

# Federal Circuit Holds That Refusal to Register TRUMP TOO SMALL Mark Was Unconstitutional

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## Highlights

- It is unconstitutional to refuse registration to a trademark that criticises a public figure, even when the mark identifies the public figure by name, simply because the latter did not consent
- Applying Section 2(c) to bar registration of the mark unconstitutionally restricted free speech in violation of the First Amendment
- The decision tempers the reach of Lanham Act registration bars

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Entitlement to federal trademark registration is far from absolute or guaranteed, and a number of statutory bars exist to prevent registration of a mark, especially when concerning another individual. However, can refusal of trademark registration in such circumstances violate an applicant's constitutional right to freedom of speech under the First Amendment? In *In re Elster* (Case No 20-2205, 24 February 2022), the US Court of Appeals for the Federal Circuit opined on constitutionally protected speech in registering a mark identifying by name and criticising a public figure.

## Background

In 2018 Steve Elster sought to register TRUMP TOO SMALL for use on shirts in Class 25, apparently to “invoke[] a memorable exchange between President Trump and Senator Marco Rubio” and to “convey[] that some features of President Trump and his policies are diminutive”. The mark was

rejected by a US Patent and Trademark Office examiner under Sections 2(a) and 2(c) of the Lanham Act, respectively barring:

- registrations that suggest a false connection with, or endorsement by, a person (15 USC §1052(a) (2022)); or
- registrations that contain a living individual's name without said individual's consent (*id* at §1052(c)).

When Elster raised First Amendment concerns, the examiner felt that:

- the registration bars did not restrict speech;
- if speech was restricted it was permissible;
- and there was no carve-out in the law for political commentary.

Elster appealed the examiner's decision to the Trademark Trial and Appeal Board (TTAB), arguing that Sections 2(a) and 2(c) were improper content-based restrictions on free speech because the strict scrutiny standard of "narrowly tailored to serve a compelling government interest" was not met. The TTAB disagreed and affirmed the examiner's decision based on Section 2(c), finding it unnecessary to address Section 2(a). The TTAB recognised that it is without authority to decide constitutionality, but noted that prior TTAB decisions examined Section 2(c)'s constitutionality. It felt that, even if strict scrutiny applied, the government had compelling interests to avoid consumer source deception and protect a named person's rights of publicity and privacy. Elster appealed.

## Decision

Trademarks are not speech by government, nor do they clearly fit into a government subsidy framework. Further, the Lanham Act bars cannot be considered limited public forum speech restrictions because, while such a forum need not be physical, it still must be tethered to a government property where its effects are felt. Rather, trademarks are private speech, entitled to First Amendment protection, and such protection is not lost if the speech is sold or commercialised rather than given away freely.

The court approached Section 2(c) as a viewpoint-neutral content-based restriction on speech in the trademark area and ruled that, as applied, it met neither the strict scrutiny standard of being narrowly tailored to serve a compelling government interest, nor the intermediate scrutiny standard of directly advancing a substantial government interest. The court did not decide which standard should apply over the other.

A person's right to criticise a political figure was emphasised, and weighed against the political figure's rights of privacy and publicity. A public figure has no right of privacy protecting him or her from critical speech by another, unless it is false information published with actual malice (ie, knowingly or with reckless disregard). Thus, with no facts suggesting falsity or malice, Trump had no right of privacy, and the government had no substantial nor compelling interest to limit Elster's freedom of speech in expressing criticism of a public figure.

Regarding a public figure's rights of publicity, the government does have interest in protecting against the misappropriation of intellectual property, especially when it lessens distinctiveness or commercial value. However, the mark did not exploit Trump's commercial interests or dilute the commercial value of his name. The government also has an interest in preventing consumer confusion from a false suggestion of endorsement, but:

1. the mark did not suggest that Trump endorsed Elster's shirts; and
2. regardless, this right is covered by Section 2(a), which was not raised on appeal.

As such, the government again had no substantial nor compelling interest.

Perhaps most importantly, the government could not require Trump's consent for the mark for a number of reasons highlighted by the excerpts below (internal citations omitted):

- "The right of publicity does not support a government restriction on the use of a mark because the mark is critical of a public official without his or her consent... [Public figures] would... use that power to suppress criticism, and thus permanently remove a valuable source of information about their identity from the marketplace."
- "The right of publicity is particularly constrained when speech critical of a public official is involved... the right of publicity cannot shield public figures from criticism."

The court reversed the TTAB's rejection of the mark under Section 2(c) as an unconstitutional application under both strict scrutiny and intermediate scrutiny.

The court also shared constitutionality concerns regarding Sections 2(a) and 2(c), and other Lanham Act registration bars, and questioned whether Section 2(c) is impermissibly overbroad for a substantial number of its applications being unconstitutional. However, ultimately the court limited its decision to Section 2(c) as applied, because the TTAB decision only concerned section 2(c) and Elster's appeal only raised an as applied challenge.

## Comment

The decision reaffirms that trademarks can be private speech protected by the First Amendment. This decision also tempers the reach of Lanham Act registration bars, such as Section 2(c), especially if criticism of a public figure is what would be barred.

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