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In the Supreme Court of the United States

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

v.

STEVE ELSTER

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

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PETITION FOR A WRIT OF CERTIORARI

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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.

**RELATED PROCEEDING**

United States Court of Appeals (Fed. Cir.):

*In re Elster*, No. 2020-2205 (Aug. 31, 2022)

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# In the Supreme Court of the United States

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No. 22-704

KATHERINE K. VIDAL, UNDER SECRETARY OF  
COMMERCE FOR INTELLECTUAL PROPERTY AND  
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## **PETITION FOR A WRIT OF CERTIORARI**

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The Solicitor General, on behalf of Katherine K. Vidal, Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office (USPTO), respectfully petitions for a writ of certiorari to review the judgment of the United States Court of Appeals for the Federal Circuit in this case.

### **OPINIONS BELOW**

The opinion of the court of appeals (App., *infra*, 1a-21a) is reported at 26 F.4th 1328. The decisions of the Trademark Trial and Appeal Board (App., *infra*, 22a-32a) and the USPTO examining attorney (App., *infra*, 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 (App., *infra*, 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. The jurisdiction of this Court is invoked under 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. The entirety of Section 1052 is reproduced in an appendix to this petition. App., *infra*, 75a-78a.

## STATEMENT

## A. Legal Background

A trademark is a “word, name, symbol, or device” that is used or intended to be used “to identify and distinguish [a person’s] goods” from “those manufactured or sold by others and to indicate the source of the goods.” 15 U.S.C. 1127; 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”). 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.”). “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).

Though trademarks are creatures of state law, see *In re Trade-Mark Cases*, 100 U.S. 82, 93 (1879), federal law “has long played a role in protecting them,” *B&B Hardware*, 575 U.S. at 142. Under the Lanham Act, ch. 540, 60 Stat. 427 (15 U.S.C. 1051 *et seq.*), the 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.* 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 also is “prima facie evidence of the validity of the registered 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). And after five years, registration can render that right “incontestable,” except on certain grounds. 15 U.S.C. 1065 (2018 & Supp. II 2020), 1115(b).

To obtain the benefits of registration, a person who uses or intends to use a trademark in commerce applies to record 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 grants the application, it issues the owner a certificate 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. 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 signa-

ture identifying a particular living individual except by his written consent.” The federal trademark-registration program has included that bar since 1946. Lanham Act § 2(c), 60 Stat. 428.

Section 1052(c) serves in part to protect the same interests that traditionally have underlain the rights of privacy and publicity that living persons have in the designations that identify them. See, e.g., *In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d 1639, 2015 WL 496132, at \*12 (T.T.A.B. Jan. 30, 2015); see also USPTO, *Trademark Manual of Examining Procedure (TMEP)* § 1206 (July 2022) (collecting cases); *University of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372, 1376 n.8 (Fed. Cir. 1983) (recognizing the link between Section 1052(c) and the right to privacy).<sup>1</sup> Section 1052(c) also operates in tandem with other Lanham Act provisions to help “protect[] consumers against

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<sup>1</sup> The right of publicity is widely recognized under state statutes and at common law. While the particulars vary between jurisdictions, the right of publicity is generally understood to bar the appropriation for commercial purposes of a person’s identity without his consent. See Restatement (Third) of Unfair Competition § 46 (1995) (“One who appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade is subject to liability.”). The right of publicity thus is “the legal label denominating the law’s recognition of the property right inherent in the commercial value of a person’s identity.” 1 J. Thomas McCarthy & Roger E. Schechter, *The Rights of Publicity and Privacy* § 6:2 (2020 ed.) (McCarthy). By the end of the twentieth century, the right to control the commercial use of one’s name and likeness “ha[d] been recognized in some form by virtually all states.” *Bi-Rite Enters., Inc. v. Bruce Miner Co.*, 757 F.2d 440, 442 (1st Cir. 1985) (citing *Prosser and Keeton on The Law of Torts* 850-851 (W. Page Keeton ed., 5th ed. 1984)); see McCarthy § 6:2 (identifying 33 States that have recognized a “right of publicity”).

source deception.” *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); see 15 U.S.C. 1114(1)(a), 1125(a)(1)(A) (trademark-infringement provisions that prohibit the use of a mark in commerce in a manner that is “likely to cause confusion, or to cause mistake, or to deceive” as to the source of particular goods). But unlike the common-law rights of privacy and publicity, and the Lanham Act prohibitions on trademark infringement, Section 1052(c) does not impose any independent limits on the use in commerce of the marks that provision covers. Rather, Section 1052(c) simply makes unavailable the commercial benefits that federal registration of a mark entails. The determination whether and under what circumstances a particular mark may be *used* is controlled by other provisions of federal and state law.

#### **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. App., *infra*, 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.” App., *infra*, 70a.<sup>2</sup>

A USPTO examining attorney refused registration under Section 1052(c). App., *infra*, 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.

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<sup>2</sup> 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).

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. App., *infra*, 33a; see 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 App., *infra*, 39a.

The Board affirmed the refusal of registration under Section 1052(c). App., *infra*, 22a-32a. The Board agreed with the examining attorney that respondent’s mark fell within the scope of Section 1052(c) because the mark “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. App., *infra*, 1a-21a. The court held that “applying [Section 1052(c)] to bar registration of [respondent’s] mark unconstitution-

ally restricts free speech in violation of the First Amendment.” *Id.* at 1a. The court acknowledged that Section 1052(c) “does not involve viewpoint discrimination.” *Id.* at 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[]” on speech 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.<sup>3</sup>

3. The court of appeals denied rehearing en banc without noted dissent. App., *infra*, 65a-66a.

#### REASONS FOR GRANTING THE PETITION

For more than 75 years, Congress has directed the USPTO to refuse the registration of trademarks that use the name of a particular living individual without his written consent. 15 U.S.C. 1052(c). The court of appeals

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<sup>3</sup> 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.” App., *infra*, 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.*

in this case held that the 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. App., *infra*, 20a. That holding is incorrect, and this Court usually grants review when a court of appeals has invalidated the application of a federal statute.

Indeed, this Court has twice before granted certiorari to review decisions of the Federal Circuit that invalidated statutory bars on federal trademark registration. See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019); *Matal v. Tam*, 137 S. Ct. 1744, 1755 (2017). And this case presents a recurring issue under the First Amendment that this Court’s decisions in *Tam* and *Brunetti* left open: “whether a Lanham Act bar” on the registration of a trademark is “a condition on a government benefit or a simple restriction on speech.” *Brunetti*, 139 S. Ct. at 2299. The Court should grant certiorari in this case to resolve that important question and to address the constitutionality of Section 1052(c).

**A. The Question Presented Warrants This Court’s Review**

1. This Court has recognized that judging the constitutionality of a federal statute “is the gravest and most delicate duty that th[e] Court is called on to perform.” *Rust v. Sullivan*, 500 U.S. 173, 191 (1991) (quoting *Blodgett v. Holden*, 275 U.S. 142, 148 (1927) (opinion of Holmes, J.)). Accordingly, “when a lower court has invalidated a federal statute,” the Court’s “usual” approach is to “grant[] certiorari.” *Brunetti*, 139 S. Ct. at 2298; see, e.g., *United States v. Sineneng-Smith*, 140 S. Ct. 1575, 1578 (2020) (granting certiorari where the government petitioned for review “because the judgment of the Court of Appeals invalidated a federal statute”); *Allen v. Cooper*, 140 S. Ct. 994, 1000 (2020) (grant-



ing certiorari “[b]ecause the Court of Appeals held a federal statute invalid”).

The Court has repeatedly granted review of decisions holding federal statutes invalid on First Amendment grounds, even in the absence of a circuit conflict. See, e.g., *Barr v. American Ass’n of Political Consultants, Inc.*, 140 S. Ct. 2335, 2345-2346 (2020) (plurality opinion); *Brunetti*, 139 S. Ct. at 2298; *Tam*, 137 S. Ct. at 1755; *United States v. Alvarez*, 567 U.S. 709, 714 (2012) (plurality opinion); *United States v. Stevens*, 559 U.S. 460, 467 (2010); *United States v. Williams*, 553 U.S. 285, 292 (2008); *Ashcroft v. ACLU*, 542 U.S. 656, 664 (2004). In *Tam*, for example, the Court granted review of a Federal Circuit decision that had invalidated the Lanham Act’s bar on the registration of “disparag[ing]” marks. 15 U.S.C. 1052(a); see *Tam*, 137 S. Ct. at 1755. And in *Brunetti*, the Court granted review of a Federal Circuit decision that had invalidated the Lanham Act’s bar on the registration of “immoral” or “scandalous” marks. 15 U.S.C. 1052(a); see *Brunetti*, 139 S. Ct. at 2298.

The Court should likewise grant review here to address the constitutionality of Section 1052(c). If the ruling below remains in place, any “applicant for registration of a mark” who is “dissatisfied” with a future decision of the Board will have a right of appeal to the Federal Circuit and thus can obtain the benefit of that court’s precedential decision in this case. 15 U.S.C. 1071(a)(1) (2018 & Supp. II 2020); see 28 U.S.C. 1295(a)(4)(B). Accordingly, as in *Tam* and *Brunetti*, there is no meaningful possibility that a circuit conflict will arise.

No better vehicle for addressing the constitutionality of Section 1052(c) is likely to emerge. The government is not aware of any other case presenting the issue that is currently pending before the Federal Circuit.

And although the USPTO currently has before it other pending trademark-registration applications that may implicate Section 1052(c), the Board and examining attorneys follow Federal Circuit precedent. See USPTO, *Trademark Trial and Appeal Board Manual of Procedure (TBMP)* § 101.03 (June 2022) (explaining that “[p]roceedings before the Board” are “governed, to a large extent, by precedential decisions in prior cases,” including “the decisions of the Court of Appeals for the Federal Circuit”); *TMEP* § 705.05 (explaining that “examination” is “governed by precedential decisions in prior cases,” including “precedential decisions from the Court of Appeals for the Federal Circuit”). Accordingly, the USPTO has suspended action on those applications pending the Court’s disposition of this petition for a writ of certiorari. If this Court denies review, it is unclear when, if ever, the constitutionality of Section 1052(c) will again be presented for judicial resolution.

2. This case also presents an opportunity for the Court to resolve a question that it left open in *Tam* and *Brunetti*: “whether a Lanham Act bar” on the registration of a trademark is “a condition on a government benefit or a simple restriction on speech.” *Brunetti*, 139 S. Ct. at 2299; see *id.* at 2302 n.\* (emphasizing that the Court in that case did not “say anything about how to evaluate viewpoint-neutral restrictions on trademark registration”); *id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part) (noting that *Tam* had “left open” the issue of “how exactly the trademark registration system is best conceived under [the Court’s] precedents”). Neither *Tam* nor *Brunetti* resolved that question because the Court concluded in those cases that the Lanham Act provisions at issue were “viewpoint-based” and therefore “unconstitutional,” regardless of the “over-

all framework” for addressing the constitutionality of bars on registration. *Id.* at 2298-2299 (majority opinion); see *Tam*, 137 S. Ct. at 1762-1765 (opinion of Alito, J.); *id.* at 1765 (Kennedy, J., concurring in part and concurring in the judgment).

Here, unlike in *Tam* and *Brunetti*, the Lanham Act provision at issue “does not involve viewpoint discrimination.” App., *infra*, 5a. This case therefore cleanly presents the question whether a viewpoint-neutral bar on the registration of a trademark is “a condition on a government benefit or a simple restriction on speech.” *Brunetti*, 139 S. Ct. at 2299. That issue is an important one because it determines the appropriate level of scrutiny under the First Amendment. See *id.* at 2315-2317 (Sotomayor, J., concurring in part and dissenting in part). And resolution of that question potentially affects the constitutionality not only of Section 1052(c), but also of the many other viewpoint-neutral bars on registration contained in Section 1052. See p. 4, *supra*.

To be sure, because respondent “raised only an as-applied challenge before” the court of appeals, that court did not decide whether Section 1052(c) “is unconstitutionally overbroad” and therefore facially invalid. App., *infra*, 20a. Rather, the court held that the USPTO could not constitutionally invoke that provision as a ground for declining to register marks, like respondent’s, that criticize a government official or public figure. See *id.* at 5a, 20a, 21a. But the question whether Section 1052(c) is constitutional as applied to marks of that nature is itself an issue of substantial legal and practical importance. See *id.* at 20a-21a (“It may be that a substantial number of section [1052(c)]’s applications would be unconstitutional.”). And the Federal Circuit’s as-applied holding was grounded in that court’s percep-

tion that the USPTO’s refusal of trademark registration should be treated, for First Amendment purposes, as a restriction on speech. See *id.* at 11a (describing the question presented in this case as “whether the government has an interest in limiting speech on privacy or publicity grounds if that speech involves criticism of government officials”). As noted above, this Court’s determination whether that premise is correct could help to clarify the constitutional status of other Lanham Act registration bars in addition to Section 1052(c).

**B. The Court Of Appeals’ Decision Is Wrong**

The court of appeals invalidated the application of Section 1052(c) to marks that contain “speech critical of government officials or public figures.” App., *infra*, 20a. In so doing, the court treated the refusal to register those marks as a “restrict[ion]” on such speech. *Id.* at 1a. That was error. Section 1052(c) is a condition on a government benefit, not a restriction on speech. And because it is a reasonable, viewpoint-neutral condition, it is consistent with the First Amendment.

1. The Free Speech Clause states that “Congress shall make no law \* \* \* abridging the freedom of speech.” U.S. Const. Amend. I. Accordingly, this Court has distinguished between laws that “‘abridg[e] the freedom of speech’” and laws that merely “decline[] to promote” it. *Ysursa v. Pocatello Educ. Ass’n*, 555 U.S. 353, 355 (2009). The Lanham Act’s viewpoint-neutral bars on trademark registration fall within the latter category.

When registration is refused because a mark “[c]onsists of or comprises a name \* \* \* identifying a particular living individual” without “his written consent,” 15 U.S.C. 1052(c), “[n]o speech is being restricted; no one is being punished,” *Brunetti*, 139 S. Ct. at 2303 (Rob-

erts, C.J., concurring in part and dissenting in part). The owner of the mark remains free to use the mark in commerce. See *ibid.* (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”). And refusal of trademark registration under Section 1052(c) does not prevent the mark owner from using the individual’s name, without that individual’s consent, in whatever speech the owner wishes to engage in. See *id.* at 2305 (Breyer, J., concurring in part and dissenting in part) (observing that “the statute does not bar anyone from speaking”).

The only effect of Section 1052(c) is to deny the owner “the ancillary benefits that come with registration,” including “additional protections against infringers.” *Brunetti*, 139 S. Ct. at 2316-2317 (Sotomayor, J., concurring in part and dissenting in part). Section 1052(c) thus operates as a condition on a government benefit, and its operation does not “reach outside” the federal trademark-registration program. *Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, 570 U.S. 205, 217 (2013). Rather, Section 1052(c) merely “defin[es] the limits of the [government] program” itself. *Id.* at 218.

This Court’s decisions upholding speech-related (but viewpoint-neutral) criteria for government benefits have involved various types of benefits, including financial subsidies and access to government-provided forums. See *Brunetti*, 139 S. Ct. at 2316-2317 & n.10 (Sotomayor, J., concurring in part and dissenting in part). The commercial benefits that federal trademark registration provides are not precisely equivalent to the benefits

that were at issue in this Court’s prior financial-subsidy or public-forum cases. But “[w]hichever label one chooses here, the federal system of trademark registration fits: It is, in essence, an opportunity to include one’s trademark on a list and thereby secure the ancillary benefits that come with registration.” *Id.* at 2317. Any uncertainty as to Section 1052(c)’s closest doctrinal analogue is far less significant than is the undisputed fact that refusal of trademark registration under that provision places no constraints on respondent’s freedom to use his chosen mark.

Section 1052(c) “does not restrict” speech. *Ysursa*, 555 U.S. at 355. Rather, Congress has simply withheld specific enforcement benefits from a particular set of speakers. Heightened scrutiny therefore is unwarranted. See *Brunetti*, 139 S. Ct. at 2316-2317 (Sotomayor, J., concurring in part and dissenting in part). The government “is acting in a capacity other than as regulator.” *Davenport v. Washington Educ. Ass’n*, 551 U.S. 177, 188 (2007). And it may place conditions on the availability of a government benefit so long as those conditions are “reasonable” and “viewpoint-neutral.” *Brunetti*, 139 S. Ct. at 2317 (Sotomayor, J., concurring in part and dissenting in part); see *Ysursa*, 555 U.S. at 355; *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995); *Regan v. Taxation With Representation of Wash.*, 461 U.S. 540, 546-551 (1983).

Here, it is undisputed that Section 1052(c) “does not involve viewpoint discrimination.” App., *infra*, 5a. Section 1052(c) serves in part “to protect rights of privacy and publicity that living persons have in the designations that identify them.” *In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d 1639, 2015 WL 496132, at \*12 (T.T.A.B. Jan. 30, 2015). Those rights have “long received legal

recognition and protection.” *John Anthony, Inc. v. Fashions by John Anthony, Inc.*, 209 U.S.P.Q. 517, 1980 WL 39056, at \*9 (T.T.A.B. Dec. 30, 1980). Because living persons have “valuable” rights in their own names, the government has an interest in not promoting or associating itself with marks that “appropriate[] or commercially exploit[]” a living person’s name “without his consent.” *Id.* at \*10. And on the other side of the balance, respondent’s unquestioned First Amendment right to criticize the former President does not entitle him to enhanced mechanisms for enforcing property rights in another person’s name. On its face and as applied here, Section 1052(c) is thus a reasonable, viewpoint-neutral condition on a government benefit.

2. In concluding that the application of Section 1052(c) to respondent’s mark violates the First Amendment, the court of appeals treated Section 1052(c) as a restriction on speech. See App., *infra*, 1a, 11a, 12a, 19a, 20a. Applying heightened scrutiny, see *id.* at 9a-10a, the court held that “the government does not have a privacy or publicity interest in restricting speech critical of government officials or public figures in the trademark context,” *id.* at 20a.

No one doubts that political speech is “at the heart” of what the First Amendment protects. App., *infra*, 11a. But as explained above, Section 1052(c) is not a restriction on speech; it is a viewpoint-neutral condition on a government benefit. The refusal under Section 1052(c) to register marks, like respondent’s, that criticize a government official or public figure does not “limit[]” political speech. *Ibid.* To the contrary, it is the *registration* of marks like respondent’s—not the *refusal* to register them—that would “chill” such speech. *Id.* at 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 serves only to bolster those “rights of exclusion,” *K Mart Corp. v. Cartier, Inc.*, 485 U.S. 176, 185 (1988), by giving owners “additional protections against infringers,” *Brunetti*, 139 S. Ct. at 2316 (Sotomayor, J., concurring in part and dissenting in part). See, *e.g.*, 15 U.S.C. 1115(a) (providing that registration shall be “prima facie evidence” of “the registrant’s exclusive right to use the registered mark in commerce”).

Thus, far from enhancing freedom of speech, the decision below makes it easier for individuals like respondent to invoke enforcement mechanisms to restrict the speech of others. This Court’s intervention is warranted to correct the court of appeals’ misapplication of First Amendment principles.

#### CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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JANUARY 2023



APPENDIX A

UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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No. 2020-2205

IN RE: STEVE ELSTER,  
*Appellant*

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Decided: Feb. 24, 2022

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

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Before DYK, TARANTO, and CHEN, *Circuit Judges*.

DYK, *Circuit Judge*.

Steve Elster appeals a decision of the Trademark Trial and Appeal Board (“Board”). The Board affirmed an examiner’s refusal to register the trademark “TRUMP TOO SMALL” for use on T-shirts. The Board’s decision was based on section 2(c) of the Lanham Act, 15 U.S.C. § 1052(c), and the Board’s finding that the mark included the surname of a living individual, President Donald J. Trump, without his consent. Because we hold that applying section 2(c) to bar registration of Elster’s mark unconstitutionally restricts free speech in violation of the First Amendment, we reverse the Board’s decision.

## BACKGROUND

In 2018, Elster sought to register the phrase “TRUMP TOO SMALL” in standard characters for use on shirts in International Class 25. The class of goods encompasses:

Shirts; Shirts and short-sleeved shirts; Graphic T-shirts; Long-sleeved shirts; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; T-shirts; Tee shirts; Tee-shirts; Wearable garments and clothing, namely, shirts. . . .

J.A. 1-2. According to Elster’s registration request, the phrase he sought to trademark invokes a memorable exchange between President Trump and Senator Marco Rubio from a 2016 presidential primary debate, and aims to “convey[] that some features of President Trump and his policies are diminutive.” J.A. 5.

The Patent and Trademark Office (“PTO”) examiner rejected Elster’s proposed mark on two grounds. First, the examiner concluded that the mark was not registrable because section 2(c) of the Lanham Act bars registration of a trademark that “[c]onsists of or comprises a name . . . identifying a particular living individual” without the individual’s “written consent.” § 1052(c). Consistent with this provision, Elster’s mark could not be registered because it used Trump’s name without his consent. It did not matter, according to the examiner, that the mark was “intended as political commentary” because there is no statutory or “case law carve[] out” for “political commentary.” J.A. 201. The examiner rejected Elster’s contention that denying the application infringed his First Amendment rights, finding that the registration bars are not restrictions on

speech, and in the alternative, that any such restriction would be permissible. In a separate decision, the examiner also denied registration of the mark under section 2(a)'s false association clause, which bars registration of trademarks that "falsely suggest a connection with persons, living or dead." § 1052(a). The examiner here also rejected a First Amendment defense.

Elster appealed both decisions to the Board, which consolidated the two cases. Elster argued that sections 2(c) and 2(a) constituted impermissible content-based restrictions on speech. He contended that strict scrutiny should apply, that neither provision was narrowly tailored to serve a compelling government interest, and that any government interest was outweighed by the First Amendment interest in allowing commentary and criticism regarding a political figure. The Board affirmed the examiner's denial of the mark in a decision that rested solely on section 2(c) grounds, finding it unnecessary to address the rejection under section 2(a).

Although the Board recognized that it does not have authority to declare statutory provisions unconstitutional, it noted that prior Board decisions have addressed the constitutionality of section 2(c) in light of the Board's experience and familiarity with the purposes underlying the statute, and it concluded that section 2(c) was not an unconstitutional restriction on free speech. The Board explained, "even if Section 2(c) were subject to greater scrutiny," it is narrowly tailored to advance two compelling government interests: protecting the named individual's rights of privacy and publicity and protecting consumers against source decep-

tion. J.A. 10. Elster appeals. We have jurisdiction pursuant to 15 U.S.C. § 1071(a).

## DISCUSSION

## I

Section 2 of the Lanham Act requires the PTO to refuse registration of certain categories of proposed trademarks. In the last five years, the Supreme Court has held unconstitutional two provisions of section 2. In *Matal v. Tam*, 582 U.S. \_\_\_, 137 S. Ct. 1744 (2017), the Court considered a provision of section 2(a) of the Lanham Act, which directed the PTO to deny registration of marks that “disparage . . . or bring . . . into contempt[] or disrepute” any “persons, living or dead,” 15 U.S.C. § 1052(a). The eight-Justice Court was evenly split between two non-majority opinions, but both sides agreed that the provision violated the First Amendment. See *Tam*, 137 S. Ct. at 1765. In *Iancu v. Brunetti*, 588 U.S. \_\_\_, 139 S. Ct. 2294 (2019), the Court considered another provision of section 2(a) of the Lanham Act, which directed the PTO to deny registration of marks that “consist[] of or comprise[] immoral . . . or scandalous matter,” § 1052(a). Again, the Court held the provision unconstitutional. See *Brunetti*, 139 S. Ct. at 2302. The two opinions in *Tam* and the majority opinion in *Brunetti* each relied on a “core postulate of free speech law”—that “[t]he government may not discriminate against speech based on the ideas or opinions it conveys”—and concluded that “[v]iewpoint discrimination doomed” the two provisions. *Id.* at 2299.

The provision of the Lanham Act involved in this case, section 2(c), prohibits registration of a trademark that

[c]onsists 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.

§ 1052(c). Neither *Tam* nor *Brunetti* resolves the constitutionality of section 2(c). Both holdings were carefully cabined to the narrow, “presumptive[] unconstitutionality[]” of section 2(a)’s viewpoint-based restrictions, *Brunetti*, 139 S. Ct. at 2299 (quoting *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829-30 (1995)), and Elster agrees that section 2(c) does not involve viewpoint discrimination, Oral Arg. at 45:49-46:35. We nonetheless conclude that as applied in this case, section 2(c) involves content-based discrimination that is not justified by either a compelling or substantial government interest.

## II

While neither *Tam* nor *Brunetti* resolves this case, they do establish that a trademark represents “private, not government, speech” entitled to some form of First Amendment protection. *Tam*, 137 S. Ct. at 1760; see *Brunetti*, 139 S. Ct. at 2299. The cases also establish that trademarks often “do not simply identify the source of a product or service but go on to say something more” on “some broader issue.” *Tam*, 137 S. Ct. at 1764 (Alito, J.). They frequently “have an expressive content” and can convey “powerful messages . . . in just a few words.” *Id.* at 1760. Even though the government in the trademark area has not imposed an absolute prohibition on speech, *Brunetti* further established that denying trademark registration “disfavors”

the speech being regulated. 139 S. Ct. at 2297, 2300. We recognize, as the government contends, that section 2(c) does not prevent Elster from communicating his message outright. But whether Elster is free to communicate his message without the benefit of trademark registration is not the relevant inquiry—it is whether section 2(c) can legally disadvantage the speech at issue here.

The advantages of trademark registration are well known, including serving as “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”; conferring “incontestable” status “once a mark has been registered for five years”; and enabling a mark holder to prevent the importation of goods “bearing an infringing mark” into the United States. *Tam*, 137 S. Ct. at 1753 (internal quotation marks omitted) (first quoting *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015); then quoting *id.* at 143; and then quoting 3 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 19:9, at 19-38 (4th ed. 2017)).

Nonetheless, the government argues that because trademark protection is the equivalent of a government subsidy, it is not subject to First Amendment scrutiny so long as viewpoint discrimination is not involved. This position has little support in the Supreme Court’s opinions in *Tam* and *Brunetti*. Although the dissenting Justices in *Brunetti* suggested that trademark registration might be viewed as a condition on a government benefit, 139 S. Ct. at 2308, 2317 (Sotomayor, J. concurring-in-part and dissenting-in-part), Justice

Alito’s opinion in *Tam*, joined by three other Justices, stated that the “federal registration of a trademark is nothing like” government subsidy programs that provide cash benefits to private parties, and that cases addressing such programs are “not instructive in analyzing the constitutionality of restrictions on” trademarks, 137 S. Ct. at 1761 (Alito, J.). Justice Kennedy’s concurring opinion in *Tam*, joined by the three remaining Justices, declined to address the government subsidy framework, suggesting it was not relevant. *Id.* at 1765, 1767 (Kennedy, J.). And when *Tam* and *Brunetti* were before this court, we held that trademark registration is not a government subsidy. *See In re Tam*, 808 F.3d 1321, 1348-54 (Fed. Cir. 2015) (en banc); *In re Brunetti*, 877 F.3d 1330, 1342-45 (Fed. Cir. 2017).

In any event, even if a trademark were a government subsidy, this is not a situation in which First Amendment requirements are inapplicable. Elster’s mark is speech by a private party in a context in which controversial speech is part-and-parcel of the traditional trademark function, as the Supreme Court decisions in *Tam* and *Brunetti* attest. Under such circumstances, the effect of the restrictions imposed with the subsidy must be tested by the First Amendment. *See Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 543, 547-48 (2001) (funding condition barring lawyers from challenging constitutionality of welfare laws violated the First Amendment); *see also FCC v. League of Women Voters*, 468 U.S. 364, 396-97 (1984) (funding condition preventing broadcasters receiving federal funds from editorializing held unconstitutional).

We are also not convinced by the government’s argument that Lanham Act bars are comparable to speech

restrictions in a limited public forum. To be sure, Justice Alito’s opinion in *Tam*, joined by three other Justices, suggested that the limited public forum doctrine, which permits some viewpoint-neutral “content- and speaker-based restrictions,” presented a “[p]otentially more analogous” framework than the subsidy theory. 137 S. Ct. at 1763 (Alito, J.). But this is not a case in which the government has restricted speech on its own property to certain groups or subjects, a fact distinguishing it from nearly all of the Supreme Court’s limited public forum cases. See *In re Brunetti*, 877 F.3d at 1346 (citing cases). While a limited public forum need not be a physical place—it can be “metaphysical”—our decision in *In re Brunetti* noted that when the Supreme Court has analyzed speech restrictions in metaphysical forums, such restrictions were always “tethered to government properties” where the effects were later felt. *Id.* at 1347 (citing *Rosenberger*, 515 U.S. at 830). No similar situation exists for the trademark registration program because “refusals chill speech anywhere from the Internet to the grocery store.” *Id.* at 1348. We are not dealing with speech in a limited public forum. The speech here is entitled to First Amendment protection beyond protection against viewpoint discrimination.

It is well established that speech ordinarily protected by the First Amendment does not lose its protection “because the [speech] sought to be distributed [is] sold rather than given away.” *Heffron v. Int’l Soc. for Krishna Consciousness, Inc.*, 452 U.S. 640, 647 (1981) (first citing *Murdock v. Pennsylvania*, 319 U.S. 105, 111 (1943); and then citing *Schaumburg v. Citizens for a Better Env’t*, 444 U.S. 620, 632 (1980)); see also *Cardtoons, L.C. v. Major League Baseball Players*



*Ass'n*, 95 F.3d 959, 970 (10th Cir. 1996) (“[W]e see no principled distinction between speech and merchandise that informs our First Amendment analysis. The fact that expressive materials are sold neither renders the speech unprotected . . . nor alters the level of protection.” (citations omitted)). Nor is expressive speech entitled to a lesser degree of protection because it is printed on a T-shirt. See *Cohen v. California*, 403 U.S. 15, 18 (1971) (holding that a jacket bearing the words “Fuck the Draft” is protected speech); see also *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 804 (Cal. 2001) (“Nor does the fact that Saderup’s art appears in large part on a less conventional avenue of communications, T-shirts, result in reduced First Amendment protection.”); *Ayres v. City of Chicago*, 125 F.3d 1010, 1014 (7th Cir. 1997) (“The T-shirts that the plaintiff sells carry an extensive written message of social advocacy; . . . there is no question that the T-shirts are a medium of expression prima facie protected by the free-speech clause of the First Amendment.”).

That trademarked speech is entitled to First Amendment protection and that the protection is not lost because of the commercial nature of the speech does not establish the relevant test. Whatever the standard for First Amendment review of viewpoint-neutral, content-based restrictions in the trademark area, whether strict scrutiny, see *Reed v. Town of Gilbert*, 576 U.S. 155, 163 (2015) (the restriction must be “narrowly tailored to serve compelling state interests”), or intermediate scrutiny, see *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 566 (1980) (the restriction must “directly advance[]” a “substantial” government interest), there must be at least a substantial govern-

ment interest in the restriction. We proceed to examine the consequential First Amendment interests and the claimed government interests.

### III

The First Amendment interests here are undoubtedly substantial. “Whatever differences may exist about interpretations of the First Amendment, there is practically universal agreement that a major purpose of that Amendment was to protect the free discussion of governmental affairs.” *Mills v. Alabama*, 384 U.S. 214, 218 (1966); *see also N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 269 (1964) (“The general proposition that freedom of expression upon public questions is secured by the First Amendment has long been settled by our decisions.”); *Hustler Mag., Inc. v. Falwell*, 485 U.S. 46, 50 (1988) (“At the heart of the First Amendment is the recognition of the fundamental importance of the free flow of ideas and opinions on matters of public interest and concern.”). Indeed, “speech concerning public affairs is more than self-expression; it is the essence of self-government.” *Garrison v. Louisiana*, 379 U.S. 64, 74-75 (1964).

In particular, “the right to criticize public men” is “[o]ne of the prerogatives of American citizenship.” *Baumgartner v. United States*, 322 U.S. 665, 673-74 (1944). Such criticism “does not lose its constitutional protection merely because it is effective criticism and hence diminishes [public figures’] official reputations.” *N.Y. Times*, 376 U.S. at 273. To the contrary, the First Amendment “has its fullest and most urgent application” to speech concerning public officials. *Monitor Patriot Co. v. Roy*, 401 U.S. 265, 272 (1971). Laws suppressing the right “to praise or criticize governmental

agents” generally cannot be squared with the First Amendment. *Mills*, 384 U.S. at 219.

The government appears to recognize that the section 2(c) restriction implicates First Amendment interests but contends that these interests are outweighed by the government’s substantial interest in protecting state-law privacy and publicity rights, grounded in tort and unfair competition law. Those interests are defined in the relevant Restatements. The Restatement (Second) of Torts defines the tort of “Appropriation of Name or Likeness,” as actionable when a tortfeasor “appropriates to his own use or benefit the name or likeness of another.” Restatement (Second) of Torts § 652C (1977). The comments elaborate that the right, thought to be “in the nature of a property right,” protects the “interest of the individual in the exclusive use of his own identity, in so far as it is represented by his name or likeness.” *Id.* at cmt. a. Recovery for appropriation also serves to “protect[] [an individual’s] personal feelings against mental distress.” *Id.*

The Restatement (Third) of Unfair Competition recognizes a separate cause of action that protects an individual’s publicity rights. An unfair competition claim arises when a party “appropriates the commercial value of a person’s identity by using without consent the person’s name, likeness, or other indicia of identity for purposes of trade.” Restatement (Third) of Unfair Competition § 46 (1995).

The question here is whether the government has an interest in limiting speech on privacy or publicity grounds if that speech involves criticism of government officials—speech that is otherwise at the heart of the First Amendment.

## IV

We consider first the claimed right of privacy. Here, there can be no plausible claim that President Trump enjoys a right of privacy protecting him from criticism in the absence of actual malice—the publication of false information “with knowledge of its falsity or in reckless disregard of the truth.” *Time, Inc. v. Hill*, 385 U.S. 374, 388 (1967). The government cites no case authority or treatise that recognizes such an interest, and there is no claim here of actual malice. In such circumstances, when the restricted speech comments on or criticizes public officials, the government has no interest in disadvantaging the speech to protect the individual’s privacy interests. This recognition goes back to the very origin of the right of privacy, as recognized by the Supreme Court in *Bartnicki v. Vopper*:

As Warren and Brandeis stated in their classic law review article: ‘The right of privacy does not prohibit any publication of matter which is of public or general interest.’

532 U.S. 514, 534 (2001) (quoting Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 Harv. L. Rev. 193, 214 (1890)).

In *Time*, the Supreme Court considered a New York privacy statute that permitted monetary recovery for “[a]ny person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade without [] written consent,” a provision quite similar in some respects to section 2(c) of the Lanham Act. 385 U.S. at 376 n.1. A private individual sued Life Magazine after it published a story that falsely equated a play’s plot with his family’s experience of be-

ing held hostage by convicts in their suburban home. *Id.* at 378-79. The Court held that absent proof of actual malice, “constitutional protections for speech and press preclude[d]” recovery under the statute for “false reports of matters of public interest.” *Id.* at 387-88.

The majority in *Bartnicki* later understood *Time* as requiring that “privacy concerns give way when balanced against the interest in publishing matters of public importance.” 532 U.S. at 534. Those privacy concerns similarly must give way when the speech at issue references a public figure because public figures subject themselves to “greater public scrutiny and ha[ve] a lesser interest in privacy than an individual engaged in purely private affairs.” *Id.* at 539 (Breyer, J., concurring); *see also id.* at 534 (majority opinion) (“One of the costs associated with participation in public affairs is an attendant loss of privacy.”). With respect to privacy, the government has no legitimate interest in protecting the privacy of President Trump, “the least private name in American life,” Appellant’s Br. 35, from any injury to his “personal feelings” caused by the political criticism that Elster’s mark advances.

## V

The asserted interest in protecting the right of publicity is more complex. The government, of course, has an interest in protecting against copying or misappropriation of an existing mark, just as it has an interest in preventing misappropriation of other forms of intellectual property. In *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522, 526 (1987), a case not cited in either party’s briefs, the Supreme Court considered the constitutionality of a statute that granted the United States Olympic Committee (“USOC”)

“the right to prohibit certain commercial and promotional uses of the word ‘Olympic’ and various Olympic symbols.” The USOC sought to enjoin a nonprofit’s use of “Gay Olympic Games” on letterheads and mailings used to promote a nine-day athletic event, as well as on T-shirts and other merchandise sold promoting the games. *Id.* at 525. The nonprofit urged that its use of “Gay Olympic Games” was protected First Amendment expression. *Id.* at 531-32. Focusing on the fact that the nonprofit’s use of the word Olympic “sought to exploit [the word’s] ‘commercial magnetism’” and that the “image [the nonprofit] sought to invoke was exactly the image” the USOC “carefully cultivated,” the Court held that it was valid for Congress to determine that these “unauthorized uses, even if not confusing, nevertheless may harm the USOC by lessening the distinctiveness and thus the commercial value of the mark,” such that the statute was consistent with the First Amendment. *Id.* at 539-41. The holding did not address whether the statute could validly prohibit speech critical of the Olympics, and in dicta suggested that it was not “clear that [the statute] restricts purely expressive uses of the word.” *Id.* at 536.

No similar claim is made here that President Trump’s name is being misappropriated in a manner that exploits his commercial interests or dilutes the commercial value of his name, an existing trademark, or some other form of intellectual property. *See also Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 575-76 (1977) (holding that state law consistent with the First Amendment can create tort liability for appropriating an individual’s performance rights).

The government, in protecting the right of publicity, also has an interest in preventing the issuance of marks that falsely suggest that an individual, including the President, has endorsed a particular product or service.<sup>1</sup> But that is not the situation here. No plausible claim could be or has been made that the disputed mark suggests that President Trump has endorsed Elster's product. In any event, trademarks inaccurately suggesting endorsement in a manner that infringes the "right of privacy, or the related right of publicity" are already barred by section 2(a) of the Lanham Act,<sup>2</sup> a provision not invoked on appeal.<sup>3</sup> See, e.g., *Bridgestone/Firestone Rsch., Inc. v. Auto. Club de l'Ouest de la Fr.*, 245 F.3d 1359, 1363 (Fed. Cir. 2001) ("This protection of rights of personal privacy and publicity distinguishes

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<sup>1</sup> This concern is also borne out by debates on section 2(c) evincing Congress's desire to prevent the use of presidential names to promote unsavory or other commercial products. See, e.g., *Hearings on H.R. 9041 Before the Subcomm. on Trademarks of the House Comm. on Patents*, 75th Cong. 79 (1938) (statement of Rep. Lanham) ("I do not believe that George Washington should have his name bandied around on every commonplace article that is in ordinary use, because I think we have better ways of preserving the name and the fame of George Washington than in that manner."); *Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents*, 76th Cong. 18-19 (1939) (statement of Rep. Rogers) ("I quite agree that Abraham Lincoln gin ought not to be used, but I would not say the use of G. Washington on coffee should not be permissible.").

<sup>2</sup> As stated previously, section 2(a)'s false association clause bars registration of trademarks that "falsely suggest a connection with persons, living or dead." § 1052(a).

<sup>3</sup> We note that the Board did not address the examiner's rejection of Elster's proposed mark on section 2(a) grounds, and the government on appeal similarly did not raise section 2(a) as an alternative basis for affirming the Board's decision.

the § 2(a) false suggestion of connection provision from the § 2(d) likelihood of confusion provision.”); *Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1376 (Fed. Cir. 1983) (“[Section] 2(a) was intended to preclude registration of a mark which conflicted with another’s rights, even though not founded on the familiar test of likelihood of confusion.”).

The right of publicity does not support a government restriction on the use of a mark because the mark is critical of a public official without his or her consent. The Restatement of Unfair Competition recognizes that challenges under state-law publicity statutes are “fundamentally constrained by the public and constitutional interest in freedom of expression,” such that the “use of a person’s identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person’s right of publicity.” Restatement (Third) of Unfair Competition § 47 cmt. c.

Thus, for example, the Tenth Circuit held that parody baseball trading cards, including cards “featuring caricatures of political and sports figures” accompanied by “humorous commentary about their careers,” constituted protected speech. *Cardtoons*, 95 F.3d at 962, 972. Although the cards appropriated the commercial value of the players’ names and likenesses without their consent, the card producer had a “countervailing First Amendment right to publish the cards” because the use of parody “provide[d] social commentary on public figures,” “an especially valuable means of expression.” *Id.* at 968-69, 972.

[C]elebrities with control over the parodic use of their identities would not use the power to ‘ration the



use of their names in order to maximize their value over time[.]’ . . . They would instead use that power to suppress criticism, and thus permanently remove a valuable source of information about their identity from the marketplace.

*Id.* at 975.

The California Supreme Court similarly concluded that there is no right to restrict dissemination of a public figure’s likeness when the publication is intertwined with parody or critical speech:

[T]he right of publicity cannot, consistent with the First Amendment, be a right to control the celebrity’s image by censoring disagreeable portrayals. Once the celebrity thrusts himself or herself forward into the limelight, the First Amendment dictates that the right to comment on, parody, lampoon, and make other expressive uses of the celebrity image must be given broad scope.

*Comedy III*, 21 P.3d at 807;<sup>4</sup> see also *Titan Sports, Inc v. Comics World Corp.*, 870 F.2d 85, 88 (2d Cir. 1989) (“[A] court must be ever mindful of the inherent tension between the protection of an individual’s right to control the use of his likeness and the constitutional guarantee of free dissemination of ideas, images, and newsworthy matter in whatever form it takes.”); *ETW Corp. v. Jireh Pub., Inc.*, 332 F.3d 915, 938 (6th Cir. 2003) (holding prints of Tiger Woods reflecting his likeness constituted protected, creative expression in the face of a right of

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<sup>4</sup> The court ultimately allowed the plaintiff to recover on its right of publicity claim because the disputed T-shirt created a “literal, conventional depiction[] of The Three Stooges so as to exploit their fame.” *Comedy III*, 21 P.3d at 811.

publicity challenge); *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 170 (3d Cir. 2013) (finding use of a football player’s photo in a video game that “imbue[d] the image with additional meaning beyond simply being a representation of a player,” was “shielded by the First Amendment”). New York courts have also recognized judicial exceptions to the state’s right of publicity statute for “newsworthy events or matters of public interest,” “works of humor,” “art,” “fiction, and satire.” *Lohan v. Take-Two Interactive Software, Inc.*, 97 N.E.3d 389, 393 (N.Y. 2018).

The right of publicity is particularly constrained when speech critical of a public official is involved. The Restatement specifically notes that the right of publicity would be unavailable to “a candidate for public office” who sought to “prohibit the distribution of posters or buttons bearing the candidate’s name or likeness, whether used to signify support or opposition.” Restatement (Third) of Unfair Competition § 47 cmt. b. Similarly, in *Paulsen v. Personality Posters, Inc.*, 299 N.Y.S.2d 501, 508-09 (Sup. Ct. 1968), a comedian who had initiated a presidential campaign could not enjoin the distribution of mocking campaign posters bearing his likeness because the poster communicated “constitutionally protected” political speech that “must supersede any private pecuniary considerations.”

The government has no valid publicity interest that could overcome the First Amendment protections afforded to the political criticism embodied in Elster’s mark. As a result of the President’s status as a public official, and because Elster’s mark communicates his disagreement with and criticism of the then-President’s

approach to governance, the government has no interest in disadvantaging Elster’s speech.

Contrary to the government’s claim that section 2(c) merely “involves a targeted effort to preclude federal registration that facilitates a particular type of commercial behavior that has already been banned by most states,” Gov’t Br. 1, our review of state-law cases revealed no authority holding that public officials may restrict expressive speech to vindicate their publicity rights, and the government cites no such cases. In fact, every authority that the government cites reaches precisely the opposite conclusion, recognizing that the right of publicity cannot shield public figures from criticism. *See generally* 1 J. Thomas McCarthy, *The Rights of Publicity & Privacy* § 2:4 (2d ed. 2020) (“Every personal and property right must peacefully co-exist within the confines of the free speech policies of the First Amendment.”).<sup>5</sup>

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<sup>5</sup> The one case the government cites involving parody or criticism of public figures held that a parody baseball card producer’s use of MLB players’ names and likenesses was not actionable under a right of publicity statute. *See Cardtoons*, 95 F.3d 959.

Most of the cases the government cites upholding the right of publicity involve a routine use of a public figure’s name or likeness to promote a product or the misappropriation of the commercial value of their identity. *Zacchini*, 433 U.S. 562 (broadcaster airing human cannonball performer’s entire act); *Jordan v. Jewel Food Stores, Inc.*, 743 F.3d 509 (7th Cir. 2014) (advertisement incorporating Michael Jordan’s name to promote grocery store); *Hart*, 717 F.3d 141, (video game using college football players’ photos and likenesses); *Bridgestone*, 245 F.3d 1359 (tire manufacturer using French brand name on tires); *Bi-Rite Enters., Inc. v. Bruce Miner Co.*, 757 F.2d 440 (1st Cir. 1985) (posters depicting British rock group); *Carson v. Here’s Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir.

In short, whether we apply strict scrutiny and the compelling government interest test, or *Central Hudson*'s intermediate scrutiny and the substantial government interest test, “the outcome is the same.” *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 571 (2011). The PTO’s refusal to register Elster’s mark cannot be sustained 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.

## VI

As Elster raised only an as-applied challenge before this court, *see, e.g.*, Appellant’s Br. 4; Oral Arg. 5:09-5:14, we have no occasion to decide whether the statute is constitutionally overbroad. We note, however, that section 2(c) raises concerns regarding overbreadth.

The First Amendment overbreadth doctrine recognizes that “a law may be overturned as impermissibly overbroad” when “a ‘substantial number’ of its applications are unconstitutional, ‘judged in relation to the statute’s plainly legitimate sweep.’” *Wash. State Grange v. Wash. State Republican Party*, 552 U.S. 442, 449 n.6 (2008) (internal quotation marks omitted) (quoting *New York v. Ferber*, 458 U.S. 747, 769-71 (1982)). It may be that a substantial number of section 2(c)’s applications

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1983) (toilet manufacturer incorporating entertainer’s “here’s Johnny” catchphrase); *Univ. of Notre Dame Du Lac*, 703 F.2d 1372 (cheese importer using same brand name as university); *Haelan Lab’ys, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866 (2d Cir. 1953) (chewing-gum producer using athlete’s photo to promote product); *Kimbrough v. Coca-Cola/USA*, 521 S.W.2d 719 (Tex. Civ. App. 1975) (Coca-Cola advertisement using football player’s photo).

would be unconstitutional. The statute leaves the PTO no discretion to exempt trademarks that advance parody, criticism, commentary on matters of public importance, artistic transformation, or any other First Amendment interests. It effectively grants all public figures the power to restrict trademarks constituting First Amendment expression before they occur.<sup>6</sup> In *Tam*, Justice Alito, joined by three other Justices, characterized as “far too broad” a statute that would bar the trademark “James Buchanan was a disastrous president.” 137 S. Ct. at 1765 (Alito, J.). Nonetheless, we reserve the overbreadth issue for another day.

#### CONCLUSION

For the foregoing reasons, we hold that the Board’s application of section 2(c) to Elster’s mark is unconstitutional under any conceivable standard of review, and accordingly reverse the Board’s decision that Elster’s mark is unregistrable.

#### REVERSED

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<sup>6</sup> As interpreted by the PTO, section 2(c) has limited application to private individuals because it requires consent only if: “(1) the person is so well known that the public would reasonably assume a connection between the person and the goods or services; or (2) the individual is publicly connected with the business in which the mark is used.” *In re ADCO Indus. Techs., L.P.*, 2020 U.S.P.Q.2d 53786, 2020 WL 730361, at \*10 (T.T.A.B. 2020).

**APPENDIX B**

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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*In re Steve Elster*

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Serial No. 87749230

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Mailed: July 2, 2020

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Before ROGERS, Chief Administrative Trademark Judge, and ZERVAS and LYNCH, Administrative Trademark Judges.

Opinion by LYNCH, Administrative Trademark Judge:

**I. Background**

Steve Elster (“Applicant”) seeks registration on the Principal Register of the mark TRUMP TOO SMALL, in standard characters, for:

Shirts; Shirts and short-sleeved shirts; Graphic T-shirts; Long-sleeved shirts; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; T-shirts; Tee shirts; Tee-shirts; Wearable garments and clothing, namely, shirts in International Class 25.<sup>1</sup>

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<sup>1</sup> Application Serial No. 87749230 has a filing date of January 10, 2018, and is based on Applicant’s assertion of a bona fide intent to

The Examining Attorney refused registration of Applicant's proposed mark under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), on the ground that it comprises matter that may falsely suggest a connection with President Donald J. Trump, and under Section 2(c), 15 U.S.C. § 1052(c), on the ground that it comprises his name without his written consent. Applicant has appealed, and the appeal has been fully briefed.<sup>2</sup>

We affirm the Section 2(c) refusal, as explained below, and we need not reach the refusal under Section 2(a)'s false association clause. *See In re Society of Health and Physical Educators*, 127 USPQ2d 1584, 1590 (TTAB 2018).

## II. Section 2(c) Refusal

Section 2(c) of the Trademark Act precludes, in relevant part, 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.” 15 U.S.C. § 1052(c). “A key purpose of requiring the consent of a living individual to the registration of his or her name, signature, or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them.” *In re ADCO Indus. Techs., L.P.*, 2020 USPQ2d 53786, \*20 (TTAB

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use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

<sup>2</sup> The record includes Applicant's original Brief, 11 TTABVUE, a Supplemental Brief, 16 TTABVUE, submitted following a remand sought by the Examining Attorney to add an additional ground for refusal (the refusal under Section 2(a)), the Examining Attorney's Brief, 19 TTABVUE, and Applicant's Reply Brief, 20 TTABVUE.

2020) (citations omitted). Another is to “protect[] consumers against source deception.” *Id.* at \*29.

For names, the statute requires that the matter sought to be registered include the name of a particular living individual, rather than merely include words that only by coincidence happen to be someone’s name but which the relevant public generally would not recognize as that living individual’s name. *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931, 933 (TTAB 1979). To address the scenario in which the name would not be recognized as identifying the individual, Section 2(c) has been interpreted to mean that when a name appears in a proposed mark, the written consent of the person with that name must be supplied where: (1) the public would reasonably assume a connection between the individual and the goods or services because the individual is so well known; or (2) the individual is publicly connected with the business in which the mark is used. *ADCO*, 2020 USPQ2d 53786 at \*22; *see also Martin v. Carter Hawley Hale Stores*, 206 USPQ at 932-33 (“requirement for consent depends upon a determination of whether the mark would be recognized and understood by the public as identifying the person”).

Thus, for example, although the mark[s] “FANTA” and “ARNOLD BRAND” happened to be the names of individuals [i.e., Robert D. Fanta, a tax accountant, who sought to cancel registrations of the mark “FANTA” for soft drinks and for carbonated soft drink and syrup concentrate for making the same, and Arnold Brand, a patent and trademark attorney active in civic affairs, who sought to cancel a registration of a mark containing the words “ARNOLD BRAND” for fresh tomatoes] who were undoubtedly



well known in their own spheres, nevertheless, in each case, it was found that the individual in question would not be likely to suffer any damage from the registration of the mark at issue because he had never attained any recognition in the field of business in which the mark was used.

*Id.* at 933 (footnotes omitted) (citing *Fanta v. The Coca-Cola Co.*, 140 USPQ 674 (TTAB 1964) and *Brand v. Fairchester Packing Co.*, 84 USPQ 97 (Comm’r Pat. 1950)).

It is undisputed in this case, and we find, that Applicant’s proposed mark includes the surname of President Donald J. Trump. Section 2(c) applies to a proposed mark that includes a particular living individual’s surname if the individual is known by that surname alone. *In re Hoefflin*, 97 USPQ2d 1174, 1176 (TTAB 2010) ((holding registration of the marks OBAMA PAJAMA and OBAMA BAHAMA PAJAMAS barred under Section 2(c) because “this statutory sub-section operates to bar the registration of marks containing not only full names, but also surnames . . . so long as the name in question does, in fact, ‘identify’ a particular living individual”); *see also In re Nieves & Nieves LLC*, 113 USPQ2d 1629, 1638 (TTAB 2015) (relevant inquiry is “whether the public would recognize and understand the mark as identifying a particular living individual”). The record in this case includes extensive evidence that the public understands “Trump” alone as a reference to President Donald Trump.<sup>3</sup> Significantly, Applicant

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<sup>3</sup> E.g., February 19, 2018 Office Action at 6-7; July 30, 2018 Office Action at 57, 65, 67-130; February 25, 2019 Office Action at 5, 11, 24, 31, 54, 57, 59, 61, 63, 65, 69, 71-74; June 24, 2019 Office Action at 17, 25, 32, 41, 51, 116-42.

clearly concedes that his mark “explicitly refers to declared presidential candidate and President Donald Trump.”<sup>4</sup> The application record does not include a written consent from President Trump, and Applicant makes no argument to the contrary.

Despite Applicant’s direct acknowledgment that his mark includes a name that identifies a particular living individual without his consent, Applicant contends that his mark does not violate Section 2(c) because the relevant public would not presume a connection between President Trump and the goods. According to Applicant, given “how [Donald Trump] depicts himself generally,” the mark in its entirety is “the antithesis of what consumers would understand to be sponsored by, approved by, or supported by Donald Trump.”<sup>5</sup> Applicant essentially argues that while President Trump strives to make a grandiose impression, Applicant’s mark as a whole conveys that some features of President Trump and his policies are diminutive.<sup>6</sup> Therefore, Applicant maintains that his mark lacks the necessary connection to the goods under Section 2(c).

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<sup>4</sup> 16 TTABVUE 7 (Applicant’s Supplemental Brief).

<sup>5</sup> 16 TTABVUE 20 (Applicant’s Supplemental Brief).

<sup>6</sup> Both Applicant and the Examining Attorney discuss and offer evidence that the 2016 presidential campaign included some widely publicized colloquies, some of which Mr. Trump participated in, about the size of certain parts of his anatomy, such as his hands, which then-presidential candidate Marco Rubio asserted were too small. July 8, 2018 Response to Office Action at 8-24; February 25, 2019 Office Action at 5-7, 24-27. Applicant also submitted evidence of media articles about President Trump’s policies in terms of small size, with headlines such as “The Shrinking of America” and “Trump Orders Largest National Monument Reduction in U.S. History.” *Id.* at 26, 31.

Applicant couches the public perception of a connection as a separate inquiry under Section 2(c), but as noted above, the analysis of a connection under the test set forth above regarding Section 2(c) really is just part of determining whether the public would perceive the name in the proposed mark as identifying a particular living individual. In this case, Applicant already has conceded this point. Unlike Section 2(a)'s explicit statutory requirement that the matter in question "falsely suggest a connection," Section 2(c) prohibits registration of any proposed mark that "consists of or comprises a name . . . identifying a particular living individual except by his written consent." 15 U.S.C. §§ 1052(a) & (c). The prohibition applies regardless of whether there is a suggested connection. As explained in *Martin v. Carter Hawley Hale Stores*, 206 USPQ at 933:

[I]t is more than likely that any trademark which is comprised of a given name and surname will, in fact, be the name of a real person. But that coincidence, in and of itself, does not give rise to damage to that individual in the absence of other factors from which it may be determined that the particular individual bearing the name in question will be associated with the mark as used on the goods, either because that person is so well known that the public would reasonably assume the connection or because the individual is publicly connected with the business in which the mark is used.

By analogy, the Board in *Hoefflin* held that an application to register OBAMA PAJAMA for pajamas, sleepwear and underwear was barred by Section 2(c) even if "the record does not support the conclusion that President Obama is in any way connected with [such goods]."

97 USPQ2d at 1177. The Board addressed the fame of a President of the United States, stating that “well-known individuals such as celebrities and world-famous political figures are entitled to the protection of Section 2(c) without having to evidence a connection with the involved goods or services.” *Id.* The evidentiary record in this case clearly shows that President Trump is extremely well known, not only because of his political office but also because of his prior celebrity.<sup>7</sup> Moreover, even if some further connection to the types of goods identified need be shown, the record reflects that through business enterprises, President Trump’s surname has been used as a brand on a wide variety of goods, including shirts.<sup>8</sup>

With a proposed mark such as this one that names someone very well-known such as President Trump, and as Applicant has admitted, there is no question that the public would view the name in question as the name of a particular living individual. As in *ADCO*, decided on a very similar evidentiary record to the one in this case, we find that the proposed mark including TRUMP “identif[ies] Donald Trump, whose identity is renowned. By any measure, . . . Donald Trump is a well-known political figure and a celebrity.” *ADCO*, 2020 USPQ2d 53786 at \*24. Thus, the necessary connection for pur-

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<sup>7</sup> February 19, 2018 Office Action at 45-64 (Time Magazine 2016 Person of the Year); July 30, 2018 Office Action at 51-52 (CBS Los Angeles article about altercation at Donald Trump’s Walk of Fame Star); *id.* at 65-133 (various articles in mainstream media about Donald Trump); June 24, 2019 Office Action at 9-144 (various articles in mainstream media about Donald Trump).

<sup>8</sup> February 19, 2018 Office Action at 14-16, 65, 76; February 25, 2019 Office Action at 52; June 24, 2019 Office Action at 145-99; October 7, 2019 Office Action at 5-50.

poses of Section 2(c) exists. Accordingly, in applying Section 2(c) in this case, we need not probe for a Section 2(a)-type connection as Applicant suggests, but rather just a showing that the relevant public would recognize the name in the mark as that of a particular living individual. Therefore, we reject Applicant's contention that under Section 2(c) a "connection" is necessary, but is foreclosed based on the theory that President Trump would not endorse the message allegedly conveyed by TRUMP TOO SMALL.

### III. Constitutional Challenge to Section 2(c)

Applicant's appeal focuses primarily on assertions that the statutory refusals to register applied in this case are unconstitutional because they violate his right to free speech under the First Amendment. Applicant alleges that Section 2(a)'s false association provision and Section 2(c)'s particular living individual provision constitute content-based restrictions on private speech, subject to strict scrutiny. According to Applicant, the prohibitions are not narrowly tailored to a compelling state interest, and cannot be justified, in particular when applied to current or former presidents, or presidential candidates, whom Applicant claims have yielded rights of privacy and publicity by seeking the office. Applicant insists that "Presidential candidates and current and former Presidents also invite widespread use of their names and identities in products and services that comment upon the candidates and Presidents in personal and/or political terms."<sup>9</sup>

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<sup>9</sup> 16 TTABVUE at 21.

The recent *ADCO* case on proposed marks that included TRUMP<sup>10</sup> involved similar constitutionality challenges to Section 2(c) and Section 2(a)'s false association provision. *ADCO Indus.-Techs.*, 2020 USPQ2d 53786 at \*25. The Board in *ADCO* stated that regardless of the USPTO's inability to strike down statutory provisions as unconstitutional, "a constitutional challenge may involve 'many threshold questions . . . to which the [agency] can apply its expertise.'" *Id.* at \*26 (citing *Elgin v. Dep't of Treasury*, 567 U.S. 1, 16, 22-23, 132 S. Ct. 2126 (2012)). Accordingly, the Board explained why it does "not agree with Applicant's challenges based on our experience with Section 2 of the Trademark Act and the purposes underlying it." *ADCO Indus.-Techs.*, 2020 USPQ2d 53786 at \*27 (citations omitted).

As a threshold matter, the Board pointed out that these provisions of the Trademark Act do not control an applicant's use of a proposed mark, but only set criteria for trademark registration. *Id.* Therefore, contrary to Applicant's assertions, Sections 2(a) and 2(c) are not direct restrictions on speech. *Id.* Next, the Board addressed the viewpoint-neutrality of Section 2(a)'s false association clause and Section 2(c), thereby distinguishing them from Section 2(a)'s disparagement and immoral/scandalous provisions struck down by the Supreme Court as viewpoint-discriminatory. *Id.* ("the

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<sup>10</sup> The marks at issue in *ADCO* were



and

Supreme Court pointedly refrained from extending its holdings to any provisions of the Lanham Act that do not discriminate based on the applicant’s viewpoint”), *citing Iancu v. Brunetti*, 139 S. Ct. 2294, 2019 USPQ2d 232043 at \*7, n.\*(2019) (addressing immoral/scandalous clause of Section 2(a), noting “Nor do we say anything about how to evaluate viewpoint-neutral restrictions on trademark registration.”) and *id.* at 2303 (Alito, J., concurring) (emphasizing that the Court’s holding turned entirely on the conclusion that the invalidated provision was viewpoint discriminatory); *see also Matal v. Tam*, 137 S. Ct. 1744, 122 USPQ2d 1757 (2017) (addressing disparagement clause of Section 2(a)). As the *Brunetti* Court characterized the holding in *Tam*, “all Members of the Court agreed that the [disparagement] provision violated the First Amendment because it discriminated on the basis of viewpoint.” *Brunetti*, 2019 USPQ2d 232043 at \*2. Similarly, the *Brunetti* Court held that the immoral/scandalous provision “infringes the First Amendment for the same reason: It too disfavors certain ideas.” *Id.* Clearly, Section 2(c) differs, in that the prohibition applies in an objective, straightforward way to any proposed mark that consists of or comprises the name of a particular living individual, regardless of the viewpoint conveyed by the proposed mark.

Finally, the Board in ADCO opined that even if the challenged provisions of Section 2(a) and Section 2(c) were considered as restrictions on speech, they do not run afoul of the First Amendment because “Congress acts well within its authority when it identifies certain types of source-identifiers as being particularly susceptible to deceptive use and enacts restrictions concerning them.” *ADCO Indus.-Techs.*, 2020 USPQ2d 53786 at \*29 (citation omitted), *citing S.F. Arts & Athletics, Inc.*

*v. U.S. Olympic Comm.*, 483 U.S. 522, 107 S. Ct. 2971, 3 USPQ2d 1145, 1153 (1987) (“Congress reasonably could conclude that most commercial uses of the Olympic words and symbols are likely to be confusing.”). Both of the statutory provisions at issue “recognize[] the right of privacy and publicity that a living person has in his or her identity and protect[] consumers against source deception.” *ADCO Indus.-Techs.*, 2020 USPQ2d 53786 at \*29.

Thus, even if Section 2(c) were subject to greater scrutiny, as Applicant alleges, the statutory provision is narrowly tailored to accomplish these purposes, and consistently and reliably applies to any mark that consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.

**Decision:** We affirm the refusal to register the proposed mark under Section 2(c) on the ground that it comprises the name of President Donald Trump without his written consent. We do not reach the refusal to register under Section 2(a)’s false association clause.



APPENDIX C

UNITED STATES PATENT AND TRADEMARK  
OFFICE (USPTO)

OFFICE ACTION (OFFICIAL LETTER)  
ABOUT APPLICANT'S TRADEMARK APPLICATION

U.S. Application Serial No. 87749230

Mark: TRUMP TOO SMALL

\* \* \* \* \*

Applicant: Elster, Steve

\* \* \* \* \*

FINAL OFFICE ACTION

\* \* \* \* \*

Issue date: October 07, 2019

On June 3, 2019, the Trademark Trial and Appeal Board (Board) suspended applicant's appeal and remanded the application to the trademark examining attorney for further examination. Subsequently, the trademark examining attorney issued a new non-final Office action on June 24, 2019, refusing registration pursuant to Trademark Act Section 2(a) because the applied-for mark consists of or includes matter which may falsely suggest a connection with Donald Trump ("false connection" refusal), requesting information regarding the relationship between the applicant and President Trump, and maintaining all the issues in the final Office action. On September 9, 2019, applicant

filed a response addressing the Section 2(a) refusal and the information request.

Based on applicant's response, the requirement for information regarding the relationship between applicant and person named in mark has been **SATISFIED**. *See* TMEP §§713.02, 714.04.

With respect to the Section 2(a) "false connection" refusal, the trademark examining attorney has carefully reviewed applicant's most recent response. In the response, applicant addresses the new refusal by stating that the refusal to register a mark that may falsely suggest a connection with a person, institution, belief or national symbol is a content-based regulation of private speech that does not meet strict scrutiny. However, applicant's arguments do not obviate the "false connection" refusal because (1) applicant has submitted no evidence or relevant legal basis in support of its assertions in this regard, and (2) in any event, the Trademark Trial and Appeal Board has no authority to rule on the constitutionality of the Trademark Act.

Applicant contends that (1) the "false connection" refusal under Trademark Act Section 2(a) is a content-based regulation of private speech that is subject to strict scrutiny, (2) the government must prove that the "false connection" refusal satisfies strict scrutiny, and (3) the government has not met its burden of proof. Response of September 9, 2019 at 3-4. These arguments are unpersuasive.

Applicant cites *Matal v. Tam*<sup>[1]</sup>, *Reed v. Town of Gilbert*<sup>[2]</sup>, and *United States v. Alvarez*<sup>[3]</sup> in support of its assertions regarding the constitutionality of the “false connection” refusal. The cited opinions, however, are distinguishable on their facts and applicant’s reliance thereon is misplaced.<sup>[4]</sup> Indeed, Justice Kennedy’s opinion in *Matal v. Tam* expressly states that “[t]his case does not present the question of how other provisions of the Lanham Act should be analyzed under the First Amendment.” 137 S. Ct. at 1768.

Without any relevant legal basis to support them, applicant’s arguments regarding the constitutionality of the “false connection” provision of Section 2(a) amount to little more than unsubstantiated rhetoric. See *In re Simulations Publications, Inc.*, 521 F.2d 797, 187 USPQ 147, 148 (CCPA 1975) (assertions in briefs are not evidence); *In re Vesoyuzny Ordena Trudovogo Krasnogo Znameni*, 219 USPQ 69, 70 (TTAB 1983) (assertions in

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<sup>1</sup> *Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>2</sup> *Reed v. Town of Gilbert*, 135 S. Ct. 2218 (2015).

<sup>3</sup> *United States v. Alvarez*, 132 S. Ct. 2537 (2012).

<sup>4</sup> See *Matal v. Tam*, 137 S. Ct. at 1757-1767 (invalidating in a plurality opinion the Lanham Act’s bar on the registrability of “disparag[ing]” trademarks under Section 2(a), holding that the provision violated the First Amendment because it discriminates on the basis of viewpoint); *Reed v. Town of Gilbert*, 135 S. Ct. 2218 (holding provisions of a town’s sign code, which imposed more stringent restrictions on signs directing the public to a meeting of a nonprofit group than it did on signs conveying other messages, were content-based regulations of speech because the restrictions in the sign code that applied to any given sign depended entirely on the communicative content of the sign); *United States v. Alvarez*, 132 S. Ct. 2537 (holding that the Stolen Valor Act, which makes it a crime to falsely claim receipt of military decorations or medals, infringes upon speech protected by the First Amendment).

briefs are not evidence); *see also* *Cai v. Diamond Hong, Inc.* 901 F.3d 1367, 1371 (Fed. Cir. 2018) (citing *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 424 F.3d 1276, 1285 (Fed. Cir. 2005) (“Attorney argument is no substitute for evidence”)); *Galen Med. Assocs., Inc. v. United States*, 369 F.3d 1324, 1339 (Fed. Cir. 2004) (“Statements of counsel, however, are not evidence.”).

Although applicant’s response is directed virtually entirely to the constitutionality of the “false connection” provision of Trademark Act Section 2(a), the Trademark Trial and Appeal Board is an administrative tribunal, not an Article III court, and is empowered to determine only the right to register a mark. TBMP §102.01 (citing Trademark Act Section 17, 15 U.S.C. §1067; Trademark Act Section 18, 15 U.S.C. §1068; Trademark Act Section 20, 15 U.S.C. §1070; Trademark Act Section 24, 15 U.S.C. §1092). As such, the Board has no authority to declare provisions of the Trademark Act unconstitutional. *In re District of Columbia*, 101 USPQ2d 1588, 1602 (TTAB 2012 (no authority to declare provisions of the Trademark Act unconstitutional), *aff’d sub nom*, *In re City of Houston*, 731 F.3d 1326, 108 USPQ2d 1226 (Fed. Cir. 2013); *Blackhorse v. Pro-Football Inc.*, 98 USPQ2d 1633, 1638 (TTAB 2011 (no authority to rule on the constitutionality of the Trademark Act on its face or as applied); *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1710 (TTAB 1999) (no authority to declare provisions of the Trademark Act unconstitutional or to determine whether Trademark Act 2(a) is overbroad or vague), *rev’d on other grounds*, 284 F. Supp. 96, 68 USPQ2d 1225 (D.D.C. 2003).

In the present case, the evidentiary record aptly demonstrates the fame of President Trump and the wide

variety of goods in the marketplace that bear the TRUMP mark. *See also, e.g.:*

Trump Store

<https://www.trumpstore.com/collections/headwear>

<https://www.trumpstore.com/collections/women>

<https://www.trumpstore.com/collections/home>

<https://www.trumpstore.com/collections/home-bath-body>

<https://www.trumpstore.com/collections/home-luggage-travel>

<https://www.trumpstore.com/collections/trump-golf-headcovers>

<https://www.trumpstore.com/collections/trump-golf-towels-pin-flags>

<https://www.trumpstore.com/collections/trump-golf-accessories>

<https://www.trumpstore.com/collections/on-the-go>

If applicant's goods are of a type that the named person or institution sells or uses, and the named party is sufficiently famous, then it may be inferred that purchasers of the goods would be misled into making a false connection of sponsorship, approval, support or the like with the named party. *See, e.g., In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1647-48 (TTAB 2015) (holding ROYAL KATE used with applicant's consumer products, including fashion products, suggested a connection with Kate Middleton would be inferred because evidence showed that Kate Middleton, by virtue of being the wife of Prince William of the British Royal family, has become a celebrity and fashion trend-setter the me-

dia reports on, including the clothes she wears, what she does, and what she buys); *In re Cotter & Co.*, 228 USPQ 202, 204-05 (TTAB 1985) (holding WESTPOINT used with applicant's firearms suggested sponsorship, approval, support or the like from West Point because evidence showed that West Point is a well-known U.S. Military Academy). Here, the record is replete with evidence demonstrating that President Trump sells clothing under the TRUMP mark.

Moreover, applicant's response indicates that applicant does intend to trade upon the goodwill of Donald Trump. Specifically, applicant admits that the applied-for mark references "presidential candidate and president Donald Trump." Response at 1. Indeed, it is difficult to imagine any other purpose for using the name "TRUMP" on apparel except to draw the connection between President Trump and applicant's products. While intent to identify a party or trade on its goodwill is not a required element of a §2(a) claim of false suggestion of an association with such a party, the Board has held that evidence of such intent is highly probative that the public would make the intended false association. *Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1377 (Fed. Cir. 1983); TMEP §1203.03(c)(i).

The evidence of record establishes that Donald Trump is a famous political figure by virtue of who he is, namely, the President of the United States. In view of the fame of President Trump and the vast array of goods bearing the TRUMP mark to which consumers are exposed in the marketplace, a connection with the President would be presumed when applied-for mark TRUMP TOO SMALL is used on applicant's goods.

For all of the foregoing reasons, and those submitted in the previous Office action (incorporated herein by reference), all four of the relevant factors weigh in favor of finding that the applied-for mark consists of or include matter which may falsely suggest a connection with Donald Trump, President of the United States. Accordingly, the refusal pursuant to Trademark Act Section 2(a) is maintained and now made **FINAL**.

In addition, applicant's response does not resolve the other issues in final status because applicant, in responding to the "false connection" refusal, has merely provided arguments and analysis that were raised previously. Therefore, the Section 2(c) refusal raised in the final Office action that issued on July 30, 2018 remains outstanding.

Because applicant's response does not resolve all outstanding refusals nor otherwise put the application in condition for publication or registration, the trademark examining attorney is holding the following issues final, including the Section 2(a) "false connection" refusal raised in the previous Office action dated June 24, 2019. *See* 37 C.F.R. §§2.63(b), 2.142(d); TMEP §715.04(b).

The following issues are in final status:

- Section 2(a) refusal – False Suggestion of an Association
- Section 2(c) refusal – Name Identifying a Particular Living Individual

The Board has been notified to resume the appeal. *See* TMEP §715.04(b).

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**APPENDIX D**

**UNITED STATES PATENT AND TRADEMARK  
OFFICE (USPTO)**

**OFFICE ACTION (OFFICIAL LETTER)  
ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO. 87749230**

**MARK: TRUMP TOO SMALL**

\* \* \* \* \*

**APPLICANT: Elster, Steve**

\* \* \* \* \*

**OFFICE ACTION**

\* \* \* \* \*

**ISSUE/MAILING DATE: 6/24/2019**

Upon further consideration, the Director has re-stored jurisdiction to the trademark examining attorney under 37 C.F.R. §2.84(a). The USPTO apologizes for any inconvenience this may cause.

**SUMMARY OF ISSUES:**

- Section 2(a) refusal – False suggestion of a connection
- Requirement for information regarding relationship between applicant and Donald Trump

**SECTION 2(a) REFUSAL – FALSE SUGGESTION OF  
A CONNECTION**

Registration is refused because the applied-for mark consists of or includes matter which may falsely suggest a connection with Donald Trump, President of the United States. Trademark Act Section 2(a), 15 U.S.C. §1052(a). Although Donald Trump is not connected with the goods provided by applicant under the applied-for mark, President Trump is so well-known that consumers would presume a connection. *See id.*

In this case, applicant seeks to register TRUMP TOO SMALL for “Shirts; Shirts and short-sleeved shirts; Graphic T-shirts; Long-sleeved shirts; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; T-shirts; Tee shirts; Tee-shirts; Wearable garments and clothing, namely, shirts.”

Under Trademark Act Section 2(a), the registration of a mark that “consists of or comprises matter that may falsely suggest a connection with persons, institutions, beliefs, or national symbols” is prohibited. *In re Pedersen*, 109 USPQ2d 1185, 1188 (TTAB 2013). To establish that an applied-for mark falsely suggests a connection with a person or an institution, the following is required:

- (1) The mark sought to be registered is the same as, or a close approximation of, the name or identity previously used by another person or institution.
- (2) The mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution.

- (3) The person or institution identified in the mark is not connected with the goods sold or services performed by applicant under the mark.
- (4) The fame or reputation of the named person or institution is of such a nature that a connection with such person or institution would be presumed when applicant's mark is used on its goods and/or services.

*In re Pedersen*, 109 USPQ2d at 1188-89; *In re Jackson Int'l Trading Co.*, 103 USPQ2d 1417, 1419 (TTAB 2012); TMEP §1203.03(c)(i); *see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1375-77, 217 USPQ 505, 508-10 (Fed. Cir. 1983) (providing foundational principles for the current four-part test used to determine the existence of a false connection).

In the present case,

- (1) The mark sought to be registered is the same as the name or identify of Donald Trump. Specifically, the word "TRUMP" in the applied-for mark identifies Donald Trump. This is supported by the evidence previously submitted in connection with the Section 2(c) refusal (incorporated by reference herein), as well as the attached Internet website evidence showing that the term "TRUMP" refers to Donald Trump. *See, e.g.:*
  - The Washington Post, *Can Trump put out the fire he started?*, [https://www.washingtonpost.com/world/2019/06/24/can-trump-put-out-fire-he-started/?utm\\_term=.4f7f2c187b30](https://www.washingtonpost.com/world/2019/06/24/can-trump-put-out-fire-he-started/?utm_term=.4f7f2c187b30)
  - CNN, *Trump escapes to Camp David after bucking aides on Iran, immigration*, <https://>

[www.cnn.com/2019/06/24/politics/donald-trump-camp-david-iran-immigration/index.html](http://www.cnn.com/2019/06/24/politics/donald-trump-camp-david-iran-immigration/index.html)

- CNBC, *Trump signs executive order slapping ‘hard-hitting’ sanctions on Iran over drone shutdown*, <https://www.cnbc.com/2019/06/24/trump-sanctions-iran-over-downed-drone.html>
- Mediaite, *Trump Refers To Himself in the Third Person While Claiming Memo ‘Totally Vindicates’ Him*, <https://www.mediaite.com/online/trump-refers-to-himself-in-the-third-person-while-claiming-memo-totally-vindicates-him/>
- The New York Times, *Will America Make Trump Great Again?*, <https://www.nytimes.com/2019/06/22/opinion/trump-2020-win.html>
- NBC, *Trump shows he remains fixated on Obama*, <https://www.nbcnews.com/politics/meet-the-press/trump-shows-he-remains-fixated-obama-n1020916>
- NPR, *Ravelry, The Knitting Website, Bans Trump Talk And Patterns*, <https://www.npr.org/2019/06/24/735460674/ravelry-the-knitting-website-bans-trump-talk-and-patterns>

In this case, the term “TRUMP” in the applied-for mark is identical to the surname of Donald Trump. Moreover, the evidence of record shows that the President is commonly referred to simply as “TRUMP” and, thus, the name “TRUMP” is synonymous with Donald Trump.

**This factor weighs in favor of finding that the applied-for mark consists of or includes matter which may falsely suggest a connection with Donald Trump.**

- (2) The proposed mark points uniquely and unmistakably to Donald Trump. Specifically, the use of Donald Trump’s surname “TRUMP”, combined with the wording “TOO SMALL”, unequivocally associates the applied-for mark with Donald Trump. Indeed, applicant has conceded that the applied-for mark as a whole refers to “Donald Trump’s refutation at the March 3, 2016 Republican debate of presidential candidate Marco Rubio’s insinuation that Donald Trump has a small penis.” Response to Office Action, filed on July 8, 2018; *see also* Request for Reconsideration, filed on January 29, 2019, at 1 (citing Donald Trump’s assurance to the American public during the March 3, 2016 Republican primary debate: “He [meaning then-candidate Marco Rubio], he referred to my hands. If they’re small, something else must be small. I guarantee you there’s no problem. I guarantee.”).

In addition to the evidence previously submitted, please see the attached Internet evidence showing that Donald Trump (and/or his features) have been referred to as small. *See, e.g.:*

- Amazon: <https://www.amazon.com/Trumps-Small-Hands-Soap-Republican/dp/B076JKNJ41>
- AV Club: <https://news.avclub.com/donald-trump-is-a-small-man-1798257937>

- Boing Boing: <https://boingboing.net/2018/02/22/platitude-crib.html>
- Headline of the Day: <https://www.headlineoftheday.com/2018/08/14/510-al-sharpton-trump-too-small-to-be-president/>
- Indy Week: <https://indyweek.com/news/soapboxer/donald-trump-small-man-big-world/>
- Market Watch: <https://www.marketwatch.com/story/outrage-over-report-that-white-house-ordered-uss-john-mccain-out-of-trumps-sight-2019-05-29>
- NBC Chicago: <https://www.nbcchicago.com/blogs/ward-room/The-Wieners-Circle-Offers-Tiny-Trump-Footlong-Hot-Dogs-Ahead-of-Candidates-Chicago-Rally-371730621.html>
- The Guardian: <https://www.theguardian.com/us-news/video/2016/mar/04/trump-defends-his-manhood-after-rubios-small-hands-comment-video>

In view of the evidence of record, it is clear that the applied-for mark points unmistakably to Donald Trump and, moreover, was intentionally selected by the applicant in an attempt to associate the mark and applicant's goods with President Trump.

**This factor weighs in favor of finding that the applied-for mark consists of or includes matter which may falsely suggest a connection with Donald Trump.**

- (3) The record is devoid of evidence indicating that Donald Trump is connected with the goods sold by the applicant under the proposed mark.

**This factor weighs in favor of finding that the applied-for mark consists of or includes matter which may falsely suggest a connection with Donald Trump.**

- (4) The fame of Donald Trump is such that a connection between the President and the applicant would be presumed by the applicant's use of the applied-for mark on its goods. In this case, the evidence of record establishes that Donald Trump is the subject of frequent media attention and is, therefore, well known by the public. Indeed, he is so well known that the name "TRUMP" in the applied-for mark would be construed by the public as a reference to President Trump.

In addition to the evidence previously submitted, please see the attached sampling of article excerpts from LexisNexis®, which reflect the fame and reputation of Donald Trump. Specifically, this evidence demonstrates that Donald Trump, as President of the United States, is the subject of constant media attention. *See, e.g.:*

Moreover, Donald Trump sells a variety of goods under the TRUMP mark, including clothing. *See, e.g.:*

- <https://www.trumpstore.com/collections/trump-t-shirt>
- <https://www.trumpstore.com/collections/women>

- <https://www.trumpstore.com/collections/headwear>
- <https://www.trumpstore.com/collections/gifts>
- <https://www.trumpstore.com/collections/gifts-candles>
- <https://www.trumpstore.com/collections/gifts-trump-signature-collection>
- <http://trumpwinery.orderport.net/product-details/0008/Wine-Key>
- <https://trumpwinery.orderport.net/merchandise/Gifts>
- <https://www.trump.com/trump-store>
- <https://www.trumpstore.com/collections/home-bedding>
- <https://www.trumpstore.com/collections/home-luggage-travel>
- <https://www.trumpstore.com/collections/home-pets>
- <https://www.eyeglasses.com/search.html?q=donald+trump>
- Washington Post: <https://www.washingtonpost.com/graphics/world/trump-worldwide-licensing/>
- Forbes: <https://www.forbes.com/sites/steveolenski/2015/11/24/donald-trumps-real-secret-to-riches-create-a-brand-and-license-it/#66773a013622>
- Motley Fool: <https://www.fool.com/investing/2016/11/17/donald-trumps-name-is-everywhere-but-what-does-he.aspx>



If applicant's goods and/or services are of a type that the named person or institution sells or uses, and the named party is sufficiently famous, then it may be inferred that purchasers of the goods and/or services would be misled into making a false connection of sponsorship, approval, support or the like with the named party. *See, e.g., In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1647-48 (TTAB 2015) (holding ROYAL KATE used with applicant's consumer products, including fashion products, suggested a connection with Kate Middleton would be inferred because evidence showed that Kate Middleton, by virtue of being the wife of Prince William of the British Royal family, has become a celebrity and fashion trend-setter the media reports on, including the clothes she wears, what she does, and what she buys); *In re Cotter & Co.*, 228 USPQ 202, 204-05 (TTAB 1985) (holding WESTPOINT used with applicant's firearms suggested sponsorship, approval, support or the like from West Point because evidence showed that West Point is a well-known U.S. Military Academy). Here, the evidence establishes the fame of Donald Trump and shows that the TRUMP mark is used on a wide variety of goods, including clothing, home accessories, luggage and travel goods, food, perfume, pet accessories, toys and wine keys. Accordingly, consumers encountering the applied-for mark used in connection with the identified goods would be misled into making a false connection of sponsorship, approval or support with President Trump.

**This factor weighs in favor of finding that the applied-for mark consists of or includes matter which may falsely suggest a connection with Donald Trump.**

For all of the foregoing reasons, all four of the relevant factors weigh in favor of finding that the applied-for mark consists of or includes matter which may falsely suggest a connection with Donald Trump, President of the United States. Accordingly, registration must be refused pursuant to Trademark Act Section 2(a).

**PLEASE NOTE:** Section 2(a) is an absolute bar to registration either on the Principal or Supplemental Register. TMEP §1203.03.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

If applicant responds to the above refusal(s), applicant must also respond to the requirement(s) set forth below.

**INFORMATION REQUIRED REGARDING RELATIONSHIP BETWEEN APPLICANT AND PERSON NAMED IN MARK**

Due to the renown of Donald Trump, and the fact that there is no information in the application record regarding a connection with applicant, applicant must specify whether Donald Trump has any connection with applicant's goods, and if so, must describe the nature and extent of that connection. See 37 C.F.R. §2.61(b); TMEP §1203.03(c)(i).

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**APPENDIX E**

**UNITED STATES PATENT AND TRADEMARK  
OFFICE (USPTO)**

**OFFICE ACTION (OFFICIAL LETTER)  
ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO. 87749230**

**MARK: TRUMP TOO SMALL**

\* \* \* \* \*

**APPLICANT: Elster, Steve**

\* \* \* \* \*

**OFFICE ACTION**

\* \* \* \* \*

**ISSUE/MAILING DATE: 7/30/2018**

**THIS IS A FINAL ACTION.**

This Office action is in response to applicant's communication filed on July 8, 2018.

In the initial Office action, the examining attorney refused registration under Trademark Act Section 2(c) because the applied-for mark consists of or comprises a name, portrait, or signature identifying a particular living individual whose written consent to register the mark is not of record.

In its response, the applicant argued against the Section 2(c) refusal. Applicant's response has been received and made of record.

The refusal pursuant to Section 2(c) of the Trademark Act is maintained and now made FINAL for the reasons set forth below. See 37 C.F.R. §2.63(b); TMEP §714.04.

**Final:**

**Section 2(c) Refusal: Name Identifying a Particular Living Individual**

Registration remains refused because the applied-for mark TRUMP TOO SMALL consists of or comprises a name, portrait, or signature identifying a particular living individual whose written consent to register the mark is not of record. Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §1206; see *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1649-50 (TTAB 2015); *In re Hoefflin*, 97 USPQ2d 1174, 1175-76 (TTAB 2010).

For purposes of Section 2(c), a name in a mark identifies a particular living individual if the person bearing the name will be associated with the mark as used on the goods or services because: “(1) the person is so well known that the public would reasonably assume a connection between the person and the goods or services; or (2) the individual is publicly connected with the business in which the mark is used.” *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1650 (TTAB 2015); see *In re Hoefflin*, 97 USPQ2d 1174, 1175-76 (TTAB 2010); *Krause v. Krause Publ’ns, Inc.*, 76 USPQ2d 1904, 1909-10 (TTAB 2005).

Section 2(c) applies not only to the full name of an individual, but also to any first name, surname, shortened name, pseudonym, stage name, title, or nickname that identifies a particular living individual. *In re Nieves & Nieves LLC*, 113 USPQ2d 1629, 1639 (TTAB

2015) (holding registration of the mark PRINCESS KATE barred under Section 2(c) in the absence of consent to register, because the mark “points uniquely and unmistakably to Kate Middleton,” the Duchess of Cambridge, whose identity is renowned); *In re Hoefflin*, 97 USPQ2d 1174, 1177-78 (TTAB 2010) (holding registration of the marks OBAMA PAJAMA, OBAMA BAHAMA PAJAMAS, and BARACK’S JOCKS DRESS TO THE LEFT barred under Section 2(c) in the absence of consent to register, because the marks create a direct association with President Barack Obama); *In re Sauer*, 27 USPQ2d 1073, 1074-75 (TTAB 1993) (holding registration of a mark containing BO, used in connection with a sports ball, barred under Section 2(c) in the absence of consent to register, because BO is the nickname of the well-known athlete BO JACKSON and thus use of the mark would lead to the assumption that he was associated with the goods), *aff’d per curiam*, 26 F.3d 140 (Fed. Cir. 1994).

In this case, applicant seeks to register TRUMP TOO SMALL for “Shirts; Shirts and short-sleeved shirts; Graphic T-shirts; Long-sleeved shirts; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; T-shirts; Tee shirts; Tee-shirts; Wearable garments and clothing, namely, shirts.” As explained in the previous Office action, Donald Trump is an American businessman, television personality, politician, and the 45th President of the United States. Elected on November 8, 2016, Trump won the general election on November 8, 2016 and assumed office on January 20, 2017. Accordingly, as President of the United States, Donald Trump is so well known that the public would reasonably assume a connection between the person and the subject goods.

In addition to the evidence previously submitted, the examining attorney now attaches the following Internet evidence as well as articles from LexisNexis® taken from major newspapers nationwide showing that President Trump is the subject of frequent media attention and is, consequently, well known to the public. *See, e.g.:*

<http://time.com/donald-trump-after-hours/>

<https://www.usatoday.com/story/news/politics/2018/07/30/rudy-giuliani-trump-team-preparing-counter-report-robert-mueller/858771002/>

[http://www.bostonherald.com/news/columnists/howie\\_carr/2018/07/howie\\_carr\\_moonbats\\_plagued\\_by\\_trump](http://www.bostonherald.com/news/columnists/howie_carr/2018/07/howie_carr_moonbats_plagued_by_trump)

<http://www.foxnews.com/opinion/2018/07/29/does-donald-trump-really-hate-breastfeeding-another-media-mis-report.html>

<https://losangeles.cbslocal.com/2018/07/29/more-drama-a-bloody-nose-and-another-brawl-at-donald-trumps-walk-of-fame-star/>

<http://fortune.com/2018/07/28/trump-donald-jr-russia-meeting/>

<https://www.npr.org/2018/07/30/633993070/trumps-tweets-show-he-s-betting-on-his-base-to-retain-power-in-washington>

<https://www.theatlantic.com/magazine/archive/2017/10/will-donald-trump-destroy-the-presidency/537921/>

[https://www.washingtonpost.com/blogs/plum-line/wp/2018/07/30/trumps-latest-rage-tweets-about-mueller-and-border-wall-reveal-gop-weakness/?utm\\_term=.cd189d50ec4b](https://www.washingtonpost.com/blogs/plum-line/wp/2018/07/30/trumps-latest-rage-tweets-about-mueller-and-border-wall-reveal-gop-weakness/?utm_term=.cd189d50ec4b)

<https://nypost.com/2018/07/28/trumps-demise-has-been-greatly-exaggerated/>

The attached evidence demonstrates that President Trump is well known by the public and so well known that the name TRUMP in the applied-for mark would be construed by the public as a reference to Donald Trump. The fact that a mark also contains other matter, in addition to a name, portrait, or signature, does not alter the requirement for written consent to register from the identified individual. *See Reed v. Bakers Eng'g & Equip. Co.*, 100 USPQ 196, 199 (PTO 1954).

Moreover, applicant concedes that the name "TRUMP" in the applied-for mark refers to Donald Trump. *See* Response ("The applied-for mark TRUMP TOO SMALL is political commentary about presidential candidate and president Donald Trump").

Upon encountering the applied-for mark TRUMP TOO SMALL, consumers would unequivocally associate the mark with Donald Trump. Accordingly, the name "TRUMP" in the applied-for mark identifies Donald Trump because President Trump is so well known that the public would reasonably assume a connection between the President and the goods specified in the application.

#### *Applicant's Arguments*

Applicant contends that the applied-for mark is entitled to registration because it consists of political commentary about Donald Trump "that the relevant consumer in the United States would not understand to be sponsored by, endorsed by, or affiliated with Donald Trump." *See* Response.



*Examining Attorney's Response*

Applicant's arguments against the refusal have been considered and found unpersuasive for the reasons set forth below.

First, applicant admits that the proposed mark is a direct reference to Donald Trump. *See* Response ("The applied-for mark TRUMP TOO SMALL is political commentary about presidential candidate and president Donald Trump"). In view of this admission, it is clear that the applied-for mark was selected by the applicant in an attempt to associate the mark and applicant's goods with President Trump, thereby benefiting monetarily from the fame of the President. Such commercial exploitation is precisely the type of activity that Section 2(c) is intended to prevent. *See In re Hoefflin*, 97 USPQ2d at 1176 (noting that the purpose of requiring the consent of a living individual to the registration of his or her name, signature, or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them); *see also* TMEP §1206.

Second, the fact that the proposed mark may be intended as political commentary is not determinative. Moreover, neither the statute nor the case law carves out a "political commentary" exception to the right of privacy and publicity.

Finally, applicant's argument that consumers would not understand the applied-for mark to be sponsored by, endorsed by, or affiliated with Donald Trump is also unavailing. The basis of the instant refusal is the rights of privacy and publicity that living persons have in the designations that identify them. *In re Hoefflin*, 97

USPQ2d at 1176; *see also Univ. of Notre Dame du Lac v. J.C. Gourmet Food Imps. Co.*, 703 F.2d 1372, 1376 n.8, 217 USPQ 505, 509 n.8 (Fed. Cir. 1983); *Canovas v. Venezia* 80 S.R.L., 220 USPQ 660, 661 (TTAB 1983). Moreover, the Trademark Trial and Appeal Board has previously held:

While with lesser-known figures there may have to be evidence showing that the consuming public connects them with the manufacturing or marketing of the goods at issue, well-known individuals such as celebrities and **world-famous political figures are entitled to the protection of Section 2(c) without having to demonstrate a connection with the involved goods or services.**

*See Hoeflin*, 97 USPQ2d at 1177 (emphasis added) (because Barack Obama is the President of the United States, the purchasing public will reasonably assume that marks consisting of the names BARACK and OBAMA identify President Barack Obama). Here, the record is replete with evidence showing that Donald Trump, as President of the United States, is extremely well known. Accordingly, the name “TRUMP” in the applied-for mark will instantly create an association with the President.

For all of the foregoing reasons, the use of the name “TRUMP” in the proposed mark would be construed by the public as a reference to Donald Trump. Accordingly, because President Trump’s written consent is not of record, registration must be refused pursuant to Section 2(c) of the Trademark Act.

The refusal under Section 2(c) will be withdrawn if applicant provides both of the following:

- (1) A statement that the name shown in the mark identifies Donald Trump, a living individual whose consent is of record.
- (2) A written consent, personally signed by the individual whose name, signature, or portrait appears in the mark, authorizing applicant to register the identifying matter as a trademark and/or service mark with the USPTO; for example, an applicant may use, if applicable, the following: “I, Donald Trump, consent to the use and registration of my name as a trademark and/or service mark with the USPTO.”

See TMEP §§813, 813.01(a), 1206.04(a).

Applicant is advised that the written consent must include a statement of the party’s consent to applicant’s *registration*, and not just the *use*, of the identifying matter as a trademark. See *Krause v. Krause Publ’ns, Inc.*, 76 USPQ2d 1904, 1912-13 (TTAB 2005); *In re New John Nissen Mannequins*, 227 USPQ 569, 571 (TTAB 1985); TMEP §1206.04(a).

This refusal is maintained and now made **FINAL**.

\* \* \* \* \*

/Amy L. Kertgate/  
Examining Attorney  
Law Office 113  
Tel: (571) 272-1943  
Email: amy.kertgate@uspto.gov

\* \* \* \* \*

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**APPENDIX F**

**UNITED STATES PATENT AND TRADEMARK  
OFFICE (USPTO)**

**OFFICE ACTION (OFFICIAL LETTER)  
ABOUT APPLICANT'S TRADEMARK APPLICATION**

**U.S. APPLICATION SERIAL NO. 87749230**

**MARK:** TRUMP TOO SMALL

\* \* \* \* \*

**APPLICANT:** Elster, Steve

\* \* \* \* \*

**OFFICE ACTION**

\* \* \* \* \*

**ISSUE/MAILING DATE: 2/19/2018**

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**NO CONFLICTING MARKS FOUND**

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

Registration is refused, however, on the following grounds.

**SECTION 2(c) REFUSAL – NAME IDENTIFYING A PARTICULAR LIVING INDIVIDUAL**

Registration is refused because the applied-for mark TRUMP TOO SMALL consists of or comprises a name, portrait, or signature identifying a particular living individual whose written consent to register the mark is not of record. Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §1206; *see In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1649-50 (TTAB 2015); *In re Hoefflin*, 97 USPQ2d 1174, 1175-76 (TTAB 2010).

For purposes of Section 2(c), a name in a mark identifies a particular living individual if the person bearing the name will be associated with the mark as used on the goods or services because: “(1) the person is so well known that the public would reasonably assume a connection between the person and the goods or services; or (2) the individual is publicly connected with the business in which the mark is used.” *In re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1650 (TTAB 2015); *see In re Hoefflin*, 97 USPQ2d 1174, 1175-76 (TTAB 2010); *Krause v. Krause Publ’ns, Inc.*, 76 USPQ2d 1904, 1909-10 (TTAB 2005).

Section 2(c) applies not only to the full name of an individual, but also to any first name, surname, shortened name, pseudonym, stage name, title, or nickname that identifies a particular living individual. *In re Nieves & Nieves LLC*, 113 USPQ2d 1629, 1639 (TTAB 2015) (holding registration of the mark PRINCESS KATE barred under Section 2(c) in the absence of consent to register, because the mark “points uniquely and

unmistakably to Kate Middleton,” the Duchess of Cambridge, whose identity is renowned); *In re Hoefflin*, 97 USPQ2d 1174, 1177-78 (TTAB 2010) (holding registration of the marks OBAMA PAJAMA, OBAMA BAHAMA PAJAMAS, and BARACK’S JOCKS DRESS TO THE LEFT barred under Section 2(c) in the absence of consent to register, because the marks create a direct association with President Barack Obama); *In re Sauer*, 27 USPQ2d 1073, 1074-75 (TTAB 1993) (holding registration of a mark containing BO, used in connection with a sports ball, barred under Section 2(c) in the absence of consent to register, because BO is the nickname of the well-known athlete BO JACKSON and thus use of the mark would lead to the assumption that he was associated with the goods), *aff’d per curiam*, 26 F.3d 140 (Fed. Cir. 1994).

In this case, Donald John Trump is an American businessman, television personality, politician, and the 45th President of the United States. Elected on November 8, 2016, Trump won the general election on November 8, 2016 and assumed office on January 20, 2017. He is the chairman and president of The Trump Organization, and the founder of Trump Entertainment Resorts. On June 16, 2015, Trump formally announced his candidacy for president of the United States in the 2016 election, seeking the nomination of the Republican Party. For these reasons, he is the subject of frequent media attention and his name is often in the public view. Please see the attached sampling of items retrieved via an Internet search.

The name “TRUMP” in the applied-for mark clearly references Donald Trump. The fact that a mark also contains other matter, in addition to a name, portrait, or

signature, does not alter the requirement for written consent to register from the identified individual. *See Reed v. Bakers Eng'g & Equip. Co.*, 100 USPQ 196, 199 (PTO 1954).

For all of the foregoing reasons, the use of the name “TRUMP” in the proposed mark would be construed by the public as a reference to Donald Trump. Accordingly, because President Trump’s written consent is not of record, registration must be refused pursuant to Section 2(c) of the Trademark Act.

The refusal under Section 2(c) will be withdrawn if applicant provides both of the following:

- (1) A statement that the name shown in the mark identifies Donald Trump, a living individual whose consent is of record.
- (2) A written consent, personally signed by the individual whose name, signature, or portrait appears in the mark, authorizing applicant to register the identifying matter as a trademark and/or service mark with the USPTO; for example, an applicant may use, if applicable, the following: “I, Donald Trump, consent to the use and registration of my name as a trademark and/or service mark with the USPTO.”

*See* TMEP §§813, 813.01(a), 1206.04(a).

Applicant is advised that the written consent must include a statement of the party’s consent to applicant’s *registration*, and not just the *use*, of the identifying matter as a trademark. *See Krause v. Krause Publ’ns, Inc.*, 76 USPQ2d 1904, 1912-13 (TTAB 2005); *In re New John Nissen Mannequins*, 227 USPQ 569, 571 (TTAB 1985); TMEP §1206.04(a).

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Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

\* \* \* \* \*

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Email: amy.kertgate@uspto.gov

\* \* \* \* \*



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**APPENDIX G**

UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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No. 2020-2205

**IN RE: STEVE ELSTER,**  
*Appellant*

---

Filed: Aug. 31, 2022

---

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

---

**ON PETITION FOR PANEL REHEARING AND  
REHEARING EN BANC**

---

Before MOORE, *Chief Judge*, NEWMAN, LOURIE,  
DYK, PROST, REYNA, TARANTO, CHEN, HUGHES, STOLL,  
CUNNINGHAM, and STARK, *Circuit Judges*.

PER CURIAM.

**ORDER**

Appellee Katherine K. Vidal filed a combined petition for panel rehearing and rehearing en banc. A response to the petition was invited by the court and filed by Steve Elster. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

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Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for rehearing en banc is denied.

The mandate of the court will issue September 7, 2022.

FOR THE COURT

August 31, 2022  
Date

/s/ Peter R. Marksteiner  
Peter R. Marksteiner  
Clerk of the Court

## APPENDIX H

## Trademark/Service Mark Application, Principal Register

Serial Number: 87749230

Filing Date: 01/10/2018

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The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	87749230
MARK INFORMATION	
*MARK	<u>Trump too small</u>
STANDARD CHARACTERS	YES
USPTO-GENERATED IMAGE	YES
LITERAL ELEMENT	Trump too small
MARK STATEMENT	The mark consists of standard characters, without claim to any particular font style, size, or color.
REGISTER	Principal
APPLICANT INFORMATION	
*OWNER OF MARK	Elster, Steve
*STREET	* * * * *

<b>*CITY</b>	* * * * *
<b>*STATE</b> (Required for U.S. applicants)	California
<b>*COUNTRY</b>	United States
<b>*ZIP/POSTAL CODE</b> (Required for U.S. and certain international addresses)	* * * * *
<b>PHONE</b>	* * * * *
<b>EMAIL ADDRESS</b>	XXXX
<b>AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes
<b>LEGAL ENTITY INFORMATION</b>	
<b>TYPE</b>	individual
<b>COUNTRY OF CITIZENSHIP</b>	United States
<b>GOODS AND/OR SERVICES AND BASIS INFORMATION</b>	
<b>INTERNATIONAL CLASS</b>	025
<b>*IDENTIFICATION</b>	Shirts; Shirts and short-sleeved shirts; Graphic T-shirts; Long-sleeved shirts; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; T-shirts; Tee shirts; Tee-shirts; Wearable gar-

	ments and clothing, namely, shirts
<b>FILING BASIS</b>	SECTION 1(b)
<b>CORRESPONDENCE INFORMATION</b>	
<b>NAME</b>	Elster, Steve
<b>STREET</b>	* * * * *
<b>CITY</b>	* * * * *
<b>STATE</b>	California
<b>COUNTRY</b>	United States
<b>ZIP/POSTAL CODE</b>	* * * * *
<b>PHONE</b>	* * * * *
<b>*EMAIL ADDRESS</b>	* * * * *
<b>*AUTHORIZED TO COMMUNICATE VIA EMAIL</b>	Yes
<b>FEE INFORMATION</b>	
<b>APPLICATION FILING OPTION</b>	TEAS RF
<b>NUMBER OF CLASSES</b>	1
<b>APPLICATION FOR REGISTRATION PER CLASS</b>	275
<b>*TOTAL FEE DUE</b>	275
<b>*TOTAL FEE PAID</b>	275

SIGNATURE INFORMATION	
SIGNATURE	/steve elster/
SIGNATORY'S NAME	Steve Elster
SIGNATORY'S POSITION	Owner
SIGNATORY'S PHONE NUMBER	* * * * *
DATE SIGNED	01/09/2018

---

**Trademark/Service Mark Application, Principal Register**

**Serial Number: 87749230**

**Filing Date: 01/10/2018**

**To the Commissioner for Trademarks:**

**MARK:** Trump too small (Standard Characters, see mark)

The literal element of the mark consists of Trump too small.

The mark consists of standard characters, without claim to any particular font style, size, or color.

The applicant, Steve Elster, a citizen of United States, having an address of

\* \* \* \* \*

requests registration of the trademark/service mark identified above in the United States Patent and Trademark Office on the Principal Register established by the Act of July 5, 1946 (15 U.S.C. Section 1051 et seq.), as amended, for the following:

**For specific filing basis information for each item, you must view the display within the Input Table.**

International Class 025: Shirts; Shirts and short-sleeved shirts; Graphic T-shirts; Long-sleeved shirts; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; T-shirts; Tee shirts; Tee-shirts; Wearable garments and clothing, namely, shirts Intent to Use: The applicant has a bona fide intention, and is entitled, to use the mark in commerce on or in connection with the identified goods/services.

The applicant's current Correspondence Information:

Elster, Steve

\* \* \* \* \*

**E-mail Authorization:** I authorize the USPTO to send e-mail correspondence concerning the application to the applicant, the applicant's attorney, or the applicant's domestic representative at the e-mail address provided in this application. I understand that a valid e-mail address must be maintained and that the applicant or the applicant's attorney must file the relevant subsequent application-related submissions via the Trademark Electronic Application System (TEAS). Failure to do so will result in the loss of TEAS Reduced Fee status and a requirement to submit an additional processing fee of \$125 per international class of goods/services.

A fee payment in the amount of \$275 has been submitted with the application, representing payment for 1 class(es).

**Declaration**



**Basis:**

**If the applicant is filing the application based on use in commerce under 15 U.S.C. § 1051(a):**

- The signatory believes that the applicant is the owner of the trademark/service mark sought to be registered;
- The mark is in use in commerce on or in connection with the goods/services in the application;
- The specimen(s) shows the mark as used on or in connection with the goods/services in the application; and
- To the best of the signatory's knowledge and belief, the facts recited in the application are accurate.

**And/Or**

**If the applicant is filing the application based on an intent to use the mark in commerce under 15 U.S.C. § 1051(b), § 1126(d), and/or § 1126(e):**

- The signatory believes that the applicant is entitled to use the mark in commerce;
- The applicant has a bona fide intention to use the mark in commerce on or in connection with the goods/services in the application; and
- To the best of the signatory's knowledge and belief, the facts recited in the application are accurate.



- To the best of the signatory's knowledge and belief, no other persons, except, if applicable, concurrent users, have the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other persons, to cause confusion or mistake, or to deceive.
- To the best of the signatory's knowledge, information, and belief, formed after an inquiry reasonable under the circumstances, the allegations and other factual contentions made above have evidentiary support.
- The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true.

**Declaration Signature**

Signature: /steve elster/      Date: 01/09/2018

Signatory's Name: Steve Elster

Signatory's Position: Owner

Payment Sale Number: 87749230

Payment Accounting Date: 01/10/2018

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Serial Number: 87749230

Internet Transmission Date: Wed Jan 10 00:37:52  
EST 2018

TEAS Stamp: USPTO/BAS-XXX.XXX.XX.XXX-  
201801100037527

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7d-CC-6264-20180110003053931277

**APPENDIX I**

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

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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.