



ARE Trademark Law Alert: Supreme Court Confirms Constitutionality of Lanham Act Prohibition on Registration of Trademarks That Comprise the Names Living People Without Their Consent in *Vidal v. Elster*

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On June 13, 2024, in *Vidal v. Elster*, No. 22-704, the United States Supreme Court unanimously upheld the constitutionality of a provision of the Lanham Act prohibiting the US Patent & Trademark Office (“USPTO”) from registering trademarks that name living people without their consent.

Background

The case grew out of the USPTO’s refusal to grant Steven Elster a federal trademark registration for the trademark TRUMP TOO SMALL for clothing under 15 U.S.C. § 1052(c) (the “Names Clause”). Elster challenged the refusal, arguing that the prohibition violated his free speech rights by treating speech about Donald Trump different from other speech. The US Court of Appeals for the Federal Circuit agreed. *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022). In a two-step analysis, the Federal Circuit found, first, that the Names Clause was a viewpoint-neutral, content-based restriction on speech subject to at least intermediate scrutiny. *Id.* at 1331, 1333-34. In a second step, the Federal Circuit concluded that the Government could not satisfy intermediate scrutiny because the Names Clause does not advance any substantial governmental interest. *Id.* at 1339.

Majority Opinion

This argument was rejected by the Supreme Court, although the Justices’ reasons for rejecting the argument differed.

After laying out the facts of the dispute in Part I, the majority opinion written by Justice Thomas noted in Part II(A) that the recent Supreme Court decisions in *Matal v. Tam*, 582 U.S. 218 (2017), and *Iancu v. Brunetti*, 588 U.S. 388 (2019), clarify that trademark restrictions that discriminate on viewpoint violate the First Amendment. That said, the “names clause does not facially discriminate against any viewpoint” even though it is clearly “content based.” *Vidal v. Elster*, No. 22-704, slip op. at 5-6 (U.S. June 13, 2024).

The majority opinion then turned in Part II(B) to the issue of whether these facts call for heightened scrutiny, and concluded they did not. History “demonstrates that restrictions on trademarks have always turned on a mark’s content. But, despite its content-based nature,



trademark law has existed alongside the First Amendment from the beginning. That longstanding, harmonious relationship suggests that heightened scrutiny need not always apply in this unique context.” *Id.* at 10-11.

In Part II(C), the majority opinion reviewed the particular history of restrictions on the trademarking of names, noting that such restrictions served purposes such as protecting a people’s ability to trademark their own names, *id.* at 12-14, and protecting people from having third parties piggyback off the goodwill they have built in their names, *id.* at 14-18. With this in mind, the Court found that the history and tradition of restricting trademarks containing names is sufficient to conclude that the Names Clause is compatible with the First Amendment. *Id.* at 12-19.

In Part III of the majority opinion, which was only joined by Justices Alito and Gorsuch, Justice Thomas defended the historical methodology used in the majority opinion against the analytical methodologies proposed for adoption by Justices Barrett and Sotomayor in their concurring opinions, as discussed below. “But, no matter the approach taken, we all agree that the names clause does not violate the First Amendment.” *Id.* at 20.

Kavanaugh Concurrence

Justice Kavanaugh, in a concurring-in-part opinion joining all but Part III of the majority opinion, joined by Chief Justice Roberts, noted that not all such viewpoint-neutral, content-based trademark restrictions need a long historical heritage to be constitutional.

Barrett Concurrence

Justice Barrett, joined by Justice Kagan, and joined in part by Justices Sotomayor, and Jackson, wrote a concurrence-in-part joining Parts I through II(B) of the majority opinion, but taking issue with Parts II(C) and III of the majority opinion by arguing that history and tradition should not be, and is not, sufficient to settle the constitutionality issue.

Instead, the issue should be addressed by determining whether the law is rationally related to a legitimate government purpose, which is the test set forth for analogous free speech cases in *Rosenberger v. Rectors and Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995). That said, under such an analysis, she argued, the Names Clause “passes muster.” After all, “[t]he Government can reasonably determine that, on the whole, protecting marks that include another living person’s name without consent risks undermining the goals of trademark. The names clause is therefore constitutional, both facially and as applied to Elster’s mark.” *Vidal v. Elster*, No. 22-704, concurring op. at 9 (U.S. June 13, 2024) (Barrett, J., concurring).

Sotomayor Concurrence

Justice Sotomayor, joined by Justices Kagan and Jackson, wrote a concurring opinion to set forth a proposed framework for deciding free speech challenges to provisions of the Lanham



Act, namely:

The analysis should proceed in two steps. First ask whether the challenged provision targets particular views taken by speakers on a given subject. If the trademark registration bar is viewpoint based, it is presumptively unconstitutional and heightened scrutiny applies; if it is viewpoint neutral, however, the trademark registration bar need only be reasonable in light of the purpose of the trademark system. Specifically, the trademark registration bar must reasonably serve its purpose of identifying and distinguishing goods for the public. If the challenged provision is both viewpoint neutral and reasonable, then it does not violate the Free Speech Clause.

Vidal v. Elster, No. 22-704, concurring op. at 5-6 (U.S. June 13, 2024) (Sotomayor, J., concurring). In an analysis similar to Justice Barrett's, Justice Sotomayor concluded that the Names Clause is not an unconstitutional infringement of Elster's free speech rights, writing, "on the conclusion that the names clause is constitutional, we all agree. Our disagreement boils down primarily to methodology." *Id.* at 3.

Conclusion

This case represents the third case in recent years to consider whether specific restrictions in the Lanham Act prohibiting the federal registration of some types of trademarks violate First Amendment free speech rights. The first two cases struck down the two most obvious viewpoint-discriminatory, content-based trademark restrictions, namely those against disparaging matter in *Matal v. Tam*, 582 U.S. 218 (2017), and against immoral or scandalous matter in *Iancu v. Brunetti*, 588 U.S. 388 (2019).

The current *Elster* case tested whether such free speech challenges could also be used to strike down content-based Lanham Act prohibitions that are not viewpoint-discriminatory, and the answer seems to be no. Although the Court did take care to note that its decision in this case "is narrow," our understanding is that this is most likely due to the methodological differences between the Justices' analyses and is not an invitation to challenge other viewpoint-neutral, content-based trademark restrictions that may unconstitutionally violate the First Amendment.

In the end, while the result with respect to Elster's mark was clear, the Justices' dispute over how to get to that result leaves much confusion on how to determine the constitutionality of other clauses of the Lanham Act and other laws in general.

We will continue to monitor developments and provide further updates regarding this case. In the meantime, please feel free to contact us if you have questions regarding issues raised by this case.



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