

Supreme Court Upholds Refusal to Register Trademark Containing the Name of Living Individual

In a recent unanimous decision in the case *Vidal v. Elster* (602 U.S. ____ (2024)), the U.S. Supreme Court upheld the refusal to register a federal trademark for the phrase “Trump Too Small” based on the fact that the Lanham Act prohibits the registration of the name of a living individual without their consent. The plaintiff in this case, Mr. Elster, filed a federal trademark application in 2018 for the mark “TRUMP TOO SMALL” for use on clothing as shown below, without the prior consent of former President Trump, arguing that the phrase was intended to be a criticism of Donald Trump and his policies and that the refusal was a violation of Mr. Elster’s First Amendment right of free speech. Mr. Elster claimed he wanted to register the mark to convey a political message about the former president.



The Supreme Court reviewed the matter based on the initial refusal to register issued by the United States Patent & Trademark Office, which was then appealed to the U.S. Court of Appeals for the Federal Circuit, who overturned the refusal holding that barring registration of “Trump Too Small” under a provision of federal trademark law unconstitutionally restricted free speech. The Court’s ruling upholds the “living-individual rule” established under the Lanham Act which requires the consent of the living individual prior to registration. Specifically, “No trademark ... shall be

refused registration ... on account of its nature unless it...[c]onsists of or comprises a name, portrait, or signature **identifying a particular living individual except by his written consent...**" 15 U.S.C. §1052(c). Proponents of the law, including the International Trademark Association, argue that this provision of trademark law is consistent with the concepts of the right of publicity and privacy, and assists in preventing the unauthorized use of individuals' names in commercial contexts. In explaining the rationale for the decision, Justice Thomas wrote: "This Court has long recognized that a trademark protects the markholder's reputation, and the connection is even stronger when the mark contains a person's name," and further stated, "This history and tradition is sufficient to conclude that the names clause — a content-based, but viewpoint-neutral, trademark restriction — is compatible with the First Amendment."

It is worth noting the Court's decision does not affect the ability of Mr. Elster to offer goods or services under any particular name or brand – in fact, Mr. Elster's T-shirts bearing the phrase "Trump Too Small" are still available online for \$24.99, even though his trademark application was refused. But the ruling does uphold the prohibition of seeking and obtaining federal trademark protection where the mark contains the name of a living individual without their consent. This ruling from the Supreme Court joins a string of other First Amendment challenges to provisions of the Lanham Act, the main statute governing trademarks. The high court in 2017 **struck down a section** of the law that barred registration of disparaging marks and **did the same** for a provision prohibiting immoral or scandalous marks in 2019.

The key takeaway from this narrowly tailored decision is that, prior to seeking federal trademark protection for a mark containing the name of a living individual, consent from that individual must be obtained. In the context of protecting a name or brand focused on a living individual, or in the continuation of such use post-merger or other transaction, it is important to ensure that the consent of the living individual is secured in some manner.