

United States Court of Appeals for the Federal Circuit

IN RE: STEVE ELSTER,
Appellant

2020-2205

Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board in No. 87749230.

Decided: February 24, 2022

JONATHAN TAYLOR, Gupta Wessler PLLC, Washington, DC, argued for appellant. Also represented by GREGORY A. BECK.

JOSHUA MARC SALZMAN, Civil Division, Appellate Staff, United States Department of Justice, Washington, DC, argued for appellee Andrew Hirshfeld. Also represented by BRIAN M. BOYNTON, DANIEL TENNY; THOMAS L. CASAGRANDE, CHRISTINA J. HIEBER, THOMAS W. KRAUSE, FARHEENA YASMEEN RASHEED, MOLLY R. SILFEN, Office of the Solicitor, United States Patent and Trademark Office, Alexandria, VA.

MATTHEW ALBERT HANDAL, New York, NY, as amicus curiae, pro se.

Before DYK, TARANTO, and CHEN, *Circuit Judges*.

DYK, *Circuit Judge*.

Steve Elster appeals a decision of the Trademark Trial and Appeal Board (“Board”). The Board affirmed an examiner’s refusal to register the trademark “TRUMP TOO SMALL” for use on T-shirts. The Board’s decision was based on section 2(c) of the Lanham Act, 15 U.S.C. § 1052(c), and the Board’s finding that the mark included the surname of a living individual, President Donald J. Trump, without his consent. Because we hold that applying section 2(c) to bar registration of Elster’s mark unconstitutionally restricts free speech in violation of the First Amendment, we reverse the Board’s decision.

BACKGROUND

In 2018, Elster sought to register the phrase “TRUMP TOO SMALL” in standard characters for use on shirts in International Class 25. The class of goods encompasses:

Shirts; Shirts and short-sleeved shirts; Graphic T-shirts; Long-sleeved shirts; Short-sleeve shirts; Short-sleeved shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; T-shirts; Tee shirts; Tee-shirts; Wearable garments and clothing, namely, shirts. . . .

J.A. 1–2. 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.” J.A. 5.

The Patent and Trademark Office (“PTO”) examiner rejected Elster’s proposed mark on two grounds. First, the examiner concluded that the mark was not registrable because section 2(c) of the Lanham Act bars registration of a

IN RE: ELSTER

3

trademark that “[c]onsists of or comprises a name . . . identifying a particular living individual” without the individual’s “written consent.” § 1052(c). Consistent with this provision, Elster’s mark could not be registered because it used Trump’s name without his consent. It did not matter, according to the examiner, that the mark was “intended as political commentary” because there is no statutory or “case law carve[] out” for “political commentary.” J.A. 201. The examiner rejected Elster’s contention that denying the application infringed his First Amendment rights, finding that the registration bars are not restrictions on speech, and in the alternative, that any such restriction would be permissible. In a separate decision, the examiner also denied registration of the mark under section 2(a)’s false association clause, which bars registration of trademarks that “falsely suggest a connection with persons, living or dead.” § 1052(a). The examiner here also rejected a First Amendment defense.

Elster appealed both decisions to the Board, which consolidated the two cases. Elster argued that sections 2(c) and 2(a) constituted impermissible content-based restrictions on speech. He contended that strict scrutiny should apply, that neither provision was narrowly tailored to serve a compelling government interest, and that any government interest was outweighed by the First Amendment interest in allowing commentary and criticism regarding a political figure. The Board affirmed the examiner’s denial of the mark in a decision that rested solely on section 2(c) grounds, finding it unnecessary to address the rejection under section 2(a).

Although the Board recognized that it does not have authority to declare statutory provisions unconstitutional, it noted that prior Board decisions have addressed the constitutionality of section 2(c) in light of the Board’s experience and familiarity with the purposes underlying the statute, and it concluded that section 2(c) was not an

unconstitutional restriction on free speech. The Board explained, “even if Section 2(c) were subject to greater scrutiny,” it is narrowly tailored to advance two compelling government interests: protecting the named individual’s rights of privacy and publicity and protecting consumers against source deception. J.A. 10. Elster appeals. We have jurisdiction pursuant to 15 U.S.C. § 1071(a).

DISCUSSION

I

Section 2 of the Lanham Act requires the PTO to refuse registration of certain categories of proposed trademarks. In the last five years, the Supreme Court has held unconstitutional two provisions of section 2. In *Matal v. Tam*, 582 U.S. ___, 137 S. Ct. 1744 (2017), the Court considered a provision of section 2(a) of the Lanham Act, which directed the PTO to deny registration of marks that “disparage . . . or bring . . . into contempt[] or disrepute” any “persons, living or dead,” 15 U.S.C. § 1052(a). The eight-Justice Court was evenly split between two non-majority opinions, but both sides agreed that the provision violated the First Amendment. *See Tam*, 137 S. Ct. at 1765. In *Iancu v. Brunetti*, 588 U.S. ___, 139 S. Ct. 2294 (2019), the Court considered another provision of section 2(a) of the Lanham Act, which directed the PTO to deny registration of marks that “consist[] of or comprise[] immoral . . . or scandalous matter,” § 1052(a). Again, the Court held the provision unconstitutional. *See Brunetti*, 139 S. Ct. at 2302. The two opinions in *Tam* and the majority opinion in *Brunetti* each relied on a “core postulate of free speech law”—that “[t]he government may not discriminate against speech based on the ideas or opinions it conveys”—and concluded that “[v]iewpoint discrimination doomed” the two provisions. *Id.* at 2299.

The provision of the Lanham Act involved in this case, section 2(c), prohibits registration of a trademark that

[c]onsists of or comprises a 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.

§ 1052(c). Neither *Tam* nor *Brunetti* resolves the constitutionality of section 2(c). Both holdings were carefully cabined to the narrow, “presumptive[] unconstitutional[ity]” of section 2(a)’s viewpoint-based restrictions, *Brunetti*, 139 S. Ct. at 2299 (quoting *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829–30 (1995)), and Elster agrees that section 2(c) does not involve viewpoint discrimination, Oral Arg. at 45:49–46:35. We nonetheless conclude that as applied in this case, section 2(c) involves content-based discrimination that is not justified by either a compelling or substantial government interest.

II

While neither *Tam* nor *Brunetti* resolves this case, they do establish that a trademark represents “private, not government, speech” entitled to some form of First Amendment protection. *Tam*, 137 S. Ct. at 1760; see *Brunetti*, 139 S. Ct. at 2299. The cases also establish that trademarks often “do not simply identify the source of a product or service but go on to say something more” on “some broader issue.” *Tam*, 137 S. Ct. at 1764 (Alito, J.). They frequently “have an expressive content” and can convey “powerful messages . . . in just a few words.” *Id.* at 1760. Even though the government in the trademark area has not imposed an absolute prohibition on speech, *Brunetti* further established that denying trademark registration “disfavors” the speech being regulated. 139 S. Ct. at 2297, 2300. We recognize, as the government contends, that section 2(c) does not prevent Elster from communicating his message outright. But whether Elster is free to communicate his

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.