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# *Tiny Hands, Tremendous Trademark Trouble: Analyzing the Legal Fallout of the TRUMP TOO SMALL Trademark Controversy*

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## **Introduction**

The First Amendment to the United States Constitution provides that “Congress shall make no law . . . abridging the freedom of speech.”<sup>1</sup> But is the right to freedom of speech absolute? The United States Supreme Court in a series of foundational decisions has made clear that there are constraints on this constitutional guarantee. Incitement of illegal activity, obscenity, and true threats are all categories of speech that are not within the bounds of the First Amendment’s protection.<sup>2</sup>

While these previous decisions have concerned matters of safety and prurient interests, what happens when Congress enacts legislation that prohibits registration of a trademark bearing the name of a person? The answer to that question was decided by Steve Elster’s efforts to register the mark, “Trump too small,” which included the name of a former United States President.

## **The Inspiration, The Application, and The TTAB Decision**

### **The Exchange that Caused the Controversy**

During the 2016 GOP primary season, then presidential-hopeful, Senator Marco Rubio had been hit with a flurry of attacks from then GOP poll-leader, and eventual GOP nominee, Donald Trump. While on the campaign trail, hoping to chip away at Trump’s lead in the polls, Rubio addressed a rally of supporters. Rubio acknowledged his shorter stature compared to Trump, but hit back with the comment “I don’t understand why his hands are the size of someone who’s five-two, have you seen his hands? And you know what they say about men with small hands, you can’t trust them.”<sup>3</sup>

Shortly thereafter, during a March 3, 2016, GOP primary debate, Trump responded to Rubio’s comments by showing off the size of his hands for the audience to see.<sup>4</sup> Trump went on to secure enough delegates to win the GOP primary,<sup>5</sup> and eventually the 2016 presidential election.<sup>6</sup> This exchange prompted Steve Elster, a politically active Democrat, to take action. Elster described the debate moment as “so far beneath any topic for a presidential debate.”<sup>7</sup> In a hope to spread the message of Trump’s diminutive policies, Elster started selling t-shirts that said, “Trump too small.”<sup>8</sup>

### **The Application and The Examining Attorney’s Decision**

On January 10, 2018, Steve Elster filed a trademark application with the United States Patent and Trademark Office for the mark “Trump too small” to be used for

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articles of clothing, specifically shirts.<sup>9</sup> The Examining Attorney refused registration of Elster's mark under Section 2(a) and Section 2(c) of the Trademark Act.<sup>10</sup> Section 2(a) of the Trademark Act provides that a trademark will not be refused registration unless it comprises matter that falsely suggests a connection with a person, living or dead.<sup>11</sup> Section 2(c) of the Trademark Act provides that a trademark will not be refused registration unless it comprises a name, portrait, or signature of a living individual without their written consent.<sup>12</sup> Section 2(c) has also been understood to apply when a proposed mark includes a particular living individual's surname if that individual happens to be known by that surname alone.<sup>13</sup> Elster asserted a First Amendment defense to both grounds for refusal, to which the Examining Attorney rejected.<sup>14</sup> Elster appealed this decision to the Trademark Trial and Appeal Board (TTAB).

## The TTAB Decision

On appeal, the TTAB only reviewed the Examining Attorney's refusal under Section 2(c). The TTAB began its analysis by stating the key purpose of the names clause and its consent to use requirement: "to protect rights of privacy and publicity that living persons have in the designations that identify them" and to protect consumers "against source deception."<sup>15</sup> In situations where the name sought to be registered would not be recognized as identifying a particular individual,

Section 2(c) has been interpreted to mean that when a name appears in a proposed mark, the written consent of the person with that name must be supplied where: (1) the public would reasonably assume a connection between the individual and the goods or services because the individual is so well known; or (2) the individual is publicly connected with the business in which the mark is used.<sup>16</sup>

The TTAB explained that there is significant evidence to support the conclusion that the public would understand that "Trump" alone is a reference to Donald Trump.<sup>17</sup> Donald Trump has been in the limelight for decades, as a real estate developer with buildings *donning* the "TRUMP" name in flashy gold or silver, as the host of NBC's *The Apprentice*, and for his many business ventures including Trump golf courses, Trump University, and Trump casinos.

Elster acknowledged that his mark "explicitly refers to declared presidential candidate and President Donald Trump" and that he did not obtain written consent from Trump.<sup>18</sup> However, Elster advanced the argument that his mark is the "antithesis of what consumers would understand to be sponsored by, approved by, or supported by

Donald Trump."<sup>19</sup> There would be no confusion as to whether Trump would associate or endorse a mark that disparages his "celebrity status."<sup>20</sup>

This argument was rejected by the TTAB. The Board explained that Elster misunderstood the test for Section 2(c); it is not whether the public would perceive the mark as something the individual would endorse, but rather it is whether the public would perceive the name in the proposed mark as identifying a particular living individual, something Elster had conceded.<sup>21</sup> Here, a President of the United States is a well-known individual. Trump's holding of political office combined with his business ventures further cements his name being a well-known commodity. Because a connection existed for purposes of Section 2(c), the TTAB did not inquire into a Section 2(a)-type connection that Elster had suggested.<sup>22</sup>

Elster also asserted a constitutional challenge to Section 2(a) and Section 2(c) alleging that refusal to register amounted to violations of the First Amendment's guarantee of freedom of speech as content-based restrictions on private speech.<sup>23</sup> Elster argued that strict scrutiny was not met because the registration bar was not narrowly tailored to a compelling government interest.<sup>24</sup> Additionally, he also argued that former or current presidents, as well as hopeful presidential candidates, relinquish rights of privacy when running or holding office.<sup>25</sup>

This argument was quickly dismissed by the TTAB who stated that Section 2(a) and Section 2(c) are both viewpoint-neutral and that Congress was well within its authority to enable restrictions on "certain types of source-identifiers as being particularly susceptible to deceptive use."<sup>26</sup> These provisions acknowledge the "right of privacy and publicity that a living person has in his or her identity," and they shield consumers from source deception.<sup>27</sup> The TTAB also held that even if Section 2(c) was subject to heightened scrutiny, the provision is narrowly tailored to two compelling government interests: protecting the named individual's rights of privacy and publicity and protecting consumers against source deception.<sup>28</sup>

Thus, because Elster did not obtain the written consent of Trump, the TTAB affirmed the Examining Attorney's decision to refuse registration of Elster's mark.

## Reversal at the Federal Circuit

Elster appealed the TTAB's decision to the United States Court of Appeals for the Federal Circuit (Federal Circuit). On February 24, 2022, the Federal Circuit reversed the TTAB's decision to affirm the Examining Attorney's refusal to register Elster's mark.

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The Federal Circuit first noted that in the previous five years of Supreme Court precedent, only two provisions of Section 2 of the Trademark Act were held to be unconstitutional.<sup>29</sup> The first involved the USPTO denying registration under Section 2(a) for a mark that “disparage[d] . . . or [brought] . . . into contempt[] or disrepute” any “persons, living or dead.”<sup>30</sup> The mark sought to be registered was initially denied registration on the grounds that the mark was disparaging towards persons of Asian descent.<sup>31</sup> In a unanimous eight-justice opinion, the Supreme Court held that denying registration was a violation of the First Amendment’s guarantee of freedom of speech based on viewpoint discrimination.<sup>32</sup> The second case also involved the USPTO denying registration under Section 2(a) for a mark that consisted of “immoral . . . or scandalous matter.”<sup>33</sup> The mark sought to be registered was initially denied on the grounds that the mark contained a phonetic closeness to an expletive.<sup>34</sup> In a six to three opinion, the Supreme Court, again, held that denying registration was a violation of the First Amendment’s guarantee of freedom of speech based on viewpoint discrimination.<sup>35</sup> While neither case involves a content-based, viewpoint-neutral restriction, both stand for the proposition that trademarks are “private, not government, speech” that is afforded First Amendment protection.<sup>36</sup>

On appeal, the government made two arguments to support its decision to refuse registration of Elster’s mark. The first argument advanced was that trademark protection was comparable to a government subsidy, and thus was not subject to First Amendment strict scrutiny so long as viewpoint discrimination is not involved.<sup>37</sup> The Federal Circuit noted that while dissenting opinions in prior case law suggested that trademark registration might be viewed as a condition on a government benefit, Justice Alito’s opinion in *Matal v. Tam* stated that trademark registration is “nothing like government subsidy programs.”<sup>38</sup> Moreover, when the issue of whether trademarks are a government subsidy was previously before the Federal Circuit, the Court consistently held them to not be.<sup>39</sup> Therefore, the Federal Circuit rejected the government’s first argument.<sup>40</sup>

The government then argued that restrictions imposed by the Trademark Act were equivalent to speech restrictions in a limited public forum.<sup>41</sup> Again, the Federal Circuit found this argument to be unpersuasive. The Federal Circuit noted that while a limited public forum need not be a physical location, restrictions in metaphorical forums “were always ‘tethered to government properties’ where the effects were later felt.”<sup>42</sup> The Court explained that this case was not one in which the government had restricted speech on its own property to certain groups or subjects.<sup>43</sup> Rather, by denying registration of Elster’s mark, the government had “chill[ed] speech

anywhere from the Internet to the grocery store.”<sup>44</sup> Because of the decision to not treat the trademark registration bar in the same context, the restriction on the speech was thus entitled to greater scrutiny.<sup>45</sup>

The Federal Circuit noted that expressive speech is not “entitled to a lesser degree of protection because it is printed on a T-shirt.”<sup>46</sup> “To the contrary, the First Amendment ‘has its fullest and most urgent application’ to speech concerning public officials. Laws suppressing the right ‘to praise or criticize governmental agents’ generally cannot be squared with the First Amendment.”<sup>47</sup>

After determining that the names clause is entitled to heightened scrutiny, the Federal Circuit then looked to whether a privacy interest or a publicity interest constituted a compelling governmental interest.

## A Privacy Interest

The first interest asserted by the government is the claimed right of privacy. The Federal Circuit notes that “there can be no plausible claim that President Trump enjoys a right of privacy protecting him from criticism in the absence of actual malice—the publication of false information ‘with knowledge of its falsity or in reckless disregard of the truth.’”<sup>48</sup> Moreover, “[t]he government cites no case authority or treatise that recognizes such an interest, and there is no claim here of actual malice. In such circumstances, when the restricted speech comments on or criticizes public officials, the government has no interest in disadvantaging the speech to protect the individual’s privacy interests.”<sup>49</sup> The Federal Circuit concluded that “the government has no legitimate interest in protecting the privacy of President Trump, ‘the least private name in American life’ from any injury to his ‘personal feelings’ caused by the political criticism that Elster’s mark advances.”<sup>50</sup>

## A Publicity Interest

The second interest asserted by the government is the claimed right of publicity. “The government, in protecting the right of publicity, also has an interest in preventing the issuance of marks that falsely suggest that an individual, including the President, has endorsed a particular product or service. But that is not the situation here.”<sup>51</sup> This right to publicity is not justified because the mark is critical of a public official without their consent. If this were permitted, The Federal Circuit noted that:

“[C]elebrities with control over the parodic use of their identities would not use the power to ‘ration the use of their names in order to maximize their value over time.’ . . . They would instead use that power to suppress criticism, and thus permanently

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remove a valuable source of information about their identity from the marketplace.”<sup>52</sup>

This publicity interest does not overcome the First Amendment protection to comment on political matters, and thus does not satisfy heightened scrutiny.<sup>53</sup> The Federal Circuit held that, as applied, Section 2(c) of the Trademark Act involved content-based discrimination that did not overcome either strict scrutiny or intermediate scrutiny.<sup>54</sup> Thus, the Federal Circuit reversed the TTAB’s decision.<sup>55</sup> The Federal Circuit also noted that Section 2(c) raised concerns regarding overbreadth but decided to leave that issue for another day.<sup>56</sup>

## Another Reversal at the Supreme Court

The United States Supreme Court ultimately reversed the Federal Circuit’s decision.<sup>57</sup> The opinion began with a history of recent trademark cases before the Supreme Court involving First Amendment issues. In a unanimous opinion, the Justices in *Matal v. Tam* agreed that a viewpoint-based bar to registration involving a mark that was offensive to those of Asian descent violated the First Amendment.<sup>58</sup> In *Iancu v. Brunetti*, a bar to registration involving marks that contained immoral or scandalous subject matter also violated the First Amendment.<sup>59</sup> However, unlike those decisions, the names clause does not discriminate based on any viewpoint.<sup>60</sup> Instead, it is a content-based, viewpoint-neutral restriction.<sup>61</sup>

The Court then turned its analysis to the history of trademark law. It noted, “[t]he protection of trademarks under English law was an inherently content-based endeavor.”<sup>62</sup> Initially, rather than being protected by federal legislation, trademark law was governed within “the province of the States” for the 18th and most of the 19th century.<sup>63</sup> Furthermore, early in the nation’s history, commerce was primarily local and thus, consumers were aware of the source of goods.<sup>64</sup>

It was not until the latter part of the 19th century when Congress enacted the first federal trademark law.<sup>65</sup> This act continued the established content-based nature of trademark law. It was during this time that “American commerce became more national in character, and . . . Although States retained their important role, ‘Congress stepped in to provide a degree of national uniformity’ for trademark protection.”<sup>66</sup> From its common law roots to the passage of the Lanham Act in 1946, trademark law has required these content-based distinctions.<sup>67</sup> However, although there have been restrictions on what marks are able to be registered, “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.”<sup>68</sup> Thus, the Court held that a content-based bar to trademark registration need not always be evaluated under a heightened level of scrutiny.<sup>69</sup>

Following a discussion of the common law and legislative history of trademark law, the Court then explained the history and tradition of trademark law and the use of an individual’s name. The first federal trademark law included a requirement that a trademark contain more than merely a name.<sup>70</sup> Several decades later, federal trademark law emphasized “[t]hat nothing herein shall prevent the registration of a trade-mark otherwise registerable because of its being the name of the applicant.”<sup>71</sup> The Court explained, “[a] man’s name is his own property, and he has the same right to its use and enjoyment as he has to that of any other species of property.”<sup>72</sup> Thus, it is “an elementary principle that every man is entitled to the use of his own name in his own business”<sup>73</sup> and “[t]he notion that people should be able to use their own name to identify their goods or business is deeply rooted in American mores.”<sup>74</sup> Thus, the common law approach to trademarking names protected only a person’s right to use his own name.

Importantly, the Court found no indication that the common law permitted trademark protection for a person seeking to use another living person’s name.<sup>75</sup> The English court system even acknowledged that this could amount to actionable fraud.<sup>76</sup> The Court explained that “[w]hen a person uses another’s mark, ‘the owner is robbed of the fruits of the reputation that he had successfully labored to earn.’ A person’s trademark is ‘his authentic seal,’”<sup>77</sup> and “[i]f another uses it, he borrows the owner’s reputation, whose quality no longer lies within his own control.”<sup>78</sup> This bar also ensures that consumers are not confused as to who is the source of the product.

In reversing the Federal Circuit’s decision, the Court admitted that its decision is narrow.<sup>79</sup> The Court did not outline a framework for determining whether all content-based, viewpoint-neutral trademark restrictions are constitutional.<sup>80</sup> Nor did the Court hold that a history and tradition approach is required to uphold a content-based trademark registration bar.<sup>81</sup> The Court held only that the names clause in §1052(c) does not violate the Free Speech clause of the First Amendment.<sup>82</sup>

## Implications

While the Court’s holding is narrow, it does provide an answer to the question of how to address a content-based, viewpoint-neutral trademark registration bar that has an established history and tradition. However, without a framework to address and resolve future constitutional



questions involving trademark law that do not have this prominent history and tradition, the Court arguably leaves future litigators questioning what the best way is to advocate. Should the argument apply fundamental First Amendment precedent and trademark law? Or should

the argument rely on possibly shaky historical analogues and tradition? It is possible that while trademark law aims to prevent consumer confusion, the *Vidal v. Elster* decision has simultaneously created advocate confusion. Only time will tell.

1. U.S. Const. amend. I.
2. See e.g., *Brandenburg v. Ohio*, 395 U.S. 444 (1969); *Roth v. United States*, 354 U.S. 476 (1957); *Counterterman v. Colorado*, 600 U.S. 66 (2023).
3. Purple Merica, *Marco Rubio says Donald Trump Has Small Hands*, YouTube, Feb. 29, 2016, <https://www.youtube.com/watch?v=Im675r1k0Yg>.
4. Gregory Krieg, *Donald Trump defends size*, CNN, March 4, 2016, <https://www.cnn.com/2016/03/03/politics/donald-trump-small-hands-marco-rubio/index.html>.
5. *2016 Presidential Primaries Results*, Politico, Dec. 13, 2016, <https://www.politico.com/2016-election/primary/results/map/president/>.
6. *2016 Presidential Election Results*, The New York Times, Aug. 9, 2017, <https://www.nytimes.com/elections/2016/results/president>.
7. *Meet the Labor Lawyer Whose Anti-Trump Slogan Is Now at Supreme Court*, The National Law Journal, June 6, 2023, <https://www.law.com/nationallawjournal/2023/06/06/meet-the-labor-lawyer-whose-anti-trump-slogan-is-now-at-supreme-court/>.
8. *Id.*
9. U.S. Trademark Application Serial No. 87749230 (filed Jan. 10, 2018).
10. *In re Elster*, No. 87749230, 2020 TTAB LEXIS 373, \*2 (T.T.A.B. July 2, 2020).
11. 15 U.S.C. § 1052(a).
12. 15 U.S.C. § 1052(c).
13. *In re Elster*, at \*4.
14. *Id.* at \*10.
15. *Id.* at \*2-3.
16. *Id.* at \*3.
17. *Id.* at \*5.
18. *Id.*
19. *Id.* at \*6.
20. *Id.*
21. *Id.*
22. *Id.* at \*10.
23. *Id.*
24. *Id.*
25. *Id.* at \*10-11.
26. *Id.* at \*13.
27. *Id.*
28. *Id.* at \*13-14.
29. *In re Elster*, 26 F.4th 1328, 1331 (Fed. Cir. 2022).
30. *Id.*
31. *Id.*
32. *Id.*
33. *Id.*
34. *Id.*
35. *Id.*
36. *Id.* (quoting *Matal v. Tam*, 582 U.S. 218, 239 (2017)); see also *Iancu v. Brunetti*, 139 S. Ct. 2294, 2299 (2019).
37. *Id.* at 1332.
38. *Id.*
39. *Id.*
40. *Id.*
41. *Id.*
42. *Id.* at 1333.
43. *Id.*
44. *Id.*
45. *Id.*
46. *Id.*
47. *Id.* at 1334.
48. *Id.* at 1335.
49. *Id.*
50. *Id.*
51. *Id.* at 1336.
52. *Id.* at 1337.
53. *Id.* at 1338.
54. *Id.* at 1338-39.
55. *Id.* at 1339.
56. *Id.*
57. *Vidal v. Elster*, 602 U.S. 286, 311 (2024).
58. *Id.* at 293.
59. *Id.*
60. *Id.*
61. *Id.* at 294.
62. *Id.* at 296.
63. *Id.* at 297 (quoting *Tam*, 582 U.S. at 224).
64. *Id.*; see also R. Bone, *Hunting Goodwill: A History of the Concept of Goodwill in Trademark Law*, 86 B.U.L. Rev. 547, 575 (2006).
65. *Id.* at 298.
66. *Id.* (quoting *Tam*, 582 U.S., at 224 (citing Act of July 8, 1870, §§ 77-84, 16 Stat. 210-212)).
67. *Id.* at 299.
68. *Id.*
69. *Id.* at 300.
70. *Id.* at 304; see also Act of July 8, 1870, § 79, 16 Stat. 211.
71. *Id.*
72. *Id.* at 301 (quoting *Brown Chem. Co. v. Meyer*, 139 U.S. 540, 544 (1891)).
73. *Id.* at 301 (quoting F. Treadway, *Personal Trade-Names*, 6 Yale L. J. 141, 143-144 (1897); see also A. Greeley, *Foreign Patent and Trademark Laws* §138, p. 135 (1899)).
74. *Id.* at 301-302 (quoting B. Pattishall, D. Hilliard, & J. Welch, *Trademarks and Unfair Competition* §2.06 (2001)).
75. *Id.* at 303.
76. *Id.*
77. *Id.* at 306 (quoting *Amoskeag Mfg. Co. v. Spear & Ripley*, 2 Sandf. 599, 606 (NY Super. Ct. 1849)).
78. *Id.* (quoting *Yale Elec. Corp. v. Robertson*, 26 F.2d 972, 974 (CA2 1928) (Hand, J.)).
79. *Id.* at 310.
80. *Id.*
81. *Id.*
82. *Id.*

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