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Appellate and Constitutional Law Update June 13, 2024

Supreme Court Upholds Prohibition On Registration Of Trademarks That Incorporate Personal Names Without Consent

***Vidal v. Elster*, No. 22-704** – Decided June 13, 2024

Today, the Supreme Court held that the Lanham Act's prohibition on registration of trademarks that include a living person's name without that person's consent does not violate the First Amendment.

"We conclude that a tradition of restricting the trademarking of names has coexisted with the First Amendment, and the names clause fits within that tradition."

JUSTICE THOMAS, WRITING FOR THE COURT

Background:

The Lanham Act establishes certain statutory requirements for trademark registration. One requirement is the Act's "names clause"—no trademark may include "a name, portrait, or

signature identifying a particular living individual except by his written consent." 15 U.S.C. § 1052(c). In 2018, Steve Elster applied to register the mark "Trump too small," a reference to then-President Donald J. Trump. The U.S. Patent and Trademark Office denied his request because he had not obtained written consent from President Trump.

Elster appealed, and the Federal Circuit reversed, holding that the names clause violated Elster's right to free speech under the First Amendment. The Federal Circuit explained that the names clause is a content-based restriction, which is subject to heightened scrutiny under the First Amendment. And it held that the names clause does not satisfy heightened scrutiny here because there is no government interest in restricting speech critical of government officials in the trademark context.

Issue:

Whether the refusal to register a mark under the names clause violates the Free Speech Clause of the First Amendment when the mark contains criticism of a government official or public figure.

Court's Holding:

No. The names clause does not violate the First Amendment because, while it is content based, it is viewpoint neutral and fits within historical tradition.

What It Means:

- The Court underscored that today's decision is "narrow" because it holds "only that history and tradition establish that the particular restriction before [the Court] . . . does not violate the First Amendment." Other content-based trademark requirements that lack a similarly well-established history and tradition may still be vulnerable to First Amendment challenges.
- Although the Court's judgment was unanimous, the fractured opinions demonstrate the Court's disagreement about how to assess the constitutionality of content-based trademark registration requirements. The majority focused on history and tradition. Justice Barrett in a separate opinion (joined by Justice Kagan in full and by Justices Sotomayor and Jackson in part) expressed the view that content-based restrictions should be upheld "so long as they are reasonable in light of the trademark system's purpose of facilitating source identification." Justice Sotomayor in a concurring opinion (joined by Justices Kagan and Jackson) said the Court should look to the "well-trodden terrain" of "trademark law and settled First Amendment precedent."
- Today's ruling distinguished other recent Supreme Court decisions holding that restrictions on trademark registrations do violate the First Amendment when they discriminate based on viewpoint. *See Matal v. Tam*, 582 U.S. 218 (2017) (disparaging marks) and *Iancu v. Brunetti*, 588 U.S. 388 (2019) (immoral or scandalous marks). In contrast to those precedents, the Court held that a uniform rule against registering trademarks that include personal names without consent does not single out a trademark based on the specific motivating ideology or the opinion or perspective of the speaker.

Gibson Dunn Appellate Honors

The Court's opinion is available here.

Gibson Dunn's lawyers are available to assist in addressing any questions you may have regarding developments at the U.S. Supreme Court. Please feel free to contact the following practice group leaders:

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