

## INTELLECTUAL PROPERTY LITIGATION

Registration Requirements for Lanham Act  
Heads to High Court

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The Lanham Act provides legal protections to trademark holders and, since 1946, it has prohibited the registration of any trademark containing the name, portrait or signature of a living person, except with their written consent.

The U.S. Supreme Court will consider whether this prohibition presents a conflict with the Free Speech Clause of the First Amendment. In particular, the court is positioned, in granting certiorari in *Vidal v. Elster* (Dkt. No. 22-704), to determine whether this provision of the Lanham Act violates the First Amendment by barring registration of a trademark that contains criticism of a government official or public figure.

This case has important implications not only for trademark registrations, but also potentially in determining collisions between trademark rights, rights of publicity, and freedom of speech considerations in future cases.

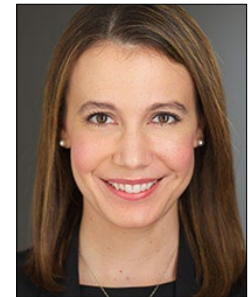
Under the Lanham Act, a mark may be registered to identify and distinguish one person's goods from those sold by others. Registration of a trademark is not mandatory; however, it provides registrants with valuable benefits, including the right to prevent others from using the mark by providing prima facie evidence of the registrant's exclusive right to use the registered mark in commerce.

Under the Lanham Act, trademarks may only be registered if they satisfy certain statutory criteria. In particular, the Lanham Act directs the U.S. Patent and Trademark Office ("USPTO") to refuse registration to any proposed trademarks that "consist of or comprise" a name "identifying a particular living individual" without his or her written consent. 15 U.S.C. 1052(c). According to the USPTO, Section 1052(c)'s bar to registration is intended to protect individuals' rights of privacy and publicity.

The respondent in this case, Steve Elster, is a California employment attorney. In 2018, Elster sought to register the trademark "TRUMP TOO SMALL"—referencing the 2016 presidential



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campaign debates between President Donald J. Trump and Senator Marco Rubio—with the intent to sell t-shirts bearing this slogan. According to Elster, this phrase was intended to “convey[] that some features of President Trump and his policies are diminutive,” a sentiment he viewed as constitutionally protected political commentary.

The USPTO rejected Elster's trademark application. The examiner reasoned that the use of the name “Trump” under the slogan would be understood to reference Donald Trump—and given that President Trump had not provided his written consent, refusal was required under Section 1052(c).

After an initial appeal to the Trademark Trial and Appeal Board (TTAB) and subsequent remand, a USPTO examiner also refused registration under 15 U.S.C. 1052(a), which prohibits the registration of marks that “falsely suggest a connection with persons, living or dead.”

Elster appealed both determinations to TTAB, which affirmed the USPTO's refusal of registration under Section 1052(c), but declined to reach a determination concerning Section 1052(a). The TTAB also rejected Elster's argument that refusal to register the mark violated his free speech rights.

Elster appealed to the U.S. Court of Appeals for the Federal Circuit. Reversing the TTAB, the Federal Circuit held that the USPTO's decision to refuse registration under Section 1052(c) unconstitutionally restricted Elster's free speech rights in violation of the First Amendment. See *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022).

In reaching its decision, the Federal Circuit looked to two recent Supreme Court cases, *Matal v. Tam*, 137 S. Ct. 1744 (2017) and *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019), which challenged other restrictions on registration provided by Section 1052. In *Tam*, the USPTO had rejected Simon Tam's efforts to register the name of his band, The Slants, finding this violated the Lanham Act's Section 1052(a) prohibition on registering "disparaging" marks.

However, the Supreme Court struck down the Lanham Act's disparagement prohibition, finding that it facially discriminated based on viewpoint by singling out a subset of messages and prohibiting them, in violation of the First Amendment. 137 S. Ct. 1744.

In *Brunetti*, the Supreme Court unanimously held that the Lanham Act's Section 1052(a) prohibition on "immoral or scandalous" marks similarly represented impermissible viewpoint discrimination in violation of the First Amendment and struck down that bar to registration. 139 S. Ct. 2294.

In *Elster*, the Federal Circuit noted that *Tam* and *Brunetti* not only "establish[ed] that a trademark represents 'private, not government, speech' entitled to some form of First Amendment protection," but also that trademarks do more than merely identify the source of a product and "go on to say something more" on "some broader issue." *In re Elster*, 26 F.4th at 1331 (quoting *Tam*, 137 S. Ct. at 1764).

Thus, denying a trademark application can "disfavor" the speech being regulated, implicating the registrant's free speech protections under the First Amendment.

Although neither the USPTO nor *Elster* contended that Section 1052(c) involves viewpoint discrimination, the Federal Circuit nevertheless held that this prohibition involved *content-based discrimination* that is not justified by either a compelling or substantial government interest.

The Federal Circuit declined to decide whether Section 1052(c) should be reviewed under the strict scrutiny or intermediary scrutiny standard for First Amendment review, as under either standard, the government had failed to show a substantial interest in the prohibition.

In so holding, the Federal Circuit reasoned that the First Amendment interests in criticizing public figures is substantial, and "[l]aws suppressing the right 'to praise or criticize governmental agents' generally cannot be squared with the First Amendment." *Id.* at 1334 (quoting *Mills v. State of Ala.*, 86 S. Ct. 1434, 1437 (1966)).

The Federal Circuit also found that these significant interests are not outweighed by the government's interests in limiting speech concerning government officials based on privacy or publicity grounds for several reasons.

First, it rejected the argument that a public official with as much notoriety as President Trump could not plausibly claim that he "enjoys a right of privacy protecting him from criticism in the absence of actual malice." Thus, the government could claim no interest in President Trump's privacy that would outweigh *Elster's* substantial interest in criticizing a public figure.

Second, as to rights of publicity, the Federal Circuit noted that there was no evidence President Trump's name was being misap-

propriated in a manner that exploited his commercial interests or falsely suggested his endorsement of *Elster's* product. Because rights of publicity are traditionally balanced against freedom of expression—including parody and political criticism—the Federal Circuit concluded that the government could demonstrate no interest that could overcome the First Amendment protections for speech critical of a public figure. Thus, it overturned the USPTO's refusal to register *Elster's* mark.

Although it declined to decide this issue because *Elster* raised only an as-applied challenge to Section 1052(c), the Federal Circuit also observed in the closing to its opinion that Section 1052(c) also raises overbreadth concerns because it provides no exceptions to the USPTO to register marks that advance important First Amendment interests, including parody, criticism, or transformative expression.

The Supreme Court granted certiorari. In its merits brief, Petitioner USPTO argued that the Federal Circuit erred by holding that Section 1052(c)—a reasonable, viewpoint-neutral condition on a government benefit—is inconsistent with the First Amendment.

Indeed, the USPTO argued that "it is the registration of marks like respondent's—not the refusal to register them—that would

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'chill' [free] speech." Thus, according to the USPTO, upholding the Federal Circuit's decision would make it easier for trademark holders to restrict the free speech rights of others.

Although the Federal Circuit did not decide this issue, the USPTO also argued that this case presents an opportunity for the Supreme Court to resolve a significant question that was left open in *Tam* and *Brunetti*: whether the Lanham Act's prohibition on registration of a trademark is "a condition on a government benefit or a simple restriction on speech."

According to the USPTO, the answer to this question has significant implications, not merely for the standard of review applicable to Section 1052(c), but also for the constitutionality of several other bars on registration contained in Section 1052.

Respondent *Elster* argues that *Tam* and *Brunetti* apply, as they both held that limits on trademark registration are restrictions on private speech that are subject to First Amendment scrutiny. According to *Elster*, Section 1052(c)'s purpose is illegitimate and does not pass either strict scrutiny or intermediate scrutiny.

To date, several amicus briefs have been submitted. Of note, the Motion Picture Association of America has argued that this case has important implications for the relationship between the First Amendment and rights of publicity, including in the context of films inspired by real events and people, which often draw rights of publicity suits by the individuals depicted in those movies.

Oral argument has not yet been scheduled.