

When Freedom of Speech Becomes Unfair Competition: *Vidal v. Elster* and the Need to Protect § 1052(c)

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Abstract

Before the case of In re Elster, everyone in the United States had the right to place offensive phrases on t-shirts regarding former President Trump and sell them if they chose to do so. After the Federal Circuit's holding in Elster, no one in the nation may ever be able to put "TRUMP TOO SMALL" on clothing or else they might get sued for trademark infringement. Over the past few years, trademarks have become the subject of Supreme Court redlining: first through the elimination of the disparagement clause in § 1052(a) in Matal v. Tam and next through the immoral or scandalous clause of § 1052(a) in Iancu v. Brunetti. Denial of federal trademarks under the Lanham Act because of viewpoint has come under immense scrutiny and judicial review as a violation of the free speech clause of the First Amendment. However, this line of cases speaks to proper viewpoint discrimination jurisprudence, and the Federal Circuit's opinion in Elster—overturning the denial of the proposed word mark "TRUMP TOO SMALL" on t-shirts as a violation of § 1052(c)—misapplies the law and stretches the policy of Matal and Brunetti incorrectly against content-based restrictions. Under the Federal Circuit's logic, the proposed mark could not be denied by the USPTO because that would constitute impermissible content-based restrictions on speech that served no compelling governmental interest. Under the court's logic, the First Amendment concerns about criticizing the government outweighed the government's concerns in limiting the speech. However, the court missed a critical fact: no speech was ever silenced. The salient question in a trademark application is whether to confer federal monopoly rights to one person. In this case, the salient question is whether the entire country should have the right to put "TRUMP TOO SMALL" on t-shirts, or whether only one trademark holder should have that right. Before the Federal Circuit's holding, Trump himself could have put that phrase on a t-shirt and placed it into the stream of commerce, along with everyone else. Now, both Trump and the rest of the country might be barred from

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using that phrase on t-shirts—else they will create a likelihood of confusion—even though Trump owns the rights to his name, image, and likeness, and the point of the Federal Circuit’s opinion was to encourage more speech, not silence the rest of the country.

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I. Introduction

Famous people are people too. They have a right to profit off the success of their own identity and not be legally barred from doing so. In *In re Elster*, the Court of Appeals for the Federal Circuit held that the Lanham Act’s § 1052(c) restriction on registering a federal trademark with someone’s famous name, without their consent, was unconstitutional as applied to the mark “TRUMP TOO SMALL” because it violated the First Amendment.¹ Prior to the holding of *Elster*, the Lanham Act’s control over registrants was severely damaged due to the Supreme Court’s holdings in *Iancu v. Brunetti* and *Matal v. Tam*, where the Court struck down the USPTO’s ability to exercise viewpoint restrictions on potential trademarks on the federal register.² In *Matal*, the Supreme Court held that the Lanham Act’s bar on registering marks that were “disparaging”³ was unconstitutional viewpoint discrimination.⁴ In

¹ *In re Elster*, 26 F.4th 1328, 1339 (Fed. Cir. 2022).

² *See generally* *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019); *Matal v. Tam*, 137 S. Ct. 1744 (2017).

³ *See Matal*, 137 S. Ct. at 1751.

⁴ *See id.* at 1763.

Brunetti, the Supreme Court held the “immoral or scandalous”⁵ clause of the Lanham Act unconstitutional because it too regulated speech based on viewpoint, which is per se unconstitutional.⁶ These holdings alone—that the USPTO as a government agency cannot perform viewpoint discrimination when declining federal trademark registration—are not in dispute. However, the First Amendment concerns in these cases have reverberated past their narrow holdings and have since brought about an erroneous decision in *Elster*. In stretching the logic of *Matal* and *Brunetti* to the realm of content-based restrictions, the court mistakenly applied First Amendment defenses, which are traditionally reserved for copyright cases, and struck narrowly tailored content-based restrictions on speech in another section of the Lanham Act, § 1052(c).⁷ While the First Amendment has an important role to play in trademark law, the Supreme Court must overturn the holding of the Federal Circuit in *Elster* and hold that the USPTO has a compelling interest in protecting the monopolization of famous names for commercial gain and that requiring that person’s signature is the least restrictive means of achieving that goal. The Supreme Court must also clarify the guidance the USPTO needs in making sure not to run afoul of the First Amendment by drawing the lines between copyright fair use and trademark fair use—two distinct concepts that confer different rights onto intellectual property holders.

II. Summary

This paper will explore how the Lanham Act’s § 1052(c) content-based restrictions pass strict scrutiny review and how the Court of Appeals for the Federal Circuit misapplied the narrow holdings of *Brunetti* and *Tam*. This paper will also give a framework for defining the compelling interest the USPTO has in protecting the names and identities of famous individuals, and it will explain how the proper test the Federal Circuit should have applied is the *Central Hudson Gas & Electric Corporation v. Public Service Commission of New York* test.

III. Discussion

A. Traditional Trademark Law and the First Amendment

Applying traditional First Amendment principles is not a one-size-fits-all approach when aimed towards the regulation of federal trademark law. Inherently, trademark law involves the censoring of speech.⁸ Some content-based regulations on speech have been deemed legal under the First Amendment of the Constitution because the very nature of trademark law is to identify the content before regulating whether it infringes upon another’s federally registered mark.⁹ The very protections that the USPTO gives out through the process of federal trademark registration allow the trademark holder to censor anyone using their mark in a manner that is likely to

⁵ 15 U.S.C. § 1052(a).

⁶ *Brunetti*, 139 S. Ct. at 2297.

⁷ *In re Elster*, 26 F.4th 1328, 1332–33 (Fed. Cir. 2022).

⁸ *See* 15 U.S.C. § 1052(d).

⁹ *See id.*

cause confusion to consumers when they purchase goods or services.¹⁰ The Lanham Act gives a mark holder the right to exclusive use of the mark in commerce throughout the entire United States.¹¹ If a different entity uses the mark and purports to be the original holder, the Lanham Act allows a cause of action for the plaintiff to sue the entity under a trademark infringement claim for damages or to receive injunctive relief.¹² This is simple enough considering the ancient and traditional common law purposes of trademark law is to fight fraud and protect the goodwill of businesses from unfair competition, which the Lanham Act intended to codify.¹³ However, it is black letter law that trademarks constitute speech as defined under First Amendment jurisprudence.¹⁴ Any regulation of a trademark or of a copying user necessitates an analysis of the mark itself, meaning one must look to the speech to analyze whether or not to censor it. This is the textbook definition of a content-based regulation on speech.¹⁵ In short, to regulate trademarks means a regulation on content itself. Tension exists in trademark law between protecting trademark holders from others hoping to piggyback off their successful marks and still allowing First Amendment speech protections.¹⁶ In the trademark context, there are safeguards in the law for fair use of a mark to protect free speech,¹⁷ known as nominative fair use and descriptive fair use.¹⁸ However, even though content-based restrictions have been allowed to pass through strict scrutiny review in Supreme Court trademark cases, any viewpoint regulation is unconstitutional.¹⁹

¹⁰ See *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 155 (2015) (“[T]he likelihood-of-confusion language that Congress used in these Lanham Act provisions has been central to trademark registration since at least 1881.”).

¹¹ See 15 U.S.C. § 1115.

¹² 15 U.S.C. §§ 1116–17.

¹³ See *Petroliaam Nasional Berhad v. GoDaddy.com, Inc.*, 737 F.3d 546, 552 (9th Cir. 2013) (discussing the incorporation of “common law theory of contributory liability into the law of trademarks and unfair competition”); *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 428 (2003) (“Traditional trademark infringement law is a part of the broader law of unfair competition . . . that has its sources in English common law, and was largely codified in the Trademark Act of 1946 (Lanham Act).”); *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 861 n.2 (1982) (White, J., concurring) (“[T]he purpose of the Lanham Act was to codify and unify the common law of unfair competition and trademark protection.”). See generally 15 U.S.C. § 1051.

¹⁴ See *In re Elster*, 26 F.4th 1328, 1333 (Fed. Cir. 2022) (“That trademarked speech is entitled to First Amendment protection and that the protection is not lost because of the commercial nature of the speech does not establish the relevant test.”).

¹⁵ See *Matal v. Tam*, 137 S. Ct. 1744, 1749 (2017) (describing “content- and speaker-based restrictions” on speech); *Reed v. Town of Gilbert*, 576 U.S. 155, 163 (2015) (“Government regulation of speech is content based if a law applies to particular speech because of the topic discussed or the idea or message expressed.”).

¹⁶ See *Matal*, 137 S. Ct. at 1758–60 (explaining that trademark registration does not equate to government speech but rather fulfills “the Lanham Act’s viewpoint-neutral requirements”).

¹⁷ See generally *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *Kelly-Brown v. Winfrey*, 717 F.3d 295 (2012).

¹⁸ See, e.g., *KP Permanent Make-Up, Inc.*, 543 U.S. at 118 (explaining the statutory defense of fair use to a claim of trademark infringement); *Kelly-Brown*, 717 F.3d at 304–05 (explaining the statutory defense of fair use to a claim of trademark infringement).

¹⁹ *Pleasant Grove City v. Summum*, 555 U.S. 460, 469 (2009).

B. *Matal*, *Brunetti*, and Viewpoint Discrimination

The First Amendment of the Constitution states that “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.”²⁰ The provision denying the government’s ability to create laws abridging free speech was at issue in *Matal* and *Brunetti*. The Supreme Court held in both cases that the USPTO could not regulate trademark speech based on viewpoint.²¹ In *Matal*, an Asian-American singer attempted to register their band name “THE SLANTS” as a federal trademark.²² The singer, Simon Tam, “chose this moniker in order to ‘reclaim’ the term and drain its denigrating force as a derogatory term for Asian persons.”²³ However, when Tam attempted to file his proposed mark, the USPTO denied the registration.²⁴ According to the USPTO, Tam’s mark could be denied under 15 U.S.C. § 1052(a), which allowed the government to prohibit the “registration of trademarks that may ‘disparage . . . or bring . . . into contemp[t] or disrepute’ any ‘persons, living or dead.’”²⁵ On appeal to the Supreme Court in 2017, Tam prevailed when the disparaging clause of § 1052(a) was struck down as violating the Free Speech Clause because it allowed the government to enforce viewpoint discrimination in denying marks.²⁶ The Court held that “[i]f there is a bedrock principle underlying the First Amendment, it is that the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.”²⁷ Two years later, the Supreme Court revisited the doctrine of viewpoint discrimination in denying marks from the federal register in *Iancu v. Brunetti*.²⁸ In *Brunetti*, a clothing designer named Erik Brunetti created a line of clothing with the mark “FUCT” on it.²⁹ It was no secret that when read aloud, the letters together sounded similar to a profane swear word.³⁰ The USPTO denied the mark’s registration on the federal register, claiming that, since the mark was in essence a swear word, it violated another line of § 1052(a) of the Lanham Act which applies “to marks that ‘[c]onsist[] of or comprise[] immoral[] or scandalous matter.’”³¹ On appeal to the Federal Circuit, the Court of Appeals held the immoral or scandalous clause was unconstitutional because it violated the First Amendment.³² The Supreme Court affirmed the Federal Circuit and struck the immoral or scandalous clause, holding that “[t]he facial viewpoint bias in

²⁰ U.S. CONST. amend. I.

²¹ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019); *Matal*, 137 S. Ct. at 1751.

²² *Matal*, 137 S. Ct. at 1747–48.

²³ *Id.* at 1747.

²⁴ *Id.*

²⁵ *Id.* (quoting 15 U.S.C. § 1052(a)).

²⁶ *Id.* at 1765.

²⁷ *Id.* at 1763 (quoting *Hustler Mag., Inc. v. Falwell*, 485 U.S. 46, 55–56 (1988)).

²⁸ *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297 (2019).

²⁹ *Id.*

³⁰ *Id.*

³¹ *Id.* at 2298 (alteration in original).

³² *Id.*

the law results in viewpoint-discriminatory application.”³³ The Court reaffirmed the policy found in the majority holding in *Matal*, stating that “[t]here are a great many immoral and scandalous ideas in the world (even more than there are swearwords), and the Lanham Act covers them all. It therefore violates the First Amendment.”³⁴

In the context of viewpoint-discrimination, both these cases are firm in their holdings. No Lanham Act provision that allows the government to refuse registration based off viewpoint is constitutional. However, in the time since *Matal* and *Brunetti*, questions have arisen over how the USPTO may regulate trademarks based on their content and how the First Amendment interplays with content-based restrictions in the Lanham Act.³⁵ The government’s content-based regulations may freely regulate unprotected speech, such as obscenity, defamation, incitement of imminent lawless action, fraud, true threats, and fighting words, to name a few.³⁶ However, a government’s content-based regulations on protected speech are heavily disfavored and must pass strict scrutiny, meaning they must be narrowly tailored to serve a compelling governmental interest.³⁷ Traditional First Amendment Supreme Court cases have consistently held that “[g]overnment regulation of speech is content based if a law applies to particular speech because of the topic discussed or the idea or message expressed.”³⁸ According to the Supreme Court in *Reed v. Town of Gilbert*, “laws that cannot be ‘justified without reference to the content of the regulated speech’ or that were adopted by the government ‘because of disagreement with the message [the speech] conveys’” are content-based and will only survive if they satisfy strict scrutiny review.³⁹

There are plenty of Lanham Act provisions that regulate speech based on content. Particularly, 15 U.S.C. § 1052(a) recites a clause that refuses registration to a mark that “[c]onsists of . . . a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods.”⁴⁰ Another line in the same section prohibits the federal registration of a trademark that “[c]onsists of . . . matter which may . . . disparage or falsely suggest a connection with persons, living or dead.”⁴¹ Section 1052(b) prohibits registration of

³³ *Id.* at 2300, 2302.

³⁴ *Id.* at 2302.

³⁵ See *In re Elster*, 26 F.4th 1328, 1331 (Fed. Cir. 2022) (“Neither *Tam* nor *Brunetti* resolves the constitutionality of [15 U.S.C. § 1052(c)].”).

³⁶ See *United States v. Stevens*, 559 U.S. 460, 468 (2010) (explaining that the First Amendment permits restrictions on speech in “a few limited areas”); *Brown v. Ent. Merchs. Ass’n*, 564 U.S. 786, 791 (2011) (describing the “limited areas” of speech that may be restricted).

³⁷ *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017); *Reed v. Town of Gilbert*, 576 U.S. 155, 163 (2015) (“Content-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests.”).

³⁸ *Reed*, 576 U.S. at 163; see also *Sorrell v. IMS Health, Inc.*, 131 S. Ct. 2653, 2663–64 (2011) (discussing restrictions on “speech with a particular content”).

³⁹ *Reed*, 576 U.S. at 164 (alteration in original) (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989)).

⁴⁰ 15 U.S.C. § 1052(a).

⁴¹ *Id.*

a trademark that “[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.”⁴² Section 1052(c) stops an applicant from registering 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.”⁴³ This provision of the Lanham Act only applies when someone registers the name of a famous person without the famous person’s consent.⁴⁴ The Trademark Trial and Appeal Board has ruled that the content requirement in § 1052(c) only applies when either “(1) the person is so well known that the public would reasonably assume a connection between the person and the goods or services; or (2) the individual is publicly connected with the business in which the mark is used.”⁴⁵

Arguably the most important language in § 1052 can be found in § 1052(d), which prohibits registration to a mark that:

so resembles a mark registered in the Patent and Trademark Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive⁴⁶

This clause supplements both traditional policy goals of trademark law: protecting the goodwill of existing businesses and protecting consumers from confusion or fraud.⁴⁷ In applying § 1052(d), someone with a federal trademark may be able to sue an infringer to stop consumers from being confused and purchasing the infringer’s goods under the false assumption that the goods came from the trademark holder.⁴⁸ All these clauses outline USPTO restrictions on potential trademarks that “comprise” or “consist” of certain subject matter—another term for content-based regulations on speech.

C. *In re Elster*

When government regulations are content-based, they are subject to strict scrutiny review.⁴⁹ Strict scrutiny review puts the burden on the government to prove that the laws at issue are narrowly tailored to serve a compelling governmental

⁴² *Id.* at § 1052(b).

⁴³ *Id.* at § 1052(c).

⁴⁴ *In re Elster*, 26 F.4th 1328, 1339 n.6 (Fed. Cir. 2022).

⁴⁵ *In re ADCO Indus. Techs., L.P.*, 2020 WL 730361, at *10 (T.T.A.B. 2020); *Elster*, 26 F.4th at 1339 n.6.

⁴⁶ 15 U.S.C. § 1052(d).

⁴⁷ *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017) (“The Lanham Act provides national protection of trademarks in order to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers.” (quoting *Park ‘N Fly, Inc., v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 198 (1985))).

⁴⁸ *See* 15 U.S.C. § 1052(d).

⁴⁹ *Reed v. Town of Gilbert*, 576 U.S. 155, 164 (2015) (quoting *Ward v. Rock Against Racism*, 491 U.S. 781, 791 (1989)).

interest.⁵⁰ In *In re Elster*, Steve Elster appealed the Trademark Trial and Appeal Board's refusal to register his trademark with the USPTO.⁵¹ Elster was in the market to sell political t-shirts and wanted to register "TRUMP TOO SMALL" as a federal trademark.⁵² Specifically, in isolating the class of goods with which this mark would apply to if granted, Elster wanted the mark to be registered for: "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."⁵³ If granted, Elster would have a national monopoly on the use of the term "TRUMP TOO SMALL" whenever placed on any of the items in the above list.⁵⁴ All the protection of the Lanham Act would give Elster prima facie evidence of a valid trademark and the ability to sue anyone in the country with "TRUMP TOO SMALL" on that class of goods or anything so similar that it would be likely to confuse consumers as to the source of the goods.⁵⁵

1. Procedural History

When Elster first applied for the federal mark, the USPTO examiner denied his application.⁵⁶ The examiner denied "TRUMP TOO SMALL" because Elster did not obtain Donald Trump's consent to use his name in a federal mark, and 15 U.S.C. § 1052(c) prohibits an applicant from registering a particular individual's name without that person's consent.⁵⁷ The USPTO 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.'"⁵⁸ On appeal to the Trademark Trial and Appeal Board, Elster attempted to attack both §§ 1052(c) and 1052(a) as "impermissible content-based restrictions on speech."⁵⁹ The Appeal Board affirmed the USPTO examiner's decision, citing 15 U.S.C. § 1052(c).⁶⁰ Section 1052(c) states that:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

...

(c) Consists 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.⁶¹

⁵⁰ *Matal*, 137 S. Ct. at 1749; *Reed*, 576 U.S. at 163.

⁵¹ *In re Elster*, 26 F.4th 1328, 1329 (Fed. Cir. 2022).

⁵² *Id.*

⁵³ *Id.* at 1330.

⁵⁴ *Id.* at 1332.

⁵⁵ *Id.*

⁵⁶ *Id.* at 1329.

⁵⁷ *Id.* at 1330.

⁵⁸ *Id.* (quoting 15 U.S.C. § 1052(a)).

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ 15 U.S.C. § 1052(c).

The Appeal Board found that “section 2(c) was not an unconstitutional restriction on free speech”⁶² and that it would satisfy even the highest level of scrutiny because “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.”⁶³

Elster appealed to the Court of Appeals for the Federal Circuit, which has jurisdiction to hear appeals from the Trademark Trial and Appeal Board.⁶⁴ The Federal Circuit had an entirely different approach to the issues Elster faced and the implications of the government meddling with free speech.⁶⁵ The Federal Circuit started its opinion by referencing the fact that the Supreme Court has overturned two Lanham Act provisions in *Matal* and *Brunetti*.⁶⁶ However, according to the Federal Circuit, “[n]either *Tam* nor *Brunetti* resolves the constitutionality of section 2(c).”⁶⁷ Rather, the Federal Circuit rightfully points out that both *Matal* and *Brunetti* only dealt with viewpoint-based discrimination, not content-based discrimination.⁶⁸ Additionally, the court noted that “Elster agrees that section 2(c) does not involve viewpoint discrimination.”⁶⁹ Even though viewpoint discrimination was not at issue and the court acknowledged it was only dealing with content-based restrictions, the court held 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.”⁷⁰

2. *Understanding the Federal Circuit’s Holding*

The Federal Circuit’s opinion is unique in many ways, in part because it eliminates the recognition of privacy rights in § 2(c) as being a compelling interest as-applied⁷¹ and also because it includes phraseology not traditionally invoked in trademark litigation like “‘free discussion of governmental affairs’”⁷² and “‘the right to criticize public men’ is ‘[o]ne of the prerogatives of American citizenship.’”⁷³ The court used *Matal* and *Brunetti* to establish that trademarks “represent[] ‘private, not government, speech’ entitled to some form of First Amendment protection”⁷⁴ and that “denying trademark registration ‘disfavors’ the speech being regulated.”⁷⁵ From its

⁶² *Elster*, 26 F.4th at 1330.

⁶³ *Id.*

⁶⁴ *Id.*

⁶⁵ *Id.* at 1330–35.

⁶⁶ *Id.* at 1331.

⁶⁷ *Id.*

⁶⁸ *Id.*

⁶⁹ *Id.*

⁷⁰ *Id.*

⁷¹ *See id.* at 1335 (“[T]he government has no legitimate interest in protecting the privacy of President Trump . . .”).

⁷² *Id.* at 1334 (quoting *Mills v. Alabama*, 384 U.S. 214, 218 (1966)).

⁷³ *Id.* (quoting *Baumgartner v. United States*, 322 U.S. 665, 673–74 (1944)).

⁷⁴ *Id.* at 1332 (quoting *Matal v. Tam*, 137 S. Ct. 1744, 1760 (2017)).

⁷⁵ *Id.* (quoting *Iancu v. Brunetti*, 139 S. Ct. 2297, 2300 (2019)).

connection that trademarks are private speech and that the denial of a mark means the disfavoring of speech, the Federal Circuit continued its analysis by framing the question as whether the disfavoring of speech criticizing a public figure is something the Constitution allows for in the trademark context.⁷⁶ By framing it this way, instead of first looking to whether protecting someone's identity from being used for commercial gain is a compelling interest, the Federal Circuit evidently had already come to a conclusion about § 2(c).

The Federal Circuit acknowledged the two broad interests being propped up by the government to defend § 2(c): right of privacy and right of publicity.⁷⁷ If used correctly, the right of privacy would have shielded Trump from “the publication of false information ‘with knowledge of its falsity or in reckless disregard of the truth.’”⁷⁸ According to the court, “there can be no plausible claim that President Trump enjoys a right of privacy protecting him from criticism in the absence of actual malice.”⁷⁹ The First Amendment interests in allowing citizens to criticize public figures play strongly under this cause of action, and “[t]hose privacy concerns similarly must give way when the speech at issue references a public figure because public figures subject themselves to ‘greater public scrutiny and ha[ve] a lesser interest in privacy than an individual engaged in purely private affairs.’”⁸⁰

More important to the government's argument to the Federal Circuit was the right of publicity: a common law intellectual property right that constitutes “the exclusive right of individuals to control the commercial exploitation of their names, images, and other attributes of their personality, and to prevent others from capitalizing on unauthorized commercial uses of their identity.”⁸¹ The court held that “[t]he right of publicity does not support a government restriction on the use of a mark because the mark is critical of a public official without his or her consent.”⁸² In addition to that holding, the court was clear that “[n]o plausible claim could be or has been made that the disputed mark suggests that President Trump has endorsed Elster's product.”⁸³ There were other sections of the Lanham Act that would have dealt with such an issue, such as § 2(a) which refuses the federal registration of a mark that “may . . . falsely suggest a connection with persons, living or dead.”⁸⁴ However, because that section was not brought up on appeal, the Federal Circuit claimed it had no reason to analyze its applicability to the expressive speech integrated into Elster's proposed mark.⁸⁵

⁷⁶ *Id.* at 1334–35.

⁷⁷ *Id.* at 1335 (discussing first the “claimed right of privacy” and later discussing “protecting the right of publicity”).

⁷⁸ *Id.* (quoting *Time Inc. v. Hill*, 385 U.S. 374, 388 (1967)).

⁷⁹ *Id.*

⁸⁰ *Id.* (quoting *Bartnicki v. Vopper*, 532 U.S. 514, 539 (2001)).

⁸¹ KURT M. SAUNDERS, *INTELLECTUAL PROPERTY LAW; LEGAL ASPECTS OF INNOVATION AND COMPETITION* 697–98 (2016).

⁸² *Elster*, 26 F.4th at 1337.

⁸³ *Id.* at 1336.

⁸⁴ 15 U.S.C. § 1052(a); *Elster*, 26 F.4th at 1336–37.

⁸⁵ *Elster*, 26 F.4th at 1336.

Additionally, the court wrote about the inherent tension between right of publicity cases, First Amendment interests, and the Restatement (Third) of Unfair Competition's balancing of those issues:

The Restatement of Unfair Competition recognizes that challenges under state-law publicity statutes are “fundamentally constrained by the public and constitutional interest in freedom of expression,” such that the “use of a person’s identity primarily for the purpose of communication information or expressing ideas is not generally actionable as a violation of the person’s right of publicity.”⁸⁶

Since the court viewed Elster’s expression as primarily critical of the government,⁸⁷ and because the right of publicity does not outweigh First Amendment interests that protect the mocking or commentating of government officials,⁸⁸ it held as its as-applied rule that:

The government has no valid publicity interest that could overcome the First Amendment protections afforded to the political criticism embodied in Elster’s mark. As a result of the President’s status as a public official, and because Elster’s mark communicates his disagreement with and criticism of the then-President’s approach to governance, the government has no interest in disadvantaging Elster’s speech.⁸⁹

The court cabined its holding to only Elster, only this case, and, being careful not to trigger an immediate appeal for a facial challenge, it only mentioned its other broader constitutional issue with § 1052(c)—the overbreadth doctrine—in passing.⁹⁰ The court wrote that, as written, § 1052(c) can unjustifiably censor too broad a swath of protected speech in its execution and “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.”⁹¹ The court concluded its opinion by leaving overbreadth “for another day”⁹² and reversed the Trademark Trial and Appeal Board’s denial of Elster’s mark, leaving Steve Elster with the power to potentially gain federal trademark rights over the mark “TRUMP TOO SMALL.”⁹³

D. The Problem with the Law in *In re Elster*

The First Amendment implications found in *Matal* and *Brunetti* were illogically applied to the federal trademark registration in *In re Elster*, resulting in an as-applied attack on the Lanham Act for violating the First Amendment. Not only did the court fail to uphold the compelling interest found in § 1052(c) of protecting individuals from having their name monopolized by others, but it also did not find requiring a

⁸⁶ *Id.* at 1337 (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. c).

⁸⁷ *Id.* at 1337–38.

⁸⁸ *Id.* at 1338.

⁸⁹ *Id.*

⁹⁰ *See id.* at 1339 (“[W]e reserve the overbreadth issue for another day.”).

⁹¹ *Id.*

⁹² *Id.*

⁹³ *Id.*

person's consent to use their identity narrowly tailored.⁹⁴ The court found that political commentary and criticism of former President Trump warranted allowing Steve Elster the possibility of obtaining a federal mark to sell "TRUMP TOO SMALL" t-shirts and other clothing.⁹⁵ To protect free speech, the court permitted Elster to pursue a federal monopoly that confers the ability to silence anyone in the nation who also attempts to sell a t-shirt that mentions "TRUMP TOO SMALL" or anything else that creates a likelihood of confusion towards consumers.⁹⁶ The court mistakenly applied criticism and commentary—fair use defenses employed after a claim of copyright infringement is found, but not trademark registration—as the rationale for permitting Elster to pursue the federal mark. What the court missed is that Elster's speech was never abridged. One does not need a federal trademark in order to obtain common law trademark protection, nor does one need it to sell t-shirts displaying political commentary or criticism. Elster was free to sell t-shirts with "TRUMP TOO SMALL" on them prior to this case and still would be free to do so today, irrespective of the court proceedings. However, federal trademark rights confer a great deal of power on their holder, and granting federal rights to one applicant while denying them to another may benefit the former and hurt the latter in a commercial sense.

1. *The Blurring of Viewpoint and Content*

The court in *Elster* wrote that "*Brunetti* further established that denying trademark registration 'disfavors' the speech being regulated."⁹⁷ It also held that "[l]aws suppressing the right 'to praise or criticize governmental agents' generally cannot be squared with the First Amendment."⁹⁸ Under that line of logic, the denial of Elster's mark constitutes suppression and must be overturned as a violation of the First Amendment. But that is simply not what was happening in *Elster*, nor did the Supreme Court in *Brunetti* ever rule so broadly. In *Brunetti*, the Supreme Court held that § 1052(a)'s immoral or scandalous clause of the Lanham Act violated the First Amendment because it disfavored certain *ideas*.⁹⁹ The *Brunetti* Court also wrote plainly that "as the Court made clear in *Tam*, a law disfavoring 'ideas that offend' discriminates based on viewpoint, in violation of the First Amendment."¹⁰⁰ The apparent rule from *Matal* and *Brunetti*, that denying a trademark disfavors speech, only applies when analyzing viewpoint-based restrictions on speech—only when a trademark is being denied because it contains "'ideas that offend.'"¹⁰¹

⁹⁴ *See id.* at 1338–39 ("The PTO's refusal to register Elster's mark cannot be sustained because the government does not have a privacy or publicity interest in restricting speech critical of government officials or public figures in the trademark context—at least absent actual malice, which is not alleged here.").

⁹⁵ *Id.* at 1338.

⁹⁶ *See id.* at 1338–39 (reversing the Board's decision that Elster's mark could not be registered).

⁹⁷ *Id.* at 1331 (quoting *Iancu v. Brunetti*, 139 S. Ct. 2294, 2297, 2300 (2019)).

⁹⁸ *Id.* at 1334 (quoting *Mills v. Alabama*, 384 U.S. 214, 218 (1966)).

⁹⁹ *Brunetti*, 139 S. Ct. at 2297 ("We hold that this provision infringes the First Amendment for the same reason: It too disfavors certain ideas.").

¹⁰⁰ *Id.* at 2301 (quoting *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017)).

¹⁰¹ *See id.* at 2297, 2301 ("[A]s the Court made clear in *Tam*, a law disfavoring 'ideas that offend'

Nothing from the holdings of *Matal* and *Tam* that deals with viewpoint-based restrictions should have applied to the restrictions here. *Elster* was dealing with the USPTO’s content-based restrictions on speech under § 1052(c), not viewpoint-based restrictions on speech. The Federal Circuit noted in its holding that “Elster agrees that section 2(c) does not involve viewpoint discrimination. 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.”¹⁰² The court explicitly mentions that “[n]either *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.”¹⁰³ Unfortunately, the Federal Circuit imported viewpoint-based rules of law and incorrectly applied them to content-based restrictions. Section 1052(c) cares nothing about viewpoint: it only looks to the content of the mark to see if it contains the name of someone famous without their consent.¹⁰⁴ The crux of when § 1052(c) applies hinges on whether the mark contains certain words:

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

...

(c) Consists 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.¹⁰⁵

The restrictions do not apply based on the viewpoint of the speaker; Steve Elster does not have to be a Trump voter for the restriction to apply to his mark. All an applicant must do is use someone else’s name without their consent, and § 1052(c) is triggered.¹⁰⁶

2. *Blurring Criticism with Commercial Monopolies*

The government’s silencing of protected speech goes against the heart of the First Amendment. However, denying Elster’s mark did not silence his ability to criticize or comment on politics; it only stopped him from obtaining a valid trademark that gave him the power to silence everyone else across the country from saying the same thing as him.¹⁰⁷ Before the holding of *Elster*, anyone could have printed “TRUMP TOO SMALL” on clothing and sold it. After the holding of *Elster*, only

discriminates based on viewpoint, in violation of the First Amendment.” (quoting *Matal*, 137 S. Ct. at 1751)).

¹⁰² *In re Elster*, 26 F.4th 1328, 1331 (Fed. Cir. 2022).

¹⁰³ *Id.* (quoting *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019)).

¹⁰⁴ 15 U.S.C. § 1052(c); see generally *In re ADCO Indus. Techs., L.P.*, 2020 WL 730361, at *10–11 (T.T.A.B. 2020) (“[W]ell-known individuals such as celebrities and world-famous political figures are entitled to the protection of Section 2(c) without having to evidence a connection with the involved goods or services.”).

¹⁰⁵ 15 U.S.C. § 1052(c) (emphasis added).

¹⁰⁶ *Elster*, 26 F.4th at 1330–31.

¹⁰⁷ See generally 15 U.S.C. § 1052(d).

one man in the nation may be allowed to say “TRUMP TOO SMALL” on t-shirts: Steve Elster. All others may be silenced. There is more at issue with the Federal Circuit’s decision, though. Not only is Donald Trump himself now potentially barred from using his own name on clothing if he attempts to include the words “TRUMP TOO SMALL,” but also anyone who comments on politics or the government now has the ability to federally register a mark with their commentary. Comment and criticism go both ways—think “TRUMP TOO GREAT” or “PENCE FOR 2024.” These are theoretical examples of protected speech that comment on politics and political figures, but now they can be federally registered by people other than those whose names are in the mark to profit off that person’s name.

The Federal Circuit paid special attention to the concept of criticizing a public figure in its decision.¹⁰⁸ Protection of speech aimed at criticizing the government is the most essential part of First Amendment jurisprudence, and the Federal Circuit was correct in stating that “the right of publicity would be unavailable to ‘a candidate for public office’ who sought to ‘prohibit the distribution of posters or buttons bearing the candidate’s name or likeness, whether used to signify support or opposition.’”¹⁰⁹ In assessing Steve Elster’s critique of Trump with the phrase “TRUMP TOO SMALL,” the court cited a similar right of publicity challenge from Tiger Woods in *ETW Corp. v. Jireh Publishing, Inc.*¹¹⁰ In that case, Tiger Woods sued Jireh, a publisher of artwork created by Rick Rush, who had created a number of prints that featured Tiger Woods’s likeness.¹¹¹ The Sixth Circuit held that the prints were creative expressions protected by the First Amendment.¹¹² The court held that “[w]hile the right of publicity allows celebrities like Woods to enjoy the fruits of their labors, here Rush has added a significant creative component of his own to Woods’s identity.”¹¹³

The Federal Circuit’s insertion of parody, criticism, and speech is incorrectly placed. According to the court, it “‘must be ever mindful of the inherent tension between the protection of an individual’s right to control the use of his likeness and the constitutional guarantee of free dissemination of ideas, images, and newsworthy matter in whatever form it takes.’”¹¹⁴ However, what the court does not recognize in its connection to the Tiger Woods case, or its recitation of the inherent tension between a person’s likeness and dissemination, is that in neither instance was there an issue of conferring extra rights. Rather, in those instances, rights are being removed. It is one thing to prohibit an artwork publisher from selling prints of Tiger Woods. It is another thing to confer federal rights to Steve Elster to exclude all other potential registrants from using the phrase “TRUMP TOO SMALL” on clothing,

¹⁰⁸ *Elster*, 26 F.4th at 1337–38.

¹⁰⁹ *See id.* at 1338 (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. b.).

¹¹⁰ *Id.*; *ETW Corp v. Jireh Pub., Inc.*, 332 F.3d 915, 918 (6th Cir. 2003).

¹¹¹ *Jireh*, 332 F.3d at 918.

¹¹² *Id.* at 937–38.

¹¹³ *Id.* at 938.

¹¹⁴ *Elster*, 26 F.4th at 1337–38 (quoting *Titan Sports, Inc. v. Comics World Corp.*, 870 F.2d 85, 88 (2d Cir. 1989)).

including the name-holder himself. The equivalent scenario is whether it would be within the scope of the Lanham Act to confer rights to the artwork publisher to be the only entity in the United States with the power to print certain trademarkable pictures of Tiger Woods in a certain fashion. Such rights would plainly interrupt Tiger Woods's inherent right of publicity and potentially a host of other infringements. However, replace Woods with Trump, and the First Amendment interests seem to become strong enough to counteract intellectual property rights, protection from source deception, the right of publicity, false endorsement, false advertising, and a host of other potential issues.

The court failed to separate whatever expressive speech was contained in "TRUMP TOO SMALL" from its commercial aspect.¹¹⁵ According to the Federal Circuit, "[i]t is well established that speech ordinarily protected by the First Amendment does not lose its protection 'because the [speech] sought to be distributed [is] sold rather than given away.'"¹¹⁶ The court found the fact that the Elster shirts would be held for sale irrelevant to the question of whether the mark received a full level of First Amendment protection or not.¹¹⁷ The court quoted the Tenth Circuit, which stated that it sees "'no principled distinction between speech and merchandise that informs our First Amendment analysis. The fact that expressive materials are sold neither renders the speech unprotected . . . nor alters the level of protection.'"¹¹⁸ The Federal Circuit then added that "[n]or is the expressive speech entitled to a lesser degree of protection because it is printed on a T-shirt."¹¹⁹ However, this holding ignores the *Central Hudson Gas & Electric v. Public Service Commission of New York* test and decades of unfair competition law. Determining the level of commerciality is not only relevant but also critical to the analysis. The more expressive the speech, the more protection it receives. The more commercial the speech, the less protection it receives, as the government has a stronger influence in regulating commercial speech than it does purely expressive speech.¹²⁰ In *Matal*, the Supreme Court wrote that:

[A] dispute between the parties on the question whether trademarks are commercial speech and are thus subject to the relaxed scrutiny outlined in *Central Hudson* . . . need not [be resolved] . . . because the disparagement clause cannot withstand even *Central Hudson* review. Under *Central Hudson*, a restriction of speech must serve "a substantial interest," and it must be "narrowly drawn."¹²¹

Right of publicity cases have held that the more commercial the speech is, the more likely it is that it has misappropriated the user's publicity to the point that a tort

¹¹⁵ See *id.* at 1333.

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ *Id.* (citing *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 970 (10th Cir. 1996)).

¹¹⁹ *Id.*

¹²⁰ See *Matal v. Tam*, 137 S. Ct. 1744, 1749 (2017).

¹²¹ *Id.* (quoting *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 564–65 (1980)).

has been committed, sometimes even requiring commercial advantage as an element of the tort.¹²² The balance must be weighed in the speech itself and the regulation being proposed. Here, Elster was already speaking by selling his t-shirts with common-law trademark rights prior to federal registration. Even if “TRUMP TOO SMALL” did not achieve any common-law trademark rights, the speech was purely commercial; Elster’s goal was (and is) to make money by selling shirts.¹²³ He could always post that phrase online, share it with others, publish it, hand the shirts out for free, and make posters, but his goal in making the shirts, and his primary goal in receiving a federal registration, must be commercial. Federal trademark rights are commercial in nature; they give a trademark owner the right to exclude all others from using their mark, i.e., a commercial monopoly on that trademark. All speech benefits derived from trademark registration are secondary to the fact that it gives the trademark owner the ability to make money more efficiently and that it gives consumers a potential indication of the source of goods. The balancing of intent in the speech leads one to conclude that Elster’s speech was commercial in nature, and “[a]n unauthorized commercial use of a celebrity’s identity for promotion or merchandising—in an advertisement or on a product like a t-shirt or coffee mug, for instance—is misappropriation.”¹²⁴ If Elster’s use of the name “Trump” was incidental to the sale of the t-shirt, it may be a different story. According to the Restatement (Third) of Unfair Competition:

The name, likeness, and other indicia of a person’s identity are used ‘for purposes of trade’ under the rule stated in § 46 if they are used in advertising the user’s goods or services, or are placed on merchandise marketed by the user, or are used in connection services rendered by the user. However, use ‘for purposes of trade’ does not ordinarily include the use of a person’s identity in news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.¹²⁵

However, Elster was marketing the shirts *because* of the use of Trump’s name on them. Removing the name Trump from the shirt eliminates almost all its commercial value. Obtaining a federal mark did not give Elster the right to speak; it gave Elster the right to silence everyone else through the power of the U.S. Patent and Trademark Office. In fact, the floodgates have opened in the months since the *Elster* decision. Multiple applications for marks containing Trump’s name or likeness have been submitted to the USPTO. A few examples of marks illustrate the issue. An applicant from Oklahoma named Lozano Miranda filed a trademark application for “TRUMP LIVES MATTER” in the class of promotional merchandise goods in November 2022.¹²⁶ An Ohio man named Donald P. Herres filed a trademark application for “ULTRA MAGA TRUMP 2024 RETURN OF THE GREAT MAGA KING” to apply over the class of silver bullion coins in July 2022.¹²⁷ A Florida man

¹²² See generally *Zacchini v. Scripps-Howard Broadcasting Co.*, 433 U.S. 562, 576–578 (1977); *Melendez v. Sirius XM Radio, Inc.*, 50 F.4th 294, 299 (2d Cir. 2022).

¹²³ *In re Elster*, 26 F.4th 1328, 1330 (Fed. Cir. 2022).

¹²⁴ SAUNDERS, *supra* note 81, at 723.

¹²⁵ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 (1995).

¹²⁶ U.S. Trademark Application Serial No. 97/664,348 (filed Nov. 5, 2022).

¹²⁷ U.S. Trademark Application Serial No. 97/525,380 (filed July 29, 2022).

named Patrick Simpson-Jones filed a trademark application for “DUMP TRUMP” in November 2022 for clothing.¹²⁸ The best example of how the decision has influenced applications comes from the new application belonging to Daphne McKee in Plano, Texas.¹²⁹ Her desired right to exclude others would include selling bumper stickers that read “TAKE AMERICA BACK AGAIN TRUMP 2024,” as she applied for a federal trademark over it in August 2022.¹³⁰ Arguably, according to the logic of the Federal Circuit, Daphne McKee might deserve the free speech right to own the mark “TAKE AMERICA BACK AGAIN TRUMP 2024,” not Donald Trump. But what happens if McKee’s mark is registered and Trump infringes on McKee’s mark when he sells bumper stickers that contain similar language as he expresses his own speech? McKee might then have a cause of action to sue Trump for federal trademark infringement—over his use of his own name and likeness.

3. *Putting the Holding Together*

There are many moving parts in the *Elster* decision. Not only did the Federal Circuit silence more free speech than it fostered by allowing *Elster* to pursue “TRUMP TOO SMALL” as a federal trademark, but it also incorrectly applied broad viewpoint-based rules into a content-based free speech case. The court also misapplied parody and criticism concerns that are lessened in a primarily commercial enterprise, bringing about a result that ignored the prevailing commercial speech theory and balance between expression and commercial advantage. Worse than that was the subduing of the traditional strict scrutiny test. Instead of framing the question as analyzing the First Amendment concerns involved in criticizing government officials, the Federal Circuit should have properly analyzed whether protecting someone’s identity from commercial misappropriation was a compelling interest before analyzing whether § 1052(c)’s consent was a narrowly tailored means to achieve that end.

E. The History of Identity as a Compelling Interest

In a proper analysis of a content-based restriction on speech, a court is meant to apply strict scrutiny and analyze whether the government regulations are narrowly tailored to serve a government interest.¹³¹ In *Elster*, the Federal Circuit first framed the interests at stake as First Amendment criticism of the government.¹³² The court went on to mention the two government interests, protecting the right of privacy and protecting the right of publicity, and ultimately held the First Amendment interests outweighed any asserted government interest.¹³³ The first question the court should have asked was whether protecting one’s identity from commercial misappropriation in § 1052(c) is a compelling governmental interest. This is the damage inflicted on

¹²⁸ U.S. Trademark Application Serial No. 97/673,805 (filed Nov. 11, 2022).

¹²⁹ U.S. Trademark Application Serial No. 97/555,027 (filed Aug. 18, 2022).

¹³⁰ *Id.*

¹³¹ *Matal v. Tam*, 137 S. Ct. 1744, 1749 (2017); *Reed v. Town of Gilbert*, 576 U.S. 155, 163 (2015).

¹³² *In re Elster*, 26 F.4th 1328, 1334 (Fed. Cir. 2017).

¹³³ *Id.* at 1335–38.

Trump through the registration of Steve Elster's mark. Since Steve Elster has the potential right to trademark "TRUMP TOO SMALL" on shirts, not only might Trump be barred from doing the same thing on clothing, but no one else in the nation would be able to infringe either,¹³⁴ creating a holding that might limit the amount of criticism towards Trump while trying to foster more of it.

1. Publicity Rights as a Compelling Interest

Protecting one's identity from misappropriation is a compelling governmental interest. Not only does this interest limit confusion from taking place,¹³⁵ but it also protects innocent parties that have achieved fame or status from having their goodwill or publicity attached to their name stolen from them for commercial gain.¹³⁶ The Supreme Court has held that the policy "for (protecting the right of publicity) is the straightforward one of preventing unjust enrichment by the theft of good will. No social purpose is served by having the defendant get some free aspect of the plaintiff that would have market value and for which he would normally pay."¹³⁷ In many of these cases, the question is over whether a state law respecting publicity rights constitutes an unconstitutional abridgement of free speech, sometimes in the context of entertainment, reporting news of the publicity, or publication.¹³⁸ Such purely expressive speech is viewed as the most protectable, as compared to commercial speech, which receives less.¹³⁹ Section 1052(c) protects a famous individual from having their name misappropriated by others for commercial gain.¹⁴⁰ Protecting that interest through § 1052(c) preserves the policy of allowing a person to use their own identity as they see fit, and without that interest protected in *Elster*, famous people may have their likeness or name co-opted or controlled by others for commercial gain, just because they have a free speech right to criticize. This free speech interest can be expressed with or without a federal trademark registration.

Part of the Federal Circuit's opinion that strikes the most at odds with the concept of identity and publicity is the statement that "[n]o plausible claim could be or has been made that the disputed mark suggests that President Trump has endorsed Elster's product."¹⁴¹ Elster's shirt makes fun of Trump, insinuates something about him, and likely offends Donald Trump personally. Since the mark is critical and offensive, the court claimed that there is no way anyone could ever suggest that Trump endorsed Elster's product.¹⁴² Not only is offensiveness not a defense in a right of publicity action, but taking control of an offensive term directed at you was the critical fact in *Matal v. Tam*.

¹³⁴ See, e.g., *Matal*, 137 S. Ct. at 1753; 15 U.S.C. § 1052(d).

¹³⁵ See generally *Elster*, 26 F.4th at 1336–38.

¹³⁶ See generally *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 565 (1977).

¹³⁷ *Zacchini*, 433 U.S. at 576 (quoting Harry Kalven, *Privacy in Tort Law Were Warren and Brandeis Wrong?*, 31 LAW & CONTEMP. PROB. 326, 331 (1966)).

¹³⁸ *Id.* at 573–78.

¹³⁹ *Matal v. Tam*, 137 S. Ct. 1744, 1749 (2017).

¹⁴⁰ *Hot Stuff Foods, LLC v. Mean Gene's Enters., Inc.*, 468 F. Supp. 2d 1078, 1089–91 (D.S.D. 2006).

¹⁴¹ *In re Elster*, 26 F.4th 1328, 1336 (Fed. Cir. 2017).

¹⁴² *Id.*

In *Matal*, an Asian-American singer attempted to register their band name “THE SLANTS” as a federal trademark.¹⁴³ The singer, Simon Tam, “chose this moniker in order to ‘reclaim’ and ‘take ownership’ of stereotypes about people of Asian ethnicity.”¹⁴⁴ The entire case of *Matal* surrounds the defense of a registrant attempting to trademark something personally offensive towards them in order to take back its control. Perhaps Donald Trump could use the mark to make fun of himself. Perhaps he could use the mark to make light of his opponent’s attempts to bring him down. Perhaps making money off a derogatory quote against him is a shrewd business move. Trump need not come up with a reason in order to use his own name—it is his name, and he is allowed to use it as he sees fit. Protecting that right not just for Trump but for all those whom § 1052(c) applies is a compelling interest, and the Federal Circuit failed when it did not acknowledge it as such.

F. Proposal

The Federal Circuit erred in holding that § 1052(c) was unconstitutional as-applied to the “TRUMP TOO SMALL” trademark.¹⁴⁵ This paper suggests a proposal to provide consistency to the Supreme Court and other courts that will likely take on a challenge to § 1052(c): under a proper *Central Hudson* test, § 1052(c) is a constitutional content-based restriction on commercial speech. Even if the Supreme Court were to ignore the commercial aspect and attempt to put § 1052(c) through strict scrutiny, it passes that review because protecting a famous person’s identity from being misappropriated for commercial purposes is a compelling governmental interest, and asking for permission before obtaining federal trademark rights is the least restrictive means to achieve that interest.

1. *Implementing Central Hudson in Elster*

The Supreme Court has left the door open to whether trademarks constitute commercial speech.¹⁴⁶ If a trademark is commercial speech (whether as a whole or on a case-by-case basis), restrictions on that speech fall under the “relaxed scrutiny” of *Central Hudson*.¹⁴⁷ According to the Supreme Court:

“At the outset, we must determine whether the expression is protected by the First Amendment. For commercial speech to come within that provision, it at least must concern lawful activity and not be misleading. Next, we ask whether the asserted governmental interest is substantial. If both inquires yield positive answers, we must determine whether the regulation directly advances the governmental interest asserted, and whether it is not more extensive than is necessary to serve that interest.”¹⁴⁸

¹⁴³ *Matal*, 137 S. Ct. at 1751.

¹⁴⁴ *Id.* at 1754.

¹⁴⁵ *See Elster*, 26 F.4th at 1339.

¹⁴⁶ *See Matal*, 137 S. Ct. at 1763 (“[W]e must confront a dispute between the parties on the question whether trademarks are commercial speech . . .”).

¹⁴⁷ *Id.*

¹⁴⁸ *Bd. of Tr. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 475 (1989) (quoting *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y.*, 447 U.S. 557, 566 (1980)).

Before analyzing the prongs of *Central Hudson*, the speech at issue must be commercial. Commercial speech is speech that “propos[es] a commercial transaction, which occurs in an area traditionally subject to government regulation.”¹⁴⁹ The evidence with Elster’s speech weighs heavily towards commercial speech. The value in the expression and the attempts to federally register were commercial in nature, like the benefits conferred onto Elster by the federal register.¹⁵⁰ The very nature of a trademark is to identify a mark of a business entity that takes part in a commercial transaction.

The first prong of the *Central Hudson* test is determining whether the speech concerns a “lawful activity”¹⁵¹ and is not “misleading.”¹⁵² While Elster’s mark constitutes a lawful activity (selling t-shirts), his activity arguably immediately fails because it misleads as to source—the same reason why the Federal Circuit should have held he violated Trump’s right of publicity. However, assuming the use of “TRUMP TOO SMALL” may cause *confusion* but not be *misleading*, the second prong asks whether the asserted government interest is substantial.¹⁵³ Protecting intellectual property rights from being misappropriated by others is a compelling governmental interest, not just a substantial one. Entire state codes and decades of state and federal cases have upheld the right of publicity and the interest protected within.¹⁵⁴ This logic satisfies the compelling interest of strict scrutiny should *Central Hudson* not apply.

The next prong is to determine whether § 1052(c) directly advances the interests it purports to protect,¹⁵⁵ which it does plainly by prohibiting registration of a mark that contains a famous person’s name, something that restricts the public’s ability to co-opt someone’s name for their commercial benefit.¹⁵⁶ The final determination is whether the regulation is not more extensive than necessary.¹⁵⁷ This too is satisfied by the consent portion of § 1052(c), because the only requirement to use someone’s name is to ask for permission, and nothing further.¹⁵⁸ There is no more narrow way to limit the use of a person’s name than asking the person if the use is acceptable to them—the one who would be commercially disadvantaged by the monopoly conferred onto the other person. Alternatively, this logic satisfies the second element in the strict scrutiny analysis because the means of requesting a person’s approval is

¹⁴⁹ *Cent. Hudson*, 447 U.S. at 562 (quoting *Ohralik v. Ohio State Bar Ass’n.*, 436 U.S. 447, 455–56 (1978)).

¹⁵⁰ *See Elster*, 26 F.4th at 1329–32.

¹⁵¹ *Cent. Hudson*, 447 U.S. at 566.

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *See, e.g., Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 565–66 (1977); *Melendez v. Sirius XM Radio, Inc.*, 50 F.4th 294, 299 (2d Cir. 2022).

¹⁵⁵ *Cent. Hudson*, 447 U.S. at 566.

¹⁵⁶ *See* 15 U.S.C. § 1052(c); *see also In re ADCO Indus. Techs., L.P.*, 2020 WL 730361, at *10 (T.T.A.B. Feb. 11, 2020).

¹⁵⁷ *Cent. Hudson*, 447 U.S. at 566.

¹⁵⁸ 15 U.S.C. § 1052(c).

a narrowly tailored means to satisfy the government's interest, should *Central Hudson* not be applied.

IV. Conclusion

In conclusion, the Court of Appeals for the Federal Circuit erred when it held that 15 U.S.C. § 1052(c) was an unconstitutional abridgment of free speech as-applied when the USPTO silenced "TRUMP TOO SMALL." The court misapplied viewpoint-based restrictions on speech from *Matal* and *Brunetti* and applied them to a narrowly tailored, content-based restriction. Protecting one's identity from commercial misappropriation, and protecting one's right of publicity, are compelling interests for the government to pursue because it protects consumers from misunderstanding and misidentifying the source of goods and protects the goodwill of those who have achieved fame. The Federal Circuit did not properly apply any standard of review, choosing instead to create a free speech balancing test that leaned heavily towards concerns that were not present to Elster's free speech rights. When § 1052(c) is challenged again, the commercial speech framework in *Central Hudson* should apply to the Lanham Act's content-based restrictions, but because the interests in § 1052(c) are compelling and narrowly tailored, they will pass strict scrutiny review as well. In either case, § 1052(c), both on its face and as-applied to Elster, is constitutional. By giving Steve Elster the potential ability to register "TRUMP TOO SMALL," the Federal Circuit silenced more speech than it fostered.