

Rights of Privacy and Publicity TOO SMALL to Overcome First Amendment Freedom of Speech

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During the 2016 presidential primaries, then presidential candidates Donald Trump and Senator Marco Rubio exchanged insults, with Trump calling Rubio “Little Marco” and Rubio commenting on the size of Trumps hands. Recently, this exchange was the basis for a Federal Circuit decision reversing a refusal to register the trademark TRUMP TOO SMALL as an unconstitutional restriction of speech under the First Amendment.

In 2018, Steve Elster applied to register the mark for use on T-shirts and related apparel. As the Federal Circuit recounts, “According to Elster’s registration request, the phrase he sought to trademark invokes a memorable exchange between President Trump and Senator Marco Rubio . . . and ‘aims to ‘convey[] that some features of President Trump and his policies are diminutive.’” The Examining Attorney at the United States Patent and Trademark Office denied Mr. Elster’s application under Sections 2(a) and 2(c) of the Lanham Act. On appeal to the Trademark Trial and Appeal Board (“TTAB”), the TTAB affirmed the refusal of the application, relying solely on Section 2(c) of the Lanham Act.

Section 2(c) of the Lanham Act prohibits registration of a trademark that: “Consists of or

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comprises a name, portrait or signature identifying a particular living individual except by his written consent.” 15 U.S.C. § 1052(c). Section 2(c) does not prohibit *all* uses of an individual’s name in a trademark. Rather, it applies only when: (1) the public would reasonably assume that the goods associated with the mark are connected with the particular individual due to the individual’s fame or recognition; or (2) the individual is publicly connected with the business in which the mark is, or will be, used.

There was no dispute that President Trump is sufficiently famous to fall within the protection of Section 2(c) “not only because of his political office but also because of his prior celebrity.” Elster argued that refusing to register the TRUMP TOO SMALL trademark violated his right to free speech under the First Amendment. The TTAB noted that as an administrative tribunal, it does not have the authority to strike down any statute as unconstitutional, but noted that a constitutional challenge may involve “many threshold questions . . . to which the [agency] can apply its expertise”, and went on to find that the refusal to register TRUMP TOO SMALL was not unconstitutional.

The TTAB first opined that Section 2(c), like all of Section 2 of the Lanham Act, merely sets forth criteria for obtaining a federal trademark registration. It does not control the *use* of the trademark. Indeed, one can use a trademark in commerce without obtaining a registration and Elster could do so here even if the registration is denied. Second, the TTAB found that Section 2(c) does not restrict any particular type of speech, but applies in “an objective, straightforward way to any proposed mark that consists of or comprises the name of a particular living individual, regardless of the viewpoint conveyed by the proposed mark.” Accordingly, the TTAB affirmed the Examiner’s refusal to register TRUMP TOO SMALL.

On appeal, the Federal Circuit reversed the TTAB, finding that Section 2(c) is unconstitutional as applied to the TRUMP TOO SMALL trademark, while deferring any decision on whether it is unconstitutional in all cases. The Court noted that trademarks can be protected speech and that denying registration, while not prohibiting use of the trademark, “chills speech” by stripping the mark of the many advantages associated with federal registration. Accordingly, there must be a substantial government interest to justify restricting speech by denying a registration.

The purpose of the Section 2(c) is to protect state law rights of privacy and publicity that individuals have in their names, appearance, and likeness. The Court quickly found that a right of privacy cannot shield a public official from comment or criticism. The Court also questioned whether a political figure maintains a right of publicity at all. At the very least, the political figure’s right of publicity would not permit a prohibition on the distribution of posters, buttons, apparel, or other materials that express support for or disagreement with the political figure. In short, “[a]s a result of the President’s status as a public official and because Elster’s mark communicates his disagreement with and criticism of the then-President’s approach to governance, the government has no interest in disadvantaging Elster’s speech.”

As we reported previously, the Supreme Court has found that portions of Section 2(a) of the Lanham Act, which prohibit the registration of “immoral, deceptive, or scandalous”

trademarks and trademarks “which may disparage . . . any persons, living or dead” are unconstitutional. While this opinion expands the Supreme Court’s reasoning to Section 2(c), whether its reasoning applies to trademarks that do not involve political figures or that do not criticize famous individuals remains to be seen. The Federal Circuit noted that it was only asked to analyze Section 2(c) as applied to Elster’s mark. But it did go on to note that Section 2(c) may be “impermissibly overbroad” because it does not leave the USPTO discretion to permit registration for marks that advance First Amendment interests.