Westlaw Journal Bonus Issue

SCOTUS SPOTLIGHT

2023 Term

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U.S. Supreme Court roundup: 2023 term

In this bonus issue for subscribers, Westlaw Journals shines a spotlight on U.S. Supreme Court cases from the 2023 term, including the groundbreaking decision on presidential immunity.

This issue includes an analysis of the unprecedented case involving former President Donald Trump's efforts to overturn the 2020 election in which the court ruled 6-3 that former presidents have absolute immunity from criminal prosecution for "official acts."

In addition, the issue analyzes two important decisions involving administrative agencies: one tossing the 40-year-old Chevron precedent regarding judicial deference to administrative agencies and the other involving the Securities and Exchange Commission's enforcement proceedings seeking monetary penalties.

This roundup also examines the high court's rulings on topics including abortion, banking, bankruptcy, civil rights, data privacy, employment law, energy and environmental law, gun regulation, intellectual property, social media, and tax law.

We hope you enjoy this special issue, a benefit of your regular subscription.

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TABLE OF CONTENTS

Westlaw Journal Bonus Issue: SCOTUS Spotlight

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of whether the statute "has room for such a rule."

Rather than make the assumption that the majority did, Justice Gorsuch said he would have dismissed the case as improvidently granted and waited for a more appropriate dispute to review.

Kannon K. Shanmugam of Paul, Weiss, Rifkind, Wharton & Garrison LLP argued for the petitioners. Wes Earnhardt of Cravath, Swaine & Moore LLP argued for Nealy. WJ

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Related Filing:
Opinion: 2024 WL 2061137
Oral argument: 2024 WL 729720
Certiorari petition: 2023 WL 3306517
11th Circuit opinion: 60 F.4th 1325
District Court opinion: 2021 WL 2280025

INTELLECTUAL PROPERTY

Justices battle trademark speech theories to reach contentious consensus on 'names clause'

By Kteba Dunlap, Esq.

The U.S. Supreme Court has held that the Lanham Act's "names clause" is constitutional, upholding the Patent and Trademark Office's decision to bar the trademark "Trump too small" from being registered.

Vidal v. Elster, No. 22-704, 2024 WL 2964139 (U.S. June 13, 2024).

In a fractured 9-0 ruling that featured a disputed opinion by Justice Clarence Thomas and two lengthy concurrences, the court on June 13 ruled that the prohibition against trademarks that include a person's name without consent is constitutional as it is viewpoint-neutral and necessarily content-based.

ATTEMPTED REGISTRATION

The trademark dispute began when Steve Elster tried to federally register a mark as a T-shirt slogan with a visual gag criticizing Donald Trump.

An examining attorney refused, finding that the mark violates the names clause because it "consists of or comprises a name, portrait or signature identifying a particular living individual."

The U.S. Court of Appeals for the Federal Circuit sided with Elster and reversed, saying that a trademark is not government speech, which the government can restrict. Rather, a trademark is private speech "entitled to some form of First Amendment protection." *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022).

PTO Director Kathi Vidal took the case to the Supreme Court.

3 THEORIES

At least three legal theories were posited in *Vidal v. Elster*, with a conservative faction relying heavily — in some cases, exclusively — on its interpretation of the history of trademark law against a more liberal set proffering tests from precedent cases.

At least three legal theories were posited in *Vidal v. Elster*, with a conservative faction relying heavily — in some cases, exclusively — on its interpretation of the history of trademark law.

Justice Amy Coney Barrett partly agreed with each side and put forth her own analogous standard, with support from the three liberal justices.

JUSTICE THOMAS: HISTORY AND TRADITION ARE ENOUGH

Noting that the case offered an open question of law — whether a viewpoint-neutral trademark restriction merits heightened First Amendment scrutiny — Justice Thomas wrote the main opinion that other conservatives joined.

In his view, the history of necessarily content-based trademark restrictions extending back to 18th-century England is enough to show that trademark law has had a "longstanding, harmonious relationship" with the First Amendment.

He interpreted this to mean that a viewpoint-neutral statute such as the names clause requires no further scrutiny to confirm its constitutionality. But the ruling is narrow, he added.

JUSTICE BARRETT: LIMITED PUBLIC FORUM ANALOGY

Justice Barrett disagreed that "loosely related cases" from history formed the sole basis for the names clause's constitutionality. She also took issue with Justice Thomas' analytical framework, characterizing it as "hunting for historical forebears on a restriction-by-restriction basis."

She would rather test the constitutionality of a content-based trademark restriction through a test borrowed from limited public forum jurisprudence, she said. Speech restrictions on public forums, like those on trademark registration, are implicitly content-based, she noted.

As long as the restrictions reasonably serve the purposes of trademark law, they pass constitutional muster, Justice Barrett said.

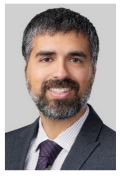
ATTORNEYS WEIGH IN ON 'TRUMP TOO SMALL' TRADEMARK RULING

"This case is about the intersection between trademark law, the First Amendment, rights of privacy, rights of publicity and political criticisms. The majority had a good opportunity to decide if the denial of trademark registrations restricted speech because the act of the denial is chilling, but they passed on this opportunity."

– Fara Sunderji, partner, Dorsey & Whitney LLP

"In this decision, the slim majority expanded the realm of cases in which 'history and tradition' decide a constitutional question. With this decision elevating the importance of this analytical approach favored by Justice [Clarence] Thomas, we can expect attorneys to increasingly litigate competing views of history when arguing constitutional questions — even in the IP context."

– Mark Lezama, litigation partner, Knobbe Martens



"The court held here that the so-called names clause of the Lanham Act is viewpoint-neutral. Accordingly, the government only needs to show that there is a reasonable reason for such restriction — here, to support the 'trademark system's purpose of facilitating source identification.' While the decision was unanimous, the various opinions of the justices expose the rift between the majority and the concurrences on whether and to what extent history and tradition should guide the court's reasoning."

– Muzamil Huq, of counsel, Morrison Foerster

"This decision should give some clarity as to the constitutionality of other types of 'viewpoint neutral' marks deemed unregistrable in Section 2 of the Lanham Act, such as Section (b) relating to flags and insignia, or even geographical indications in Section (a)."

– Monica Riva Talley, director, Sterne Kessler

"While the narrow ruling upholding the names clause restriction was expected, the court's heavy reliance on history was not. It's unlikely to significantly affect trademark practice going forward, since the names clause has been on the books for decades, but it means that any applicant trying to challenge other content-based restrictions in the Lanham Act (such as the prohibition on registering marks containing the flag or coat of arms of any country, state or municipality) will need to make sure they do a thorough investigation into the history of similar restrictions over the past couple hundreds of years."

– Aaron D. Johnson, partner, Lewis Roca

"Ultimately, the court didn't take the opportunity to rule more broadly as to whether a refusal of trademark registration is an impingement on First Amendment rights. Rather, the court more narrowly kept the living names provision intact, and without extensive analysis of free speech principles to reach its majority decision."

– David Bell, partner, Haynes Boone

"Content-based criteria for trademark registration do not abridge the right to free speech so long as they reasonably relate to the preservation of the mark owner's goodwill and the prevention of consumer confusion," she said.

JUSTICE SOTOMAYOR: MAJORITY'S TEST IS NO GOOD

Although Justice Sonia Sotomayor largely agreed with Justice Barrett, she differed in viewing trademark registration as a government benefit and thus subject to the same constitutional check that a rule withholding benefits undergoes.

No new standard is required, she wrote, because precedent holds that "withholding benefits for content-based, viewpoint-neutral reasons does not violate the free speech clause when the applied criteria are reasonable and the scheme is necessarily content based."

Justice Sotomayor, like Justice Barrett, sharply criticized the main opinion's reliance on what they consider less-than-stellar historical research. But she went further, saying the majority had abandoned legal precedent for a "judge-made" history-and-tradition test.

She quoted the late conservative Justice Antonin Scalia several times to make her point that courts must rely on litigants' arguments and First Amendment doctrine. WJ

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Related Filing:
Supreme Court opinion: 2024 WL 2964139
Reply brief: 2023 WL 3345737
Opposition brief: 2023 WL 3173153
Certiorari petition: 2023 WL 1392051
Federal Circuit opinion: 26 F.4th 1328