

DANGLING THE CARROT OF TRADEMARK REGISTRATION

Brigitte Desnoes[†]

TABLE OF CONTENTS

I.	INTRODUCTION	1274
II.	IN RE ELSTER BACKGROUND	1276
	A. INITIAL PTO REFUSAL.....	1276
	B. TTAB OPINION.....	1278
	1. Purpose of § 2(c).....	1278
	2. In re ADCO Decision.....	1282
	C. FEDERAL CIRCUIT OPINION.....	1283
III.	TRADEMARK REGISTRATION AND THE FIRST AMENDMENT	1284
	A. TRADEMARK REGISTRATION OVERVIEW.....	1284
	B. TAM AND BRUNETTI.....	1287
	1. Matal v. Tam.....	1287
	2. Iancu v. Brunetti.....	1289
IV.	FIRST AMENDMENT FRAMEWORKS	1290
	A. COMMERCIAL SPEECH.....	1293
	1. Overview.....	1293
	2. Analogy to Trademark.....	1296
	B. GOVERNMENT SUBSIDIES AND GOVERNMENT PROGRAMS.....	1298
	1. Overview.....	1298
	2. Analogy to Trademark.....	1299
	C. LIMITED PUBLIC FORUM.....	1299
	1. Overview.....	1299

DOI: <https://doi.org/10.15779/Z38J678Z0T>

© 2023 Brigitte Desnoes.

† J.D. 2024, University of California, Berkeley, School of Law. Thank you to Professor Talha Syed, Professor Sonia Katyal, and my fellow students in the 2022 Law & Technology Writing Workshop. Since this Note was completed in December 2022, the Office of the Solicitor General filed a Petition for Writ of Certiorari with the Supreme Court on January 27, 2023. The Petition was granted on June 5, 2023, and oral argument was heard on November 1, 2023. During oral argument, Justice Kavanaugh and Justice Kagan inquired about and seemingly expressed support for the application of the limited public forum framework to trademark registration. Transcript of Oral Argument, *Vidal v. Elster*, 143 S. Ct. 2579 (2023).

2. <i>Analogy to Trademark</i>	1302
V. PARODIC USE CARVEOUT?	1304
VI. CONCLUSION	1306

I. INTRODUCTION

At the core of the free speech clause of the First Amendment is the idea that the government may not restrict expression that it finds offensive or disagreeable.¹ Such expression includes the Westboro Baptist Church’s picketing at military funerals,² an individual’s wearing a jacket that says “Fuck the Draft,”³ and the burning of the American flag.⁴ Yet the First Amendment does not prevent a state DMV from refusing to approve a specialty license plate that might be offensive to others,⁵ or a city from prohibiting posterage on utility poles.⁶ At the same time, it does prevent a government’s banning tobacco advertising within one thousand feet of schools.⁷ The thread between these cases lies in a convoluted maze of categories and hierarchies that the Supreme Court has developed over the past century in its attempt to balance legitimate governmental and societal interests in speech regulation with the overarching ethos of free expression.

Speech “regulation” that occurs through the process of trademark registration is in limbo in this maze. The United States Patent and Trademark Office (PTO) reviews trademark applications and can refuse registration to marks if they do not meet certain requirements as laid out by Congress in the Lanham Act. How much should we scrutinize the justifications for registration refusal? The Supreme Court has held that the PTO’s refusals to register both “disparag[ing]” and “immoral or scandalous” trademarks were unconstitutional violations of the First Amendment.⁸ Most recently, the Federal Circuit held that the PTO’s refusal to register the trademark TRUMP

1. *Texas v. Johnson*, 491 U.S. 397, 414 (1989) (“If there is a bedrock principle underlying the First Amendment, it is that the Government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.”).

2. *See Snyder v. Phelps*, 562 U.S. 443 (2011) (holding that the picketing church members had a First Amendment right to speak on matters of public concern).

3. *See Cohen v. California*, 403 U.S. 15 (1971) (holding the jacket language protected under the First Amendment).

4. *See Johnson*, 491 U.S. at 414 (holding the right to burn the American flag was protected speech under the First Amendment).

5. *See Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 576 U.S. 200 (2015).

6. *See City Council of Los Angeles v. Taxpayers for Vincent*, 466 U.S. 789 (1984).

7. *See Lorillard Tobacco Co. v. Reilly*, 533 U.S. 525 (2001).

8. *Matal v. Tam*, 137 S. Ct. 1744 (2017); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

TOO SMALL was unconstitutional as well.⁹ According to the trademark applicant, Steve Elster, the mark was political commentary not only about Senator Marco Rubio’s “small hands” insult at a 2016 presidential debate, but also about the “smallness of Donald Trump’s overall approach to governing as president.”¹⁰ The PTO rejected his trademark application under a relatively straightforward provision of the Lanham Act, § 2(c), which states that a trademark shall be rejected if it “identif[ies] a particular living individual except by his written consent.”¹¹ Despite this provision, the court found that the protection of political speech outweighed any government interest in the right of publicity or right of privacy, not least because of Trump’s status as a deeply public figure.¹²

Yet, the Federal Circuit court failed to do what the Supreme Court has painstakingly done for decades in crafting its modern free speech jurisprudence—carefully consider the context of the speech. In *Elster*, the speech in question was not expressed and restricted in a public forum, but in a forum for federal trademark registration. A trademark refused federal registration is not deprived of its status as a trademark, because trademarks arise from use in commerce and exist at common law with or without registration. Nor is the applicant stripped of the ability to use the phrase “Trump Too Small” in any capacity, on merchandise or otherwise. Trademark registration merely provides certain benefits to a trademark owner, primarily through an evidentiary presumption of validity when a mark owner is either defending against or alleging trademark infringement. In practice, the trademark registration system looks a lot like a limited public forum, one of the First Amendment “contexts” in which restricted speech is merely denied certain benefits of occurring in a government provided forum, but not restricted altogether. Examples of forums given this title by the Court include a student-organization forum upon registration with a law school¹³ and an internal school district mail system.¹⁴ In the former case, the Court emphasized that by offering benefits from registering an organization with the school and

9. *In re Elster*, 26 F.4th 1328, 1330 (Fed. Cir. 2022).

10. Response to Office Action of February 19, 2018, U.S. Trademark Application Serial No. 87/749,230 (filed July 7, 2018).

11. 15 U.S.C. § 1052(c).

12. *See In re Elster*, 26 F.4th at 1335. (“With respect to privacy, the government has no legitimate interest in protecting the privacy of President Trump, ‘the least private name in American life,’ from any injury to his ‘personal feelings’ caused by the political criticism that Elster’s mark advances.”).

13. *See* Christian Legal Soc’y Chapter of Univ. of Cal., Hastings Coll. of L. v. Martinez, 561 U.S. 661 (2010).

14. *See* Perry Educ. Ass’n v. Perry Loc. Educators’ Ass’n, 460 U.S. 37 (1983).

complying with the school's policies, the school was "dangling the carrot of subsidy, not wielding the stick of prohibition."¹⁵

With *Elster* and § 2(c) as a backdrop, this Note delves into the theoretical and policy underpinnings of the limited public forum, as well as two other First Amendment frameworks that have been proposed as means through which to analyze trademark registration regulation: regulation of commercial speech and regulation of speech through a government subsidy. First, Part II details the procedural history and trademark issues leading to *In re Elster*. Part III describes the nature of trademark registration and the two cases in which the Supreme Court considered trademark registration in the context of the First Amendment: *Matal v. Tam*¹⁶ and *Iancu v. Brunetti*.¹⁷ Part IV analyzes the aforementioned First Amendment frameworks in the context of trademark registration, landing on the limited public forum as most analogous to registration. Part V then considers and rejects a parodic use carveout.

II. *IN RE ELSTER* BACKGROUND

In this Part, Section II.A sets the stage for the Federal Circuit decision, detailing the PTO's initial refusal of Steve Elster's TRUMP TOO SMALL trademark registration. Section II.B details the TTAB's opinion of Elster's appeal, with sub-Sections II.B.1 and II.B.2 highlighting two foundations of the TTAB's position: the purpose of § 2(c), and an earlier decision, *In re ADCO Industries-Technologies, L.P.*,¹⁸ which dealt with substantially the same issue. Finally, Section II.C details the Federal Circuit's opinion in *Elster*.

A. INITIAL PTO REFUSAL

On January 10, 2018, Steve Elster filed a trademark application with the PTO for the mark TRUMP TOO SMALL for use on shirts.¹⁹ A little over a month later, the PTO responded with a straightforward notice of refusal pursuant to § 2(c) of the Lanham Act.²⁰ Section 2(c) bars the registration of a trademark which "[c]onsists of or comprises a name, portrait, or signature

15. *Christian Legal Soc'y*, 561 U.S. at 683.

16. 137 S. Ct. 1744 (2017).

17. 139 S. Ct. 2294 (2019).

18. *In re ADCO Indus.-Techs., L.P.*, 2020 U.S.P.Q.2d 53786 (I.T.A.B. 2020).

19. TEAS RF New Application, U.S. Trademark Application Serial No. 87/749,230 (filed Jan. 10, 2018).

20. The Trademark Act of 1946—also known as the Lanham Act—is the federal statute that governs federal trademark registration. As will be discussed *infra* Part III.A, registration of a mark pursuant to the Lanham Act does *not* create the existence of trademark, in the way registration of an invention creates the existence of a patent. J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 6:8 (5th ed. 2019).

identifying a particular living individual except by his written consent.”²¹ The PTO determines that a name in a mark “identifies” an individual if (1) the person is so well known that the public would reasonably assume a connection between the person and the goods or services, or (2) the individual is publicly connected with the business in which the mark is used.²² In this case, the PTO noted that the word TRUMP “clearly references” Donald Trump, “the subject of frequent media attention,” and his written consent was not on record.²³

In his initial response to the rejection, Elster stated that the mark was political commentary both about Donald Trump’s refutation of Marco Rubio’s “insinuation that Donald Trump has a small penis” during a March 3, 2016 Republican presidential debate, and the “smallness of Donald Trump’s overall approach to governing as president of the United States.”²⁴ And, in fact, because Trump tried to “repudiate the assertion that his penis is small,” no consumer would reasonably think he sponsored or endorsed the goods accompanied by the trademark.²⁵ After the PTO again straightforwardly refused registration under § 2(c), Elster responded with the argument that the trademark was “core political speech about a political figure.”²⁶ Elster cited *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, a case in which the Tenth Circuit upheld the production of parody baseball cards caricaturing active and former baseball players in spite of the MLB’s claim of players’ rights of publicity.²⁷ The PTO denied the request for reconsideration on the same grounds as prior refusals, adding that the *Cardtoons* case was “misplaced.”²⁸ Elster appealed to the Trademark Trial and Appeal Board (TTAB), after which the PTO amended the refusal on an additional ground under the false

21. 15 U.S.C. § 1052(c).

22. *In re Nieves & Nieves L.L.C.*, 113 U.S.P.Q.2d 1639, 1650 (T.T.A.B. 2015).

23. Office Action Outgoing, U.S. Trademark Application Serial No. 87/749,230 (filed Feb. 19, 2018).

24. Response to Office Action of February 19, 2018, *supra* note 10. See Gregory Krieg, *Donald Trump Defends the Size of His Penis*, CNN (Mar. 4, 2016), <https://www.cnn.com/2016/03/03/politics/donald-trump-small-hands-marco-rubio/index.html> (reporting that Donald Trump stated in the debate, “[Rubio], he referred to my hands, if they’re small, something else must be small. I guarantee you there’s no problem. I guarantee.”); see also Emily Shapiro, *The History Behind the Donald Trump ‘Small Hands’ Insult*, ABCNEWS (Mar. 4, 2016), <https://abcnews.go.com/Politics/history-donald-trump-small-hands-insult/story?id=37395515>.

25. Response to Office Action of February 19, 2018, *supra* note 10.

26. Request for Reconsideration after Final Action & Response to Office Action of July 30, 2018, U.S. Trademark Application Serial No. 87/749,230 (filed Jan. 29, 2019).

27. *Id.* (citing *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 969 (1996)).

28. Request for Reconsideration Denied, U.S. Trademark Application Serial No. 87/749,230 (filed Feb. 25, 2019).

association clause of § 2(a), which bars registration of marks which “falsely suggest a connection with persons, living or dead.”²⁹

Finally, Elster responded on explicit constitutional grounds.³⁰ He stated that the government’s refusal to register a certain trademark was a content-based regulation of private speech, meaning that it is subject to strict scrutiny under the First Amendment.³¹ Strict scrutiny requires the government to prove that a restriction of speech furthers a compelling interest and is narrowly tailored to achieve that interest.³² Elster stated that the government had not articulated a compelling interest in § 2(a), nor was the regulation narrowly tailored.³³

B. TTAB OPINION

On July 2, 2022, the TTAB affirmed the PTO’s § 2(c) refusal, finding it unnecessary to reach the issue of § 2(a)’s false association clause.³⁴ Rather, the TTAB reiterated what the PTO had pointed out—it is not required, as for refusal under § 2(a), that the public perceive an association with or endorsement by the individual identified in a mark.³⁵ Therefore, Elster’s argument that the mark is the “antithesis of what consumers would understand to be sponsored by” Trump was moot.³⁶ On the First Amendment question, the Board cited its own decision in *In re ADCO Industries-Technologies, L.P.*,³⁷ in which it addressed and rejected the same issue. Sub-Sections II.B.1 and II.B.2 delve further into each of these points.

1. Purpose of § 2(c)

The Lanham Act provides that no trademark application that can be distinguished from the goods of others can be denied registration unless it falls under one of the § 2 provisions, including: falsely suggesting a connection with persons, living or dead; consisting of deceptive matter; containing a geographical indication used in connection with wines or spirits which identifies a place other than the origin of the goods; and containing a flag or

29. Motion to Remand, U.S. Trademark Application Serial No. 87/749,230 (filed May 31, 2019); Office Action Outgoing, U.S. Trademark Application Serial No. 87/749,230 (filed June 24, 2019); 15 U.S.C. § 1052(a).

30. Response to Office Action of June 24, 2019, U.S. Trademark Application Serial No. 87/749,230 (filed Sept. 9, 2019).

31. *Id.* at 3.

32. *Id.* (citing *Reed v. Town of Gilbert*, 135 S. Ct. 2218, 2227 (2015)).

33. *Id.*

34. *In re Elster*, Serial No. 87/749,230 (T.T.A.B. July 2, 2020).

35. *Id.* at 5.

36. *Id.*

37. 2020 U.S.P.Q.2d 53786 (T.T.A.B. 2020).

coat of arms of the United States, any state or municipality, or any foreign nation.³⁸ The Lanham Act defines a trademark as a designation used to “identify and distinguish” goods from those sold by others,³⁹ and the test for protection of a trademark is “likelihood of confusion” by consumers.⁴⁰ The false association and deception clauses of § 2(a) perhaps flow intuitively based on these purposes, but some § 2 provisions bar registration for reasons beyond preventing likelihood of confusion. For example, the bar on certain geographic indications for wines and liquors came from the Uruguay Round Agreements Act, which implemented the international trade agreement that created the World Trade Organization (WTO); the restrictions do not require proof that the trademark is false or misleading.⁴¹

In addition, § 2(c) captures rights outside the bounds of likelihood of confusion but recognized at common law—namely, the rights of privacy and publicity.⁴² The provision provides that registration of a trademark is allowed unless it “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.”⁴³ While drafting the Act, one House member noted of the President clause that “we would not want to have Abraham Lincoln gin,” while another agreed but added that they “would not say the use of G. Washington on coffee should not be permissible.”⁴⁴ Clearly, in 1939, it’s unlikely consumers would have

38. 15 U.S.C. § 1052.

39. 15 U.S.C. § 1127.

40. 2 MCCARTHY, *supra* note 20, § 23:1.

41. *Id.* § 14:40; *see also The Uruguay Round*, WTO, https://www.wto.org/english/thewto_e/whatis_e/tif_e/fact5_e.htm (last visited Dec. 17, 2022). TRIPS art. 23(1) provided that each member shall provide the legal means to “prevent use of a geographical indication identifying wines [or spirits] for wines [or spirits] not originating in the place indicated by the geographical indication . . . even where the true origin of the goods is indicated or the geographical indication is used in translation or accompanied by expressions such as ‘kind,’ ‘style,’ ‘imitation,’ or the like.” For example, it is not necessary that the geographic origin of a wine named ALASKA CHARDONNAY be believed or material to the consumer decision. Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381, 407 n.99 (2016). Nevertheless, Tushnet notes that this “might still be justified on a prophylactic deception-avoidance rationale.” *Id.*

42. *See Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372 (Fed. Cir. 1983) (“[T]here may be no likelihood of such confusion as to the source of goods even under a theory of ‘sponsorship’ or ‘endorsement,’ and, nevertheless, one’s right of privacy, or the related right of publicity, may be violated.”) (discussing 2(a) false association but noting 2(c) “is also of this nature”).

43. 15 U.S.C. § 1052(c).

44. Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents, 76th Cong. 19 (1939) (statement of Thomas E. Roberts, former Comm’r of Patents).

been that more confused about Abraham Lincoln's relationship with a distillery than George Washington's relationship with a coffee roastery. The representatives were articulating something different from likelihood of confusion—possibly what Jennifer Rothman and Robert Post have described as “diminishment.”⁴⁵ In contrast to the harm of confusion of an individual's sponsorship or participation in some commercial venture, which can injure the value of that person's interests whether or not they are famous, “the harm of *diminishment* applies primarily (perhaps exclusively) to those plaintiffs whose identities already possess goodwill in the market,” wherein their identities “may be distinctly vulnerable to damage through overexposure and tarnishment.”⁴⁶

In fact, § 2(c) codifies a long history of common law and statutory protections rooted in a “personality-based understanding of trademark law.”⁴⁷ For example, Rothman cites an 1873 treatise which describes a trademark as “carr[ying] the idea of a man's personality, like his ordinary autograph.”⁴⁸ Given the early use of trade names that were derived from one's identity, trademark was understood to encompass more than merely market-based interests; rather, unauthorized uses of another's name in trade were “also understood as an affront to a person's autonomy interests, their dignity, and their natural right to the fruits of their own labor.”⁴⁹ In 1898, for example, the predecessor to the PTO refused to register “Dewey's Chewies” for confections because George Dewey, a famous Admiral, “was a ‘living celebrity’ who was ‘entitled to protection from the ordinary trader,’” regardless of a prospective consumer's confusion.⁵⁰ The idea of ownership in oneself ultimately led to the common law adoption of the standalone rights of privacy and publicity, which most states recognize today.⁵¹

45. Jennifer Rothman & Robert Post, *The First Amendment and the Right(s) of Publicity*, 130 YALE L.J. 86, 111–12 (2020).

46. *Id.*

47. See Jennifer Rothman, *Navigating the Identity Thicket: Trademark's Lost Theory of Personality, The Right of Publicity, and Preemption*, 135 HARV. L. REV. 1272, 1307 n.167 (2022) (citing Trade-Mark Act of 1905, ch. 592, § 5(b), 33 Stat. 724, 726 (“[N]o portrait of a living individual may be registered as a trade-mark, except by the consent of such individual, evidenced by an instrument in writing . . .”) and the California Act of April 4, 1941, ch. 58, § 14242(g), 1941 Cal. Stat. 703, 705 (precluding registration of a mark that consists of “[t]he portrait of a living person except by consent of the person evidenced by an instrument in writing”)).

48. Rothman, *supra* note 47, at 1295–96 (citing WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS AND ANALOGOUS SUBJECTS § 90 (Boston, Little, Brown & Co. 1873)).

49. *Id.* at 1296.

50. *Id.* at 1308–09 (citing *Ex parte McInnerney*, 85 Off. Gaz. Pat. Off. 148, 149 (1898)).

51. *Id.* at 1297; see also J. THOMAS MCCARTHY, RIGHTS OF PUBLICITY AND PRIVACY § 6:3 (2d ed. 2016).

The right of privacy broadly includes: an intrusion upon one's seclusion or solitude, public disclosure of private facts, publicity which places one in false light, and appropriation of one's name or likeness.⁵² This fourth right has developed into a standalone right of publicity.⁵³ While the former generally is the right "to be let alone," and encompasses a kind of *psychic* protection, the latter protects a famous person's *pecuniary* interest in the commercial exploitation of his identity.⁵⁴

Because a right of privacy or publicity violation is directly tied to one's identity, § 2(c) requires "identification."⁵⁵ If a person is neither "generally known," nor publicly connected to the field relating to the business concerned, then the mark cannot be said to constitute "identification" of a particular person.⁵⁶ The PTO accordingly excludes protection for someone who "coincidentally bears an applied-for name,"⁵⁷ but also recognizes that identification of a person can occur even if it is a name shared by others⁵⁸ or only part of their full name.⁵⁹ In any scenario, an individual who is not well known would have to show that the consuming public connects them with the product, whereas "well-known individuals such as celebrities and world-famous political figures are entitled to the protection of § 2(c) without having to evidence a connection with the involved goods or services."⁶⁰ This results in sometimes obvious work on the PTO's part, for example, to point to news articles to in support of the finding that Donald Trump is "well known by the public."⁶¹ In rejecting a trademark application for OBAMA PAJAMA, the

52. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831 (6th Cir. 1983) (citing William L. Prosser, *Privacy*, 48 CALIF. L. REV. 383, 389 (1960)).

53. *Id.*

54. *Id.*; see also RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46, cmt. b (1995) ("The distinction between the publicity and privacy actions . . . relates primarily to the nature of the harm suffered by the plaintiff; similar substantive rules govern the determination of liability").

55. *Martin v. Carter Hawley Hale Stores, Inc.*, 206 U.S.P.Q. 931, 932–33 (T.T.A.B. 1979).
56. See Trademark Manual of Examining Procedure § 1206.03 (November 2023).

57. *In re Richard M. Hoefflin*, U.S. Trademark Application Serial No. 77/632,391, 97 U.S.P.Q.2d 1174, 1175 (T.T.A.B. 2010).

58. See *In re Steak & Ale Rests. Am., Inc.*, 185 U.S.P.Q. 447 (T.T.A.B. 1975) (affirming refusal to register PRINCE CHARLES for meat, since it identified Prince Charles, a member of the English royal family).

59. See *Ross v. Analytical Tech. Inc.*, 51 U.S.P.Q.2d 1269 (T.T.A.B. 1999).

60. *In re Hoefflin*, 97 U.S.P.Q.2d at 1177.

61. Office Action Outgoing, U.S. Trademark Application Serial No. 87/749,230 (filed July 30, 2018). In *In re Hoefflin*, the TTAB noted that "[t]he Trademark Examining Attorney has done an excellent job marshalling a variety of press excerpts to demonstrate the obvious—namely, that President Barack Obama is extremely well known." *In re Hoefflin*, Serial No. 77/632,391, 97 U.S.P.Q.2d at 8.

TTAB noted that despite the applicant's argument that no one would conclude that President Obama was connected with the brand's pajamas, sleepwear, and underwear, it was "because he is the President of the United States" that § 2(c) applied.⁶² Accordingly, the application was rejected.⁶³ At the same time, although the mark ARNOLD BRAND for fresh tomatoes encompassed the name of an individual named Arnold Brand, a relatively well-known attorney, Brand had not attained recognition in the field of business in which the mark was used, and his attempt to cancel the trademark registration under § 2(c) failed.⁶⁴

For a famous person, the only harms that a court will likely recognize in the face of a § 2(c) violation are the pecuniary and goodwill harms attendant to the right of publicity, rather than the right of privacy. For example, in one case, the Sixth Circuit found that no right of privacy interests were invaded simply because the plaintiff (Johnny Carson) was "embarrassed by" the defendant's product (portable toilet seats named "Here's Johnny").⁶⁵ Right of publicity interests, however, were.⁶⁶ The court noted that the theory of the right is that "a celebrity's identity can be valuable in the promotion of products, and the celebrity has an interest that may be protected from the unauthorized commercial exploitation of that identity."⁶⁷

2. *In re ADCO Decision*

In *In re ADCO*,⁶⁸ the Court considered a claim similar to that in *In re Elster*.⁶⁹ The proposed mark in that case consisted of the phrase TRUMP-IT for a package opener.⁷⁰ As in *Elster*, the PTO rejected the mark under both §§ 2(a) and 2(c), which the applicant claimed was unconstitutional under the First Amendment.⁷¹ The TTAB noted that as a threshold matter, the applicant erred in treating provisions of the Lanham Act as akin to direct restrictions on free speech.⁷² The Board stated that "Section 2 does not prevent an applicant from using any slogan of its choice on its merchandise or from advertising that

62. *In re Hoefflin*, 97 U.S.P.Q.2d at 1177.

63. *Id.* at 1178.

64. *Martin v. Carter Hawley Hale Stores*, 206 U.S.P.Q. at 933 (citing *Brand v. Fairchester Packing Co.*, 84 U.S.P.Q. 97 (Comm'r Pat. 1950)).

65. *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983).

66. *Id.* at 835.

67. *Id.*

68. *In re ADCO Indus.-Techs., L.P.*, 2020 U.S.P.Q.2d 53786 (I.T.A.B. 2020).

69. *In re Elster*, 26 F.4th at 1330.

70. *In re ADCO Indus.-Techs.*, 2020 U.S.P.Q.2d 53786, at *1.

71. *Id.* at *21.

72. *Id.* at *25.

merchandise through any advertising message of its choosing.”⁷³ In addition, the provisions do not call for rejecting trademarks based on viewpoint, but rather on viewpoint neutral criteria.⁷⁴ Finally, even if the challenged provisions were evaluated as outright restrictions on speech, rather than on registration, they are within Congress’s authority to make decisions for the sake of the public; both of the statutes “recognize[] the right of privacy and publicity that a living person has in his or her identity and protects consumers against source deception.”⁷⁵ Certainly, as the TTAB added in *Elster*, § 2(c) is narrowly tailored, since it “consistently and reliably applies to any mark that consists of or comprises a name, portrait or signature identifying a particular living individual.”⁷⁶

C. FEDERAL CIRCUIT OPINION

Finally, the Federal Circuit heard the case, ultimately agreeing with *Elster* and finding the application of § 2(c) to reject registration of the mark unconstitutional.⁷⁷ The court declined to decide how best to analyze the nature of trademark registration rejections—whether through strict or intermediate scrutiny as expressive or commercial speech.⁷⁸ Under either conceptualization, the court held, the government had no sufficient right of publicity or right of privacy interests to overcome the powerful First Amendment protections of the “political criticism” embodied in trademark.⁷⁹

First, there was no “plausible” claim of Trump’s right of privacy from criticism in the absence of actual malice.⁸⁰ In fact, there is no right of privacy at all when the government restricts speech that comments on or criticizes public officials.⁸¹ Moreover, the court stated that no right of publicity existed because no claim was made that Trump’s name was misappropriated in a way that exploited his commercial interests or diluted the commercial value of his name.⁸² Moreover, “no plausible claim” could be made that the disputed mark suggests President Trump has endorsed *Elster*’s product.⁸³ Broadly, as with the right of privacy, there is no “substantial” interest in a right of publicity claim

73. *Id.* at *27

74. *Id.* at *27–28.

75. *Id.* at *28.

76. *In re Elster*, Serial No. 87/749,230, at *11.

77. *In re Elster*, 26 F.4th at 1330.

78. *Id.* at 1338–39.

79. *Id.* at 1338.

80. *Id.* at 1336.

81. *Id.* at 1335.

82. *Id.* at 1336.

83. *Id.*

in the context of criticism of a public official.”⁸⁴ Despite the government’s claim that Congress’s enacting § 2(c) was a targeted effort to preclude registration that facilitates a type of commercial behavior already banned in most states, the court’s “review of state-law cases revealed no authority holding that public officials may restrict expressive speech to vindicate their publicity rights.”⁸⁵

III. TRADEMARK REGISTRATION AND THE FIRST AMENDMENT

The Federal Circuit decision reflects a fundamental misunderstanding of trademark and trademark registration, as well as how best to conceptualize such speech “regulation” in the context of First Amendment jurisprudence. In this Part, Section III.A explains trademark registration. Section III.B details the two Supreme Court cases preceding *In re Elster*, in which the Court first considered the constitutionality of federal trademark registration provisions.

A. TRADEMARK REGISTRATION OVERVIEW

A trademark is a designation of the source of goods and services used to “identify and distinguish” the source from those manufactured or sold by others.⁸⁶ Early trademark protection evolved out of the common law tort of fraud and deceit, in which the fraudulent intent to deceive consumers through the use of another’s trademark was the key inquiry, rather than consumers’ confusion itself.⁸⁷ Today, while some disagree about the primacy of one goal over another, the protection of trademarks broadly has two goals: (1) to protect consumers from deception and confusion over trademarks, and (2) to protect the owner of trademark from misappropriation by others.⁸⁸

Though often included under the umbrella of intellectual property, trademarks are fundamentally different from patents or copyrights.⁸⁹ First, as

84. *Id.*

85. *Id.* at 1338.

86. 15 U.S.C. § 1127.

87. 2 MCCARTHY, *supra* note 20, § 5:2.

88. *Id.* § 2:2 (citing S. REP. NO. 133, at 3 (1946)). For example, Professor McKenna has argued that trademark law is rooted in unfair competition law and was never traditionally intended to protect consumers. Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1841 (2007). On the other hand, Professor Tushnet has stated that “[p]rotection against consumer confusion is the rhetorical core of modern trademark law.” Rebecca Tushnet, *Registering Discontent: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867 (2017).

89. 1 MCCARTHY, *supra* note 20, § 6:1 (describing “a tremendous amount of confusion in the mind of the public and even the practicing bar as to the fundamental differences between patents, trademarks and copyrights”).

indicated by the twin goals of trademark law, trademark protection does not exist to foster or reward innovation.⁹⁰ Second, trademark rights do not exist for a given duration upon registration with the U.S. Government. Rather, the exclusive right to a trademark “grows out of its *use*, and not its mere adoption.”⁹¹ Without continual use in commerce, trademarks are meaningless. These differences track to the constitutional basis for the federal power to regulate trademarks. While Congress has the power to regulate patents and copyrights under the patent and copyright clause of the Constitution—which grants Congress the power to “promote the progress of sciences and the useful arts, by securing for limited times to authors and inventors, the exclusive right to their respective writings and discoveries”—trademarks are excluded from such a grant.⁹² Because trademarks generally grow out of “a considerable period of use, rather than a sudden invention,” a clause concerning authors and inventors is inapplicable.⁹³ Rather, Congress has power to regulate trademarks only under its power to regulate commerce in the Commerce Clause.⁹⁴

The Lanham Act was enacted in 1946 to establish a federal system of national trademark registration. Importantly, the Act was not intended to change the common law of trademark that had developed up to its enactment.⁹⁵ While federal registration of a patent or copyright confers property-like exclusive rights to use and protection of the creation, federal registration of trademark requires proof of “use in commerce” and is, as in common law, meaningless absent continual use of the mark.⁹⁶ There is an opportunity provided in the Lanham Act to file an application for registration based on a good faith “intent to use,” but only after the mark is used in commerce is the registration actually issued.⁹⁷

There are benefits, however, to federal registration of a trademark. First, registration provides constructive national notice of ownership.⁹⁸ Second, if an owner of a registered trademark were to file an infringement action, the fact

90. *See In re Trade-Mark Cases*, 100 U.S. 82, 93–94 (1879) (noting that a trademark does not depend upon “novelty, invention, discovery, or any work of the brain”).

91. *Id.*

92. *Id.*

93. *Id.*

94. *Id.*

95. “The Lanham Act did not supplant the state common law of trademarks . . . [i]n fact, Section 15 of the Lanham Act grants federally registered marks the right to exclusive use of the mark only insofar as they do not conflict with any pre-existing rights acquired under state law.” *Dorpan v. Hotel Meliá, Inc.*, 728 F.3d 55, 62 (1st Cir. 2013) (citing 15 U.S.C. § 1065).

96. 2 MCCARTHY, *supra* note 20, § 19:1.25.

97. *Id.*

98. 15 U.S.C. § 1072.

of registration can be introduced as prima facie evidence of the mark's validity and the plaintiff's ownership.⁹⁹ Third, trademark registration provides the opportunity to file incontestability. Between the fifth and sixth anniversary of registering a trademark, if the mark has been consecutively used in commerce for five years, a trademark owner can file for "incontestable status."¹⁰⁰ A defendant defending against an incontestable trademark owner's infringement claim is left with limited defenses.¹⁰¹ There are also some non-governmentally conferred advantages to registration. For example, Amazon requires trademark registration or a pending trademark registration application for inclusion of the relevant product in the Amazon Brand Registry.¹⁰²

Fundamentally, though, while federal trademark registration confers some procedural and substantive benefits, it does not change the nature of a trademark that exists, registered or unregistered, through use in business.¹⁰³ There are also trademark uses protected in the common law but not federally registerable, such as commercial trade names, and trademarks not used in interstate or foreign commerce.¹⁰⁴ Moreover, unregistered trademarks are enforceable under § 43(a) of the Lanham Act, which creates a federal cause of action for infringement of unregistered trademarks.¹⁰⁵

99. 15 U.S.C. § 1115(a). A defendant can still raise various legal and equitable defenses.

100. 15 U.S.C. § 1065.

101. 15 U.S.C. § 1115(b).

102. *See Get Started in Three Steps*, AMAZON, <https://brandservices.amazon.com/brandregistry/eligibility> (last visited Dec. 15, 2023) (describing relevant eligibility requirements to enroll in the program). The program offers a number of exclusive programs to "build and protect your brand," such as a tool to report IP infringement. *Brand Protection Quick Start Guide*, AMAZON, <https://brandservices.amazon.com/protect-brand> (last visited Dec. 15, 2023).

103. *See B & B Hardware, Inc. v. Hargis Indus., Inc.*, 575 U.S. 138, 142 (2015) (noting that "federal law does not create trademarks"); *see also San Juan Products, Inc. v. San Juan Pools of Kansas, Inc.*, 849 F.2d 468, 474 (10th Cir. 1998) (cited in 2 MCCARTHY, *supra* note 20, § 19:3) ("Unlike the registration of a patent, a trademark registration of itself *does not create the underlying right to exclude*. Nor is a trademark created by registration. While federal registration triggers certain substantive and procedural rights, the absence of federal registration does not unleash the mark to public use. The Lanham Act protects unregistered marks as does the common law.").

104. 2 MCCARTHY, *supra* note 20, § 19:8.

105. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 768 (1992) ("Section 43(a) prohibits a broader range of practices than does § 32, which applies to registered marks, but it is common ground that § 43(a) protects qualifying unregistered trademarks.").

B. TAM AND BRUNETTI

1. Matal v. Tam

In *Matal v. Tam*, the Court unanimously decided that the “disparagement clause” of the Lanham Act, § 2(a), was facially unconstitutional.¹⁰⁶ The case marked the first time a federal intellectual property statute was invalidated on constitutional grounds since 1879.¹⁰⁷ Section 2(a) prohibited the registration of a trademark “which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”¹⁰⁸ Based on this clause, the PTO rejected Simon Tam’s trademark registration of his band name “THE SLANTS,” citing the fact that the name, a derogatory term for persons of Asian descent, “had been found offensive numerous times.”¹⁰⁹ The Court held that such a provision violated the “bedrock First Amendment principle” that the government cannot discriminate against “ideas that offend.”¹¹⁰

One key question courts ask in deciding how to scrutinize a given restriction on speech is whether it is viewpoint-discriminatory. The test asks whether the government has singled out and disfavored a subset of messages based on the views expressed.¹¹¹ A Texas law prohibiting flag desecration, for example, was clearly viewpoint discriminatory by prohibiting one’s attitude toward the American flag.¹¹² Of all forms of speech regulation, the Court is most skeptical of viewpoint-discriminatory speech, since the “bedrock” principle of the First Amendment is that the government may not prohibit expression of an idea.¹¹³ Accordingly, such restrictions are subject to “the most exacting scrutiny” and are presumptively unconstitutional.¹¹⁴ In *Tam*, the clause was viewpoint discriminatory since “giving offense is a viewpoint,”¹¹⁵

106. 137 S. Ct. 1744 (2017).

107. The Court struck down federal trademark legislation in *The Trade-Mark Cases*, 100 U.S. 82 (1879).

108. 15 U.S.C. § 1052(a).

109. *Tam*, 137 S. Ct. at 1754.

110. *Id.* at 1751.

111. *Id.* at 1750.

112. *See Texas v. Johnson*, 491 U.S. 397, 413, n.9 (“[I]f Texas means to argue that its interest does not prefer *any* viewpoint over another, it is mistaken; surely one’s attitude toward the flag and its referents is a viewpoint.”).

113. *Id.* at 414. Viewpoint discrimination is a “form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny.” *Tam*, 137 S. Ct. at 1765. (Kennedy, J., concurring in part).

114. *Johnson*, 491 U.S. at 412.

115. *Tam*, 137 S. Ct. at 1763.

and the Government's proffered justifications were insufficient under such exacting scrutiny.¹¹⁶

The problem with the Court's straightforward application of such rigorous viewpoint-discrimination scrutiny is that it allowed the Court to avoid the question of what kind of speech regulation restrictions on trademark registration are. The Court acknowledged the "debate" about whether trademarks are commercial speech, rather than expressive speech, but noted that it "need not resolve this debate . . . because the disparagement clause cannot withstand even [the lesser commercial speech scrutiny]."¹¹⁷ The Court *did*, however, decide that trademarks are private, not government speech.¹¹⁸ In so doing, it distinguished trademark registration from a state's specialty license plate approval process.¹¹⁹ Whereas license plates are subject to direct state control, are closely identified with the State in the public mind, and have been used to convey State messages, trademarks have not historically conveyed Government messages, nor does the public associate the contents of a trademark with the Government.¹²⁰

Yet the label of "private speech" provides little insight into the relevant First Amendment framework, beyond signaling that the First Amendment has restrictive import in ways it doesn't for purely government speech.¹²¹ And while the First Amendment can be broadly thought of as a protection of speech, it more practically is "a bundle of different but interrelated concepts, joined together under the oversimplifying rubric of 'freedom of speech.'"¹²² For better or worse, this has come to mean that categorization of speech

116. *Id.* at 1765.

117. *Id.* at 1764.

118. *Id.* at 1760.

119. *Id.* (distinguishing *Walker v. Tex. Div.*, 576 U.S. at 200, in which the Court held that Texas did not violate an organization's free speech in rejecting its application for a specialty license plate with a confederate battle flag).

120. *Id.* The Court also distinguished *Johanns v. Livestock Mktg. Ass'n*, 544 U.S. 550 (2005) (holding that federally mandated beef advertisements were government speech), and *Pleasant Grove City, Utah v. Sumnum*, 555 U.S. 460 (2009) (holding that a small city's selection of a permanent monument in a public park was government speech).

121. *See, e.g., Pleasant Grove City, Utah v. Sumnum*, 555 U.S. 460, 467 (2009) ("The Free Speech Clause restricts government regulation of private speech; it does not regulate government speech.").

122. Frederick Schauer, "Private" Speech and the "Private Forum": *Givhan v. Western Line School District*, 1979 SUP. CT. REV. 217, 217-18 (1979). More critically, Professor Schauer has posited that "if there exists a single theory that can explain the First Amendment's coverage, it has not yet been found." Frederick Schauer, *The Boundaries of the First Amendment: A Preliminary Exploration of Constitutional Salience*, 117 HARV. L. REV. 1765, 1786 (2004).

matters significantly in determining the extent of the First Amendment's protection.¹²³ The decision, then, was left for another day.

2. *Iancu v. Brunetti*

Just two years after *Tam*, the Court struck down another clause of § 2(a) of the Lanham Act as facially unconstitutional.¹²⁴ The clause prohibited registration of “immoral[] or scandalous” trademarks, and was used to reject Erik Brunetti's registration of the trademark FUCT, the name of his clothing line.¹²⁵ The Court again provided no framework through which trademark registration should be analyzed. As in *Tam*, the “key question” was simply whether the criterion was viewpoint-neutral or viewpoint-based,¹²⁶ which it was, since the clause “disfavors certain ideas.”¹²⁷ Importantly, the unanimous opinion reflected only the Court's determination that the bar on registration of “immoral” trademarks was viewpoint-discriminatory. Three Justices—Chief Justice Roberts, Justice Breyer, and Justice Sotomayor—dissenting in part, argued that the bar on registration on “scandalous” trademarks could be a narrowly construed, viewpoint-neutral, and reasonable regulation of expressive activity.

Chief Justice Roberts noted that refusal to register “obscene” or “vulgar” marks encompassed by a narrow reading of “scandalous” would not offend the First Amendment—“regardless of how exactly the trademark registration system is best conceived . . . a question we left open in *Tam*.”¹²⁸ Notably, he distinguished the stakes of trademark speech from that of more traditional

123. “[I]dentifying the category of speech at issue (e.g., commercial speech, obscenity) is an important step in determining what First Amendment standards, including what level of judicial scrutiny, a court might apply to the law.” VICTORIA L. KILLION, CONG. RESEARCH SERV., IF11072, *THE FIRST AMENDMENT: CATEGORIES OF SPEECH* 1 (2019); see also Joseph Blocher, *Categoricalism and Balancing in First and Second Amendment Analysis*, 84 N.Y.U. L. REV. 375, 397 (“Rather than fully embracing categorization or balancing at all levels of analysis, First Amendment doctrine generally combines the two, for example by using balancing or other standard-like tests to establish the borders of constitutional coverage and then applying categorical rules to speech in certain subcategories [or vice versa].”). In oral argument in one case, Chief Justice Roberts noted that such balancing standards “just kind of developed over the years as sort of baggage that the First Amendment picked up.” *Id.* (internal citation omitted). This Note does not address the many critiques of First Amendment category delineation and tiers of scrutiny, and instead describes a solution that fits within such “baggage,” i.e., the Court's established doctrine.

124. *Brunetti*, 139 S. Ct. at 2297.

125. *Id.*

126. *Id.* at 2299.

127. *Id.* at 2297. The PTO examining attorney determined that FUCT was a “total vulgar” and “therefore . . . unregistrable” mark. *Id.*

128. *Id.* at 2303 (Roberts, C.J., concurring in part and dissenting in part).

speech, writing: “no speech is being restricted; no one is being punished. The owners of such marks are merely denied additional benefits.”¹²⁹ Justice Sotomayor, too, downplayed the stakes of trademark speech restriction, noting that they are “far removed” from a situation threatening Brunetti’s liberty, or even his right to use or enforce his trademark.¹³⁰ She likened the registration system either to a government subsidy or a limited public (or nonpublic) forum, two conceptions of forums for speech different from traditional expressive speech; under either framework, “reasonable viewpoint-neutral content discrimination is generally permissible.”¹³¹ Finally, Justice Breyer wrote that the trademark statute fits into no First Amendment categories, and should be subjected to a “proportionality” analysis.¹³²

IV. FIRST AMENDMENT FRAMEWORKS

Tam and *Brunetti* were straightforwardly decided because the provisions invoked the most “egregious form of content discrimination”¹³³ — discrimination based on viewpoint. However, a restriction that is viewpoint-neutral but nevertheless discriminates based on the content of speech is still subject to strict scrutiny.¹³⁴ In other words, such content discrimination is presumptively unconstitutional and justified only if the government proves such restrictions are narrowly tailored to serve compelling state interests (a standard only somewhat less demanding than “exacting” scrutiny).¹³⁵

To determine whether a provision is content-neutral, the Court asks whether it can be justified without reference to the content of the regulated speech.¹³⁶ As an illustration, consider the difference between two sign regulation cases that reached the Court. In *City Council of Los Angeles v. Taxpayers for Vincent*, a political sign service company challenged the City of Los

129. *Id.*

130. *Id.* at 2312 (Sotomayor, J., concurring in part and dissenting in part).

131. *Id.* at 2317.

132. *Id.* at 2306 (Breyer, J., concurring in part and dissenting in part). In *Reed v. Town of Gilbert*, 576 U.S. 155, 175 (2015), Justice Breyer similarly expressed his frustration with First Amendment categories. He wrote, “I believe that categories alone cannot satisfactorily resolve the legal problem before us. The First Amendment requires greater judicial sensitivity both to the Amendment’s expressive objectives and to the public’s legitimate need for regulation than a simple recitation of categories, such as ‘content discrimination’ and ‘strict scrutiny’ would permit. In my view, the category ‘content discrimination’ is better considered in many contexts, including here, as a rule of thumb, rather than as an automatic ‘strict scrutiny’ trigger, leading to almost certain legal condemnation.”

133. *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 829 (1995).

134. *Reed*, 576 U.S. at 2227.

135. *Id.*

136. *Id.*

Angeles's removal of the group's political signs from utility poles pursuant to an ordinance prohibiting the posting of signs on various forms of public property.¹³⁷ The Court found that such an ordinance was content-neutral and impartially applied, impacting all forms of speech in the same way.¹³⁸ In contrast, in *Reed v. Town of Gilbert*, a church challenged a city's code which provided differing restrictions on signs based on their categories as, for example, an "ideological sign" or "political sign."¹³⁹ The Court found the code was content-discriminatory, and ultimately unconstitutional.¹⁴⁰

Section 2(c) and the other § 2 provisions clearly discriminate on the basis of content.¹⁴¹ For example, § 2(c) looks to the content of a trademark to ask: does this mark identify an individual without their consent? Without a conception of such speech "regulation" that subjects the § 2 provisions to a lower level of scrutiny, they are potentially all at risk of being struck down as, at a minimum, unconstitutional as-applied in certain scenarios.¹⁴² The Court's selection of a framework would provide guidance to Congress, trademark examiners, trademark registrants, and courts about the Government's ability to restrict trademarks from registration by articulating the level of scrutiny with which to compare the regulation to countervailing interests, such as protection of political speech.

In their partial dissents in *Brunetti*, the three Justices stated that the "scandalous" provision could be saved if it were construed in a viewpoint-neutral way. In so doing, they implied that trademark registration is different than other content-based restrictions; they noted that "scandalous" trademarks could comport with the reasonable or general interests of the Government without reference to "compelling governmental interests" or "narrow tailoring."¹⁴³ In other words, they implied that trademark registration is subject

137. 466 U.S. at 793.

138. *Id.* at 817.

139. 576 U.S. at 2227.

140. *Id.* at 2232.

141. *See Brunetti*, 139 S. Ct. at 2317 n.12 (Sotomayor, J., concurring in part and dissenting in part) ("Though I do not address the constitutionality of provisions not before the Court, I note as well that the 'scandalous' bar in § 1052(a) is hardly the only provision in § 1052 that could be characterized as content discriminatory. *See, e.g.*, § 1052(b) (no flags or insignias); § 1052(c) (no unapproved markers of deceased U.S. Presidents during the lives of their spouses)."); Tushnet, *supra* note 41, at 382 ("Section 2 is almost nothing but content-based.").

142. *See In re Elster*, 26 F.4th at 1331 ("Neither *Tam* nor *Brunetti* resolves the constitutionality of section 2(c). Both holdings were carefully cabined to the narrow, 'presumptive[] unconstitutional[ity]' of section 2(a)'s viewpoint-based restrictions.") (internal citations omitted).

143. *See Brunetti*, 139 S. Ct. at 2308 (Sotomayor, J., concurring in part and dissenting in part) ("Such a narrowing construction would save that duly enacted legislative text by rendering it a reasonable, viewpoint-neutral restriction on speech that is permissible in the

to a lower level of scrutiny than expressive speech (such as rational basis review).

This Part will explore the First Amendment frameworks that the Justices considered in both *Tam* and *Brunetti*—trademark registration as a regulation of commercial speech, as a government subsidy and as a limited public forum. Though some Justices expressed a preference for the appropriate framework—Justice Sotomayor for a non-cash government program or limited public forum¹⁴⁴ and Justice Alito for a limited public forum¹⁴⁵—all explicitly left open the question for a future time.¹⁴⁶

The *Elster* court also declined to select a framework, though it only conceptualized trademarks as either expressive political speech or commercial speech.¹⁴⁷ In support of the protection of expressive speech, the *Elster* court cites, among other cases, *Cohen v. California*, in which a court upheld First Amendment protection of a jacket with the words “Fuck the Draft.”¹⁴⁸ That trademark registration is not a restriction on expressive speech should be clear from Section II.A. Preventing someone from wearing a jacket with certain words is an imposition on free expression, whereas refusing to register a trademark prevents no expression from being spoken or sold.¹⁴⁹ However,

context of a beneficial governmental initiative like the trademark-registration system.”), 2307 (Breyer, J., concurring in part and dissenting in part) (“The Government has at least a reasonable interest in ensuring that it is not involved in promoting highly vulgar or obscene speech.”), 2303 (Roberts, C.J., concurring in part and dissenting in part) (“The Government . . . has an interest in not associating itself with trademarks whose content is obscene, vulgar, or profane.”).

144. *See id.* at 2316 n.10 (Sotomayor, J., concurring in part and dissenting in part) (“Trademark registration differs [from cash-subsidy government programs] because any ‘subsidy’ comes in the form of a noncash benefit, but that difference does not foreclose understanding the registration system as a beneficial, noncash governmental program. No Justice, meanwhile, rejected the limited-public-forum analogy . . . and scholars have noted arguments for adopting it.”).

145. *Tam*, 137 S. Ct. at 1763 (noting that trademark registration is “potentially more analogous” to a limited public forum than government programs or subsidies, the latter of which he deemed “nothing like” the programs at issue). Chief Justice Roberts, and Justices Thomas and Breyer also joined Justice Alito in this opinion.

146. *See Brunetti*, 139 S. Ct. at 2302 (declining to “say anything about how to evaluate viewpoint-neutral restrictions on trademark registration.”).

147. *See In re Elster*, 26 F.4th at 1338–39.

148. *Id.* at 1333.

149. *See* Sonia K. Katyal, *Trademark Intersectionality*, 57 UCLA L. REV. 1601, 1646 (2010) (“The phrase in *Cohen* involved pure expression in the marketplace of ideas, whereas the same phrase in the Lanham Act context involves federal registration of a commodity as a brand in the marketplace of goods.”). Professor Katyal also noted that an additional difference is that *Cohen* involved a “criminal prohibition on speech” rather than a refusal to registration, which involves no speech prohibition. *Id.*

there is more academic support for trademark registration as a regulation of commercial speech,¹⁵⁰ so, though various Justices have seemed to express more support for either the limited public forum or government subsidy framework, it is worth exploring more fully.

A. COMMERCIAL SPEECH

1. Overview

Commercial speech is evidence of the moving target of First Amendment protections.¹⁵¹ Though rejected as outside the bounds of the First Amendment in 1942,¹⁵² it was accepted as protectable speech in 1976 in *Virginia State Board of Pharmacy v. Virginia Citizens Consumer Council, Inc.*¹⁵³ There, the Court considered a restriction prohibiting pharmacists from advertising the truthful price of their drugs.¹⁵⁴ Virginia had reasoned that if pharmacists could cut corners to offer and advertise low prices, they might be able to trick consumers into their low-quality services and harm them.¹⁵⁵ The Court was skeptical of this “highly paternalistic” approach—outright banning truthful speech—and found that in the absence of any tangible evidence of deception, the restriction was unconstitutional under the First Amendment.¹⁵⁶ The Court made it clear that commercial speech was different from expressive speech, and a lower degree of protection of the speech was needed to ensure an unimpaired flow of “truthful and legitimate commercial information.”¹⁵⁷ The Court articulated a balancing test just four years later in *Central Hudson Gas & Electric Corp. v. Public Service Commission of New York*.¹⁵⁸ The first prong (1) asks whether the commercial speech concerns lawful activity and is not misleading. If the speech is commercial in nature but misleading or unlawful, “there can be no constitutional objection to the suppression of commercial messages that do

150. See, e.g., Ned Snow, *Denying Trademark for Scandalous Speech*, 51 U.C. DAVIS L. REV. 2331, 2363 n.125 (“It seems likely that the test would apply given that trademark rights do not exist unless there is a bona fide use in commerce of the mark.”).

151. See Amanda Shanor, *First Amendment Coverage*, 93 N.Y.U. L. REV. 318, 326 (noting that commercial speech was “once explicitly excluded from First Amendment coverage altogether, but was several decades later swept within the First Amendment’s ambit,” and that “[t]he scope of the First Amendment is dynamic, not static”).

152. See *Valentine v. Chrestensen*, 316 U.S. 52, 54 (1942) (holding that in contrast to communicating information and opinions in the street, “the Constitution imposes no such restraint on government as respects purely commercial advertising”).

153. 425 U.S. 748, 770 (1976).

154. *Id.*

155. *Id.* at 769.

156. *Id.* at 770.

157. *Id.* at 771 n.24.

158. 447 U.S. 557, 563 (1980).

not accurately inform the public about lawful activity.”¹⁵⁹ The next three prongs of the test articulate the “intermediate” scrutiny a court should apply, and ask whether: (2) the government interest is substantial, (3) the regulation directly advances the governmental interest asserted, and (4) the regulation is not more extensive than necessary to serve that interest.¹⁶⁰

Typically, the central inquiry in commercial speech cases is into the consumer harm which such commercial speech restrictions seek to alleviate.¹⁶¹ This inquiry often depends on the nature of the audience of certain commercial speech.¹⁶² For example, in *Edenfield v. Fane*, the Court found that a restriction on direct solicitations by CPAs was a violation of the First Amendment, distinguishing the decisions from the Court’s upholding of a ban on solicitations by attorneys, because “[t]he typical client of a CPA is far less susceptible to manipulation.”¹⁶³ And in *Lorillard Tobacco Co. v. Reilly*, the Court found that despite the Government’s interest in protecting children, a regulation prohibiting outdoor tobacco advertising near schools was unduly restrictive because “tobacco retailers and manufacturers have an interest in conveying truthful information about their products to *adults*, and adults have a corresponding interest in receiving truthful information about tobacco products.”¹⁶⁴

Such audience orientation, however, can nevertheless create tension with what the Court often perceives as paternalistic government measures. In *Virginia State Board of Pharmacy*, the Court questioned the state Board of Pharmacy’s approach of banning the advertisement of drug prices as “highly paternalistic.” In considering the choice between suppression of advertisements and the danger of misuse of advertisement information, the Court stated that the First Amendment makes the choice for the Court—to “open the channels of communication.”¹⁶⁵ This anti-paternalistic approach has taken on such a role in recent commercial speech opinions that the scrutiny of regulation of commercial speech has arguably been elevated to that of

159. *Id.*

160. *Id.*

161. *See* *Edenfield v. Fane*, 507 U.S. 761, 770–71 (1993) (“[A] governmental body seeking to sustain a restriction on commercial speech must demonstrate that the harms it recites are real and that its restriction will in fact alleviate them to a material degree.”).

162. *See* Robert Post, *The Constitutional Status of Commercial Speech*, 48 UCLA L. REV. 1, 14 (2000) (describing commercial speech as “sharply audience oriented”).

163. 507 U.S. at 775.

164. 533 U.S. 525, 564 (2001) (emphasis added).

165. *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748, 770 (1976).

expressive speech, beyond the “intermediate” scrutiny of *Central Hudson*.¹⁶⁶ In *Thompson v. Western States Medical Center*, for example, the Court stated that even if the government had argued that it prohibited certain drug advertisements because of a fear that such advertisements put people at risk, “this concern amounts to a fear that people would make bad decisions if given truthful information about compounded drugs.”¹⁶⁷

Nearly all the regulations that the Court has recently considered under the commercial speech doctrine involve outright prohibitions of certain forms of speech. Such cases include an FDA regulation prohibiting manufacturers from advertising compound drugs;¹⁶⁸ a prohibition on advertising the price of alcohol;¹⁶⁹ a prohibition on the sale of pharmacy records that reveal prescribing practices of individual doctors,¹⁷⁰ and a federal ban on stating the alcohol content on beer labels.¹⁷¹ In each case, the court rejected the government’s attempts to restrict truthful, factual information as violative of the First Amendment given the lack of fit between the harm in question and the government’s approach to alleviating such harm.¹⁷² In addition, the Court has suggested that disclosure and disclaimer requirements are preferable to pure speech suppression.¹⁷³ Alternatively, government speech on its own is preferable to speech suppression in order to accomplish the government’s policy or consumer protection goals.¹⁷⁴

166. See, e.g., *Sorrell v. IMS Health Inc.*, 564 U.S. 552, 577 (2011) (noting that the “fear that people would make bad decisions if given truthful information” cannot justify content-based burdens on speech). The Court also stated that the First Amendment “directs us to be especially skeptical of regulations that seek to keep people in the dark for what the government perceives to be their own good.” *Id.* (citing *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484, 503 (1996) (opinion of Stevens, J.)).

167. 535 U.S. 357, 374 (2002).

168. *Id.*

169. *44 Liquormart, Inc. v. Rhode Island*, 517 U.S. 484 (1996).

170. *Sorrell v. IMS Health Inc.*, 564 U.S. 552 (2011).

171. *Rubin v. Coors Brewing Co.*, 514 U.S. 476 (1995).

172. That each case restricted truthful information was crucial to the Court. See *Sorrell*, 564 U.S. at 579 (“The State nowhere contends that detailing is false or misleading within the meanings of this Court’s First Amendment precedents.”).

173. Rebecca Tushnet, *Trademark Law as Commercial Speech Regulation*, 58 S.C. L. REV. 737, 748 (2006) (citing *Zauderer v. Off. of Disciplinary Counsel*, 471 U.S. 626, 651 (1985)); see also *In re R. M. J.*, 455 U.S. 191, 201 (1982) (“[A] warning or disclaimer might be appropriately required . . . in order to dissipate the possibility of consumer confusion or deception.”) (internal citations omitted).

174. See *Sorrell*, 564 U.S. at 578 (“Vermont may be displeased that details who use prescriber-identifying information are effective in promoting brand-name drugs. The State can express that view through its own speech.”); see also *44 Liquormart*, 517 U.S. at 498 (“[T]he remedy to be applied is more speech, not enforced silence. Only an emergency can justify repression.”) (plurality opinion) (internal citations omitted).

2. *Analogy to Trademark*

Trademark registration should not be characterized as regulation of commercial speech. As an initial matter, that a slogan or form of expression is embroidered on merchandise or generally for sale does not necessarily transform it into commercial speech. However, even if all marks are conceived of as commercial speech, trademark registration decisions do not take on the form of commercial speech regulation as an analytical framework. First, trademark registration decisions do not involve outright prohibitions of speech, but rather the denial of access to the benefits of registration. Second, while some registration provisions under § 2 bar registration if a mark is deceptive or misleading, others, including § 2(c), facilitate the protection of third party rights already provided by common law. In other words, there is no tension between the “right to information” and paternalistic goals, because consumers are not deprived of information, nor is the purpose of a provision like § 2(c) to protect consumers.

As Chief Justice Roberts noted in his opinion in *Brunetti*, in the face of trademark registration denial, “[n]o speech is being restricted; no one is being punished.”¹⁷⁵ Whether a mark is registered does not prevent its use in business or commerce. Steve Elster can sell any number of products with the phrase “Trump too small” absent a trademark registration. In fact, the PTO, in its early rejections of Elster’s application, noted multiple items for sale without trademark registration such as a t-shirt with the phrase “Can’t Build a Wall If Your Hands Are Too Small”¹⁷⁶ and a soap called “Trump’s Small Hand Soap.”¹⁷⁷ The only way Elster could be hampered in a material way from selling his envisioned t-shirts would be if Donald Trump himself registered (or gave consent to another to register) the mark and made sufficient use of the mark to satisfy the requirement for “use in commerce.”¹⁷⁸

175. *Brunetti*, 139 S. Ct. at 2303.

176. *Can’t Build Wall Hands Too Small Justice Baby Trump T-Shirt*, AMAZON, <https://www.amazon.com/BUILD-HANDS-SMALL-JUSTICE-TRUMP^=dp/B07FLTBVYZ> (last visited Dec. 18, 2023).

177. *Trump’s Small Hands Soap – Republican and Democrat – Made in the USA*, AMAZON, <https://www.amazon.com/Trumps-Small-Hands-Soap-Republican/dp/B076JKNJ41> (last visited Dec. 18, 2023).

178. Samuel Ernst considered this in a recent Article, noting the unlikelihood of Trump selling shirts informing the public that his policies and body parts were “TOO SMALL,” and adding that even if Trump were to do that, it would be hard for him to prove likelihood of confusion. See Samuel Ernst, *Trump Really Is Too Small: The Right To Trademark Political Commentary*, 88 BROOK. L. REV. 839, 872 (2023). Professor Ernst does, however, argue that § 2(c) is unconstitutional.

In addition, § 2(c), and other provisions of § 2, have a purpose beyond preventing consumer deception or protecting consumers in the vein of an FDA regulation, or tobacco advertising restriction. In contrast, the commercial speech analysis hinges on whether the speech being policed is misleading or truthful. Rebecca Tushnet has noted that the goal of restricting commercial speech in fostering access to truthful information “depends on truth and falsity being pure binaries.”¹⁷⁹ Yet, as discussed in Section III.C, § 2(c) has purpose beyond assisting the policing of deceptive trademarks. Rather, it tackles a kind of dilution-like interest of a celebrity or known person in preventing “diminishment,” as acknowledged by common law rights of privacy and publicity.¹⁸⁰ Even if one thinks such interests are not sufficiently worthy of preservation (though there is certainly support for a federal right of publicity),¹⁸¹ leaving room for Congress to be able to enact legislation with meaningful purpose beyond the bounds of falsity is.

In contrast, in *In re Elster*, the Federal Circuit stated that “no plausible claim” could be made that President Trump has endorsed the shirt, and therefore he couldn’t possibly have a right of publicity claim.¹⁸² Under this interpretation, any PTO rejection of a trademark based on § 2(c) without false endorsement would not survive commercial speech scrutiny. And even if some restrictions could survive in certain fact patterns that suggests false endorsement, the purpose of § 2(c), or any restrictions which Congress may want to enact that reach beyond deception, may be lost. For example, in *Native American Arts, Inc. v. Waldron Corp.*, Judge Posner reversed the district judge’s finding that the Indian Arts and Crafts Act (IACA), which forbids selling a good “in a manner that falsely suggests it is . . . an Indian product” is unconstitutional.¹⁸³ However, he affirmed the district court’s judgement for the defendant despite plaintiffs’ contention that the instructions to the jury did not sufficiently capture the purpose of the IACA.¹⁸⁴ The plaintiffs argued that there must be a qualifier or disclaimer along with the use of a misleading word, since the statute forbids “unqualified use” specifically. However, Judge Posner

179. Tushnet, *supra* note 173, at 748.

180. *See supra* Section II.B.1.

181. *See, e.g.*, Kevin L. Vick & Jean-Paul Jassy, *Why a Federal Right of Publicity Statute is Necessary*, 28 COMM. LAW. 14 (2011); Brittany Lee-Richardson, *Multiple Identities: Why the Right of Publicity Should be a Federal Law*, 20 UCLA ENT. L. REV. 190 (2013).

182. *In re Elster*, 26 F.4th at 1335.

183. 399 F.3d 871, 874 (7th Cir. 2005) (“A non-Indian maker of jewelry designed to look like jewelry made by Indians is free to advertise the similarity but if he uses the word ‘Indian’ he must qualify the usage so that consumers aren’t confused and think they’re buying not only the kind of jewelry that Indians make, but jewelry that Indians in face made. There is no constitutional infirmity.”).

184. *Id.* at 875.

found that a context-based false association finding by the jury was sufficient, since “[w]e expect the jury would have been confused by such a regulation.”¹⁸⁵ The court thus narrowed the IACA to be a regulation rooted in consumer protection from deception alone, and eschewed the broader interests of and protections for Native American cultural heritage that formed the foundation of the Act.¹⁸⁶ As Rebecca Tushnet noted, “[t]his is part of a broader dynamic that encourages a regulation’s defenders to define their goal as avoiding falsity, since that is the only aim for which current First Amendment commercial speech doctrine has any sympathy.”¹⁸⁷

B. GOVERNMENT SUBSIDIES AND GOVERNMENT PROGRAMS

1. Overview

Government subsidies and government programs are an outgrowth of government speech doctrine. In both situations, the Court is deferent to the government’s decisions to selectively speak, recruit private speakers to speak on its behalf, or selectively provide subsidies, even if such decisions include viewpoint-discrimination. Two key theories underlie this deference. First, where the government speaks, either on its own or through a private entity, it is accountable to the electorate, and the citizenry has the ability to elect new officials if it disagrees with the substance of such speech.¹⁸⁸ This doctrine “reflects the fact that it is the democratic electoral process that first and foremost provides a check on government speech.”¹⁸⁹ Second, the Constitution does not confer an entitlement to funds, even if a lack of such funds prevents a full expression of free speech. In other words, in government program cases, “a decision not to subsidize the exercise of a fundamental right does not infringe the right, and thus is not subject to strict scrutiny.”¹⁹⁰

In government program cases, the government appropriates public funds to establish a program, and “is entitled to broadly define that program’s limits.”¹⁹¹ In other words, discriminating based on viewpoint is reframed as “simply insisting that public funds be spent for the purpose for which they are authorized.”¹⁹² The Court has upheld government program restrictions such as a federal act prohibiting public libraries from receiving certain federal

185. *Id.*

186. Tushnet, *supra* note 173, at 753.

187. *Id.*

188. *Legal Servs. Corp. v. Velazquez*, 531 U.S. 533, 541 (2001).

189. *Walker v. Texas Div.*, 576 U.S. at 207.

190. *Regan v. Tax’n with Representation of Wash.*, 461 U.S. 540, 549 (internal citations omitted).

191. *United States v. Am. Libr. Ass’n*, 539 U.S. 194, 196 (2003).

192. *Id.*

assistance unless they install software blocking obscene or pornographic images,¹⁹³ and a federal regulation that prohibited a medical professional receiving Title X funding from providing abortion counseling.¹⁹⁴

In subsidy cases too, the Court gives Congress “wide latitude” to set its spending priorities.¹⁹⁵ More explicitly, the government “may allocate competitive funding according to criteria that would be impermissible were direct regulation of speech or a criminal penalty at stake.”¹⁹⁶ So, in *National Endowment for the Arts v. Finley*, the Court upheld an act which required a consideration of “decency and respect” in awarding artistic grants.¹⁹⁷

2. *Analogy to Trademark*

Restrictions on government subsidy and government speech are not analogous to trademark registration because trademarks are private, not government speech.¹⁹⁸ As the Court noted, “[t]he Government does not dream up these marks, and it does not edit marks submitted for registration.”¹⁹⁹ Moreover, registration of a mark does not constitute approval of the mark. Finally, the Court held it is unlikely that “more than a tiny fraction of the public has any idea what federal registration of a trademark means.”²⁰⁰ Accordingly, the “accountability” which makes deference to government speech palatable is nearly non-existent in the trademark context.

C. LIMITED PUBLIC FORUM

1. *Overview*

When private speech is restricted on government property, Courts ask whether the property falls within one of a three types of “fora”: a traditional public forum,²⁰¹ a designated public forum, or a limited public forum.²⁰²

193. *Id.* at 195.

194. *Rust v. Sullivan*, 500 U.S. 173 (1991).

195. *Nat'l Endowment for the Arts v. Finley*, 524 U.S. 569, 587 (1998).

196. *Id.* at 571.

197. *Id.*

198. *Tam*, 137 S. Ct. at 1757.

199. *Id.* at 1758.

200. *Id.* at 1759.

201. “When government regulation discriminates among speech-related activities in a public forum, the Equal Protection Clause mandates that the legislation be finely tailored to serve substantial state interests.” *Carey v. Brown*, 447 U.S. 455, 461 (1980). Examples of traditional public forum include: streets and parks that since “time out of mind, have been used for purposes of assembly, communicating thoughts between citizens, and discussing public questions.” *Perry*, 460 U.S. at 45.

202. In first introducing the tripartite framework, the Court labeled the third type of forum as a “nonpublic forum.” *Perry*, 460 U.S. at 45. The Court has since used “nonpublic forum” and “limited public forum” interchangeably. *See, e.g.*, *Minn. Voters Alliance v. Mansky*,

Government property can mean both physical bounds of government ownership, such as government-owned airport terminals²⁰³ and school district mail systems,²⁰⁴ but also property in a “metaphysical” sense, such as a student activities fund²⁰⁵ or a public television broadcast.²⁰⁶ In these cases, the same type of speech restrictions may be valid or invalid depending on the location (metaphysical or otherwise) of the speaker.²⁰⁷

Examples of traditional public forums include streets and parks, which, since “time out of mind,” have been used “for purposes of assembly, communicating thoughts between citizens, and discussing public questions.”²⁰⁸ The state may enforce restrictions on a traditional public forum only if it is content-neutral, narrowly tailored to serve a significant government interest, and “leave[s] open ample alternative channels of communication.”²⁰⁹ Importantly, the Court has held that the government does not create a public forum by inaction, but by intentionally opening up the forum for public discourse.²¹⁰ A government entity can create a *designated* public forum if government property that has not traditionally been regarded as a public forum is intentionally opened up for that purpose,²¹¹ whereby restrictions on speech in such a forum are subject to the same levels of scrutiny as a traditional public forum.²¹²

Finally, the *limited* public forum is a government property (which, again, can be “metaphysical” in nature) that the government has reserved for a specific purpose. “Implicit” in this concept is “the right to make distinctions

138 S. Ct. 1876, 1885 (“Generally speaking, our cases recognize three types of government-controlled spaces: traditional public forums, designated public forums, and nonpublic forums.”); *Christian Legal Soc’y*, 561 U.S. at 679 n.10 (“In conducting forum analysis, our decisions have sorted government property into three categories. First, in traditional public forums Second, [when] governmental entities create designated public forums Third [when] governmental entities establish limited public forums.”).

203. *Int’l Soc’y for Krishna Consciousness, Inc. v. Lee*, 505 U.S. 672 (1992).

204. *Perry Ed. Ass’n v. Perry Local Educators’ Ass’n*, 460 U.S. 37 (1983).

205. *Rosenberger v. Rector & Visitors of Univ. of Va.*, 515 U.S. 819, 830 (1995) (“The [Student Activities Fund] is a forum more in a metaphysical than in a spatial or geographic sense, but the same principles are applicable.”).

206. *Arkansas Educ. Television Comm’n v. Forbes*, 523 U.S. 666 (1998).

207. See Daniel A. Farber & John E. Nowak, *The Misleading Nature of Public Forum Analysis: Content and Context in First Amendment Adjudication*, 70 VA. L. REV. (1984) (“Public forum analysis might well be called the ‘geographical’ approach to first amendment law, because results often hinge almost entirely on the speakers’ location.”).

208. *Perry*, 460 U.S. at 45.

209. *Id.*

210. *Cornelius v. NAACP Leg. Def. Fund*, 473 U.S. 788, 802 (1985).

211. *Id.*

212. *Id.*

in access on the basis of subject matter and speaker identity.”²¹³ These distinctions may be impermissible in a public forum but are inherent and inescapable in the process of limiting a nonpublic forum to activities compatible with the intended purpose of the property.”²¹⁴ The core of this concept is the holding that “government has much more flexibility to craft rules limiting speech,”²¹⁵ but also that the Constitution does not require free access “on every type of Government property without regard to the nature of the property or to the disruption that might be caused by the speaker’s activities.”²¹⁶ As such, as long as the regulation of speech is reasonable for the forum’s intended purpose, and not intended to suppress viewpoints contrary to a public official, it is not in violation of the First Amendment.²¹⁷

For example, a ban on wearing a political badge, button, or political insignia “plainly restricts a form of expression within the protection of the First Amendment.”²¹⁸ However, because a polling place on election day is a nonpublic forum, set aside for the sole purpose of voting, the restriction is only subject to a “reasonable” review in light of the purpose of voting.²¹⁹

To ascertain the creation of such a forum, the Court has looked to (1) the policy and practice of the government and (2) the nature of the property and its compatibility with expressive activity.²²⁰ On (1), the Court uses policy and practice indicia to “ascertain whether [the government] intended to designate a place not traditionally open to assembly and debate as a public forum.”²²¹ On (2), the Court asks whether the forum is clearly a space for expressive activity such that it should be deemed a public forum. That a forum may be used for communication of information and ideas is *not* sufficient to transform the space into a public forum.²²² Moreover, the existence of alternative channels is important to the determination of the forum—“[r]arely will a

213. *Perry*, 460 U.S. at 49.

214. *Id.* at 46.

215. *Id.*

216. *Cornelius*, 473 U.S. at 800.

217. *Id.*

218. *Minn. Voters Alliance*, 138 S. Ct. at 1885.

219. *Id.*

220. *Cornelius*, 473 U.S. at 802.

221. *Id.*

222. *See* *United States Postal Serv. v. Council of Greenburgh Civic Ass’ns*, 449 U.S. 1076 (1981) (holding that U.S. Postal Service letterbox was not a “public forum” even if it was the most efficient means for communication); *Greer v. Spock*, 424 U.S. 828 (1976) (holding that bulletin board in a military base cafeteria not a public forum); *Lehman v. City of Shaker Heights*, 418 U.S. 298 (1974) (holding that advertising space made available in public transportation in a city was not a public forum despite being “specifically used for the communication of information and ideas”).

nonpublic forum provide the only means of contact with a particular audience.”²²³

A recent example of limited public forum analysis is *Christian Legal Society v. Martinez*,²²⁴ in which the Court rejected a First Amendment challenge to Hastings Law School (now UC Law San Francisco) conditioning official school registration on compliance with an “all-comers policy,” pursuant to which student groups must allow any student to participate regardless of that student’s beliefs.²²⁵ The Court found that the case “fit[] comfortably” within the limited public forum category.²²⁵ The Christian Legal Society, which brought the challenge, sought “what is effectively a state subsidy” and faced only indirect pressure to modify its membership policy; it was not prohibited from excluding individuals if it simply forwent the benefits of official school recognition, such as the ability to place announcements in a school newsletter and send emails using a Hastings official email.²²⁶ Further, limited public forum analysis better accounted for the fact that Hastings was “dangling the carrot of subsidy, not wielding the stick of prohibition.”²²⁷ The existence of alternative channels for the group was also significant in the Court’s reasonableness analysis—alongside the fact that Hastings’ interest in the all-comers policy, including its interest in minimizing the “daunting labor” of having to inquire into each club’s rejection of a student, was reasonable, the policy was made “all the more creditworthy” by the significant alternative channels available.²²⁸ Although an unregistered club could not take advantage of certain methods of communication, “the advent of electronic media and social-networking sites reduces the importance of those channels.”²²⁹

2. *Analogy to Trademark*

The trademark registration system can be most appropriately analogized to the limited public forum because it is a forum for private “speech” that offers limited access to benefits, that allows for significant doctrinal emphasis on access to alternative channels. The limited public forum, unlike commercial speech regulation, does not involve outright prohibition of speech. In fact,

223. *Cornelius*, 473 U.S. at 809 (emphasizing “access to alternative channels” beyond the federal contribution system in question, including “direct mail and in-person solicitation outside the workplace”).

224. 561 U.S. 671 (2010).

225. *Id.*

226. *Id.* at 682.

227. *Id.* at 683.

228. *Id.*

229. *Id.*

“[r]arely will a nonpublic forum provide the only means of contact with a particular audience.”²³⁰

As discussed in Section IV.1.a, in determining the existence of a limited public forum, the Court looks to (1) the policy and practice of the government, and (2) the nature of the property and its compatibility with expressive activity. In the first prong, the Court attempts to ascertain whether the government intended to designate a place not traditionally open to assembly and debate as a public forum. For trademark registration, it is clear that in promulgating various requirements for registration, Congress did not intend to designate such registration as a public forum open to all who wish to register trademarks. On the second prong, trademark registration was not created for the purpose of providing or incentivizing a forum for expressive activity.²³¹ That expressive activity may be compatible with trademark registration, “does not imply that the forum thereby becomes a public forum for First Amendment purposes.”²³²

As to “alternative channels,” trademark holders can “communicate” with their desired audience regardless of registration. In other words, the PTO is “dangling the carrot of subsidy” rather than compelling inclusion in a forum it controls.²³³ In *Christian Legal Society*, Hastings dangled the carrot of official club recognition with benefits such as access to school facilities, bulletin boards to advertise events, and use of Hastings’ name and logo. In the trademark registration context, the PTO dangles the carrot of registration with benefits such as a presumption of validity and nationwide notice of ownership as of the registration date.

The above is reaffirmed both by the fact that the Justices seemed to express preference for this model,²³⁴ and that the conclusion subjects trademark registration restrictions to a rational basis review without forcing it

230. *Cornelius*, 473 U.S. at 809 (“Here . . . the speakers have access to alternative channels, including direct mail and in person solicitation outside the workplace, to solicit contributions from federal employees.”).

231. *See supra* Section III.A (noting that federal trademark registration does not alter the rights retained in common law unregistered trademarks, which arise from use in commerce).

232. *Cornelius*, 473 U.S. at 802 (“[T]hat such [expressive] activity occurs in the context of the forum created does not imply that the forum thereby becomes a public forum for First Amendment purposes.”).

233. *See Christian Legal Soc’y*, 561 U.S. at 682.

234. Justice Alito, in his opinion in *Tam*, joined by three Justices, referred to the limited public forum as “potentially more analogous” to trademark registration than the frameworks of government subsidies or government programs. 137 S. Ct. at 1763. Justice Sotomayor, in her opinion in *Brunetti*, noted that in contrast to four Justices’ rejection of cash-subsidy programs as a model for understanding trademark registration, “[n]o Justice, meanwhile, rejected the limited-public-forum analogy.” 139 S. Ct. at 2316 n.10 (concurring in part and dissenting in part).

to become a vessel of false advertising law. In allowing the increased deference of the limited public forum framework, courts will create consistency and clarity for PTO examiners and trademark applicants—with the knowledge that certain provisions aren't subject to potential carveouts—and Congress—with the ability to make further decisions about how best to manage the federal trademark registration system on top of common law. Moreover, while Elster is free to build brand goodwill around the trademark TRUMP TOO SMALL without a registered trademark, preventing registration could potentially increase free expression. Were he to be granted the mark registration, he could more perhaps be more equipped to deter the creation of similar parodies of a national moment.

V. PARODIC USE CARVEOUT?

An illumination of the trademark registration system through First Amendment doctrinal analysis may not sufficiently quell a certain discomfort with the protection of former President Trump's rights to prevent trademark registration of a trademark making fun of him. Surely, for such extreme cases—a parody of a political figure and “the least private name in American life”²³⁵—one might hope there could be a parodic use carveout of § 2(c).²³⁶ Most presidents and political figures, in fact, tend to ignore the use of their names on products.²³⁷ Moreover, as discussed *supra* Section II.A, the purpose of § 2(c) is to protect rights of privacy and publicity of living persons; most states that recognize a right of publicity acknowledge a First Amendment defense.²³⁸ For example, California has adopted a test similar to copyright's fair use doctrine, which considers “whether the work in question adds significant creative elements so as to be transformed into something more than a mere celebrity likeness or imitation.”²³⁹

At the same time, there is a circuit split in the reasoning for such defenses, and courts generally have “failed to articulate a clear standard to resolve the

235. *In re Elster*, 2 F.4th 1328, 1335.

236. *Id.* at 1339 (noting that § 2(c) gave the PTO “no discretion to exempt trademarks that advance parody, criticism, commentary on matters of public importance, artistic transformation, or any other First Amendment interests”).

237. See Ernst, *supra* note 178, at 10 n.10 (citing Dave Gilson, *Most Presidents Ignore Products That Rip Off Their Names. Will Trump?*, MOTHER JONES (Feb. 13, 2017), <https://www.motherjones.com/politics/2017/02/trump-name-publicity-rights/> (“Despite his initial promise to keep a close watch on his image, Obama would eventually ignore thousands of products with no political message that likely infringed on his publicity rights.”).

238. See Rothman & Post, *supra* note 45, at 127.

239. *Id.* (citing *Comedy III Prods., Inc. v. Gary Saderup, Inc.*, 21 P.3d 797, 799 (Cal. 2001)).

conflict, resulting in a confusing morass of inconsistent, incomplete, or mutually exclusive approaches, tests, and standards.”²⁴⁰ Moreover, no proposed balancing test touches on the unique role of trademark registration—a process of content discrimination that does not actually trample on free speech in the way an injunction wholly restricting the sale of a product might. In *Comedy III Productions, Inc. v. Gary Saderup, Inc.*, the California Supreme Court stated that the “transformative” right of publicity test elaborated in the opinion was designed to “protect the right-of-publicity holder’s core interest in monopolizing the merchandising of celebrity images without unnecessarily impinging on the artists’ right of free expression.”²⁴¹ As emphasized in this Note, trademark registration refusal does not impinge on an artist’s free expression, nor does it chill speech in a way that warrants careful balancing with a famous person’s rights. It makes content-based decision based on rational legislative decisions about the kinds of marks to allow in the benefits of trademark registrations, in the way of a limited public forum.²⁴²

Moreover, no aspect of the limited public forum framework would prevent Congress from enacting legislation or amending § 2(c) to include something akin to copyright fair use. However, until the right of publicity is more fully understood—which it may be, as further support for a federal right to publicity is embraced²⁴³—it’s not practical for the PTO to select and apply one of many viable balancing tests to all future potentially parodic applications.²⁴⁴

240. *Id.* at 125 n.167 (citing Roberta Rosenthal Kwall, *A Perspective on Human Dignity, the First Amendment, and the Right of Publicity*, 50 B.C. L. REV. 1345, 1346 (2009) (identifying five different “balancing tests for determining how the right of publicity should be applied in cases presenting First Amendment challenges”).

241. 21 P.3d 797, 808 n.10 (2001).

242. As Rebecca Tushnet sums up her defense of the § 2 provisions, “if we are really that suspicious of government economic regulation picking winners and losers by way of speech, then we shouldn’t even have trademark registration.” Tushnet, *supra* note 41, at 424.

243. *See supra* note 181.

244. *See* Ernst, *supra* note 178 (“Who is to say whether ROYAL KATE jewelry is a brazen attempt to use Kate Middleton’s name to sell jewelry or is, instead (or in addition) a comment on the opulence and materialism of the British royal family?”). Professor Ernst also notes the absurdity in forcing the PTO to make a decision on which courts have been unable to come to agreement, but argues that such a lack of direction is reason not for § 2(c) to remain untouched, but to be struck down completely. He writes that, “[t]he other provisions to section 2 adequately allow the PTO to bar registration if there is deception, passing off, dilution, confusion or any of the other legitimate trademark concerns. Hence, it would appear to do no harm if section 2(c) were eliminated.” However, to do so would confine trademark registration to the realm of commercial speech, where a provision like § 2(c) is meant to do more than regulate deception. *See supra* Section II.B.1.

VI. CONCLUSION

Beyond the doctrinal fit with limited public forum, trademark registration as a limited public forum is a normatively preferable outcome because, in giving deference to the purpose of the forum (and therefore its registration provisions), it would create consistency for courts, applicants, examiners, and, in the case of § 2(c), third parties affected by applications. In addition, preventing registration of expressive language could actually increase free speech by limiting access to one outlet through which individuals could more easily attempt to control culturally and politically important speech. Finally, it would provide Congress with a foundation to enact further registration restrictions outside the bounds of policing deceptive and misleading speech.

In sum, trademark registration is not the regulation of expressive speech or commercial speech, nor is it a form of government speech through the “subsidy” of certain trademarks. In simply providing a benefit to registrants who comply with the requirements of the forum the government opened, registered trademarks look a lot like the registered organizations at UC Hastings. The school, in offering some benefits to “registered” organizations, was simply “dangling the carrot of subsidy,” to achieve compliance with its policy goal, but in no way restricting speech outside the forum for those benefits.²⁴⁵ It’s worth returning one last time to Chief Justice Roberts’ words about trademark registration decisions: “[n]o speech is being restricted; no one is being punished.”²⁴⁶ While it may seem counterintuitive to turn to a confusing corner of First Amendment doctrine to make this relatively simple point clear, it is ultimately the best way to prevent judicial overreach into valid congressional decisions about how to facilitate a federal trademark system in coexistence with common law.

245. *Christian Legal Soc’y*, 561 U.S. at 682.

246. *Brunetti*, 139 S. Ct. at 2302.