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Trademark Rights and Freedom of Speech: Unpacking the Supreme Court's Ruling in Vidal v. Elster

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The Supreme Court issued its decision in *Vidal v. Elster* this past week. Elster addresses a constitutional challenge to the prohibition on the registration of a mark that "[c]onsists of or comprises a name … identifying a particular living individual except by his written consent." 15 U.S.C. Sec. 1052(c). Elster sought to register the mark "TRUMP TOO SMALL." When that was refused under Section 1052(c), Elster argued Section 1052(c) violates his First Amendment rights. The Supreme Court rejected Elster's challenge.

The Court acknowledges that it has twice addressed trademark restrictions that discriminate based on viewpoint (*Matal v. Tam* and *Iancu v. Brunetti*) and struck those provisions down. The Court explained, however, that it has not addressed content-based, but viewpoint-neutral trademark restrictions. Slip Op. at 6 ("we must now consider for the first time the constitutionality of a content-based—but viewpoint-neutral—trademark restriction"). The Court concludes that Section 1052(c) is a content-based restriction (as many trademark restrictions are). But while content-based restrictions on free speech are typically subject to strict scrutiny (which makes the restriction presumptively unconstitutional), the Court concludes that Section 1052(c) is not subject to such a test. Slip Op. at 11 ("we need not evaluate a solely content-based restriction on trademark registration under heightened scrutiny").

Unfortunately, the Court does not supply a test or framework for other content-based, viewpoint-neutral challenges to trademark restrictions. Slip Op. at 12 ("we do not delineate an exhaustive framework for when a content-based trademark restriction passes muster under the First Amendment"). Instead, the Court concludes that the "history and tradition" of restrictions against registering a mark with another's name is sufficient to conclude that Section 1052(c) is constitutional. Slip Op. at 19 ("A firm grounding in traditional trademark law is sufficient to justify the content-based trademark restriction before us"). The Court "do[es] not opine on what may be required or sufficient in other cases." Slip Op. at 19. As the Court summarizes it, the decision does "not set for a comprehensive framework," nor does it "suggest that an equivalent history and tradition is required to uphold every content-based trademark restriction." Slip Op. at 22. It holds "only that history and tradition establish that the particular restriction before [it], the names clause in Section 1052(c), does not violate the First Amendment." Slip Op. at 22.

While all of the Justices agreed on the constitutionality of Section 1052(c), several concurrences would have adopted a test for assessing the constitutionality of trademark restrictions that are content-based, but viewpoint-neutral. Justice Barrett concluded that "[c]ontent-based criteria for trademark registration do not abridge the right to free speech so long as they reasonably relate to the preservation of the markowner's goodwill and the prevention of consumer confusion." Barrett Concurrence at 8. Justice Sotomayor would adopt a two-step analysis: "First ask whether the challenged provision targets particular views taken by speakers on a given subject. If the trademark registration bar is viewpoint-based, it is presumptively unconstitutional and heightened scrutiny applies; if it is viewpoint-neutral however, the trademark registration bar need only be reasonable in light of the purpose of the trademark system." Sotomayor Concurrence at 5.

Ultimately, the Court's decision today will likely spawn more constitutional challenges. By leaving open

the appropriate framework and testing for First Amendment challenges to viewpoint-neutral trademark restrictions, it is likely we will see this issue raised more frequently in cases.