

# SCOTUS Hears Oral Arguments in “Trump too small” Case

November 6, 2023

On November 1, 2023, the Supreme Court of the United States (“SCOTUS”) heard oral argument in *Vidal v. Elster*, an appeal from the Fourth Circuit where the Respondent, Steve Elster, challenged the Trademark Trial and Appeal Board’s (“TTAB”) decision to affirm a United States Patent and Trademark Office (“USPTO”) examiner’s refusal to register the trademark “Trump too small” for use on t-shirts.<sup>[1]</sup> The question presented is whether the refusal to register a mark under 15 U.S.C. § 1052(c) unconstitutionally violates the Free Speech Clause of the First Amendment.

In 2018, Mr. Elster sought to register the phrase “Trump too small” for use on t-shirts and similar items in International Class 25.<sup>[2]</sup> The phrase “Trump too small” references a now infamous exchange between then presidential candidates Donald J. Trump and Florida Senator Marco Rubio during a 2016 debate.<sup>[3]</sup>

The USPTO examiner refused to register the mark, citing 15 U.S.C. § 1052(c).<sup>[4]</sup> This statute prohibits trademark registrations that include a living person’s “name, portrait, or signature” without that person’s written consent. This statute recognizes the right of privacy and publicity that a living person has over their name, likeness, and identity and is meant to protect consumers against source deception.<sup>[5]</sup>

Mr. Elster appealed the examiner’s decision to the TTAB which suspended the appeal at the examiner’s request to allow for further examination.<sup>[6]</sup> The examiner, upon further review, found the mark should also be refused under 15 U.S.C. § 1052(a), which bars the registration of marks that “falsely suggest a connection with persons, living or dead.” The TTAB affirmed the examiner’s refusal to register the mark.<sup>[7]</sup>

Mr. Elster subsequently appealed to the Fourth Circuit, arguing that 15 U.S.C. § 1052(c) and 15 U.S.C. § 1052(a) created an impermissible content-based restriction on speech that violated his First Amendment rights.<sup>[8]</sup> Mr. Elster also argued that the Fourth Circuit should, in reviewing the TTAB’s decision, apply strict scrutiny because neither 15 U.S.C. § 1052(c) nor 15 U.S.C. § 1052(a) was “narrowly tailored to serve a compelling government interest, and that any government interest was outweighed by the First Amendment interest in allowing commentary and criticism regarding a political figure.”<sup>[9]</sup>

The Fourth Circuit reversed the TTAB’s decision, holding that the application of 15 U.S.C. § 1052(c) to support a refusal to register Mr. Elster’s mark unconstitutionally restricted free speech in violation of the First Amendment.<sup>[10]</sup> The Fourth Circuit stated the USPTO’s refusal “to register Elster’s mark [could not] be sustained [under strict

scrutiny review] 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.” [11]

On June 5, 2023, SCOTUS granted the USPTO’s petition for writ of certiorari to review the Fourth Circuit’s decision. [12] The oral argument heard by SCOTUS on November 1, 2023 is available to the public [here](#). A decision in the case is expected by early summer 2024.

SCOTUS’ review of *Vidal v. Elster* is the latest in a series of cases that address First Amendment trademark-related issues. In *Matal v. Tam*, 137 S. Ct. 1744 (2017), SCOTUS held that the disparagement clause of 15 U. S. C. §1052(a), prohibiting federal trademark registration for marks that might disparage any persons, living or dead, was facially invalid under First Amendment protection of speech. In *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019), SCOTUS held 15 U. S. C. §1052(a)’s prohibition on registration of “immoral or scandalous” trademarks violates the First Amendment. The Fourth Circuit, in reviewing Mr. Elster’s claim, recognized that neither *Tam* nor *Brunetti* resolved the question of 15 U. S. C. §1052(c)’s constitutionality.[13]

SCOTUS’ decision in *Vidal v. Elster* will likely create a boundary line of how far First Amendment protections extend into trademark law, specifically where the applicant’s proposed mark contains criticism of a government official or public figure.

Cullen and Dykman’s Intellectual Property team continues to monitor important developments in trademark and copyright law. Should you have any questions about this legal alert, please feel free to contact Karen Levin ( [klevin@cullenllp.com](mailto:klevin@cullenllp.com)) at (516) 296-9110, or Ariel Ronneburger ([aronneburger@cullenllp.com](mailto:aronneburger@cullenllp.com)) at (516) 296-9182.

This advisory provides a brief overview of the most significant changes in the law and does not constitute legal advice. Nothing herein creates an attorney-client relationship between the sender and recipient.

## Footnotes

[1] *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022), cert. granted sub nom. *Vidal v. Elster*, 143 S. Ct. 2579 (2023).

[2] Petition for Writ of Certiorari, available at <https://shorturl.at/cIJOV> (last accessed Nov. 3, 2023).

[3] Kierra Frazier, *Supreme Court to Hear “Trump Too Small” Trademark Case*, <https://www.politico.com/news/2023/06/05/supreme-court-to-hear-trump-too-small-trademark-case-00100187> (last visited Nov. 3, 2023).

[4] Petition for Writ of Certiorari, available at <https://shorturl.at/cIJOV> (last accessed Nov. 3, 2023).

[5] *In Re Adco Indus. - Techs., L.P.*, No. 87545258, 2020 WL 730361, at \*13 (Feb. 11, 2020)

[6] *Id.*

[7] *Id.*

[8] *In re Elster*, 26 F.4th 1328, 1330 (Fed. Cir. 2022), cert. granted sub nom. *Vidal v. Elster*, 143 S. Ct. 2579 (2023).

[9] *Id.*

[10] *Id.* at 1339.

[11] *Id.*

[12] *Vidal v. Elster*, 143 S. Ct. 2579 (2023).

[13] *In re Elster*, 26 F.4th 1328, 1331 (Fed. Cir. 2022), *cert. granted sub nom. Vidal v. Elster*, 143 S. Ct. 2579 (2023).

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