

Trademark Law Alert--“TRUMP TOO SMALL” Not Registrable as a Trademark After All

06.25.2024 By [Mary L. Kevlin](#)



In [Vidal v. Elster](#), No. 22-704, 602 U.S. ____ (June 13, 2024), the U.S. Supreme Court unanimously held that the “names clause” of the Lanham Act, 15 U.S.C. § 1052 (c), is constitutional as to the refusal to register TRUMP TOO SMALL as a trademark for shirts absent Donald Trump’s written consent. Although the Court unanimously upheld the “names clause,” the Justices expressed different supporting reasoning.

The “names clause” precludes 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.

The First Amendment of the U.S. Constitution provides that:

Congress shall make no law . . . abridging the freedom of speech.

The Supreme Court reversed the Court of Appeals for the Federal Circuit, that, as we [previously reported](#), held the “names clause” was an unconstitutional violation of freedom of speech as applied to this case. The Supreme Court instead reversed and upheld the registration refusal by the U.S. Trademark Office and the Trademark Trial and Appeal Board.

Elster stated that his mark “invokes a memorable exchange between . . . [Donald] Trump and Senator Marco Rubio from a 2016 presidential primary debate, and aims to ‘convey[] that some features of . . . Trump [his hands] and his policies are diminutive.’” *In re Elster*, 26 F.4th 1328, 1330 (Fed. Cir. 2022). Elster contended this is political speech that is protected under the First Amendment.

Justice Thomas, writing the opinion for the majority of the Court¹, began by stating that a content-based regulation such as the “names clause” generally is presumptively unconstitutional and may be justified only by compelling state interests. Further, he noted that viewpoint discrimination is “a particularly ‘egregious form of content discrimination’”.

He observed that the Court had previously struck down viewpoint-based restrictions in the Trademark Act as violating the First Amendment. In [Matal v. Tam](#), 582 U.S. 218, 223 (2017), it struck down the bar against registering disparaging marks, as we [reported](#). In [Iancu v. Brunetti](#), 558 U.S. 388 (2019), it struck down the bar against registering immoral or scandalous marks, as we [reported](#).

However, in contrast to those cases that left open the question of “how to evaluate viewpoint-neutral restrictions on trademark registration,” citing *Tam* and *Brunetti*, Justice Thomas stated that the “names clause,” while content-based, is also viewpoint-neutral. It prohibits registration of a person’s name that identifies a particular living person without that person’s consent, whether the use of the name is “flattering, critical or neutral.” He concluded that the Court was therefore addressing a neutral, content-based trademark registration restriction for the first time.

Justice Thomas rested his conclusion that the “names clause” is constitutional on the narrow ground of the history and tradition of trademark rights, particularly as they pertain to names. He stated that the inherently content-based nature of trademark law had “never been a cause for constitutional concern.” He also reviewed historical caselaw that had established that a person generally has a claim only to his or her own name but has no First Amendment right “to piggyback off the goodwill another entity has built in its name.” He concluded that this history and tradition made this a “relatively simple case” without the need to look any further. However, he stated that a case presenting a content-based trademark restriction without a historical analogue might require a different approach. Furthermore, a different case might require more than a history/tradition reasoning.

Although Justice Kavanaugh and Chief Judge Roberts agreed with the historical/tradition rationale of Justice Thomas, they issued a three-sentence concurrence to emphasize that a content-based, viewpoint-neutral trademark registration restriction “might well be constitutional even absent such a historical pedigree,” a distinct question that could be addressed in a future case.

Justice Barrett’s concurrence disagreed with the Court’s treatment of the historical record as dispositive, questioning whether the historical record even supported the Court’s conclusion. But she agreed with the Court’s judgment based on the principle that the “names clause” is reasonable in light of the trademark system’s purpose of facilitating source identification.

¹ Justices Alito and Gorsuch joined in the entire opinion. Justices Kavanaugh and Chief Judge Roberts joined the opinion except Part III (and wrote a three-sentence clarifying concurrence), so Parts I, II and IV had a majority. Justice Barratt also joined Parts I and IIA and B of the opinion but wrote a separate concurrence joined by Justice Kagan and in part by Justice Sotomayor that employed different reasoning to reach the same result. Justice Sotomayor, joined by Justices Kagan and Jackson, wrote a separate concurrence also using different reasoning from the majority.

Justice Sotomayor also rejected the historical basis of the Court's decision. She would instead apply the Court's First Amendment precedent with a two-step analysis: First, is the provision viewpoint-neutral? If not, "it is presumptively unconstitutional and heightened scrutiny applies." Second, if it is viewpoint neutral, as here, "the trademark registration bar need only be reasonable in light of the purpose of the trademark system.... [and] reasonably serve its purpose of identifying and distinguishing goods for the public." She stated that the "names clause" is reasonable because it merely withholds the ancillary benefits of registration without preventing the holder from "using his mark in commerce or communicating any message incidental to the mark."

In sum, the Justices all agreed that the "names clause" is content-based but viewpoint-neutral. As such, they held that clause constitutional either because of the history and tradition of trademark rights, particularly as pertaining to names, or because that clause is reasonable either considering the source identification principle of trademark law and/or because that clause does not prevent a mark's use in commerce.

Author's Note:

The narrowness of the majority's reasoning essentially confines its applicability only to the constitutionality of the "names clause." Both Justice Thomas' opinion for the majority and Justice Kavanaugh's concise concurrence leave open how First Amendment challenges to other viewpoint-neutral restrictions of the Lanham Act should be addressed.

The reasoning employed by the majority, however, may provide some guidance as to how a challenge to state right of publicity statutes and caselaw might be handled favorably, as publicity rights often turn on names, portraits, and signatures, as does Section 2(c) of the Lanham Act.

The opinions clearly highlight that a refusal to register a mark does not prevent use of it. To prevent use, it would be necessary to bring a court action for an injunction on the ground of violating some state or federal law, such as a right of publicity or dilution.

Interestingly, the "false suggestion of a connection" prong of Section 2(a) of the Lanham Act was also asserted as an additional ground to refuse registration of Elster's mark by the Trademark Office. However, on appeal, the Trademark Trial and Appeal Board only addressed the "names clause" ground in its opinion. The false suggestion of a connection ground was not appealed and not addressed by either the Federal Circuit or the Supreme Court. The eventual fate of that provision against a First Amendment challenge to a refusal to register thus remains unanswered by the *Elster* case.

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