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First Amendment "Trumps" Section 2(c) of the Lanham Act

California attorney Steve Elster filed an application in 2018 to register the mark "TRUMP TOO SMALL" for use on shirts in International Class 25. According to the application, the phrase "invokes a memorable exchange between President Trump and Senator Marco Rubio from a 2016 presidential primary debate and aims to convey that some features of President Trump and his policies are diminutive." The Trademark Examining Attorney at the U.S. Patent and Trademark Office (PTO) initially rejected the application on two grounds. The mark could not be registered because Section 2(c) of the Lanham Act, 15 U.S.C. § 1052(c) bars using the name of a living individual without their consent and Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a) precludes registration of a mark that falsely suggests a connection or association with persons, living or dead. The Trademark Trial and Appeal Board (TTAB) affirmed the initial decision to deny registration of the mark solely on the Section 2(c) ground, finding it unnecessary to address the rejection under Section 2(a).

On Feb. 24, 2022, the U.S. Court of Appeals for the Federal Circuit reversed the TTAB's decision, allowed registration of the trademark "TRUMP TOO SMALL," and held that the TTAB's application of Section 2(c) to Elster's application violated the applicant's First Amendment right to freedom of speech. In re Elster, Appeal No. 2020-2205 (Fed. Cir. Feb. 24, 2022). The court stated that a trademark represents "private, not government, speech" entitled to some form of First Amendment protection. In addition, trademarks often "do not simply identify the source of a product or service but go on to say something more" on "some broader issue" and frequently "have an expressive content." Although the Federal Circuit recognized that Section 2(c) did not prevent Elster from communicating his message outright, the issue was whether Section 2(c) could legally disadvantage the speech at issue, noting the various advantages attached to a trademark registration.

The Federal Circuit weighed the applicant's First Amendment interests against the government's substantial interest in protecting state-law privacy and publicity rights. With respect to privacy, the court stated: "The government has no legitimate interest in protecting the privacy of President Trump, the least private name in American life." The court also found that the trademark did not violate Trump's publicity rights, which protect a person's use of their name in commerce, because there were no allegations that Elster was exploiting the commercial value of Trump's name or implying that Trump endorsed the shirts. "The right of publicity cannot shield public figures from criticism."

The Federal Circuit ruling continues a trend of decisions favoring First Amendment rights over federal trademark restrictions. In Matal v. Tam, 582 U.S. ___, 137 S. Ct. 1744 (2017) (Asian-American rock band The Slants), the U.S. Supreme Court considered a provision of Section 2(a) of the Lanham Act that directed the PTO to deny registration of marks that "disparage … or bring … into contempt[] or disrepute" any "persons, living or dead." In Iancu v. Brunetti, 588 U.S. ___, 139 S. Ct. 2294 (2019) (artist Erik Brunetti's "FUCT" brand), the Court considered another provision of Section 2(a) of the Lanham Act that directed the PTO to deny registration of marks that "consist[] of or comprise[] immoral … or scandalous matter." The Court held both provisions unconstitutional because they violated the free speech clause of the First Amendment as viewpoint-based restrictions.

continued on next page

Similarly, the Federal Circuit held that Elster's First Amendment right to criticize public figures outweighs a federal law barring the registration of trademarks that use a person's name without their consent (and supersedes Trump's interests of privacy and publicity). Unlike the two prior U.S. Supreme Court cases holding the disparagement and immoral/scandalous clauses of Section 2(a) unconstitutional, however, the Federal Circuit did not strike down Section 2(c) altogether. Instead, the Federal Circuit decision found content-based discrimination based on the message conveyed in the mark. The Federal Circuit also observed in dicta that Section 2(c) may be unconstitutionally broad insofar as it did not permit the registration of marks that "advance parody, criticism, commentary on matters of public importance, artistic transformation or any other First Amendment interests."

Takeaway: Section 2(c) of the Lanham Act may have limited, if any, further effect on applications to register marks.

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