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Does TRUMP Trademark Ruling Create First Amendment Exception That Is TOO BIG or TOO SMALL?

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Interesting question: Can someone trademark another person's name without that person's consent? The answer to that is usually "no," but, hey, we would not be the first people to say that we live in interesting times. And if we said that, we would not be infringing on anyone's rights. That aside, the answer to the first question this week is "yes," at least when the person is a public figure, and the trademark is viewed as an exercise of free speech critical of that public figure.

So, let's turn to the interesting case of *In re: Steve Elster,* Case no. 2020-2205, slip op. (Fed. Cir. 2022) (hereinafter "*Elster*"), decided February 24th by the United States Court of Appeals for the Federal Circuit (the "CAFC"). Its opinion tells the story of an effort to incorporate the word TRUMP into a trademark without the 45th President's consent.

The story begins in 2018, when Steve Elster sought to register the phrase "TRUMP TOO SMALL" for use on shirts. According to Elster's registration request, the phrase he sought to trademark 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 Patent and Trademark Office ("PTO") examiner rejected Elster's proposed mark, concluding that the mark was not registrable because Section 2(c) of the Lanham Act bars registration of a trademark that "[c]onsists of or comprises a name . . . identifying a particular living individual" without the individual's "written consent." 15 U.S.C. § 1052(c). The PTO concluded that the mark was not registrable because it used President Trump's name without his consent. (In recent years, the PTO had also rejected marks critical of Trump's predecessor, such as OBAMA (DIDN'T) CARE, OBAMA PRESIDENCY SURVIVOR, and OBAMA, YOU'RE FIRED!). The PTO simultaneously rejected Elster's contention that the denial of the registration violated his First Amendment right to free speech.

Elster appealed the denial of his application to the Trademark Trial and Appeals Board (the "Board"), raising the same constitutional argument that he has a First Amendment interest in commentary and criticism regarding a political figure. The Board affirmed the examiner's denial of the mark and concluded that Section 2(c) was not an unconstitutional restriction on free speech. Elster appealed to CAFC.

In reaching its conclusion that the denial of the mark *did* violate Elster's First Amendment rights, the

CAFC made three necessary findings.

First, the CAFC definitively concluded that a trademark is private speech entitled to First Amendment protection. In so finding, the CAFC relied upon prior Supreme Court precedent that challenged the constitutionality of the related Section 2(a) of the Lanham Act on free speech grounds—*Matal v. Tam*, S. Ct. 1744 (2017) and *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019). *Tam* and *Brunetti* establish that a trademark represents "private, not government, speech" entitled to some form of First Amendment protection. *Tam*, 137 S. Ct. at 1760; *see also Brunetti*, 139 S. Ct. at 2299. Those cases also establish that trademarks often "do not simply identify the source of a product or service but go on to say something more" on "some broader issue." *Tam*, 137 S. Ct. at 1764 (Alito, J.). Trademarks frequently "have an expressive content" and can convey "powerful messages . . . in just a few words." *Id.* at 1760. *Brunetti* further established that denying trademark registration "disfavors" the speech being regulated. 139 S. Ct. at 2297. While the government in *Elster* argued that denial of the registration did nothing to prevent Mr. Elster's ability to communicate his message, the central question, according to the CAFC, was "whether section 2(c) can legally disadvantage the speech at issue here." *Elster* at 6. Ultimately, the CAFC held that "Elster's mark is speech by a private party in a context in which controversial speech is part-and-parcel of the traditional trademark function, as the Supreme Court decisions in *Tam* and *Brunetti* attest. Under such circumstances, the effect of the restrictions imposed with the subsidy must be tested by the First Amendment." *Id.* at 7.

Second, the CAFC held that Elster's Frist Amendment interests in his "TRUMP TOO SMALL" mark were valid, and "undoubtedly substantial." *Elster* at p 9. "Whatever differences may exist about interpretations of the First Amendment, there is practically universal agreement that a major purpose of that Amendment was to protect the free discussion of governmental affairs." *Mills v. Alabama*, 384 U.S. 214, 218 (1966); *see also N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 269 (1964) ("The general proposition that freedom of expression upon public questions is secured by the First Amendment has long been settled by our decisions.").

Third, the CAFC rejected the government's argument that its substantial interest in protecting state-law privacy and publicity rights outweighed Elster's free speech rights. As the CAFC explained, "[t]he question here is whether the government has an interest in limiting speech on privacy or publicity grounds if that speech involves criticism of government officials— speech that is otherwise at the heart of the First Amendment." *Elster* at p 11. In finding no privacy basis for denial of Elster's mark, the CAFC explained that "there can be no plausible claim that President Trump enjoys a right of privacy protecting him from criticism in the absence of actual malice . . . when the restricted speech comments on or criticizes public officials, the government has no interest in disadvantaging the speech to protect the individual's privacy interests." *Id.* "With respect to privacy, the government has no legitimate interest in protecting the privacy of President Trump, 'the least private name in American life,' [] from any injury to his 'personal feelings' caused by the political criticism that Elster's mark advances." *Id.* at 12.

Similarly, the CAFC rejected the argument that Trump's name had been misappropriated in a manner that exploits his commercial interests or dilutes the commercial value of his name, an existing trademark, or some other form of intellectual property. While the government, in protecting the right of publicity, has an interest in preventing the issuance of marks that falsely suggest that an individual—including the President—has endorsed a particular product or service, the CAFC found there could be "[n]o plausible claim . . . that the disputed mark suggests that President Trump has endorsed Elster's product." *Id.* at 14. "As 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." *Id.* at

17. Ultimately, the CAFC refused to sustain the PTO's refusal to register Elster's mark because "the government does not have a privacy or publicity interest in restricting speech critical of government officials or public figures in the trademark context—at least absent actual malice, which is not alleged here." *Id.* at 19.

While this ruling does clarify and narrow the scope of Section 2(c) for marks using the name of public figures to express criticism of such officials, its overall interplay with the First Amendment remains in limbo. Though the CAFC held that it had "no occasion to decide whether the statute is constitutionally overbroad" because Elster "raised only an as-applied challenge before this court," it did note its apprehension that Section 2(c) raises concerns regarding overbreadth. *Id.* Whether a new challenge will arise squarely addressing the overall breadth of Section 2(c) and its interplay with the First Amendment will be an issue to watch moving forward. Like the CAFC, "we reserve the overbreadth issue for another day." *Id.* at 20.

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