

Supreme Court Upholds Lanham Act Restriction on Registering a Living Person's Name Without Consent in Trump Too Small Case

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PRACTICES Intellectual Property, Trademark and Advertising

On June 13, 2024, the U.S. Supreme Court unanimously held that the Lanham Act's names clause, which prohibits federal registration of marks that include a living person's name without their consent, is viewpoint-neutral and does not violate the First Amendment. The Court thereby affirmed the refusal to federally register "Trump Too Small" as a trademark as President Trump had understandably never provided his consent.

The opinion pulled largely from common-law trademark history to underscore the long-held principle that a living person has broad ownership over their own name and that a trademark applicant cannot piggyback off of the goodwill of a name that is not their own. The decision did not implement an overall framework for judging whether all content-based but viewpoint-neutral trademark restrictions are constitutional. This leaves the door open for further individualized review of the Lanham Act's provisions.

Background

In 2018, an attorney named Steve Elster applied to register "Trump Too Small" as a trademark for shirts with the U.S. Patent and Trademark Office (the "USPTO"). The mark was inspired by U.S. Senator Marco Rubio's 2016 comment that Donald Trump has "small hands" and expressed Elster's view on Trump's governance approach.¹

The USPTO Examining Attorney refused registration in part based on Section 2(c) of the Lanham Act – the Names Clause that requires the written consent by a referenced living individual whose name appears in a mark. The Trademark Trial and Appeal Board (the "TTAB") affirmed the refusal, disregarding Elster's First Amendment protection claim.²

Elster appealed the USPTO refusal to the Court of Appeals for the Federal Circuit, which turned out to be more sympathetic to his First Amendment argument, and overturned the lower ruling, concluding that the USPTO had no valid public interest in granting "all public figures the power to restrict trademarks constituting First Amendment expressions before they occur." The Federal Circuit found Section 2(c) to involve content-based discrimination, but it did not address what level of scrutiny would apply. Instead, it focused its analysis on whether there was any substantial government interest in the restriction of speech and weighed the competing interests. Elster's First Amendment rights, in the Federal Circuit's view, ultimately won out over the USPTO's claimed interests in protecting an individual's right to privacy and publicity. The U.S. Supreme Court, however, would in turn disagree with the Federal Circuit's analysis.

The USPTO petitioned the Court for writ of certiorari, granted in June 2023, and oral arguments took place on November 1, 2023. The USPTO argued that Lanham Act restrictions on what names are registerable as a trademark are reasonable, viewpoint-neutral conditions on a government

benefit (registration) and not a restriction on speech. The USPTO further reasoned that registration of marks criticizing political figures – i.e., greater First Amendment rights – would in fact chill speech by enabling owners to stop others from using those references. Refusing registration of such marks, if anything, would broaden free speech, so said the USPTO. Elster argued that Section 2(c) disfavors speech based on content alone, which justifies a need for heightened scrutiny.

The Court's Decision

In the majority opinion, authored by Justice Clarence Thomas, the Court ruled in the USPTO's favor and thus for its refusal of the "Trump Too Small" application. It reasoned that although Section 2(c) is content based, like many trademark laws, it is constitutional and would not be held to heightened scrutiny due to its "longstanding, harmonious relationship" with the First Amendment dating back to at least the 1800s.

The Court indicated that the question of whether a trademark registration is granted is *not* a regulation on speech, and that granting a registration does not equate to a government benefit. It follows that the Names Clause should not be subjected to heightened scrutiny on that basis.

Finally, the Court determined that Section 2(c) was viewpoint neutral – as the USPTO argued – because it is "agnostic" and does not "distinguish between two opposed sets of ideas."

The Court did not provide a thorough discussion of balancing of First Amendment and trademark ownership interests. It also did not opine on whether registration of marks critical of persons would chill other speech.

With the Names Clause couched as content-based yet constitutional due to its unique history, it was left in place without painstaking analysis. Had the Court subjected Section 2(c) to heightened scrutiny on the ground that the section is content-based, then that could have encouraged even more challenges to other Lanham Act clauses. That is because other Lanham Act clauses are, by their nature, content-based. Yet, similar to other recent Supreme Court trademark cases, such as *Brunetti* and *Tam* (where other Lanham Act trademark restrictions were deemed viewpoint discriminatory and therefore unconstitutional), this decision avoided determining a trademark's place among First Amendment speech categories broadly. The Court was clear in stating that this is a narrow decision and whether other viewpoint-neutral, content-based trademark restrictions are constitutional without "such a historical pedigree" is a question for another day.

¹ <https://www.cbsnews.com/news/marco-rubio-goes-after-donald-trumps-small-hands/>.

² The Examining Attorney had also refused the application due to Sec. 2(a), suggesting a false connection with a living individual. The TTAB decided to forgo discussion of Sec. 2(a). <https://ttabvue.uspto.gov/ttabvue/ttabvue-87749230-EXA-23.pdf>. It was not addressed on further appeal.