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LEGAL ALERT

Vidal v. Elster: The Supreme Court Affirms the Constitutionality of Section 2(c) of the Lanham Act

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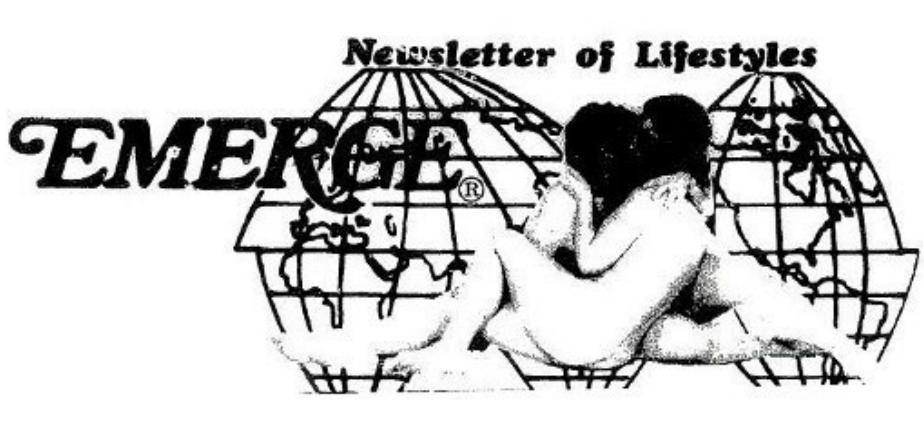
In *Vidal v. Elster*,[1] the Supreme Court addressed the constitutionality of Section 2(c) of the Lanham Act, which prohibits the registration as a trademark or service mark of any "name, portrait, or signature identifying a particular living individual except by his written consent."[2] It did so in the context of the U.S. Patent and Trademark Office's refusal to register a mark containing a satirical reference to former President Donald Trump, which a fractured Court held did not violate the violate the applicant's right to free speech.[3] In reaching that conclusion, the Court did not invoke its usual test for evaluating the constitutionality of content-discriminatory (but not viewpoint-discriminatory) restrictions on speech, namely, that found in *Central Hudson Gas & Electric Corp. v. Public Service Commission*.[4] Instead, it applied a historical analysis potentially signaling the end of *Central Hudson* inside and outside the trademark registration context. With respect to that context, the Court took pains to limit its holding to Section 2(c) and disclaimed any intent to articulate a framework for evaluating the constitutionality of other grounds for unregistrability. Nevertheless, its methodology arguably can support challenges to grounds lacking the lengthy historical pedigree attributed to Section 2(c) by the Court. Those include grounds added to the Act in the relatively recent past, as well as extrastatutory ones—such as an applied-for mark's failure to function as a mark—recognized even more recently in the case law.

A. Pre-*Elster* Paradigms for Evaluating Restrictions on Registrability

1. *McGinley*

As enacted, Section 2(a) of the Lanham Act prohibits the registration of, inter alia, "immoral, . . . or scandalous matter; or matter which may disparage . . . persons or bring them into contempt or disrepute."[5] In applying those prohibitions, the USPTO long had the benefit of the Court of Customs and Patent Appeals' decision in *In re McGinley*.[6] *McGinley* arose from an application to register the following mark—described by the court as "appearing to expose the male genitalia"—for a "newsletter devoted to social and interpersonal relationship topics" and "social club services":



In addition to affirming the USPTO's determination that the mark was immoral and scandalous within the meaning of Section 2(a), the court rejected the applicant's claim of a first amendment violation with the following observation:

> With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant's First Amendment rights would not be abridged by the refusal to register his mark.[7]

Over the next 36 years, the USPTO and its reviewing courts routinely invoked that holding of *McGinley* to dispose of free speech-based challenges to applicants appealing refusals of their applications.

2. A Different Paradigm: *Tam* and *Brunetti*

With increasing frequency prior to its opinion in *Elster*, the Supreme Court applied a different paradigm for evaluating First Amendment-based challenges to government actions in contexts other than that of the trademark registration process. That approach divides those actions into two categories: ones with content-discriminatory effects and those with viewpoint-discriminatory effects.

Content-based discrimination occurs when the government attempts to regulate all speech about a certain topic, no matter what that speech says about the topic.[8] In contrast, viewpoint-based discrimination is a subset of content-based discrimination and occurs when the government attempts to regulate certain opinions about a topic.[9]

Government restrictions on commercial speech bearing on lawful activity and having a content-discriminatory effect are disfavored. Nevertheless, as a historical matter, they can be justified under the intermediate scrutiny test of *Central Hudson Gas & Electric Corp. v. Public Service Commission*[10] if:

- the asserted government interest is substantial;
- the regulation directly advances that government interest; and
- the regulation is no more extensive than necessary.[11]

In contrast, viewpoint-based discrimination is truly disfavored because it is "an egregious form of content discrimination"[12] and can only be justified if the restriction at issue constitutes government speech.[13]

The Supreme Court first applied this framework to the trademark registration process in *Matal v. Tam*.[14] *Tam* arose from the USPTO's rejection of an application to register the mark THE SLANTS for entertainment services because the mark potentially disparaged Asian-Americans despite the membership of the applicant, Simon Tam, in that group. In an appeal from that action, the full Federal Circuit invalidated Section 2(a)'s "may disparage" prohibition as fatally inconsistent with the First Amendment.[15] Despite the absence of a circuit split, the Supreme Court agreed to answer the following question: "Whether the disparagement provision in 15 U.S.C. [§] 1052(a) is facially invalid under the Free Speech Clause of the First Amendment."[16]

In answering that question in the affirmative, the Court, in an opinion authored by Justice Alito, addressed the question of whether the USPTO's decision to register a particular mark constitutes government speech immune from government scrutiny. The Court unanimously held it does not, calling the argument "far-fetched."[17] In doing so, the Court distinguished its earlier opinion in *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*,[18] in which it had classified messages on specialty license plates as government speech. The Court determined none of the elements present in *Walker*—the states' long-standing practice of using license plates to convey messages, the public's identification of license plates with states, and the states' direct control over the messages conveyed on specialty plates—was present in *Tam*.[19] Just as all Justices agreed on these points and that the statutory language at issue therefore was subject to First Amendment scrutiny, they were also unanimous that the portion of Section 2(a) at issue was not viewpoint-neutral, even if it evenhandedly prohibited the potential disparagement of all groups.[20]

In a portion of his opinion not constituting that of the Court, Justice Alito also considered whether trademarks are commercial speech, and thus if restrictions on their registrability should receive a lower level of scrutiny under the *Central Hudson* test. Nevertheless, Alito's opinion did not decide whether trademarks qualified for that treatment, determining only that, if so, the potential disparagement clause could not withstand even *Central Hudson* review, which requires that a restriction on commercial speech serve "a substantial interest" and be "narrowly drawn."[21] Alito concluded the disparagement clause was neither, writing that any intention to prevent offense "strikes at the heart of the First Amendment" and that, in any event, the statutory language could not be "narrowly drawn" to exclude from registration marks that support "invidious discrimination."[22] Significantly, however, Alito and the three Justices joining his opinion expressly left open "the question whether *Central Hudson* provides the appropriate test for deciding free speech challenges to provisions of the Lanham Act."[23] Consequently, in a development anticipating the Court's analysis in *Elster*, not a single Justice fully committed himself or herself to *Central Hudson's* viability in this context.

Having thus disposed of Section 2(a)'s prohibition on the registration of potentially disparaging marks as an impermissibly viewpoint-discriminatory restriction, the Court applied the same framework in an opinion that invalidated the same section's prohibition on the registration of immoral and scandalous marks in *Iancu v. Brunetti*.[24] Relying on the framework established in *Tam*, the Court framed the issue as whether the prohibition constituted a highly disfavored viewpoint-based restriction subject to strict scrutiny. It then answered that question affirmatively:

> It is viewpoint-based. . . . Put the pair of overlapping terms ["immoral" and "scandalous"] together and the statute, on its face, distinguishes between two opposed sets of ideas: those aligned with conventional moral standards and those hostile to them; those inducing societal nods of approval and those provoking offense and condemnation. The statute favors the former, and disfavors the latter. "Love rules"? "Always be good"? Registration follows. "Hate rules"? "Always be cruel"? Not according to the Lanham Act's "immoral or scandalous" bar.
>
> The facial viewpoint bias in the law results in viewpoint-discriminatory application.[25]

3. The Emergence of the Court's History-Based Analysis

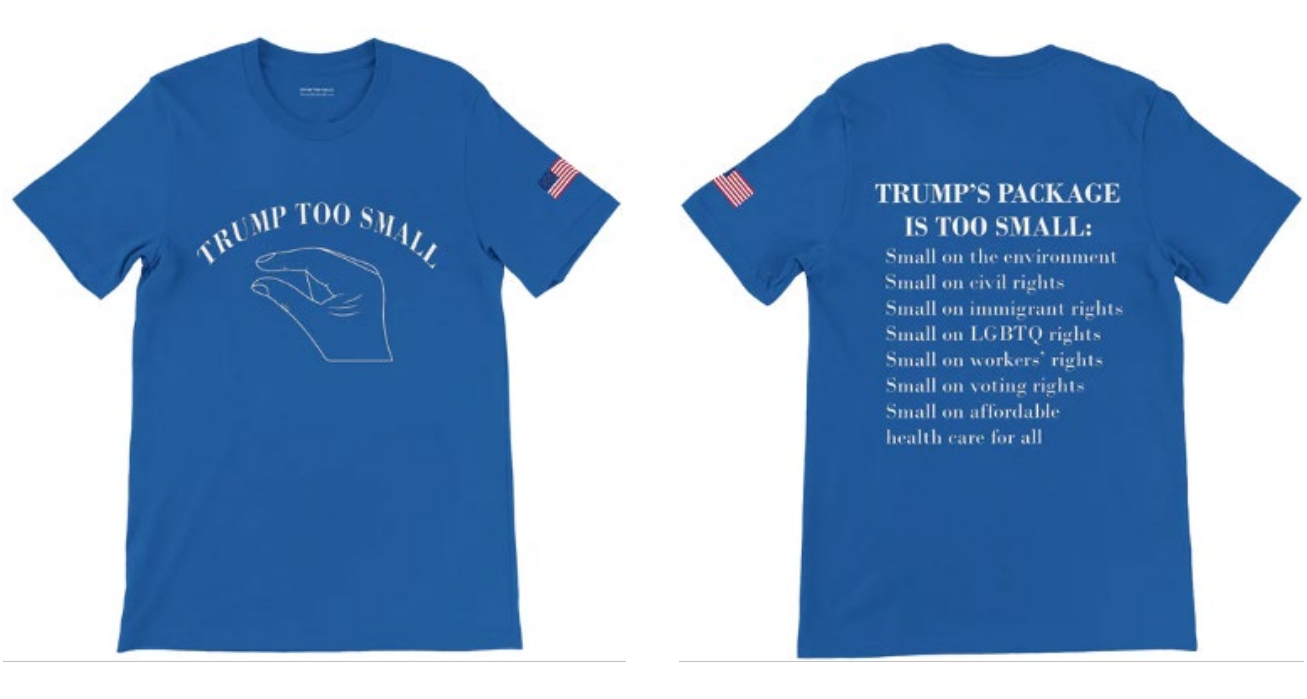
The content discrimination vs. viewpoint discrimination model is not the only paradigm the Court has used to evaluate the constitutionality of government actions. In recent years, the Court also has increasingly looked to whether the action at issue is consistent with historical practices. For example, the Court's opinion in *New York State Rifle & Pistol Association v. Bruen* emphasized history and tradition in analyzing a New York firearms licensing scheme.[26] That opinion undertook an extensive overview of the history of public carry laws dating back to the year 1285.[27] Because the Court understands U.S. history in the context of its English roots, that historical overview began with the history of handguns and carry laws in England.[28] It then addressed, in turn, the history of carry laws and practices in colonial America, the years before the Civil War, and Reconstruction era.[29] But this was not the Court's first time emphasizing what has been described as a "text, history, and tradition" analysis. Indeed, the Court looked to this history partially because advocates (particularly respondent) briefed and argued the case from the perspective of history and tradition.[30]

The term prior to *Bruen*, the Court employed a similar approach to its decision in *Dobbs v. Jackson Women's Health Organization*.[31] The *Dobbs* Court emphasized that its analysis must be "guided by the history and tradition that map the essential components of our Nation's concept of ordered liberty."[32] And as with *Bruen*, the Court approached the history by beginning with English common law history and continuing through to more modern history.[33] Likewise, in the same term as *Bruen*, the Court in *Kennedy v. Bremerton School District* applied "[a]n analysis focused on original meaning and history" in the context of the First Amendment's Establishment Clause.[34] These recent cases show the Court speaking directly and clearly about history and tradition in its analyses, but they also indicate that a majority of the justices believe this history-and-tradition framework has long been at work in the Court's jurisprudence.[35] Indeed, those opinions are replete with citations to prior opinions from the Court using history and tradition to evaluate constitutional rights and government action.[36]

B. *Elster*

1. The Proceedings Below

In the wake of *Tam* and *Brunetti*, the Supreme Court in *Elster* took up a challenge to a successful First Amendment-based challenge to Section 2(c) of the Act, which mandates the refusal of any application to register a mark that "[c]onsists of or comprises a name . . . identifying a particular living individual" without the individual's written consent.[37] The challenger applied to register TRUMP TOO SMALL as a mark for various types of shirts:



As the Federal Circuit explained, "the phrase he sought to trademark [sic] invokes a memorable exchange between President Trump and Senator Marco Rubio from a 2016 presidential primary debate, and aims to 'convey[] that some features of President Trump and his policies are diminutive.'"[38] Unlike the applicants in *Tam* and *Brunetti*, however, he did not assert that Section 2(c) had a viewpoint-discriminatory effect but still argued it impermissibly discriminated on the basis of content.

In defending Section 2(c) against the applicant's First Amendment-based appeal of the USPTO's refusal of his application, the USPTO unconvincingly grasped at straws found in opinions other than that of the Court itself in *Tam* and *Brunetti*, beginning with the theory that federal registration constitutes a legitimate subsidy under Congress's plenary power under the Constitution's Taxing and Spending Clause.[39] The court found that theory wanting, holding instead that:

> [E]ven if a trademark [registration] were a government subsidy, this is not a situation in which First Amendment requirements are inapplicable. [The applicant's] mark is speech by a private party in a context in which controversial speech is part-and-parcel of the traditional trademark function, as the Supreme Court decisions in *Tam* and *Brunetti* attest. Under such circumstances, the effect of the restrictions imposed with the subsidy must be tested by the First Amendment.[40]

The court next disposed of the USPTO's argument that Section 2(c)'s prohibition against registration was comparable to speech restrictions in a limited public forum. As it saw things, "this is not a case in which the government has restricted speech on its own property to certain groups or subjects, a fact distinguishing it from nearly all of the Supreme Court's limited public forum cases."[41] In particular, "[w]hile a limited public forum need not be a physical place—it can be 'metaphysical'—. . . when the Supreme Court has analyzed speech restrictions in metaphysical forums, such restrictions were always 'tethered to government properties' where the effects were later felt."[42] But, the court held, "[n]o similar situation exists for the trademark registration program because 'refusals chill speech anywhere from the Internet to the grocery store.'"[43] This meant that "[t]he speech here is entitled to First Amendment protection beyond protection against viewpoint discrimination" such as that at issue in *Tam* and *Brunetti*.[44]

Having thus agreed with the applicant that Section 2(c) was at least content discriminatory, the court held that "[w]hatever the standard for First Amendment review of viewpoint-neutral, content-based restrictions in the trademark area, whether strict scrutiny or intermediate scrutiny, there must be at least a substantial government interest in the restriction."[45] According to the USPTO, there were two such substantial interests, which were the protection of the former president's state-law rights of privacy and publicity. Addressing the former right, the court held there could be no "no plausible claim" that the former president enjoyed a right of privacy "protecting him from criticism in the absence of actual malice—the publication of false information 'with knowledge of its falsity or in reckless disregard of the truth.'"[46] With the USPTO unable to identify supporting judicial authority (or even scholarship) recognizing such an interest, and in the absence of a claim of actual malice on the applicant's part, Section 2(c)'s prohibition on registration could not rest on a right-of-privacy foundation. The USPTO's asserted interest in protecting the former president's right of publicity required a "more complex" analysis, but it also fell short of the mark: Although the government might have the ability under *United States Olympic Committee v. San Francisco Arts & Athletics*,[47] to regulate conduct potentially lessening the distinctiveness and value of another's mark, even in the absence of likely confusion, "[n]o similar claim is made here that President Trump's 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."[48] Moreover, and in any case, "[t]he right of publicity does not support a government restriction on the use of a mark because the mark is critical of a public official without his or her consent."[49] Section 2(c) therefore was unconstitutional on at least an as-applied basis "under any conceivable standard of review."[50]

2. The Supreme Court's Opinion

Agreeing to review the Federal Circuit's invalidation of Section 2(c), the Supreme Court granted the government's petition for a writ of certiorari, which presented the following question: "Whether the refusal to register a mark . . . violates the Free Speech Clause of the First Amendment when the mark contains criticism of a government official or public figure."[51] The Court answered that question in an opinion authored by Justice Thomas, which, as a threshold matter, agreed with the Federal Circuit's conclusion that Section 2(c)—referred to by the Court as the "names clause"—has a content-discriminatory effect, but not a viewpoint-discriminatory one. Citing the USPTO's practice of refusing registration to applied-for marks containing any recognizable references to living individuals, the Court explained that "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.'"[52]

At that point, the Court might have been expected to invoke the *Central Hudson* test, just as the Federal Circuit had done. It did not do so, however, and, indeed, neither the Court's opinion nor the myriad others filed in the case even mention *Central Hudson* at all. Instead, the Court undertook a historical analysis of both trademark law generally and its treatment of claimed rights in personal names in particular, which led the Court ultimately to conclude that "[s]everal features of trademark [law] counsel against a *per se* rule of applying heightened scrutiny to viewpoint-neutral, but content-based trademark regulations."[53]

One such feature, the Court held, was "the inherently content-based nature of trademark law," which "has never been a cause for constitutional concern."[54] As evidence of that nature, the Court cited to the common-law's discouragement of claims of rights to personal names, which it considered to be codified in the Lanham Act in form of Section 2(e)(4)'s prohibition on the registration of applied-for marks deemed to be primarily merely surnames without supporting showings of secondary meaning.[55] The court also found support for its conclusion in the common-law cause of action for infringement recognized by both English courts and their early United States counterparts, which, it noted, extended to alleged misappropriations of personal names.[56] "[P]olicing trademarks so as to prevent confusion over the source of goods," it explained, "requires looking to the mark's content." Thus, "[t]he common law did . . . allow a person to obtain a trademark containing his own name—with a caveat: A person could not use a mark *containing* his name to the exclusion of a person with the *same* name."[57] So too did the Court take a different view from the Federal Circuit of its past decision in *San Francisco Arts & Athletics*, which the Court held stood for the proposition that "a party has no First Amendment right to piggyback off the goodwill another entity has built in its name";[58] "[t]he names clause," it concluded, "guards a similar interest."[59]

The result of the Court's deep dive into the history of trademark law was that Section 2(c) withstood constitutional scrutiny:

> We conclude that a tradition of restricting the trademarking [sic] of names has coexisted with the First Amendment, and the names clause fits within that tradition. Though the particulars of the doctrine have shifted over time, the consistent through line is that a person generally had a claim only to his own name. The names clause reflects this common-law tradition by prohibiting a person from obtaining a trademark of another living person's name without consent, thereby protecting the other's reputation and goodwill.[60]

3. Practical Consequences of the Opinion

On one level, the Court's opinion changes little. Specifically, Section 2(c) barred the registration of marks falling within its scope prior to June 13, 2024, and it continues to do so today. Likewise, the Court took pains to disclaim any intent to hold that "an equivalent history and tradition is required to uphold every content-based trademark restriction,"[61] explaining that "[w]e hold only that history and tradition establish that the particular restriction before us, the names clause . . . , does not violate the First Amendment."[62] Finally, the Court's historical analysis is arguably consistent with those it has undertaken in such other recent cases as *Bruen*, *Dobbs*, and *Kennedy*.

Nevertheless, and especially in light of the attention paid to *Central Hudson* paid by the Federal Circuit in its evaluation of Section 2(c)'s constitutionality, the complete absence of any references to that earlier case in any of the opinions in *Elster* is noteworthy. That absence may merely suggest the Justices saw the *Central Hudson* test as so inapposite that it did not merit extended discussion. It may also, however, suggest that *Central Hudson* is a dead man walking, both in the trademark registration context and in other contexts as well.

Of greater importance to the registration system, and regardless of the Court's intent for its opinion not to have such an effect, the Court's historical analysis will undoubtedly cast a long shadow over future challenges to other content-based prohibitions on registration. And, if it does, it may facilitate First Amendment-based challenges to those prohibitions in ways not contemplated by the Court. For example, because certification marks did not exist under the common law, the circumstances under which registrations of them can be cancelled was necessarily first addressed under federal statutory law only with the Lanham Act's passage in 1946.[63] Likewise, Section 14(3)'s ground for cancellation that a registered mark has been used to misrepresent the source of the goods or services[64] took its current form only in 1962.[65] So too does the prohibition on the registration of primarily geographically deceptively misdescriptive marks found in Section 2(e)(3)[66] have no readily apparent common-law antecedents and was added to the Lanham Act only in 1993 as part of the NAFTA Implementation Act.[67] And, of course, such extrastatutory grounds for unregistrability as failure to function as a mark, ornamentality, and informational subject matter have arisen even more recently as judge-made doctrines.[68] If the constitutionality of these prohibitions on registration is evaluated through a purely historical lens, the outcome might well be different from that in *Elster*. Whether courts will undertake such evaluations or, alternatively, heed the Court's admonition that its holding applies only to Section 2(c)—at least for now—remains to be seen.

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[1] No. 22-704, 2024 WL 2964139 (U.S. June 13, 2024).

[2] 15 U.S.C. § 1052(c) (2018).

[3] The lead opinion, authored by Justice Thomas, was joined in its entirety by Justices Alito and Gorsuch and in part by the Chief Justice and Justice Kavanaugh, leaving a portion of it lacking the support of a majority of Justices. Joined by the Chief Justice, Justice Kavanaugh filed an opinion concurring in part. Justice Barrett filed an opinion concurring in part, joined by Justice Kagan and joined in part by Justices Sotomayor and Jackson. Finally, Justice Sotomayor filed an opinion concurring in the judgment, which Justices Kagan and Jackson joined.
This alert focuses exclusively on the Court's opinion.

[4] 447 U.S. 557 (1980).

[5] 15 U.S.C. § 1052(a).

[6] 660 F.2d 481 (C.C.P.A. 1981), *abrogated by In re* Tam, 808 F.3d 1321 (Fed. Cir. 2015), *aff'd sub nom.* Matal v. Tam, 582 U.S. 218 (2017).

[7] *Id.* at 484 (citation omitted).

[8] *See* Reed v. Town of Gilbert, Ariz., 576 U.S. 155, 163 (2015) ("Government regulation of speech is content based if a law applies to particular speech because of the topic discussed or the idea or message expressed.").

[9] *See* Rosenberger v. Rector & Visitors of Univ. of Va., 515 U.S. 819, 829 (1995) ("The government must abstain from regulating speech when the specific motivating ideology or the opinion or perspective of the speaker is the rationale for the restriction.").

[10] 447 U.S. 557 (1980).

[11] *Id.* at 562–66.

[12] *Rosenberger*, 515 U.S. at 829.

[13] *See, e.g.*, Walker v. Texas Div., Sons of Confederate Veterans, Inc., 576 U.S. 2007 (2015) (rejecting viewpoint discrimination-based challenge to state refusal to issue specialty license plate based on holding that messages on license plates constitute government speech).

[14] 582 U.S. 218 (2017).

[15] *See In re* Tam, 808 F.3d 1321 (Fed. Cir. 2015) (en banc), *aff'd sub nom*. Matal v. Tam, 582 U.S. 218 (2017).

[16] Brief for the Petitioner at i, Matal v. Tam, 582 U.S. 218 (2017) (No. 15–1293).

[17] 582 U.S. at 236.

[18] 576 U.S. 200 (2015).

[19] *Tam*, 582 U.S. at 239–40.

[20] To Justices Kennedy, Ginsberg, Sotomayor, and Kagan, the lack of viewpoint neutrality meant the prohibition on registration necessarily invoked "heightened scrutiny." *Tam*, 582 U.S. at 251 (Kennedy, J., concurring in part and concurring in the judgment). They would have held the prohibition invalid without additional analysis, despite the commercial nature of trademarks: "Unlike content based discrimination, discrimination based on viewpoint, including a regulation that targets speech for its offensiveness, remains of serious concern in the commercial context." *Id.* In contrast, Justice Alito, joined by Chief Justice Roberts and Justices Thomas and Breyer addressed "the Government's argument that this case is governed by cases in which this Court has upheld the constitutionality of government programs that subsidized speech expressing a particular viewpoint." *Id.* at 239 (opinion of Alito, J.).

[21] *Id.* at 245.

[22] *Id.* at 246.

[23] *Id.* at 245 n.17.

[24] 588 U.S. 388 (2019).

[25] *Id.* at 394 (alterations in original) (citations omitted).
As an apparent alternative holding, the Court concluded that the prohibition at issue was impermissibly overbroad under the First Amendment. As it explained, "in any event, the 'immoral or scandalous' bar is substantially overbroad. There are a great many immoral and scandalous ideas in the world (even more than there are swearwords), and the Lanham Act covers them all. It therefore violates the First Amendment." *Id.* at 399.

[26] 597 U.S. 1 (2022); *see also id.* at 79 (Kavanaugh, J., concurring) ("The Court employs and elaborates on the text, history, and tradition test . . . .").

[27] *Id.* at 40, 70 ("At the end of this long journey through the Anglo-American history of public carry . . . .").

[28] *Id.* at 39–40.

[29] *Id.* at 46–50, 50–60, 61–70.

[30] *See, e.g.*, *id.* at 40 ("To begin, respondents and their amici point to several medieval English regulations from as early as 1285 that they say indicate a longstanding tradition of restricting the public carry of firearms.").

[31] 597 U.S. 215 (2021).

[32] *Id.* at 240.

[33] *Id.* at 242–45, 248–50.

[34] 597 U.S. 507, 536 (2022).

[35] *See, e.g.*, *Bruen*, 597 U.S. at 24 ("This Second Amendment standard accords with how we protect other constitutional rights. Take, for instance, the freedom of speech in the First Amendment . . . .").

[36] *See Dobbs*, 597 U.S. at 231 (citing Washington v. Glucksberg, 521 U.S. 702, 721); *Bruen*, 597 U.S. at 25 (citing United States v. Stevens, 559 U.S. 460, 468–471 (2010)).

[37] 15 U.S.C. § 1052(c).

[38] *See In re* Elster, 26 F.4th 132 (Fed. Cir. 2022) ("*Elster I*"), *rev'd sub nom.* Vidal v. Elster, No. 22-704, 2024 WL 2964139 (U.S. June 13, 2024) ("*Elster II*").

[39] U.S. Const. art. 3, § 1.

[40] *Elster I*, 26 F.4th at 1332.

[41] *Id.* at 1333.

[42] *Id.*

[43] *Id.* (quoting *In re* Brunetti, 877 F.3d 1330, 1348 (Fed. Cir. 2017), *aff'd sub nom.* Iancu v. Brunetti, 588 U.S. 388 (2019)).

[44] *Id.*

[45] *Id.* at 1333.

[46] *Id.* at 1335 (quoting Time, Inc. v. Hill, 385 U.S. 374, 388 (1967)).

[47] 483 U.S. 522 (1987).

[48] *Elster I*, 26 F.4th at 1336.

[49] *Id.* at 1337.

[50] *Id.* at 1339.

[51] Petition for Certiorari at (I), No. 22-704, 2024 WL 2964139 (U.S. June 13, 2024) (No. 22-704).

[52] *Elster II*, 2024 WL 2964139, at *5 (alteration in original) (quoting 2 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 13:37.50 (5th ed.)).

[53] *Id.* at *6. The Court's analysis was not limited to United States trademark law. Instead, the Court noted, "[o]ur country has recognized trademark rights since the founding" but that "the law developed slowly" and was often derived from English law, which the Court characterized as having "an inherently content-based endeavor." *Id.*

[54] *Id.*

[55] *Id.* at *4 (citing 15 U.S.C. § 1052(e)(4) (2018)).

[56] *Id.* at *7.

[57] *Id.* at *9.

[58] *Id.* at *11.

[59] *Id.*

[60] *Id.*

[61] *Id.* at *12. In particular, the Court emphasized that its application of a history-and-tradition approach worked in *Elster* because there were historical analogues and left open the possibility of using other judicial methodologies in cases with sparser history. *Id.* at *11; *see also id.* at *19 (Barrett, J., concurring, in part) ("Besides, as the Court admits, its approach merely delays the inevitable: Eventually, the Court will encounter a restriction without a historical analogue and be forced to articulate a test for analyzing it.").

[62] *Id.*

[63] 15 U.S.C. § 1064(5) (2018).

[64] *Id.* § 1064(3).

[65] *See generally* Theodore H. Davis Jr., *Cancellation Under Section 14(3) for Registrant Misrepresentation of Source*, 85 Trademark Rep. 67, 68–72 (1995) (tracing evolution of statutory language).

[66] 15 U.S.C. § 1052(e)(3).

[67] Pub. L. No. 103–182, 107 Stat. 2057 (1993).

[68] For a study of the frequency of failure-to-function refusals by the USPTO, see Lucas Daniel Cuatrecasas, *Failure to Function and Trademark Law's Outermost Bound*, 96 N.Y.U. L. Rev. 1312, 1326 (2021). And, for a pre-*Elster* opinion sustaining the failure-to-function ground for refusal against a constitutional attack, see *In re GO & Assocs.*, 90 F.4th 1354 (Fed. Cir. 2024).