

The Supreme Court Upholds Refusal to Register “Trump Too Small” Trademark

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Last week, in *Vidal v. Elster*, the Supreme Court upheld the Lanham Act’s prohibition against registering a trademark that includes a living person’s name without their consent.¹ This case is the latest in a trilogy of challenges to the constitutionality of trademark registration bars in the Lanham Act. The Court previously struck down as unconstitutional the clauses in Section 2(c) prohibiting registration of marks constituting “disparagement” and “immoral or scandalous matter.”² In a departure from those decisions, the Court upheld the U.S. Patent and Trademark Office’s refusal to register a trademark for “Trump Too Small”—a piece of political commentary that the applicant sought to use on apparel to criticize a government official. The Court reasoned that, unlike the other provisions, the “names” prohibition is viewpoint-neutral, and thus does not violate any First Amendment right.

While the result was unanimous (9-0), the decision contains a patchwork of joiners and concurrences that espouse several different paths to reach the same conclusion. The result is a narrow ruling that expressly “does not set forth a comprehensive framework for judging whether all content-based but viewpoint-neutral trademark restrictions are constitutional.”³

If you have any questions concerning this memorandum, please reach out to your regular firm contact or the following authors.

BAY AREA

Angela L. Dunning
+1 650 815 4131
adunning@cgsh.com

NEW YORK

David H. Herrington
+1 212 225 2266
dherrington@cgsh.com

Armind B. Bepko
+1 212 225 2517
abepko@cgsh.com

Nathaniel (Nate) Reynolds
+1 212 225 2889
nreynolds@cgsh.com

¹ 2024 WL 2964139 (U.S. June 13, 2024).

² See *Matal v. Tam*, 582 U.S. 218 (2017); *Iancu v. Brunetti*, 588 U.S. 388 (2019).

³ *Elster*, 2024 WL 2964139 at *3.



Background

In 2016, during a Presidential primary debate, Senator Marco Rubio made a comment implying that Donald Trump’s hands (and by innuendo, other attributes) were small. This led to the phrase “Trump too small” becoming a popular satirical jab at Trump. Following the debate, Steve Elster started printing the phrase accompanied by a hand gesture on shirts, hats, and sweatshirts and selling them online.



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Mr. Elster applied to register the phrase as a trademark with the U.S. Patent and Trademark Office, but his application was denied as the mark includes Trump’s name without consent. Section 2(c) of the Lanham Act prohibits registration of a name, portrait or signature identifying a living person, or a deceased President’s name during the life of his widow, without consent.

The Trademark Trial and Appeal Board affirmed the refusal, but the Federal Circuit reversed, noting that in the last five years the Supreme Court has found that two other provisions of Section 2 of the Lanham Act to be unconstitutional on First Amendment grounds. In *Matal v. Tam*, the Court struck down the restriction on disparaging trademarks because it prohibits the viewpoint of “giving offense.”⁵ In that case, an Asian-American performer’s attempt to register his band name, “The Slants,” was rejected as a racist and

derogatory term for people of Asian descent. Similarly, *Iancu v. Brunetti* involved an artist’s attempt to register a trademark for a clothing line called “FUCT.” The Supreme Court overturned this denial because the Lanham Act’s restriction on trademarks containing “immoral or scandalous matter” constituted an impermissible viewpoint restriction.⁶

The Federal Circuit followed suit in this case, concluding that the “names” clause is a viewpoint-neutral, content-based restriction on speech that could not stand irrespective of the level of scrutiny to be applied—strict (whereby the government must have a compelling government interest in restricting speech) or intermediate (whereby the government must have only a substantial government interest in restricting speech). Either way, the outcome would be the same, it held, because the government had no interest in restricting speech that is critical of government officials or public figures in the trademark context.

The Supreme Court Decision

In a unanimous decision the Supreme Court reversed, ruling that the Trademark Office’s refusal to register “Trump Too Small” did not violate the First Amendment. Writing for the majority, Justice Thomas (joined by Justices Alito and Gorsuch) first distinguished between content-based and viewpoint-based restrictions on speech. Content-based regulations target speech based on its communicative content, while “viewpoint discrimination” is a “particularly ‘egregious form of content discrimination’ that targets not merely a subject matter ‘but particular views taken by speakers on the subject.’” It was on this basis that the Court distinguished its rulings in *Matal* and *Brunetti*, both of which involved a prohibition on registrations for trademarks based on viewpoint—those that could give offense or be considered “immoral or scandalous”—warranting application of strict scrutiny (requiring that the restriction be narrowly tailored to meet a compelling government interest).

⁴ Screenshot from trumptooosmall.com

⁵ *Tam*, 582 U.S. at 223.

⁶ *Brunetti*, 588 U.S. at 390.

In contrast, the “names” clause is content-based but viewpoint-neutral because it does not single out trademarks based on the viewpoint or ideology expressed. Rather, it applies equally to any names used without consent, whether used in a positive or negative light. Justice Thomas reasoned that the Court had not previously decided whether viewpoint-neutral trademark restrictions were subject to the same strict scrutiny as viewpoint-based restrictions, and concluded they were not.

The Court then held that “[t]he history and tradition of restricting trademarks containing names is sufficient to conclude that the “names” clause is compatible with the First Amendment.”⁷ Individuals have always had the right to use their own names as trademarks in business. Conversely, passing off products under another person’s name has long been considered fraudulent. The “names” clause enshrines this common-law understanding by protecting an individual’s exclusive right over their name and preventing unauthorized use by others. Prohibiting the registration of trademarks with a living person’s name without their consent does not violate free speech rights. Rather, the “names” clause “has deep roots in our legal tradition. Our courts have long recognized that trademarks containing names may be restricted.”⁸

Justice Kavanaugh, joined by Justice Roberts, concurred with the majority opinion, but went on to suggest that a viewpoint-neutral, content-based trademark restriction might still be constitutional even without this historical context, and that this issue could be revisited in a future case.

Justice Barrett, joined by Justices Kagan, Sotomayor, and Jackson in part, concurred with the Court’s conclusion that the “names” clause does not violate the First Amendment but disagreed that the historical evidence sufficiently established a tradition justifying the clause. Rather, she reasoned, a standard should be adopted, grounded in trademark law and First Amendment precedent, to determine when content-based trademark restrictions are permissible.

Justice Sotomayor, joined by Justices Kagan and Jackson, also disagreed with the Court’s reliance on history and tradition to resolve the issue presented, holding that the constitutionality of viewpoint-neutral, content-based trademark registration restrictions should be evaluated using established First Amendment precedent rather than historical analogues. Such restrictions are permissible if they are reasonable and serve the trademark system’s core purpose of avoiding consumer confusion, as the “names” clause does by preventing confusion as to source or sponsorship and protecting producer goodwill.

Key Takeaways

This is the third time in eight years that the Court has weighed in on the constitutionality of Lanham Act restrictions on registration. In *Elster*, the Court seems to have drawn a line between viewpoint-based and viewpoint-neutral restrictions. While registration cannot be denied for marks that are disparaging or contain “immoral or scandalous material,” the Trademark Office may continue to deny registration to a mark that incorporates a living person’s name without consent—a viewpoint-neutral restriction.

Notably, although Mr. Elster cannot obtain a federal trademark registration for “Trump Too Small,” nothing in the decision affects his right to continue offering goods and services under that mark. Federal registration is not necessary to obtain trademark rights or enforce those rights against infringement by others. Registration confers certain benefits, such as establishing prima facie evidence of validity and the owner’s exclusive right to use it, as well as the right to pursue and obtain certain forms of relief. But state and common law also provide a right of action against alleged infringers if a mark owner can establish priority of rights in a valid trademark.

Finally, the narrowness of this decision—expressly not advancing any framework to apply to future challenges—leaves open the question of how to analyze other Lanham Act registration bars that might be vulnerable to attack as viewpoint-based.

⁷ *Elster*, 2024 WL 2964139 at *2.

⁸ *Id.* at 8.