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Does "Trump Too Small" Registration Refusal Violate the First Amendment?

by

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Introduction

On January 27, 2023, the PTO (with the help of the Solicitor General) filed a petition for writ of certiorari in the US Supreme seeking reversal of the Federal Circuit decision last year that held that the Trademark Office's refusal to register the "Trump Too Small" mark (sought by a third-party without the consent of Donald Trump) violated the First Amendment. The individual trademark owner, an attorney located in California, filed his trademark registration in 2018 seeking protection for his T-shirt (and associated clothing) that constitute political speech (albeit with negative innuendo about Mr. Trump, his personhood and his policies):

Original PTO Examiner Rejects Trademark Application

The PTO Examiner ruled (back in 2019) that the mark violated Sections 2(a) and 2(c) of the Lanham Act, which respectively bars registrations that suggest a false connection with a person, and registrations that contain a living individual's name without said individual's consent. The Examiner ruled that there was no carve-out in the law for political commentary.

Trademark Trial and Appeals Board Affirms Examiner's Rejection

The TTAB affirmed the Examiner's refusal to register and ruled that Section 2(c) was not an unconstitutional restriction on free speech because it met the strict scrutiny standard of being narrowly tailored to advance government interests (protecting rights of privacy and publicity of individuals, and protecting consumers against confusion).

Federal Circuit Reverses: First Amendment Protects Trademark Applicants

The Federal Circuit reversed the TTAB and ruled that *Matal v. Tam* and *Iancu v. Brunetti* established that a trademark "represents 'private, not government, speech' entitled to some form of protection." Further, speech does not lose its First Amendment protection when it is sold in a commercial context. Is Section 2(c) a "content-based restriction" on speech subject to "strict" scrutiny? The Federal Circuit holds that it is.

Because of the Federal Circuit's extension of the Supreme Court's recent rulings in *Matal v. Tam* and *Iancu v. Brunetti,* the Court holds that as-applied, Section 2(c) does not survive strict scrutiny: "the government has no valid publicity interest that could overcome the First Amendment protections afforded to the political criticism embodied in Elster's mark", nor did the government hold a legitimate interest in insulating the former President, a public official, from injury to his "personal feelings" caused by political criticism. It held there was no plausible claim that the "Trump Too Small" mark diluted the commercial value of Trump's name, nor did it suggest endorsement by him.

The Cert Petition Filed Last Week Challenges the Federal Circuit's Decision

In the cert petition filed last week on behalf of the PTO, the Solicitor General questions:

1. Whether Section 2(c) is a restriction on speech or a "viewpoint-neutral condition on a government benefit"? The Petition argues it is the latter and thus no strict scrutiny applies here.

2. Whether it is *registration* of such marks (and not *refusal* to register them) that will "chill" First Amendment protected political speech? The Petition argues that federal trademark registration and the exclusivity it promotes (not the refusal thereof) will chill First Amendment political speech because providing a "federal litigation club" to a political slogan can actually chill widespread First Amendment publication and use of it. In effect, the Petition argues that no one should own political speech; federal registration of valid trademarks give its owner the national right to prevent others from using the mark in violation of the First Amendment.

3. Does the government have an equally important interest in protecting "rights of privacy and publicity that living persons have in the designations that identify them"? The Petition argues that it does; it further argues that individual privacy and publicity rights (even of public figures including US Presidents) have "long received legal recognition and protection."

What Does This Case Mean For the Court's First Amendment Jurisprudence?

This case arrives while still pending before the Court are the Jack Daniel's trade dress case (which we wrote about last month) as well as the Andy Warhol/Prince copyright case (which we wrote about the month before last). All these cases raise serious First Amendment issues about the role that free speech plays in a federal system that protects trade dress and other trademarks as well as copyrights and other intellectual property rights on a national basis.

As we noted last month, the High Court could choose to side with IP owners by confirming protections against alleged infringers' appropriations of their property (transformative or otherwise), or it could do the opposite and expand First Amendment and fair use doctrines within the domains of copyright and trademark law, forever changing the landscape of both. Here, the High Court is being asked to allow a new trademark registration to issue to a new trademark owner based on First Amendment rights invalidating the statutory requirements for registration set forth in Section 2(c) and which would otherwise require the consent of Mr. Trump given use of his name.

Further, it should be noted that any ruling allowing the pending "Trump Too Small" application to go forward would not stop Donald Trump (along with his many companies that have various "Trump" registered trademarks) to file an opposition to the pending application; put differently, the High Court's ruling – even if it were to affirm the Federal Circuit's ruling – would not mean (on any absolute basis) that the precise "Trump Too Small" application will actually be registered as one or more successful trademark oppositions could well stop the registration process.

Finally, if the High Court affirms the Federal Circuit, and if the "Trump Too Small" trademark registration issues (and even as against multiple oppositions by Mr. Trump and his various companies who own "Trump" registered trademarks), the ultimate question could become whether the First Amendment extends further influence on the likelihood of confusion and infringement analysis as is argued by the dog toy maker in the pending Jack Daniel's case. It may be that the High Court will first decide the Jack Daniel's case and then remand the current case to the Federal Circuit for further consideration in light of the Jack Daniel's decision. Needless to say, if the High Court accept grants the pending Petition, the First Amendment will be playing an even more major role in the Court's docket this year and perhaps in the coming years as well.

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