

ALERT

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‘Trump Too Small’ Trademark Quest Reaches Supreme Court

By: MHH Intellectual Property Practice Group

A case involving the U.S. Patent and Trademark Office (USPTO)’s refusal to register the trademark TRUMP TOO SMALL for tee shirts has made its way to the U.S. Supreme Court. The justices recently agreed to a USPTO request to review the case after the United States Court of Appeals for the Federal Circuit (Federal Circuit) overturned the USPTO’s refusal to register the mark. Given it is already summer, the Supreme Court is likely to weigh in during its next term starting in October.

Why This Matters

The case is significant because it could provide Supreme Court guidance on balancing the First Amendment’s right to free speech with publicity and trademark rights. Section 2(c) of the Lanham Act (also known as the Trademark Act) prohibits the registration of trademarks containing the “name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.”

In its petition for certiorari, the USPTO specifically asked the justices to decide whether refusing to register a trademark under Section 2(c) violates the Free Speech Clause of the First Amendment when the mark contains criticism of a government official or public figure. The USPTO has also suspended action on pending applications for trademarks falling into this category until the Supreme Court reviews the case.

The case – [Vidal vs. Elster](#) – is also interesting because of two fairly recent Supreme Court decisions concerning the First Amendment and trademark rights. However, neither of those cases involved the use of a person’s name. Instead, the trademark applicants ran into a Lanham Act provision banning the registration of a trademark that is “immoral, scandalous and disparaging.”

In [Matal vs. Tam](#) (2017), the applicant sought to register the trademark THE SLANTS for live musical performances by a musical band. The USPTO refused to register the mark on the basis that THE SLANTS is a derogatory term for persons of Asian descent. In [Iancu vs. Brunetti](#) (2019), the desired trademark was “FUCT” for clothing. In both of these cases, the Supreme Court held that the Lanham Act provision violated the First Amendment because it required the government (in this case, the USPTO) to determine what is immoral, scandalous and disparaging, thereby taking a “viewpoint” on the speech.

The TRUMP TOO SMALL case, on the other hand, is viewpoint neutral. Any trademark that contains the name of a living individual without their consent – regardless of its message – cannot be registered under current trademark law.

ALERT

Background

The origins of the case date back to January 2018, when Steve Elster tried to register the phrase “TRUMP TOO SMALL” as a trademark for tee shirts and other clothing. An examining attorney with the USPTO refused Elster’s trademark application based on Section 2(c) of the Lanham Act, which prohibits trademarks that include the names of living individuals without their consent. In an appeal, the Trademark Trial and Appeal Board in July 2020 upheld the refusal.

However, the Federal Circuit in February 2022 reversed, holding that applying Section 2(c) to bar registration of Elster’s trademark unconstitutionally restricted his free speech in violation of the First Amendment. “According to Elster’s registration request, the phrase he sought to trademark 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,’” the Federal Circuit noted in its decision.

The USPTO’s subsequent petition for a rehearing was denied.

The USPTO responded by filing a petition for certiorari with the Supreme Court in January 2023 and followed that in February 2023 with the announcement that, pending the justices’ review of Vidal vs. Elster, it was suspending action on applications for trademarks critical of a government official or public figure.

If you have any questions regarding the matter raised in this Alert, please feel free to contact Terese Arenth at tarenth@moritthock.com or Michael Schwab at mschwab@moritthock.com.

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