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# The Trademark Problem of 'TRUMP TOO SMALL'

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Michael Grynberg \*

### INTRODUCTION

Consider the phrase—and my apologies for asking—"Trump too small." It comes from the 2016 campaign for the Republican presidential nomination. A back-and-forth between Donald Trump and Florida Senator Marco Rubio culminated in a debate exchange about the size of Trump's penis.<sup>1</sup> This cultural low prompted one Steve Elster to seek registration of the trademark TRUMP TOO SMALL for use on shirts.<sup>2</sup> The Patent and Trademark Office ("PTO") refused, relying on section 2(c) of the Lanham Act, which bars registering a mark that "[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual" absent written consent.<sup>3</sup>

*In re Elster* reversed the PTO's rejection of Elster's application.<sup>4</sup> The Federal Circuit ruled that applying the section 2(c) bar to TRUMP TOO SMALL would unduly burden Elster's First Amendment rights.<sup>5</sup> This is nonsense. If we are concerned with burdens on speech, the larger issue is the prospect that registering the mark would create opportunities to limit others' ability to use the phrase as speech.<sup>6</sup> But it is nonsense well-grounded in recent Supreme Court opinions that use the First Amendment to strike down the Lanham Act's bars to registering disparaging and scandalous marks.<sup>7</sup>

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1. Emily Crockett, "Donald Trump Just Defended His Penis Size at the Republican Debate," VOX (Mar. 3, 2016, 10:03 PM), <https://www.vox.com/2016/3/3/11158910/trump-penis-republican-debate-fox> [<https://perma.cc/56EN-6RV8>] [<https://web.archive.org/web/20221003200708/https://www.vox.com/2016/3/3/11158910/trump-penis-republican-debate-fox>].

2. U.S. Trademark Application Serial No. 87749230 (filed Jan. 10, 2018). More precisely, the application is based on intent to use, so even if approved, Elster would still need to use the mark in commerce before it could be registered. 15 U.S.C. § 1051(d).

3. 15 U.S.C. § 1052(c).

4. 26 F.4th 1328 (Fed. Cir. 2022).

5. *Id.*

6. *In re Tam*, 808 F.3d 1321, 1378 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016), *aff'd sub nom.*, *Matal v. Tam*, 137 S. Ct. 1744 (2017) (Reyna, J., dissenting) ("But if the expressive content of the mark precludes regulation, on what authority may the government grant . . . the exclusive right to use this mark in commerce?").

7. See *Matal v. Tam*, 137 S. Ct. 1744 (2017) (striking down the bar); *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019) (striking down the bar to registering scandalous marks).

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First Amendment implications aside, *Elster* highlights the bind facing the PTO when presented with low-quality trademarks. TRUMP TOO SMALL is not an effective brand name. When seen on a T-shirt, the phrase will naturally be read as an insulting commentary on the former President, not as a source indicator. But trademark law allows logos and slogans to be protected as merchandise.<sup>8</sup> Even if the TRUMP TOO SMALL application is intended to support a merchandising play,<sup>9</sup> that is not enough reason in and of itself to deny the registration.

But apparent merchandising efforts like TRUMP TOO SMALL are different in kind from merchandising related to sports or university paraphernalia, for they lack any pre-existing goodwill to monetize. In effect, many would-be merchandisers are free riders, seeking to reap where they have not sown by capitalizing on cultural moments or other circumstances unconnected to their efforts.<sup>10</sup> Trademark law lacks an effective vocabulary for these situations, placing significant pressure on nebulous doctrines like “failure to function” that may not be able to bear the weight increasingly placed on them to screen out low-quality trademarks.<sup>11</sup> *In re Elster* thus illustrates a problem relating not to the First Amendment but rather to the choice to make trademark doctrine the vehicle for vindicating markholders’ merchandising interests.

## I. THE HISTORY OF TRUMP TOO SMALL

### A. THE ATTEMPTED REGISTRATION

In case you repressed the memory, the Republican Presidential Debate of March 3, 2016, featured a surreal exchange. Florida Senator Marco Rubio and future President Donald Trump traded arguments about whether Rubio had personally attacked Trump. Trump then stated: “I have to say this. He hit my hands. Nobody has ever hit my hands.

8. See *infra* Part II.B.

9. To be clear, I do not know Elster’s plans and make no claims about them. The application was based on intent to use, so there was no specimen. That said, one of Elster’s submissions to the PTO contained this image:



Serial No. 87749230, Response to Office Action at 7, Sept. 9, 2019.

10. See *infra* Part II.C.

11. See *infra* Part II.D.

I have never heard of this. Look at those hands. Are they small hands?" The audience laughed, and Trump continued, "he referred to my hands, if they are small, something else must be small. I guarantee you there is no problem. I guarantee."<sup>12</sup>

What was that about? One account summarized:

Yes, Rubio made fun of Trump on the campaign trail for having small hands. But it wasn't the first time that's happened. Trump has famously been defensive of his hands since *Spy* magazine first called him a "short-fingered Vulgarian" in 1988. Trump still occasionally sends the editor of the now-defunct publication pictures of his hands to prove that his fingers aren't short.<sup>13</sup>

Enter Steve Elster, who sought to register TRUMP TOO SMALL with the PTO as a trademark. His application, filed on an intent-to-use basis,<sup>14</sup> sought registration of the mark for: "Shirts; Shirts and short-sleeved shirts; Graphic T-shirts; Long-sleeved shirts; Short-sleeve shirts; Short-sleeved 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."<sup>15</sup>

The examining attorney refused registration based on sections 2(a) and 2(c) of the Lanham Act.<sup>16</sup> Section 2(a) prohibits registration of a mark containing matter that may "falsely suggest a connection with persons, living or dead."<sup>17</sup> Section 2(c) blocks registration of a mark that "[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual" absent written consent.<sup>18</sup> Neither bar may be surmounted by showing that the claimed mark has acquired secondary meaning.<sup>19</sup>

Citing *l'affaire* Rubio, Elster argued that registration was appropriate because the mark "is political commentary about presidential candidate and president Donald Trump that the relevant consumer in the United States would not understand to be

12. Ryan Teague Beckwith, *Read the Full Transcript of the Eleventh Republican Debate in Detroit*, TIME (Mar. 4, 2016, 1:06 AM), <https://time.com/4247496/republican-debate-transcript-eleventh-detroit-fox-news> [<https://perma.cc/8QWR-DD46>] [<https://web.archive.org/web/20221003201804/https://time.com/4247496/republican-debate-transcript-eleventh-detroit-fox-news>].

13. Crockett, *supra* note 1. Senator Rubio later apologized for the precipitating insinuation. Salvador Hernandez, *Marco Rubio Says He's Sorry for Implying Donald Trump Has a Small Dick*, BUZZFEED NEWS (May 29, 2016, 5:11 PM), <https://www.buzzfeednews.com/article/salvadorhernandez/yep> [<https://perma.cc/V4XB-39HL>] [<https://web.archive.org/web/20221003202337/https://www.buzzfeednews.com/article/salvadorhernandez/yep>].

14. Filing a trademark application on an intent-to-use basis means that the application is not based on existing uses of the claimed mark. *Trademark Applications—Intent-to-Use (ITU) Basis*, PTO, <https://www.PTO.gov/trademarks/apply/intent-use-itu-applications> [<https://perma.cc/UE23-LV2B>] [<https://web.archive.org/web/20221009183400/https://www.PTO.gov/trademarks/apply/intent-use-itu-applications>] (last visited Oct. 9, 2022).

15. U.S. Trademark Application Serial No. 87749230 (filed Jan. 10, 2018).

16. Serial No. 87749230, Office Action Outgoing, dated Oct. 7, 2019.

17. 15 U.S.C. § 1052(a).

18. 15 U.S.C. § 1052(c).

19. 15 U.S.C. § 1052(f).

sponsored by, endorsed by, or affiliated with Donald Trump.”<sup>20</sup> The Trademark Trial and Appeal Board (“TTAB”) affirmed the section 2(c) refusal, not reaching the 2(a) bar.<sup>21</sup> Elster raised a First Amendment challenge to the application of section 2(c), but the TTAB argued that section 2(c) is narrowly tailored to serve two government interests: specifically, protecting the rights of privacy and publicity of the person referred to by the mark.<sup>22</sup>

### B. *IN RE ELSTER*

Elster’s appeal to the Federal Circuit met with more success.<sup>23</sup> *In re Elster* begins its analysis by noting how the Supreme Court changed trademark registration law in *Matal v. Tam*<sup>24</sup> and *Iancu v. Brunetti*.<sup>25</sup> The cases struck down the Lanham Act’s bars against registering marks containing disparaging<sup>26</sup> and scandalous<sup>27</sup> matter, respectively, as unconstitutional viewpoint discrimination. *Elster* adheres to the frame established by *Tam* and *Brunetti* by treating denials of trademark registrations as speech burdens. In doing so, the opinion acknowledges the counterargument that registration denials do not prevent anyone from using the content in question:

We recognize . . . that section 2(c) does not prevent Elster from communicating his message outright. But whether Elster is free to communicate his message without the benefit of trademark registration is not the relevant inquiry—it is whether section 2(c) can legally disadvantage the speech at issue here.<sup>28</sup>

20. Serial No. 87749230, Response to Office Action at 1, Feb. 19, 2018.

21. Elster, Serial No. 87749230 (T.T.A.B. July 2, 2020), <https://ttabvue.uspto.gov/ttabvue/ttabvue-87749230-EXA-23.pdf> [<https://perma.cc/GZ7F-ZLRE>] [<https://web.archive.org/web/20221003203808/https://ttabvue.uspto.gov/ttabvue/ttabvue-87749230-EXA-23.pdf>]. The opinion was not published.

22. *Id.* at 10 (“Thus, even if Section 2(c) were subject to greater scrutiny, as Applicant alleges, the statutory provision is narrowly tailored to accomplish these purposes[.]”). The Board also argued that the law prevents source confusion. *Id.* at 10.

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

24. *Matal v. Tam*, 137 S. Ct. 1744 (2017).

25. *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

26. 15 U.S.C. § 1052(a) (prohibiting registration of any matters that “disparage” any persons).

27. *Id.* (prohibiting registration of “immoral” or “scandalous” matter).

28. *Elster*, 26 F.4th at 1331–32. And, as noted above, though registration denials do not prevent anyone from using a mark’s content, registrations *do*. Judge Reyna noted the problem in his dissent at the Circuit level in *In re Tam*, the case that brought First Amendment scrutiny to the registration process. *In re Tam*, 808 F.3d 1321, 1378 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016), *aff’d sub nom.*, *Matal v. Tam*, 137 S. Ct. 1744 (2017) (Reyna, J., dissenting) (“But if the expressive *content* of the mark precludes regulation, on what authority may the government grant . . . the exclusive right to use this mark in commerce?”); *see generally* Rebecca Tushnet, *The First Amendment Walks into A Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381, 386 (2016) (“Another constitutional jurisprudence could use the fact that a trademark confers a private right to suppress other people’s speech as a reason that the government can make balancing decisions about whom to favor.”).

The court also rejected the argument that trademark registrations are government subsidies that should escape scrutiny if viewpoint discrimination is not at issue.<sup>29</sup> In any case, the court viewed *Tam* and *Brunetti* as requiring First Amendment scrutiny even if registrations were considered to be subsidies.<sup>30</sup> Finally, the fact that the speech in question was on merchandise did not affect the level of First Amendment scrutiny.<sup>31</sup>

Having set the stage, the court described TRUMP TOO SMALL as precisely the kind of speech that requires close First Amendment review. "[T]he right to criticize public men' is '[o]ne of the prerogatives of American citizenship.'" <sup>32</sup> With those stakes in mind, the court turned to whether enforcement of the section 2(c) bar protects any compelling or substantial government interests.<sup>33</sup> Echoing the TTAB, the government argued that by protecting privacy and publicity rights, section 2(c) vindicates both compelling and substantial government interests.<sup>34</sup>

Without passing on the argument as a general matter, the court responded that Trump's status as a political figure and celebrity complicates matters. "[T]he 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."<sup>35</sup> As for Trump's publicity interests, no one claimed that his "name is being misappropriated in a manner that exploits his commercial interests or dilutes the commercial value of his name, an existing trademark, or some other form of intellectual property."<sup>36</sup> Nor was there any "plausible claim" that Trump had endorsed Elster's product, which the court viewed as more a question for analysis under the section 2(a) bar in any case.<sup>37</sup> Finally, Elster's use was likely not a violation of Trump's publicity rights given the doctrine's built-in safeguards for protecting freedom of expression.<sup>38</sup>

29. *Id.* at 1332.

30. *Id.* Nor, in the court's view, do registrations constitute a limited public forum. *Id.* at 1332–33.

31. *Id.* at 1333.

32. *Id.* at 1334 (quoting *Baumgartner v. United States*, 322 U.S. 665, 673–74 (1944)).

33. The court described the section 2(c) bar as a content-based, rather than viewpoint-based, limitation. *Id.* at 1331.

34. Brief for Appellee at 8, *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022) ("Under the widely recognized rights of publicity and privacy, individuals possess a protectable intellectual property interest in the commercial use of their own identities."); *id.* at 41 ("Section 2(c) furthers the substantial governmental interest in ensuring that the federal government does not facilitate the infringement of the rights of publicity and privacy recognized under state law, while also buttressing provisions designed to prevent consumers from mistakenly believing an identified individual is associated with a product.").

35. *Elster*, 26 F.4th at 1335 (quoting Brief for Appellant at 35).

36. *Id.* at 1336.

37. *Id.*

38. *Id.* at 1337 ("The Restatement of Unfair Competition recognizes that challenges under state-law publicity statutes are 'fundamentally constrained by the public and constitutional interest in freedom of expression,' such that the 'use of a person's identity primarily for the purpose of communicating information or expressing ideas is not generally actionable as a violation of the person's right of publicity.'") (quoting RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 47 cmt. (c)); *id.* at 1338 ("The government has no valid publicity interest that could overcome the First Amendment protections afforded to the political criticism embodied in Elster's mark. As a result of the President's status as a public official, and because Elster's mark communicates his disagreement with and criticism of the then-President's approach to governance, the government has no interest in disadvantaging Elster's speech.").

Accordingly, regardless of whether strict or intermediate scrutiny applies,<sup>39</sup> “[t]he PTO’s refusal to register Elster’s mark cannot be sustained because the government does not have a privacy or publicity interest in restricting speech critical of government officials or public figures in the trademark context—at least absent actual malice, which is not alleged here.”<sup>40</sup>

Elster only brought an as-applied challenge, so the court left section 2(c) on the books, but noted the prospect that the provision may be constitutionally overbroad:

It may be that a substantial number of section 2(c)’s applications would be unconstitutional. The statute leaves 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. It effectively grants all public figures the power to restrict trademarks constituting First Amendment expression before they occur.<sup>41</sup>

## II. TRUMP TOO SMALL AND THE LOGIC OF MERCHANDISING

Following Supreme Court precedent, *Elster* frames the dispute over TRUMP TOO SMALL as primarily a question of First Amendment—rather than trademark—law. The Federal Circuit’s approach therefore overlooks several important trademark questions at stake in this case and others like it. They include the way merchandising interests may undermine trademark quality and the difficulty trademark law has with accommodating merchandising interests in general.

### A. TRUMP TOO SMALL AND TRADEMARK QUALITY

Imagine you are opening a widget factory, and you need a brand name. Imagine further that Donald Trump were not famous for all the reasons that he is. Which mark looks better to you, TRUMP or TRUMP TOO SMALL? If it helps to return to reality and a famous Donald Trump, do you prefer EAGLE or TRUMP TOO SMALL?

If either decision gives you pause, think about what you need from your mark. It needs to stand as a repository of meaning that you will fill with associations concerning your product. What is the product? How good is it? Who is it for? How much does it cost? For a mark to answer these questions, it needs to be something that consumers can remember and pick out from the competition. That is, it needs to be distinctive and memorable.<sup>42</sup> Is TRUMP TOO SMALL easy to remember? When your buyers see it, will they think trademark, or something else? A joke, perhaps? Maybe they’ll think the

39. The court continued the trend of withholding judgment on whether the intermediate scrutiny standard of commercial speech cases would apply. *Id.* at 1338–39.

40. *Id.* at 1339.

41. *Id.*

42. BYRON SHARP, *HOW BRANDS GROW* 195 (2010) (“Distinctive, consistent icons and imagery build memory associations that allow a brand to be noticed and recalled in a range of buying situations.”).

phrase is political commentary. But you are not in the political commentary business, you are selling widgets.<sup>43</sup>

On this logic, TRUMP or EAGLE is a superior mark to TRUMP TOO SMALL. Either mark has significantly more potential for being mentally available to purchasers, that is, they are easier to remember. And because they do not bring other meanings along as baggage, they will be easier to pair with associations that are expected to promote sales.<sup>44</sup> In earlier work, I've argued that trademark law systematically favors "empty vessels" like these because they are better able to perform the trademark function<sup>45</sup> than marks that bring market-relevant or distracting information to the table. Trademark law's promotion of empty vessels dovetails with the demands of effective branding. Marketers should prefer marks that are mentally available to consumers so shoppers can distinguish them from competing products.<sup>46</sup> Small wonder, then, that TRUMP was a federally-registered trademark long before Donald Trump was even born.<sup>47</sup>

Nonetheless, "TRUMP TOO SMALL" *could* be a trademark. Given its insulting nature, moreover, TRUMP TOO SMALL does not mislead as to approval, nor would it—in my view, anyway—infringe existing TRUMP marks. But in the ordinary case, we wouldn't expect a reasonable seller to select such a mark to identify and distinguish their goods. Stated another way, seller incentives alone ordinarily do a lot to promote the trademark quality function without the need for trademark law to intervene. In the ordinary course of events, one would not expect to see marks like TRUMP TOO SMALL regardless of how the PTO does its job.

## B. THE PROBLEM OF MERCHANDISING

Of course, Elster *did* attempt to register TRUMP TOO SMALL, and his decision is perfectly sensible if he's not selling widgets but merchandise. Stated another way, placing TRUMP TOO SMALL on T-shirts makes sense if the slogan *is* the product (as when the slogan is on the face of the shirts themselves), but not if his purpose is to brand a product (as when the slogan is used on shirt labels).

We thus arrive to the problem of merchandising in trademark law. Nobody would think that TRUMP TOO SMALL emblazoned on a shirt identifies the source of the shirt. The message is an obvious insult. Though not a good mark for that reason, there may well be a market for T-shirts and other paraphernalia bearing that message. Although protection for the insult is a poor fit for trademark law, trademark law has for decades allowed trademark holders to claim merchandising rights over their

43. And if you are in the political commentary game? Hold that thought.

44. See Michael Grynberg, *A Trademark Defense of the Disparagement Bar*, 126 YALE L.J. F. 178, 184–87 (2016).

45. *Id.* at 183–90.

46. SHARP, *supra* note 42, at 180 ("Brands largely compete in terms of physical and mental . . . availability. . . . Building mental availability requires distinctiveness and clear branding.").

47. See TRUMP, Registration No. 235,312. The registration was for "dress and negligee shirts" and the registration date of November 15, 1927 predates the Lanham Act. PTO records show an assignment to Donald Trump, recorded on May 10, 2006. The registration is now dead for lack of renewal.



marks.<sup>48</sup> Even though merchandised marks fail to identify source—no Red Sox fan believes that a baseball cap featuring the Boston Red Sox “B” is made by either the team or Major League Baseball—judges typically conclude that consumers seeing unauthorized merchandise are likely to be confused about whether the mark holder has licensed the trademark on the good in question.<sup>49</sup>

As a result, trademark holders can extract monopoly rents from consumers. However much trademark scholars criticize this state of affairs,<sup>50</sup> it is one that seems to comport with the moral intuitions of judges and consumers alike.<sup>51</sup> Unfortunately, the merchandising right creates multiple problems for trademark law independent of my inability to find a fairly priced Red Sox cap.

### C. MERCHANDISING, WELL-KNOWN MARKS, AND FREE RIDERS

The merchandising right incentivizes the pursuit of low-quality marks whose appeal is independent of any effort by the would-be trademark holder. This is a form of free riding, which trademark law normally condemns.<sup>52</sup> To understand why, consider popular merchandised marks. Imagine your favorite sports team, or university. Now picture the name or logo that adorns its merchandise. Does it perform the trademark function effectively? Usually, these are perfectly good marks in their “home” market. For example, BOSTON RED SOX identifies a source of baseball services independently of the mark’s licensed use on baseball caps.<sup>53</sup> DUKE names a provider of education services independent of its use on various BLUE DEVIL merchandise.<sup>54</sup> So too for trademark holders outside the sports realm. Suppose Volkswagen wants control of the

48. See, e.g., *Boston Pro. Hockey Ass’n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 510 F.2d 1004, 1011 (5th Cir. 1975).

49. See, e.g., *Bd. Of Supervisors for La. State Univ. Agric. & Mech. Coll. v. Smack Apparel Co.*, 550 F.3d 465, 485 (5th Cir. 2008) (“[T]he inescapable conclusion is that many consumers would likely be confused and believe that [defendant’s] t-shirts were sponsored or endorsed by the [plaintiff] Universities.”). The approach of focusing on perceived licensing at least has a textual basis in the Lanham Act. See 15 U.S.C. § 1125(a) (providing cause of action against use of a device that is “likely to cause confusion” as to “the origin, sponsorship, or approval” by the plaintiff of the defendant’s goods). PTO practice has long accepted this view of trademark rights. See *In re Olin Corp.*, 181 U.S.P.Q. (BNA) 182 (T.T.A.B. 1973) (observing that a university’s name on a shirt is ornamentation, but the name “will also advise the purchaser that the university is the secondary source of that shirt. . . . [T]he university’s name on the shirt will indicate the sponsorship or authorization by the university.”).

50. See Michael Grynberg, *Living with the Merchandising Right*, — YALE J.L. & TECH. — (forthcoming) (Sept. 22, 2022) at 2 n.2 (collecting citations) (unpublished manuscript) [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=4055689](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4055689) [<https://perma.cc/93A7-PWY7>] [[https://web.archive.org/web/20220922193029/https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=4055689](https://web.archive.org/web/20220922193029/https://papers.ssrn.com/sol3/papers.cfm?abstract_id=4055689)].

51. *Id.* at 11–19; Matthew B. Kugler, *The Materiality of Sponsorship Confusion*, 50 U.C. DAVIS L. REV. 1911, 1953, 1957 (2017).

52. See, e.g., Mark A. Lemley & Mark P. McKenna, *Owning Mark(et)s*, 109 MICH. L. REV. 137, 146–156 (2010).

53. See BOSTON RED SOX, No. 1,095,47 (for “Entertainment services in the nature of baseball exhibitions”).

54. For an account of Duke’s aggressive practices policing its marks, see James Boyle & Jennifer Jenkins, *Mark of the Devil: The University as Brand Bully*, 31 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 391, 411 (2020).

market for VW keychains.<sup>55</sup> Volkswagen cannot claim that right unless VW functions as a trademark in the first instance. That is, merchandising rights in keychains will not work for the letters "VW" if those letters do not also function in their original role of identifying and distinguishing Volkswagen cars.<sup>56</sup>

The dual function of merchandised marks helps explain why the law grants trademark holders control over the merchandising markets. Logoed merchandise is typically purchased by fans. Because the mark holders played a role in generating the goodwill motivating the purchases, courts assume that they "earned" the merchandise markets. *Boston Professional Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, the foundational merchandising rights case, makes the point explicitly in its observation that "the major commercial value of the emblems is derived from the efforts of plaintiffs."<sup>57</sup>

To be sure, we might disagree with the underlying moral premise.<sup>58</sup> Alternatively, one might argue that fans should enjoy the consumer surplus that would come with free competition in the sale of merchandised marks given the role of fandom in creating the value of merchandised marks. Nonetheless, cases like *Boston Professional Hockey* reflect a common intuition.<sup>59</sup> To the courts, trademark holders in merchandising cases have earned their markets. By contrast, defendants seeking to merchandise goods featuring others' trademarks are free riders who are reaping where they have not sown.<sup>60</sup>

In many cases, however, those pursuing merchandising rights are not seeking to exploit earned goodwill but are rather free riding themselves. Some attempted registrations look like efforts to capitalize on someone else's fame<sup>61</sup> or exploit a cultural moment.<sup>62</sup> In these cases, the person seeking to reap where they have not sown is the applicant.

The multiple applications seeking a trademark registration for the phrase "I can't breathe" provide a particularly stark example. In 2014, Eric Garner was killed by police during his arrest on suspicion of selling untaxed cigarettes. Before losing consciousness

55. There is no need to suppose. See *Au-Tomotive Gold v. Volkswagen of Am.*, 457 F.3d 1062 (9th Cir. 2006).

56. *Id.* at 1074–75 (refusing to allow aesthetic functionality defense for products incorporating trademarks because the complementary appeal of such products for owners of trademarked cars is "indistinguishable from and tied to the marks source-identifying nature").

57. 510 F.2d at 1011.

58. See, e.g., Mark A. Lemley, *Property, Intellectual Property, and Free Riding*, 83 TEX. L. REV. 1031, 1032 (2005).

59. Kugler, *supra* note 5151, at 1957.

60. See, e.g., *Bos. Athletic Ass'n v. Sullivan*, 867 F.2d 22, 33 (1st Cir. 1989).

61. See, e.g., *In re Sauer*, 27 U.S.P.Q.2d 1073 (T.T.A.B 1993), *aff'd*, 26 F.3d 140 (Fed. Cir. 1994) (refusing registration of BO BALL for object evoking football and baseball and thus Bo Jackson).

62. The COVID-19 pandemic, for example, produced many attempted registrations. See Irene Calboli, *Trademarks and the Covid-19 Pandemic: An Empirical Analysis of Trademark Applications Including the Terms "Covid," "Coronavirus," "Quarantine," "Social Distancing," "Six Feet Apart," and "Shelter in Place"*, 54 AKRON L. REV. 401, 415 (2020) ("That sensational events may function as a powerful tool to sell products is further evidenced by the fact that the largest number of applications were filed for merchandising and promotional products. These products include apparels, household items such as coasters, mugs, and glassware, decorations, adhesive stickers, and more.").

from a chokehold after being brought to the ground, Garner said "I can't breathe."<sup>63</sup> His death by head and chest compression was declared a homicide,<sup>64</sup> though no charges were brought against the arresting officers.<sup>65</sup> Many of the protests that followed featured the phrase,<sup>66</sup> as did some of the protests following the 2020 murder of George Floyd, who also spoke the words as he was dying.<sup>67</sup>

In both cases, trademark registration applications were filed for the phrase "I can't breathe" soon after the incidents.<sup>68</sup> Like "Trump too small," "I can't breathe" evokes significant non-source meanings. Moreover, granting trademark rights over the phrase would not reward (or form the basis of rewarding in the future) goodwill generated in a traditional market where the mark is actually used as a source indicator. Such rights only enable exploitation of fame that the would-be trademark owners had nothing to do with creating.<sup>69</sup>

63. Al Baker, David J. Goodman, & Benjamin Mueller, *Beyond the Chokehold: The Path to Eric Garner's Death*, N.Y. TIMES (June 13, 2015), <https://www.nytimes.com/2015/06/14/nyregion/eric-garner-police-chokehold-staten-island.html> [<https://perma.cc/3P5M-TRKE>] [<https://web.archive.org/web/20220922025744/https://www.nytimes.com/2015/06/14/nyregion/eric-garner-police-chokehold-staten-island.html>].

64. Jake Pearson, *Autopsy: Police Chokehold Caused NYC Man's Death*, ASSOCIATED PRESS (Aug. 1, 2014), <https://web.archive.org/web/20140804033643/https://bigstory.ap.org/article/medical-examiner-says-chokehold-police-officer-caused-death-nyc-man-ruled-homicide> [<https://perma.cc/57AG-QPZC>] [<https://web.archive.org/web/20140804033643/https://bigstory.ap.org/article/medical-examiner-says-chokehold-police-officer-caused-death-nyc-man-ruled-homicide>].

65. Al Baker et al., *supra* note 63.

66. See, e.g., Scott Cacciola, *At Nets' Game, a Plan for a Simple Statement Is Carried Out to a T*, N.Y. TIMES (Dec. 9, 2014), <http://www.nytimes.com/2014/12/10/sports/basketball/i-cant-breathe-tshirts-in-the-nba-how-jayz-lebron-james-and-others-made-them-happen.html> [<https://perma.cc/PWX5-CYRT>] [<https://web.archive.org/web/20220922030013/https://www.nytimes.com/2014/12/10/sports/basketball/i-cant-breathe-tshirts-in-the-nba-how-jayz-lebron-james-and-others-made-them-happen.html>].

67. Mike Baker, Jennifer Valentino-DeVries, Manny Fernandez, Michael LaForgia, *Three Words. 70 Cases. The Tragic History of 'I Can't Breathe'*, N.Y. TIMES (June 29, 2020), <https://www.nytimes.com/interactive/2020/06/28/us/i-cant-breathe-police-arrest.html> [<https://perma.cc/PN36-STXP>] [<https://web.archive.org/web/20220922030254/https://www.nytimes.com/interactive/2020/06/28/us/i-cant-breathe-police-arrest.html>]. The *New York Times* reports that "[o]ver the past decade . . . at least 70 people have died in law enforcement custody after saying the same words—'I can't breathe.'" *Id.*

68. A TESS search of the phrase "I can't breathe" shows twelve attempts for the phrase alone as well as others containing additional words or variations. As might be expected, these efforts drew public condemnation. See, e.g., Tim Lince, *'Reprehensible'—GEORGE FLOYD and I CANT BREATHE Trademark Applications Filed*, WORLD TRADEMARK R. (June 8, 2020), <https://www.worldtrademarkreview.com/governmentpolicy/reprehensible-george-floyd-and-i-cant-breathe-trademark-applications-filed> [<https://perma.cc/NKK2-CXJB>] [<https://web.archive.org/web/20220922030427/https://www.worldtrademarkreview.com/article/reprehensible-george-floyd-and-i-cant-breathe-trademark-applications-filed>]; Derrick Clifton, *Worst Person Ever Just Filed a Trademark for 'I Can't Breathe'*, MIC, (Dec. 19, 2014), <https://www.mic.com/articles/106890/someone-filed-a-trademark-for-i-can-t-breathe-and-it-s-utterly-disgusting> [<https://perma.cc/T6NC-KJHP>] [<https://web.archive.org/web/20220922030537/https://www.mic.com/articles/106890/someone-filed-a-trademark-for-i-can-t-breathe-and-it-s-utterly-disgusting>].

69. It would also create the prospect that a trademark registration might be used to suppress speech, thus placing pressure on trademark law's various doctrinal mechanisms to protect free expression.

#### D. GAPS IN THE SYSTEM

Trademark law does not have reliable mechanisms for dealing with the pursuit of weak marks for merchandising purposes. One of the benefits of section 2(c) was that it offered a fairly "clean" way to dispose of applications to register a subset of weak marks. The provision is both statutory (and therefore not open to challenge as the product of administrative fiat) and relatively easy to apply. Thanks to *In re Elster*, however, it may be on its way to joining the now-unavailable disparagement and scandalous bars on the sidelines of trademark law.

The PTO may need to fill the gap with increasing use of the sometimes-vague failure-to-function doctrine. Failure-to-function has traditionally been best known as a way of managing the submission of registration specimens, giving the PTO a basis for rejecting applications that use marks in a manner inconsistent with ordinary branding<sup>70</sup>—e.g., placing a trademark on the face of a shirt, rather than on a label.<sup>71</sup> This allows the rejection of marks used as merchandise, but leaves would-be merchandisers with the ability to modify their applications to include more traditional trademark uses.<sup>72</sup> Having then secured a registration, they may be able to deploy the registration in support of merchandising-based claims.<sup>73</sup> This is so even though trademark holders may not have done anything to earn the goodwill that courts normally see as deserving of merchandising rights.<sup>74</sup>

In recent years, the PTO has made increasing use of the failure-to-function principle to challenge marks that do not perform the trademark function well as a matter of semantic meaning.<sup>75</sup> This is how the PTO turned away the first effort to register "I can't breathe" as a mark. The examining attorney concluded that it was informational

70. See TMEP § 904.07(b) (July 2022); § 1202.03; see generally Alexandra J. Roberts, *Trademark Failure to Function*, 104 IOWA L. REV. 1977, 1989–97 (2019).

71. The TMEP explains that one needs to "consider the size, location, and dominance of the proposed mark, as applied to the goods, to determine whether ornamental matter serves a trademark function." Accordingly, a "small, neat, and discrete word or design feature (e.g., small design of animal over pocket or breast portion of shirt) may be likely to create the commercial impression of a trademark, whereas a larger rendition of the same matter emblazoned across the front of a garment (or a tote bag, or the like) may be perceived merely as a decorative or ornamental feature of the goods. However, a small, neat, and discrete word or design feature will not necessarily be perceived as a mark in all cases." TMEP § 1202.03(a) (July 2022).

72. *LTTB, LLC v. Redbubble, Inc.*, 385 F. Supp. 3d 916, 919 (N.D. Cal. 2019) (describing initial refusal to register the mark LETTUCE TURNIP THE BEET), *aff'd*, 840 F. App'x 148 (9th Cir. 2021). Moreover, the PTO will accept registrations where there is reason to view the otherwise ornamental mark as signaling sponsorship. See TMEP § 1202.03 (July 2022) ("Ornamental matter that serves as an identifier of a 'secondary source' is registrable on the Principal Register. For example, ornamental matter on a T-shirt (e.g., the designation 'NEW YORK UNIVERSITY') can convey to the purchasing public the 'secondary source' of the T-shirt (rather than the manufacturing source). Thus, even where the T-shirt is distributed by a party other than that identified by the designation, sponsorship or authorization by the identified party is indicated."); § 1202.03(c) (July 2022).

73. *LTTB*, 385 F. Supp. 2d at 917–18.

74. Grynberg, *supra* note 50, at 43–48.

75. Lucas Daniel Cuatrecasas, Note, *Failure to Function and Trademark Law's Outermost Bound*, 96 N.Y.U. L. REV. 1312, 1328 (2021) ("[A] mark's semantic meaning and inherent nature have become essential to today's failure-to-function cases."); *id.* at 1326 (charting refusals).

matter.<sup>76</sup> A similar argument could be made with respect to “Trump too small.” Semantic uses of failure-to-function principles may also fill the gap left by the use of the First Amendment to strike down the disparagement and scandalous bars.<sup>77</sup> But the option faces several difficulties. While traceable to the statute,<sup>78</sup> failure-to-function analysis is open to challenge as being unclear in practice.<sup>79</sup> This, in turn, invites potential second guessing by the often IP-maximalist Federal Circuit.<sup>80</sup>

Whatever the end equilibrium, it is worth bearing in mind that the root of the problem lies not in First Amendment law but in trademark doctrine. The PTO is in this box due to the successful effort by markholders to create a special trademark right for the use of marks as merchandise. By their very nature, such uses are hard to fit into trademark doctrine. Instability in the law is the inevitable result.<sup>81</sup>

### III. CONCLUSION

The increasing prominence of First Amendment challenges to statutory registration bars disrupts the already unsteady relationship between trademark law and merchandising practices. In a normal market, would-be trademark holders have an incentive to select marks that perform the trademark function well. The judicial invention of a trademark merchandising right altered these incentives. For many mark holders, the merchandising right created an opportunity to exploit the goodwill of existing, functional, marks in a new market. But for some, the merchandising right is an opportunity to pursue ineffective marks that lack either preexisting goodwill or the plausible prospect of developing such goodwill. These marks may nonetheless be profitable as merchandise if trademark law may be used to confer monopoly rights over their sale. The PTO has some tools to moderate these pursuits, but courts are using the First Amendment to remove some of them. *In re Elster* continues this trend, increasing the pressure on vaguer alternatives like failure-to-function. Ultimately, however, the

76. Serial No. 86479784, Office Action Outgoing, Mar. 4, 2015; *see also* TMEP § 1202.04 (July 2022) (“[m]erely informational matter fails to function as a mark to indicate source and thus is not registrable.”). Notably, however, the examining attorney also pointed to the possibility of the creation of a false suggestion of a connection with Eric Garner.

77. *See, e.g., In re Snowflake Enters.*, No. 87496454 (T.T.A.B. June 24, 2021) (non-precedential) (using failure-to-function analysis to refuse registration of a variant of the most offensive slur in the English language).

78. *See* 15 U.S.C. § 1052 (unless a mark runs afoul of a registration bar, “[n]o trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature.”).

79. Cuatrecasas, *supra* note 75, at 1316 (contending that as currently employed by the TTAB, “the failure-to-function doctrine is incoherent. Overall, it lacks clarity. On a more granular level, the doctrine rests on inconsistent multifactor tests whose factors the TTAB adds, subtracts, modifies, reconceptualizes, and weighs differently across cases, giving the PTO little meaningful criteria by which to decide what marks merit registration”); *see id.* at 1325–55.

80. *But see In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 1351 (Fed. Cir. 2022) (affirming refusal to register SUCKS on failure-to-function grounds and observing that “though our court has had limited occasion to address the issue, the source identifier requirement is broader than just whether a proposed mark is generic or descriptive.”).

81. *See generally* Grynberg, *supra* note 50, at 24–54.

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root problem is not the First Amendment, but in the decades-old decision to press trademark law into the service of creating and protecting merchandising markets.