

Oral Argument at the Supreme Court Suggests Refusing to Register TRUMP TOO SMALL Trademark Did Not Violate the First Amendment

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Supreme Court Building in Washington, DC, United States

The Supreme Court heard oral arguments in *Vidal v. Elster* this week, which asks whether refusing to register a trademark that criticizes President Trump violates the Free Speech Clause of the First Amendment. It seems the Supreme Court is poised to say it does not.

This dispute dates back 2018, when Elster applied to register the TRUMP TOO SMALL mark for use on T-shirts and other apparel. The Trademark Office refused to register TRUMP TOO SMALL under Section 2(c) of the Lanham Act, which prohibits registration of any mark that “consists of or comprises a name, portrait or signature identifying a particular living individual except by his written consent” under certain circumstances. The Trademark Trial and Appeal Board (TTAB) affirmed the refusal to register, finding

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that Section 2(c) merely sets criteria for obtaining a federal trademark registration and does not restrict speech.

However, as we previously reported, the Federal Circuit Court of Appeals reversed the TTAB, finding that Section 2(c) does impermissibly “chill speech” in this circumstance and may be impermissibly overbroad. In short, the Federal Circuit found that Elster’s intended use of the mark—to sell TRUMP TOO SMALL clothing that suggests President Trump’s policies and features are diminutive—was speech protected by the First Amendment and the government does not have a valid interest restricting speech critical of government officials or public figures. Questions from the Supreme Court Justices during the oral argument on Wednesday may suggest the Federal Circuit got this one wrong.

The Justice Department, arguing on behalf of the United States Patent and Trademark Office, argued that Section 2(c) does not run afoul of the First Amendment because denying registration of the TRUMP TOO SMALL mark does not prohibit Elster from selling T-shirts with the slogan. Elster could still use the mark, he just would not have exclusive rights to the mark or any other benefits afforded by federal trademark registrations.

It seems the majority of the Justices agree. At one point, Justice Alito even joked to the Justice Department “You don’t need my vote to win your case.”

Justice Sotomayor indicated that this comes down to “first principles” the question being “is this an infringement of speech? And the answer is no.” She later told Elster’s counsel that “[y]ou’re not talking about stopping speech” rather: “You’re talking about not receiving government protection for activity that you would like to heighten protection for. It doesn’t stop you from selling.” Justice Kagan then pointed out that there is a long line of analogous cases indicating that the government can give or withhold benefits without restricting speech, suggesting this is such a case.

Justice Gorsuch went on to note the “long and robust history about restricting names” from trademark protection and the several other limitations on registration such as marks that incorporate geographic names and descriptive terms.

Chief Justice Roberts suggested that allowing Elster to register TRUMP TOO SMALL could actually suppress speech—Elster could prevent others from using the phrase to criticize President Trump by enforcing his trademark against them. The Chief Justice expressed concern that this suppression could be heightened if it causes a “race for people to trademark...Trump Too This, Trump Too That, whatever, and then particularly in an area of political expression, that really cuts off a lot of expression.”

It appears that the Supreme Court is likely to find that Section 2(c), at least in this context, is not unconstitutional. Stay tuned to the TMCA for an update when the Supreme Court issues their opinion.