

This Opinion is Not a
Precedent of the TTAB

Mailed: July 2, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Steve Elster

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Serial No. 87749230

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Steve Elster, Esq., *pro se*.

Amy Kertgate, Trademark Examining Attorney, Law Office 113,
Myriah Habeeb, Managing Attorney.

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Before Rogers, Chief Administrative Trademark Judge, and
Zervas and Lynch, Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background

Steve Elster (“Applicant”) seeks registration on the Principal Register of the
mark TRUMP TOO SMALL, in standard characters, for:

Shirts; Shirts and short-sleeved shirts; Graphic T-shirts;
Long-sleeved shirts; Short-sleeve shirts; Short-sleeved

Serial No. 87749230

shirts; Short-sleeved or long-sleeved t-shirts; Sweat shirts; T-shirts; Tee shirts; Tee-shirts; Wearable garments and clothing, namely, shirts in International Class 25.¹

The Examining Attorney refused registration of Applicant's proposed mark under Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), on the ground that it comprises matter that may falsely suggest a connection with President Donald J. Trump, and under Section 2(c), 15 U.S.C. § 1052(c), on the ground that it comprises his name without his written consent. Applicant has appealed, and the appeal has been fully briefed.²

We affirm the Section 2(c) refusal, as explained below, and we need not reach the refusal under Section 2(a)'s false association clause. *See In re Society of Health and Physical Educators*, 127 USPQ2d 1584, 1590 (TTAB 2018).

II. Section 2(c) Refusal

Section 2(c) of the Trademark Act precludes, in relevant part, registration of a mark that “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.” 15 U.S.C. § 1052(c). “A key purpose of requiring the consent of a living individual to the registration of his or her name, signature, or portrait is to protect rights of privacy and publicity that living persons have in the designations that identify them.” *In re ADCO Indus.-*

¹ Application Serial No. 87749230 has a filing date of January 10, 2018, and is based on Applicant's assertion of a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), 15 U.S.C. § 1051(b).

² The record includes Applicant's original Brief, 11 TTABVUE, a Supplemental Brief, 16 TTABVUE, submitted following a remand sought by the Examining Attorney to add an additional ground for refusal (the refusal under Section 2(a)), the Examining Attorney's Brief, 19 TTABVUE, and Applicant's Reply Brief, 20 TTABVUE.

Serial No. 87749230

Techs., L.P., 2020 USPQ2d 53786, *20 (TTAB 2020) (citations omitted). Another is to “protect[] consumers against source deception.” *Id.* at *29.

For names, the statute requires that the matter sought to be registered include the name of a particular living individual, rather than merely include words that only by coincidence happen to be someone’s name but which the relevant public generally would not recognize as that living individual’s name. *Martin v. Carter Hawley Hale Stores, Inc.*, 206 USPQ 931, 933 (TTAB 1979). To address the scenario in which the name would not be recognized as identifying the individual, Section 2(c) has been interpreted to mean that when a name appears in a proposed mark, the written consent of the person with that name must be supplied where: (1) the public would reasonably assume a connection between the individual and the goods or services because the individual is so well known; or (2) the individual is publicly connected with the business in which the mark is used. *ADCO*, 2020 USPQ2d 53786 at *22; *see also Martin v. Carter Hawley Hale Stores*, 206 USPQ at 932-33 (“requirement for consent depends upon a determination of whether the mark would be recognized and understood by the public as identifying the person”).

Thus, for example, although the mark[s] “FANTA” and “ARNOLD BRAND” happened to be the names of individuals [i.e., Robert D. Fanta, a tax accountant, who sought to cancel registrations of the mark “FANTA” for soft drinks and for carbonated soft drink and syrup concentrate for making the same, and Arnold Brand, a patent and trademark attorney active in civic affairs, who sought to cancel a registration of a mark containing the words “ARNOLD BRAND” for fresh tomatoes] who were undoubtedly well known in their own spheres, nevertheless, in each case, it was found that the individual in question would not be likely to suffer any

Serial No. 87749230

damage from the registration of the mark at issue because he had never attained any recognition in the field of business in which the mark was used.

Id. at 933 (footnotes omitted) (citing *Fanta v. The Coca-Cola Co.*, 140 USPQ 674 (TTAB 1964) and *Brand v. Fairchester Packing Co.*, 84 USPQ 97 (Comm'r Pat. 1950)).

It is undisputed in this case, and we find, that Applicant's proposed mark includes the surname of President Donald J. Trump. Section 2(c) applies to a proposed mark that includes a particular living individual's surname if the individual is known by that surname alone. *In re Hoefflin*, 97 USPQ2d 1174, 1176 (TTAB 2010) ((holding registration of the marks OBAMA PAJAMA and OBAMA BAHAMA PAJAMAS barred under Section 2(c) because "this statutory sub-section operates to bar the registration of marks containing not only full names, but also surnames ... so long as the name in question does, in fact, 'identify' a particular living individual"); *see also In re Nieves & Nieves LLC*, 113 USPQ2d 1629, 1638 (TTAB 2015) (relevant inquiry is "whether the public would recognize and understand the mark as identifying a particular living individual"). The record in this case includes extensive evidence that the public understands "Trump" alone as a reference to President Donald Trump.³ Significantly, Applicant clearly concedes that his mark "explicitly refers to declared presidential candidate and President

³ E.g., February 19, 2018 Office Action at 6-7; July 30, 2018 Office Action at 57, 65, 67-130; February 25, 2019 Office Action at 5, 11, 24, 31, 54, 57, 59, 61, 63, 65, 69, 71-74; June 24, 2019 Office Action at 17, 25, 32, 41, 51, 116-42.

Serial No. 87749230

Donald Trump.”⁴ The application record does not include a written consent from President Trump, and Applicant makes no argument to the contrary.

Despite Applicant’s direct acknowledgment that his mark includes a name that identifies a particular living individual without his consent, Applicant contends that his mark does not violate Section 2(c) because the relevant public would not presume a connection between President Trump and the goods. According to Applicant, given “how [Donald Trump] depicts himself generally,” the mark in its entirety is “the antithesis of what consumers would understand to be sponsored by, approved by, or supported by Donald Trump.”⁵ Applicant essentially argues that while President Trump strives to make a grandiose impression, Applicant’s mark as a whole conveys that some features of President Trump and his policies are diminutive.⁶ Therefore, Applicant maintains that his mark lacks the necessary connection to the goods under Section 2(c).

Applicant couches the public perception of a connection as a separate inquiry under Section 2(c), but as noted above, the analysis of a connection under the test set forth above regarding Section 2(c) really is just part of determining whether the public would perceive the name in the proposed mark as identifying a particular

⁴ 16 TTABVUE 7 (Applicant’s Supplemental Brief).

⁵ 16 TTABVUE 20 (Applicant’s Supplemental Brief).

⁶ Both Applicant and the Examining Attorney discuss and offer evidence that the 2016 presidential campaign included some widely publicized colloquies, some of which Mr. Trump participated in, about the size of certain parts of his anatomy, such as his hands, which then-presidential candidate Marco Rubio asserted were too small. July 8, 2018 Response to Office Action at 8-24; February 25, 2019 Office Action at 5-7, 24-27. Applicant also submitted evidence of media articles about President Trump’s policies in terms of small size, with headlines such as “The Shrinking of America” and “Trump Orders Largest National Monument Reduction in U.S. History.” *Id.* at 26, 31.

Serial No. 87749230

living individual. In this case, Applicant already has conceded this point. Unlike Section 2(a)'s explicit statutory requirement that the matter in question "falsely suggest a connection," Section 2(c) prohibits registration of any proposed mark that "consists of or comprises a name ... identifying a particular living individual except by his written consent." 15 U.S.C. §§ 1052(a) & (c). The prohibition applies regardless of whether there is a suggested connection. As explained in *Martin v. Carter Hawley Hale Stores*, 206 USPQ at 933:

[I]t is more than likely that any trademark which is comprised of a given name and surname will, in fact, be the name of a real person. But that coincidence, in and of itself, does not give rise to damage to that individual in the absence of other factors from which it may be determined that the particular individual bearing the name in question will be associated with the mark as used on the goods, either because that person is so well known that the public would reasonably assume the connection or because the individual is publicly connected with the business in which the mark is used.

By analogy, the Board in *Hoefflin* held that an application to register OBAMA PAJAMA for pajamas, sleepwear and underwear was barred by Section 2(c) even if "the record does not support the conclusion that President Obama is in any way connected with [such goods]." 97 USPQ2d at 1177. The Board addressed the fame of a President of the United States, stating that "well-known individuals such as celebrities and world-famous political figures are entitled to the protection of Section 2(c) without having to evidence a connection with the involved goods or services." *Id.* The evidentiary record in this case clearly shows that President Trump is extremely well known, not only because of his political office but also

Serial No. 87749230

because of his prior celebrity.⁷ Moreover, even if some further connection to the types of goods identified need be shown, the record reflects that through business enterprises, President Trump's surname has been used as a brand on a wide variety of goods, including shirts.⁸

With a proposed mark such as this one that names someone very well-known such as President Trump, and as Applicant has admitted, there is no question that the public would view the name in question as the name of a particular living individual. As in *ADCO*, decided on a very similar evidentiary record to the one in this case, we find that the proposed mark including TRUMP "identif[ies] Donald Trump, whose identity is renowned. By any measure, ... Donald Trump is a well-known political figure and a celebrity." *ADCO*, 2020 USPQ2d 53786 at *24. Thus, the necessary connection for purposes of Section 2(c) exists. Accordingly, in applying Section 2(c) in this case, we need not probe for a Section 2(a)-type connection as Applicant suggests, but rather just a showing that the relevant public would recognize the name in the mark as that of a particular living individual. Therefore, we reject Applicant's contention that under Section 2(c) a "connection" is necessary, but is foreclosed based on the theory that President Trump would not endorse the message allegedly conveyed by TRUMP TOO SMALL.

⁷ February 19, 2018 Office Action at 45-64 (Time Magazine 2016 Person of the Year); July 30, 2018 Office Action at 51-52 (CBS Los Angeles article about altercation at Donald Trump's Walk of Fame Star); *id.* at 65-133 (various articles in mainstream media about Donald Trump); June 24, 2019 Office Action at 9-144 (various articles in mainstream media about Donald Trump).

⁸ February 19, 2018 Office Action at 14-16, 65, 76; February 25, 2019 Office Action at 52; June 24, 2019 Office Action at 145-99; October 7, 2019 Office Action at 5-50.

Serial No. 87749230

III. Constitutional Challenge to Section 2(c)

Applicant’s appeal focuses primarily on assertions that the statutory refusals to register applied in this case are unconstitutional because they violate his right to free speech under the First Amendment. Applicant alleges that Section 2(a)’s false association provision and Section 2(c)’s particular living individual provision constitute content-based restrictions on private speech, subject to strict scrutiny. According to Applicant, the prohibitions are not narrowly tailored to a compelling state interest, and cannot be justified, in particular when applied to current or former presidents, or presidential candidates, whom Applicant claims have yielded rights of privacy and publicity by seeking the office. Applicant insists that “Presidential candidates and current and former Presidents also invite widespread use of their names and identities in products and services that comment upon the candidates and Presidents in personal and/or political terms.”⁹

The recent *ADCO* case on proposed marks that included TRUMP¹⁰ involved similar constitutionality challenges to Section 2(c) and Section 2(a)’s false association provision. *ADCO Indus.-Techs.*, 2020 USPQ2d 53786 at *25. The Board in *ADCO* stated that regardless of the USPTO’s inability to strike down statutory provisions as unconstitutional, “a constitutional challenge may involve ‘many

⁹ 16 TTABVUE at 21.



¹⁰ The marks at issue in *ADCO* were

Serial No. 87749230

threshold questions . . . to which the [agency] can apply its expertise.” *Id.* at *26 (citing *Elgin v. Dep’t of Treasury*, 567 U.S. 1, 16, 22-23, 132 S. Ct. 2126 (2012)). Accordingly, the Board explained why it does “not agree with Applicant’s challenges based on our experience with Section 2 of the Trademark Act and the purposes underlying it.” *ADCO Indus.-Techs.*, 2020 USPQ2d 53786 at *27 (citations omitted).

As a threshold matter, the Board pointed out that these provisions of the Trademark Act do not control an applicant’s use of a proposed mark, but only set criteria for trademark registration. *Id.* Therefore, contrary to Applicant’s assertions, Sections 2(a) and 2(c) are not direct restrictions on speech. *Id.* Next, the Board addressed the viewpoint-neutrality of Section 2(a)’s false association clause and Section 2(c), thereby distinguishing them from Section 2(a)’s disparagement and immoral/scandalous provisions struck down by the Supreme Court as viewpoint-discriminatory. *Id.* (“the Supreme Court pointedly refrained from extending its holdings to any provisions of the Lanham Act that do not discriminate based on the applicant’s viewpoint”), citing *Iancu v. Brunetti*, 139 S. Ct. 2294, 2019 USPQ2d 232043 at *7, n.*(2019) (addressing immoral/scandalous clause of Section 2(a), noting “Nor do we say anything about how to evaluate viewpoint-neutral restrictions on trademark registration.”) and *id.* at 2303 (Alito, J., concurring) (emphasizing that the Court’s holding turned entirely on the conclusion that the invalidated provision was viewpoint discriminatory); see also *Matal v. Tam*, 137 S. Ct. 1744, 122 USPQ2d 1757 (2017) (addressing disparagement clause of Section 2(a)). As the *Brunetti* Court characterized the holding in *Tam*, “all Members of the

Serial No. 87749230

Court agreed that the [disparagement] provision violated the First Amendment because it discriminated on the basis of viewpoint.” *Brunetti*, 2019 USPQ2d 232043 at *2. Similarly, the *Brunetti* Court held that the immoral/scandalous provision “infringes the First Amendment for the same reason: It too disfavors certain ideas.” *Id.* Clearly, Section 2(c) differs, in that the prohibition applies in an objective, straightforward way to any proposed mark that consists of or comprises the name of a particular living individual, regardless of the viewpoint conveyed by the proposed mark.

Finally, the Board in *ADCO* opined that even if the challenged provisions of Section 2(a) and Section 2(c) were considered as restrictions on speech, they do not run afoul of the First Amendment because “Congress acts well within its authority when it identifies certain types of source-identifiers as being particularly susceptible to deceptive use and enacts restrictions concerning them.” *ADCO Indus.-Techs.*, 2020 USPQ2d 53786 at *29 (citation omitted), *citing S.F. Arts & Athletics, Inc. v. U.S. Olympic Comm.*, 483 U.S. 522, 107 S. Ct. 2971, 3 USPQ2d 1145, 1153 (1987) (“Congress reasonably could conclude that most commercial uses of the Olympic words and symbols are likely to be confusing.”). Both of the statutory provisions at issue “recognize[] the right of privacy and publicity that a living person has in his or her identity and protect[] consumers against source deception.” *ADCO Indus.-Techs.*, 2020 USPQ2d 53786 at *29.

Thus, even if Section 2(c) were subject to greater scrutiny, as Applicant alleges, the statutory provision is narrowly tailored to accomplish these purposes, and

Serial No. 87749230

consistently and reliably applies to any mark that consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent.

Decision: We affirm the refusal to register the proposed mark under Section 2(c) on the ground that it comprises the name of President Donald Trump without his written consent. We do not reach the refusal to register under Section 2(a)'s false association clause.