

Intellectual Property & Technology Law Journal

Edited by the Technology and Proprietary Rights Group of Weil, Gotshal & Manges LLP

VOLUME 36 • NUMBER 8 • SEPTEMBER 2024

U.S. Supreme Court Upholds Constitutionality of Federal Trademark Statute’s “Names Clause”

By Thomas W. Brooke and Patrick J. LaBella

The U.S. Supreme Court, in *Vidal v. Elster*,¹ has unanimously rejected a First Amendment challenge to the “names clause” of the Lanham Act on June 13, 2024. The names clause prohibits federally registering a trademark that contains a living person’s name without that person’s consent.² The U.S. Patent and Trademark Office (USPTO) used the names clause to reject Steve Elster’s application to register the phrase “Trump too small” without former President Donald Trump’s consent. After the USPTO denied Elster’s application, he challenged the names clause as an unconstitutional prohibition on free speech. Though the case generated three concurring opinions, all nine Supreme Court justices affirmed that the names clause is constitutional and allowed the USPTO to continue to enforce the provision when reviewing trademark applications.

Registering a surname as a trademark requires a showing of distinctiveness, almost always acquired through successful use and promotion of that name as a brand. The Court’s opinion now confirms that a trademark applicant needs permission from a specific living person identified in by the mark.

This ruling does not prohibit commentary or opinion-based speech. The Court’s holding is narrow and does not provide much guidance for future attempts to use a well-known name as a brand. Public figures, ranging from politicians to celebrities from film, fashion and elsewhere, and their lawyers will likely scrutinize future attempts to use well-known names as brands.

BACKGROUND AND SUPREME COURT’S DECISION

Analyzing the trademark applicant Elster’s claims below, the U.S. Court of Appeals for the Federal Circuit found his First Amendment arguments to be compelling.³ The Federal Circuit determined that the names clause is a “content-based” speech restriction because it treats trademark applications differently based on whether or not they contain a living person’s name. Content-based speech restrictions are presumptively unconstitutional and “may be justified only if the government proves that they are narrowly tailored to serve compelling state interests.”⁴ Applying this heightened scrutiny, the Federal Circuit ruled that the names clause did not advance a substantial government interest, and it found the provision unconstitutional.

Thomas W. Brooke (thomas.brooke@hklaw.com) is a partner in the Washington, D.C., office of Holland & Knight LLP. Patrick J. LaBella was a 2024 summer associate at the firm.

The Supreme Court disagreed with the Federal Circuit’s decision to apply heightened scrutiny to the names clause. Writing for the majority, Justice Clarence Thomas explained that trademark protection “necessarily requires content-based distinctions,” and carefully distinguished the names clause from “viewpoint-based” speech restrictions. Viewpoint-based restrictions target “particular views taken by speakers on a subject,” and represent “more blatant” violations of the First Amendment than content-based restrictions.⁵ The Supreme Court has held twice in the last decade that some provisions of the Lanham Act unconstitutionally limit speech with viewpoint-based restrictions. In *Matal v. Tam*,⁶ the Court ruled that a prohibition against disparaging trademarks violated the First Amendment as a viewpoint-based speech restriction. The Court used the same rationale in *Iancu v. Brunetti*⁷ to strike down a provision of the Lanham Act that prohibited trademarks containing immoral or scandalous matter.

CONCLUSION AND TAKEAWAYS

The Supreme Court distinguished the names clause from those viewpoint-based restrictions on trademark applications that it recently struck down. Regardless of whether the trademark portrays another person’s name in a flattering, critical or neutral light, the clause entirely prohibits the trademark’s registration without the named individual’s consent. This reality, coupled with the “uniquely content-based nature of trademark regulation,” influenced the Court’s decision not to apply a heightened level of scrutiny.

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Instead, the Court relied heavily on history and tradition dating to English common law that prohibited registering a trademark that contained another person’s name. Under English law, selling a product under another person’s name could constitute actionable fraud. The tradition against using another person’s name in trade continued throughout American history. Justice Thomas outlined that by 1911, federal trademark law permitted trademarks that contained a person’s name, but only when the name was that of the applicant. This history and tradition were sufficient for the majority to conclude – without announcing a test to analyze similar provisions in the future – that the names clause does not violate the First Amendment.

Justices Amy Coney Barrett and Sonia Sotomayor each would have developed a standard to apply to like cases in the future. Justice Barrett would have drawn an analogy to “limited public forum” cases, while Justice Sotomayor would have relied less on history and tradition and more heavily on First Amendment precedent to resolve the case.

Despite these differing rationales, the immediate impact of the Court’s decision in *Elster* is clear: Parties cannot register a trademark that contains another person’s name without their written consent.

Notes

1. *Vidal v. Elster*, No. 22-704 (U.S. June 13, 2024).
2. 15 U.S.C. § 1052(c).
3. See *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022).
4. *Nat’l Inst. of Family & Life Advocates v. Becerra*, 585 U.S. 755, 766 (2018).
5. *Rosenberger v. Rector & Visitors of the Univ. of Va.*, 515 U.S. 819, 829 (1995).
6. *Matal v. Tam*, 582 U.S. 218 (2017).
7. *Iancu v. Brunetti*, 588 U.S. 388 (2019).

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