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Supreme Court Rejects Registration of “Trump Too Small” Trademark

By Jessica Falk and Priya Kamath

On June 13, 2024, the Supreme Court issued its opinion in *Vidal v. Elster*, the third in a series of recent First Amendment based challenges to the Lanham Act’s provisions governing what types of marks may achieve federal registration. At issue was whether the Lanham Act’s prohibition against registering a trademark that “[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent,” 15 U.S.C. § 1052(c), violates the First Amendment right to free speech. *Elster*, No. 22-704, at 1 (June 13, 2024). Specifically, Respondent Steve Elster sought to obtain a federal trademark registration for the phrase “Trump too small” for use on clothing, in reference to jabs traded between then-presidential candidates Donald Trump and Marco Rubio in 2016. *Id.* at 2-3. Petitioner, the U.S. Patent and Trademark Office (“USPTO”), refused Elster’s registration request in part because Elster did not have written consent from Donald Trump to reference his name. *Id.* at 3. The U.S. Court of Appeals for the Federal Circuit reversed, concluding that the provision was a “viewpoint-neutral, content-based restriction on speech” that was subject to “at least intermediate scrutiny” and therefore Elster’s proposed trademark was protected speech under the First Amendment. *Id.*

Justice Clarence Thomas delivered the Court’s opinion, which unanimously reversed the Federal Circuit’s decision and rejected the First Amendment challenge. However, the Court was sharply divided on the rationale behind the rejection, with the Justices providing three concurring opinions and numerous partial joiners. The Court agreed that the provision, which the Court dubbed the “names clause,” is content-based as it “restrict[s] discussion of a subject matter or topic,” here, a living individual. *Id.* at 2, 4. It further noted that the names clause was viewpoint-neutral as it does not “facially discriminate against any viewpoint” since the “names clause prohibits marks that use another person’s name without consent” regardless of whether the “use of [the] name is flattering, critical or neutral.” *Id.* at 5 (internal citation omitted). The Court thus distinguished the matter from its recent decisions striking down Lanham Act provisions as violative of the First Amendment because they “discriminate[d] based on viewpoint.” *Id.* at 4 (citing *Matal v. Tam*, 582 U.S. 218 (2017) (voiding ban on disparaging or offensive trademarks) and *Iancu v. Brunetti*, 588 U.S. 388 (2019) (invalidating prohibition on immoral or scandalous trademarks)). In so doing, the Court rejected Elster’s assertion that the names clause resulted in “viewpoint discrimination in practice” because it is easier to obtain consent for a flattering rather than critical mark. *Id.* at 5. The Court noted that there are many reasons why a person would withhold consent, even if the mark was complimentary, including to avoid association with another’s goods or services and to prevent exploitation. *Id.* The Court thus proceeded to address, for the first time, the constitutionality of a content-based but viewpoint-neutral trademark restriction.

Despite content-based speech regulation being “presumptively unconstitutional,” *id.* at 6, the Court recognized that “restrictions on trademarks have always turned on a mark’s content,” since the goals of trademark law are to indicate ownership and the source of goods and/or services, and prevent confusion as to the source of same. *Id.* at 11. Accordingly, given the “uniquely content-based nature of trademark regulation and the longstanding coexistence of trademark regulation with the First Amendment,” the Court did not need to evaluate the names clause restriction under heightened scrutiny. *Id.* The Court then relied on the history and tradition of the First Amendment to uphold the names clause. The Court pointed to the common-law’s approach of protecting “only a person’s right to use his *own* name” which “carried over into federal statutory law.” *Id.* at 15. The Court further noted that the Lanham Act’s protection of a person’s use of his name—and therefore his reputation—is harmonious with the Court’s prior refusal to recognize a “First Amendment right to piggyback off the goodwill another entity has built in its name.” *Id.* at 18.

Justice Barrett, joined in whole by Justice Kagan and in part by Justices Sotomayor and Jackson, wrote a concurrence in which she emphasized that the majority’s exclusive reliance on history and tradition was unpersuasive. *Elster*, No. 22-704, slip op. at 9 (Barrett, J., concurring). Justice Barrett instead proposed that the Court adopt a standard similar to that used to scrutinize limited public forums, which are also maintained through content-based restrictions. *Id.* at 7. Justice Sotomayor, joined by Justices Kagan and Jackson, also penned a concurrence criticizing the majority’s sole reliance on history and tradition in forming its ruling. Justice Sotomayor proposed a test whereby a viewpoint-neutral provision “need only be reasonable in light of the purpose of the trademark system” to “identify[] and distinguish[] goods for the public.” *Elster*, No. 22-704, slip op. at 5 (Sotomayor, J., concurring). Such trademark registration provisions would not violate the Free Speech Clause. *Id.* at 5-6. Justice Kavanaugh also issued a concurring opinion, noting only that “a viewpoint-neutral, content-based trademark restriction might well be constitutional even absent such a historical pedigree.” *Elster*, No. 22-704, slip op. at 1 (Kavanaugh, J., concurring).

The Court was careful to emphasize the narrow nature of its opinion and that the names clause’s content-based restriction was justified because it rests on “[a] firm grounding in traditional trademark law.” *Elster*, No. 22-704, at 19. The *Elster* decision thus follows the Court’s prior reluctance to adopt *per se* rules in the intellectual property space. It also previewed the different approaches each Justice may take if the Court is presented with a future dispute on whether a content-based, viewpoint-neutral trademark restriction without historical grounding is constitutional.

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