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Obtaining Trademark Registration for Marks Containing Political Commentary: A Look into *Vidal v. Elster*

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Obtaining Trademark Registration for Marks Containing Political Commentary: A Look into *Vidal v. Elster*

ANNICK RUNYON*

For decades, courts have struggled with balancing trademark law with the First Amendment—specifically with cases challenging the denial of trademark registration of certain marks. Congress codified trademark registration through the Lanham Act, also known as the Trademark Act of 1946. This statute outlines the registration process and expands the rights of trademark owners. In recent years, a string of cases have ruled certain provisions of the Lanham Act that bar certain marks from registration unconstitutional.

Currently under review by the Supreme Court, the case Vidal v. Elster involves an applicant who was denied trademark registration for his mark “Trump Too Small” for use on t-shirts. After submitting his registration application, the United States Patent and Trademark Office (“USPTO”) denied registration of the mark and explained that it was barred by the “living individual” clause of Section 2(c) of the Lanham Act. This clause prevents registration of marks that contain the name of a living individual without that individual’s consent. Elster did not have Trump’s consent to

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use his name. On appeal, the Federal Circuit Court of Appeals ruled that Section 2(c) was unconstitutional as-applied in this circumstance because it violated Elster's First Amendment right to criticize political figures without government interference. The Federal Circuit's narrow holding did not find the entirety of Section 2(c) unconstitutional, but many scholars see the road that lies ahead. Now, the Supreme Court's decision is pending on the matter. Ultimately, this case highlights complex nuances of trying to obtain trademark registration over marks containing political commentary, and the consequences of this pending decision could potentially erode the constitutionality of other trademark doctrines in the United States.

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INTRODUCTION

For decades, courts have struggled with balancing trademark law with the First Amendment—specifically with cases challenging the denial of trademark registration of certain marks.¹ Congress codified trademark registration through the Lanham Act, also known as the Trademark Act of 1946.² This statute outlines the registration process and expands the rights of trademark owners.³ In recent years, a string of cases have ruled certain provisions of the Lanham Act that bar certain marks from registration unconstitutional.⁴

In 2017, the Supreme Court in *Matal v. Tam* ruled the “disparagement” clause of Section 2(a) of the Lanham Act unconstitutional because it violated the Free Speech clause of the First Amendment.⁵ Similarly, in 2019, the Court in *Iancu v. Brunetti* ruled the “immoral or scandalous” clause of Section 2(a) of the Lanham Act unconstitutional by reasoning that “[i]t too disfavors certain ideas” and violates the First Amendment.⁶ Again, in 2023, the First Amendment challenged yet another Lanham Act provision that bars certain marks from registration—the “living individual” clause of Section 2(c).⁷

Currently under review by the Supreme Court, *Vidal v. Elster* involves an applicant who was denied trademark registration for his mark “Trump Too Small” for use on t-shirts.⁸ After submitting his registration application, the United States Patent and Trademark Office (“USPTO”) denied registration of the mark and explained that it was barred by the “living individual” clause of Section 2(c) of the Lanham Act.⁹ This clause prevents registration of marks that contain the name of a living individual without that individual’s consent.¹⁰

¹ See, e.g., *Matal v. Tam*, 582 U.S. 218, 223 (2017); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

² 15 U.S.C. §§ 1051–1052 (1946).

³ *Id.*

⁴ *Matal*, 582 U.S. at 223; *Brunetti*, 139 S. Ct. at 2297.

⁵ *Matal*, 582 U.S. at 223.

⁶ *Brunetti*, 139 S. Ct. at 2297–98.

⁷ See *In re Elster*, 26 F.4th 1328, 1330 (Fed. Cir. 2022).

⁸ *Id.* at 1329; see also *Vidal v. Elster*, SCOTUSBLOG, <https://www.scotusblog.com/case-files/cases/vidal-v-elster/> (last visited Nov. 13, 2023) [hereinafter *Vidal v. Elster* SCOTUS Blog].

⁹ *In re Elster*, 26 F.4th at 1329.

¹⁰ *Id.* at 1330.

Elster did not have Trump’s consent to use his name.¹¹ On appeal, the Federal Circuit Court of Appeals ruled that Section 2(c) was unconstitutional *as-applied* in this circumstance because it violated Elster’s First Amendment right to criticize political figures without government interference.¹² The Federal Circuit’s narrow holding did not find the entirety of Section 2(c) unconstitutional, but many scholars see the road that lies ahead.¹³ Now, this case is under review by the Supreme Court.¹⁴ Ultimately, this case highlights complex nuances of trying to obtain trademark registration over marks containing political commentary, and the consequences of this pending decision have the potential to erode the constitutionality of other trademark doctrines in the United States.

The argument in this Note proceeds as follows. Part I provides an overview of trademark principles by introducing the importance of the Lanham Act, discussing the trademark registration process, and introducing bars to trademark registration found in Section 2 of the Lanham Act.¹⁵ Part II explains the tension between trademark law and the First Amendment by delving into the benefits of trademark registration, such as how trademark owners own exclusive use of their mark and have the ability to bring a trademark infringement claim against other users of their registered mark.¹⁶ Part III showcases the jurisprudence that led to the unconstitutionality of Section 2(a) of the Lanham Act—the disparaging, immoral, and scandalous clauses. It further analyzes the cases *Matal v. Tam* and *Iancu v. Brunetti* by highlighting the implications stemming from those decisions.¹⁷ Lastly, Part IV analyzes the most recent case challenging another provision of the Lanham Act—*Vidal v. Elster*. This Part concludes the Note by predicting the future constitutionality of the “living individual” clause of Section 2(c) of the Lanham Act.¹⁸

¹¹ *Id.*

¹² *Id.* at 1339.

¹³ *See id.*; *see also* discussion *infra* Section IV.B.

¹⁴ Vidal v. Elster SCOTUS Blog, *supra* note 8.

¹⁵ *See* discussion *infra* Part I.

¹⁶ *See* discussion *infra* Part II.

¹⁷ *See* discussion *infra* Part III.

¹⁸ *See* discussion *infra* Part IV.

I. TRADEMARK PRINCIPLES

Intellectual property refers to trademarks, copyrights, and patents.¹⁹ This type of law protects intangible creations made from the human mind, including names and images used in commerce, artistic works, and inventions.²⁰ Essentially, intellectual property enforces the rights of creators against unauthorized third party use of their ideas.²¹

In the intellectual property realm, trademark law has its own unique characteristics. Unlike copyrights and patents, trademark law is not mentioned in the Constitution,²² but rather it was established under the common law.²³ Trademark rights under the common law are based on a trademark owner's use of the mark in commerce within a particular geographic area.²⁴ Thus, trademark protection under the common law is limited to a specific city, state, or region where the mark is in use.²⁵ To broaden trademark protection, Congress enacted the Lanham Act in 1946.²⁶ Under the Act, a trademark is defined as "any word, name, symbol, or device, or any combination thereof" used by an individual in commerce to identify their goods or services.²⁷ The purpose of trademark law is "to foster the free flow of commerce and to allow consumers to recognize which

¹⁹ *What is Intellectual Property?*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/about-ip/en/> (last visited Nov. 7, 2023).

²⁰ *Id.*

²¹ See Gary L. Deel, *What is Intellectual Property Law? And Why Does it Matter?*, AM. PUB. UNIV., <https://www.apu.apus.edu/area-of-study/security-and-global-studies/resources/what-is-intellectual-property-law/> (last visited Nov. 13, 2023).

²² See U.S. CONST. art. I, § 8, cl. 8 (referencing copyright and patent protection through the clause: "[t]o 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").

²³ See *Why Register Your Trademark?*, U.S. PAT. & TRADEMARK OFF. (May 11, 2023, 12:21 PM), <https://www.uspto.gov/trademarks/basics/why-register-your-trademark>.

²⁴ *Id.*

²⁵ *Id.*

²⁶ 15 U.S.C. § 1051 (1946).

²⁷ *Id.* § 1127.

goods are manufactured by which merchants,” which starkly contrasts with copyright being known as “the engine of free expression.”²⁸ In other words, trademark law has an economic focus.²⁹

The Lanham Act provides a federal trademark registration process that expands the rights of trademark owners.³⁰ Trademark registration benefits include: the listing of the mark on the principal register; constructive notice to the public of the trademark owner’s ownership of the mark; the right to use the registered trademark symbol (®) next to the mark; permission to bring an action regarding the mark in federal court; and the ability to collect damages or profits in a trademark infringement suit.³¹ Federal trademark registration is not a prerequisite for legal trademark recognition, but it provides trademark owners with crucial benefits not available under the common law.³² Most notably, federal registration of a trademark creates a legal presumption of ownership over the mark.³³ This presumption is the first step in establishing a prima facie case for trademark infringement claims, which are the most common type of claims brought under trademark law.³⁴ Hence, the Lanham Act provides salient benefits that trademark owners should strive to obtain and utilize.

²⁸ Transcript of Oral Argument at 26, *Vidal v. Elster*, No. 22-704 (Nov. 1, 2023).

²⁹ *Id.* at 8.

³⁰ See 15 U.S.C. §§ 1051–1052.

³¹ See *Why Register Your Trademark?*, *supra* note 23; Klemchuk PLLC, *What Are Trademark Infringement Damages Under the Lanham Act?*, IDEATE BLOG (Feb. 9, 2023), <https://www.klemchuk.com/ideate/trademark-infringement-damages>.

³² See *In re Tam*, 808 F.3d 1321, 1374–75 (Fed. Cir. 2015).

³³ See, e.g., *A&H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 210–11 (3d Cir. 2000) (finding part one for a prima facie case for trademark infringement was satisfied because A&H Sportswear, Inc. registered the mark “Miraclesuit”); see also *Why Register Your Trademark?*, *supra* note 23.

³⁴ See *A&H Sportswear*, 237 F.3d at 210–11; *Lanham Trademark Act Claims Lawyers & Attorneys*, PRIORI, <https://www.priorilegal.com/intellectual-property/trademark/lanham-trademark-act-claims> (last visited Feb. 23, 2024).

The process for trademark registration begins with filing an application with the USPTO.³⁵ The application verifies that the mark in question is used as a source identifier of goods or services used in interstate commerce.³⁶ An examining attorney at the USPTO reviews the application and determines whether the mark violates any bars from registration outlined in Section 2 of the Lanham Act.³⁷ These registration bars promote the purpose of trademark law—to protect businesses’ reputations while also protecting consumers from deceptive goods and services.³⁸ In other words, the examining attorney balances the prospective trademark owner’s right to protect their business against the public’s right to use the words or images freely in commerce in order to advance consumer protection.

Historically, Section 2(a) of the Lanham Act presented controversial bars to registration.³⁹ This clause used to allow barring registration of marks deemed disparaging, immoral, or scandalous.⁴⁰ A disparaging mark is a mark that “dishonor[s] by comparison with what is inferior, slight[s], deprecate[s], degrade[s], or affect[s] or injure[s] by unjust comparison.”⁴¹ An immoral or scandalous mark is “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.”⁴² However, these registration bars conflicted with the First Amendment and an individual’s freedom of speech.⁴³ Consequently, these provisions of

³⁵ *About Us*, U.S. PAT. & TRADEMARK OFF. (Nov. 7, 2022, 9:36 AM), <https://www.uspto.gov/about-us> (“The United States Patent and Trademark Office (USPTO) is the federal agency for granting U.S. patents and registering trademarks.”).

³⁶ *Trademark Process*, U.S. PAT. & TRADEMARK OFF. (Mar. 24, 2023, 10:36 AM), <https://www.uspto.gov/trademarks/basics/trademark-process>.

³⁷ *See id.*

³⁸ *See What is a Trademark?*, U.S. PAT. & TRADEMARK OFF. (July 18, 2023, 9:10 AM), <https://www.uspto.gov/trademarks/basics/what-trademark>.

³⁹ *See, e.g., Matal v. Tam*, 582 U.S. 218, 223 (2017); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

⁴⁰ 15 U.S.C. § 1052(a) (2016).

⁴¹ *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014).

⁴² *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

⁴³ *See Robbie Hendricks*, Note, *David (TM) v. Goliath (First Amendment): In Reality, Goliath Wins*, 2 ARIZ. ST. SPORTS & ENT. L.J. 68, 70 (2012).

the Lanham Act have been deemed unconstitutional and highlight the clash between these two areas of law.⁴⁴

II. TENSION BETWEEN TRADEMARK LAW & THE FIRST AMENDMENT

The First Amendment lays out one of the most well-known rights in the United States: the freedom of speech.⁴⁵ Since the founding of this nation, this fundamental principle has been at the forefront of controversy and litigation.⁴⁶ Simply put, the right to freedom of speech allows individuals to express their opinions and beliefs without governmental restraint or retaliation.⁴⁷ However, in the intellectual property realm, there can be difficulty balancing a trademark owner's rights against third party users of similar marks.⁴⁸ On one hand, the freedom of speech promotes the right to speak without censorship from the government, while on the other, federal trademark registration grants exclusive rights to trademark owners over specific words or images in connection with their goods and services associated with that mark.⁴⁹ Hence, federal trademark registration deprives others from using similar content in a similar business manner.⁵⁰ This leads to restricting other individuals' speech in the marketplace regarding the words, phrases, symbols, and images that are available to describe their businesses.⁵¹

⁴⁴ *Id.*

⁴⁵ See U.S. CONST. amend. I (“Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the *freedom of speech*, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances.”).

⁴⁶ See Hendricks, *supra* note 43, at 68.

⁴⁷ N.Y. Times Co. v. United States, 403 U.S. 713, 723 (1971).

⁴⁸ David L. Hudson, Jr., *Trademarks and the First Amendment*, FREE SPEECH CTR. (Nov. 6, 2023), <https://firstamendment.mtsu.edu/article/trademarks-and-the-first-amendment/>.

⁴⁹ *See id.*

⁵⁰ *Trademark Scope of Protection*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademarks/basics/scope-protection> (last visited Nov. 7, 2023).

⁵¹ *See id.*

All three branches of government play a critical role in ensuring that trademark laws are consistent with the Constitution and, specifically, the First Amendment.⁵² First, the legislature should consider how the Lanham Act conflicts with the freedom of speech and make appropriate changes by amending the statute.⁵³ Second, the judiciary should create a definitive balancing test regarding the interests that should be taken into account between trademark registration rights and the First Amendment to create uniformity and predictability among the courts.⁵⁴ And third, the executive branch, through the USPTO, should abide by more objective guidelines when reviewing applications and determining whether any bars to registration apply.⁵⁵ With all branches working in unison, trademark enforcement and the right to freedom of speech can co-exist more peacefully; but nevertheless, this harmonious, hypothetical system is not the current situation.

To this day, courts still use different approaches when balancing trademark registration rights and free speech.⁵⁶ In response, applicants typically use a First Amendment argument as a defense when challenging bars to registration under the Lanham Act.⁵⁷ Several recent and pivotal cases challenged components of Section 2(a), ruling that the disparaging, immoral, and scandalous clauses were unconstitutional because these bars to registration violated trademark applicants' free speech.⁵⁸ These cases further illustrate the stark tension between trademark law and the First Amendment.

⁵² Lisa P. Ramsey, *Free Speech Challenges to Trademark Law After Matal v. Tam*, 56 HOUS. L. REV. 401, 406 (2018).

⁵³ *Id.*

⁵⁴ *Id.*

⁵⁵ *See id.*

⁵⁶ *See, e.g., Matal, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 807 (9th Cir. 2003).

⁵⁷ Ramsey, *supra* note 52, at 407.

⁵⁸ *See, e.g., Matal v. Tam*, 582 U.S. 218, 223 (2017); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

III. THE ROAD TO SECTION 2(A)'S UNCONSTITUTIONALITY

A. *The Disparaging Clause: Matal v. Tam*

When enacting the Lanham Act, Congress initially included a registration ban on disparaging marks.⁵⁹ The government reasoned that it purportedly “disapprove[d] of the messages” from these types of trademarks in commerce.⁶⁰ Through USPTO guidelines and case law, there was a two-part process for determining whether marks were “disparaging.”⁶¹ First, when evaluating whether a mark was disparaging, the examining attorney from the USPTO considered the following:

[T]he likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services.⁶²

Then, the examining attorney determined if “that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.”⁶³ Examining attorneys looked at the mark from the standpoint of the general public, which became an overly subjective process.⁶⁴ Consequently, a string of inconsistent rulings regarding the approval of “disparaging” mark registrations made one band challenge the constitutionality of the clause as a whole.⁶⁵

⁵⁹ *In re Tam*, 808 F.3d 1321, 1327 (Fed. Cir. 2015).

⁶⁰ *Id.*

⁶¹ See *Elements of a § 2(a) Disparagement Refusal*, TRADEMARK MANUAL OF EXAMINING PROC. (“TMEP”) § 1203.03(b)(i) (Nov. 2023), <https://tmep.uspto.gov/RDMS/TMEP/Apr2016#/Apr2016/TMEP-1200d1e1.html>; see also *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014).

⁶² TMEP § 1203.03(b)(i).

⁶³ *Id.*

⁶⁴ See *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981).

⁶⁵ See *In re Tam*, 808 F.3d at 1332.

In November 2011, “one of the first and only all-Asian American dance rock bands in the world”⁶⁶ filed a trademark registration application to protect the name of their band—The Slants.⁶⁷ The founder of the band, Simon Tam, explained that the band’s name alludes to the member’s slant “on life” and criticizes the derogatory slang term directed towards Asians by making it their own.⁶⁸ The band gained popularity not only as musicians but also as advocates for their fellow Asian-Americans.⁶⁹ Nonetheless, the USPTO denied trademark registration for their mark “The Slants,” refusing registration under Section 2(a) of the Lanham Act and finding that the term was disparaging to individuals of Asian descent.⁷⁰

Tam appealed and requested reconsideration to the Trademark Trial and Appeal Board (“TTAB”), arguing that the band was using the term “The Slants” as commentary on Asian-American stereotypes and not in a disparaging manner.⁷¹ Specifically, Tam argued that “[the band] want[ed] to take on these stereotypes that people have about [them], like the slanted eyes, and own them.”⁷² However, after further review, the TTAB affirmed the USPTO’s refusal to register the mark, reiterating that despite the band’s commentary, the mark was still “a highly disparaging reference to people of Asian descent.”⁷³ Tam then appealed to the Federal Circuit Court of Appeals.⁷⁴

In 2015, the Federal Circuit Court reversed the TTAB’s decision and instead found the disparaging clause unconstitutional under the First Amendment.⁷⁵ At the beginning of the opinion, the court remarks that “[t]he government cannot refuse to register disparaging

⁶⁶ *About the Slants*, THE SLANTS, <https://theslants.com/about> (last visited Nov. 7, 2023).

⁶⁷ *See In re Tam*, 808 F.3d at 1331.

⁶⁸ Andra Ingram, *Member Feature, Member Content, Homie Spotlight: Simon Tam*, HELPING OUR MUSIC EVOLVE (Sept. 18, 2018), <https://homeformusic.org/member-spotlight/2018/9/17/simon-tam>.

⁶⁹ *See* April Baer, *The Slants: Trading in Stereotypes*, NPR (June 11, 2008, 1:22 PM), <https://www.npr.org/2008/06/11/90278746/the-slants-trading-in-stereotypes>.

⁷⁰ *In re Shiao Tam*, 108 U.S.P.Q.2d (BNA) 1305, 1306 (T.T.A.B. 2013).

⁷¹ *Id.* at 1306–07.

⁷² *Id.* at 1307.

⁷³ *Id.* at 1306.

⁷⁴ *See In re Tam*, 808 F.3d 1321, 1332 (Fed. Cir. 2015).

⁷⁵ *Id.* at 1328.

marks because it disapproves of the expressive messages conveyed by the marks[,] [and] [i]t cannot refuse to register marks because it concludes that such marks will be disparaging to others.”⁷⁶ Moreover, the opinion highlighted the importance of “tolerat[ing] insulting, and even outrageous, speech” in order to preserve the freedom of speech.⁷⁷ Initially, this decision—finding the disparaging clause unconstitutional—looked like a win for the band, but months later, another court reached the opposite conclusion in a similar case.⁷⁸ Because of this inconsistency in the disparaging clause’s application and constitutionality, the Supreme Court granted certiorari for *Matal v. Tam*.⁷⁹ In 2017, the Court unanimously struck down Section 2(a) of the Lanham Act, ruling that the disparaging clause was in fact unconstitutional because it violates the Free Speech Clause of the First Amendment.⁸⁰

This landmark trademark case established the fundamental concept that trademarks are private speech and not immune from First Amendment review.⁸¹ Justice Alito stressed that trademarks do not represent government speech, subsidies, or programs because the federal government does not create or edit registered trademarks.⁸² The Court evaluated the two governmental interests behind the disparagement clause: (1) “preventing ‘underrepresented groups’ from being ‘bombarded with demeaning messages in commercial advertising’” and (2) “protecting the orderly flow of commerce.”⁸³ Despite these arguments, the Court still found that the disparagement clause was far too broad because it affected “any trademark that disparages *any person, group, or institution*,” by “go[ing] much further

⁷⁶ *Id.*

⁷⁷ *Id.* at 1357.

⁷⁸ *See* Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439, 489 (E.D. Va. 2015). The NFL team, the Washington Redskins, found themselves in a similar situation as The Slants, when the TTAB cancelled the team’s registered mark “Redskins” under the Section 2(a) disparagement clause after being registered for over fifty years. *Id.* at 448–50. The U.S. District Court for the Eastern District of Virginia affirmed the cancellation. *Id.* at 490.

⁷⁹ *See* *Matal v. Tam*, 582 U.S. 218, 230 (2017).

⁸⁰ *Id.* at 247.

⁸¹ *Id.* at 239.

⁸² *Id.* at 223, 234–44.

⁸³ *Id.* at 245.

than is necessary to serve the interest[s] asserted.”⁸⁴ Moreover, Justice Alito wrote how private speech cannot be “passed off as government speech by simply affixing a government seal of approval.”⁸⁵ If trademarks constituted government speech, the government would be free to “silence or muffle the expression of disfavored viewpoints”—which is exactly what the First Amendment is meant to prevent.⁸⁶ Ultimately, *Tam v. Matal* found the disparagement clause unconstitutional, concluding that trademarks are private speech entitled to First Amendment protections.⁸⁷ This decision then opened the door to challenging the constitutionality of other Lanham Act provisions infringing on trademark owners freedom of speech.⁸⁸

B. *Immoral & Scandalous Marks: Iancu v. Brunetti*

Similarly to determining disparaging marks, examining attorneys at the USPTO also used an overly subjective process to determine whether a mark constituted “immoral or scandalous” content.⁸⁹ To determine whether a mark was immoral or scandalous, an examining attorney analyzed whether the mark was “shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable; . . . giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.”⁹⁰ Additionally, examining attorneys could only consider the mark in the context of the marketplace as applied to the goods or services identified in the registration application.⁹¹ Because of the demise of the disparaging clause, scholars predicted that the “immoral or scandalous” provision of the Lanham Act would meet a similar fate.⁹² Two years after the decision in *Matal*, this issue was presented in *Iancu v. Brunetti*.⁹³

⁸⁴ *Id.* at 246.

⁸⁵ *Matal*, 582 U.S. at 235.

⁸⁶ *Id.*

⁸⁷ *Id.* at 239, 247.

⁸⁸ See Tanya Behnam, *Battle of the Band: Exploring the Unconstitutionality of Section 2(A) of the Lanham Act and the Fate of Disparaging, Scandalous, and Immoral Trademarks in a Consumer-Driver Market*, 38 LOY. L.A. ENT. L. REV. 1, 35–36 (2017).

⁸⁹ See *In re Mavety Media Grp. Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

⁹⁰ *Id.*

⁹¹ *Id.*

⁹² Behnam, *supra* note 88, at 36.

⁹³ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

In 2011, the applicant Brunetti submitted an application to register the mark “Fuct” in connection with his clothing brand.⁹⁴ The USPTO denied his application by finding that the mark was barred by the immoral or scandalous provision in Section 2(a) of the Lanham Act.⁹⁵ Brunetti appealed to the TTAB, arguing that the immoral or scandalous provision violated the First Amendment.⁹⁶ In response, the TTAB argued that it was “not the appropriate forum” for analyzing this First Amendment argument or any other constitutional arguments from “legal commentators or blog critics.”⁹⁷ Instead, the TTAB affirmed the USPTO’s decision to refuse the mark’s trademark registration.⁹⁸ Again, Brunetti appealed to the Federal Circuit Court of Appeals, which resulted in reversing the TTAB’s decision.⁹⁹

In January 2019, the Supreme Court granted certiorari.¹⁰⁰ The Court held in *Iancu v. Brunetti* that the “immoral or scandalous” provision in Section 2(a) of the Lanham Act violated the First Amendment and was entirely unconstitutional, reasoning that it allows for viewpoint discrimination and, once again, restricts free speech and “disfavors certain ideas.”¹⁰¹ Writing for the majority, Justice Kagan addressed several concerns.¹⁰² First, similarly to *Matal*, the Court found that the immoral or scandalous provision resulted in the government analyzing trademarks on a moral standard rather than an objective one, which violates trademark applicants’ freedom of speech during the registration process.¹⁰³ Since the immoral or scandalous provision was a cohesive standard—meaning,

⁹⁴ *In re Brunetti*, No. 85310960, 2014 WL 3976439, at *1, *3 (T.T.A.B. Aug. 1, 2014) (using the acronym “FUCT” as a mark to mean “Friends U Can’t Trust”).

⁹⁵ *Id.* at *1.

⁹⁶ *Id.* at *1, *5.

⁹⁷ *Id.* at *5.

⁹⁸ *Id.* at *6.

⁹⁹ *In re Brunetti*, 877 F.3d 1330, 1335 (Fed. Cir. 2017).

¹⁰⁰ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2298 (2019); see also *Iancu v. Brunetti*, SCOTUSBLOG, <https://www.scotusblog.com/case-files/cases/iancu-v-brunetti/> (last visited Feb. 24, 2024).

¹⁰¹ *Brunetti*, 139 S. Ct. at 2297.

¹⁰² *Id.*

¹⁰³ *Id.* at 2299–2300 (describing that the USPTO refused to register a mark glorifying drug use but allowed a similar mark that focused on religion and faith using the subjective “immoral or scandalous” standard).

there was not a distinct test for each word (“immoral” or “scandalous”), but rather the entire phrase analyzed as a whole—its use by the examining attorneys at the USPTO resulted in viewpoint discrimination that clashed with the First Amendment.¹⁰⁴ Interestingly, the opinion addresses the USPTO’s request for the Court to limit the meaning of the immoral or scandalous provision to make it comply with the First Amendment.¹⁰⁵ In response, Justice Kagan emphasized that the Court may only interpret a provision with “ambiguous statutory language,” and since no ambiguity exists in Section 2(a), it is not within the power of the judiciary to reinterpret statutes that the legislature did not intend.¹⁰⁶

Further, the concurrence and dissents in *Iancu v. Brunetti* offered advice to Congress and issued warnings to consumers and businesses.¹⁰⁷ First, Justice Alito concurred, agreeing with Justice Kagan that this interpretation of the statute in the manner requested by the USPTO could only be done by the legislative branch, and notes that “[v]iewpoint discrimination is poison to a free society.”¹⁰⁸ Additionally, he expressed how Congress could rewrite the immoral or scandalous provision in a way that does not violate the First Amendment by specifically targeting vulgar terms that have no purpose in expressing ideas.¹⁰⁹ Second, Justice Sotomayor wrote her own opinion, concurring in part and dissenting in part, which predicted an influx of trademark registration applications for offensive marks, and that the USPTO would have no other option but to approve of countless vulgar terms to be used in commerce.¹¹⁰ These remarks left many scholars wondering whether the marketplace would become flooded with obscene words and images, and whether Congress could create a new provision to curtail this predicted influx of vulgarity.¹¹¹

¹⁰⁴ *Id.* at 2298.

¹⁰⁵ *Id.* at 2301.

¹⁰⁶ *Id.* at 2301–02.

¹⁰⁷ *See Brunetti*, 139 S. Ct. at 2302, 2308 (Alito, J., concurring & Sotomayor, J., concurring in part and dissenting in part).

¹⁰⁸ *See id.* at 2302 (Alito, J., concurring).

¹⁰⁹ *Id.* at 2303.

¹¹⁰ *Id.* at 2308 (Sotomayor, J., concurring in part and dissenting in part).

¹¹¹ *See, e.g.,* Ned Snow, *Immoral Trademarks After Brunetti*, 58 HOUS. L. REV. 401, 401 (2020).

C. *Did the Predictions Come True? The Aftermath of Brunetti and Matal*

Now, five years after *Brunetti* and seven years after *Matal*, we examine these three issues resulting from the unconstitutionality of the disparaging, immoral, and scandalous clauses of Section 2(a) of the Lanham Act: (1) whether Justice Sotomayor correctly predicted an influx of offensive trademarks; (2) whether Congress can enact a new provision that passes constitutional scrutiny to curtail the registration of offensive trademarks; and (3) the impact that consumers and retailers have in discouraging the use of offensive marks in the marketplace.

First, did Justice Sotomayor's concurrence in *Brunetti* correctly predict "a rush to register trademarks for even the most viscerally offensive words and images that one can imagine"?¹¹² After *Matal*, registration applications for "viscerally offensive" trademarks did skyrocket.¹¹³ However, actual registration of these marks remained low.¹¹⁴ Between 2017 and 2019, nearly sixty percent of all trademark applications were approved for registration.¹¹⁵ By contrast, less than ten percent of "viscerally offensive" trademark applications were approved.¹¹⁶ Notably, this percentage for offensive trade-

¹¹² *Brunetti*, 139 S. Ct. at 2318 (Sotomayor, J., concurring in part and dissenting in part).

¹¹³ Jeffrey Greene & Rose Kautz, *The State Of Scandalous Trademarks Post-Brunetti*, LAW360 (Apr. 16, 2020, 6:14 PM), <https://www.cooley.com/-/media/cooley/pdf/reprints/2020/the-state-of-scandalous-trademarks-post-brunetti.ashx>. The following describes the process for these results:

Using comedian George Carlin's "seven dirty words" as a representative sample of commonly recognized "scandalous phrases," we collected detailed records for over 1,100 trademark applications submitted to the U.S. Patent and Trademark Office between 2000 and 2019. To determine the impact of *Brunetti* (and its predecessor *Matal v. Tam*, which was decided in 2017), we compared the data for trademark applications submitted in the past three years to the data for trademark applications submitted between 2000 and 2016.

Id.

¹¹⁴ *Id.*

¹¹⁵ *Id.*

¹¹⁶ *Id.*

mark registration is lower than the historical registration rate of similar marks prior to 2017 (before *Matal*).¹¹⁷ Thus, Justice Sotomayor was partially correct. The aftermath of the *Brunetti* and *Matal* decisions did create an influx of offensive trademark registration applications.¹¹⁸ Yet, the examining attorneys at the USPTO have other options to curtail approval of such marks, especially if the words or images do not act as actual source identifiers for the goods or services associated with them.¹¹⁹

Consequently, the fashion industry was significantly affected by this influx, with half of offensive trademark filings submitted for Class 25—goods associated with clothing and apparel.¹²⁰ More specifically, offensive trademark filings were five times more likely to be identified with clothing than any other good or service.¹²¹ Due to numerous controversial advertisements headlined from the fashion/beauty industry,¹²² these findings should not be surprising. It demonstrates how famous companies are using vulgar branding to attract attention towards their products.¹²³ Thus, the beauty and fashion industry will likely continue to be heavily impacted by offensive marks because of companies seeking to capitalize on controversy in the media.¹²⁴

Second, the *Brunetti* opinion suggested potential legislative action to curtail the influx of offensive trademark applications for registration.¹²⁵ Even though the majority refused to interpret the “immoral or scandalous” provision in a constitutional manner, Justice Alito’s concurrence expressed how Congress has the ability to create a new “immoral or scandalous” provision that does not violate

¹¹⁷ *Id.* fig.1.

¹¹⁸ Greene & Kautz, *supra* note 113.

¹¹⁹ *Id.*

¹²⁰ *Id.* fig.2.

¹²¹ *Id.*

¹²² See, e.g., Rachel Leah, *Prada, Gucci and now Burberry: Are Brands Under Fire for Offensive Designs Doing It On Purpose?*, SALON (Feb. 20, 2019, 4:30 PM), <https://www.salon.com/2019/02/20/prada-gucci-and-now-burberry-are-brands-under-fire-for-offensive-designs-doing-it-on-purpose/>.

¹²³ See *id.*

¹²⁴ See *id.*

¹²⁵ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302–03 (2019) (Alito, J., concurring).

the First Amendment.¹²⁶ For example, Congress could enact a provision that bans **all** vulgar or offensive marks.¹²⁷ By creating a list of vulgar terms that must be denied trademark registration, examining attorneys at the USPTO would have a neutral guideline to streamline their decision making process. This would lessen inconsistent rulings and remove the initial subjectivity that violated the First Amendment. However, some issues to keep in mind with this prospective method include how to choose the words for this list, how examining attorneys should analyze marks with multiple words, and how this method applies to images and symbols.

Creating a new method for analyzing offensive trademark applications, no matter how narrow or specific, invites similar concerns addressed in the *Brunetti* opinion.¹²⁸ For instance, complications can arise when offensive marks are used as a parody, highlighting the question of whether misspellings or sound-alikes of vulgar terms would also be deemed offensive and objectively denied registration through this process.¹²⁹ In trademark law, the parody defense allows the registration and use of marks that present commentary on political, religious, or social views—even if vulgar or offensive.¹³⁰ Therefore, providing the USPTO with an objective list of vulgar words that must automatically be denied registration is not entirely sufficient, since examining attorneys would still need to evaluate applications subjectively to ensure that the marks are not used as a parody in relation to the goods and services associated with it.¹³¹ Further, in our dynamic social and political culture, it is important to note that what society deems as vulgar is constantly changing.¹³²

¹²⁶ *Id.* at 2303.

¹²⁷ See Tim Lince, *Iancu v. Brunetti Ruling – Trademark Community Has its Say on Implications of Momentous US Supreme Court Decision*, WORLD TRADEMARK REV. (June 25, 2019), <https://www.worldtrademarkreview.com/article/iancu-v-brunetti-ruling-trademark-community-has-its-say-implications-of-momentous-scotus-decision>.

¹²⁸ Devon Sanders, Note, *Misbehaved Marks: Exploring the Implications of Iancu v. Brunetti*, 2020 B.C. INTELL. PROP. & TECH. F. 1, 10 (2020).

¹²⁹ See Lince, *supra* note 127.

¹³⁰ See Susan V. Mazurek, *Laugh It Off: A Guide to Parody Under U.S. Trademark Law*, TCAM TODAY: FAEGRE DRINKER (Apr. 10, 2023), <https://www.faegre-drinker.com/en/insights/publications/2023/4/laugh-it-off-a-guide-to-parody-under-us-trademark-law>.

¹³¹ See *id.*

¹³² Sanders, *supra* note 128, at 11.

Accordingly, if Congress enacted a new “immoral or scandalous” clause that passed constitutional scrutiny, the recognition of new obscenities in our culture would make enforcement of this clause difficult and hardly feasible.¹³³ Overall, determining the degree of vulgarity in a word or image is an innately subjective process and will always present difficulties when creating limitations that preserve the constitutionality of such a clause.¹³⁴

Third, how can consumers alone impact the use or registration of offensive marks in the marketplace? The *Brunetti* decision essentially shifted the burden of regulating offensive marks from the government to business owners and consumers.¹³⁵ This shift works by assuming that consumers will react to seeing offensive words, phrases, and images in the marketplace.¹³⁶ If consumers deem a mark as offensive, they will be less likely to purchase the goods or services associated with that term.¹³⁷ This would deter business owners from using vulgar or obscene language in association with their business because consumers will be less inclined to purchase those goods or services.¹³⁸ A significant amount of consumers will not want to align themselves with certain messages associated with offensive words, phrases, or images.¹³⁹ Moreover, retailers will be less likely to display these types of products and services because of their effect on its own profitability and reputation.¹⁴⁰ Ultimately, this solution represents the free market approach—where society can use self-regulation to reduce the use of offensive trademarks in the marketplace without a statutory provision or legislative aid.¹⁴¹

After nearly seventy years of restricting disparaging, immoral, and scandalous marks from trademark registration, *Brunetti* and *Matal* altered fundamental principles regarding governmental reach

¹³³ *Id.*

¹³⁴ *Id.*

¹³⁵ *See Iancu v. Brunetti*, 139 S. Ct. 2294, 2306 (2019) (Breyer, J., concurring in part and dissenting in part).

¹³⁶ Sanders, *supra* note 128, at 12.

¹³⁷ *Id.* at 12–13.

¹³⁸ *Id.* at 13.

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

in trademark law to allow “society’s control over what it deems appropriate.”¹⁴² As a result, an influx of applications for trademark registration of offensive marks occurred (even though approval of such marks declined).¹⁴³ Now, limiting the influx of offensive marks in the marketplace is still dependent upon the actions of the USPTO’s examining attorneys, the legislature, and the free market.

D. *An Example of Self-Regulation: From NFL’s Washington Redskins to Washington Commanders*

The litigation involving the National Football League (“NFL”) team formerly known as “The Washington Redskins” is a prime example of self-regulation.¹⁴⁴ In 1933, the owner of the Washington football team selected the name “Washington Redskins” to distinguish his team from other sports teams in the area.¹⁴⁵ After using the name for over thirty years, the team registered their mark “Redskins” with the USPTO in 1967.¹⁴⁶ The team associated itself with Native American imagery, including logos of Native American men, Native American garments, and the team’s band and cheerleaders use of Native American headdresses and stereotypical black braided wigs.¹⁴⁷ Nearly fifty years later, in 2014, responding to a petitioner’s request, the TTAB cancelled the team’s mark because of the disparagement clause in Section 2(a) of the Lanham Act, reasoning “at the time of their registrations[,] the marks consisted of matter that both ‘may disparage’ a substantial composite of Native Americans and bring them into contempt or disrepute.”¹⁴⁸

¹⁴² Sanders, *supra* note 128, at 14.

¹⁴³ Greene & Kautz, *supra* note 113.

¹⁴⁴ See Emma Bowman, *For Many Native Americans, the Washington Commanders’ New Name Offers Some Closure*, NPR (Feb. 6, 2022, 12:07 PM), <https://www.npr.org/2022/02/06/1078571919/washington-commanders-name-change-native-americans>.

¹⁴⁵ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 448 (E.D. Va. 2015).

¹⁴⁶ *Id.*

¹⁴⁷ *Id.* at 469–70.

¹⁴⁸ *Id.* at 451. Interestingly, the cancellation of the NFL team’s “Redskins” mark never went into effect, and because of this, the team was able to maintain all the benefits of federal trademark registration during the litigation. Michael McCann, *Why the Redskins Scored a Victory in the Supreme Court’s Ruling in Favor of The Slants*, SPORTS ILLUSTRATED (June 19, 2017), <https://www.si.com/nfl/2017/06/19/washington-redskins-name-slants-trademark-supreme-court>.

In response to their mark's cancellation, the team appealed to the Eastern District Court of Virginia.¹⁴⁹ The court affirmed the TTAB's decision, upholding the cancellation of the "Redskins" mark and the constitutionality of the disparagement clause (before the *Matal* decision).¹⁵⁰ Months later, the Federal Circuit ruled the opposite in the district court case of *Matal v. Tam*.¹⁵¹ While watching *Matal* reach the Supreme Court, the team asked the Fourth Circuit to postpone oral argument for their case until after the Court's *Matal* decision and ultimate ruling on the disparaging clause's constitutionality.¹⁵²

Because *Matal* struck down the disparaging clause, the Washington Redskins' trademark cancellation was reversed.¹⁵³ However, the NFL team still made the considerable decision to change the team's name to the "Washington Commanders."¹⁵⁴ This decision was likely made for several reasons, such as responding to public pressure, preserving the team's reputation, taking accountability for their use of the harmful term, and redirecting the team's image. By appropriately reacting to the "disparaging" controversy, the Washington Commanders valued the public's opinion and self-regulated its organization by rebranding itself without the use of the offensive trademark.

Essentially, the First Amendment is the vehicle used to challenge various clauses of Section 2 of the Lanham Act.¹⁵⁵ As previously mentioned, these bars to registration create a complex balance between trademark rights and freedom of speech. After the demise of the disparaging, immoral, and scandalous clauses, which clause

¹⁴⁹ *Pro-Football, Inc.*, 112 F. Supp. 3d at 451.

¹⁵⁰ *Id.* at 490.

¹⁵¹ *In re Tam*, 808 F.3d 1321, 1328 (Fed Cir. 2015).

¹⁵² *Supreme Court to Weigh in on Disparaging Trademarks*, MANATT (Dec. 15, 2016), <https://www.manatt.com/Insights/Articles/2016/Supreme-Court-to-Weigh-in-on-Disparaging-Trademark>.

¹⁵³ See Bill Chappell, *Washington Redskins' Trademark Registrations Cancelled*, NPR (June 18, 2014, 10:43 AM), <https://www.npr.org/sections/thetwo-way/2014/06/18/323205099/u-s-patent-office-cancels-washington-redskins-trademark-registration>; Erik Brady, *Appeals Court Vacates Decisions that Canceled Redskins Trademark Registrations*, USA TODAY (Jan. 18, 2018, 8:58 PM), <https://www.usatoday.com/story/sports/nfl/2018/01/18/appeals-court-vacates-decisions-canceled-redskins-trademark-registrations/1046758001/>.

¹⁵⁴ Bowman, *supra* note 144.

¹⁵⁵ See, e.g., *Matal v. Tam*, 582 U.S. 218, 223 (2017); *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

will be challenged next? Will the First Amendment argument always prevail against bars to registration? And, can the First Amendment argument also be used to challenge the constitutionality of other trademark doctrines beyond federal trademark registration?

IV. CHALLENGING POLITICAL COMMENTARY: *VIDAL V. ELSTER*

A. *Case Background & Development*

In 2022, the Federal Circuit Court of Appeals was presented with another First Amendment challenge to a new clause of the Lanham Act—Section 2(c)’s “living individual” clause.¹⁵⁶ The case first started when Steve Elster filed an application with the USPTO in 2018 to register the mark “Trump Too Small” in standard characters for use on t-shirts.¹⁵⁷ According to Elster’s application, the phrase “invokes a memorable exchange between President Trump and Senator Marco Rubio from a 2016 presidential primary debate, and aims to ‘convey[] that some features of President Trump and his policies are diminutive.’”¹⁵⁸ The USPTO rejected the application, concluding that the mark was barred from registration under Section 2(c) of the Lanham Act, which prohibits registering a trademark that consists of a name identifying a particular individual without that person’s consent.¹⁵⁹ In this case, Elster did not have Trump’s consent to use his name.¹⁶⁰

On appeal to the TTAB, Elster argued that Section 2(c) constituted unconstitutional free speech restrictions because “any government interest was outweighed by the First Amendment interest in allowing commentary and criticism regarding a political figure.”¹⁶¹ The TTAB affirmed the USPTO’s refusal to register his mark “Trump Too Small” by reasoning that Section 2(c) advances two compelling governmental interests: protecting individuals privacy

¹⁵⁶ *In re Elster*, 26 F.4th 1328, 1331 (Fed. Cir. 2022).

¹⁵⁷ *Id.* at 1330.

¹⁵⁸ *Id.*

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

¹⁶¹ *Id.*

rights and protecting the public against consumer confusion.¹⁶² Elster appealed, continuing his advocacy for his right to free speech.¹⁶³ His case was granted further review, where the Federal Circuit Court of Appeals reversed the lower court's decision and held that Section 2(c) of the Lanham Act violates the First Amendment by restricting free speech *as-applied* in this case.¹⁶⁴ Thus, the Federal Circuit found this specific instance unconstitutional but not the entirety of the clause.¹⁶⁵ Moreover, and importantly, language in the opinion suggests future constitutionality concerns regarding Section 2(c)'s "overbreadth" but reserves that issue for another day.¹⁶⁶

The Supreme Court granted certiorari.¹⁶⁷ In *Vidal v. Elster*, the issue presented before the Court is whether refusal to register a mark under Section 2(c) of the Lanham Act violates the Free Speech Clause of the First Amendment, specifically when the mark in question contains political commentary and criticism of a government official or public figure.¹⁶⁸ On November 1, 2023, the Supreme Court heard oral argument for this case.¹⁶⁹ Interestingly, the consensus from the questions asked by the Justices seems to infer a different potential First Amendment ruling for *Vidal v. Elster* than its *Matal* and *Brunetti* decisions.¹⁷⁰

During oral argument, the Justices were primarily concerned with Section 2(c) of the Lanham Act's limiting effects on speech and its historical tradition.¹⁷¹ By trying to narrow the issue, Justice Sotomayor pointed out how the main concern in this case is whether Elster can register his mark "Trump Too Small."¹⁷² She acknowledged how Elster can still use his mark in commerce and may have the ability to gain exclusive right to the mark under common law

¹⁶² *In re Elster*, 26 F.4th at 1330.

¹⁶³ *Id.*

¹⁶⁴ *Id.* at 1339.

¹⁶⁵ *Id.*

¹⁶⁶ *Id.*

¹⁶⁷ *Vidal v. Elster* SCOTUS Blog, *supra* note 8.

¹⁶⁸ *Id.*

¹⁶⁹ *Id.*

¹⁷⁰ See Ronald Mann, *Court Likely to Reject "Trump Too Small" Trademark Claim*, SCOTUSBLOG (Nov. 2, 2023, 12:57 PM), <https://www.scotusblog.com/2023/11/court-likely-to-reject-trump-too-small-trademark-claim/>.

¹⁷¹ *Id.*

¹⁷² *Id.*

doctrine, even if the USPTO refuses his federal trademark registration for the mark.¹⁷³ This point highlighted how his free speech would not be restricted, and Justice Sotomayor went on to say “[h]e can sell as many shirts with this saying, and the government’s not telling him he can’t use the phrase, [that] he can’t sell it anywhere he wants. There’s no limitation on him selling it. So there’s no traditional infringement.”¹⁷⁴ Moreover, Justice Sotomayor drove home the point by saying “[t]he question is, is this an infringement on speech? And the answer is no.”¹⁷⁵ If the other Justices rely on similar reasoning, the pending decision will likely side with the government and deny federal trademark registration for Elster’s mark “Trump Too Small.” This suggests that the First Amendment argument will not deteriorate the constitutionality of Section 2(c) of the Lanham Act, even when the mark contains political commentary of government officials.

B. Vidal v. Elster’s *Potential Impact on Trademark Law*

After the Federal Circuit’s *In re Elster* decision, legal scholars flooded blogs, newspapers, and podcasts with their reactions regarding the decision’s influence from *Brunetti* and *Matal*.¹⁷⁶ At their core, these three opinions highlight the strength of the First Amendment and its notion that “[t]he government may not discriminate

¹⁷³ *Id.*

¹⁷⁴ Transcript of Oral Argument at 20–21, *Vidal v. Elster*, No. 22-704 (Nov. 1, 2023).

¹⁷⁵ *Id.* at 20.

¹⁷⁶ See, e.g., Lisa Ramsey, *Trademark Registration of Political Messages for Expressive Merchandise—In re Elster* (Guest Blog Post), TECH. & MKTG. L. BLOG (Mar. 4, 2022), <https://blog.ericgoldman.org/archives/2022/03/trademark-registration-of-political-messages-for-expressive-merchandise-in-re-elster-guest-blog-post.htm>; Rebecca Tushnet, *2(c) Unconstitutional As Applied to TRUMP TOO SMALL*, REBECCA TUSHNET’S 43(B)LOG (Feb. 24, 2022), <https://tushnet.blogspot.com/2022/02/2c-unconstitutional-as-applied-to-trump.html>; Jennifer E. Rothman, *Federal Circuit Holds Bar on Registering “Trump Too Small” Violates First Amendment*, ROTHMAN’S ROADMAP TO THE RIGHT OF PUBLICITY (Feb. 26, 2022), https://rightofpublicityroadmap.com/news_commentary/federal-circuit-holds-bar-on-registering-trump-too-small-violates-first-amendment/; John L. Welch, *CAFC Deems Section 2(c) Unconstitutional As Applied in “TRUMP TOO SMALL” Refusal to Register*, THE TTABLOG® (Feb. 28, 2022), <http://thettablog.blogspot.com/2022/02/cafc-deems-section-2c-unconstitutional-as.html>.

against speech based on the ideas or opinions it conveys.”¹⁷⁷ However, *Brunetti* and *Matal* differ from *Vidal v. Elster* because Section 2(a) governed viewpoint-based restrictions, while Section 2(c) involves content-based restrictions.¹⁷⁸ When the government engages in viewpoint-based discrimination, it singles out a particular opinion on a specific issue that differs from other viewpoints on the same issue.¹⁷⁹ When the government engages in content-based discrimination, it restricts speech on the subject matter itself.¹⁸⁰ Thus, *Vidal v. Elster* once again displays the clash between trademark law and free speech by potentially commenting on whether the First Amendment is implicated in this situation and whether the government can deny registration to marks containing political commentary.¹⁸¹

When analyzing the effects of allowing trademark registration for marks providing political commentary, *Vidal v. Elster* presents an interesting paradox.¹⁸² The heart of this Note focuses on individuals’ free speech in the context of trademark registration and the ability to use whatever language a business owner wants to use in association with their business, and the arguments in *Vidal v. Elster* stress how applicants have a “substantial” First Amendment interest in criticizing public officials in the marketplace.¹⁸³ In this case, the right to free speech is not lessened because it is located on a t-shirt,¹⁸⁴ and it “does not lose its constitutional protection merely because it is effective criticism and hence diminishes [public figures’] official reputations.”¹⁸⁵ As previously mentioned, one of the First Amendment’s main roles is “to protect the free discussion of governmental affairs.”¹⁸⁶ Thus, *Elster* relied on the “fullest and most

¹⁷⁷ See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).

¹⁷⁸ *Ramsey*, *supra* note 176.

¹⁷⁹ Kevin Francis O’Neill, *Viewpoint Discrimination*, FREE SPEECH CTR. (Jan. 26, 2024), <https://www.mtsu.edu/first-amendment/article/1028/viewpoint-discrimination>.

¹⁸⁰ *Id.*

¹⁸¹ See Transcript of Oral Argument at 4, *Vidal v. Elster*, No. 22-704 (Nov. 1, 2023).

¹⁸² See generally *In re Elster*, 26 F.4th 1328, 1329–39 (Fed. Cir. 2022).

¹⁸³ See discussion *supra* Sections III.A, III.B.; see also *In re Elster*, 26 F.4th at 1331–32.

¹⁸⁴ See *In re Elster*, 26 F.4th at 1330.

¹⁸⁵ *Id.* at 1334.

¹⁸⁶ *Welch*, *supra* note 176.

urgent” use of the First Amendment, arguing that Section 2(c)’s bar to registration was unconstitutional and that his mark “Trump Too Small” is entitled to federal trademark registration protections.¹⁸⁷

Notably, on the other hand, approving trademark registration for marks providing political commentary allows trademark owners to restrict other individuals’ use of similar language or images for their own businesses.¹⁸⁸ Thus, the trademark owner is essentially suppressing the usage of specific words and messages in the marketplace.¹⁸⁹ Normally, this idea reinforces a fundamental principle of trademark law because it protects the trademark owner’s business, time, money, and effort put into making the mark a source identifier for their goods or services.¹⁹⁰ However, do we support this same notion for trademarks providing political, religious, or societal commentary? Do we want one trademark owner controlling the narrative in the marketplace? This is one of the most significant issues with *Vidal v. Elster, Brunetti, and Matal*; however, both the Supreme Court and Federal Circuit fail to acknowledge it.

For example, Elster can use the mark “Trump Too Small” on t-shirts and other apparel items with or without registration. However, by obtaining trademark registration rights for the mark, Elster can stop others from using the mark or similar language in commerce.¹⁹¹ Elster can bring trademark infringement claims against individuals using the mark “Trump Too Small” and potentially against others using different variations of the term “Trump.”¹⁹² When bringing these claims, Elster can prove the validity of his mark “Trump Too Small” through his trademark registration because it creates a presumption of the mark’s validity.¹⁹³ Therefore, Elster’s biggest hur-

¹⁸⁷ *See id.*

¹⁸⁸ Ramsey, *supra* note 176.

¹⁸⁹ *Id.* (“Granting one person or entity a registration in this context will make it easier for the trademark owner to suppress and chill the expression of competitors and others who want to use that message in connection with the sale of similar products.”).

¹⁹⁰ *See About Trademark Infringement*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/page/about-trademark-infringement> (last visited Jan. 29, 2024).

¹⁹¹ *See id.*

¹⁹² *See id.*

¹⁹³ *See id.*

dle would be proving that the alleged infringer's mark causes a likelihood of confusion with his senior mark.¹⁹⁴ If the claims prevail, Elster could be awarded injunctive or monetary relief, including "defendant's profits, any damages sustained by the plaintiff, and the costs of the action."¹⁹⁵

This circumstance leads to both private and government censorship over these types of marks containing certain speech because trademark owners are allowed to bring suit for infringement through the Lanham Act.¹⁹⁶ Elster could restrict individuals from using his mark or language similar to his mark by receiving monetary relief as a result.¹⁹⁷ The Supreme Court and Federal Circuit have not contemplated the type of harm that could be caused by allowing political marks to have federal registration protection, and courts should be wary of the meaning of these implications for the future of trademark law. Simply, this complex paradox illustrates how trademark owners right to free speech grants them the exclusive right over their registered marks—thus, infringing on others right to free speech.

Next, why did the Court decide to hear *Vidal v. Elster* when the mark "Trump Too Small" is likely unregistrable under other trademark doctrines? Even if the Court rules that Section 2(c) of the Lanham Act is unconstitutional as-applied in this case, Elster's mark may not prevail against the failure-to-function doctrine.¹⁹⁸ Under the failure-to-function doctrine, the USPTO may not register any mark that "does not serve as a source indicator of the identified goods/services."¹⁹⁹ This doctrine is mainly "a product of ad hoc TTAB innovation" from Federal Circuit precedent and not rooted in statutory language found in the Lanham Act.²⁰⁰ Nonetheless, the USPTO uses

¹⁹⁴ *See id.*

¹⁹⁵ *Id.*

¹⁹⁶ *See Ramsey, supra* note 176 (emphasizing this issue specifically "if the goods or services are artistic expression print and online publications, news services, entertainment services, apparel, and other types of expressive products or merchandise").

¹⁹⁷ *See About Trademark Infringement, supra* note 190.

¹⁹⁸ *Ramsey, supra* note 176.

¹⁹⁹ JAMES E. HAWES & AMANDA V. DWIGHT, TRADEMARK REGISTRATION PRACTICE CH. 8 § 2 (2023).

²⁰⁰ Lucas Daniel Cuatrecasas, *Failure to Function and Trademark Law's Outermost Bound*, 96 N.Y.U. L. REV. 1312, 1315 (2021); *see also Widely Used Messages*, TRADEMARK MANUAL OF EXAMINING PROCS. ("TMEP")

this doctrine regularly to deny trademark applications, and the doctrine's purpose is to help consumers accurately identify the source of the good or service.²⁰¹ If the USPTO finds that “Trump Too Small” does not function as an identifier of Elster's t-shirts, then it will not be registered.²⁰² Consequently, in the end, the mark “Trump Too Small” may not have federal trademark protections, regardless of the Court's decision.²⁰³ Perhaps another reason why the Court wanted to address this case was to acknowledge the weight of politicians' influences in business and the potential consequences of limiting or amplifying certain speech during an election year.

Lastly, we examine the influence of *Vidal v. Elster* on the future constitutionality of Section 2(c) of the Lanham Act and its effect on other trademark doctrines. Because of the Federal Circuit Court's holding that Section 2(c) violated the First Amendment in this case,²⁰⁴ it is predicted that there will be an influx of appeals, which may challenge the constitutionality of the entirety of Section 2(c) of the Lanham Act (and not just as-applied)—which was suggested throughout *In re Elster* by Circuit Judge Timothy Dyk:

The statute 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. It effectively grants all public figures the power to restrict trademarks constituting First Amendment expression before they occur. In *Tam*, Justice Alito, joined by three other Justices, characterized as “far too broad” a statute that would bar the trademark

§ 1202.04(b), <https://tmep.uspto.gov/RDMS/TMEP/print?version=current&href=TMEP-1200d1e1927.html> (discussing how phrases used to convey “social, political, religious, or similar informational messages in common use” are not normally acknowledged as a mark for certain goods or services).

²⁰¹ HAWES & DWIGHT, *supra* note 199.

²⁰² Ramsey, *supra* note 176.

²⁰³ *See id.*

²⁰⁴ *In re Elster*, 26 F.4th 1328, 1339 (Fed. Cir. 2022).

“James Buchanan was a disastrous president.” Nonetheless, we reserve the overbreadth issue for another day.²⁰⁵

In re Elster left the USPTO with little guidance on how to bar trademark registrations that violate Section 2(c) of the Lanham Act but also implicate the First Amendment.²⁰⁶ By construing this narrow holding, the Federal Circuit opened the door to questioning the “overbreadth” of Section 2(c)’s constitutionality and its application in the registration process. Now, the Supreme Court, while reviewing this decision, has the ability to comment on Section 2(c)’s overbreadth discussion or curtail it.

Because of the *In re Elster* and pending *Vidal v. Elster* decisions, courts are now more likely to subject other trademark doctrines to constitutional scrutiny.²⁰⁷ For example, the First Amendment argument could challenge the dilution doctrine next.²⁰⁸ The dilution doctrine bans the use or registration of commercial expression that is likely to dilute a famous trademark by tarnishment from a third party’s trademark.²⁰⁹ Thus, dilution claims protect famous trademarks from third parties taking advantage of the famous company’s reputation and profitability.²¹⁰ These claims have a substantial chilling effect on commercial expression because the vagueness in determining “tarnishment” creates uncertainty regarding what trademarks are allowed or prohibited.²¹¹

Moreover, there is no registry for famous marks, which makes who can bring a dilution claim less predictable.²¹² Similarly to *Matal*, dilution claims result in an overly subjective process that produces inconsistent results and restrictions on speech.²¹³ For these reasons, the dilution doctrine could be the next trademark principle

²⁰⁵ *Id.*

²⁰⁶ *See id.*

²⁰⁷ Ramsey, *supra* note 176.

²⁰⁸ *Id.*

²⁰⁹ *Id.*

²¹⁰ *See id.*

²¹¹ *Id.*

²¹² Heidi L. Belongia, *Why is Fame Still Confusing?: Misuse of the “Niche Market Theory” Under the Federal Trademark Dilution Act*, 51 DEPAUL L. REV. 1159, 1174 (2002).

²¹³ Ramsey, *supra* note 52, at 408.

challenged by the First Amendment, showcasing once again the ongoing tension between these two areas of law.

CONCLUSION

Justice Alito wrote in *Matal* how “the proudest boast of our free speech jurisprudence is that we protect the freedom to express ‘the thought that we hate.’”²¹⁴ We can expand this quote to also mean that the First Amendment is intended to protect the speech that we hate, love, tolerate, condone, and so forth. Throughout this Note, we examined the judicial history of the First Amendment challenging different clauses of the Lanham Act. With the Supreme Court reviewing *Vidal v. Elster*, the Court’s decision may have several outcomes. First, and simply, the Court will determine whether Elster’s freedom of speech was violated when the USPTO denied to register his mark “Trump Too Small” under Section 2(c) of the Lanham Act.²¹⁵ If the Court affirms, it will echo similar reasoning from *Matal* and *Brunetti* by upholding the First Amendment. If the Court overrules, the Court will finally place limits on this argument’s applicability; and interestingly, this would also mean that the mark to not receive First Amendment protections would be a mark containing political commentary.

Moreover, the Court’s decision can shed light on the paradox that entails granting exclusive use of marks in the marketplace while concurrently restricting others’ ability to use similar language for their businesses, especially with marks containing political, religious, and social commentary. Ultimately, *Vidal v. Elster* can either confirm what we already know about the First Amendment’s strength against the constitutionality of the Lanham Act clauses that prevent trademark registration, or the case can unlock new limitations on this argument and its future applicability against other trademark doctrines.

²¹⁴ *Matal v. Tam*, 582 U.S. 218, 246 (2017).

²¹⁵ *Vidal v. Elster* SCOTUS Blog, *supra* note 8.