

Supreme Court Upholds Names Clause in Trademark Law, Emphasizing Historical and Traditional Foundations

WRITTEN BY

Howard J. Shire | Justin W. Tilghman

This article was published in the August 2024 edition of the [Intellectual Property Strategist](#) and [Law.com](#) and is republished here with permission.

In a landmark decision written by Justice Clarence Thomas, the Supreme Court has unanimously upheld the constitutionality of the Lanham Act's provision that prohibits the registration of trademarks consisting of, or comprising the name of, a particular living individual without the individual's written consent. 15 U.S.C. §1052(c) (barring registration for a mark that "[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent . . .") (Names Clause).

The case, *Vidal v. Elster*, 602 U.S. — (2024), centered on Steve Elster's attempt to register the trademark "Trump too small," accompanied by an illustration of a hand gesture, for use on shirts and hats. Elster's application was initially refused by the examiner and then by the Trademark Trial and Appeal Board (TTAB), which cited this section of the Lanham Act. The Federal Circuit reversed this decision, which paved the way for the Supreme Court to grant *certiorari*.

Elster claimed that his use of Donald Trump's name in this context was protected by the First Amendment because it was based on Trump's famous comment about the size of his hands during a 2016 debate among Republican presidential candidates, and was intended as a criticism as to how small (meaning how poor) Trump had been as president. Thus, Elster argued, this statute was unconstitutional as applied to his trademark application.

The Supreme Court's ruling addressed several key points. The Court determined that the Names Clause is not a viewpoint-based regulation. It does not target speech based on the specific motivating ideology or the opinion or perspective of the speaker. Instead, it prohibits registration of all marks that use another person's name without consent, regardless of whether the use is flattering, critical, or neutral.

This statute was found by the Court to be content-based because it applies to particular speech based on the topic discussed or the idea or message expressed. Specifically, it turns on whether the proposed trademark contains a person's name and if the registrant has that person's consent. For the first time, the Court held that a solely content-based restriction on trademark registration need not be evaluated under heightened scrutiny. This decision was informed by the historical coexistence of trademark law and the First Amendment, which suggests that content-based distinctions are an intrinsic feature of trademarks. The Court decided that in evaluating a solely

content-based trademark restriction under the First Amendment, a court can consider its history and tradition. The Names Clause fits within the historical tradition of trademark law, which has always included content-based distinctions to ensure that trademarks function as source identifiers.

The Names Clause was found to be compatible with the First Amendment. The historical tradition of restricting the trademarking of another person's name has coexisted with the First Amendment, and the Names Clause reflects trademark law's historical rationale of ensuring that consumers make no mistake about who is responsible for a product. The Court's decision underscores the importance of content-based distinctions in trademark law to protect the reputation and goodwill of individuals. The Names Clause, which prohibits the registration of trademarks that consist of or comprise the name of a particular living individual without written consent, serves to prevent consumer confusion and protect the individual's goodwill. For instance, imagine a manufacturer trying to register the names of famous athletes, like Derek Jeter and Jorge Posada, for baseball equipment. Without the Names Clause, and assuming these athletes do not own trademark registrations for their names, registration of these names would likely cause consumers to misattribute these products to the athletes, potentially diluting their names' commercial value and reputation. The Names Clause ensures that such trademarks cannot be registered without the individuals' consent, thereby protecting both the consumers and the individuals' reputations.

The Court's reliance on history and tradition as a test for evaluating the constitutionality of the Names Clause is significant. Historically, trademark law has always been content-based, with courts and legislatures making distinctions based on the content of the marks. This historical context supports the Court's decision that content-based trademark restrictions do not necessarily require heightened scrutiny under the First Amendment.

The Supreme Court's decision in *Vidal v. Elster* reaffirms the constitutionality of the Lanham Act's Names Clause, emphasizing the importance of content-based distinctions in trademark law to protect the reputation and goodwill of individuals. This ruling underscores the Court's recognition of the historical and traditional foundations of trademark law in the context of the First Amendment.

RELATED INDUSTRIES + PRACTICES

- [Intellectual Property](#)
- [Trademark + Copyright](#)