

No. 20-2205

**In the United States Court of Appeals
for the Federal Circuit**

IN RE: STEVE ELSTER,
Appellant.

On Appeal from the United States Patent and Trademark Office
Trademark Trial and Appeal Board, Serial No. 87749230

REPLY BRIEF OF APPELLANT

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CERTIFICATE OF INTEREST

As required by Federal Circuit Rule 47.4, I certify the following:

1. The full names of all parties represented by me are: Steve Elster.
2. The names of the real parties in interest, if different from the parties named above, are: Not applicable.
3. There are no parent corporations or publicly held companies that own 10% or more of the stock of any party represented by me.
4. The names of all law firms and the partners and associates that are expected to appear in this Court and who have not already entered an appearance are: Not applicable.
5. Appellant knows of no pending matters in this or any court that will directly affect or be directly affected by this Court's decision in this appeal.
6. No information is required for this case under Fed. R. App. P. 26.1(b) (organizational victims in criminal cases) and 26.1(c) (bankruptcy case debtors and trustees).

Dated: July 27, 2021

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STATEMENT OF RELATED CASES

The appellant is unaware of any cases related to this appeal.

INTRODUCTION AND SUMMARY OF ARGUMENT

It is hard to imagine a statute that is a poorer fit for its supposed purposes than section 2(c) of the Lanham Act. It purports to protect the right of privacy, yet it covers only “celebrities and world-famous political figures,” Appx6, and bestows special protection on the President alone—the least private figure in American life. It also purports to protect the right of publicity. But as this case makes plain, the statute routinely targets speech that could never give rise to liability for violating that right. And although a key purpose of trademark registration is to prevent source deception and confusion, section 2(c)’s only practical effect is to prohibit *non*-deceptive marks.

Forced to defend a law that cannot withstand scrutiny, the government tries to avoid scrutiny altogether. But its arguments run headlong into *In re Brunetti*, 877 F.3d 1330 (Fed. Cir. 2017), and *In re Tam*, 808 F.3d 1321 (Fed. Cir. 2015) (en banc). These cases leave no doubt that section 2(c) burdens speech based on content and must satisfy scrutiny. Under these precedents, the government cannot evade scrutiny by arguing that the law is viewpoint-neutral and regulates only the commercial aspects of a mark, or by comparing the principal register to a subsidy or limited public forum.

These holdings—which the Supreme Court did not disturb—foreclose all of the government’s attempts to avoid scrutiny here and mandate the application of at least intermediate scrutiny. Because section 2(c) does not come close to satisfying such scrutiny, it is unconstitutional as applied to the proposed mark “Trump too small.”

ARGUMENT

I. Binding precedent forecloses the government’s attempts to avoid subjecting section 2(c) to scrutiny.

The government’s lead argument is that section 2(c) should not be subjected to *any* scrutiny, even intermediate. But every reason that the government gives in support of this argument conflicts with this Court’s precedents in *Brunetti* and *Tam*.

A. The government first claims (at 9, 26) that *Brunetti* and *Tam* can be ignored because they analyzed “viewpoint-based restrictions designed to curtail expression,” whereas section 2(c) is “a viewpoint-neutral provision that does not target modes of expression.” This argument is doubly wrong. It is wrong, first and foremost, because *Brunetti* expressly rejects this proposed distinction as a basis to avoid scrutiny. This Court held that “[i]ndependent of whether [a section 2 prohibition] is viewpoint discriminatory,” the prohibition is subject to scrutiny if it “discriminates based on content”—strict scrutiny if it “regulates the expressive components” of a mark, and *Central Hudson* scrutiny if it regulates “purely” the “commercial components.” 877 F.3d at 1341, 1349–50. The government’s position is directly contrary to these holdings. An argument that section 2(c) is viewpoint-neutral and regulates only the commercial aspects of a mark is an argument for *intermediate* scrutiny—not for no scrutiny at all.

In any event, the argument is wrong on its own terms. Regardless of whether section 2(c) discriminates based on viewpoint, it targets for exclusion any mark that expresses the name or identity of “a particular living individual” (or “the name . . .

of a deceased President . . . during the life of his widow”) without consent. 15 U.S.C. § 1052(c). That law targets “expression” in any relevant sense. Expression, after all, is just another word for speech, and section 2(c) plainly targets speech. And more to the point, the statute makes it virtually impossible to register a mark that expresses an opinion about a public figure—including a political message (as here) that is critical of the President of the United States. It doesn’t get much more expressive than that.

The government next proclaims (at 27) that section 2(c) is not actually content-based, so scrutiny is inapplicable under this Court’s decisions in *Brunetti* and *Tam*. According to the government, that’s because section 2(c) is “animated” by Congress’s desire to “respect a species of intellectual property.” But even if that were true (and the legislative history and neighboring provisions suggest a more illegitimate purpose at work), that is the asserted *justification* for regulating speech based on content. It doesn’t mean that the government *isn’t* regulating speech based on content.

As the Supreme Court has made clear: “Government regulation of speech is content based if a law applies to particular speech because of the topic discussed,” such as when a law “defin[es] regulated speech by particular subject matter.” *Reed v. Town of Gilbert*, 576 U.S. 155, 163 (2015). Section 2(c) is undeniably such a law. On its face, it requires a PTO examiner to assess the content of a proposed mark to determine whether it “[c]onsists of or comprises a name . . . identifying a particular living individual,” or “the name . . . of a deceased President . . . during the life of his

widow,” without consent. 15 U.S.C. § 1052(c). The law therefore “singles out specific subject matter for differential treatment, even if it does not target viewpoints within that subject matter.” *Reed*, 576 U.S. at 169. “That is a paradigmatic example of content-based discrimination.” *Id.*; accord *Tam*, 808 F.3d at 1335 (“It is beyond dispute that § 2(a) discriminates on the basis of content in the sense that it ‘applies to particular speech because of the topic discussed.’” (quoting *Reed*, 576 U.S. at 163)).

Unable to avoid scrutiny under this Court’s decisions in *Brunetti* and *Tam*, the government questions (at 28) whether they “retain the force of circuit precedent.” But they plainly do. Neither the Supreme Court’s opinion in *Brunetti* nor *Tam* “say anything about how to evaluate viewpoint-neutral restrictions on trademark registration” that are content-based. *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 n* (2019). After the en banc Court in *Tam* held that at least intermediate scrutiny must apply to such a restriction, “the Supreme Court did not reverse or otherwise cast doubt on the continuing validity” of that holding. *See Brunetti*, 877 F.3d at 1343 n.1. To the contrary, Justice Alito’s opinion for the Court stated that it “need not resolve” whether strict scrutiny or intermediate scrutiny applied because the statute was unconstitutional either way, and “[e]ft open the question whether *Central Hudson* provides the appropriate test.” 137 S. Ct. 1744, 1764 n.17 (2017). Hence, this Court in *Brunetti* indicated that the en banc Court’s decision in *Tam* remains binding in this respect, “question[ing] the force of [the government’s] assertion” otherwise. 877 F.3d

at 1343 n.1. And rightly so. As the Second Circuit explained (in an opinion cited with approval by this Court in *Brunetti*): “There is no authority for the proposition that when the Supreme Court affirms a judgment on a different ground than an appellate court it thereby overturns the holding that the Supreme Court has chosen not to address. To hold otherwise would undermine basic principles of stare decisis and institutional regularity.” *Balintulo v. Ford Motor Co.*, 796 F.3d 160, 166 n.28 (2d Cir. 2015).

The principles of stare decisis are, if anything, even stronger now because the *Brunetti* Court then “independently reach[ed] the same conclusion as the en banc court.” *In re Brunetti*, 877 F.3d at 1343 n.1. As noted, this Court in *Brunetti* stated that it “need not resolve” whether the provision at issue in that case discriminated based on viewpoint because, “[i]ndependent of whether [it] is viewpoint discriminatory,” the provision “impermissibly discriminates based on content in violation of the First Amendment.” *Id.* at 1341. The Court held that the statute was “unconstitutional even if treated as a regulation of purely commercial speech reviewed according to the intermediate framework established in *Central Hudson*.” *Id.* at 1350.

In affirming, the Supreme Court did not cast any doubt on these conclusions. It simply held, as it had in *Tam*, that the statute discriminated based on viewpoint, and was unconstitutional for that reason alone. To suggest that this holding somehow undercuts the reasoning of this Court’s decision is to “conflate[] two distinct but related limitations that the First Amendment places on government regulation of

speech.” *Reed*, 576 U.S. at 168. “Government discrimination among viewpoints,” the Supreme Court has explained, “is a more blatant and egregious form of content discrimination.” *Id.* (quotation marks omitted). But it is not the *only* form of content discrimination. A “speech regulation targeted at specific subject matter is content based even if it does not discriminate among viewpoints within that subject matter.” *Id.* at 169. “For example, a law banning the use of sound trucks for political speech—and only political speech—would be a content-based regulation, even if it imposed no limits on the political viewpoints that could be expressed.” *Id.*; see also *Carey v. Brown*, 447 U.S. 455, 462 n.6 (1980) (“It is . . . no answer to assert that the . . . [speech regulation at issue] does not discriminate on the basis of the speaker’s viewpoint, but only on the basis of the subject matter of his message.”). The same is true here.

More broadly, as we explained in our opening brief, the Supreme Court’s First Amendment precedents provide strong support for this Court’s conclusions in *Tam* and *Brunetti*. The Supreme Court has repeatedly explained that “[c]ontent based regulations are presumptively invalid,” *R.A.V. v. St. Paul*, 505 U.S. 377, 382 (1992), and “may be justified only if the government proves that they are narrowly tailored to serve compelling state interests,” *Reed*, 576 U.S. at 163. Even if the law imposes a “content-based burden” on purely commercial speech, “that circumstance is sufficient to justify application of heightened scrutiny”—meaning, at a minimum, *Central Hudson* scrutiny. *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 571 (2011).

The government’s only response is to say (at 9) that heightened scrutiny should not apply because section 2(c) does not “burden speech.” That argument not only contravenes this Court’s holdings in *Brunetti* and *Tam*, but also the Supreme Court’s. The whole reason that the Supreme Court held that the laws in those cases were viewpoint discriminatory is that they *burdened* disfavored speech. True, the burden was imposed only on speech with a certain viewpoint—a particularly repugnant form of content-based discrimination. But the burden itself was the same: the denial of registration. And that burden was sufficient to implicate First Amendment scrutiny.

The Justices were in agreement on this score. In *Tam*, the Court unanimously held that “[t]rademarks are private, not government, speech,” *Tam*, 137 S. Ct. at 1760, and that regulation of trademarks through the Lanham Act—including the decision of which messages to accept for federal registration, and which to deny—implicates the First Amendment. The Court rejected arguments that would have “eliminate[d] any First Amendment protection or result[ed] in highly permissive rational-basis review.” *Id.* at 1757; *see also id.* at 1767 (Kennedy, J.) (explaining that denying trademark registration imposes “a First Amendment burden”). It then reaffirmed this view in *Brunetti*. *See Brunetti*, 139 S. Ct. at 2297 (explaining that denying registration “disfavors” the speech being regulated).

Under these precedents, section 2(c) triggers First Amendment scrutiny. And under this Court’s precedents, that means at least *Central Hudson* scrutiny.

B. The government’s proposed alternative to *Central Hudson* is for this Court to adopt an entirely new mode of analysis—one that would allow the government to regulate speech based on content even when the regulation is so poorly tailored that it cannot withstand intermediate scrutiny. The government appears to accept (at 32) that viewpoint-based distinctions in section 2 are impermissible, and that content-based distinctions that “target[] the expressive component of a mark for the purpose of influencing the marketplace of ideas” (whatever that means) must satisfy strict scrutiny. Yet the government resists application of even intermediate scrutiny as to other provisions that impose the same burden on speech based on its content. And it does so even though intermediate scrutiny itself “allows for reasonable, viewpoint neutral regulations on the type of marks eligible for federal [regulation]” so long as the government can justify those regulations under *Central Hudson*. Gov. Br. 32.

In making this argument, the government peddles the same flawed analogies that it did in *Tam* and *Brunetti*, comparing the principal register to a government subsidy or a limited public forum. But, as the government acknowledges, this Court squarely rejected both analogies. In *Tam*, the en banc Court overwhelmingly “rejected the applicability of [the subsidy] analysis to trademark registration, 9–3.” *Brunetti*, 877 F.3d at 1343. “The four Justices who reached the issue in *Tam* likewise held the government subsidy framework does not apply to trademark registration,” with Justice Alito’s plurality opinion finding this to be “no difficult question.” *Id.* This

Court in *Brunetti* “reach[ed] the same conclusion,” *id.* at 1343 n.1, forcefully rejecting the analogy. *Id.* at 1343–45. It further held that “trademark registration is not a limited public forum,” so the statute could not be saved from scrutiny based on this analogy either. *Id.* at 1345–48. Nothing in Justice Kagan’s opinion for the Supreme Court in *Brunetti* disturbed any of this analysis, so it is controlling here. As a result, neither the government-subsidy doctrine nor the limited-public-forum doctrine applies.

The government gives no good reason why this Court could, or should, accept arguments that it has rejected twice before. The government provides just one paragraph (at 33) in support of its subsidy argument. But it doesn’t respond to the core problem with that argument—that “[u]nlike trademark registration, the programs at issue in the Supreme Court’s cases upholding the constitutionality of conditions under the Spending Clause necessarily and directly implicate Congress’ power to spend or control government property.” *Id.* at 1343; *see also Tam*, 137 S. Ct. at 1761 (Alito, J.) (making same point); *Autor v. Pritzker*, 740 F.3d 176, 182–83 (D.C. Cir. 2014) (“The Supreme Court has never extended the subsidy doctrine to situations not involving financial benefits.”). Simply put: “The federal registration of a trademark is nothing like the programs at issue in these cases.” *Tam*, 137 S. Ct. at 1761 (Alito, J.).

The government’s public-forum argument is even less developed. It relies on Justice Sotomayor’s partial dissent in *Brunetti*, but the analysis set forth in that opinion is not the law and does not alter this Court’s precedents. And the government

provides no explanation of why, in both *Brunetti* and *Tam*, its own counsel expressed doubts about this analogy, stating that “it did not believe the forum analysis applied to trademark registration, and in particular that it did not ‘regard the register itself as a forum.’” *Brunetti*, 877 F.3d at 1346 n.2 (quoting government in *Tam*); see Tr. of Oral Argument at 27, *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (No. 18-302) (“[W]e don’t regard [trademark registration] as a limited public forum.”). Nor does the government deny that, were this Court to disregard its precedent and finally embrace the analogy here, the consequences for copyright alone would be staggering.

In short, there is no need to fashion a new test here. Intermediate scrutiny equips the government with sufficient leeway to impose reasonable restrictions on federal registration of trademarks. And if a restriction is so poorly tailored that it cannot satisfy even intermediate scrutiny, it is not too much to ask of the government to revise the restriction to make it fit better with its intended aims.

II. Section 2(c) fails even intermediate scrutiny under *Central Hudson*.

Having spent most of its brief trying to avoid scrutiny, the government makes little effort to carry its “heavy” burden of justifying the law under *Central Hudson*.⁴⁴ *Liquormart v. Rhode Island*, 517 U.S. 484, 516 (1996). Without evidence, it claims that section 2(c) advances two purported interests: (1) restricting “a significant quantity of material that could be misleading” and (2) “respecting the right[] of publicity” under state tort law. Gov. Br. 39, 44. Those arguments, however, do not come close to

satisfying the government’s burden of proving that section 2(c) is narrowly tailored to materially advance a substantial state interest. Far from satisfying *Central Hudson*, the government instead manages to demonstrate why the law targets only *non*-misleading speech that no state does (or constitutionally could) restrict.

A. Section 2(c) does nothing to prevent misleading speech.

The government begins its defense of section 2(c) with a half-hearted claim that the restriction targets “misleading” commercial speech. *See* Gov. Br. 39. Trademarks “that reference an individual without that person’s consent” are misleading, the government argues, because they “often confuse consumers as to whether the referenced individual is associated with the goods in question.” *Id.*

Although there is no question that the government, in the abstract, has a substantial interest in protecting consumers from “confusing or misleading” trademarks, *Tam*, 137 S. Ct. at 1768 (Kennedy, J.), section 2(c) is not at all tailored to advance that interest. As the government acknowledges, neither section 2(c) nor the right of publicity that it purports to protect are “limited to circumstances in which the unauthorized use of an identity would mislead the public.” Gov. Br. 12–13, 39; *see* Restatement (Third) of Unfair Competition § 47 (1995), cmt. a (“Proof that prospective purchasers are likely to believe that the identified person endorses or sponsors the user’s goods or services is not required . . .”). Even under the government’s framing, identification of a specific person in a trademark holds, at

most, the *potential* to be used in a misleading way—in cases where the trademark falsely suggests an association that does not exist. *See, e.g.*, Gov. Br. 39 (arguing that section 2(c) “captures a significant quantity of material that could be misleading”).

But there are plenty of other trademarks that identify a particular person in a way that is not misleading, including those that suggest a true association and those that suggest no association at all. This is one such case: The government does not even attempt to argue that consumers might believe that the phrase “Trump too small” suggests that the former President is somehow involved with producing Mr. Elster’s T-shirts. As courts have recognized, the “use of celebrity names” for criticism or parody is “not likely to confuse or deceive” anyone. *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 975 (10th Cir. 1996).

The Supreme Court has repeatedly held that the mere possibility that a type of commercial speech “may, under some circumstances, be deceptive” does not justify a blanket restriction on that speech. *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 649 (1985); *see also In re R.M.J.*, 455 U.S. 191, 203 (1982) (holding that a state “may not place an absolute prohibition on . . . potentially misleading information”). If it were otherwise, there would be no limit on the government’s power to restrain commercial speech because nearly *any* advertising device is subject to at least the potential for dishonest use. *See Zauderer*, 471 U.S. at 645–46. For that reason, the Court has held, the government may not restrict “truthful and nondeceptive advertising

simply to spare itself the trouble of distinguishing such advertising from false or deceptive advertising.” *Id.* at 646. The government here, by restricting non-misleading political criticism based on the risk that *other* trademarks might be deceptive, has done exactly that.

In fact, it has done worse than that, because the speech that section 2(c) targets is, in practice, not even potentially misleading. As our opening brief explained, the “prevention of consumer deception” that the government seeks to accomplish is the function of a *separate* provision of the Lanham Act—section 2(a), which bars registration of marks that “falsely suggest a connection with persons, living or dead.” *In re Adco Indus.-Techs., L.P.*, 2020 WL 730361, at *13 (T.T.A.B. 2020). In contrast, Section 2(c) “absolutely bars” registration of any mark “that identifies a particular living individual absent written consent”—whether or not that identification is capable of misleading anyone. *In re Hoefflin*, 97 U.S.P.Q.2d 1174, 2010 WL 5191373, at *1 (T.T.A.B. 2010). The practical effect of section 2(c) is thus to restrict only marks that do *not* falsely suggest a connection. The government has no answer to this point.

B. Enforcing the “right of publicity” to prevent political criticism advances no valid government interest, much less a substantial one.

The government’s remaining claimed interest is a purported “interest in respecting” the right of publicity—“a widely recognized form of intellectual-property right” under state law. Gov. Br. 44. That right, it argues, “is generally understood to

bar the appropriation of a person’s identity without her consent for commercial purposes.” *Id.* The state interests behind the right of publicity, however, cannot justify restricting criticism of a major political figure. Because no state would recognize the right of publicity in this context, restriction of the proposed mark would do nothing to advance any state-law rights. The government’s claimed interest would be better served by following the states’ narrower, more tailored approach.¹

1. The government first argues that, because marks targeted by section 2(c) would “not be lawful in the many states that recognize” the right of publicity, the provision “is directed to ‘illegal advertising.’” *Id.* at 39–40. The government therefore argues that it does not meet the first step of the *Central Hudson* test, leaving it entirely outside the First Amendment’s protection. *See id.*

This argument misunderstands *Central Hudson*’s first prong. The question is whether the banned commercial speech “concern[s] *transactions* that are themselves illegal,” as would, for example, advertisements for illegal gambling. *Bates v. State Bar*

¹ Although the government invokes the “right of privacy” in addition to the “right of publicity,” it makes no effort to assert privacy interests as an independent basis for upholding section 2(c). *See* Gov. Br. 15. As our opening brief explained, and the government does not dispute, there is no reasonable argument that a former President of the United States has a privacy interest in preventing criticism based on statements he made in a nationally televised presidential debate. The “right of privacy,” as the government uses the term, is relevant only because the right of publicity is, somewhat paradoxically, often considered a species of “privacy” tort. *See id.* at 43 (acknowledging that “the interest celebrities have in their personas is often not best described as a right of ‘privacy’”).

of Ariz., 433 U.S. 350, 384 (1977) (emphasis added). It does not, as the government assumes, ask whether the restricted *speech* is itself unlawful. That makes sense: The “lawfulness” inquiry cannot “turn on the existence of [a] speech ban” or else “all commercial speech bans would all be constitutional.” *Bellsouth Telecomms., Inc. v. Farris*, 542 F.3d 499, 506 (6th Cir. 2008).

Nor can the lawfulness of a federal speech restriction turn on the existence of a parallel state restriction on speech—at least unless the state restriction itself satisfies First Amendment scrutiny. *See ACLU v. Ashcroft*, 322 F.3d 240, 247 (3d Cir. 2003) (noting that the federal government “does not have an interest in the enforcement of an unconstitutional law”). Here, as our opening brief explained, none of the various justifications that courts have offered for the state-law right of publicity even arguably support restricting T-shirts with the phrase “Trump too small.” And the government never argues otherwise, choosing instead to rely exclusively on the *existence* of the right of publicity under state law. Without evidence that enforcing the right of publicity against the proposed trademark here would advance a substantial government interest, however, the existence of the right does nothing to justify the restriction.

2. The government also argues that section 2(c), even if it’s not treated as a restriction on illegal speech, nevertheless advances the government’s interest in honoring state law on the right of publicity. The government is again wrong because no state would apply the right of publicity to allow Mr. Trump to prevent the speech

at issue here. Although it is true that the laws of many states recognize the right of celebrities to control the commercial use of their identities, that right “is fundamentally constrained by the public and constitutional interest in freedom of expression.” Restatement (Third) of Unfair Competition § 46, cmt. c. As courts have “unanimously” recognized, the right of publicity under state law must be “balanced against public rights of free access to socially and politically useful ideas.” 1J. Thomas McCarthy, *The Rights of Publicity & Privacy* § 2:4 (2d ed. 2020); see, e.g., *ETW Corp. v. Jireh Publishing, Inc.*, 332 F.3d 915, 931 (6th Cir. 2003); *Hoffman v. Capital Cities/ABC, Inc.*, 255 F.3d 1180, 1183–84 (9th Cir. 2001); *Cardtoons*, 95 F.3d at 969; *Rogers v. Grimaldi*, 875 F.2d 994, 1004 (2d Cir. 1989). And that “inherent tension between the right of publicity and the right of freedom of expression . . . becomes particularly acute” in cases, like this one, where “the person seeking to enforce the right is a famous actor, athlete, politician, or otherwise famous person” subject to “scrutiny and comment in the public media.” *ETW Corp.*, 332 F.3d at 931. The right of publicity does not—and cannot, consistent with the First Amendment—extend so far as to bar commercial speech involving “social commentary on public figures.” *Cardtoons*, 95 F.3d at 969.²

² Even the state laws that the government cites (at 18) recognize free-speech exceptions. See, e.g., *Dora v. Frontline Video, Inc.*, 15 Cal. App. 4th 536, 542 (1993); *Tyne v. Time Warner Ent. Co.*, 901 So.2d 802, 809–10 (Fla. 2005); *Messenger ex rel. Messenger v. Gruner + Jahr Printing & Publ’g.*, 94 N.Y.2d 436, 441–42 (N.Y. 2000).

The government briefly acknowledges the cases applying such First Amendment limits, but characterizes them as “edge cases” that arise “when the right of publicity is used to try to control novel creative works such as parody baseball cards.” Gov. Br. 41–42 (citing *Cardtoons*, 95 F.3d at 968). This case, the government claims, does not raise the same “hard questions of First Amendment law.” *Id.* But the truth is the opposite: The First Amendment interests here are *more* significant. The parody baseball cards in *Cardtoons* were entitled to First Amendment protection because they were “social commentary on public figures . . . involved in a significant commercial enterprise.” 95 F.3d at 969. Here, the restricted speech involves a public figure who is not only commercially significant, but who is also a former (and likely future candidate for) President of the United States. It thus involves political speech about an important public official—speech at the very core of the First Amendment’s protection. *See Hustler Magazine v. Falwell*, 485 U.S. 46, 50, 52 (1988).

The government disagrees, arguing (at 40) that the protection due to discussion of public figures does not apply to “commercial exploitation” of a public figure’s identity. But even in the commercial-speech context, the “fundamental values” animating the First Amendment remain relevant when the speech at issue “actually consist[s] of core expression.” *Tam*, 808 F.3d at 1374 (Dyk, J., concurring and dissenting). And the “fact that expressive materials are sold does not diminish the degree of protection to which they are entitled.” *ETW Corp.*, 332 F.3d at 924–25.

Mr. Elster “need not give away” his T-shirts “to bring them within the ambit of the First Amendment.” *Cardtoons*, 95 F.3d at 969–70.

It is therefore unsurprising that the government fails to identify a single case applying the right of publicity in circumstances even remotely resembling those here. It cites only an illustration from the Restatement of Torts involving use of a president’s name, which it invokes (at 42) as a “paradigmatic” example of the publicity right. Restatement (Second) of Torts § 652C (1977). The restatement, however, does not purport to delineate the First Amendment’s limits. And in any event, the illustration is about a false endorsement, where an insurance company falsely used the president’s name to engage in business. Because the business name was deceptive, it could be denied registration under section 2(a) without raising First Amendment concerns. This case could hardly be more different.

Recognizing that the First Amendment limits section 2(c) would not, as the government claims (at 41), rest on “disagree[ment] with the right to publicity” or its “theoretical foundation.” The point is not “that public officials lack ‘any legitimate economic interest’ in their personas,” Gov. Br. 45, but just that, at a minimum, they lack such a legitimate “interest in licensing” the “public debate.” Elster Opening Br. 43. That does not require “wholesale rejection of a right of publicity in any and all cases,” but only that courts follow the right-of-publicity case law in recognizing that

the First Amendment is a “valid concern to be carefully considered and balanced in a specific case.”¹ McCarthy, *The Rights of Publicity* § 2:4.

3. Finally, the government has almost no argument that its restriction is narrowly tailored to its claimed interest. It argues (at 43–44) only that section 2(c) is “sufficiently tailored” because it “tracks the contours of the right to publicity.” But as already explained, the statute burdens speech that could not give rise to tort liability under the law of any state. Restricting the trademark here does not protect Mr. Trump from “misappropriation” of his identity or any other valid interests. All that it protects him from is criticism.

To be sure, Congress made no secret of its interest in protecting former presidents and their spouses from such negative associations—saying that it was concerned more about “Abraham Lincoln gin” than “George Washington coffee.” *See* Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents, 76th Cong., 1st Sess. 18–21 (1939). But neither Mr. Trump nor the government can claim any legitimate interest in restricting trademarks just because they make a president look bad.

The dramatic overbreadth of the government’s position is perhaps best illustrated by its apparent view (at 45) that its claimed interest would also be narrowly served by a restriction on the mark “James Buchanan was a disastrous president”—the same restriction that Justice Alito in *Tam* used as an example of a law that was

self-evidently “far too broad” to survive intermediate scrutiny. 137 S. Ct. at 1765. The restriction on “Trump too small” is just as self-evidently unconstitutional.

CONCLUSION

The decision of the Trademark Trial and Appeal Board should be reversed.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

This brief complies with the type-volume limitation of Federal Rule of Appellate Procedure 32(a)(7)(B) because this brief contains 5,013 words, excluding the parts of the brief exempted by Rule 32(f). This brief complies with the typeface requirements of Rule 32(a)(5) and the type-style requirements of Rule 32(a)(6) because this brief has been prepared in proportionally spaced typeface using Microsoft Word 2010 in 14-point Baskerville font.

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CERTIFICATE OF SERVICE

I hereby certify that on July 27, 2021, I electronically filed the foregoing reply brief with the Clerk of the Court for the U.S. Court of Appeals for the Federal Circuit by using the CM/ECF system. All participants are registered CM/ECF users and will be served by the CM/ECF system.

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