust laws of the United States; or

(8) That the mark is functional; or

(9) That equitable principles, including laches, estoppel, and acquiescence, are applicable.

8. 15 U.S.C. 1124 provides:

Importation of goods bearing infringing marks or names forbidden

Except as provided in subsection (d) of section 1526 of title 19, no article of imported merchandise which shall copy or simulate the name of any domestic manufacturer, or manufacturer, or trader, or of any manufacturer or trader located in any foreign country which, by treaty, convention, or law affords similar privileges to citizens of the United States, or which shall copy or simulate a trademark registered in accordance with the provisions of this chapter or shall bear a name or mark calculated to induce the public to believe that the article is manufactured in the United States, or that it is manufactured in any foreign country or locality other than the country or locality in which it is in fact manufactured, shall be admitted to entry at any customhouse of the United States; and, in order to aid the officers of the customs in enforcing this prohibition, any domestic manufacturer or trader, and any foreign manufacturer or trader, who is entitled under the provisions of a treaty, convention, declaration, or agreement between the

United States and any foreign country to the advantages afforded by law to citizens of the United States in respect to trademarks and commercial names, may require his name and residence, and the name of the locality in which his goods are manufactured, and a copy of the certificate of registration of his trademark, issued in accordance with the provisions of this chapter, to be recorded in books which shall be kept for this purpose in the Department of the Treasury, under such regulations as the Secretary of the Treasury shall prescribe, and may furnish to the Department facsimiles of his name, the name of the locality in which his goods are manufactured, or of his registered trademark, and thereupon the Secretary of the Treasury shall cause one or more copies of the same to be transmitted to each collector or other proper officer of customs.

9. 15 U.S.C. 1127 provides in pertinent part:

Construction and definitions; intent of chapter

In the construction of this chapter, unless the contrary is plainly apparent from the context—

The United States includes and embraces all territory which is under its jurisdiction and control.

* * * * *

The term “trademark” includes any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

* * * * *

The term “mark” includes any trademark, service mark, collective mark, or certification mark.

* * * * *

The term “registered mark” means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase “marks registered in the Patent and Trademark Office” means registered marks.

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