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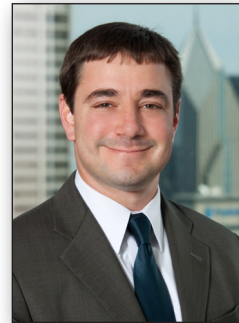
FALL 2024

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THE NAMES CLAUSE SEEMS
STRAIGHTFORWARD
BUT BECOMES MORE
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TRADEMARK EXPRESSES A
POLITICAL STATEMENT.

The Lanham Act's "Names Clause" Survives First Amendment Challenge

By Seth Appel



Trademark registration in the United States often intersects with Constitutional free speech rights.

In recent years, the U.S. Supreme Court has invalidated multiple provisions of the federal Trademark Act ("Lanham Act") on the ground that they violate the First Amendment. In *Vidal v. Elster*, however, the Court recently left intact the long standing prohibition against registration of names of living individuals without their consent. It thus upheld the refusal to register the politically charged phrase, TRUMP TOO SMALL, as a trademark for shirts.

Background and Prior Decisions

Use of famous names in trademarks has always been a delicate issue. Edward S. Rogers (our firm's founder and the primary drafter of the Lanham Act) stated in the House Committee hearings that "[t]he idea of prostituting great names by sticking them on all kinds of goods is very distasteful to me." Hearings on H.R. 9041 Before the House Committee on Patents, Subcommittee on Trade-Marks, 75th Cong., 3d Sess. 79 (1938). Section 2(c) of the Lanham Act prohibits registration of a trademark that "consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent." 15 U.S.C. 1052(c). This "names clause" seems straightforward, but becomes more complicated when the trademark expresses a political statement.

Matal v. Tam **Application to Register THE SLANTS**

Section 2(a) of the Lanham Act originally prohibited registration of a trademark that “consists of or comprises ... matter which may disparage.” Based on this provision, the USPTO refused registration of marks such as SQUAW for clothing and retail store services, *In re Squaw Valley Development Co.*, 80 USPQ2d 1264 (TTAB 2006); HEEB for clothing and entertainment services, *In re Heeb Media LLC*, 89 USPQ2d 1071 (TTAB 2008); and STOP THE ISLAMISATION OF AMERICA for providing information regarding understanding and preventing terrorism, *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014). Trademarks associated with the Washington Redskins football team also were denied registration for running afoul of the disparagement clause.

However, the Supreme Court struck down the disparagement clause in 2017. *Matal v. Tam*, 137 S.Ct. 1744 (2017). The USPTO had refused registration of THE SLANTS on the ground that it disparaged persons of Asian descent. The Court held that the disparagement clause was viewpoint discrimination in violation the First Amendment. Justice Alito, writing for the majority, stated that it “offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend.”

To be sure, the clause evenhandedly prohibits disparagement of all groups. It applies equally to marks that damn Democrats and Republicans, capitalists and socialists, and those arrayed on both sides of every possible issue. It denies registration to any mark that is offensive to a substantial percentage of the members of any group. But in the sense relevant here, that is viewpoint discrimination: Giving offense is a viewpoint.

The Court also rejected the argument that granting or refusing trademark registration is government speech, and therefore outside the First Amendment. “If private speech could be passed off as government speech by simply affixing a government seal of approval, government could silence or muffle the expression of disfavored viewpoints.”

UNLIKE THE DISPARAGEMENT CLAUSE AND THE IMMORAL/SCANDALOUS CLAUSE, THE SUPREME COURT DETERMINED THE NAMES CLAUSE IS VIEWPOINT NEUTRAL.

Iancu v. Brunetti **Application to Register FUCT**

Two years after *Tam*, the Supreme Court struck down a similar provision in Section 2(a) prohibiting registration of any trademark that “[c]onsists of or comprises immoral, ... or scandalous matter.” *Iancu v. Brunetti*, 139 S.Ct. 2294 (2019). That prohibition, which dated back to the Trademark Act of 1905, often was applied in recent years to marks containing words or images considered vulgar. *See, e.g., In re Boulevard Entertainment*, 334 F.3d 1336 (Fed. Cir. 2003) (affirming refusal to register JACK-OFF for “entertainment in the nature of adult-oriented conversations by telephone”); *In re Michalko*, 110 USPQ2d 1949 (TTAB 2014) (affirming refusal to register ASSHOLE REPELLENT for “amusement device, namely, a can with a spray top used as a gag gift and sold as a unit”); *In re Red Bull GMBH*, 78 USPQ 2d 1375 (TTAB 2006) (affirming refusal to register BULLSHIT for alcoholic and non-alcohol beverages and other items).

In *Brunetti*, the USPTO had refused registration of FUCT for clothing on the ground that it is immoral or scandalous under Section 2(a). However, the Supreme Court held that the bar against registering immoral or scandalous marks – like the bar against registering disparaging marks – disfavored certain ideas and thus constituted viewpoint discrimination.

Justice Kagan, writing to the majority, explained:

[T]he statute ... distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking offense and condemnation. The statute favors the former, and disfavors the latter.

Therefore, the Court concluded, the bar on registering immoral/scandalous marks “collide[s] with our First Amendment doctrine.”

Proposed Registration of TRUMP TOO SMALL

Against this background, Steve Elster applied to register TRUMP TOO SMALL as a trademark for shirts. This phrase referred to an exchange between then-candidate Donald Trump and Senator Marco Rubio during the 2016 Republican primary debate. Elster advertises and sells shirts displaying the statement “TRUMP TOO SMALL” on his website at www.trumptoosmall.com. His right to say this, or to sell his shirts, was not at issue in the case, only the issue of whether he was entitled to a trademark registration.



The USPTO refused registration under Section 2(c) because the proposed mark included the name of a “particular living individual,” and his written consent was not of record.

Based on the rationales of *Tam* and *Brunetti*, Elster contended that the bar against registering personal names similarly violates the First Amendment. However, the Supreme Court held it does not. Unlike the disparagement clause and the immoral/scandalous clause, the Court determined that the names clause is viewpoint neutral. Accordingly, Elster was not entitled to a trademark registration. *Vidal v. Elster*, 602 U.S. 286 (2024).

Justice Thomas, writing for the majority, distinguished the names clause from the two provisions that were previously held unconstitutional, quoting J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 13:37.50 (5th ed.):

The names clause does not facially discriminate against any viewpoint. No matter the message a registrant wants to convey, the names clause prohibits marks that use another person’s name without consent. It does not matter “whether the use of the name is flattering, critical or neutral.”

Elster argued that the names clause leads to viewpoint discrimination in practice because it is easier to obtain consent for a trademark that flatters a person rather than mocks him. The Court responded, however, that there are many reasons why a person might be unable to secure another’s consent: “Even when the trademark’s message is neutral or complimentary, a person may withhold consent to avoid

any association with the goods, or to prevent his name from being exploited for another’s gain.” The Court also rejected Elster’s point that there was viewpoint discrimination in practice, noting the USPTO has refused registration of marks such as WELCOME PRESIDENT BIDEN; I STUMP FOR TRUMP; and OBAMA PAJAMA – “all because they contained another’s name without his consent, not because of the viewpoint conveyed.”

The Court recognized that the names clause bars registration of marks based on their content, and accordingly, it considered for the first time the constitutionality of a content-based (but viewpoint-neutral) trademark registration restriction. To do this analysis, the Court dove into the history of trademark protection in the United States. It explained that “trademark rights have always coexisted with the First Amendment, despite the fact that trademark protection necessarily requires content-based distinctions.” For example, a basic function of trademark law has always been to prevent confusion as to the source of goods, which requires looking to the marks’ content. The Court decided that due to “the uniquely content-based nature of trademark regulation and the longstanding coexistence of trademark regulation with the First Amendment,” it need not apply heightened scrutiny to content-based restrictions on trademark registration.

In upholding the names clause, the Court cited various texts discussing trademark protection in the years before and after passage of the Lanham Act, including two scholarly articles by our late senior partner, Beverly Pattishall. It stated:

The Lanham Act’s names clause has deep roots in our legal tradition. Our courts have long recognized that trademarks containing names may be restricted. And, these name restrictions served established principles. This history and tradition is sufficient to conclude that the names clause—a content-based, but viewpoint-neutral, trademark restriction—is compatible with the First Amendment.

The Court added: “The notion that people should be able to use their own name to identify their goods or business is deeply rooted in American mores,” quoting B. Pattishall, D. Hilliard, & J. Welch, *Trademarks and Unfair Competition* § 2.06 (2001).

Notwithstanding *Vidal v. Elster*, it is important to remember that the names clause does not restrict use of phrases featuring politicians’ names, on shirts or otherwise. The First Amendment generally would protect an individual’s right to proclaim TRUMP TOO SMALL in most contexts; however, it does not ensure the right to register TRUMP – or any other famous name – as a trademark. ■

NEW ASSOCIATE

■ Erick Baldemar Rivera



We are pleased to welcome Erick Baldemar Rivera as an associate. Erick received his J.D. from Chicago-Kent College of Law, and worked at the Firm as a Summer Associate in 2023.

In law school, Erick was a Notes and Comments Editor for the *Chicago-Kent*

Law Review. He was also inducted into the Bar and Gavel Society for his service to the law school, and his paper “Mental Health, Remote Work, and Discrimination,” won the Mary Rose Strubbe Labor & Employment Writing Prize in 2024.

APPOINTMENTS

■ Ashly Boesche

Ashly has become a Fellow of the American Bar Foundation.

■ Thad Chaloehtiarana



Thad has been appointed Vice Chair of the Nominating Committee for the American Bar Association Section of Intellectual Property Law.

■ Robert Sacoff



Bob has been elected to a two year term on the Steering Committee of the AIPPI-US Division of the American Intellectual Property Law Association.

PRESENTATIONS

■ Ashly Boesche



Ashly gave a presentation at the American Bar Association annual meeting on August 1st, entitled “Is Imitation the Sincerest Form of Flattery? The Rise of Dupe Culture and Deep Fakes in This AI Revolution.”

PUBLICATIONS

■ Seth Appel

Seth’s case note, “Trademark Registration of TRUMP TOO SMALL is Not Protected by First Amendment, Supreme Court Holds,” was published in the July *AIPPI Newsletter*.

*firm*NOTEWORTHY

Pharmaceutical Trade Marks Group

Pattishall McAuliffe was a proud sponsor of this year’s Autumn Conference held from October 16-19 in St Julian’s, Malta.

Who’s Who Legal: Thought Leaders USA

David Hilliard, Janet Marvel and Robert Sacoff have been recognized as being among the country’s leading trademark lawyers for 2025.