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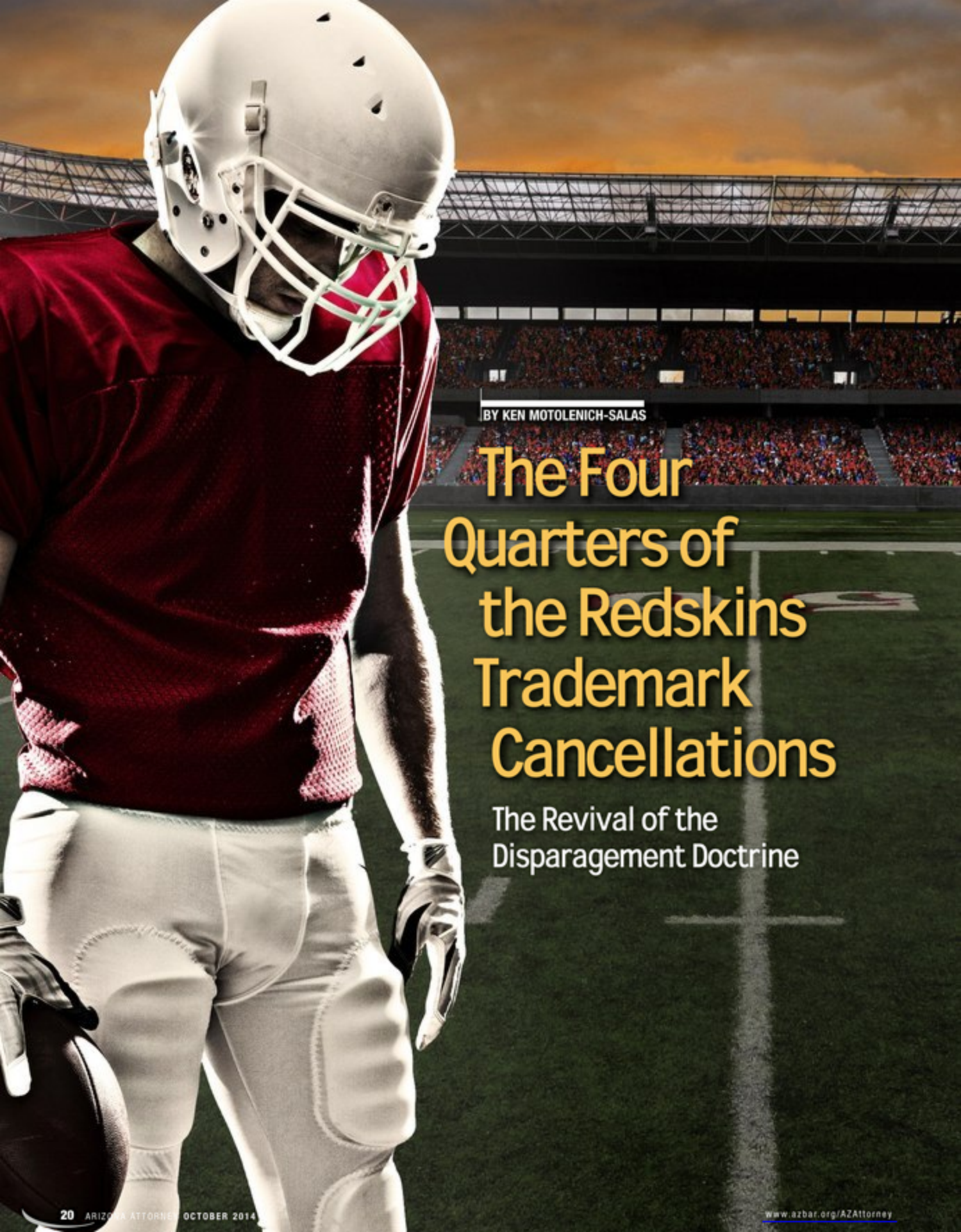
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The Four Quarters of the Redskins Trademark Cancellations

The Revival of the
Disparagement Doctrine

In the context of everyday life,

disparagement means “to lower in rank or reputation” or “to depreciate ... or speak slightly about.”¹ But what does it mean in the context of trademark law? The answer to this question implicates the rarely used Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a). Although infrequently encountered in everyday trademark practice, the Trademark Trial and Appeal Board (“TTAB”) of the United States Patent & Trademark Office (“USPTO”) recently cancelled the famous “Redskins” trademarks associated with the Washington, DC, National Football League (“NFL”) team.² This decision enjoyed wide press coverage, with the merits of the decision debated by everyone from sports radio talk show hosts to football fans. But it probably won’t end there. The cancellation likely will breathe new life into the doctrine, with interest groups and individuals from such groups relying on it to address trademarks that allegedly cause them reputational harm, as well as marketplace participants using it as another arrow in their quiver to attack trademarks used by their competitors.³

Pre-Game: What Is a Trademark Disparagement?

There is a two-part test to determine if a trademark is disparaging or not.

First, the trier of fact must determine what is the meaning of the matter in question as it appears in the trademarks, and as those trademarks are used in connection with the goods and/or services identified in the trademark registrations. Second, the trier of fact must determine if the meaning of the trademarks is one that would be found disparaging to a substantial composite of the relevant group (*viz.*, the group allegedly disparaged by the trademark and referenced thereby).⁴

Both questions are to be answered as of the various dates of registration of the involved trademarks. In doing so, the doctrine is structured in a way to prevent hindsight bias, which could result if the specific views taken into consideration in the disparagement calculus were contemporary views of the relevant population.⁵ Cancellation is only granted with “due caution” and “after a most careful study of all the facts.”⁶

Ironically, the phases of the Redskins trademark dispute can be viewed as a battle between two sides (individual Native Americans versus Pro-Football, Inc.,⁷ the owner of the Redskins’ trademarks) over four time periods—akin to a football game.

First Quarter: Redskins Defense Overwhelmed by Powerful Offense

To understand how the contours of the disparagement doctrine will take shape going forward, an examination of the Redskins trademark decision is required. To do that, we go back to 1992, when seven Native Americans filed a petition against Pro-Football in the TTAB to cancel six “Redskins” trademark registrations on the grounds of disparagement.⁸

After seven years of litigation, the TTAB held that the Redskins trademarks were disparaging to Native Americans at the time when they were registered and cancelled the registrations.⁹ It appeared that the Redskins marks had been defeated. But Pro-Football

ran a play from its playbook that would change the outcome: laches.

Second Quarter: Redskins Take the Lead After Tough Back-and-Forth

Pro-Football appealed the decision pursuant to 15 U.S.C. § 1071(b), which at that time allowed for the appeal of a TTAB decision by filing a civil action in the United States District Court for the District of Columbia.¹⁰ In *Pro-Football Inc. v. Harjo*, the court reversed the cancellations, concluding that the evidence did not support the conclusion of disparagement. The court also said that even if the trademarks were disparaging, the Native Americans who filed the cancellation petition were barred from obtaining relief on the grounds of laches.¹¹

The *Harjo* petitioners appealed the decision to the United States Court of Appeals for the District of Columbia Circuit, which reversed the laches conclusion as to one of the Native Americans who filed the petition and remanded.¹² The district court on remand found that laches barred the claim in light of the (i) petitioners’ inaction over eight years in failing to diligently bring forth and prosecute their claim and (ii) resulting prejudice, both economic and at trial, suffered by Pro-Football, which had invested significantly in the trademarks over that entire period.¹³

Again, the matter went up on appeal, but this time the D.C. Circuit affirmed, finding it would be inequitable to allow the Native American petitioners success on their cancellation petition on the grounds of laches. Notably, the D.C. Circuit resolved the case solely on laches grounds.¹⁴ Thus, the offense knew what it needed to do in the second half: find petitioners who had not sat on their rights and would not be subject to the laches defense, and hone the disparagement argument that prevailed the first time around at the TTAB in *Harjo*.

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Third Quarter:

Redskins Let the Offense Score: Trademark Registrations Cancelled

In *Amanda Blackhorse, Marcus Briggs-Cloud, Philip Gover, Jillian Pappan, and Courtney Tsotigh v. Pro-Football, Inc.*,¹⁵ the TTAB was again faced with determining if the six Redskins trademarks were disparaging under Section 2(a) of the Lanham Act and, if so, if the defense of laches nonetheless barred cancellation. Six Native Americans contended in their petition that the six trademarks were disparaging of Native Americans at the time when the trademarks were registered—different years from 1967 through 1990—and thus not entitled to federal trademark protection by a trademark registration.

Here, the TTAB focused on answering the following question: Was the term “redskins” disparaging to Native Americans at the time that the trademarks were registered? The TTAB, on June 18, 2014, answered this question affirmatively and rejected the laches defense. In applying the first part of the disparagement test (what is the meaning of the matter in question as it appears in the marks and as those marks are used in connection with the goods and services identified in the trademark registrations), the TTAB found that the disparagement claim only pertained to the term “redskins,” not the Native American imagery used by the team,¹⁶ and that “redskins” clearly referred to the NFL team and carried with it the allusion to Native Americans inherent in the original definition of that word.¹⁷

On the second part of the test (is the meaning of the marks one that may disparage a substantial composite of the relevant population, *viz.*, Native Americans?), the TTAB relied on two categories of evidence: (i) general analysis of the word and (ii) the specific views of Native Americans at the time of registration. As to the former, the TTAB relied heavily on old dictionaries that indicated under the definition of “redskins” that the term was often offensive. Of critical importance to the TTAB, and heavily relied on by the petitioners, was the fact that the oldest such dictionary reference to the offensive nature of “redskins” was from the Random House Unabridged First Edition in 1966—one year before the first Redskins trademark registration.¹⁸ For 1859 to 1965, however, there was no such reference.¹⁹ Then, beginning in 1966, the num-

The trademark must be found to be disparaging when the trademark was registered.



ber of dictionary entries indicating the term “redskins” was offensive increased. The entries included restrictive usage labels for “redskins” ranging from “not the preferred term” to “often disparaging and offensive.”²⁰

Then, the TTAB looked at evidence related to the specific views of Native Americans on the term “redskins.” One piece of evidence they examined was a resolution from the National Congress of American Indians (“NCAI”), which represented about 30 percent of Native Americans.²¹ Specifically, the NCAI executive council in 1993 issued a resolution that set forth both the past and ongoing viewpoint of Native Americans on the term’s offensiveness.²² So what the TTAB did, in essence, was accept the NCAI resolution from 1993 as “represent[ing] the views of a substantial composite of [what] Native Americans” believed in the past as probative of whether Native Americans actually considered the term offensive back when the Redskins trademarks were first registered in 1967.²³

Another piece of evidence that the TTAB relied on was a 1972 meeting of the NCAI President with then Redskins part-owner and president Edward Bennett Williams requesting that the team cease using “redskins” because it was disparaging.²⁴

They also considered the *Michigan Civil Rights Commission Report on Use of Nicknames, Logos and Mascots Depicting Native American People in Michigan Education Institutions* (1988), which referenced NCAI’s efforts to have the team’s name changed,²⁵ as well as 19 letters written during the 1972–1993 timeframe from individuals across the United States who identified themselves as Native Americans. The letters were sent to past team owners and protested the use of the term “redskins.”²⁶

With all that evidence taken together, the TTAB found that, at a minimum, approximately 30 percent of Native Americans—considered a substantial composite—found the term “redskins” used in connection with the football team to be disparaging at all times, including during the years corresponding to the registration years for the trademarks (1967, 1972, 1974, 1978 and 1990), which warranted cancellation on the grounds of disparagement pursuant to Section 2(a) of the Lanham Act.²⁷

Pro-Football had one last drive: its previously successful laches defense. However, this time the TTAB rejected it. The TTAB found that laches did not apply to a disparagement claim where the disparagement pertains to a group of which the individual petitioner simply comprises one or more members.²⁸ The TTAB also found it difficult to justify balancing any economic harm to the Washington football organization against human dignity.²⁹

Furthermore, the TTAB noted that it and courts had “routinely held that where there is a broader public policy concern at issue, the equitable defense of laches does not apply.”³⁰ Coupled with Pro-Football’s failure to show “that any one of the [petitioners] ha[d] unreasonably delayed in bringing the petition to cancel” or that Pro-Football “ha[d] been prejudiced” by “the eleven and fifteen month delays of [petitioners] Tsotigh and Pappan” upon which the laches defense was based, the TTAB held there was insufficient support in the record to bar cancellation on the grounds of laches.³¹

One of the three administrative judges on the panel dissented. In his dissent, the judge chided the majority’s heavy reliance on the dictionary evidence, which he called “inconclusive.”³² He also found unreliable

the evidence to corroborate NCAI membership to justify its opinions as reflective of those of a "substantial composite" of the Native American population.³³ Lastly, he pointed out that, upon his reading of the record, there was simply insufficient evidence to support that a substantial composite of the Native American population, from 1967 to 1990, found the term "redskins" specifically in connection with the team disparaging.³⁴

Fourth Quarter:

Effect Felt, Appeal of Decision Initiated, Who Will Win?

Right now, going into the pending Fourth Quarter appeal,³⁵ here is what Pro-Football is facing, as it is down at present in the game. Pro-Football can still use "redskins." The TTAB decision has the effect of cancelling a federal trademark registration that, although not without effects,³⁶ does not foreclose the use of any one or more of the trademarks by the team.³⁷ However, the team must tread cautiously in its marching up and down the field going forward when expressing its intent to continue use of the term, as it has faced some resulting backlash, with some in the press expressing their dismay with this intransigence by simply refusing to use the "redskins" term to refer to the team.³⁸

Team owner Daniel Snyder, no stranger to controversy, will have to decide how to line up his team in this Fourth Quarter. Specifically, he must (i) maximize his chance of success in having the Eastern District of Virginia reverse the TTAB decision below, (ii) present as favorable a record on further appeal of the eventual decision of the Eastern District of Virginia to the Federal Circuit should that come to pass, and (iii) minimize the probability of the U.S. Supreme Court granting certiorari, surely bound to cause even more severe negative publicity for the team, to finally end the long dispute once and for all.


What About Other Games?

It would be naïve to believe that this decision will not be reviewed avidly by interest groups or marketplace competitors to see how it could benefit them in their battles to eliminate (i) perceived reputational harm from the continued use of alleged disparaging trademarks or (ii) a competitor's continued use of a trademark that could legitimately be considered as disparaging. The key limitation that these parties intent on using the doctrine will face is the requirement that the trademark must be found to be disparaging *when the*

trademark was registered.

So, for example, Native American groups will be very hard pressed to succeed in cancellation of any registered trademarks that contain the word "Indians," because it is quite likely that the term—still used in common parlance today to refer to Native Americans—was not considered disparaging when the suspect trademark was registered. In fact, it is quite likely that if the Washington team changed its name to the "Indians" or the name of a particular tribe, the team would not face a viable disparagement-based opposition³⁹ or cancellation claim from Native Americans.

In addition, terms whose connotation may have shifted with the sands of time would still be difficult to cancel because what is relevant is not any contemporary connotation but rather its connotation at the time when a mark was registered.

Finally, discovery battles loom large in any case where this doctrine is implicated in determining what is or is not a substantial composite of the relevant group that finds the suspect trademark disparaging.⁴⁰ In any event, a rarely used doctrine in trademark law has received a good dusting and revealed what is a very strong basis of attacking a trademark. 

endnotes

1. www.merriam-webster.com/dictionary/disparagement?show=0&w=1405713218.
2. The decision, *Amanda Blackhorse, Marcus Briggs-Cloud, Philip Gover, Jillian Pappan, and Courtney Tsotig v. Pro-Football Inc.*, 2014 WL 2757516 (Trademark Tr. & App. Bd. June 18, 2014), is available through the TTAB's TTABVue system at <http://ttabvue.uspto.gov/ttabvue/v?qt=adv&procstatus=All&pn=92046185&propno=&q=&propnamecop=&propname=&cop=&pn=&prop2=&pn2=&cop=&cn>. The trademarks cancelled are Registrations (1) No. 0,836,122 (THE REDSKINS, stylized font shown below), first registered on Sep. 26, 1967, for "entertainment services—namely, football exhibitions rendered in stadia and through the media of radio of television broadcasts" in Class 41 [education and entertainment services], (2) No. 0,978,824 (WASHINGTON REDSKINS), first registered on Feb. 12, 1974,

for entertainment services—namely, presentations of professional football contests, in Class 41; (3) No. 0,986,668 (WASHINGTON REDSKINS and design shown below), for "entertainment services—namely, presentations of professional football contests," in Class 41; (4) No. 0,987,127 (THE REDSKINS and design shown below), first registered on June 25, 1974, for "entertainment services—namely, presentations of professional football contests" in Class 41; (5) No. 1,085,092 (REDSKINS), first registered Feb. 7, 1978, for "entertainment services—namely, presentation of professional football contests" in Class 41; and (6) No. 1,606,810 (REDSKINETTES), first registered on July 17, 1990, for "entertainment services, namely, cheerleaders who perform dance routines at professional football games and exhibitions and other personal appearances" in Class 41.

- (1): 
- (2): 
- (3): 
3. However, any marketplace participant, in seeking to cancel a competitor's trademark through a petition filed with the TTAB on the grounds of disparagement, would still have to have the requisite standing to bring such an action, which would require a showing that it "believes that [it] is or will be damaged" by the continued registration of such alleged registered disparaging trademark. 15 U.S.C. § 1064 (Section 14 of the Lanham Act).
4. *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014).
5. The provisions of Section 2(a) of the Lanham Act require the TTAB, when faced with a petition to cancel brought under

Section 14(3) of the Lanham Act based on Section 2(a), to determine if the evidence made of record in a case established that the trademarked term was disparaging to a substantial composite of the relevant group at the time each of the challenged registrations issued. *Consorzio del Prosciutto di Parma v. Parma Sausage Prods. Inc.*, 23 U.S.P.Q. 2d 1894, 1898-99 (Trademark Tr. & App. Bd. 1992) (citing Section 14(3)'s language of "registration was obtained ... contrary to the provisions of ... subsection (a) ... of section 2").

6. *Rockwood Chocolate Co. v. Hoffman Candy Co.*, 372 F.2d 552 (C.C.P.A. 1979).
7. Pro-Football, Inc. is a Maryland corporation with a principal place of business in Ashburn, Va., the home of the Redskins organization itself, which owns the "Redskins" trademarks <https://sccefile.scc.virginia.gov/Business/F024104>.
8. Cancellation Proceeding No. 92/021,069, *Suzan Harjo*,