

Content-Based Trademark Regulation

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In the past eight years, the Supreme Court struck down two provisions of the Lanham Act that banned registering “disparaging” or “immoral or scandalous” trademarks as unconstitutional viewpoint-based restrictions on the registrant’s speech. However, in *Jack Daniel’s v. VIP*, the Court ruled that when defendant uses the contested trademark as a source indicator, courts should apply “ordinary trademark scrutiny” rather than the speech-protective Rogers test, even if the defendant’s use has expressive elements. Last term, in *Vidal v. Elster*, the Court unanimously upheld Section 2(c) of the Lanham Act, which restricts registering trademarks using others’ names. The Court concluded this restriction was content-based, but all nine justices agreed that a content-based trademark regulation does not automatically trigger strict or heightened scrutiny.

The Court was divided on reasoning. Five Republican-appointed justices pointed to the long history of denying trademark rights in the names of others as sufficient to conclude section 2(c) does not violate the First Amendment. Justice Barrett and three Democratic appointees found Section 2(c) reasonable because it supports trademark law’s core purposes of source indication and protecting brand goodwill.

These decisions reveal three trends about commercial regulation and the First Amendment. First, the Court appears hesitant to apply strict or heightened scrutiny to trademark and copyright regulations. Second, the history and tradition approach can function to relax scrutiny of some commercial regulation. Third, the Court’s democratic appointees, joined by some conservative justices, favor a more flexible reasonableness analysis over rigid scrutiny tiers in some commercial contexts.

Questions remain about future trademark challenges, especially regarding the law’s protection against trademark tarnishment. While historical evidence of trademark law’s consideration of mark owner goodwill might support relaxed scrutiny, tarnishment law also affects expressive interests of unauthorized trademark users.