



Right of Publicity

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Prohibition Against Using a Person's Name in a Registered Mark Without Consent Remains Constitutional

On June 13, 2024, the Supreme Court held that the Lanham Act's prohibition on registering trademarks utilizing another person's name without consent was constitutional. In *Vidal v. Elster* 602 U. S. ____ (2024), the Supreme Court reversed the Federal Circuit's ruling that 15 U. S. C. §1052(c), the Lanham Act's "names clause," is unconstitutional. All nine justices concurred in the outcome but have not left a clear guide for analyzing viewpoint-neutral restrictions on speech.

Under the Lanham Act, the USPTO may not register a trademark that "[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent." 15 U. S. C. §1052(c). Steve Elster attempted to register the trademark "TRUMP TOO SMALL" but was refused under this provision because he did not have the consent of former president Donald Trump to use his name as a trademark. Elster appealed the USPTO's refusal to the Federal Circuit claiming that application of the names clause violates his First Amendment rights. The Federal Circuit agreed, holding the provision unconstitutional because even though it was viewpoint-neutral and did not merit heightened

scrutiny, under intermediate scrutiny the government was not able to identify any substantial governmental interest to maintain the prohibition. The Court agreed to review the question of whether this viewpoint-neutral prohibition of trademark registration was constitutional.

When enforcing the First Amendment's freedom of speech protections, the Supreme Court "distinguish[es] between content-based and content-neutral regulations of speech." *National Institute of Family and Life Advocates v. Becerra*, 585 U. S. 755, 766. Although the restriction at issue in this case was content-based, which is presumptively unconstitutional, the Court found that the prohibition does not require any findings towards a particular viewpoint. This is different than the Court's two recent decisions striking down other prohibitions in the Lanham Act based on First Amendment considerations: *Matal v. Tam*, 582 U. S. 218 (marks potentially offensive to a group of people) and *Iancu v. Brunetti*, 588 U. S. 388 (marks containing scandalous or immoral content). The Court in its reasoning drew a distinction between the viewpoint-neutral prohibition of the names clause, and viewpoint-biased prohibitions like those at issue in *Tam* (prohibiting language that "gives offense") and *Brunetti* (prohibiting language that is "immoral" or "scandalous").

The Court then determined that even though the names clause was content-based (though viewpoint neutral), the history and tradition of the trademark system supported the constitutionality of the names clause. Trademarks have

always been analyzed based on their content. The most common rejection for a newly applied for mark, a likelihood of confusion with an already registered mark, inherently requires the reviewer to look at and compare the content of the two marks. Further, the content-based nature of trademark law has always existed in harmony with the First Amendment, which suggests that the Court does not always need to apply heightened scrutiny. The Court ends its historical approach by concluding that "a tradition of restricting the trademarking of names has coexisted with the First Amendment, and the names clause fits within that tradition."

Justice Barrett concurred in the outcome, but criticized the majority's historical approach, and regrets that the Court did not adopt a standard for gauging whether a content-based trademark registration restriction abridges the right to free speech. She would hold that content-based trademark restrictions are permissible if they are reasonable in light of the trademark system's purpose of providing for source identification of goods and services. Adopting this principle would lead to the same outcome in the case, as Justice Barrett notes that the names clause "reflects trademark law's historical rationale of identifying the source of goods." She also points out that the Court is bound to encounter a restriction that does not have a history behind it and will be forced to adopt a test for content-based registration restrictions at that time.

This case is a victory for public figures and their control over their personal branding. Applicants for trademark registration must continue to get clearance before incurring the significant cost of registration when using a living person's name. While this decision is likely to have minimal impact

on most trademark filings, it does come as part of a larger trend of the Court's willingness to address longstanding provisions of the Lanham Act. And should Justice Barrett's prophesy come to pass, this may not be the last word on content-based, viewpoint-neutral restrictions.

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