

Examination Guide 1-23

Examination for Compliance with Section 2(c) While Constitutionality of Section 2(c) as Applied to Marks That Are Critical of Government Officials or Public Figures Remains in Question Issued February 22, 2023

Section 2(c) of the Lanham Act, 15 U.S.C. § 1052(c), bars the registration of a mark that “[c]onsists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow, if any, except by the written consent of the widow.” In February 2022, the U.S. Court of Appeals for the Federal Circuit held that the application of section 2(c) to marks that are critical of government officials or public figures is unconstitutional, absent a showing of actual malice, because it impermissibly restricts free speech. *In re Elster*, 26 F.4th 1328, 2022 USPQ2d 195 (Fed. Cir. 2022), *reh’g denied per curiam*, No. 2020-2205 (Fed. Cir. Aug. 31, 2022). On January 27, 2023, the United States Patent and Trademark Office (USPTO) filed a petition to the U.S. Supreme Court for a writ of certiorari to review the decision.

The outcome of this potential U.S. Supreme Court review is relevant to the issue of registrability of marks with the USPTO. Consistent with normal USPTO procedures and the USPTO’s broad discretion to manage its own docket, the USPTO will be suspending action on pending applications involving marks subject to refusal under section 2(c) that are critical of government officials or public figures, as discussed below. *See* 37 CFR § 2.67; Trademark Manual of Examining Procedure §§ 716-716.02.

While the constitutionality of section 2(c) as applied to this category of marks remains in question and subject to potential Supreme Court review, for any new applications where the mark is subject to refusal under section 2(c) and the mark contains matter critical of a government official or public figure, the USPTO will issue only an advisory refusal under section 2(c). If a mark’s registrability under section 2(c) is the only issue, the examining attorney will specify the reason for the advisory refusal and suspend action on the application in the first office action. For all applications, including those initially examined before the Federal Circuit’s decision in *Elster*, action on the application will be suspended if section 2(c) is the only remaining issue or if the application is otherwise in condition for final action as to any other refusals or requirements. Any such suspension of an application will remain in place until at least the last of the following occurs: (1) a petition for certiorari is denied; or (2) certiorari is granted, and the U.S. Supreme Court issues a decision.