

## 'Trump Too Small' At The High Court: What You Need To Know

By **Tiffany Hu**

*Law360 (June 5, 2023, 8:53 PM EDT)* -- The U.S. Supreme Court agreed on Monday to take up a case over the U.S. Patent and Trademark Office's decision not to register a man's trademark criticizing former President Donald Trump. To get you up to speed, here's everything you need to know about *Vidal v. Elster* and what a high court ruling could mean.

### How the Case Got Here

In January 2018, a man named Steve Elster filed an application to register the phrase "Trump Too Small" as a trademark for T-shirts and other apparel. The phrase is a reference to an exchange between Trump and U.S. Sen. Marco Rubio, R-Fla., from a 2016 presidential primary debate, which, according to Elster's registration request, aims to "convey that some features of President Trump and his policies are diminutive."

The Trademark Trial and Appeal Board in July 2020 affirmed an examiner's refusal to register Elster's mark, agreeing that it violated Section 2(c) of the Lanham Act's prohibition on the registration of any mark that "consists of or comprises a name, portrait or signature identifying a particular living individual except by his written consent."

The trademark was a reference to Trump, then president — meaning it ran afoul of the statute's ban on the registration of anything that identifies "a particular living individual," according to the board.

But the Federal Circuit in February 2022 overturned the TTAB's decision, ruling in a precedential opinion that the board's decision unconstitutionally restricts free speech. The government's interest in protecting privacy and publicity rights do not outweigh Elster's "substantial" First Amendment right to criticize public figures, the appeals court said.

In its certiorari petition, the USPTO urged the justices to clarify "whether a Lanham Act bar" on the registration of a trademark is "a condition on a government benefit or a simple restriction on speech," and claimed that earlier high court precedent did not answer this question.

In February, the USPTO announced it was "suspending action" on any applications for trademarks that cover phrases "that are critical of government officials or public figures," while the office waits for the Supreme Court to weigh in.

### Other Cases

In recent years, the Supreme Court has ruled on two high-profile cases over granting trademarks: *Matal v. Tam*, a 2017 ruling that struck down a ban on racist trademarks, and *Iancu v. Brunetti*, a 2019 sequel that invalidated a similar ban on profane or lewd material.

In *Matal v. Tam*, the high court ruled that the trademark statute's ban on the registration of material that "may disparage" groups of people — such as racist or demeaning terms — violated the First Amendment by restricting speech.

Two years later, in *Iancu v. Brunetti*, the justices struck down a similar ban on the registration of profane or lewd trademarks on the grounds that it was an unconstitutional form of discrimination against viewpoint, something rarely allowed under the First Amendment.

The high court had rejected the USPTO's argument that the ban on scandalous marks could be treated differently from the ban on disparaging marks, saying the agency could not simply promise to selectively enforce a statute.

Like the court's earlier ruling, the *Brunetti* decision had more to do with the First Amendment than pure trademark law, but taken together, *Tam* and *Brunetti* have experts wondering if other provisions of the Lanham Act might soon face similar battles.

### **What a High Court Ruling May Mean**

The *Elster* case seems to be distinguishable from the *Brunetti* and *Tam* disputes given that the earlier decisions involved speech or sentiments that did not identify a single living person — let alone a public figure or celebrity — according to Jonathan Menkes, a partner at Knobbe Martens.

"What is fascinating about this case is it highlights the clash between rights of publicity, the First Amendment, and the right to register a trademark, and we should expect that the Supreme Court will add clarity as to how to properly balance these competing interests," Menkes said.

"However, it is unclear how the Supreme Court will reconcile — or distinguish — these cases, and I suspect a lot of [intellectual property] practitioners will be following this case very closely given its far-reaching impact beyond mere registration of a trademark," Menkes added.

Trademark practitioners will be waiting to see if the Supreme Court will "do away with another barrier to registration" of a different section of federal trademark law, according to Monica Riva Talley, a partner at Sterne Kessler Goldstein & Fox PLLC.

"It would be very interesting if all of a sudden the floodgates are open, and you're allowed to register trademarks that consist of famous people's names," Talley told Law360. "I think that would be very confusing and sort of contrary to the purposes of the Lanham Act, in terms of making sure people are not confused as to the source."

--Additional reporting by Andrew Karpan. Editing by Robert Rudinger.