'Trump Too Small' Args Show Justices Inclined To Reverse

By **Brian Brookey** (November 20, 2023)

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On Nov. 1, the U.S. Supreme Court conducted **oral argument** in Vidal v. Elster, which involves the registrability of the mark "Trump Too Small."

Registration of federal trademarks is governed by the Trademark Act of 1946, commonly referred to as the Lanham Act. Section 1052(c) bars registration of a mark that "[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except with his written consent."

The question presented in this case was whether "the refusal to register a mark under Section 1052(c) violates the free speech clause of the First Amendment when the mark contains criticism of a government official or public figure."

Although a decision is not expected for several months, the tenor of the justices' questions and comments makes it clear that the answer most likely is no.

Background

Petitioner Steve Elster is a California attorney who sells T-shirts using the phrase "Trump Too Small," mocking former President Donald Trump and his policies.

In 2018, Elster applied for registration. Based on, among other things, Section 1052(c), the U.S. Patent and Trademark Office rejected his application.

The U.S. Court of Appeals for the Federal Circuit reversed that decision last year, finding that the rejection violated Elster's First Amendment right to free speech.

Katherine Vidal, in her capacity as director of the USPTO, sought Supreme Court review and asked the court to reverse the Federal Circuit's opinion.

In recent years, the Supreme Court has stricken other restrictions on registration contained in the Lanham Act on free speech grounds. In its 2017 opinion in Matal v. Tam, the Supreme Court found that rejection of registration on the grounds that a mark was supposedly "disparaging" violated the First Amendment.

Two years later, in Iancu v. Brunetti, the court came to a similar conclusion regarding the constitutionality of refusing registration of marks that are "immoral or scandalous."

Elster's case raised the question of whether the Supreme Court would once again find that — no pun intended — the First Amendment trumps a limitation on registrability.

Summary of Oral Argument

In what Chief Justice John Roberts noted was his 100th argument before the Supreme Court, Deputy Solicitor General Malcolm Stewart appeared on behalf of the USPTO. Counsel Jonathan Taylor — in his first Supreme Court appearance — argued on Elster's behalf.

Stewart began by highlighting his three main arguments. First, denying registration is simply withholding a governmental benefit, and not restricting speech.

Second, unlike the situations in Tam and Brunetti, the prohibition on registering someone else's name is viewpoint-neutral, meaning that Elster was not entitled to heightened scrutiny, and that the USPTO just had to demonstrate the reasonableness of what Stewart referred to as the living individual clause.

Third, Stewart raised the policy argument that striking the restriction would actually harm free speech rights, because Elster would have a "monopoly" that would prevent others from using the mark "Trump Too Small."

Many of the justices played devil's advocate in their questioning of Stewart, with the notable exception of Justice Samuel Alito, who openly expressed his skepticism of the government's position.

Like Stewart, Taylor opened his argument by previewing three areas on which he wanted to focus: the need for heightened scrutiny because the rejection was content-based and not neutral; the impropriety of leveraging the trademark system for purposes unrelated to trademark registration; and the contention that the living individual clause amounts to "speaker-based discrimination."

The justices left Taylor with little time to explore all of these points.

The court's questioning of Taylor was much more aggressive than that of Stewart, and in fact at times seemed condescending. Most of the justices left no doubt as to where they stood — which was not good news for Elster.

Analysis

Many of the questions posed to Stewart dealt with abstract and theoretical issues, such as the potential impact of a decision upholding the living individual clause on copyright law. Stewart pointed out, quite reasonably, that there would be no such impact.

Copyright law protects the free expression of ideas, while trademark law deals with designating the source of goods and services, and preventing confusion as to that source.

Responding to a hypothetical, Stewart pointed out that prohibiting registration of the "Trump Too Small" mark would not mean that an author could not copyright a "Trump Too Small" book.

Of course, there is no analog in the Copyright Act that would lead to such a conclusion, so the justices' focus on that issue seemed puzzling. The question no one addressed was whether the U.S. Copyright Office's ban on registering the title of a book — as opposed to its contents — somehow could be seen as a restriction on free speech.

As it stands now, Elster would not be entitled to copyright the title of a "Trump Too Small" book any more than he can trademark that phrase. Given that the prohibition on copyrighting a title is inarguably viewpoint-neutral, one would imagine that even Elster would agree that it is constitutional.

Turning to the actual issue at hand, most of the argument revolved around the central question of whether a limitation on registrability is a restriction or infringement of free

speech, or merely a condition of obtaining a governmental benefit.

The court left this question unanswered in Tam and Brunetti, finding that because the restrictions in those cases were viewpoint-based, they were unconstitutional regardless of how the restriction is characterized.

The government's position is that refusing registration does not infringe on free speech rights at all. Stewart argued that the government can pick and choose to whom it provides benefits, and is doing just that in limiting the registrability of marks that comprise another person's name.

In Tam, Justice Alito expressly rejected the argument that refusing registration was simply refusing to grant a governmental benefit and not restricting speech. He remained openly hostile to the idea, suggesting to Stewart that he might be a lost cause with respect to at least this theory.

Other justices were more receptive to the argument, and to a related contention: that because Elster was free to sell his "Trump Too Small" T-shirts even without a federal trademark registration, no free speech rights are implicated. Elster can speak about Trump all he wants, regardless of whether that speech is granted the governmental imprimatur of a trademark registration.

This issue is important because whether the restriction infringes on free speech dictates the standard of review applicable to determining the constitutionality of the living individual clause.

Elster argued that the restriction is subject to strict scrutiny, or at least intermediate scrutiny, because it is not viewpoint-neutral and thus directly affects free speech rights.

Taylor argued that although the restriction seems neutral on its face, it actually discriminates based on the views expressed and the identity of the speaker.

His theory is that because an individual, such as Trump, will never consent to a mark that criticizes that individual, but is more likely to consent to favorable marks, in practical effect the living individual clause is not viewpoint-neutral.

A number of justices made their views well known in their aggressive questioning of Taylor. They seemed incredulous at the argument that refusing registration was tantamount to prohibiting or burdening speech, and noted the lack of historical support and legal precedent for this position.

During Stewart's argument, Justice Sonia Sotomayor asked whether the bottom line is simply whether refusing to register the mark is an infringement on speech. She answered her own question, saying that it was not.

Several justices picked up this thread during Taylor's argument, noting repeatedly that because denial of a registration did not mean Elster was barred from speaking, there are no First Amendment issues in play. Taylor was unable to parry the justices' remarks in that regard.

Nor was he able to rebut the justices' observations that there was no case law supporting his client's cause, and that given the long history of the restriction in question predating the Lanham Act, finding for Elster would mean that the government has been infringing on First

Amendment rights for generations.

As most of the justices suggested, there does seem to be a fundamental difference between the living individual clause and the restrictions at issue in Tam and Brunetti.

Determining whether a mark is "disparaging," as in Tam, or "immoral and scandalous," as in Brunetti, is inherently subjective, and requires examining the content of the message behind the mark for which registration is sought.

Whether a mark refers to a living person, and whether that person has consented, are objective facts, and a refusal under the living individual clause has nothing to do with the actual content of the message.

Justice Ketanji Brown Jackson pointed out that Elster had no data to suggest that consent is never provided for negative or even neutral marks. It is certainly possible that an individual could consent to registration of such a mark. And conversely, a person could decline to consent to registration of a flattering mark.

To the extent the consent argument presupposes that consent will always be granted for marks using a name in a positive manner, and never for marks critical of the person from whom consent is sought, that argument does seem fatally flawed.

If Elster was hoping for a decision that would fall in line with Tam and Brunetti, it appears he will be disappointed. The justices seemed more concerned about allowing an individual to control his or her own name — including the monetization of the name — than with any ancillary speech issues.

There is certainly a reasonable basis for viewing this case differently from Tam and Brunetti. Even though Justice Alito may not see a difference, at least with respect to the government benefits argument, it is not all a foregone conclusion that he is a lost cause with respect to the ultimate question of whether the living individual clause is constitutional.

And even if Justice Alito votes for the third time to strike down a provision of the Lanham Act, there seems to be a clear majority inclined to find in favor of the government.

We will know for certain sometime in the next few months. In the meantime, Elster continues to offer his merchandise for sale.

Correction: A previous version of this article misstated the author's thesis in the headline. The error has been corrected.

Brian Brookey is a partner at Tucker Ellis LLP.