

PUBLICATION

Redskins Trademarks Cancelled - Found Disparaging to Native Americans (Again)

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June 18, 2014

On June 18, 2014, in *Amanda Blackhorse et al. v. Pro-Football, Inc.*, Cancellation No. 92046185 (TTAB 6/18/2014), the Trademark Trial and Appeals Board (TTAB) cancelled six trademark registrations issued between 1967 and 1990 for trademarks consisting in whole or in part of the term REDSKINS and related to the NFL Football franchise Washington Redskins, because they are "disparaging to Native Americans at the respective times they were registered, in violation of Section 2(a) of" the Lanham Act. The TTAB acknowledged that its decision "concerns only the statutory right to *registration* under Section (2)(a) [of the Lanham Act]," and that it lacked "statutory authority to issue rulings concerning the right to *use* trademarks. *Id.* at 2. As such, the Opinion (pending a likely appeal) forecloses the rights of Pro-Football, Inc. (the entity that owns the Washington Redskins) from claiming any of the benefits of federal trademark registration, but it does not address the owner's potential enforcement of its common law rights in the marks under Section 43(a) of the Lanham Act. The Opinion also opens a number of broad debates over the use and enforcement of trademarks, and the defenses to trademark infringement, in light of clear Federal policy banning the registration of scandalous, immoral and disparaging trademarks.

The Lanham Act prohibits registration of a trademark that, *inter alia*, "[c]onsists of or comprises immoral, deceptive, or scandalous matter; **or matter which may disparage** or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt . . ." 15 U.S.C. § 1052(a). As such, a mark that satisfies all of the criteria for federal registration may still be refused, or subsequently cancelled, if it is immoral, deceptive, scandalous or disparaging.

The genesis of the TTAB's decision began in 1992, when Suzan Harjo and six other Native Americans filed a petition to cancel the same six REDSKINS registrations, arguing that the marks are "disparaging" to Native Americans, "scandalous," and bring them 'into contempt, ridicule, and disrepute." After seven years of litigation, the TTAB issued an Order cancelling the six registrations. *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1743 (TTAB 1999). Instead of appealing the TTAB Cancellation Order to the Court of Appeals for the Federal Circuit under Lanham Act § 21(a), as is common, Pro-Football, Inc. instead chose to appeal to the U.S. District Court for the District of Columbia under § 21(b), which permitted the District Court to consider the case *de novo*, instead of taking the entire record before the Patent and Trademark Office, as the Court of Appeals for the Federal Circuit would have done.

At the District Court, Pro-Football, Inc. prevailed on summary judgment. The District Court held that the TTAB's finding of disparagement was not supported by "substantial evidence," and also that the doctrine of laches (when unreasonable delay in pursuing a right or claim results in the equitable bar of the claim) precluded consideration of the case. *Pro-Football, Inc. v. Harjo*, 68 USPQ2d 1225, 1263 (D.D.C. 2003). The District Court disagreed with the TTAB on just about everything, from its evaluation of the survey evidence to the disparaging nature of the word in general compared to the use of the "redskins" as used in the trademarks. The District Court took issue with the survey results of the general population to show that the marks were disparaging to Native Americans, when the survey showed that a higher percentage of the general population than of Native Americans viewed the term "redskin" as offensive. The District Court also refused to accept an "expansive doctrine" under which "no professional sports team that uses Native American imagery

would be permitted to keep their trademarks if the team's fans or the media took any action or made any remark that could be construed as insulting to Native Americans." The petitioners appealed the District Court's ruling to the United States Court of Appeals of the District of Columbia Circuit, but unfortunately for anyone interested in the merits of the disparagement issue, the Court of Appeals focused instead on the issue of laches. *Pro-Football, Inc. v. Harjo*, 75 USPQ2d 1525, 1528 (D.C. Cir. 2005). On remand, the District Court held that the laches defense barred the claim (*Pro-Football, Inc. v. Harjo*, 87 USPQW2d 1891, 1903 (D.D.C. 2008)), and on appeal, the D.C. Circuit affirmed without addressing the disparagement issue. *Pro-Football, Inc. v. Harjo*, 90 USPQ2d 1593 (D.C. Cir. 2009).

While further evaluation of the disparagement issue in the *Harjo* case was on its way to a dead end in the courts, another five individuals filed a separate petition to cancel the REDSKINS marks in *Amanda Blackhorse et al. v. Pro-Football, Inc.*, Cancellation No. 92046185 (TTAB 6/18/2014). In *Blackhorse*, the TTAB once again concluded that the REDSKINS marks are disparaging. However, the TTAB observed that the record before it on this second time around was "qualitatively different" than the record before it in *Harjo*, which included broader allegations not asserted in *Blackhorse*, such as whether the marks are scandalous to the general public, and that the "weight and relevance of certain evidence became obfuscated by several uses raised in the *Harjo* case" that were not at issue in *Blackhorse*. *Id.* at 15 & n.32.

Narrowly, on the issue of disparagement, the TTAB followed a two-step analysis: (1) determining the meaning of the matter in question, as it appears in the service marks and as those marks are used in connection with the registrations; and (2) whether the meaning of the marks disparage Native Americans. As to the first question, the TTAB found that "'the meaning of the matter in question' retains the core meaning of Native American when used as the name of respondent's sports team." *Id.* at 15. As to the second question, the TTAB found that the petitioners proved by a preponderance of the evidence "that a substantial composite of Native Americans found the term REDSKINS to be disparaging in connection with respondent's service during the relevant time frame of 1967-1990." *Id.* at 72.

The TTAB supported its decision based on its extensive findings of fact, including those "based on Native American viewpoints, i.e., the viewpoint of paramount concern under the applicable analysis." *Id.* at 59 & n.172. As to the Native American viewpoint, the TTAB relied on a 1993 resolution of the National Congress of American Indians (NCAI), which established that the term Redskins is and had always been a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging, and racist designation for Native Americans." *Id.* at 65. The TTAB findings also included extensive dictionary evidence. For example, before 1966, no dictionary in the record included a usage label for the term REDSKIN, but beginning in 1966, usage labels in dictionaries indicating the term REDSKIN to be offensive, disparaging, contemptuous or not preferred first appeared and grew in number. *Id.* at 60-61. The TTAB also found that from the mid-1960s to 1996, the word "redskin(s)" had dropped out of written and most spoken language as a reference to Native Americans because it was increasingly recognized as an offensive term that was disparaging to Native Americans during the relevant time period. *Id.* at 61. Evidence before the TTAB established that, at a minimum, approximately thirty percent of Native Americans found the term REDSKINS used in connection with the respondents services to be disparaging at all times, including the time at which each subject mark was registered, and that thirty percent was "more than [a] substantial" composite of Native Americans. *Id.* at 71.

While the validity of the six REDSKINS trademark registrations may yet rest on the decision of another court on appeal, a litany of unanswered questions and unresolved issues remain. For example, may one enforce a trademark based on common law trademark rights, or rely on disparagement as a defense, even if they are inconsistent with Federal policy to the contrary? More broadly, to what extent can (or does) Federal trademark law impinge upon First Amendment rights? When one considers that the arguments against the marks in both *Harjo* and *Blackhorse* concerned only the word REDSKIN, and not any design element or logo, the issue can

grow in complexity. Trademark owners should be aware that the issues concerning the Redskins trademarks are not as isolated as they may seem.