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Trump Really *Is* Too Small

THE RIGHT TO TRADEMARK POLITICAL COMMENTARY

Samuel F. Ernst[†]

“Every joke is a tiny revolution. If you had to define humour in a single phrase, you might define it as dignity sitting on a tin-tack. Whatever destroys dignity, and brings down the mighty from their seats, preferably with a bump, is funny.”
—George Orwell¹

INTRODUCTION

The latest provision of the Lanham Act to fall victim to the First Amendment is section 2(c), which provides that you cannot federally register a mark that “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.”² On February 24, 2022, the Court of Appeals for the Federal Circuit held that this provision is unconstitutional as applied to the mark TRUMP TOO SMALL—a mark intended as criticism of defeated former President Donald Trump’s failed policies and certain diminutive physical features. Specifically, the court held that, as applied to a mark commenting on a political figure, “section 2(c) involves content-based discrimination that is not justified by either a

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¹ George Orwell, *Funny, but Not Vulgar* (1945), reprinted in GEORGE ORWELL, *FUNNY, BUT NOT VULGAR AND OTHER SELECTED ESSAYS AND JOURNALISM* 119 (The Folio Society ed. 1998).

² Trademark Act of 1948 (Lanham Act), Pub. L. No. 79-489, § 2(c), 60 Stat. 427, 428 (codified as amended at 15 U.S.C. § 1052(c)). Although the provision prohibits registration of the “portrait” or “signature” of a particular individual in addition to that person’s “name,” for convenience and conciseness I will refer only to the “name” ban throughout this paper.

compelling or substantial government interest.”³ This is because the provision denies registration based simply on the subject matter being discussed—here, Donald Trump. In dictum the court stated that section 2(c) may be facially unconstitutional as overbroad, because a substantial number of its applications violate free speech.⁴ But because the appellant, Steve Elster, only raised an as-applied challenge, the court “reserve[d] the overbreadth issue for another day.”⁵

Under the Supreme Court’s First Amendment jurisprudence—and, in particular, under its decisions in *Matal v. Tam* and *Iancu v. Brunetti*—the Federal Circuit’s decision is correct.⁶ Unlike the provisions at issue in *Tam and Brunetti*, which barred the registration of disparaging, immoral, and scandalous marks, section 2(c) does not discriminate against speech based on the viewpoint expressed; rather it bars the registration of a famous person’s name whether the mark in question praises, criticizes, or is neutral about that person. The provision is, nonetheless, a content-based restriction and is therefore subject to at least intermediate scrutiny (if we view trademarks as commercial speech). Intermediate scrutiny requires that section 2(c) advance a substantial government interest and be narrowly tailored to serve that interest.⁷ The government argued it has a substantial interest in barring the registration of celebrities’ names without their consent to protect the right of publicity.⁸ But even if the federal government has a substantial interest in protecting the state right of publicity, section 2(c) is not tailored to meet that interest.

Every state that protects the right of publicity allows for some First Amendment defense and “recogniz[es] that the right of publicity cannot shield public figures from criticism.”⁹ But section 2(c) requires the Patent and Trademark Office (PTO) to reject registration of a famous person’s name without taking *any* countervailing interests into account, First Amendment or otherwise. The provision is therefore hostile to animating First

³ *In re Elster*, 26 F.4th 1328, 1331 (Fed. Cir. 2022).

⁴ *Id.* at 1339.

⁵ *Id.*

⁶ See *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017) (holding that the Lanham Act’s bar on the registration of disparaging marks is facially unconstitutional); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (2019) (holding that the Lanham Act’s bar on the registration of immoral and scandalous marks is facially unconstitutional).

⁷ See *In re Elster*, 26 F.4th at 1333–34 (“Whatever the standard for First Amendment review of viewpoint-neutral, content-based restrictions in the trademark area, whether strict scrutiny or intermediate scrutiny there must be at least a substantial government interest in the restriction.”) (internal citations omitted).

⁸ *Id.* at 1334.

⁹ *Id.* at 1338.

Amendment principles. Speech subjecting powerful people to comic ridicule has long been used as a form of political resistance, and often distributed on signs, clothing, and other novelty items.¹⁰ Of course, the denial of federal registration does not prevent an applicant from expressing the political commentary or even using the mark in commerce. But federal registration confers such critically important benefits on a trademark applicant that its denial results in a substantial burden on speech and is therefore subject to First Amendment scrutiny.¹¹

In its petition for en banc or panel rehearing, the government suggested a new argument: that section 2(c) actually *promotes* free speech.¹² After all, if the PTO were to grant Elster a federal registration in TRUMP TOO SMALL, Elster would have a limited right to exclude others from using that mark in commerce, at least insofar as there would be a likelihood of consumer confusion. Or, as the government overstates it, “under the panel’s decision, Elster can now enlist the federal courts in preventing every other member of the public from engaging in what the panel characterized as speech ‘at the heart of the First Amendment.’”¹³ The notion that Elster could wield such power with his mark is highly unlikely—indeed, nigh on impossible. And the argument that such a hypothetical fear preserves the constitutionality of section 2(c) must be rejected under the Supreme Court’s First Amendment precedent.¹⁴

Nonetheless, the government’s argument raises a more general concern regarding the dangers of granting trademark protection in political commentary. Federal registration of a mark containing political commentary grants an exclusionary right and can therefore pose a real threat to free speech, because the mark holder can prevent others from saying the same political commentary in commerce insofar as it would result in trademark infringement.¹⁵ A more likely threat to free speech

¹⁰ See *infra* Sections II.B.2, II.C.

¹¹ For example, federal registration is a prerequisite to bringing suit in federal court, provides a legal presumption of ownership and right to use, and eventually results in the mark becoming incontestable in certain situations. See *Why Register Your Trademark?*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/why-register-your-trademark> [<https://perma.cc/SGF7-MS37>]; 15 U.S.C. § 1065.

¹² Petition for Panel Rehearing and Rehearing en banc at 11–12, *In re Elster*, 26 F.4th 1328 (May 2, 2022) (No. 20-2205), ECF No. 62 [hereinafter Rehearing Petition]. The Federal Circuit denied rehearing on August 31, 2022. Order on Petition for Panel Rehearing and Rehearing En Banc at 2, *In re Elster*, 26 F.4th 1328 (Aug. 31, 2022) (No. 20-2205), ECF No. 72.

¹³ Rehearing Petition, *supra* note 12, at 11–12.

¹⁴ See *infra* Part III.

¹⁵ See *infra* Section III.B.

than granting registration to someone like Elster, however, would be if politicians were to register marks mocking or criticizing themselves merely to exclude others from using such speech in commerce.

To give a hypothetical example, if Donald Trump were the first to register the mark TRUMP TOO SMALL, he might be able to exclude others from selling T-Shirts or bumper stickers levying that same charge (assuming Trump swallowed his pride and made some bona fide use of the mark in commerce). The Lanham Act (the Act) does not prohibit politicians from registering marks containing political commentary about themselves,¹⁶ thereby reaping the rewards of a federal registration; but it forbids other citizens from registering marks containing a politician's name without their permission.¹⁷ Hence, the Act creates a regime that burdens critical political commentary while incentivizing propaganda. Indeed, the Act harms free speech when it allows politicians and other celebrities to register marks *praising* themselves if they use those marks to restrict similar such commentary by others in commerce. And even private individuals are free to register a mark containing political commentary and use it to chill free speech, so long as they do not use a famous person's name and the mark otherwise qualifies for trademark protection. Section 2(c) does nothing to prevent these concerns. Hence, to the extent the government is genuinely concerned with the chilling effect of registering political commentary, section 2(c) does very little, if anything, to directly advance that interest, as would be required for it to survive intermediate scrutiny. The fact that other provisions of the Lanham Act allow for the registration of political commentary is the real threat to free speech.¹⁸

These worries implicate a broader critique of the Supreme Court's approach to free speech. The Court views the First Amendment in purely negative terms as only protecting the rights of the individual speaker, instead of guaranteeing a society with vigorous speech on all sides. Free speech would benefit from a nuanced, balancing approach, rather than the rigid categories dictated by the Court's First Amendment opinions. This is particularly true in the case of intellectual property, wherein the speaker is often not only asserting the right to speak, but also to exclude others from saying the same thing.¹⁹

¹⁶ See, e.g., MAKE AMERICA GREAT AGAIN, Registration No. 4773272.

¹⁷ See *infra* Section III.A.

¹⁸ See *infra* Section III.B.

¹⁹ See *infra* Section III.B.

These concerns with the registration of marks containing political commentary can be addressed using traditional trademark doctrine and without violating the First Amendment. The PTO may deny registration if a mark is not used as a source indicator under the “failure to function” doctrine.²⁰ A mark “must be used as a mark—featured in a way that will draw consumers’ attention to it and lead them to view it as a source indicator.”²¹ In most cases, consumers would not view political slogans printed on T-Shirts, bumper stickers, and such like as source indicators of those goods. They are political commentary, not trademarks, and the trademark laws should not be used to exclude other people from printing the same or similar slogans on goods in commerce. Any artistic expression in political slogans might be protectible under the Copyright Act, but subject to term limitations and other requirements that the Lanham Act does not impose.

Hence, the issues raised in the *Elster* case, like many other contemporary trademark issues, implicate the ways in which the Lanham Act has improperly evolved from a consumer protection statute into an intellectual property regime, resulting in the troubling proposition that people can own mere words. Property-based trademark protections, such as section 2(c) and the dilution statute,²² are not justified by the government’s legitimate interest in regulating commerce to free it from deception and consumer confusion. Nor are they grounded in an explicit enumerated power to grant rights of exclusion, as are patents and copyrights. Accordingly, such property-based trademark protections should be declared unconstitutional in violation of the First Amendment, because the chilling effect they have on free speech outweighs any legitimate government interest.

Part I provides the background to section 2(c), the *Elster* case, and the *Tam* and *Brunetti* cases. Part II discusses why the Federal Circuit properly determined that section 2(c) is unconstitutional as applied to TRUMP TOO SMALL and argues that the statute is, in fact, facially invalid under Supreme Court precedent. Part III discusses the government’s new argument

²⁰ See *infra* Part IV.

²¹ Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 1977 (2019). A “source indicator” communicates to the consumer the company or other source that produces the goods. See *id.* at 1977–79.

²² The dilution statute provides protection from the dilution by tarnishment or blurring of “famous” trademarks, even in the absence of a likelihood of consumer confusion or any other harm related to a consumer protection policy. Tarnishment occurs when a famous mark’s reputation is degraded by association with another mark. Similarly, blurring is when a famous mark’s distinctiveness is affected by association with another mark. See 15 U.S.C. § 1125(c).

that section 2(c) protects political speech and rejects that argument. This Part then goes on to discuss the real threats to political speech posed by trademark registration and how the Supreme Court's rigid First Amendment analysis fails to address these threats. Part IV discusses how the "failure to function" doctrine might serve as a more appropriate remedy for the Lanham Act's threats to free speech. Part IV concludes by observing that the free speech concerns in trademark law find their origin in its unfortunate evolution from a consumer protection regime into a body of law that improperly encroaches into the realm of intellectual property, granting exclusionary rights in words and symbols without the strictures or constitutional grounding of the Copyright Act. Property-based trademark provisions such as section 2(c) and the dilution statute should be stricken as unconstitutional.

I. BACKGROUND

A. *TRUMP TOO SMALL and Section 2(c) of the Lanham Act*

The origins of Elster's TRUMP TOO SMALL mark, and its ultimate clash with section 2(c), can be traced to the 2016 Republican presidential primaries. In March of that year, Senator Marco Rubio spoke to reporters about his opponent, Donald Trump.²³ According to CNN, Rubio said:

He's always calling me Little Marco. And I'll admit he's taller than me. He's like 6'2, which is why I don't understand why his hands are the size of someone who is 5'2 . . . And you know what they say about men with small hands? You can't trust them.²⁴

The original source of Rubio's comments was reputedly *Vanity Fair* editor Graydon Carter, who claimed to have taunted Trump for twenty-five years about his small fingers: "Just to drive him a little bit crazy, I took to referring to him as a 'short-fingered vulgarian' in the pages of *Spy* magazine. That was more than a quarter of a century ago."²⁵

Subsequently, at the March 3, 2016 Republican Presidential Debate, Trump attempted to refute Rubio's comments as follows: "Nobody has ever hit my hands. I have never heard of this. Look at those hands. Are they small

²³ Gregory Krieg, *Donald Trump Defends Size of His Penis*, CNN (Mar. 4, 2016, 1:32 PM), <https://www.cnn.com/2016/03/03/politics/donald-trump-small-hands-marco-rubio> [<https://perma.cc/4K7R-GPVH>].

²⁴ *Id.*

²⁵ *Id.*

hands? . . . And he referred to my hands, if they are small, something else must be small. I guarantee you there is no problem. I guarantee.”²⁶ Trump’s crude comments at what should have been a serious policy debate drew widespread publicity and condemnation.²⁷

The mocking of Trump for his diminutive features did not stop there. During Trump’s presidency, Steve Elster filed an application with the PTO to register the mark TRUMP TOO SMALL in connection with T-shirts.²⁸ Elster contended that the mark “is political commentary about [Trump’s] refutation at the March 3, 2016 Republican debate of presidential candidate Marco Rubio’s insinuation that Donald Trump has a small penis.”²⁹ Elster further asserted that the mark “is also political commentary about the smallness of Donald Trump’s overall approach to governing as President of the United States.”³⁰

The PTO denied registration of the mark pursuant to section 2(c).³¹ That provision provides that the PTO must deny registration if a mark “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.”³² A provision requiring the denial of registration on this basis appears to be unique to US law. However, in the 2019 revision to the Model Trademark Guidelines, the International Trademark Association (INTA) recommended the adoption of the first part of section 2(c) by other countries. INTA recommended denying registration if a mark “consists of or comprises the name, portrait or signature of a particular living individual except with his or her written consent.”³³ As

²⁶ *Transcript of the Republican Presidential Debate in Detroit*, N.Y. TIMES (Mar. 4, 2016), <https://www.nytimes.com/2016/03/04/us/politics/transcript-of-the-republican-presidential-debate-in-detroit.html>.

²⁷ See, e.g., Dan Balz, *One Clear Loser in Thursday’s Debate: The Grand Old Party*, WASH. POST (Mar. 4, 2016), https://www.washingtonpost.com/politics/one-clear-loser-in-thursdays-debate-the-grand-old-party/2016/03/04/95cc5102-e1cc-11e5-8d98-4b3d9215ade1_story.html [<https://perma.cc/JYP9-LL4P>] (“[T]he debate did next to nothing to make Trump or his three remaining rivals look or sound presidential.”).

²⁸ *In re Elster*, 26 F.4th 1328, 1330 (Fed. Cir. 2022).

²⁹ Response to Non-Final Office Action, *reprinted in* Corrected Joint Appendix at 138, *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022) (No. 20-2205), ECF No. 43 [hereinafter Joint Appendix].

³⁰ *Id.*

³¹ *In re Elster*, 26 F.4th at 1330.

³² 15 U.S.C. § 1052(c).

³³ INT’L TRADEMARK ASS’N, MODEL TRADEMARK LAW GUIDELINES: A REPORT ON CONSENSUS POINTS FOR TRADEMARK LAWS § 3.2 (2019), <https://www.inta.org/wp->

justification, INTA stated that the proposal “would allow opposition or revocation based on prior intellectual property rights which may not be the subject of a trademark application or registration.”³⁴ INTA did not specify which “prior intellectual property rights” it was referring to, but one suspects it is the right of publicity discussed below.

Section 2(c) was enacted as part of Congress’s mammoth reconstruction and codification of federal trademark law in the 1946 Lanham Act.³⁵ The legislative history of the provision is sparse and relates only to the portion about deceased presidents. In particular, some legislators were concerned that trademarking the name of a deceased president in certain contexts could be unseemly. One House member stated, “we would not want to have Abraham Lincoln gin.”³⁶ Another member agreed, but with qualifications, stating, “Abraham Lincoln gin ought not to be used, but I would not say the use of G. Washington on coffee should not be permissible.”³⁷ Representative Lanham himself stated: “I do not believe that George Washington should have his name bandied around on every commonplace article that is in ordinary use, because I think we have better ways of preserving the name and the fame of George Washington than in that manner.”³⁸ In fact, there is a long tradition of people naming their products and businesses after presidents and other famous political figures, without apparent pushback or controversy.³⁹ Indeed, despite section 2(c), the practice continues in modern times.⁴⁰ Most presidents have

content/uploads/public-files/advocacy/model-laws-guidelines/INTA-Model-Trademark-Law-Guidelines-v2019.pdf [https://perma.cc/X5RL-K7VA].

³⁴ *Id.*

³⁵ 15 U.S.C. § 1051.

³⁶ *Hearing on H.R. 4744 Before the Subcommittee on Trademarks of the House Committee on Patents*, 76th Cong., 18–21 (1939) (statement of Representative Maroney), as reprinted in U.S. GOV’T PRINTING OFF., HEARINGS BEFORE THE COMMITTEE ON PATENTS, SUBCOMMITTEE ON TRADE-MARKS MARCH 28, 29, 30, 1939, 76TH CONG. 14 (1939), <https://www.google.com/books/edition/Hearings/WvqVaA8kpZgC?hl=en&gbpv=0>.

³⁷ *Id.* (statement of Representative Rogers).

³⁸ *Hearings on H.R. 9041 Before the Sub-committee on Trademarks of the House Committee on Patents*, 75th Cong. 80 (1939) (statement of Representative Lanham), as reprinted in U.S. GOV’T PRINTING OFF., HEARINGS BEFORE THE COMMITTEE ON PATENTS, SUBCOMMITTEE ON TRADE-MARKS MARCH 15, 16, 17, 18, 1938, 75TH CONG. 80 (1938), https://www.google.com/books/edition/Trade_marks/sn0oAAAAMAAJ?hl=en&gbpv=0.

³⁹ See, e.g., Brian Baker, *Presidential Names and Automobiles*, AUTO. HALL OF FAME (Feb. 11, 2021), <https://www.automotivehalloffame.org/presidential-names-and-automobiles/> [https://perma.cc/64RC-WYP9] (discussing cars named after Abraham Lincoln, George Washington, and First Lady Dolly Madison).

⁴⁰ See, e.g., Simone Weichselbaum, *Obama’s Name Sparks Numerous Local Business Name Changes, Owners Have Pride in First Black President*, DAILY NEWS (June 6, 2011, 4:00 AM), <https://www.nydailynews.com/new-york/obama-sparks-numerous-local-business-owners-pride-black-president-article-1.126061> [https://perma.cc/TVG9-DASN].

largely ignored it, and one might speculate that this is because they have more pressing business to deal with.⁴¹

According to the PTO, however, the purpose of the first part of section 2(c) dealing with living individuals “is ‘to protect rights of privacy and publicity that living persons have in the designations that identify them.’”⁴² With respect to celebrities and famous political figures, the PTO denies registration under this provision under a simple, two-part test. Registration is denied if (1) “the public would recognize and understand the mark as identifying a particular living individual”⁴³ and (2) “the record does not contain the famous person’s consent to register the mark.”⁴⁴ The PTO does not further inquire into whether the mark suggests a false connection with the celebrity, causes source confusion, is deceptive or misleading, or into any of the other relevant inquiries rooted in trademark policy.⁴⁵ Nor could the PTO plausibly interpret section 2(c) to require these further inquiries because it would render the section duplicative of the other subsections within the Act that do impose such restrictions.⁴⁶

Hence, pursuant to section 2(c), the PTO denies registration to marks that appear intended to capitalize on the celebrity’s name to sell products or even “pass off” those products

⁴¹ See Dave Gilson, *Most Presidents Ignore Products that Rip off Their Names. Will Trump?*, MOTHER JONES (Feb. 13, 2017), <https://www.motherjones.com/politics/2017/02/trump-name-publicity-rights/> [<https://perma.cc/B7H7-5QYS>] (“Despite his initial promise to keep a close watch on his image, Obama would eventually ignore thousands of products with no political message that likely infringed on his publicity rights.”).

⁴² U.S. PAT. & TRADEMARK OFF., TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1206 (2022) [hereinafter TMEP], <https://tmepp.uspto.gov/RDMS/TMEP/current#/current/TMEP-1200d1e1.html> [<https://perma.cc/2SWX-WTLC>] (quoting *In re ADCO Indus. Techs., L.P.*, 2020 WL 730361, at *7–8 (TTAB 2020)).

⁴³ *In re Nieves & Nieves L.L.C.*, 113 U.S.P.Q.2d 1629, 2015 WL 496132, at *12 (T.T.A.B. 2015). With respect to individuals that are not “well-known,” the PTO only applies the ban on an additional finding that “the individual is publicly connected with the business in which the mark is used.” *In re ADCO Indus. Techs., L.P.*, 2020 WL 730361, at *10.

⁴⁴ Samuel F. Ernst, *Section 1052(c) of the Lanham Act: A First Amendment Free Zone?*, PATENTLYO (Dec. 12, 2021), <https://patentlyo.com/patent/2021/12/section-lanham-amendment.html> [<https://perma.cc/QJL3-JL6Q>]; *In re Nieves & Nieves L.L.C.*, 113 U.S.P.Q.2d 1629, 2015 WL 496132, at *12 (T.T.A.B. 2015).

⁴⁵ See *In re Hoefflin*, 97 U.S.P.Q.2d 1176, 2010 WL 5191373, at *3 (T.T.A.B. 2010); *In re Nieves & Nieves*, 2015 WL 496132, at *4.

⁴⁶ See 15 U.S.C. § 1052(a) (prohibiting registration of, *inter alia*, deceptive marks and marks that “falsely suggest a connection with persons, living or dead”); 15 U.S.C. § 1052(d) (prohibiting registration of marks that would “be likely . . . to cause confusion, or to cause mistake, or to deceive”); 15 U.S.C. § 1052(e) (prohibiting registration of, *inter alia*, marks that are “merely descriptive or deceptively misdescriptive” or “functional”). “[O]ne of the most basic interpretive canons [is] that [a] statute should be construed so that effect is given to all its provisions, so that no part will be inoperative or superfluous, void or insignificant.” *Corley v. United States*, 556 U.S. 303, 314 (2009) (quoting *Hibbs v. Winn*, 542 U.S. 88, 101 (2004) (internal quotation marks and citation omitted)).

as being affiliated with the celebrity (but without requiring or even inquiring into this misbehavior). For example, the PTO denied registration to OBAMA PAJAMA under section 2(c) based solely on “a variety of press excerpts . . . demonstrat[ing] the obvious—namely, that President Barack Obama is extremely well known”; and that the record did not contain President Obama’s written consent to the registration.⁴⁷ The PTO denied registration to ROYAL KATE as applied to luxury goods because “ROYAL KATE identifies Kate Middleton, whose identity is renowned.”⁴⁸

And because the PTO makes such a skeletal inquiry (as the statute appears to require), it also denies registration to marks consisting of political commentary without taking into consideration any countervailing First Amendment interests. That is exactly what the PTO did in the case of Elster’s mark, TRUMP TOO SMALL. The PTO examiner rejected registration under section 2(c), stating, “[r]egistration remains refused because the applied-for mark TRUMP TOO SMALL consists of or comprises a name, portrait, or signature identifying a particular living individual whose written consent to register the mark is not of record.”⁴⁹ The examiner’s evidentiary record consisted solely of “Internet evidence as well as articles from LexisNexis® taken from major newspapers nationwide showing that President Trump is the subject of frequent media attention and is, consequently, well known to the public.”⁵⁰

Elster argued that section 2(c) did not bar registration “because it consists of political commentary about Donald Trump that the relevant consumer in the United States would not understand to be sponsored by, endorsed by, or affiliated with Donald Trump.”⁵¹ In response, the examiner stated that “the purpose of requiring the consent of a living individual to the registration of his or her name, signature, or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them.”⁵² The examiner

⁴⁷ *In re Hoefflin*, 97 U.S.P.Q.2d 1176, 2010 WL 5191373, at *3 (T.T.A.B. 2010).

⁴⁸ *In re Nieves & Nieves*, 2015 WL 496132, at *14.

⁴⁹ Final Office Action, *reprinted in* Joint Appendix, *supra* note 29, at 200. In a separate decision, the examiner rejected registration under section 2(a)’s bar on the “registration of [] marks that ‘falsely suggest a connection with persons, living or dead.’” *In re Elster*, 26 F.4th 1328, 1330 (Fed. Cir. 2022) (quoting 15 U.S.C. § 1052(a)). Although Elster appealed both decisions, the Trademark Trial and Appeal Board affirmed based solely on section 2(c), stating that “we need not reach the refusal under Section 2(a)’s false association clause.” USPTO Opinion, *reprinted in* Joint Appendix, *supra* note 29, at 2.

⁵⁰ Final Office Action, *reprinted in* Joint Appendix, *supra* note 29, at 201.

⁵¹ *Id.*

⁵² *Id.* (citing *In re Hoefflin*, 97 U.S.P.Q.2d 1176, 2010 WL 5191373, at *3 (T.T.A.B. 2010)).

concluded, without citation, that “neither the statute nor the case law carves out a ‘political commentary’ exception to the right of privacy and publicity.”⁵³

Before the Trademark Trial and Appeal Board (TTAB), Elster again asserted that the refusal of the PTO to register his mark violated his right to free speech.⁵⁴ In an unpublished opinion, the Board rejected his arguments and affirmed the denial of registration.⁵⁵ The Board relied principally on a prior TTAB opinion called *In re ADCO Industrial Technologies*, which had affirmed the denial of the mark TRUMP-IT as applied to package openers.⁵⁶ The mark at issue in *ADCO* accordingly invoked Donald Trump’s name, not as political commentary, but merely to draw attention to its brand. This made no difference to the Board.

The Board stated that it did “not agree with Applicant’s challenges based on our experience with Section 2 of the Trademark Act and the purposes underlying it.”⁵⁷ According to the Board, Section 2(c) was not a “direct restriction[] on speech” because it did not prevent Elster from using the proposed mark, “but only set criteria for trademark registration.”⁵⁸ The Supreme Court and Federal Circuit decisions in *Tam* and *Brunetti* had relied heavily on the critical benefits of federal trademark registration in deciding that bars on registering disparaging, immoral, and scandalous marks restricted free speech.⁵⁹ The Board nonetheless distinguished those decisions on the basis that the provisions at issue involved viewpoint discrimination, and not a viewpoint-neutral content restriction such as section 2(c).⁶⁰

Finally, the Board stated that “even if the challenged provisions of Section 2(a) and Section 2(c) were considered as restrictions on speech, they do not run afoul of the First Amendment because” they are narrowly tailored to accomplish a legitimate governmental purpose.⁶¹ Specifically, “[b]oth of the statutory provisions at issue ‘recognize[] the right of privacy and publicity that a living person has in his or her identity and

⁵³ *Id.* But see *infra* Section II.B.

⁵⁴ USPTO Opinion, *reprinted in* Joint Appendix, *supra* note 29, at 8.

⁵⁵ *Id.*

⁵⁶ *Id.* at 8–11; see *ADCO Indus.-Techs., L.P.*, 2020 WL 730361, at *14 (T.T.A.B. 2020).

⁵⁷ *Id.* at 9 (internal quotation marks omitted) (quoting *ADCO Indus.-Techs.*, 2020 WL 730361, at *12).

⁵⁸ *Id.* (citing *ADCO Indus.-Techs.*, 2020 WL 730361, at *27).

⁵⁹ See *infra* Section I.B.

⁶⁰ USPTO Opinion, *reprinted in* Joint Appendix, *supra* note 29, at 9 (citing *ADCO Indus.-Techs.*, 2020 WL 730361, at *27).

⁶¹ *Id.* at 10.

protect[] consumers against source deception.”⁶² The Board then asserted in conclusory fashion that “the statutory provision is narrowly tailored to accomplish these purposes, and consistently and reliably applies to any mark that consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.”⁶³ Hence, the Board’s conclusion was both circular and contradictory: barring registration to *any* mark naming a famous person was narrowly tailored to protect the rights of publicity and privacy because the restriction applied broadly to *any* such mark.

Elster appealed the denial of registration to the Federal Circuit, as discussed below.

B. *The Tam and Brunetti Decisions*

Before analyzing the Federal Circuit opinion reversing the Board in *Elster*, it is necessary to place that decision in context by discussing the Supreme Court’s decisions in *Tam* and *Brunetti*.

1. The *Tam* Decision Strikes Down the Bar on Registering “Disparaging” Marks

In *Matal v. Tam* the Supreme Court found “the disparagement clause” of section 2(a) of the Lanham Act unconstitutional.⁶⁴ This provision bars the registration of a trademark that “[c]onsists of or comprises . . . matter . . . which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”⁶⁵ The registrants in *Tam* sought federal registration of the mark THE SLANTS for a rock band, “believ[ing] that by taking that slur as the name of their group, they will help to ‘reclaim’ the term and drain its denigrating force.”⁶⁶ The PTO had denied registration under the disparagement clause on the grounds that the mark disparaged people of Asian ethnicity.⁶⁷

On appeal from the Board, the en banc Federal Circuit struck down the disparagement provision as facially unconstitutional in violation of the First Amendment because it engages in viewpoint discrimination against private speech.⁶⁸ As

⁶² *Id.* (quoting *ADCO Indus.-Techs.*, 2020 WL 730361, at *13) (second alteration in original).

⁶³ *Id.* at 10–11.

⁶⁴ *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (referring to 15 U.S.C. § 1052(a)).

⁶⁵ 15 U.S.C. § 1052(a).

⁶⁶ *Tam*, 137 S. Ct. at 1751.

⁶⁷ *Id.* at 1754.

⁶⁸ *In re Tam*, 808 F.3d 1321, 1327–28 (Fed. Cir. 2015) (en banc).

a preliminary matter, the court rejected the government's argument that the disparagement clause was immune from First Amendment protection on the basis that "it prohibits no speech," and merely denies the benefits of federal registration.⁶⁹ The government had argued that "Mr. Tam [is] free to name his band as he wishes and use this name in commerce," despite the denial of federal trademark registration.⁷⁰ The court reasoned that the benefits of federal trademark registration are so critical that their denial based on the government's disapproval of the trademark's message imposes a substantial burden and chilling effect on that speech.⁷¹ Supreme Court precedent provides that "[t]he [g]overnment's content-based burdens must satisfy the same rigorous scrutiny as its content-based bans."⁷² The Board's conclusion in *Elster* that section 2(c) is not subject to First Amendment scrutiny because it does not outright ban the speech in question is, indeed, directly contrary to this precedent.⁷³

Because the disparagement clause constituted a content-based restriction on speech, the Federal Circuit held that it was subject to strict scrutiny.⁷⁴ The disparagement clause was not only discriminating based on content but on viewpoint, which holds even greater First Amendment protection.⁷⁵ But the court noted that strict scrutiny would apply even to a content-based restriction on speech that was viewpoint neutral (such as the provision that is the subject of this article, section 2(c)).⁷⁶ The court stated, "[a] regulation is content based even when its reach is defined simply by the topic (subject matter) of the covered speech."⁷⁷ And, according to the Supreme Court, "[c]ontent-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests."⁷⁸ The Federal Circuit found that the disparagement provision failed this test, but it reasoned in the alternative that the provision was unconstitutional even under the more lenient *Central Hudson*

⁶⁹ *Id.* at 1339.

⁷⁰ *Id.*

⁷¹ *Id.* at 1345.

⁷² *Id.* at 1335 (quoting *United States v. Playboy Ent. Grp., Inc.*, 529 U.S. 803, 812 (2000)).

⁷³ *See supra* Section I.A.

⁷⁴ *In re Tam*, 808 F.3d at 1334.

⁷⁵ *Id.* at 1334–35 ("Viewpoint-based regulations, targeting the substance of the viewpoint expressed, are even more suspect [than viewpoint neutral content-based restrictions].").

⁷⁶ *Id.* at 1334.

⁷⁷ *Id.*

⁷⁸ *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2226 (2015) (quoted in *In re Tam*, 808 F.3d at 1334).

“intermediate scrutiny” test applied to commercial speech.⁷⁹ The *Central Hudson* test asks, in pertinent part, whether the regulation burdening speech directly advances a substantial government interest, and whether the regulation is not more extensive than necessary to serve the interest.⁸⁰ The government has no substantial interest in “burden[ing] speech it finds offensive. This is not a legitimate interest.”⁸¹ Accordingly, the disparagement provision was facially unconstitutional.

The Supreme Court affirmed the Federal Circuit’s decision in *Tam* by a vote of eight-to-zero.⁸² Like the Federal Circuit, the Court’s judgment is grounded in the concept that the improper denial of federal trademark registration may constitute an unconstitutional burden on speech, even though “[w]ithout federal registration, a valid trademark may still be used in commerce.”⁸³ This is because “[f]ederal registration . . . confers important legal rights and benefits on trademark owners who register their marks.”⁸⁴ Hence, the fact that denial of federal registration is not an outright ban on speech does not mean the provisions restricting registration are free from First Amendment scrutiny.

The Court also rejected the government’s arguments that the disparagement clause was free from First Amendment scrutiny because “trademarks are government speech” or because trademark registration constitutes a “government subsidy.”⁸⁵ This is important because the government raised the exact same arguments again in the *Elster* case, as discussed in the next Section.⁸⁶

The “government speech” doctrine provides that, although the government generally may not burden private speech based on its content or viewpoint, the government is free to discriminate based on content or viewpoint when it is itself speaking. In other words, “[w]hen a government entity embarks on a course of action, it necessarily takes a particular viewpoint and rejects others. The Free Speech Clause does not require [the] government to maintain viewpoint neutrality when its officers

⁷⁹ *In re Tam*, 808 F.3d at 1355–57.

⁸⁰ *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of NY*, 447 U.S. 557, 566 (1980).

⁸¹ *In re Tam*, 808 F.3d at 1357.

⁸² Four justices joined in full an opinion by Justice Alito and four justices agreed with part of Justice Alito’s reasoning, but issued a separate opinion authored by Justice Kennedy. *Matal v. Tam*, 137 S. Ct. 1744, 1744 (2017).

⁸³ *Id.* at 1751–52.

⁸⁴ *Id.* at 1753 (quoting *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 172 (2015) (Thomas, J., dissenting)).

⁸⁵ *Id.* at 1757–61; *Id.* at 1768 (Kennedy, J., concurring in part).

⁸⁶ *See infra* Section II.A.

and employees speak about that venture.”⁸⁷ The government argued that registration of a trademark constitutes government speech, and the PTO is therefore free to choose which content and viewpoints to register. The Court rejected this argument, reasoning as follows:

At issue here is the content of trademarks that are registered by the PTO, an arm of the Federal Government. The Federal Government does not dream up these marks, and it does not edit marks submitted for registration If the federal registration of a trademark makes the mark government speech, the Federal Government is babbling prodigiously and incoherently. It is saying many unseemly things. . . . It is expressing contradictory views. It is unashamedly endorsing a vast array of commercial products and services. And it is providing Delphic advice to the consuming public

. . . .

. . . Trademarks are private, not government[] speech.⁸⁸

Hence, the disparagement clause could not escape First Amendment scrutiny on the basis that trademark registration is “government speech.”

Under the “government subsidy” doctrine, the “Court has upheld the constitutionality of . . . programs that subsidized speech expressing a particular viewpoint.”⁸⁹ The government argued that trademark registration was a government subsidy, and the government was therefore free to grant or withhold this subsidy based on the content or viewpoint expressed in marks.⁹⁰ The Alito opinion rejected this argument because the cases establishing the doctrine “all involved cash subsidies or their equivalent.”⁹¹ Unlike the programs at issue in the government subsidy cases, “[t]he PTO does not pay money to parties seeking registration of a mark. Quite the contrary is true: An applicant for registration must pay the PTO a filing fee.”⁹² The government cannot grant or deny registration of a trademark based on the political content or viewpoint of the applicant’s speech any more than it can grant or deny registration of property titles, security interests, vehicle registrations, or driving, hunting, fishing, or

⁸⁷ *Tam*, 137 S. Ct. at 1757.

⁸⁸ *Id.* at 1758, 1760.

⁸⁹ *Id.* at 1757, 1760.

⁹⁰ *Id.* at 1757, 1760–61.

⁹¹ *Id.* at 1761 (first citing *Rust v. Sullivan*, 500 U.S. 173 (1991) (involving federal funds to private parties for family planning services); then *National Endowment for the Arts v. Finley*, 524 U.S. 569 (1998) (involving cash grants to artists); then *United States v. Am. Libr. Ass’n, Inc.*, 539 U.S. 194 (2003) (involving federal funds for libraries); then *Regan v. Tax’n with Representation of Wash.*, 461 U.S. 540 (1983) (involving tax benefits); and then *Cammarano v. United States*, 358 U.S. 498 (1959) (involving tax benefits)).

⁹² *Tam*, 137 S. Ct. at 1761.

boating licenses based on the content or viewpoint of the applicant's speech.⁹³ Hence, the disparagement clause did not escape scrutiny based on the notion that trademark registration is a government subsidy.

The Court declined to resolve a dispute between the parties as to whether trademarks are commercial speech, which would subject content-based provisions regulating them to the intermediate scrutiny of *Central Hudson*, or if instead such regulations are subject to strict scrutiny.⁹⁴ This resolution was unnecessary because the disparagement clause could not even withstand *Central Hudson* review.⁹⁵ The Court agreed with the Federal Circuit that the government has no "interest in preventing speech expressing ideas that offend."⁹⁶

The government asserted as its substantial interest the orderly flow of commerce, which would be "disrupted by [] marks that 'involv[e] disparagement of race, gender, ethnicity, national origin, religion, sexual orientation, and similar demographic classification.'"⁹⁷ The Alito opinion held that the disparagement clause was not narrowly tailored to advance this interest because it applies to "trademark[s] that disparage[] *any person, group, or institution*."⁹⁸ Accordingly, the provision would not only prohibit registration of hateful marks, but also of marks disparaging racists, sexists, and homophobes—in short, "any person."⁹⁹ Notably for our purposes, the Alito opinion stated that the disparagement provision is impermissibly overbroad because it would bar registration of marks criticizing politicians: he asks rhetorically whether the trademark "James Buchanan was a disastrous President" would conceivably disrupt commerce.¹⁰⁰ The disparagement clause prohibits registration of marks that may disparage "persons, living or dead,"¹⁰¹ which would, of course, include James Buchanan. Because the disparagement clause would prevent registration of the Court's hypothetical mark criticizing a president, it is overbroad and violates free speech. This bears directly on section 2(c), which the PTO has used to bar registration of TRUMP TOO SMALL.¹⁰²

⁹³ *See id.*

⁹⁴ *Id.* at 1764.

⁹⁵ *Id.*

⁹⁶ *Id.*

⁹⁷ *Id.* (second alteration in original) (quoting *In re Tam*, 808 F.3d 1321, 1380–81 (Fed. Cir. 2015) (Reyna, J., dissenting)).

⁹⁸ *Id.* at 1764–65 (emphasis in original).

⁹⁹ *See id.* at 1765 (emphasis omitted).

¹⁰⁰ *Id.*

¹⁰¹ 15 U.S.C. § 1052(a).

¹⁰² *See supra* Section I.A.

2. The *Brunetti* Decision Strikes Down the Bar on Registering “Immoral” and “Scandalous” Marks

In *Brunetti*, the Supreme Court struck down as unconstitutional the Lanham Act’s bar on the registration of “immoral” and “scandalous” marks.¹⁰³ The registrant, Erik Brunetti, “founded a clothing line” under the brand name “FUCTION,” and sought registration of that word as his trademark.¹⁰⁴ The PTO denied registration under another part of section 2(a), which prohibits, in pertinent part, the registration of marks that “[c]onsist[] of or comprise[] immoral . . . or scandalous matter.”¹⁰⁵ According to the Supreme Court,

[t]o determine whether a mark fits in the category, the PTO asks whether a “substantial composite of the general public” would find the mark “shocking to the sense of truth, decency, or propriety”; “giving offense to the conscience or moral feelings”; “calling out for condemnation”; “disgraceful”; “offensive”; “disreputable”; or “vulgar.”¹⁰⁶

The PTO examiner denied Brunetti’s registration, finding that the mark “was ‘a total vulgar [sic].’”¹⁰⁷ The Board affirmed, finding “that the mark was ‘highly offensive’ . . . and that it had ‘decidedly negative sexual connotations.’”¹⁰⁸ On appeal, a panel of the Federal Circuit struck down the “immoral . . . or scandalous” bar as unconstitutional under the First Amendment,¹⁰⁹ and, as it had done in *Tam*, the Supreme Court affirmed.¹¹⁰

The majority opinion in *Brunetti* is brief, discussing primarily the government’s argument that the immoral or scandalous bar is viewpoint neutral.¹¹¹ The Supreme Court disagreed:

It is viewpoint-based. . . . [T]he Lanham Act allows registration of marks when their messages accord with, but not when their messages defy, society’s sense of decency or propriety. Put the pair of overlapping terms together and the statute, on its face, distinguishes

¹⁰³ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

¹⁰⁴ *Id.*

¹⁰⁵ 15 U.S.C. § 1052(a); *see id.* at 2297–98.

¹⁰⁶ *Brunetti*, 139 S. Ct. at 2298 (quoting *In re Brunetti*, 877 F.3d 1330, 1336 (Fed. Cir. 2017)).

¹⁰⁷ *Id.* at 2298 (quoting Official Action (Official Letter) About Applicant’s Trademark Application, *reprinted in* Joint Appendix at 27–28, *In re Brunetti*, 877 F.3d 1330, 2019 WL 914147).

¹⁰⁸ *Id.* (internal citation omitted).

¹⁰⁹ *In re Brunetti*, 877 F.3d 1330, 1357 (Fed. Cir. 2017) (referring to the clause in 15 U.S.C. § 1052(a) at issue).

¹¹⁰ *Brunetti*, 139 S. Ct. at 2297.

¹¹¹ *Brunetti*, 139 S. Ct. at 2300–02.

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.¹¹²

Having made that determination, the Court quickly invalidated the provision, without going through the motions of analyzing strict or intermediate scrutiny: “If the ‘immoral or scandalous’ bar . . . discriminates on the basis of viewpoint, it must also collide with our First Amendment doctrine. The Government does not argue otherwise.”¹¹³

The Government asked the Court to interpret the statute as applying only to “‘vulgar’—meaning ‘lewd,’ ‘sexually explicit or profane’” marks, positing that this would be a ban on marks based on their mode of expression, and not on the message expressed.¹¹⁴ But the Court rejected this argument, “because the statute says something markedly different. . . . The statute as written does not draw the line at lewd, sexually explicit, or profane marks.”¹¹⁵ Rather, “[i]t covers the universe of immoral or scandalous . . . material. Whether or not . . . profane.”¹¹⁶ The Court concluded that “once the ‘immoral or scandalous’ bar is interpreted fairly, it must be invalidated.”¹¹⁷

II. THE FEDERAL CIRCUIT CORRECTLY DETERMINED THAT BARRING REGISTRATION OF TRUMP TOO SMALL IS UNCONSTITUTIONAL.

This brings us back to *Elster*, and the conclusion that the Federal Circuit was inextricably bound by precedent to hold section 2(c) unconstitutional, at least as applied to marks containing political commentary. And probably the court should have gone further to declare the statute facially invalid.

A. *Section 2(c) is Not Subject to Rational Basis Review*

The *Elster* case presents a different question from *Tam* and *Brunetti* because it involves a viewpoint neutral regulation.

¹¹² *Id.* at 2299–300.

¹¹³ *Id.* at 2299.

¹¹⁴ *Id.* at 2301 (quoting Brief for Petitioner at 27, 30, *Brunetti*, 139 S. Ct. 2294 (No. 18-302), 2019 WL 913833).

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Id.* at 2302. Justices Breyer and Sotomayor agreed with the government that the “scandalous” provision could be narrowly interpreted to preserve its constitutionality, and therefore dissented in part. *Id.* at 2304–08 (Breyer, J., concurring in part); *Id.* at 2308–19 (Sotomayor, J., concurring in part).

Section 2(c) bars registration of the name of a famous person without their consent whether the mark in question criticizes, praises, or expresses no opinion about the celebrity it identifies.¹¹⁸ Accordingly, most of the government’s case relied on arguments that Section 2(c) is subject only to rational basis review.¹¹⁹ The government argued that “viewpoint-neutral limitations on federal trademark registrability are not direct restrictions on speech and should not be subjected to heightened scrutiny.”¹²⁰

However, the Federal Circuit correctly determined that section 2(c) is subject to First Amendment scrutiny because it involves “content-based discrimination.”¹²¹ As the Supreme Court held in *Reed v. Town of Gilbert*, “a speech regulation targeted at specific subject matter is content based even if it does not discriminate among viewpoints within that subject matter.”¹²² Section 2(c) does just that, burdening speech by denying federal trademark registration when the subject matter of that speech involves a famous person. And even though viewpoint discrimination “is a ‘more blatant’ and ‘egregious form of content discrimination,’” both viewpoint discrimination and content-based discrimination are subject to strict scrutiny.¹²³

Nor is section 2(c) subject to rational basis review on the basis that it does not impose an outright ban on speech. It is true that without federal trademark registration of a mark containing political commentary, an applicant may still express his views and use the mark in commerce. However, the Supreme Court has recognized that the denial of federal registration imposes a burden on speech, because “registration gives trademark owners valuable benefits.”¹²⁴ The Court’s conclusion

¹¹⁸ See *In re Elster*, 26 F.4th 1328, 1331 (Fed. Cir. 2022) (“[S]ection 2(c) does not involve viewpoint discrimination.”).

¹¹⁹ See Brief for Appellee Andrew Hirshfield at 22–38, *In re Elster*, 26 F.4th 1328 (No. 20-2205).

¹²⁰ *Id.* at 25.

¹²¹ *In re Elster*, 26 F.4th at 1331.

¹²² *Reed*, 576 U.S. at 169 (holding unconstitutional a code imposing different restrictions on the manner in which people may display outdoor signs based on the subject matter—but not the viewpoints—they address); see also *City of Austin v. Reagan Nat’l Ad. of Austin*, 142 S. Ct. 1464, 1472, 1475 (2022) (holding that provisions placing restrictions on billboards advertising off-site locations are content neutral because they “do not single out any topic or subject matter for differential treatment.”).

¹²³ *Reed*, 576 U.S. at 168 (quoting *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U.S. 819, 829); see also *Consolidated Edison Co. of N.Y. v. Public Serv. Comm’n of N.Y.*, 447 U.S. 530, 537 (1980) (“The First Amendment’s hostility to content-based regulation extends not only to restrictions on particular viewpoints, but also to prohibition of public discussion of an entire topic.”).

¹²⁴ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297–98 (2019) (“For example, registration constitutes ‘prima facie evidence’ of the mark’s validity. And registration serves as ‘constructive notice of the registrant’s claim of ownership,’ which forecloses some defenses in infringement actions.”) (internal citations omitted) (first quoting 15

that denial of registration burdens speech makes common sense, because registrants would be dissuaded from selecting and using marks that they could not register. A regulation that burdens (and does not prohibit) speech is subject to First Amendment scrutiny even if it is content based and not viewpoint based. The Court has held that “[t]o sustain the targeted, content-based burden [a regulation] imposes on protected expression, the State must show at least that the statute directly advances a substantial governmental interest and that the measure is drawn to achieve that interest.”¹²⁵

There does remain some question as to whether trademark regulations are subject to intermediate scrutiny, rather than strict scrutiny, on the basis that they regulate “commercial speech.” The Supreme Court defines “commercial speech” as “speech that does no more than propose a commercial transaction.”¹²⁶ The uncertainty arises because many trademarks do more than simply propose a commercial transaction; they are also expressive.

As trademark expert Professor Lisa Ramsey points out, in addition to identifying the source of goods and products, trademarks “can also convey political or social messages and espouse powerful viewpoints and ideas about a variety of topics in just a few words.”¹²⁷ JUST DO IT is a trademark of Nike that indicates the source of its clothing and footwear.¹²⁸ The mark also conveys an influential social message that, according to one author, “invited dreams. It was a call to action, a refusal to listen to excuses and a license to be eccentric, courageous and exceptional.”¹²⁹ Professor Ramsey cites MAKE AMERICA GREAT AGAIN as an example of a mark conveying a political message,¹³⁰ and, of course, we can also take as an example the mark at issue in *Elster*, TRUMP TOO SMALL.

U.S.C. § 1115(a) then quoting 15 U.S.C. § 1072); Federal registration “can make a mark ‘incontestable’ once a mark has been registered for five years. Registration also enables the trademark holder ‘to stop the importation into the United States of articles bearing and infringing mark.’”; *Matal v. Tam*, 137 S. Ct. 1744, 1753 (2017) (internal citations omitted) (quoting 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:9 (5th ed. 2023)).

¹²⁵ *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 572 (2011).

¹²⁶ *Harris v. Quinn*, 573 U.S. 616, 648 (2014) (quoting *United States v. United Foods*, 533 U.S. 405, 409 (2001)).

¹²⁷ Lisa Ramsey, *Free Speech Challenges to Trademark Law After Matal v. Tam*, 56 HOUS. L. REV. 401, 436 (2018).

¹²⁸ JUST DO IT, Registration No. 1,875,307 (“CLOTHING, NAMELY T-SHIRTS, SWEATSHIRTS AND CAPS”).

¹²⁹ FRIEDRICH VON BORRIES, WHO’S AFRAID OF NIKETOWN?: NIKE-URBANISM, BRANDING AND THE CITY OF TOMORROW 37 (2004).

¹³⁰ Lisa Ramsey, *A Free Speech Right to Trademark Protection?*, 106 TRADEMARK REP. 797, 836 (2016) (internal citation omitted).

Hence, as Professor Rebecca Tushnet has observed, “it’s *weird* that, more than 75 years after the Lanham Act was enacted, courts are not willing to tell us whether its scope matches or exceeds that of commercial speech.”¹³¹ In particular, the Supreme Court in *Tam* declined to resolve the parties’ dispute as to “whether trademarks are commercial speech and are thus subject to the relaxed scrutiny outlined in *Central Hudson Gas*,” because the disparagement provision was facially invalid even under intermediate scrutiny.¹³² Likewise the Court’s majority opinion in *Brunetti* makes no mention of which standard of review it is applying, stating simply that “[i]f the ‘immoral or scandalous’ bar similarly discriminates on the basis of viewpoint, it must also collide with our First Amendment doctrine.”¹³³

However, none of this confusion results in the government’s conclusion that section 2(c) is subject to rational basis review. The Federal Circuit correctly held in *Elster* that “[w]hatever the standard for First Amendment review of viewpoint-neutral, content-based restrictions in the trademark area, whether strict scrutiny or intermediate scrutiny, there must be at least a substantial government interest in the restriction.”¹³⁴ There can be no rational basis review, as the government urges. At the very least section 2(c) must pass intermediate scrutiny, which it fails to do, as discussed below.¹³⁵

Finally, the government argued that section 2(c) is immune from scrutiny based on arguments that had already been rejected in *Tam* and *Brunetti*. The government argued, once again, that “because trademark protection is the equivalent of a government subsidy, it is not subject to First Amendment scrutiny so long as viewpoint discrimination is not involved.”¹³⁶ But the Alito opinion in *Tam* soundly rejected the notion that trademark registration is akin to a government subsidy in reasoning that had nothing to do with whether the restriction on registration constituted viewpoint or content-based discrimination.¹³⁷

¹³¹ Rebecca Tushnet, *2(c) Unconstitutional as Applied to TRUMP TOO SMALL*, REBECCA TUSHNET’S 43(B)LOG (Feb. 24, 2022) (emphasis in original), <https://tushnet.blogspot.com/2022/02/2c-unconstitutional-as-applied-to-trump.html> [<https://perma.cc/A8NB-7CAG>].

¹³² *Matal v. Tam*, 137 S. Ct. 1744, 1763–64 (2017) (citing *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557 (1980)).

¹³³ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).

¹³⁴ *In re Elster*, 26 F.4th 1328, 1333–34 (Fed. Cir. 2022) (internal citations omitted).

¹³⁵ *See infra* Section I.B.

¹³⁶ *In re Elster*, 26 F.4th at 1332.

¹³⁷ *Matal*, 137 S. Ct. at 1761 (holding that “federal registration of a trademark is nothing like the programs at issue in [the government subsidy] cases”); *see supra* Section I.B.

The government then argued that section 2(c) need not face First Amendment scrutiny because trademark registration restrictions are akin to government regulations controlling speech in a limited public forum.¹³⁸ But in *Elster*, the Federal Circuit pointed out that this argument had already been rejected in the Federal Circuit's opinion in *Brunetti*, which constituted binding precedent for the *Elster* panel.¹³⁹

In short, the government's arguments that section 2(c) was subject to rational basis review were to no avail, and we move on to analysis of the section under *Central Hudson*.

B. Section 2(c) Does Not Pass Central Hudson Intermediate Scrutiny on the Basis that It Protects the Rights of Privacy or Publicity

The *Central Hudson* test for whether government restrictions on commercial speech pass muster under the First Amendment has four parts. First, the regulated speech must concern lawful activity and not be misleading, and so deserving of First Amendment protection. Second, the regulation must be supported by a substantial government interest. Third, the regulation must directly advance that interest. Fourth, the regulation must not be more extensive than necessary to serve that interest.¹⁴⁰

1. Section 2(c) Burdens Lawful Speech

As to the first part of the *Central Hudson* test, the *Elster* panel correctly determined that TRUMP TOO SMALL deserves First Amendment protection.¹⁴¹ The government has never contended that the trademark is "unlawful," and the PTO's rejection of the mark under section 2(c) neither contained nor required a finding that the mark is misleading. As *Elster* has pointed out, "given 'how [Donald Trump] depicts himself generally,' the mark . . . is 'the antithesis of what consumers would understand to be sponsored by, approved by, or supported by Donald Trump.'"¹⁴² As a general matter, trademarks deserve First Amendment protection under *Central Hudson*, even if they

¹³⁸ *In re Elster*, 26 F.4th at 1333.

¹³⁹ *Id.* (quoting *In re Brunetti*, 877 F.3d 1330, 1347 (Fed. Cir. 2017) (citing *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 830 (1995))).

¹⁴⁰ *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 566 (1980).

¹⁴¹ *In re Elster*, 26 F.4th at 1329.

¹⁴² USPTO Opinion, *reprinted in* Joint Appendix, *supra* note 29, at 5 (alteration in original) (quoting Applicant's Supplemental Brief before the Board).

are purely commercial speech and do not contain political or social commentary.¹⁴³ Hence, section 2(c)'s facial validity is suspect because it would often burden marks that are not deceptive or misleading. It bars registration without requiring any inquiry into such matters.

2. The Government Does Not Have a Substantial Interest in Protecting Celebrities' Privacy from Political and Social Commentary Absent Actual Malice.

The government's asserted substantial interest in enforcing section 2(c) was to "protect[] state-law privacy and publicity rights, grounded in tort and unfair competition law."¹⁴⁴ The Federal Circuit correctly dispensed with the alleged privacy interest in short shrift: "Here, there can be no plausible claim that President Trump enjoys a right of privacy protecting him from criticism in the absence of actual malice—the publication of false information 'with knowledge of its falsity or in reckless disregard of the truth.'"¹⁴⁵

The government has never claimed that Elster asserts "TRUMP TOO SMALL" with actual malice.¹⁴⁶ Nor could it. Elster's assertion that Trump's policies are "TOO SMALL" is a political opinion, not something that can be objectively true or false. As to the relative size of certain of Trump's body parts (his fingers, his hands, etc.), that would also appear to be a subjective opinion. Trump enjoys no right to privacy to prevent Elster from expressing his own views on the topic.

More generally, the notion that the government has an interest in protecting the President of the United States from criticism to guard his or her privacy interest contradicts an animating purpose of the First Amendment. "[T]here is practically universal agreement that a major purpose of [the First] Amendment was to protect the free discussion of governmental affairs."¹⁴⁷ Specifically, the freedom to criticize public officials "is [o]ne of the prerogatives of American

¹⁴³ See *infra* section II.A.

¹⁴⁴ *In re Elster*, 26 F.4th at 1334.

¹⁴⁵ *Id.* at 1335 (quoting *Time, Inc. v. Hill*, 385 U.S. 374, 388 (1967)).

¹⁴⁶ *Id.*

¹⁴⁷ *Mills v. Alabama*, 384 U.S. 214, 218 (1966).

citizenship.”¹⁴⁸ It does not matter that Elster’s trademark may diminish Trump or hurt his feelings.¹⁴⁹

The Federal Circuit correctly found that “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.”¹⁵⁰ Indeed, few people criticize public officials more freely or in more caustic terms than Donald Trump. One study found that the defeated former President levied between six thousand and ten thousand insults on Twitter from the time he launched his presidential campaign to January 6, 2021, when he was permanently barred from the private service,¹⁵¹ due to “the risk of further incitement of violence” in the wake of the attack on the US Capitol.¹⁵²

Absent a showing of actual malice, the First Amendment protects all speech commenting on, not just the President and public officials, but any celebrities or famous persons.¹⁵³ The standard applies beyond public officials to “a well-known ‘celebrity’ [whose] name [is] a ‘household word.’”¹⁵⁴ Hence, section 2(c) is facially invalid. It cannot be justified by a government interest in protecting celebrities from public comment because it contains no requirement of actual malice to bar registration.

¹⁴⁸ *In re Elster*, 26 F.4th at 1334 (quoting *Baumgarten v. United States*, 322 U.S. 665, 673–74 (1944)).

¹⁴⁹ See *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 273 (1964) (“Criticism of their official conduct does not lose its constitutional protection merely because it is effective criticism and hence diminishes their official reputations.”).

¹⁵⁰ *In re Elster*, 26 F.4th at 1335 (quoting Appellant Brief at 35, *In re Elster*, 26 F.4th 1328, No. 20-2205 (Feb. 16, 202), ECF No. 21).

¹⁵¹ Katie Van Syckle, *Five Years, Thousands of Insults: Tracking Trump’s Invective*, N.Y. TIMES (Jan. 26, 2021), <https://www.nytimes.com/2021/01/26/insider/Trump-twitter-insults-list.html> [https://perma.cc/7HKQ-EVWB] (internal quotation marks omitted) (quoting *Permanent Suspension of @realDonaldTrump*, TWITTER (Jan. 8, 2021), http://blog.twitter.com/en_us/topics/company/2020/suspension [https://perma.cc/T3ZP-CESG]).

¹⁵² Kate Conger & Mike Isaac, *Twitter Permanently Bans Trump, Capping Online Revolt*, N.Y. TIMES (Jan. 12, 2021), <https://www.nytimes.com/2021/01/08/technology/twitter-trump-suspended.html>.

¹⁵³ See *Curtis Pub. Co. v. Butts*, 388 U.S. 130, 135, 155 (1967) (applying the “actual malice” standard to the coach of a college football team who was employed by a private corporation).

¹⁵⁴ *Waldbaum v. Fairchild Publ’ns, Inc.*, 627 F.2d 1287, 1294 (D.C. Cir. 1980) (internal citations and quotation marks omitted).

3. Section 2(c) is Not Tailored to Protect the State Right of Publicity.

The government also defended section 2(c) on the grounds that it has an interest in protecting the state right of publicity. The Federal Circuit acknowledged that the government may have a substantial interest in protecting something akin to the right of publicity insofar as the registration of a mark would result in “misappropriation of other forms of intellectual property”;¹⁵⁵ for example, if registration of a mark would result in “dilut[ing] the commercial value of [Trump’s] name, an existing trademark, or some other form of intellectual property.”¹⁵⁶ The court went on to say that “[t]he government, in protecting the right of publicity, also has an interest in preventing the issuance of marks that falsely suggest that an individual, including the President, has endorsed a particular product.”¹⁵⁷

But section 2(c) pointedly allows the PTO to deny registration of a mark without any finding that registration would cause dilution, false endorsement, passing off, likelihood of confusion, or any other harm to intellectual property rights that the Lanham Act can legitimately protect. Nor could section 2(c) be interpreted to require such a finding, because rejection of registration on those other grounds is provided for by other sections of the Lanham Act, such that injecting such a requirement into section 2(c) would render it duplicative of those other sections.¹⁵⁸ Nor does section 2(c) require a finding by the PTO that registration would violate a state right of publicity under the applicable standards. Rather, the PTO denies registration after answering two simple questions: (1) would “the public . . . recognize and understand the mark as identifying a particular living individual[?]”;¹⁵⁹ and (2) does “the record . . . contain the famous person’s consent to register the mark[?]”¹⁶⁰

To the extent the government *does* have a substantial interest in protecting the state right of publicity, section 2(c) is far more extensive than necessary to protect that interest. This is because every state right of publicity allows for the weighing of countervailing First Amendment considerations before

¹⁵⁵ *In re Elster*, 26 F.4th at 1335.

¹⁵⁶ *Id.* at 1336.

¹⁵⁷ *Id.*

¹⁵⁸ See INT’L TRADEMARK ASS’N, *supra* note 33, § 3.2.

¹⁵⁹ *In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d 1629, 2015 WL 496132, at *12 (T.T.A.B. 2015).

¹⁶⁰ Ernst, *supra* note 44; see *supra* notes 43–44 and accompanying text.

restricting speech. As Jennifer Rothman observes, “[a]t least five balancing approaches have been applied to evaluate First Amendment defenses in right of publicity cases.”¹⁶¹ The Eighth Circuit’s general balancing test requires “that state law rights of publicity . . . be balanced against first amendment considerations.”¹⁶² Under this framework, the Eighth Circuit decided that a fantasy baseball company’s First Amendment right to publish factual information, such as the names, statistics, and biographical information of major league baseball players, “supersede[d] the players’ rights of publicity.”¹⁶³

Missouri’s test asks whether the predominant purpose of using the famous person’s name or identity is to exploit its commercial value; or, rather, whether “the predominant purpose of the product is to make an expressive comment on or about a celebrity.”¹⁶⁴ Under this test, the Missouri Supreme Court found that the defendants did not have the First Amendment right to use the name of a famous hockey player as the name of a villain in a comic book because such use was “predominantly a ploy to sell comic books,” and “not a parody or other expressive comment or a fictionalized account.”¹⁶⁵

The California test borrows from copyright’s fair-use analysis. This test considers “whether the new work merely ‘supersede[s] the objects’ of the original creation, or instead adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is ‘transformative.’”¹⁶⁶ Under this test, the court held that the defendant’s free speech rights did not allow him to sell lithographs and T-Shirts with highly realistic depictions of the Three Stooges.¹⁶⁷

¹⁶¹ JENNIFER E. ROTHMAN, *THE RIGHT OF PUBLICITY: PRIVACY REIMAGINED FOR A PUBLIC WORLD* 145 (2018); see also Robert C. Post & Jennifer E. Rothman, *The First Amendment and the Right(s) of Publicity*, 130 *YALE L.J.* 86, 125–32 (2020).

¹⁶² *C.B.C. Distrib. & Mktg., Inc. v. Major League Baseball Advanced Media, L.P.*, 505 F.3d 818, 823 (8th Cir. 2007).

¹⁶³ *Id.* at 824–25. Because TRUMP TOO SMALL is core political speech at the heart of the First Amendment it would presumably outweigh the right of publicity as well.

¹⁶⁴ *Doe v. TCI Cablevision*, 110 S.W.3d 363, 374 (Mo. 2003) (en banc) (quoting Mark S. Lee, *Agents of Chaos: Judicial Confusion in Defining the Right of Publicity-Free Speech Interface*, 23 *LOY. L.A. ENT. L. REV.* 471, 500 (2003)).

¹⁶⁵ *Id.* The predominant purpose of TRUMP TOO SMALL is to critique Donald Trump’s policies and body features, not to exploit his identity to sell T-shirts. Accordingly, the right of publicity would yield to the First Amendment under this regime as well.

¹⁶⁶ *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 808 (2001) (internal citations and quotation marks omitted).

¹⁶⁷ *Id.* at 811. Conversely, TRUMP TOO SMALL adds the transformative political critique “TOO SMALL” to Trump’s name and would likely pass muster under this test.

An approach adopted by the Third and Ninth Circuits (known as the “Transformative Use” test) inquires whether the use of the plaintiff’s identity was not merely imitative, but rather “for purposes of lampoon, parody, or caricature,” and therefore entitled to First Amendment protection.¹⁶⁸ Under this test, Electronic Arts’ use of images of athletes in video games was too imitative to qualify for First Amendment protection against right of publicity claims.¹⁶⁹

Finally, there is the test adopted by the Restatement (Third) of Unfair Competition. Here, “the use of a person’s identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses” is allowed.¹⁷⁰ But their identity cannot be used “if they are used in advertising the user’s goods or services, or are placed on merchandise marketed by the user, or are used in connection with services rendered by the user.”¹⁷¹ Under this test, Ginger Rogers and the estate of Fred Astaire could not prevent a filmmaker from using the title “Ginger and Fred” in a fictional film because the use was “clearly related to the content of the movie and is not a disguised advertisement for the sale of goods or services or a collateral commercial product.”¹⁷²

The right of publicity is frequently criticized by scholars for evolving far beyond its original moorings as a modest outgrowth of the right of privacy.¹⁷³ Specifically, scholars have criticized these First Amendment defenses to the right of publicity as providing *insufficient* protection for free speech.¹⁷⁴ But section

¹⁶⁸ See, e.g., *Hart v. Elec. Arts, Inc.*, 717 F.3d 141, 160 (3d Cir. 2013); *Davis v. Elec. Arts, Inc.*, 775 F.3d 1172, 1177–78 (9th Cir. 2015).

¹⁶⁹ *Davis*, 775 F.3d 1172, 1178. In contrast, TRUMP TOO SMALL is for the purpose of lampooning Trump and does not merely parrot his name standing alone. Hence, the right of publicity would not block Elster’s use of the phrase.

¹⁷⁰ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (AM. L. INST. 1995).

¹⁷¹ *Id.*

¹⁷² *Rogers v. Grimaldi*, 875 F.2d 994, 1004–05 (2d Cir. 1989). TRUMP TOO SMALL is commentary on TRUMP, not a disguised advertisement for something else that is merely incidental to Donald Trump.

¹⁷³ See, e.g., Stacey L. Dogan & Mark A. Lemley, *What the Right of Publicity Can Learn from Trademark Law*, 58 STAN. L. REV. 1161, 1167 (2006) (“[C]ourts and legislatures began to recognize a much broader right of celebrities to prevent commercial use of their identities, without regard to whether the use suggested false endorsement or whether the celebrity had actively sought out the spotlight. It was this shift in emphasis—from protecting the integrity of an individual’s identity to protecting the economic value of celebrity as an alienable economic right—that ushered in the modern age of publicity rights, with all its attendant tensions.”).

¹⁷⁴ See, e.g., David Franklyn & Adam Kuhn, *Owning Oneself in a World of Others: Towards a Paid-for First Amendment*, 49 WAKE FOREST L. REV. 977, 1011 (2014) (“The right [of publicity] is growing unchecked, and attempts to balance it against the First Amendment have resulted in a patchwork of misleading potential defenses.”); ROTHMAN, THE RIGHT OF PUBLICITY, *supra* note 161, at 145 (“The uncertainty of what a speaker can do has itself chilled speech because content creators do not want to risk

2(c) is even worse. It takes *no* countervailing interests into account before denying registration to a mark, First Amendment or otherwise. Accordingly, to the extent the government interest animating section 2(c) is to protect the right of publicity, the statute is unconstitutionally overbroad because it burdens speech that the right of publicity would not burden. The provision is therefore far more extensive than necessary to serve the government's purported interest and is facially unconstitutional.

Again, the distinction may be raised that section 2(c) does not prohibit speech, unlike the right of publicity, which can be used to obtain injunctions against commercial speech in particular circumstances. Unlike a party enjoined from speech under the right of publicity, a disappointed trademark registrant can nonetheless use the trademark in commerce. And again, the answer is that Supreme Court precedent applies scrutiny to regulations that merely burden free speech; not just to regulations that ban free speech. And the Supreme Court and the Federal Circuit have found that the denial of trademark registration constitutes a sufficient burden on speech to subject statutes requiring such denial to at least *Central Hudson* intermediate scrutiny,¹⁷⁵ which section 2(c) fails.

Applying such scrutiny, the Federal Circuit was correct in concluding that “[t]he 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.”¹⁷⁶ Accordingly, even under the intermediate scrutiny of *Central Hudson*, section 2(c) is unconstitutional as applied to political commentary. And because, unlike the right of publicity, the provision requires denial of registration without any inquiry into whether the mark in question constitutes political or social commentary protected by the First Amendment, it is fatally overbroad.

4. The Court Should Have Declared the Statute Facially Unconstitutional

One unfortunate aspect of the *Elster* decision is that the Federal Circuit merely declared that the provision is

litigation or liability.”); Dogan & Lemley, *supra* note 173, at 1162 (“[T]he courts have developed no meaningful counterweight to this ever-expanding right [of publicity]. Instead, they have created a few ad hoc exceptions in cases where the sweeping logic of the right of publicity seems to lead to results they consider unfair.”); Eugene Volokh, *Freedom of Speech and the Right of Publicity*, 40 HOUS. L. REV. 903, 930 (2003) (“[T]here is good reason to think . . . that the right of publicity is unconstitutional as to all noncommercial speech, and perhaps even as to commercial advertising as well.”).

¹⁷⁵ See *supra* Section I.B.

¹⁷⁶ *In re Elster*, 26 F.4th 1328, 1337 (Fed. Cir. 2022).

unconstitutional as applied to TRUMP TOO SMALL. The court declined to hold that the provision is facially unconstitutional, “[a]s Elster raised only an as-applied challenge.”¹⁷⁷ There are several reasons why it would be beneficial for the courts to resolve the facial invalidity of section 2(c) soon, either on appeal of the *Elster* case to the Supreme Court,¹⁷⁸ or in a future case. First, as I have discussed in previous publications, the PTO has been given no guidance as to how to apply the statute to future registrations.¹⁷⁹ Should it apply one of the rights of publicity defenses discussed above?¹⁸⁰ Which one? Is the PTO even equipped to apply First Amendment balancing tests in the context of registration decisions? Is the statute unconstitutional only as applied to marks containing political commentary or (as discussed below) is it unconstitutionally overbroad and therefore invalid in all cases?

Second, many otherwise valid marks will be denied registration in the interim before the facial unconstitutionality issue is properly presented again. And indeed, the mere presence of the provision could have a chilling effect on parties’ choosing marks containing political commentary, parody, or other speech at the heart of the First Amendment.

The mark at issue here may appear to be boorish, low-brow humor, but humor is an important ingredient in much political resistance. George Orwell wrote about this in his essay, “Funny, but not Vulgar”:

A thing is funny when—in some way that is not actually offensive or frightening—it upsets the established order. Every joke is a tiny revolution. If you had to define humour in a single phrase, you might define it as dignity sitting on a tin-tack. Whatever destroys dignity, and brings down the mighty from their seats, preferably with a bump, is funny. And the bigger they fall, the bigger the joke.¹⁸¹

Indeed, when he was in office, nothing seemed to get under Trump’s skin more than being lampooned on *Saturday*

¹⁷⁷ *Id.* at 1339.

¹⁷⁸ The Supreme Court and courts of appeal may depart from the general principle and elect, in particular cases, to rule on issues of law that were not raised or argued below. See *Hormel v. Helvering*, 312 U.S. 552, 557 (1941) (“There may always be exceptional cases or particular circumstances which will prompt a reviewing or appellate court, where injustice might otherwise result, to consider questions of law which were neither pressed nor passed upon by the court or administrative agency below.”).

¹⁷⁹ Samuel F. Ernst, *Another One Bites the Dust: The Federal Circuit Holds that the PTO Violated the First Amendment by Denying Registration to TRUMP TOO SMALL*, PATENTLY-O (Feb. 27, 2022), <https://patentlyo.com/patent/2022/02/violated-amendment-registration.html> [<https://perma.cc/LE2W-8K76>].

¹⁸⁰ See *supra* Section II.B.

¹⁸¹ Orwell, *supra* note 1.

Night Live.¹⁸² Moreover, the fact that TRUMP TOO SMALL hints at the obscene may make it even more potent political commentary. Orwell continues:

[T]he modern emphasis on what is called ‘clean fun’ is really the symptom of a general unwillingness to touch upon any serious or controversial subject. Obscenity is, after all, a kind of subversiveness. Chaucer’s ‘Miller’s Tale’ is a rebellion in the moral sphere, as *Gulliver’s Travels* is a rebellion in the political sphere. The truth is that you cannot be memorably funny without at *some point* raising topics which the rich, the powerful and the complacent would prefer to see left alone.¹⁸³

There are many contemporary examples of humor being used as part of the political resistance against autocrats in, for example, North Africa, Serbia, Egypt, Russia, and the United States.¹⁸⁴ Accordingly, the facial unconstitutionality of section 2(c) should be considered now, to incentivize these jokes flooding forth on T-shirts, buttons, and bumper stickers without further delay.

The Federal Circuit suggested the likely basis for striking Section 2(c) in dictum: the First Amendment overbreadth doctrine. That principle provides that “a law may be overturned as impermissibly overbroad when a ‘substantial number’ of its applications are unconstitutional, ‘judged in relation to the statute’s plainly legitimate sweep.’”¹⁸⁵ Section 2(c)’s sweepingly broad scope “leaves the PTO no discretion to exempt trademarks that advance parody, criticism, commentary on matters of public importance, artistic transformation, or any other First Amendment interests.”¹⁸⁶ Nor is it possible to conceive of a plausible interpretation of the clear wording of the statute that would allow the PTO to exempt from its coverage core First Amendment speech. Nor would it be practical or desirable to have

¹⁸² See, e.g., Nicholas Hautman, *Donald Trump Tears into Alec Baldwin Over the ‘Agony’ of ‘Saturday Night Live’ Impersonation*, US MAG. (Mar. 2, 2018), <https://www.usmagazine.com/celebrity-news/news/donald-trump-tears-alec-baldwin-agony-saturday-night-live-impersonation/> [<https://perma.cc/7XY8-Z8MU>].

¹⁸³ Orwell, *supra* note 1.

¹⁸⁴ See Adam Gallagher & Anthony Navone, *Not Just a Punchline: Humor and Nonviolent Action*, OLIVE BRANCH (May 16, 2019) (citing examples in North Africa and the Middle East), <https://www.usip.org/blog/2019/05/not-just-punchline-humor-and-nonviolent-action> [<https://perma.cc/F68L-FZXE>]; Molly Wallace, *Why Social Change Needs to Be a Laughing Matter*, WAGING NONVIOLENCE: PEOPLE POWERED NEWS & ANALYSIS (June 17, 2017), <https://wagingnonviolence.org/2017/06/incorporate-humor-civil-resistance/> [<https://perma.cc/SGX3-48VM>] (discussing “[n]ew research explor[ing] how humor is used in nonviolent action—particularly its power to disrupt dominant discourses and challenge power.”).

¹⁸⁵ *In re Elster*, 26 F.4th 1328, 1339 (Fed. Cir. 2022) (internal quotation marks omitted) (quoting *Wash. State Grange v. Wash. State Republican Party*, 552 U.S. 442, 449 n.6 (2008)).

¹⁸⁶ *Id.*

the PTO separate the wheat of protected speech from the chafe in thousands of routine registration decisions.

Nor is it necessary to have a statute requiring the PTO to make such distinctions. The other provisions of section 2 adequately allow the PTO to bar registration if there is deception, passing off, confusion, or any of the other legitimate trademark concerns. Is there any legitimate basis for having this statute too, which bars registration without taking any of these concerns into account? For example, the PTO denied registration to ROYAL KATE as applied to luxury goods under section 2(c), finding that “ROYAL KATE identifies Kate Middleton whose identity is renowned.”¹⁸⁷ If a proper First Amendment check were to be placed on section 2(c), the PTO would first have to decide the difficult question of whether ROYAL KATE jewelry is a brazen attempt to use Kate Middleton’s name to sell jewelry or is, instead (or in addition), a comment on the opulence and materialism of the British royal family. But there is no reason to have the PTO do this. If the concern is that ROYAL KATE falsely suggests a connection with Kate Middleton, the PTO can deny registration under section 2(a), which bars registration if a mark “falsely suggest[s] a connection with persons, living or dead.”¹⁸⁸ And in fact, the PTO *did* deny registration to ROYAL KATE on this alternative ground.¹⁸⁹ Denial of registration on this basis does not raise any First Amendment concerns because the government has a substantial interest under the Lanham Act in preventing source confusion, deception, and unfair competition.¹⁹⁰

On the other hand, a mark such as TRUMP TOO SMALL likely does not falsely suggest a connection with Donald Trump because it is critical of Trump. But if it does, then the PTO may properly deny registration under section 2(a). Nor would consumers likely be confused into believing that Donald Trump is the source of goods containing a mark criticizing him. However, if the PTO can establish that they would, then it may deny registration under section 2(d).¹⁹¹ Hence, it would appear to do no harm if section 2(c) were eliminated.

¹⁸⁷ *In re Nieves & Nieves LLC*, 113 U.S.P.Q.2d 1629, 2015 WL 496132, at *14 (TTAB 2015).

¹⁸⁸ 15 U.S.C. § 1052(a).

¹⁸⁹ *In re Nieves & Nieves*, 2015 WL 496132, at *12.

¹⁹⁰ *See Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017); *see also* Ramsey, *supra* note 127, at 449 (arguing that the government has a substantial interest in “(1) preventing fraudulent, deceptive, or misleading uses of marks; (2) promoting fair competition; and (3) facilitating the communication of source-identifying information about goods or services”).

¹⁹¹ *See* 15 U.S.C. § 1052(d) (The PTO must deny registration of “a mark which so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another . . . as to be likely . . . to cause confusion.”).

The government contends that even if these legitimate trademark policies are not implicated, the government can deny registration to protect the right of publicity. But protecting the state right of publicity is not among Congress's stated intents in passing the Lanham Act. Rather, Congress passed the Lanham Act to prevent such things as deception, fraud, misleading marks, and counterfeiting.¹⁹² To the extent the government does have a legitimate interest in protecting the state right of publicity, section 2(c) is not tailored to meet this interest because it prohibits the registration of marks comprised of speech that would not be prohibited or burdened by the right of publicity under its First Amendment defenses.¹⁹³ Hence, section 2(c) is facially unconstitutional as overbroad.

III. IS SECTION 2(C) NECESSARY TO PROTECT FREE SPEECH?

A. *Section 2(c) is Neither Necessary Nor Sufficient to Protect Free Speech*

The government made offhand mention of a new argument for the first time in its rehearing petition before the Federal Circuit: that section 2(c) is necessary to *protect* free speech because federal registration of a mark containing political commentary would prevent others from expressing that same message:

The panel's approach of treating Section 2(c) as akin to a speech restriction disserves, rather than promotes, First Amendment values. Federal registration provides exclusive, nationwide rights in a mark, empowering Elster to prevent others from selling products branded in a way similar to his own products. The remedies available for trademark infringement include injunctive relief, *see* 15 U.S.C. § 1116, meaning that under the panel's decision, Elster can now enlist the federal courts in preventing every other member of the public from engaging in what the panel characterized as speech "at the heart of the First Amendment."¹⁹⁴

One might imagine a hypothetical 2024 presidential campaign in which Senator Marco Rubio adopts the slogan, "Trump is Too Small," and prints it on bumper stickers, yard signs, T-shirts, and buttons distributed throughout the land.¹⁹⁵

¹⁹² *See* 15 U.S.C. § 1127.

¹⁹³ *See supra* Section II.B.

¹⁹⁴ Rehearing Petition, *supra* note 12, at 11–12 (quoting Opinion from TTAB at 11, *reprinted in* Rehearing Petition, *supra* note 12).

¹⁹⁵ *But see* Tim Elfrink, *Marco Rubio, World's Biggest Hypocrite, Will Vote for Donald Trump*, MIAMI NEW TIMES (May 12, 2016), <https://www.miaminewtimes.com/news/marco-rubio-worlds-biggest-hypocrite-will-vote->

The government appears to believe that Steve Elster could then obtain a court order enjoining this political speech.

The government overstates the case by a country mile. First, Elster could not obtain an order enjoining “every other member of the public from engaging in what the panel characterized as speech ‘at the heart of the First Amendment’”;¹⁹⁶ he could only conceivably enjoin those who use his mark or a similar mark in commerce. Second, Elster could prove infringement against that subset of people only to the extent that their use of the mark would likely cause consumer confusion.¹⁹⁷ It would appear highly unlikely that the public would be confused into believing that Marco Rubio’s or any other politician’s official campaign merchandise operated as a source indicator for someone else. Even if the accused infringer were a private citizen, the public would not likely view it as a source indicator at all, as discussed below.¹⁹⁸ Third, there would be little chance of meeting the equitable factors for injunctive relief. To say the least, the balance of harms and public interest would weigh heavily against preventing a politician or any other person from engaging in political speech in a national campaign, even if such an order would not be outright banned by the First Amendment.¹⁹⁹

for-donald-trump-8452230 [https://perma.cc/JU52-VVGN]; Peter Wade, *Florida Man Who Called Trump a ‘Con Artist’ Now Smears Jan. 6 Committee as a ‘Scam’: Sen. Marco Rubio Seems to Be Thirsty for Some MAGA Love*, ROLLING STONE (Feb. 6, 2022), https://www.rollingstone.com/politics/politics-news/marco-rubio-jan-6-committee-scam-1295923/ [https://perma.cc/3GTF-TQ52]; Alexi C. Cardona, *Rubio Didn’t Challenge the Election, but He Has Long Been Trump’s Toady*, MIAMI NEW TIMES (Jan. 8, 2021), https://www.miamiherald.com/news/five-times-marco-rubio-defended-president-donald-trump-11797984 [https://perma.cc/H5NG-TCQS].

¹⁹⁶ Rehearing Petition, *supra* note 12, at 11–12; *see supra* note 13 and accompanying text.

¹⁹⁷ *See* 15 U.S.C. § 1114(1) (requiring likelihood of confusion to prove infringement of a registered mark). In fact, Elster would not even need to federally register his mark to sue for false designation of origin or false description if he could satisfy the requirements of 15 U.S.C. § 1125(a)(1)(A), including proof of likelihood of confusion.

¹⁹⁸ *See infra* Section IV.

¹⁹⁹ *See Garcia v. Google, Inc.*, 786 F.3d 733, 747 (9th Cir. 2015) (en banc) (affirming on rehearing en banc the 9th Circuit reversing and remanding the District Court’s denial of a motion for a preliminary injunction against copyright infringement be entered because, *inter alia*, “[t]he panel’s takedown order of a film of substantial interest to the public is a classic prior restraint of speech.”); *Herb Reed Enters., LLC v. Fla. Ent. Mgmt., Inc.*, 736 F.3d 1239, 1247 (9th Cir. 2013) (quoting from *Winter v. Nat. Res. Def. Council, Inc.*, 555 U.S. 7, 44 (2008)) (In order to obtain a preliminary injunction for trademark infringement, the plaintiff “must establish that [he] is likely to succeed on the merits, that [he] is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in [his] favor, and that an injunction is in the public interest.”); *Oriental Fin. Grp., Inc. v. Cooperativa de Ahorro y Credito Oriental*, 832 F.3d 15, 37 (1st Cir. 2016) (In order to grant permanent injunctive relief for trademark infringement, “the district court must reassess equitable factors such as the nature of the harm flowing from the infringement, the availability of alternative remedies, and any hardship an injunction might cause to [the defendant] or to the public.”). For an interesting discussion of the propriety of applying the traditional

But even if a hypothetical suit against a political candidate would fail, perhaps a suit against a nonpolitician would fare better. And even if it would not, the mere fact of federal registration can have a chilling effect on free speech.²⁰⁰ Hence, we are still left with the argument that section 2(c) serves the purpose of preventing the monopolization of political speech. Other than the offhand mention in its rehearing petition, the government has never advanced the need to protect free speech as the animating interest behind section 2(c). If it were to do so, section 2(c) would be wholly insufficient to protect that interest for two reasons. First, the Lanham Act allows the PTO to register a wide array of marks that contain political or social commentary, so long as they do not use the name of a famous person without his or her consent and otherwise qualify under the provisions of section 2. Second, section 2(c) does not prevent politicians themselves from registering political speech containing their own names and thereby burdening others from using the same political message in commerce.

And that, perhaps, is the real thing to be concerned about with respect to the trademarking of political and social commentary. Theoretically, a politician like Donald Trump could register a mark critical of himself—such as TRUMP TOO SMALL—solely to restrict others from conveying the same or a similar message on goods in commerce. But this too may be unlikely for several reasons. First, the politician would have to be willing to make sufficient use of the mark in commerce to qualify for trademark protection. “The term ‘use in commerce’ means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”²⁰¹ One suspects Donald Trump would be reluctant to sell even the minimal number of T-shirts to maintain a trademark if the T-shirts informed the public that his own policies and body parts were “TOO SMALL” or were otherwise critical of him. Even if a politician were willing to engage in this gambit, it may be difficult to prove likelihood of confusion. Consumers would be unlikely to believe that the hypothetical defendant’s T-shirt criticizing Donald Trump actually originated from or was sponsored by Trump. There is no requirement to prove likelihood of confusion to sue for dilution, but surely Trump would not seek to make a mark critical of himself famous, as dilution requires.

equitable factors in the context of trademark infringement, see Mark Lemley, *Did eBay Irreparably Injure Trademark Law?*, 92 NOTRE DAME L. REV. 1795 (2017).

²⁰⁰ For a discussion of the chilling effect of trademark registration on speech, see Ramsey, *supra* note 127, at 426–27.

²⁰¹ 15 U.S.C. § 1127.

Even if an injunction were unavailable and infringement unlikely to be proven, the mere specter of damages and the cost of a lawsuit could be enough to quell political speech. And, section 2(c) does nothing to prevent this theoretical practice. In fact, the Lanham Act gets things completely backwards. It allows politicians to register their names as marks containing political commentary about themselves, thereby reaping the financial rewards of a federal registration; but forbids other citizens from doing so without the politicians' consent. Hence, the Act creates a regime that burdens critical political commentary while incentivizing propaganda. By this logic, section 2(c) results in de facto viewpoint discrimination.

Should the Act therefore bar politicians from registering marks containing their names while allowing everyone else to do it? This would impinge on the free speech of politicians. Moreover, allowing *anyone* to trademark political commentary could result in the quelling of free speech. This is the paradox of recognizing a First Amendment right to free expression through trademark registration. Once having gained the trademark registration, there is a danger that the registrant may use the mark to prevent the free speech of others.²⁰² However, this concern is too big of a whale for section 2(c) to swallow due to the other contexts in which the Lanham Act allows for the registration of marks containing political or social commentary. Professor Ramsey provides many examples of registered trademarks containing political and social commentary, including, “FAIR AND BALANCED for the news reporting services of Fox News . . . #METOO’ for lipstick, perfume, wristbands, and legal services, and MAKE AMERICA GREAT AGAIN and BLACK LIVES MATTER for clothing, printed publications, and various other goods and services.”²⁰³ Nothing in section 2(c) prevents the registration of these marks. Under the Supreme Court’s jurisprudence, it would violate the First Amendment to deny registration of these marks based on their political and social content. However, the Court has failed properly to consider that registration poses a greater threat to free speech than the denial of registration. Registration allows private entities to use political marks to restrict the free speech of others. And again, even if such a lawsuit might fail if actually

²⁰² Ramsey, *supra* note 130, at 834 (arguing that “the right to freedom of expression should not be invoked to justify trademark registration of a desired trademark because of the potential ability of the owner to use that right to suppress expression by others”).

²⁰³ Ramsey, *supra* note 127, at 462 (citations omitted).

litigated, the federal registration itself can cause a chilling effect on free speech.

B. The Supreme Court's First Amendment Jurisprudence Is Too Rigid to Engage the Free Speech Problems Inherent in Intellectual Property Law

The problem, then, with the Supreme Court's First Amendment jurisprudence is that it fails to take a holistic, nuanced approach to these complicated questions. Rather, the Court deals in rigid categories of scrutiny that focus myopically on the rights of the speaker (here, the trademark registrant), without considering how the absolute protection of those rights might affect the speech rights of others. This is a focus of Genevieve Lakier's excellent scholarship, in which she is critical of the Court's view of free speech "as a right that guarantees freedom from intentional government interference with an individual's autonomy, but one that provides almost no protection whatsoever against private interference and constraint."²⁰⁴

There are many current examples of the Court's narrow-minded approach resulting in less freedom of speech, not more.²⁰⁵ For example, in *Boy Scouts of America v. Dale*, the Court decided that the First Amendment rights of the Boy Scouts organization were violated by a New Jersey public accommodations law requiring it to rehire a gay scoutmaster it had fired.²⁰⁶ The Court decided that the New Jersey law unconstitutionally constrained the Boy Scouts from communicating "a message of moral cleanliness that did not include homosexuality."²⁰⁷ But as Lakier points out,

[i]n holding as much, the Court again paid no attention to the other expressive interests at stake in the dispute—including perhaps most importantly the expressive interests of the scoutmaster, James Dale, who lost his position not because of his sexual orientation but because of his willingness to publicly speak out about his sexual orientation.²⁰⁸

This concern would have been irrelevant to the Court, because the Boy Scouts are a private entity, and the Court only views the First Amendment as protecting against government

²⁰⁴ Genevieve Lakier, *The First Amendment's Real Lochner Problem*, 87 U. CHI. L. REV. 1241, 1246 (2020).

²⁰⁵ See *id.* at 1322–30.

²⁰⁶ *Boy Scouts of Amer. v. Dale*, 530 U.S. 640, 644 (2000); see also Lakier, *supra* note 204, at 1328.

²⁰⁷ Lakier, *supra* note 204, at 1328.

²⁰⁸ *Id.*

restrictions on speech.²⁰⁹ The end result is that the grant of speech rights to a private actor allows that entity to restrict the speech rights of other actors, resulting in less free speech.

The most notorious example of this is, of course, *Citizens United v. Federal Election Commission*. There, the Court vindicated the First Amendment rights of private corporations to be free from campaign finance laws prohibiting them from making unlimited use of their “general treasury funds” to advocate for or against political candidates.²¹⁰ The practical result of the decision is that private corporations can use their wealth to flood the media with political propaganda to a degree that the speech of less powerful private citizens and organizations cannot be heard above the cacophony. As a technical matter, the Court appeared to protect free speech, but in reality, the decision restricted free speech more than ever before. In short, the marketplace of ideas cannot lead to truth if corporate speakers are viewed as citizens and hold an exponentially louder megaphone than actual human beings. Thomas Jefferson may have been correct in 1801 when he stated that it is safe to tolerate “error of opinion . . . where reason is left free to combat it.”²¹¹ However, in 2022, private individuals have very little practical freedom to correct the political speech of corporations, and therefore much less freedom of speech.

What is required is a more nuanced approach to the First Amendment, as Justice Breyer often argued.²¹² In *Brunetti*, Justice Breyer argued against the rigid, “category-based approach to the First Amendment,” pointing out that “[t]he First Amendment is not the Tax Code.”²¹³ He urged the Court to instead “appeal more often and more directly to the values the First Amendment seeks to protect.”²¹⁴ Rather than focusing on inflexible, outcome-determinative categories, Justice Breyer suggested a balancing test: “I would ask whether the regulation at issue ‘works speech-related harm that is out of proportion to its

²⁰⁹ *Manhattan Cmty. Access Corp. v. Halleck*, 139 S. Ct. 1921, 1928 (2019) (“The text and original meaning of those Amendments, as well as this Court’s longstanding precedents, establish that the Free Speech Clause prohibits only *governmental* abridgment of speech.”).

²¹⁰ *Citizens United v. Fed. Election Comm’n*, 558 U.S. 310, 318–19 (2010).

²¹¹ See Thomas Jefferson, *First Inaugural Address* (Mar. 4, 1801), in *WRITINGS* 492–93 (Merrill D. Peterson ed. 1984).

²¹² See, e.g., *Reed v. Town of Gilbert*, 576 U.S. 155, 176–79 (2015) (Breyer, J., concurring) (criticizing rigid categories of scrutiny); *United States v. Alvarez*, 567 U.S. 709, 730 (2012) (Breyer, J., concurring) (urging a balancing approach to First Amendment jurisprudence).

²¹³ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2304 (2019) (Breyer, J., concurring in part).

²¹⁴ *Id.* at 2305.

justifications.”²¹⁵ This would have allowed the Court to decide, for example in *Citizens United*, that the state’s justification for limiting corporate political expenditures far outweighs the speech-related harm to those corporate entities, because the statute allows for the flourishing of more free speech overall.

Some would argue that weighing the adverse effects of private actors’ speech on the free speech rights of others is not supported in the language of the First Amendment, which only provides that “Congress shall make no law . . . abridging the freedom of speech,”²¹⁶ and says nothing about private restrictions on speech. But the issue is whether Congress has made a law which on the whole abridges free speech by allowing powerful private actors like corporations and politicians to diminish the free speech of others. This makes no difference to the current Supreme Court, whose jurisprudence dictates that “the concept that government may restrict the speech of some elements of our society in order to enhance the relative voice of others is wholly foreign to the First Amendment.”²¹⁷ This is incorrect, because for many decades the Supreme Court *did* apply a more nuanced balancing approach in its First Amendment jurisprudence. This approach took into account the potentially deleterious effects of powerful private interests on the quantum of free speech in society as a whole.²¹⁸

Applying such a balancing test in *Elster* would still result in the conclusion that section 2(c) is unconstitutional. Indeed, the Federal Circuit panel does an admirable job of weighing the free speech interests on both sides of the equation before concluding that the statute is unconstitutional, “whether we apply strict scrutiny . . . or . . . intermediate scrutiny.”²¹⁹ The core of the court’s analysis is not preoccupied with these rigid categories. Instead the court weighs the fact that “[t]he First Amendment interests here are undoubtedly substantial” against the fact that the PTO has very little if any legitimate interest in protecting a public official’s privacy and publicity interests.²²⁰ In section 2(c), Congress has created a law that effectively allows

²¹⁵ *Id.* (quoting *Alvarez*, 567 U.S. 709, 730 (2012) (Breyer, J., concurring)).

²¹⁶ U.S. CONST. amend I (emphasis added).

²¹⁷ *Buckley v. Valeo*, 424 U.S. 1, 48–49 (1976).

²¹⁸ Lakier, *supra* note 204, at 1307–11 (describing how “[t]he Court . . . employ[ed] this, what we might call ‘realist,’ conception of freedom of speech throughout the 1950s and 1960s,” perceiving “that private economic power could limit the exercise of constitutional rights just as government coercion could, and that government intervention into the private sphere could consequently protect, not merely threaten, constitutional liberty.”).

²¹⁹ *In re Elster*, 26 F.4th 1328, 1338–39 (Fed. Cir. 2022).

²²⁰ *Id.* at 1334.

famous people to veto the marks of other people by withholding their consent to registration—even in the absence of consumer confusion, deception, or any other legitimate IP concern—often because they merely do not wish to be mocked or criticized. While using section 2(c) to veto marks would be stricken under both a nuanced balancing approach and the rigid categories-based approach, the latter cannot sufficiently deal with the larger threats to free speech permitted under the Lanham Act.

But the Supreme Court’s rigid analysis is not sufficient to deal with the larger threats to free speech permitted under the Lanham Act: the ability of powerful politicians, celebrities, and corporations to gain an exclusionary right in political and social commentary through trademark registration. The Court’s practice of only considering the rights of the speaker is particularly pernicious in intellectual property. This is because often the speaker is not only asserting a right to speak, but also the right to exclude other people from speaking.

Several scholars have observed how copyright law’s private rights of exclusion can impinge on free speech. Yochai Benkler argues that “[c]opyright and related laws regulate society’s information production and exchange process. They tell some people how they can use information, and other people how they cannot.”²²¹ To the extent that trademarks are increasingly viewed as private intellectual property, rather than as limited devices to protect consumers from confusion, they implicate the same concerns.²²² The situation is worse in trademark law, however, because copyright retains at least some term limits and other requirements that are absent from the Lanham Act. Moreover, because Congress’s power to grant exclusionary copyrights is expressly granted in the Constitution, it may lay some legitimate claim to coexisting with the First Amendment as part of the general constitutional scheme, burdening free speech in ways that trademark law cannot.

I remain convinced that section 2(c) is an unconstitutional burden on free speech. To the extent the government is genuinely concerned that trademarks containing political commentary can be used to exclude others from such speech, 2(c) does nothing to address that problem. The provision, in fact, exacerbates that problem by giving politicians veto power over political commentary trademarks they do not approve while allowing them

²²¹ Yochai Benkler, *Free as the Air to Common Use: First Amendment Constraints on Enclosure of the Public Domain*, 74 N.Y.U. L. REV. 354, 357 (1999); see also L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 VAND. L. REV. 1 (1987).

²²² See *infra* Part IV.

to freely register trademarks of self-praise. And so long as one does not use the identity of a politician without their consent, anyone can register all manner of political and social commentary as a trademark, thereby gaining a limited right to exclude others from using that speech in commerce.

In order to truly safeguard our free speech rights from trademark law's exclusionary rights, we need a First Amendment jurisprudence that is flexible enough to balance those rights against the First Amendment interests of competitors, consumers, and society as a whole. This is an important concern because often it is the wealthy and powerful who benefit from the Supreme Court's rigid First Amendment jurisprudence: corporations, politicians, celebrities, and those having the savvy and resources to hire attorneys to register and vindicate their intellectual property rights. And it is the less empowered whose free speech rights are generally disregarded under the Court's analysis: individual artists, voters, and activists, who may lack the resources to protect their freedom of speech.²²³

Should section 2(c) nonetheless be applied outside of the political and social commentary context, to bar registration of marks that use a celebrity's name for merchandising purposes? For example, should someone other than Michael Jordan be able to sell or license the sale of Michael Jordan T-Shirts? Should someone other than Donald Trump be able to sell Donald Trump steaks or automobiles? Perhaps not, but section 2(c) is not necessary to prevent these uses. As discussed above, the Lanham Act separately provides for the denial of registration of marks that suggest a false connection with a person, are deceptive, or would cause source confusion or mistake.²²⁴

IV. IS THE "FAILURE TO FUNCTION" DOCTRINE THE SOLUTION TO THE GOVERNMENT'S PERCEIVED CONCERN?

As discussed, the government claims it is concerned with how registering marks containing political commentary could threaten the free speech rights of others who want to make such commentary.²²⁵ A simple solution would be disallowing the registration of marks primarily consisting of political or social

²²³ See Lakier, *supra* note 204, at 1245 ("Just as it once did in its freedom of contract cases, in recent decades the Supreme Court has embraced a highly academic conception of freedom of speech . . . [which] insists that most legislative efforts to protect the expressive freedom of the less powerful by limiting the expressive freedom of the more powerful are constitutionally impermissible.").

²²⁴ 15 U.S.C. §§ 1052(a), (d).

²²⁵ See *supra* Section III.A.

commentary completely—either by famous people or by members of the general public. How could this be done in compliance with the First Amendment? By relying on traditional trademark doctrine to deny such registrations, rather than the peculiar section 2(c), which does not effectively address this concern and has no grounding in the original purposes of the Lanham Act: fair competition and consumer protection.

The PTO and the courts can deny protection to marks that are primarily political or social commentary under the “failure to function” doctrine. In her article, “Trademark Failure to Function,” Alexandra J. Roberts explains that “[t]o be protectible, a trademark must be . . . used in a trademark way.”²²⁶ It is insufficient for a mark to be distinctive and used in commerce. Rather, “it must be used as a mark—featured in a way that will draw consumers’ attention to it and lead them to view it as a source indicator.”²²⁷ This requirement is found in the Lanham Act’s definition of a “trademark,” which provides, in pertinent part, that a trademark must be “used by a person to identify and distinguish that person’s goods from those of others and to indicate the source of the goods, even if that source is generally unknown.”²²⁸ The relevant question is whether the public would perceive the mark as a source indicator,²²⁹ even if consumers “cannot . . . identify the precise company that manufactures particular goods.”²³⁰ Professor Roberts points out that “[f]ailure to function arises most often at the registration stage.”²³¹ The doctrine should be applied more rigorously at both the registration and litigation stage to eliminate marks that consist primarily of social or political commentary.

A. *Ornamental Matter that Fails to Function*

The “Trademark Manual of Examining Procedure” divides failure-to-function denials into two general categories:

²²⁶ Roberts, *supra* note 21, at 1981.

²²⁷ *Id.* at 1977.

²²⁸ 15 U.S.C. § 1127.

²²⁹ Roberts, *supra* note 21, at 1995 (relying on *In re Eagle Crest, Inc.*, 96 U.S.P.Q.2d 1227, 2010 WL 3441109, at *2 (T.T.A.B. 2010)).

²³⁰ *Id.* (discussing the “anonymous source doctrine” in section 1127 of the Lanham Act); see also Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621, 678 (2004) (“In the 1910s and ‘20s, the ‘anonymous source theory’ was developed to meet a felt need. According to this theory, in order to qualify for protection, a trademark need only designate a single, though possibly anonymous, source.”) (citing Frank I. Schechter, *The Rational Basis of Trademark Protection*, 40 HARV. L. REV. 813, 816 (1927)).

²³¹ Roberts, *supra* note 21, at 1985.

ornamentation and informational matter.²³² Under the first category, “[s]ubject matter that is merely a decorative feature does not identify and distinguish the applicant’s goods and, thus, does not function as a trademark.”²³³ For example, “[a] decorative feature may include words, designs, *slogans*, or trade dress.”²³⁴ Political and politicized slogans, such as “Make America Great Again” or “Black Lives Matter,” may not be perceived by consumers as a trademark because of how and where they appear on the product. A genuine trademark might appear on a hood ornament or a T-shirt tag. By contrast, as Professor Ramsey writes, “display of the word or symbol prominently on the front or back of T-shirts is less likely to function as a mark compared to use of it on a tag or label attached to the product.”²³⁵

For example, in one case the TTAB affirmed the denial of registration of the mark “NO MORE RINOS!” as applied to posters, bumper stickers, campaign buttons, T-shirts, and other products.²³⁶ The Board noted that “No More RINOs!” is a commonly used political slogan meaning ‘No More Republicans In Name Only.’²³⁷ The Board then examined the physical display of the mark on the registrant’s products:

The specimens of use . . . consist of photographs of a bumper sticker, sign and novelty pin, each displaying applicant’s proposed mark in large, prominent lettering in the center of each item. Clearly, the placement, size, and dominance of the wording are consistent with informational (or ornamental), not trademark use. Such prominence is more consistent with the conveying of an informational message than with signifying a brand or an indicator of source.²³⁸

The Board concluded that due to the way in which the political slogan was displayed, “it [did] not have the commercial impression of a source indicator,” and was therefore not entitled to registration.²³⁹ Hence, the PTO can deny registration to a political slogan because it is used as the main feature of a T-Shirt or bumper sticker. When so used, consumers do not perceive the slogan as an indication of the source of the physical goods, but rather as political expression.

²³² See generally TMEP, *supra* note 42, § 1202.03 (“Refusal on Basis of Ornamentation”); *Id.* § 1202.04 (“Informational Matter”).

²³³ *Id.* § 1202.03.

²³⁴ *Id.* (emphasis added).

²³⁵ Lisa P. Ramsey, *Using Failure to Function Doctrine to Protect Free Speech and Competition in Trademark Law*, 104 IOWA L. REV. ONLINE 70, 85 (2020).

²³⁶ *In re* Thomas J. Hulting, 107 U.S.P.Q.2d 1175, 2013 WL 5407310, at *1 (T.T.A.B. 2013).

²³⁷ *Id.* at *2.

²³⁸ *Id.* at *3.

²³⁹ *Id.*

B. Informational Matter that Fails to Function

The “Trademark Manual of Examining Procedure” also allows for the denial of registration of “Informational Matter.”²⁴⁰ This includes “general information about the goods or services.”²⁴¹ For example, the Federal Circuit held that the proposed mark THE BEST BEER IN AMERICA was “so highly laudatory and descriptive of the qualities of [registrant’s] product that the slogan does not and could not function as a trademark to distinguish Boston Beer’s goods and serve as an indication of origin.”²⁴² But it also includes “Widely Used Messages”²⁴³ and “Slogans or Words Used on the Goods.”²⁴⁴ For example, the TTAB denied registration to the mark EVERYBODY VS RACISM as applied to tote bags, T-shirts, hoodies, and other clothing.²⁴⁵ The Board reasoned as follows:

[W]e find that consumers would perceive EVERYBODY VS RACISM as merely an informational anti-racist message that everyone—every person, institution or organization should support the fight against racism. The commonplace meaning imparted by the phrase EVERYBODY VS RACISM would be the meaning impressed upon the purchasing public, and it would not be perceived as a service mark or trademark. Clothing and tote bags imprinted with EVERYBODY VS RACISM will be purchased by consumers for the informational message it conveys. Therefore, consumers accustomed to seeing this phrase displayed on clothing, tote bags and other retail items from many different sources would not view the slogan as a trademark indicating source of the clothing or tote bags.²⁴⁶

In another case, the Board denied registration to ONCE A MARINE, ALWAYS A MARINE because the primary function of the mark was “to express support, admiration or affiliation with the Marines,” not to indicate the source of goods or services.²⁴⁷ These decisions rely, in part, on evidence before the PTO that the slogans at issue were widely used by others in a nontrademark context. One might argue that a mark like TRUMP TOO SMALL could escape this doctrine if it were truly novel. But the use by others of the mark merely serves as evidence to demonstrate the main point: that the appearance and informational content of the mark indicates that it does not

²⁴⁰ TMEP, *supra* note 42, § 1202.04.

²⁴¹ *Id.* § 1202.04.

²⁴² *In re Bos. Beer Co.*, 198 F.3d 1370, 1373–74 (Fed. Cir. 1999).

²⁴³ TMEP, *supra* note 42, § 1202.04(b).

²⁴⁴ *Id.* § 1202.03(f)(i).

²⁴⁵ *In re Go & Assocs., LLC*, No. 88944728, 2022 WL 1421542, at *1 (T.T.A.B. 2022).

²⁴⁶ *Id.* at *7 (citing *In re Eagle Crest Inc.*, 96 U.S.P.Q. 2d 1227, 1230 (T.T.A.B. 2010)).

²⁴⁷ *In re Eagle Crest*, 96 U.S.P.Q. 2d at 1232.

function as a source indicator and should not, therefore, have trademark protection. Accordingly, Professor Ramsey writes that the doctrine should be used to deny registration to “political phrases like KEEP AMERICA GREAT and MAKE AMERICA AMERICA AGAIN.”²⁴⁸

Hence, the PTO could deny registration to a mark primarily comprising political commentary (whether it includes a famous person’s name) without running afoul of the First Amendment on this legitimate trademark ground: such marks fail to function as source identifiers to consumers. After all, are these really trademarks? When a consumer sees a T-shirt or bumper sticker saying, “Love Trumps Hate” or “Trump Too Small” or “Tuck Frump” or “Dump Trump” or “Trump: 20-24 Years in Prison” or “Bye-Don 2020” or even “Trump for President,” she will most likely perceive those words as the free expression of political opinions. They are not actually indicators of the source and quality of the T-Shirt or bumper sticker such as is a mark like FRUIT OF THE LOOM.

C. *The Denial of Registration to Marks that Fail to Function as Trademarks Does Not Violate the First Amendment*

Failure-to-function denials are undoubtedly “content based” under the Supreme Court’s jurisprudence, because they deny protection to marks whose content is primarily political or social commentary. But as other scholars have long pointed out, most trademark registration decisions are content-based restrictions on speech, as are most enforcement decisions.²⁴⁹ For example, when a court enjoins a party for commercial messaging infringing a trademark, it is restraining that commercial speech based on the content causing likely consumer confusion. When a court denies federal registration to a mark because it falsely suggests a connection with another entity, it is burdening speech based on its content.

²⁴⁸ Ramsey, *supra* note 235, at 87–88.

²⁴⁹ See, e.g., Mark A. Lemley & Eugene Volokh, *Freedom of Speech and Injunctions in Intellectual Property Cases*, 48 DUKE L.J. 147, 218 (1998) (“Other courts have concluded that while trademark laws *do* restrict speech, they do so in a ‘content-neutral’ manner and are therefore permissible. These courts have apparently confused viewpoint-neutrality with content-neutrality.”) (internal citations omitted); Eugene Volokh, *Freedom of Speech and Intellectual Property: Some Thoughts After Eldred*, 44 LIQUORMART, and Bartnicki, 40 HOUS. L. REV. 697, 703–12 (2003); Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 433 (2008) (“Trademark laws define the speech they prohibit or allow based on the content of the speech.”).

These regulations of commercial speech pass constitutional muster under *Central Hudson* because the government has a substantial interest in using the trademark laws to prevent consumer confusion, market deception, and unfair competition.²⁵⁰ Failure-to-function denials to marks consisting primarily of political or social commentary are similarly based in a substantial government interest: ensuring trademark protection is reserved for legitimate consumer protection and fair competition purposes, and not to monopolize free expression.

There is no substantial government interest in using the trademark laws to grant property-like rights in artistic expression, such as political slogans. “The Trademark Act is not an act to register mere words, but rather to register trademarks.”²⁵¹ Trademark law originated as a consumer protection and unfair competition regime to allow consumers to easily distinguish brands from one another and rely on the consistent quality (or lack thereof) of goods and services coming from particular sources. As Rebecca Tushnet has written, “Protection against consumer confusion is the core of modern trademark law: trademark ensures that people can get what they want when they buy Coca-Cola soda.”²⁵² Section 2(c), which is grounded in the right of publicity a celebrity has in her persona—and not by the need to prevent marketplace confusion, deception, and unfair competition—is not animated by a legitimate trademark justification. Rather than denying registration to the limited universe of marks targeted by section 2(c), the PTO should deny registration to all marks consisting primarily of political and social commentary on the basis that they do not function to prevent marketplace confusion, deception, and unfair competition.

Denying registration to marks consisting primarily of political commentary results in the free expression of such clever opinions while incentivizing bumper sticker and T-shirt manufacturers to compete on the physical quality of their goods.

²⁵⁰ See Lemley & Volokh, *supra* note 249, at 221 (“The strongest constitutional justification for trademark laws is that, properly construed, they prevent only commercial speech that is likely to cause consumer confusion, and that false or misleading commercial speech can be restricted.”).

²⁵¹ *In re Bose Corp.*, 546 F.2d 893, 896 (C.C.P.A. 1976).

²⁵² Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867, 873 (2017) (citing *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989) (“[Trademark’s function is] protecting consumers from confusion as to source. While that concern may result in the creation of ‘quasi-property rights’ in communicative symbols, the focus is on the protection of consumers.”) (alteration in original)).

There is likely sufficient incentive for people to create clever and expressive political slogans from the intense desire to influence politics that has long been a hallmark of this country. To the extent that is not true, authors might seek copyright protection for the expressive aspects of their political slogans, subject to its attendant restrictions and term limits. Copyright, after all, is the species of intellectual property that is intended to protect artistic expression. And it avoids protecting mere ideas, such as political opinions.²⁵³ Moreover, the power of Congress to grant property-like exclusionary rights through copyright is explicitly authorized by the Constitution, which provides that “Congress shall have Power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.”²⁵⁴ Congress’s power to grant exclusionary property rights under the Commerce Clause through a trademark act becomes much more tenuous the more that law veers from its original purpose of protecting consumers and regulating deceptive trade practices.

Of course trademarks long ago morphed into a form of intellectual property; for example, with the dilution statute, which requires no likelihood of consumer confusion or market deception at all.²⁵⁵ For this reason, as other scholars have argued, the dilution statute too should be declared unconstitutional as a violation of the First Amendment.²⁵⁶ Dilution allows for the suppression of speech based on the creation of a property-like exclusionary right that Congress had no business inventing outside of the context of patent and copyright law and in the absence of any finding of likely confusion, deception, or unfair competition in interstate commerce. It is long overdue to return trademark law to its

²⁵³ 17 U.S.C. § 102(b) (“In no case does copyright protection for an original work of authorship extend to any idea.”).

²⁵⁴ U.S. CONST. art. I, § 8, cl. 8.

²⁵⁵ See 15 U.S.C. § 1125(c) (providing protection to “famous” marks against tarnishment and blurring even in the absence of a likelihood of consumer confusion); see also Tushnet, *supra* note 252 at 915 (“This immediate problem with dilution is a consequence of dilution’s foundational flaw: dilution eschews any consumer protection purpose. It is about protecting trademark owners, whether that protection is framed as rewarding investment, protecting property rights, or safeguarding dignity.”) (footnote omitted).

²⁵⁶ See, e.g., Mary LaFrance, *No Reason to Live: Dilution Laws as Unconstitutional Restrictions on Commercial Speech*, 58 S.C. L. Rev. 709, 711 (2007) (“Under the standards established by the Supreme Court in *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*, dilution laws violate the First Amendment because they restrict commercial speech without advancing any substantial government interest.”) (footnote omitted); see also Ramsey, *supra* note 127, at 456 (“[D]ilution laws are probably unconstitutional.”).

original moorings and stop allowing it to serve as a regime for the private ownership of language.

CONCLUSION

The Federal Circuit is undoubtedly correct that under Supreme Court precedent, section 2(c) of the Lanham Act's bar on registering marks containing a name, portrait, or signature identifying a particular living individual except by his written consent violates the First Amendment as applied to marks containing political commentary. Indeed, the provision is likely facially unconstitutional as overbroad. Speech criticizing those wielding power—particularly comic ridicule—is part of a long tradition of dissent against tyranny and is at the heart of the First Amendment.

However, this issue invites an examination of the many more pernicious contexts in which the Lanham Act *does* allow for the trademarking of political and social commentary. This, in turn, raises a broader critique of the Supreme Court's rigid, categories based First Amendment analysis as failing to balance the effects of negative First Amendment rights on the free speech of other individuals and the flourishing of free speech in society as a whole. This is particularly true for intellectual property in cases where the speaker is not only asserting the right to speak, but also the right to own that speech—to exclude others from saying the same thing. The Lanham Act can be used to solve this problem, not through the constitutionally invalid section 2(c), but rather through denying protection to marks that “fail to function” as source indicators. In general, trademark law would benefit from any reform that would return it to its original grounding as a consumer protection law, rather than an intellectual property regime.