

Syllabus

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**SUPREME COURT OF THE UNITED STATES**

Syllabus

**VIDAL, UNDER SECRETARY OF COMMERCE FOR  
INTELLECTUAL PROPERTY AND DIRECTOR,  
UNITED STATES PATENT AND TRADEMARK OFFICE  
v. ELSTER**

CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR  
THE FEDERAL CIRCUIT

No. 22–704. Argued November 1, 2023—Decided June 13, 2024

Drawing on a 2016 Presidential primary debate exchange between then-candidate Donald Trump and Senator Marco Rubio, respondent Steve Elster sought to federally register the trademark “Trump too small” to use on shirts and hats. An examiner from the Patent and Trademark Office refused registration based on the “names clause,” a Lanham Act prohibition on the registration of a mark that “[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent,” 15 U. S. C. §1052(c). The Trademark Trial and Appeal Board affirmed, rejecting Elster’s argument that the names clause violates his First Amendment right to free speech. The Federal Circuit reversed.

*Held:* The Lanham Act’s names clause does not violate the First Amendment. Pp. 3–22.

(a) When enforcing the First Amendment’s prohibition against abridging freedom of speech, this Court “distinguish[es] between content-based and content-neutral regulations of speech.” *National Institute of Family and Life Advocates v. Becerra*, 585 U. S. 755, 766. A content-based regulation “target[s] speech based on its communicative content,” *Reed v. Town of Gilbert*, 576 U. S. 155, 163, and is “presumptively unconstitutional,” *National Institute of Family and Life Advocates*, 585 U. S., at 766. Viewpoint discrimination is a particularly “egregious form of content discrimination” that targets not merely a subject matter “but particular views taken by speakers on the subject.” *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U. S. 819, 829.



Cite as: 602 U. S. \_\_\_\_ (2024)

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## SUPREME COURT OF THE UNITED STATES

No. 22–704

KATHERINE K. VIDAL, UNDER SECRETARY OF  
COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR, UNITED STATES PATENT  
AND TRADEMARK OFFICE, PETITIONER  
v. STEVE ELSTER

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF  
APPEALS FOR THE FEDERAL CIRCUIT

[June 13, 2024]

JUSTICE THOMAS announced the judgment of the Court and delivered the opinion of the Court with respect to Parts I, II, and IV, and an opinion with respect to Part III, in which JUSTICE ALITO and JUSTICE GORSUCH join.\*

Steve Elster sought to register the trademark “Trump too small.” But, the Patent and Trademark Office (PTO) refused to register the mark because the Lanham Act prohibits registration of a trademark that “[c]onsists of or comprises a name . . . identifying a particular living individual except by his written consent.” 60 Stat. 428, 15 U. S. C. §1052(c). Elster contends that this prohibition violates his First Amendment right to free speech. We hold that it does not.

### I

A trademark is “a symbol or a device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons.” Trade-Mark

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\*JUSTICE BARRETT joins Parts I, II–A, and II–B of this opinion.

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Cases, 100 U. S. 82, 92 (1879); see also §1127. As we have explained, “[t]he principle underlying trademark protection is that distinctive marks—words, names, symbols, and the like—can help distinguish a particular artisan’s goods from those of others.” *B&B Hardware, Inc. v.*

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small,” accompanied by an illustration of a hand gesture, to use on shirts and hats. The mark draws on an exchange between then-candidate Donald Trump and Senator Marco Rubio during a 2016 Presidential primary debate.

The PTO examiner refused registration under the names clause because the mark used President Trump’s name without his consent. The Trademark Trial and Appeal Board affirmed, and it also re jected Elster’s argument that the names clause violates his First Amendment right to free speech.<sup>1</sup> The Federal Circuit reversed, holding that the names clause violated the First Amendment. *In re Elster*, 26 F. 4th 1328 (CA Fed. 2022). The court first concluded that the names clause is a viewpoint-neutral, content-based restriction on speech subject to -at least intermediate scru-





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based because it prohibited trademarks based only on one viewpoint, immoral or scandalous matter, while permitting trademarks based on other viewpoints. *Id.*, at 393–394.

The names clause does not facially discriminate against any viewpoint. No matter the message a registrant wants to convey, the names clause prohibits marks that use another person’s name without consent. It does not matter “whether the use of [the] name is flattering, critical or neutral.” 2 *McCarthy* §13:37.50. The Government is thus not singling out a trademark “based on the specific motivating ideology or the opinion or perspective of the speaker.” *Reed*, 674 U. S. 117, 133, 137–138, 140–141, 143–144, 146–147, 149–150, 152–153, 155–156, 158–159, 161–162, 164–165, 167–168, 170–171, 173–174, 176–177, 179–180, 182–183, 185–186, 188–189, 191–192, 194–195, 197–198, 200–201, 203–204, 206–207, 209–210, 212–213, 215–216, 218–219, 221–222, 224–225, 227–228, 230–231, 233–234, 236–237, 239–240, 242–243, 245–246, 248–249, 251–252, 254–255, 257–258, 260–261, 263–264, 266–267, 269–270, 272–273, 275–276, 278–279, 281–282, 284–285, 287–288, 290–291, 293–294, 296–297, 299–300, 302–303, 305–306, 308–309, 311–312, 314–315, 317–318, 320–321, 323–324, 326–327, 329–330, 332–333, 335–336, 338–339, 341–342, 344–345, 347–348, 350–351, 353–354, 356–357, 359–360, 362–363, 365–366, 368–369, 371–372, 374–375, 377–378, 380–381, 383–384, 386–387, 389–390, 392–393, 395–396, 398–399, 401–402, 404–405, 407–408, 410–411, 413–414, 416–417, 419–420, 422–423, 425–426, 428–429, 431–432, 434–435, 437–438, 440–441, 443–444, 446–447, 449–450, 452–453, 455–456, 458–459, 461–462, 464–465, 467–468, 470–471, 473–474, 476–477, 479–480, 482–483, 485–486, 488–489, 491–492, 494–495, 497–498, 500–501, 503–504, 506–507, 509–510, 512–513, 515–516, 518–519, 521–522, 524–525, 527–528, 530–531, 533–534, 536–537, 539–540, 542–543, 545–546, 548–549, 551–552, 554–555, 557–558, 560–561, 563–564, 566–567, 569–570, 572–573, 575–576, 578–579, 581–582, 584–585, 587–588, 590–591, 593–594, 596–597, 599–600, 602–603, 605–606, 608–609, 611–612, 614–615, 617–618, 620–621, 623–624, 626–627, 629–630, 632–633, 635–636, 638–639, 641–642, 644–645, 647–648, 650–651, 653–654, 656–657, 659–660, 662–663, 665–666, 668–669, 671–672, 674–675, 677–678, 680–681, 683–684, 686–687, 689–690, 692–693, 695–696, 698–699, 700–701, 703–704, 706–707, 709–710, 712–713, 715–716, 718–719, 721–722, 724–725, 727–728, 730–731, 733–734, 736–737, 739–740, 742–743, 745–746, 748–749, 751–752, 754–755, 757–758, 760–761, 763–764, 766–767, 769–770, 772–773, 775–776, 778–779, 781–782, 784–785, 787–788, 790–791, 793–794, 796–797, 799–800, 802–803, 805–806, 808–809, 811–812, 814–815, 817–818, 820–821, 823–824, 826–827, 829–830, 832–833, 835–836, 838–839, 841–842, 844–845, 847–848, 850–851, 853–854, 856–857, 859–860, 862–863, 865–866, 868–869, 871–872, 874–875, 877–878, 880–881, 883–884, 886–887, 889–890, 892–893, 895–896, 898–899, 900–901, 903–904, 906–907, 909–910, 912–913, 915–916, 918–919, 921–922, 924–925, 927–928, 930–931, 933–934, 936–937, 939–940, 942–943, 945–946, 948–949, 951–952, 954–955, 957–958, 960–961, 963–964, 966–967, 969–970, 972–973, 975–976, 978–979, 981–982, 984–985, 987–988, 990–991, 993–994, 996–997, 999–1000.



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“ha[ve] been long recognized by the common law and the chancery courts of England and of this country, and by the

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Case lieth”). So, the content of the mark (whether it was the same as another person’s) triggered the restriction.

Although there was an early push for federal legislation to protect trademarks, no such law was enacted during our country’s infancy. See B. Paster, *Trademarks—Their Early History*, 59 *Trademark Rep.* 551, 565–566 (1969); see also F. Schechter, *Historical Foundations of the Law Relating to Trade-Marks* 131 (1925) (Schechter). Instead, trademark law fell largely within “the province of the States” for the 18th and most of the 19th century. *Tam*, 582 U. S., at 224. For example, Massachusetts passed a private bill incorporating a cotton corporation on the condition that it affix a label to its goods “with the seal of the said Corporation.” 1 *Mass. Private and Special Laws*, 1789, ch. 43, §5, p. 226 (1805). The law also prevented others from “us[ing] a like seal or label” by subjecting them to treble damages. *Ibid.* . To be sure, for most of our first century, most commerce was local and most consumers therefore knew the source of the goods they purchased. See R. Bone, *Hunting Goodwill: A History of the Concept of G.7 (o)-2.1 (r mn - sc(the4Hunting l226566 .4though)B0.Ai )]TJ /*

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be liable for fraud if he passed the medicine off as that of Thomson. *Ibid.*

In a similar vein, the first reported trademark case in federal court revolved around a trademark's content. Justice Story, sitting as Circuit Justice, granted an injunction to prohibit a seller of spools from infringing on the plaintiff's trademark of "Taylor's Persian Thread." *Taylor v. Carpenter*, 15 F. Cas. 184 (D. Mass. 1844). Justice Story's opinion

prohibits the defendant from selling spools that bear the plaintiff's trademark, (to the plaintiff) MC /HyphenS



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Amendment from the beginning. That longstanding, harmonious relationship suggests that heightened scrutiny need not always apply in this unique context.

The content-based nature of trademark protection is compelled by the historical rationales of trademark law. A trademark has generally served two functions: “indicating ownership of the goods to which it [is] affixed” and “indicating the source or origin of manufacture.” *Schechter* 122. Indicating ownership of a good was needed in part to “fi[x] responsibility for defective merchandise.” Restatement §9, Comment b. And, indicating the source of the good helped “prospective purchasers . . . make their selections based upon the reputation, not merely of the immediate vendor, but also of the manufacturer.” *Ibid* . Both goals thus reflect

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the First Amendment” (internal quotation marks omitted)); post, at 6 (opinion of S OTOMAYOR, J.); post, at 6–7 (opinion of BARRETT, J.).

## C

We have acknowledged that trademark rights and restrictions can “play well with the First Amendment.” Jack Daniel’s, 599 U. S., at 159 (internal quotation marks omitted). In this case, we do not delineate an exhaustive framework for when a content-based trademark restriction passes muster under the First Amendment. But, in evaluating a solely content-based trademark restriction, we can consider its history and tradition, as we have done before when considering the scope of the First Amendment. See *City of Austin v. Reagan Nat. Advertising of Austin, LLC*, 596 U. S. 61, 75 (2022); *id.*, at 101 (T HOMAS, J., dissenting); *R. A. V.*, 505 U. S., at 382–383; *Roth v. United States*, 354 U. S. 476, 482–483 (1957).

The Lanham Act’s names clause has deep roots in our legal tradition. Our courts have long recognized that trademarks containing names may be restricted. And, these name restrictions served established principles. This history and tradition is sufficient to conclude that the names clause—a content-based, but viewpoint-neutral, trademark restriction—is compatible with the First Amendment. We need look no further in this case.

## 1

Restrictions on trademarking names have a long history. See generally 2 *McCarthy* §13:5. Such restrictions have historically been grounded in the notion that a person has



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Chemical Co. v. Meyer, 139 U. S. 540, 544 (1891). It is therefore “an elementary principle that every man is entitled to the use of his own name in his own business.” F. Treadway, Personal Trade-Names, 6 Yale L. J. 141, 143–144 (1897) (Treadway); see also A. Greeley, Foreign Patent and Trademark Laws §138, p. 135 (1899) (“The right of any one to place his own name on goods sold by him is recognized as a natural right and cannot be interfered with”). “The notion that people should be able to use their own name to identify their goods or business is deeply rooted in American mores.” B. Pattisha II, D. Hilliard, & J. Welch, Trademarks and Unfair Competition §2.06 (2001).

Recognizing a person’s ownership over his name, the common law restricted the trademarking of names. It prevented a person from trademarking any name—even his own—by itself. In “the early years of trademark law,” courts recognized that “there can be no trade-mark in the name of a person, because . . . every person has the right to use his own name for the purposes of trade.” 2 McCarthy §13:5 (internal quotation marks omitted); see also Restatement §14, Comment e (“[A]t early common law, the recognition of an unencumbered right to use one’s name in trade effectively precluded the existence of trademark or trade name rights in personal names”); W. Browne, Law of Trade-Marks §206, p. 219 (2d ed. 1885) (“The rule is, that a man cannot turn his mere name into a trade-mark”);

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share the same name.” J. Rothman, *Navigating the Identity Thicket*, 135 *Harv. L. Rev.* 1271, 1306 (2022); see also *Treadway* 143–144. In other words, a person’s right to his name cannot be exclusive as to other people bearing the same name: John Smith cannot acquire a trademark that prohibits other John Smiths from using their own names. See *McLean*, 96 U. S., at 252 (“[H]e cannot have such a right, even in his own name, as against another person of the same name, unless such other person uses a form of stamp or label so like that used by the complaining party as to represent that the goods of the former are of the latter’s manufacture”); accord, *Brown Chemical*, 139 U. S., at 542; *McNeely v. McNeely*, 62 N. Y. 427, 432 (Ct. App. 1875); see also *Treadway* 143; accord, *post*, at 10 (opinion of B ARRETT, J.). Consider the case of John L. Faber and John H. Faber, two men who independently manufactured lead pencils near Nuremberg, Germany. Both men stamped the pencils they manufactured with their shared surname. After recognizing that each man “had the right to put his own name on his own pencils,” the New York Supreme Court declined to allow one man to effectively trademark the other man’s name. *Faber v. Faber*, 3 *Abb. Pr. (N. S.)* 115, 116 (1867).

We see no evidence that the common law afforded protection to a person seeking a trademark of another living person’s name. To the contrary, English courts recognized that selling a product under another person’s name could be actionable fraud. See, e.g., *Singleton*, 3 *Dougl.* 293, 99 *Eng. Rep.* 661; *Croft v. Day*, 7 *Beav.* 84, 88, 49 *Eng. Rep.* 994, 996 (1843) (“[N]o man has a right to sell his goods as the goods of another”). This recognition carried over to our country. See *McLean*, 96 U. S., at 252 (“[I]t is doubtless correct to say that a person may have a right in his own name as a trademark as against a trader or dealer of a different name”); see also *Faber*, 3 *Abb. Pr. (N. S.)*, at 116. Even in the absence of fraud, it would be difficult, if not impossible, to square such a right to trademark another person’s name with our



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law” rather than writing trademark law from scratch. Restatement §9, Comment e; see also W. Derenberg, *Trade-Mark Protection and Unfair Trade* 22 (1936) (explaining that the “function [of federal trademark law] is essentially an evidential one, reflecting the underlying common law trade-mark right with the existence of which it rises and falls”). It is thus unsurprising that the Lanham Act included the names clause, prohibiting the registration of a mark containing “a name . . . identifying a particular living individual except by his written consent.” §1052(c). The names clause reflects the common law’s careful treatment of names when it comes to trademarks.

The restriction on trademarking names also reflects trademark law’s historical rationale of identifying the source of goods. See *Hanover Star Milling Co. v. Metcalf*, 240 U. S. 403, 412 (1916) (“The primary and proper function of a trade-mark is to identify the origin or ownership of the article to which it is affixed”); accord, *post*, at 8 (opinion of BARRETT, J.). Trademark protection ensures that consumers know the source of a product and can thus evaluate it based upon the manufacturer’s reputation and goodwill. See Restatement §9, Comment b; see also *Powell v. Birmingham Vinegar Brewery Co.*, 13 Rep. Pat. Cas. 235, 250 (Ct. App. 1896) (Lindley, L. J.) (“His mark, as used by him, has given a reputation to his goods. His trade depends greatly on such reputation. His mark sells his goods”). By barring a person from using another’s name, the names clause reflects the traditional rationale of ensuring that consumers make no mistake about who is responsible for a product. See also *Hanover Star Milling Co.*, 240 U. S., at 412–413 (“The essence of the wrong [for trademark infringement] consists in the sale of the goods of one manufacturer or vendor for those of another”).

Moreover, the names clause respects the established connection between a trademark and its protection of the mark-







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analogue may require a different approach. Post, at 15.

But, we need not develop such a comprehensive theory to

address the relatively simple pK 5-8.8VAN(5-2 8 (5-8.8U(5-2 8GH(S))TJ 0 Tw 10.98 0

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Post, at 15 (Opinion of Elster), 2015 WL 100728 >>BDCd-.









Cite as: 602 U. S. \_\_\_\_ (2024)

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BARRETT, J., concurring in part

**SUPREME COURT OF THE UNITED STATES**

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No. 22–704

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KATHERINE K. VIDAL, UNDER SECRETARY OF  
COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR, UNITED STATES PATENT  
AND TRADEMARK OFFICE, PETITIONER



BARRETT, J., concurring in part

## A

As the Court explains, trademark law existed at the founding, albeit in nascent form. Ante, at 7; B. Pattishall, *The Constitutional Foundations of American Trademark Law*, 78 *Trademark Rep.* 456, 457–459 (1988). From the outset, trademark protection “was an inherently content-based endeavor.” Ante, at 7. Early English and American laws prohibited producers from placing another producer’s trademark on their goods—a prohibition that depended on comparing the content of the mark with the content of the allegedly infringing use. Ante, at 7–8. That alone does not prove that every type of content-based trademark regulation should escape heightened scrutiny. More relevant is that courts and legislatures, in identifying the marks that merit legal protection, have long discriminated on the basis of content. Ante, at 9–10. This history, in my view, is key to understanding why we need not evaluate content-based trademark registration restrictions under heightened scrutiny.

Once trademark law got off the ground in the mid-19th century, it had an unmistakably content-based character. *Thomson v. Winchester*, the first reported American trademark case, involved two parties who both sold medicine under the name “ ‘Thomsonian Medicines.’ ” 36 *Mass.* 214, 216



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mark merits protection only so far as it “identif[ies] the article to which it is affixed as that of the person adopting it, and distinguish[es] it from others.” *Gillott v. Esterbrook*, 47 Barb. 455, 462 (N. Y. Sup. Ct. 1867), *aff’d*, 48 N. Y. 374 (1872); see also *Matal v. Tam*, 582 U. S. 218, 223 (2017). This inquiry is inherently content based.

The ratification of the Fourteenth Amendment in 1868, which incorporated the First Amendment against the States, did not prompt courts to change course.<sup>1</sup> They continued to scrutinize proposed marks based on their content. Likewise, this Court’s first trademark decision, issued in 1871, invoked *Amoskeag*’s content-based criteria to define those trademarks “entitled to legal protection.” *Canal Co. v. Clark*, 13 Wall. 311, 323–324 (1872) (concluding that “geographical names,” including “ ‘Pennsylvania wheat’ ” and “ ‘Virginia tobacco,’ ” could not be protected as trademarks,



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to the content of the applicant’s mark. See 15 U. S. C. §1052. Thus, just as courts have long identified the criteria for trademark protection along content-based lines, Congress has defined the rules for enhanced trademark protection along content-based lines.

## B

The upshot is that content discrimination has long been “necessary for [trademark’s] purposes and limitations.” See *Legal Services Corporation v. Velazquez*, 531 U. S. 533, 543 (2001) (considering the “accepted usage” of a “particular medium” to determine the constitutionality of speech restrictions within that medium). The law protects trademarks because they help consumers identify the goods that they intend to purchase and allow producers to “reap the financial rewards associated with the[ir] product’s good reputation.” *Jack Daniel’s Properties, Inc. v. VIP Products LLC*, 599 U. S. 140, 146 (2023); see also *Falkinburg*, 35 Cal., at 64. But trademarks can only fulfill these twin goals if they actually serve as source identifiers, see *Jack Daniel’s*, 599 U. S., at 146, which, as explained above, is a content-based question, see *supra*, at 4–5.

These content-based trademark rules have long coexisted with the Free Speech Clause, and their function is generally compatible with it. Courts have applied content-based rules not to “suppres[s] . . . ideas,” but simply to serve trademark law’s purposes. See *Davenport*, 551 U. S., at 189 (internal quotation marks omitted). Indeed, these trademark restrictions can actually help prevent “interfere[nce] with the marketplace of ideas,” *id.*, at 188, insofar as they ensure that a single producer cannot exclusively appropriate words or phrases in the general domain, see *Wolfe*, 18 How. Pr., at 67. This is not to say that the Government could not abuse content-based trademark registration restrictions—as I explain below, such restrictions are not insulated from scru-

BARRETT, J., concurring in part

tiny. But they do not set off alarm bells signaling the likelihood that “ ‘official suppression of ideas is afoot.’ ” *Davenport*, 551 U. S., at 189 (quoting *R. A. V.*, 505 U. S., at 390). Therefore, I agree with the Court that we need not treat content-based trademark registration restrictions as presumptively unconstitutional. *Ante*, at 6.

## II

Though content-based registration restrictions do not trigger strict scrutiny, they are still subject to judicial review. Thus, we must decide how to evaluate *Elster*’s challenge to the names clause.

The Solicitor General suggests that we draw an analogy to another area that is inherently content based: the limited public forum. When the government opens its property to speech for a particular purpose, creating a limited public forum, it necessarily must “reserv[e the property] for certain groups or for the discussion of certain topics.” *Rosenberger v. Rector and Visitors of Univ. of Va.*, 515 U. S. 819, 829 (1995). Content-based restrictions are “inherent and inescapable” in maintaining a forum for speech “compatible with the intended purpose of the property.” *Perry Ed. Assn. v. Perry Local Educators’ Assn.*, 460 U. S. 37, 49 (1983). It is therefore inappropriate to view these restrictions as presumptively unconstitutional and apply strict scrutiny. Still, not every restriction is permissible. T-ct Tc54i/ulh a Tc 0.02ekfor swhecny. BDC 0.0815T



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necessarily identify its source. See *supra*, at 4–5. The bar on registering “deceptive” marks likewise prevents registered marks from misidentifying the source of the goods. §1052(a).

The names clause passes muster under this test. A trademark that includes another living person’s name without her consent has the obvious potential to create source confusion. Further, the clause helps protect producer goodwill. By freely using another person’s name in her mark, the markowner can unfairly capitalize on the reputation of the named individual, who may be a producer in her own right. Conversely, if the markowner’s goods or services are shoddy, she might jeopardize the named individual’s reputation.

Elster protests that consumers would not assume that Donald Trump is responsible for the mark “ ‘Trump too small.’ ” Brief for Respondent 35. Thus, he argues that even if the names clause generally guards against source confusion, refusing to register his proposed mark does not. But Congress is entitled to make categorical judgments, particularly where heightened scrutiny does not apply. The Government can reasonably determine that, on the whole, protecting marks that include another living person’s name without consent risks undermining the goals of trademark. The names clause is therefore constitutional, both facially and as applied to Elster’s mark.

### III

Rather than adopt a generally applicable principle, the Court asse 08 Td 2twholoprop (etoreraT\* (ofieputationcre, )er, the cld 2) (ms.9 (7k)4.bly deta

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## A

First, the Court's history. It is true that "a tradition of restricting the trademarking of names" arose in the late 19th century. Ante, at 19. As the Court says, a personal name by itself, without any accompanying words or symbols, did not typically qualify as a trademark. See *McLean v. Fleming*, 96 U. S. 245, 252–253 (1878); ante, at 13. And a person could not always enforce a trademark including her own name against another with the same name. See *Brown Chemical Co. v. Meyer*, 139 U. S. 540, 542 (1891); ante, at 14.<sup>3</sup> The first federal trademark statute reflected these principles, prohibiting the registration of a mark that was "merely the name of a person, firm, or corporation only, unaccompanied by a mark sufficient to distinguish it from the same name when used by other persons." §79, 16 Stat. 211. Today, the Lanham Act continues to bar the registration of a mark that is "primarily merely a surname." 15 U. S. C. §1052(e)(4).fds,



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Holmes Shoe Co. v. Delsarte Mfg. Co., 46 A. 1089 (N. J. Ch. Ct. 1900) (“The name of a famous person, used merely as a fancy name, may become an exclusive trade-mark”); W. Browne, *Law of Trade-Marks* §216, pp. 225–226 (2d ed. 1885) (same).<sup>5</sup>

The legislative history of the Lanham Act also undercuts the Court’s conclusion. If the names clause codified an existing common-law tradition, one might expect to see some reference to that tradition when the names clause was adopted. But proponents of the clause offered a different justification. Discussing a predecessor version of the clause, Edward Rogers, the Lanham Act’s primary drafter, remarked that “[t]he idea of prostituting great names by sticking them on all kinds of goods is very distasteful to

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law would already prevent those uses of another’s name as a trademark. On the contrary, they seemed most concerned about the types of marks that the common law appeared to allow. See *supra*, at 11.

It is thus difficult to say that the names clause is constitutional solely because of its historical pedigree.<sup>6</sup> Perhaps recognizing that reality, the Court relies not only on the purported common-law tradition restricting the trademarking of names, but also points to the names clause’s relation to trademark’s historical purposes. *Ante*, at 16–18. The latter argument is quite similar to my own—I agree that the names clause helps to ensure that the proposed mark functions as a source identifier and to guard against reputational consequences, serving trademark’s historical goals.

## B

But I cannot agree with the Court that the existence of a “common-law tradition” and a “historical analogue” is sufficient to resolve this case. *Ante*, at 19–20. Even if the Court’s evidence were rock solid, I still would not adopt this approach. To be sure, tradition has a legitimate role to play in constitutional adjudication. For instance, the longstanding practice of the political branches can reinforce our understanding of the Constitution’s original meaning. *Consumer Financial Protection Bureau v. Community Financial Services Assn. of America, Ltd.*, 601 U. S. 416, 442 (2024) (KAGAN, J., concurring). A course of deliberate practice might liquidate ambiguous constitutional provisions. See *The Federalist* No. 37, p. 229 (C. Rossiter ed.

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<sup>6</sup>The Court characterizes my critique as a demand for a “historical twin.” *Ante*, at 19, n. 4. On the contrary, my point is that the Court has not cleared the “historical analogue” bar it sets for itself. The existence of closely analogous historical counterexamples surely complicates the argument that “history and tradition” alone establish the clause’s constitutionality. By presenting its evidence as conclusive, “the Court overclaims.” *Samia v. United States*, 599 U. S. 635, 657 (2023) (BARRETT, J., concurring in part and concurring in judgment).



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1961). The views of preceding generations can persuade, and, in the realm of *stare decisis*, even bind. But tradition is not an end in itself—and I fear that the Court uses it that way here.

The Court does not (and could not) argue that the late-19th and early-20th century names-restriction tradition serves as evidence of the original meaning of the Free Speech Clause. Cf. *Samia v. United States*, 599 U. S. 635, 655–656 (2023) (BARRETT, J., concurring in part and concurring in judgment). Nor does it treat the history it recites as a persuasive data point. Instead, it presents tradition itself as the constitutional argument; the late-19th and early-20th century evidence is dispositive of the First Amendment issue. Yet what is the theoretical justification for using tradition that way?

Relying exclusively on history and tradition may seem like a way of avoiding judge-made tests. But a rule rendering tradition dispositive is itself a judge-made test. And I do not see a good reason to resolve this case using that approach rather than by adopting a generally applicable principle. (After all, there is a tradition of the latter approach too. See, e.g., *McCulloch v. Maryland*, 4 Wheat. 316, 421 (1819) (adopting standard for application of the Necessary and Proper Clause).) In the course of applying broadly worded text like the Free Speech Clause, courts must inevitably articulate principles to resolve individual cases. I do not think we can or should avoid doing so here. As I explained in Part I–B, the takeaway from history is that content-based trademark restrictions have long been central to trademark’s purpose of facilitating source identification, and they have not posed a serious risk of censorship. This principle offers a generally applicable way to think about whether registration restrictions “ ‘play well with the First Amendment.’ ” Ante, at 12. We should bring clarity to the law by adopting it.

In my view, the Court’s laser-like focus on the history of

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this single restriction misses the forest for the trees. It gives secondary billing to what I think is the central point: that the names clause “reflects trademark law’s historical rationale of identifying the source of goods.” Ante, at 16. I see no reason to proceed based on pedigree rather than principle. Besides, as the Court admits, its approach

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SUPREME COURT OF THE UNITED STATES

No. 22–704

KATHERINE K. VIDAL, UNDER SECRETARY OF  
COMMERCE FOR INTELLECTUAL PROPERTY  
AND DIRECTOR, UNITED STATES PATENT  
AND TRADEMARK OFFICE, PETITIONER  
v. STEVE ELSTER

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF  
APPEALS FOR THE FEDERAL CIRCUIT

[June 13, 2024]

JUSTICE SOTOMAYOR, with whom JUSTICE KAGAN and JUSTICE JACKSON join, concurring in the judgment.

This case involves a free-speech challenge to a viewpoint-neutral, content-based condition on trademark registration. In deciding how to evaluate this kind of challenge, the Court faces two options: Either look only to the history and tradition of the condition, or look to trademark law and settled First Amendment precedent. The first option, which asks whether the history of a particular trademark registration bar plays well with the First Amendment, leads this Court into uncharted territory that neither party requests. The other guides it through well-trodden terrain. I would follow the well-trodden path.

In assessing the constitutionality of the names clause and other trademark registration provisions, I would rely on this Court’s tried-and-tested First Amendment precedent. This Court has held in a variety of contexts that withholding benefits for content-based, viewpoint-neutral reasons



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idea or message expressed”). The names clause is also viewpoint neutral because it is agnostic as to how the name in the mark is being used and does not “distinguish between two opposed sets of ideas.” *Brunetti*, 588 U. S., at 394; see ante, at 5 and n. 2 (majority opinion) (holding that the clause is viewpoint neutral both on its face and in practice). On these points, and on the conclusion that the names clause is constitutional, we all agree. Our disagreement boils down primarily to methodology.

## B

Those familiar with this trilogy of First Amendment challenges to the Lanham Act may be surprised, perhaps even disappointed, to learn that, although this case presents the “situation we did not address in *Tam* or *Brunetti*,” the Court has shied away from setting forth a “framework ‘for deciding free speech challenges to provisions of the Lanham Act.’” Ante, at 6 (majority opinion) (quoting *Tam*, 582 U. S., at 245, n. 17 (plurality opinion)). Yet perhaps the biggest surprise (and disappointment) of today’s five-Justice majority opinion is its reliance on history and tradition as a dispositive test to resolve this case.

In holding that the names clause is constitutional, that majority asserts that one need look only to the “history and tradition” of the clause and “no further.” Ante, at 12. Why look to history and tradition alone? Because, the majority says, it “is sufficient to conclude that the names clause . . . is compatible with the First Amendment.” *Ibid*. Considering this Court has never applied this kind of history-and-tradition test to a free-speech challenge, and that “[n]o one briefed, argued, or even hinted at the rule that the Court announces today,” one would have expected a more satisfactory explanation. *Lozman v. Riviera Beach*, 585 U. S. 871 (2018) (T(218 TTj 0.0008 Tc 0 Tw [ 0 T

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sufficient explanation in part by claiming that, if anything, the Court's evidence "does not establish a historical analogue for the names clause." Ante, at 1 (opinion concurring in part). That may well be true. Yet this back-and-forth highlights the indeterminacy of the Court's history-and-tradition inquiry, which one might aptly describe as the equivalent of entering a crowded cocktail party and looking over everyone's heads to find your friends. Cf. *Conroy v. Aniskoff*, 507 U. S. 511, 519 (1993) (Scalia, J., concurring in judgment). To make matters worse, the five-Justice majority that undertakes this tradition-as-dispositive inquiry found its friends in a crowded party to which it was not invited. That majority has drawn conclusive inferences from its historical evidence, all without any guidance from the litigants or the court below. That stark departure from settled principles of party presentation and adversarial testing in favor of in-chambers historical research by nonhistorians raises more questions than answers. Cf. *Maslenjak v. United States*, 582 U. S. 335, 354 (2017) (GORSUCH, J., joined by THOMAS, J., concurring in part and concurring in judgment) ("[T]he crucible of adversarial testing on which we usually depend, along with the experience of our thoughtful colleagues on the district and circuit benches, could yield insights (or reveal pitfalls) we cannot muster guided only by our own lights").

It is not appropriate, much less necessary, to find common-law analogues to settle the constitutionality of the names clause or any other trademark registration provision. I agree with JUSTICE BARRETT that, even if the majority's historical "evidence were rock solid," there is no good reason to believe that "hunting for historical forebears on a restriction-by-restriction basis is the right way to analyze the constitutional question." Ante, at 1, 13. The majority attempts to reassure litigants and the lower courts that a "history-focused approach" here is sensible and workable, by citing to *New York State Rifle & Pistol Assn., Inc. v.*







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longstanding practice of government can inform the meaning of constitutional provisions in appropriate cases. See ante, at 13–15 (opinion of B ARRETT, J.); cf. *Consumer Financial Protection Bureau v. Community Financial Services Assn. of America, Ltd.*, 601 U. S. 416, 442 (2024) (KAGAN, J., concurring); *The Pocket Veto Case*, 279 U. S. 655, 689 (1929). That is not how the five-Justice majority is using history, however. The majority instead treats a disputed (and isolated) account of the history and tradition of the names clause as determinative of its constitutionality. Cf. ante, at 12–20 (applying new history-and-tradition test). It is that “judge-made test” that is unmoored from constitutional text and precedent, and which I repudiate as unhelpful. Ante, at 14 (opinion of B ARRETT, J.).

Even then, history does not give us the full story. The assertion that content-based distinctions in trademark law have long played well with the First Amendment, although true, requires a more fulsome explanation, particularly as applied to the trademark registration system. The primary reason why viewpoint-neutral trademark registration criteria easily coexist with the Free Speech Clause is that they do not burden expression. Instead, a denial of registration withholds ancillary benefits that might bolster someone’s expression. When a government confers a benefit that supports some forms of expressive activity, the decision to withhold that benefit on viewpoint-neutral grounds “ ‘cannot be equated with the imposition of a “penalty” on that activity,’ ” which would trigger heightened scrutiny. *Rust v. Sullivan*, 500 U. S. 173, 193 (1991) (quoting *Harris v. McRae*, 448 U. S. 297, 317, n. 19 (1980)).

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“The First Amendment protects the freedom of speech; it does not require the Government to give aid

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dissenting in part). Indeed, this Court has recognized repeatedly that the First Amendment permits governmental bodies to rely on reasonable, viewpoint-neutral, content-based criteria when deciding to benefit certain communicative activities. See, e.g., *National Endowment for Arts v. Finley*, 524 U. S. 569, 587–588 (1998) (“[T]he Government may allocate competitive funding according to criteria that would be impermissible were direct regulation of speech or a criminal penalty at stake”).

As I explained in *Brunetti*, and the Solicitor General argues in this case, various strands of precedent support this point, ranging from cases about limited public (or nonpublic) forums to those involving monetary subsidies and non-cash governmental programs (such as the collection of fees by public-sector labor unions). See 588 U. S., at 422–424 (collecting cases); Brief for Petitioner 16–21 (same).<sup>1</sup> In these cases, content discrimination was necessarily a part of the governmental initiative at issue, yet the initiative was not subject to the constitutional straitjacket of heightened scrutiny. See, e.g., *Perry Ed. Assn. v. Perry Local Educators’ Assn.*, 460 U. S. 37, 49 (1983) (noting that content discrimination is “[i]mplicit in the concept of the nonpublic forum,” yet declining to apply heightened scrutiny). That was so because each “initiative . . . supported some forms of expression without restricting others. Some speakers were better off, but no speakers were worse off.” *Brunetti*, 588 U. S., at 423 (opinion of SOTOMAYOR, J.).

These cases “may not be controlling [here] in a strict

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<sup>1</sup> According to JUSTICE THOMAS (who is joined by two Justices), I focus primarily on cash-subsidy and union-due cases. A closer look at this opinion and the cases that I cite will reveal that is not exactly true. As I mentioned in *Brunetti*, and both the Government and JUSTICE BARRETT assert in this case, limited public (or nonpublic) forum cases also constitute helpful analogies for arriving at the generally applicable principles that should apply to this kind of case. See Brief for Petitioner 18–19; accord, ante, at 7–9, and n. 2 (opinion of BARRETT, J.).

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(opinion of SOTOMAYOR, J.). From this Court's analogous nonpublic-forum and limited-public-forum cases, it is clear that "reasonable" means that the challenged provision must reasonably serve the purpose of the content-based scheme. On this point, I agree with JUSTICE BARRUSTI



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Jorge Posada to capitalize on their goodwill to promote the products. So, the manufacturer lands on JETER OUT OF THE PARK and CATCH LIKE POSADA as marks. The names clause bars registration of these phrases without the named individuals' written consent. It does so for good reason: Jeter and Posada may not want consumers to misattribute these products to them, just as consumers may not want to buy products under the false pretense that these goods somehow are connected to the players.<sup>3</sup> Source identification is especially important when, for example, the named individual produces similar products—say, Jeter and Posada sell their own baseball goods under the marks MR. NOVEMBER BATS BY JETER and CHAMP'S MITTS BY POSADA. They would not want manufacturers to dilute the commercial value of their name and reputation. Nor would Jeter and Posada want a Boston Red Sox fan to manufacture cheaper goods and use their names to promote second-rate products. The names clause prevents that from happening.

Congress was entitled to make this legislative judgment. The Government, after all, “has a reasonable interest in refraining from lending its ancillary support to marks” that use an unconsenting individual's name for commercial gain. *Brunetti*, 588 U. S., at 425 (opinion of S OTOMAYOR, J.); cf.



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