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LAW BULLETIN MEDIA

Does right to free speech trump trademark law on cheeky T-shirts?

Welcome to today's Intellectual Property Challenge, where we pose a question and you guess the answer.

Question: Can someone trademark another person's name without their consent?

Discussion: In 2018, California attorney Steve Elster applied to register the trademark "Trump Too Small" for shirts in International Class 25.

According to Elster's registration request, the phrase he sought to trademark invokes a memorable exchange between former President Donald J. Trump and Sen. Marco Rubio from a 2016 presidential primary debate, and aims to "convey that some features of President Trump and his policies are diminutive."

The examining attorney for the United States Patent and Trademark Office (USPTO) rejected the application on two grounds.

First, the name "Trump" refers to a living individual who has not given his consent to the use of this name in the trademark. Second, the examining attorney rejected Elster's contention that denying the application infringes on Elster's



IP NEWS CHALLENGE

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First Amendment rights by restricting his speech.

Elster appealed to the Trademark Trial and Appeal Board, which affirmed the rejection. Elster then appealed to the U.S. Court of Appeals for the Federal Circuit.

The Federal Circuit reversed, sending the application back to the USPTO for registration. The Federal Circuit acknowledges that trademarks are private and

not government speech: "Elster's mark is speech by a private party in a context in which controversial speech is part-and-parcel of the traditional trademark function." Speech protected by the First Amendment does not lose its protection because the speech is going to be distributed or sold rather than given away.

Elster's trademark fulfills the major purpose of the First Amendment because it is part of free discussion of governmental affairs. The Federal Circuit also addressed any claims that Trump may have about the use of his name.

As a public figure, Trump cannot claim that the trademark violates his right of privacy or right of publicity when the focus of the speech is protected by the First Amendment.

Answer: A trademark can use the name of a public figure in the exercise of First Amendment Free Speech.

Case Cite: *In re Elster*, 26 F4th 1328 (U.S. Fed. Cir. 2022).

Sur-Reply: This decision builds on the growing trend that puts First Amendment free speech rights at the forefront of trademark protection.