

## Challenge-Flag Thrown: The Trademark Trial and Appeal Board's Cancellation of the Redskins' Trademarks and Pro-Football's Chances on Appeal

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JULIE A. HOPKINS\* AND THOMAS M. JORAANSTAD\*\*

## Challenge-Flag Thrown: The Trademark Trial and Appeal Board's Cancellation of the Redskins' Trademarks and Pro-Football's Chances on Appeal

*"As long as I own this football team and long after I'm gone, they will always be the Washington Redskins."* – Jack Kent Cooke, former owner, Washington Redskins<sup>1</sup>

*"We'll never change the name. It's that simple. NEVER – you can use caps."* – Daniel Snyder, Washington Redskins Owner<sup>2</sup>

### I. INTRODUCTION

ON A CHILLY AFTERNOON IN DECEMBER, one hundred activists gathered, chanted, and marched outside of FedEx Field in Landover, Maryland, home of the Washington Redskins football team.<sup>3</sup> This was the largest protest at a Washington

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1. Leonard Shapiro, *A Sometimes Difficult Man Who Never Found it Hard to Love Life*, WASH. POST, Apr. 7, 1997, at C7.

2. Erik Brady, *Daniel Snyder Says Redskins Will Never Change Name*, USA TODAY (May 10, 2013, 8:14 AM), <http://www.usatoday.com/story/sports/nfl/redskins/2013/05/09/washington-redskins-daniel-snyder/2148127>.

3. John Woodrow Cox, *At FedEx Field, Redskins Name Protestors Exchange Sharp Words with Fans*, WASH. POST (Dec. 28, 2014), [http://www.washingtonpost.com/local/at-fedex-field-redskins-name-protesters-exchange-sharp-words-with-fans/2014/12/28/f3aa1acc-8ed3-11e4-a412-4b735edc7175\\_story.html](http://www.washingtonpost.com/local/at-fedex-field-redskins-name-protesters-exchange-sharp-words-with-fans/2014/12/28/f3aa1acc-8ed3-11e4-a412-4b735edc7175_story.html).

home game, and the last of a disappointing season for the team.<sup>4</sup> Demonstrators, including many Native Americans, urged fans to “Rethink,” “Replace,” and “Rename.”<sup>5</sup> The protestors chanted, “We are people, not your mascots.”<sup>6</sup> Some fans ignored them, many more shouted back “Hail to the Redskins” and other far less printable responses.<sup>7</sup> The protest was one in a series of recent attempts to bring awareness to the issue and reflects the ongoing desire of many Native Americans, and increasingly the public at large, for the Washington football team to change its name.<sup>8</sup>

As the debate over whether the team should change its name continues to be played out at football stadiums, in living rooms, and in the media, the ongoing legal battle to cancel the football team’s trademarks begins its next chapter. Recently, in a 2–1 decision by the Trademark Trial and Appeal Board (the “TTAB”), and for the second time, the TTAB granted a petition to cancel the REDSKINS trademarks under a little used provision of federal law that allows a registered trademark to be cancelled if the trademark is perceived to be disparaging to a substantial composite of the referenced group—in this case, Native Americans.<sup>9</sup> The TTAB, relying on much of the same evidence from the first cancellation proceedings, agreed with the petitioners that the term *redskin*(s) is disparaging to Native Americans.<sup>10</sup>

Despite this victory for proponents of the name change, the fight is not over. The owner of the six cancelled trademarks, Pro-Football, Inc. (“Pro-Football”), has filed an action in the United States District Court for the Eastern District of Virginia (the “Eastern District”) to overturn the TTAB’s decision.<sup>11</sup> Considering the flaws of the major pieces of evidence relied on by petitioners and the TTAB in making its decision, and considering further how similar evidence and reasoning was treated by the United States District Court for the District of Columbia (the “D.C. Circuit”) in a previous and nearly identical action, it seems possible, if not likely, that the Court will find that the *Blackhorse* petitioners are unable to show by a preponderance of the evidence that the marks are disparaging as perceived by Native Americans, and thus the TTAB’s decision to cancel the trademarks is not

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4. *Id.*

5. *Id.*

6. *Id.* Elsewhere, fans of the name chanted, “keep the name.” Chris Lingeback, *‘Keep the Name’ Chant Drowns Out Dan Snyder at Redskins Rally in Houston*, CBS DC (Sept. 6, 2014, 11:16 PM), <http://washington.cbslocal.com/2014/09/06/keep-the-name-chant-drowns-out-dan-snyder-at-redskins-rally-in-houston/>.

7. Cox, *supra* note 3.

8. *See id.*

9. *U.S. Patent Office Rules ‘Redskins’ Name Disparaging, Cancels Trademarks*, CBS DC (June 18, 2014, 1:04 PM), <http://washington.cbslocal.com/2014/06/18/u-s-patent-office-cancels-six-trademarks-for-washington-redskins/> [hereinafter *U.S. Patent Office Rules*].

10. *Id.*

11. Andrew Zajac, *NFL’s Redskins Appeal Ruling that Team Name is Offensive*, BLOOMBERG (Aug. 15, 2014), <http://www.bloomberg.com/news/print/20140814/redskinsappealboardrulingthateamnameisdisparaging.html>.

supported by substantial evidence.<sup>12</sup> If the Eastern District reaches this conclusion, the TTAB decision must be reversed, and the marks will remain registered.<sup>13</sup>

In order to understand the current legal battle over the Redskin(s) trademarks, it is necessary to understand issues beyond the current legal proceedings. Initially, the history of Native American imagery and names as athletic team nicknames and mascots will be discussed, as well as efforts to curb and eliminate the use of such nicknames and mascots.<sup>14</sup> After a brief, but essential outline of the common law and statutory roots of trademark protection in the United States, the Article will address trademark cancellation proceedings generally.<sup>15</sup> Next, a look at Section 2(a) of the Lanham Act, and the related jurisprudence involving “scandalous” and “disparaging” marks will demonstrate the roots of the legal framework the TTAB used in its recent ruling.<sup>16</sup> The first cancellation proceeding, the “Harjo Litigation,” and the second cancellation proceeding, the “Blackhorse Litigation,” will be subsequently explained in detail.<sup>17</sup> Finally, this Article will analyze the likelihood that the TTAB’s decision in the Blackhorse Litigation will be upheld or reversed on appeal.<sup>18</sup> As will be shown, if the Eastern District adopts the same approach as the D.C. Circuit in the Harjo Litigation, which seems likely, the TTAB decision will be reversed in the current action.<sup>19</sup>

## II. BACKGROUND

### A. Native American Names as Athletic Team Nicknames and Mascots

American sports teams at all levels have a long history of using Native American names and imagery in team names, logos, and mascots.<sup>20</sup> For example, in 1912, the Boston Beaneaters, now the Atlanta Braves, changed its name to the Boston Braves, becoming one of the first professional teams to use a Native American term as its name.<sup>21</sup> Numerous professional and collegiate level sports teams followed suit, adopting similar names.<sup>22</sup> The popularity of Native American terms for team

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12. See *infra* Part IV.

13. See Zajac, *supra* note 11.

14. See *infra* Part II.A.

15. See *infra* Part II.B–C.

16. See *infra* Part III.A–B.

17. See *infra* Part III.C–D.

18. See *infra* Part IV.

19. See *infra* Part IV.

20. Brief for Nat’l Cong. of Am. Indians et al. as Amici Curiae Supporting Petitioners at 16, *Harjo v. Pro-Football, Inc.*, 558 U.S. 1025 (2009) (No. 09-326) [hereinafter NCAI Brief] (estimating that over 3,000 middle school, high school, colleges, and universities at one time used Native American mascots and nicknames).

21. J. Gordon Hylton, *Before the Redskins Were the Redskins: The Use of Native American Team Names in the Formative Era of American Sports, 1857–1933*, 86 N.D. L. REV. 879, 896–97 (2010).

22. NCAI Brief, *supra* note 20, at 16.

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mascots and nicknames skyrocketed in the early twentieth century, with, at its peak, over 3,000 high school, college, and professional teams using Native American mascots or nicknames.<sup>23</sup> In 1963, the Dallas Texans relocated to Kansas City and were renamed the Chiefs, the last professional sports team to adopt a Native American mascot.<sup>24</sup> Today, several professional teams still use such names.<sup>25</sup>

In response to this trend and other negative portrayals of Native Americans in the media, in 1968, the National Congress of American Indians (the “NCAI”) established an official campaign “to bring an end to negative and harmful stereotypes [of Native Americans] in the media and popular culture.”<sup>26</sup> Over the ensuing decades, efforts by Native American groups and changing public attitudes<sup>27</sup> towards Native American mascots and imagery have changed the mascot landscape. In 2005, the National Collegiate Athletic Association (“NCAA”) stated it would no longer allow the use of Native American mascots or nicknames in its postseason tournaments, simultaneously issuing a list of eighteen schools with “hostile or abusive” mascots and nicknames.<sup>28</sup> Myles Brand, the president of the NCAA stated, “as a national association, we believe that mascots, nicknames or images deemed hostile or abusive in terms of race, ethnicity or national origin should not be visible at the championship events that we control.”<sup>29</sup> Following the NCAA’s lead, some

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23. *See id.*

24. NAT’L CONG. OF AM. INDIANS, ENDING THE LEGACY OF RACISM IN SPORTS & THE ERA OF HARMFUL “INDIAN” SPORTS MASCOTS 9 (2013), available at [http://www.ncai.org/attachments/policy/paper\\_mijapmouwdbjqftjayzqwqldrwzvsyfakbwhpmtacoroyolpn\\_ncai\\_harmful\\_mascots\\_report\\_ending\\_the\\_legacy\\_of\\_racism\\_10\\_2013.pdf](http://www.ncai.org/attachments/policy/paper_mijapmouwdbjqftjayzqwqldrwzvsyfakbwhpmtacoroyolpn_ncai_harmful_mascots_report_ending_the_legacy_of_racism_10_2013.pdf) [hereinafter ENDING THE LEGACY].

25. This includes the Kansas City Chiefs and Washington Redskins (National Football League); the Atlanta Braves and Cleveland Indians (Major League Baseball); and the Chicago Blackhawks (National Hockey League). See Erik Brady, *Redskins not Only Team Targeted for Indian Nickname*, USA TODAY (May 5, 2014, 11:07 AM), <http://www.usatoday.com/story/sports/2014/05/04/redskins-mascot-nickname-indians-wahoo-chiefs-blackhawks-braves/8705159/>.

26. ENDING THE LEGACY, *supra* note 24, at 2.

27. See, e.g., Press Release, U.S. Comm’n on Civil Rights, Statement of U.S. Commission on Civil Rights on the use of Native American Images and Nicknames as Sports Symbols (Apr. 13, 2001), available at <http://www.usccr.gov/press/archives/2001/041601st.htm> (calling for “the end of the use of Native American images and team names” by non-Native teams).

28. Press Release, Nat’l Collegiate Athletic Ass’n, NCAA Executive Committee Issues Guidelines for Use of Native American Mascots at Championship Events (Aug. 5, 2005), available at <http://fs.ncaa.org/Docs/PressArchive/2005/Announcements/NCAA%2BExecutive%2BCommittee%2BIssues%2BGuidelines%2Bfor%2BUse%2Bof%2BNative%2BAmerican%2BMascots%2Bat%2BChampionship%2BEvents.html>. The following nicknames and mascots were deemed hostile and abusive: Braves, Chippewas, Seminoles, Utes, Indians, Fighting Illini, Redmen, Choctaws, Fighting Sioux, and Savages. *Id.* Teams with those mascots are still allowed to participate in the postseason tournaments and championships, but they are not allowed to wear uniforms or anything else that shows the offending nicknames or imagery. *Id.*

29. *Id.*

states have taken similar action.<sup>30</sup> These efforts led to a precipitous decline in the use of such mascots,<sup>31</sup> with less than 1,000 of the once 3,000 “Indian” references remaining.<sup>32</sup>

This trend, however, has not been followed by the professional sports teams that use Native American mascots and nicknames.<sup>33</sup> Among these teams is the Washington Redskins, who adopted the moniker “Redskins” in 1933.<sup>34</sup> For decades, Native American groups have pressured Washington’s owners to change the name.<sup>35</sup> Its current owner, Daniel Snyder, like its former owner, Jack Kent Cooke,<sup>36</sup> denies that the term “redskin(s)” is in any way offensive and vehemently refuses to change the name.<sup>37</sup> In contrast, many Native American groups and individuals maintain that the term is derogatory, disparaging, and offensive.<sup>38</sup> After years of

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30. See, e.g., WIS. STAT. ANN. § 118.134 (West 2014) (allowing school district residents to officially object and potentially remove a Native American school nickname, logo, or mascot); Mich. St. Bd. of Educ., *Resolution: Use of American Indian Mascots, Nicknames, and Logos* (June 26, 2003), available at [http://www.michigan.gov/documents/mascots\\_69612\\_7.res.pdf](http://www.michigan.gov/documents/mascots_69612_7.res.pdf) (urging all Michigan schools to remove Native American mascots); CNN Wire Staff, *Oregon bans Native American School Mascots, Images*, CNN.COM (May 18, 2012, 10:37 PM), <http://www.cnn.com/2012/05/18/us/oregon-native-american-mascots/> (reporting on the Oregon State Board of Education vote that banned Oregon schools from using Native American images and mascots). In contrast, an ongoing debate has taken place in North Dakota over whether to replace the University of North Dakota (“UND”) nickname, the Fighting Sioux, despite the NCAA policy. The fight included a state senate bill ordering UND to keep the name, a statewide referendum on whether to keep the name, and a lawsuit against the NCAA. See *Most Sioux Logos to Stay at UND*, ESPN.COM (Sept. 26, 2012, 9:03 PM), [http://espn.go.com/college-sports/story/\\_/id/8429126/ncaa-allows-most-north-dakota-sioux-logos-stay](http://espn.go.com/college-sports/story/_/id/8429126/ncaa-allows-most-north-dakota-sioux-logos-stay).

31. Of the nineteen schools cited for hostile and abusive names, at least eleven have changed or eliminated their mascot. Ibram Rogers & Frank J. Matthews, *Use of Indian Mascots Coming to an End for College Teams*, DIVERSE (June 1, 2006), <http://diverseeducation.com/article/5934/>.

32. ENDING THE LEGACY, *supra* note 24, at 6.

33. Although no professional team name has changed since 1963, the Atlanta Braves stopped using Chief Noc-A-Homa as its mascot in 1986, but this was due to a contract dispute. See *Sports People; Mascot Won't Return*, N.Y. TIMES (Jan. 19, 1986), <http://www.nytimes.com/1986/01/19/sports/sports-people-mascot-won-t-return.html>. Chief Noc-A-Homa would emerge from a teepee in the outfield and dance for each Braves’ home run. *Id.* The Braves caused controversy recently by bringing back the “Screaming Savage” logo on its batting practice caps. See Kevin Kaduk, ‘Screaming Savage’ Makes Return on Braves’ Batting Practice Caps for 2013, YAHOO! SPORTS (Dec. 27, 2012, 10:25 AM), <https://ca.sports.yahoo.com/blogs/mlb-big-league-stew/screaming-savage-makes-return-braves-batting-practice-caps-152538767—mlb.html>.

34. ENDING THE LEGACY, *supra* note 24, at 10.

35. *Id.* at 12.

36. Shapiro, *supra* note 1, at C7 (reporting on a conversation with Jack Kent Cooke in which Cooke denies the offensive nature of the word Redskins).

37. *Daniel Snyder Defends ‘Redskins’*, ESPN.COM (Aug. 6, 2014, 9:44 AM), [http://espn.go.com/nfl/story/\\_/id/11313245/daniel-snyder-redskins-term-honor-respect](http://espn.go.com/nfl/story/_/id/11313245/daniel-snyder-redskins-term-honor-respect) (“A Redskin is a football player. A Redskin is our fans. The Washington Redskins fan base represents honor, represents respect, represent pride. . . . it’s a positive.” (quoting Daniel Snyder, Owner, Washington Redskins)).

38. See NCAI Brief, *supra* note 20, at 3–7. Twenty-three Native American advocacy groups joined the NCAI Brief calling for the elimination of the Redskins nickname because the mark is “patently offensive, disparaging, and demeaning and perpetrates a centuries-old stereotype.” *Id.* at 8.

unsuccessfully lobbying Pro-Football, Inc.<sup>39</sup> for a name change, seven Native Americans filed a petition to cancel six registered trademarks containing the term “redskin(s)” in 1992.<sup>40</sup> This began a seventeen-year court battle (the “Harjo Litigation”) that ended in 2009 when the Federal Circuit Court of Appeals upheld the lower court’s dismissal of the petition on laches grounds.<sup>41</sup>

*B. Federal Trademark Protection*

Before examining the Harjo Litigation and the current cancellation petition proceedings involving the six marks, it is necessary to examine the Lanham Act of 1946—the basis for the cancellation proceeding, and the source of federal trademark rights.<sup>42</sup> Trademark rights are rooted in common law.<sup>43</sup> The United States utilizes a “use-based” trademark system,<sup>44</sup> meaning that the person claiming rights in a mark or attempting to register a mark must first have used the mark in commerce.<sup>45</sup> After several, largely unsuccessful attempts at a federal scheme to regulate trademarks,<sup>46</sup> Congress passed the Lanham Act in 1946, in part, to encourage federal registration and centralization of trademarks.<sup>47</sup>

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39. Pro-Football, Inc. is the corporation owned by Daniel Snyder that actually owns the trademarks and the team. See *Company Overview of Pro-Football, Inc.*, BLOOMBERG BUS., <http://investing.businessweek.com/research/stocks/private/snapshot.asp?privcapId=24082365> (last visited Jan. 19, 2015).

40. See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999), *rev'd*, 284 F. Supp. 2d 96 (D.D.C. 2003), *remanded on alternative grounds*, 415 F.3d 44 (D.C. Cir. 2005), *on remand*, 567 F. Supp. 2d 46 (D.D.C. 2008), *aff'd on laches ground*, 565 F.3d 880 (D.C. Cir. 2009).

41. *Id.* The Harjo Litigation will be discussed in more detail later in this article. See *infra* Part III.C.

42. Lanham Act of 1946, Pub. L. No. 79-489, 60 Stat. 427 (1946) (codified as amended at 15 U.S.C. §§ 1051–1127 (2014)).

43. *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879) (“The right to adopt and use a symbol or device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has long been recognized by the common law. . . . This exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement.”). See also *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 372 (1st Cir. 1980) (“[Federal] registration does not create the underlying right in a trademark. That right, which accrues from the use of a particular name or symbol, is essentially a common law property right.” (citing *Campbell Soup Co. v. Armour & Co.*, 175 F.2d 795, 797 (3rd Cir. 1949), *cert. denied*, 338 U.S. 847 (1949))).

44. See 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 19:1.25 (4th ed. 2014) [hereinafter MCCARTHY]. For a discussion on the merits of the use-based registration system, see William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987).

45. See, e.g., *Miller v. Glenn Miller Prods. Inc.*, 454 F.3d 975, 979 (9th Cir. 2006) (“Registration does not create a mark or confer ownership; only use in the market-place can establish a mark.”); see also 15 U.S.C. § 1051 (2014) (setting forth the requirements for federal trademark registration).

46. See Ethan Horwitz & Benjamin Levi, *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*, 7 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 59, 60–62 (1996) (discussing the ineffectiveness of the Lanham Act’s predecessors).

47. MCCARTHY, *supra* note 44, at § 19:2 (citing *Bongrain Int’l (Am.) Corp. v. Delice de France, Inc.*, 811 F.2d 1479 (Fed. Cir. 1987)).

The Lanham Act allows the holder of a mark to register the mark with the United States Patent and Trademark Office (“USPTO”).<sup>48</sup> Although federal registration does not create a trademark or confer ownership, a registered mark enjoys numerous benefits including: (1) public notice of ownership of the mark;<sup>49</sup> (2) a legal presumption of ownership of the mark and exclusive right to use the mark nationwide or in connection with the good and services registered;<sup>50</sup> (3) the ability to bring actions associated with the mark in federal court;<sup>51</sup> (4) a basis to obtain registration in foreign countries;<sup>52</sup> and (5) U.S. Customs protection against the importation of infringing foreign goods.<sup>53</sup>

To register a mark with the USPTO, the claimant first files an application.<sup>54</sup> The application is reviewed by an examining attorney, who, among other things, ensures that the mark is not statutorily barred from registration.<sup>55</sup> If the examining attorney approves the application, the mark is subsequently published for opposition in the USPTO’s Official Gazette.<sup>56</sup> During this thirty day period, individuals and organizations may file oppositions challenging the mark’s registration.<sup>57</sup> If no opposition is filed, or filed oppositions fail, the mark is placed on the Principal Register.<sup>58</sup>

### *C. Cancellation Proceedings*

Although the mark may be federally registered, the propriety of the registration may be subsequently challenged by filing a cancellation petition.<sup>59</sup> Any individual or organization with standing<sup>60</sup> who wishes to cancel the mark may file a cancellation

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48. 15 U.S.C. § 1051 (2014).

49. *Id.* § 1062.

50. *Id.* § 1057.

51. *Id.* § 1121.

52. *Id.* § 1141(a).

53. *Id.* § 1124.

54. *Trademark Process*, USPTO.GOV, <http://www.uspto.gov/trademarks/process/index.jsp> (last updated Sept. 6, 2012, 5:25 PM).

55. *Id.*

56. *Id.*

57. *Id.*

58. 15 U.S.C. § 1062 (2014).

59. *Id.* § 1064. The grounds on which a party may file a cancellation petition vary depending on whether the petition was brought within five years of the mark’s registration. *Id.* This article will focus on cancellation petitions brought after five years.

60. The issue of standing is beyond the scope of this article. For a discussion on standing to challenge scandalous and disparaging marks, see Lynda J. Oswald, *Challenging the Registration of Scandalous and Disparaging Marks under the Lanham Act: Who has Standing to Sue?*, 42 AM. BUS. L.J. 251 (2004); Roger D. Blair & Thomas F. Cotter, *The Elusive Logic of Standing Doctrine in Intellectual Property Law*, 74 TUL. L. REV. 1323 (2000).

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petition with the TTAB on the grounds that registration was obtained contrary to the statutory bars listed in Section 2(a)–(c) of the Lanham Act.<sup>61</sup> A successful cancellation petition, however, only cancels a mark's registration on the Principal Register; it does not necessarily invalidate the mark holder's state or common law rights.<sup>62</sup>

Next, the TTAB examines the appropriate evidence to determine whether the mark should be cancelled.<sup>63</sup> Registration on the Principal Register attaches a presumption of validity to the challenged mark,<sup>64</sup> and the burden of proof is on the petitioner to overcome this presumption by a preponderance of the evidence.<sup>65</sup> If the petitioner meets this burden, then the burden shifts to the registrant to defend the validity of the mark's registration.<sup>66</sup> If a party is dissatisfied with the decision of the TTAB, the aggrieved party has two options. First, the decision of the TTAB may be appealed to the United States Court of Appeals for the Federal Circuit ("Federal Circuit") by either party to the cancellation proceeding.<sup>67</sup> The Federal Circuit reviews the TTAB's decision using the record of the underlying TTAB proceeding, and thus no new evidence is permitted in an appeal to the Federal Circuit.<sup>68</sup> The Supreme Court considers appeals from the Federal Circuit.<sup>69</sup>

Alternatively, the aggrieved party may institute a civil action in federal district court.<sup>70</sup> If the adverse parties reside in multiple federal districts not within the same state, the United States District Court for the Eastern District of Virginia has jurisdiction over the civil action.<sup>71</sup> This action is both an appeal, and a new action; thus, the parties may request additional relief and submit new evidence.<sup>72</sup> While the district court appeal is *de novo*, it is unique in that the findings of fact made by the

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61. 15 U.S.C. § 1064(3) (citing 15 U.S.C. § 1052(a)–(c)). This article will focus on subsection (a), the basis for the cancellation proceedings brought against the six marks containing the term *redskin(s)*. See *infra* Part III.C–D.

62. *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 1391 (Fed. Cir. 2010) (“[C]ancellation of a trademark registration does not necessarily translate into abandonment of common law trademark rights.”). See also MCCARTHY, *supra* note 44, at § 20:40.

63. 15 U.S.C. § 1067.

64. *W. Fla. Seafood, Inc. v. Jet Rests., Inc.*, 31 F.3d 1122, 1125 (Fed. Cir. 1994) (“[A] presumption of validity attaches to a service mark registration, and the party seeking cancellation must rebut this presumption by a preponderance of the evidence.”).

65. See *Cold War Museum, Inc. v. Cold War Air Museum, Inc.*, 586 F.3d 1352, 1358 (Fed. Cir. 2009).

66. See *id.*

67. 15 U.S.C. § 1071(a).

68. *Id.* See also MCCARTHY, *supra* note 44, at § 21:16; *Aktieselskabet AF 21. Nov. 2011 v. Fame Jeans Inc.*, 525 F.3d 8, 13 (D.C. Cir. 2008) (“In a Federal Circuit appeal, the PTO transmits its record to the court, which ‘shall review the decision from which the appeal is taken on the record.’” (citing 15 U.S.C. § 1071(a))).

69. 28 U.S.C. § 1254 (2012).

70. 15 U.S.C. § 1071(b)(1); see *Swatch AG v. Beehive Wholesale, LLC*, 739 F.3d 150, 155 (4th Cir. 2014).

71. 15 U.S.C. § 1071(b)(4).

72. *Id.* § 1071(b)(3); see *CAE, Inc. v. Clean Air Eng'g, Inc.*, 267 F.3d 660, 673 (7th Cir. 2001).

TTAB are afforded great weight.<sup>73</sup> In fact, upon motion, the entire record of the previous proceedings may be admitted as evidence.<sup>74</sup> The district court has the authority to grant or cancel trademark registrations and decide any related matters.<sup>75</sup> Appeals from the district court go to the appropriate court of appeals, and then ultimately, to the Supreme Court.<sup>76</sup>

### III. SECTION 2(A)

As previously discussed, cancellation proceedings may be brought at any time after a mark's registration on the Principal Register on the grounds that the mark violates a statutory bar listed in Section 2(a) of the Lanham Act. Section 2(a) precludes registration of "scandalous" or "disparag[ing]" marks.<sup>77</sup> Both the Harjo Litigation, and the most recent cancellation petition seeking cancellation of the Redskin(s) marks were brought pursuant to Section 2(a).<sup>78</sup> Thus, in order to fully understand the most recent decision, an analysis of Section 2(a) is necessary.

Section 2(a) reads in relevant part:

*No trademark . . . shall be refused registration on the principal register on account of its nature unless it . . . [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 or disrepute. . . .*<sup>79</sup>

Unfortunately, the legislative history of the Lanham Act does not offer much insight as to what constitutes what is "scandalous," "immoral," or when a mark may "disparage."<sup>80</sup> This lack of direction forced courts and the TTAB to determine on their own what constitutes "scandalous" or "disparaging," how scandalous or disparaging a mark must be to bar registration, and what evidence may be reviewed in conjunction with these inquiries.<sup>81</sup> Most decisions prior to the Harjo Litigation challenging marks under Section 2(a) involved accusations of scandalousness, and

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73. MCCARTHY, *supra* note 44, at § 21:20.

74. 15 U.S.C. § 1071(b)(3).

75. See *Swatch*, 739 F.3d at 155.

76. 28 U.S.C. § 1254 (2012).

77. 15 U.S.C. § 1052(a) (2012).

78. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999), *rev'd*, 284 F. Supp. 2d 96 (D.D.C. 2003), *remanded on alternative grounds*, 415 F.3d 44 (D.C. Cir. 2005), *on remand*, 567 F. Supp. 2d 46 (D.D.C. 2008), *aff'd on laches ground*, 565 F.3d 880 (D.C. Cir. 2009).

79. 15 U.S.C. § 1052(a).

80. See DAPHNE ZOGRAFOS, INTELLECTUAL PROPERTY AND TRADITIONAL CULTURAL EXPRESSIONS 86, 88 (2010); Jasmine Abdel-Khalik, *To Live in In-"Fame"-y: Reconceiving Scandalous Marks as Analogous to Famous Marks*, 25 CARDOZO ARTS & ENT. L.J. 173, 176–77 (2007).

81. See Abdel-Khalik, *supra* note 80, at 176–77.

not disparagement.<sup>82</sup> When courts eventually reviewed challenges alleging disparagement, these decisions were guided by jurisprudence interpreting “scandalous,” and thus, a brief look at these early challenges is helpful.

A. “Scandalous”

Early jurisprudence interpreting Section 2(a) focused mainly on challenges to marks accused of being “scandalous” or “immoral.” One of the first decisions examining whether a mark was “scandalous” or “immoral” and thus should be refused registration occurred in 1938.<sup>83</sup> The United States Court of Customs and Patent Appeals<sup>84</sup> determined that the mark “MADONNA” as a trademark for wine was “of very doubtful propriety” and “would be scandalous and its registration prohibited under said trade-mark act.”<sup>85</sup> In making its decision, the court reasoned that due to the lack of legislative history regarding the meaning of the word scandalous, it should be given its ordinary meaning, and the court therefore looked to dictionaries for such meaning.<sup>86</sup> The court further noted that the mark should also be viewed in the context of the type of goods offered under the mark.<sup>87</sup> During this time, “vulgar” or “sexual” marks were also denied registration for being “scandalous” within the meaning of Section 2(a).<sup>88</sup> These decisions established the general framework of looking to the common meaning and definition of the term to determine how scandalous a mark or term is, and then examining the term and

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82. See ZOGRAFOS, *supra* note 80, at 86, 88.

83. See, e.g., *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938). Although decided eight years before the passage of the Lanham Act, the reasoning is still followed today, as the court determined whether the mark was “scandalous” within the meaning of § 5(a) of the Trademark Act of 1905, a predecessor to the Lanham Act. See *id.* at 328.

84. This court no longer exists, as its judges and jurisdiction were transferred to the Federal Circuit in 1982. See *U.S. Court of Customs and Patent Appeals (Successor to the Court of Customs Appeals), 1910-1982*, FED. JUDICIAL CTR., [http://www.fjc.gov/history/home.nsf/page/courts\\_special\\_cpa.html](http://www.fjc.gov/history/home.nsf/page/courts_special_cpa.html) (last visited Feb. 20, 2015).

85. *In re Riverbank Canning Co.*, 95 F.2d at 329.

86. *Id.* at 328. The court also examined the dictionary meaning for the mark, “MADONNA.” *Id.*

87. *Id.* This was the first in a number of decisions denying registration of marks that used a religious name in conjunction with certain products if such products were prohibited by, or an affront to, said religion. See *In re Reemtsma Cigarettenfabriken G.M.B.H.*, 122 U.S.P.Q. (BNA) 339 (T.T.A.B. 1959) (refusing registration of the mark SENUSSI for cigarettes because Senussi is the name of a Muslim sect that forbids cigarettes); *In re P.J. Valckenberg, G.M.B.H.*, 122 U.S.P.Q. (BNA) 334 (T.T.A.B. 1959) (refusing registration of the mark MADONNA for wine, again); *In re Sociedade Agricola e. Comerical Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. 275 (T.T.A.B. 1968) (refusing registration of MESSIAS for wine because it was equivalent to Messiahs); *but see In re Waughtel*, 138 U.S.P.Q. (BNA) 594 (T.T.A.B. 1963) (allowing registration of AMISH for cigars after proof that Amish allowed cigar-smoking).

88. See generally *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (affirming the refusal of the registration of JACK-OFF as scandalous due to its vulgarity); *In re Fox*, 702 F.3d 633, 640 (Fed. Cir. 2012) (holding that the mark COCK SUCKER is vulgar). Decisions regarding what is and is not vulgar are quite inconsistent and unpredictable. For a discussion of these decisions, see Abdel-Khalik, *supra* note 80, at 205–09.

meaning within the context of the goods and services offered. Eventually, the Federal Circuit Court of Appeals established that “whether the mark consists of or comprises scandalous matter must be determined from the standpoint of a substantial composite of the general public (although not necessarily a majority), and in the context of contemporary attitudes . . . keeping in mind changes in social mores and sensitivities[.]”<sup>89</sup>

*B. Disparagement Jurisprudence*

Although within the same subsection of Section 2(a) as “scandalous” and “immoral,” disparagement represents an independent basis to challenge a registered mark.<sup>90</sup> In comparison to scandalous and vulgar marks, however, far fewer decisions have examined whether marks contain “matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute[.]”<sup>91</sup> In 1951, in one of the earliest cases addressing disparagement, the mark “DOUGH-BOY” was denied registration in connection with a prophylactic preparation.<sup>92</sup> The examiner found that the mark was disparaging in conjunction with prophylactics because “doughboys” was a nickname given to American soldiers in WWI and the packaging displayed a picture of an American soldier.<sup>93</sup> Notwithstanding this decision, few marks were challenged or reviewed for disparagement pursuant to Section 2(a).

Many years passed without meaningful analysis of disparagement until 1988, when the TTAB analyzed whether an applicant’s mark of a defecating dog disparaged the plaintiff Greyhound’s dog mark.<sup>94</sup> The TTAB adopted a two-part test to determine whether the applicant’s mark disparaged the existing greyhound mark:

*(1) [T]hat the communication reasonably would be understood as referring to the plaintiff; and (2) that the communication is disparaging, that is,*

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89. See *In re Boulevard Entm’t, Inc.*, 334 F.3d at 1340 (internal citations omitted).

90. MCCARTHY, *supra* note 44, at § 19:77.25.

91. 15 U.S.C. § 1052(a) (2012).

92. *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227 (P.T.O. 1951).

93. *Id.* at 227–28. This early case established the idea that the mark must be considered in connection with the goods identified with the mark in order to examine whether a mark is disparaging. See *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 125 (D.D.C. 2003), *remanded on alternative grounds*, 415 F.3d 44 (D.C. Cir. 2005), *on remand*, 567 F. Supp. 2d 46 (D.D.C. 2008), *aff’d on laches ground*, 565 F.3d 880 (D.C. Cir. 2009).

94. *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1988).

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*would be considered offensive or objectionable by a reasonable person of ordinary sensibilities.*<sup>95</sup>

After concluding that the public would recognize the applicant's design as referring to the plaintiff's design, the TTAB analyzed whether the defecating dog would be generally offensive to "a substantial portion of the public."<sup>96</sup> In its analysis, the TTAB simply looked at the proposed mark—a defecating dog—and reviewed essentially no other evidence.<sup>97</sup> The TTAB summarily stated that the sight of a dog defecating as used on the applicant's goods (t-shirts) would be offensive to a substantial portion of the general public.<sup>98</sup> Because the mark would be associated with the petitioner's mark, the TTAB concluded the mark disparaged the petitioner's mark and denied registration.<sup>99</sup>

The *Greyhound* decision did little to clarify what constitutes evidence that a mark disparaged a *group of people* for the purposes of Section 2(a). However, in *In re In Over Our Heads, Inc.*,<sup>100</sup> the TTAB reviewed a mark to determine whether it disparaged a group of people.<sup>101</sup> The applicant sought registration of the mark MOONIES, with the two "o"s in the mark designed to resemble naked buttocks to be used in conjunction with dolls.<sup>102</sup> The examiner refused registration on the basis that "moonies" used in this manner disparaged members of the Unification Church.<sup>103</sup> On appeal, the TTAB referred to dictionary definitions of "moonie(s)" to determine the meaning of the word, and found references in the dictionary to both church members and exposing one's buttocks.<sup>104</sup> Since the mark was used in conjunction with dolls that dropped their pants, however, the TTAB concluded that the public would perceive MOONIES as referring to the act of dropping one's pants, and not to members of the Unification Church.<sup>105</sup> Importantly, the Unification Church was not opposing registration.<sup>106</sup> Finally, the TTAB stated that:

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95. *Id.* at 1639 (citing the RESTATEMENT (SECOND) OF TORTS § 629 (1977)). Some commentators have criticized the TTAB's use of the Restatement test because the Restatement was written thirty years after the Lanham Act was passed and is inconsistent with the TTAB's prior decisions. See Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPP. L. REV. 7, 30 (1994).

96. *Greyhound*, 6 U.S.P.Q.2d (BNA) at 1639.

97. *Id.*

98. *Id.* at 1640.

99. *Id.* at 1642.

100. 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990).

101. *Id.* at 1654–55.

102. *Id.* at 1653–54.

103. *Id.* at 1654–55. The Unification Church was founded by Sun Myung Moon and its members are sometimes referred to as "moonies." *Id.*

104. *Id.*

105. *Id.*

106. *Id.*

*Because the guidelines are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established.*<sup>107</sup>

Thus, the TTAB reversed the examiner and allowed registration of the mark.<sup>108</sup>

### C. The Harjo Litigation

In 1992, seven Native Americans filed a cancellation petition with the TTAB, arguing that six trademarks<sup>109</sup> containing the term “redskin(s)” and owned by Pro-Football, Inc. (“Pro-Football”) violated the Lanham Act’s prohibition of marks that disparaged persons or brought them into contempt or disrepute.<sup>110</sup> The petition represented the first opportunity for the TTAB to determine whether a mark disparaged a racial or ethnic group.<sup>111</sup> Importantly, the TTAB made a number of evidentiary rulings on the specific evidence that could be considered in a Section 2(a) disparagement claim.<sup>112</sup> Specifically, the TTAB dismissed Pro-Football’s objections that certain evidence was outside the relevant time period, admitted the evidence, and held that the evidence shed light on whether the term was disparaging and that the timeliness and any other flaws simply went to the probative value of the evidence.<sup>113</sup>

The TTAB also clarified that whether the marks at issue are disparaging is based on the disparaging nature of the marks when the respective registrations were issued, and not whether the marks are considered disparaging in present society.<sup>114</sup> Furthermore, the TTAB stated that “scandalous” and “disparage” as used in Section 2(a) represented different statutory bars, holding that “scandalous” looked to

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107. *Id.* at 1654–55.

108. *Id.* at 1655.

109. REDSKINETTES, Registration No. 1,606,810 (July 17, 1990); REDSKINS, Registration No. 1,085,092 (Feb. 7, 1978); THE REDSKINS & DESIGN, Registration No. 987,127 (June 25, 1974); WASHINGTON REDSKINS & DESIGN, Registration No. 986,668 (June 18, 1974); WASHINGTON REDSKINS, Registration No. 978,824 (Feb. 12, 1974); THE REDSKINS (stylized), Registration No. 836,122 (Sept. 29, 1967).

110. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999), *rev’d*, 284 F. Supp. 2d 96 (D.D.C. 2003), *remanded on alternative grounds*, 415 F.3d 44 (D.C. Cir. 2005), *on remand*, 567 F. Supp. 2d 46 (D.D.C. 2008), *aff’d on laches ground*, 565 F.3d 880 (D.C. Cir. 2009).

111. MCCARTHY, *supra* note 44, at § 19:77.25.

112. *See Harjo*, 50 U.S.P.Q.2d (BNA) at 1716–18 (allowing survey and expert testimony evidence, among other evidence, to be considered).

113. *Id.* at 1717.

114. *Id.* at 1734–35.

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society as a whole,<sup>115</sup> while “disparage” looked only to the beliefs of the identifiable group.<sup>116</sup> In doing so, the TTAB declared that the opinions of those individuals in the identifiable group are the only relevant points of view as to whether the term was disparaging.<sup>117</sup> Thus, the TTAB developed the two-part test that became the standard for whether a mark should be barred for being disparaging:<sup>118</sup>

- (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods and services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
- (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.<sup>119</sup>

After examining evidence of the term *redskin(s)* in connection with the Washington Redskins football team, the TTAB concluded that the term referred to both the football team and “carrie[d] the allusion to Native Americans inherent in the original definition of that word.”<sup>120</sup> The TTAB then examined whether the term disparaged Native Americans. The TTAB concluded that based on the entire record, the petitioners established, by a preponderance of the evidence, that *redskin(s)*, as used in Pro-Football’s marks in connection with its goods and services, disparaged Native Americans as perceived by a “substantial composite” of Native Americans.<sup>121</sup>

Subsequently, Pro-Football brought a civil action in the federal district court for the District of Columbia, seeking a *de novo* review pursuant to 15 U.S.C. §

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115. The TTAB concluded that the registrations were not “scandalous.” *Id.* at 1748–49. “Scandalous” refers to the perception by the general public, while “disparag[ing]” refers to the specific group. *Id.* Thus, the TTAB concluded that the general acceptance by the general public of the continued use of *redskin(s)* in association with the football team for decades demonstrated that the requisite amount of the general public did not find the term “scandalous.” *Id.*

116. *Id.* at 1737.

117. *Id.* at 1740–41 (“[I]t is only logical that, in deciding whether the matter may be disparaging, we look, not to American society as a whole . . . but to the views of the referenced group.”).

118. *Id.* See also *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264 (T.T.A.B. 2006); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008); *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215 (T.T.A.B. 2010).

119. *Harjo*, 50 U.S.P.Q.2d (BNA) at 1740–41.

120. *Id.* at 1742.

121. *Id.* at 1747.

1071(b).<sup>122</sup> Although labeled a “*de novo* review,”<sup>123</sup> the district court concluded that the TTAB’s findings in a cancellation proceeding may only be overturned if the party seeking reversal proves the TTAB’s decision is “unsupported by substantial evidence.”<sup>124</sup> Additionally, whether a mark is disparaging to the referenced group is a question of fact, not law.<sup>125</sup> Thus, the burden of proving that the TTAB’s findings are unsupported by substantial evidence is borne by the party challenging the findings.<sup>126</sup> Ultimately, the court held that the appellate court must review the “TTAB’s application of the legal principles to [the TTAB’s] findings of fact and [the TTAB’s] determination that these findings demonstrate by a preponderance of the evidence that the trademarks at issue may disparage Native Americans.”<sup>127</sup>

First, the court determined that the TTAB correctly held that Harjo/Petitioner needed to demonstrate by a preponderance of evidence that the challenged marks disparaged Native Americans.<sup>128</sup> Next, the court upheld the two-part test crafted by the TTAB to determine whether a mark is disparaging, including limiting the relevant perceptions to only those people who are part of the identifiable group.<sup>129</sup> The court also agreed with the TTAB that the “question of disparagement must be considered in relation to the goods or services identified by the mark in the context of the marketplace.”<sup>130</sup> Finally, the court agreed with the TTAB that both parts of the test are to be answered as of the dates the marks were registered.<sup>131</sup> Although the court reversed the TTAB’s decision on laches grounds,<sup>132</sup> the court undertook a

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122. *Pro-Football, Inc., v. Harjo*, 284 F. Supp. 2d 96, 100 (D.D.C. 2003). When the appeal was brought, the default federal district court under § 1071(b) was the District of Columbia. *Id.* As noted previously, the Eastern District of Virginia is now the default federal district court. *See supra* note 71 and accompanying text.

123. The review is “*de novo*” only insofar as new evidence may be introduced, but unlike a true *de novo* proceeding, the TTAB’s findings of facts are given great weight. *Pro-Football*, 284 F. Supp. 2d at 115 n.18.

124. *Id.* at 114 (citing the standard of review set forth in the Administrative Procedure Act, 5 U.S.C. § 706). *See also Dickinson v. Zurko*, 527 U.S. 150, 151 (1999); *Mazzari v. Rogan*, 323 F.3d 1000, 1005 (Fed. Cir. 2003). Harjo advocated that the court adopt a “clearly erroneous” standard of review. *Pro-Football*, 284 F. Supp. 2d at 114.

125. *Pro-Football*, 284 F. Supp. 2d at 117. The court reiterated, however, that the court reviews *de novo* the question of whether the legal standard applied by the TTAB is the appropriate standard. *Id.* at 118 (“[The TTAB’s] findings of fact . . . are reviewed under the substantial evidence test. The Court then turns its attention to the legal principles adopted by the TTAB to help it resolve this case. The court reviews the TTAB’s legal principles *de novo*.”).

126. *Id.* at 117–18 (citing *Trans Union Corp. v. F.T.C.*, 245 F.3d 809, 814–15 (D.C. Cir. 2001)).

127. *Id.* at 118.

128. *Id.* at 122. *Pro-Football* had argued that the “clear and convincing evidence” standard should be applied. *Id.*

129. *Id.* at 124–25.

130. *Id.* at 125.

131. *Id.*

132. *Id.* at 139. Laches is not an issue in the current litigation and will not be discussed in any detail.

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detailed analysis of the evidence, and its analysis needs to be discussed as it greatly informs the current litigation.

Despite affirming the TTAB's test for disparagement, the court ultimately concluded that the TTAB's holding that the marks disparaged Native Americans was unsupported by substantial evidence.<sup>133</sup> The court held that the TTAB's determination of the first question of the test, (namely, that for the relevant time period the meaning of the term *redskin(s)* was a Native American person, even as used in connection with the goods and services) was supported by substantial evidence.<sup>134</sup>

However, with regards to the second question of the test, the court concluded that "the TTAB's conclusion that the six trademarks may disparage Native Americans is not supported by substantial evidence."<sup>135</sup> The court began by stating that the TTAB's decision "is logically flawed, and fails to apply the correct legal standard to its own findings of fact."<sup>136</sup> The court noted that none of the linguistic evidence directly proved that the marks were disparaging when used in connection with the football club at the relevant times.<sup>137</sup> The court also found that the Ross Survey evidence relied on by the TTAB was not relevant evidence because it was taken in 1996, included people that were not even born in 1967, and thus revealed nothing about the attitudes of Native Americans during the relevant time period.<sup>138</sup> Furthermore, the Ross Survey did not ask about the use of the term *redskin(s)* in connection with the football team.<sup>139</sup>

Outside the Ross Survey evidence, which according to the court was not relevant, only the testimony of the seven Native Americans who brought suit was introduced as evidence, and the court concluded that these seven could not possibly constitute a substantial composite of Native Americans.<sup>140</sup> The dictionary evidence the TTAB relied upon to conclude that the term *redskin* was disparaging was also unsupported by substantial evidence, according to the court.<sup>141</sup> The court also

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133. *Id.* at 125–26. (“[T]he TTAB’s finding that the marks at issue ‘may disparage’ Native Americans is unsupported by substantial evidence, is logically flawed, and fails to apply the correct legal standard to its own findings of fact.”).

134. *Id.* at 126. The court agreed with the TTAB that Pro-Football’s trademarks, even though used in connection with a football team, consistently used Native American imagery and thus “*redskin(s)*” had not lost its meaning as a reference to Native Americans. *Id.* at 127.

135. *Id.*

136. *Id.* at 126.

137. *Id.* at 127.

138. *Id.* at 132–33.

139. *Id.* at 132.

140. *Id.* at 129.

141. *Id.* at 130–31 (noting that half of the dictionaries submitted listed *redskin* as derogatory or offensive but this was not relevant evidence, as it merely demonstrated what the general population may think, and not the relevant group, Native Americans).

dismissed the newspaper articles and resolutions from the relevant time periods from Native American individuals and groups protesting the use of the name, because this evidence, on its own, did not necessarily reflect the views of a substantial composite of Native Americans.<sup>142</sup> In essence, the court determined that nearly every piece of evidence that the TTAB had relied upon was not relevant, either because it was not from the relevant time period, or because it reflected the view of the general public, and not the relevant group. As a result, the court concluded that the TTAB's conclusion that the marks were disparaging to Native American was unsupported by substantial evidence.<sup>143</sup>

Harjo appealed the district court's decision to the Court of Appeals for the District of Columbia.<sup>144</sup> In a per curiam opinion that addressed only the narrow laches issue, the court of appeals reversed the district court's holding that the cancellation proceeding was barred by laches and remanded the proceeding to the district court for the narrow purpose of evaluating whether laches barred one party's claim.<sup>145</sup> The Court of Appeals did not address or disturb the district court's findings concerning the disparagement. On remand, the district court reviewed laches as to one party's claim and concluded that laches indeed barred his claim.<sup>146</sup> On appeal, the Court of Appeals affirmed the district court's decision.<sup>147</sup>

#### D. Blackhorse v. Pro-Football, Inc.

While the Harjo Litigation was ongoing, five Native Americans filed a cancellation petition (the "Blackhorse Litigation") seeking cancellation of the same six trademarks containing the term *redskin(s)* on the grounds that the marks were disparaging to Native Americans and thus barred from registration.<sup>148</sup> The cancellation petition was stayed pending resolution of the Harjo Litigation, but when the Harjo Litigation was resolved on laches grounds, the ultimate issue of whether the marks were barred from registration under Section 2(a) of the Lanham Act remained unresolved, and the cancellation proceedings continued.<sup>149</sup> The Blackhorse Litigation culminated in the TTAB's cancellation of all six marks on the

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142. *Id.* at 135–36.

143. *Id.* at 136.

144. *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005), *on remand*, 567 F. Supp. 2d 46 (D.D.C. 2008), *aff'd on laches ground*, 565 F.3d 880 (D.C. Cir. 2009).

145. *Id.* at 50.

146. *Pro-Football, Inc., v. Harjo*, 567 F. Supp. 2d 46, 62 (D.D.C. 2008), *aff'd on laches ground*, 565 F.3d 880 (D.C. Cir. 2009).

147. *Pro-Football, Inc. v. Harjo*, 565 F.3d 880, 881 (D.C. Cir. 2009).

148. *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080, 2014 WL 2757516 (T.T.A.B June 18, 2014).

149. *See id.* at \*6 ("Thus, the D.C. Circuit resolved the case solely on the issue of laches, never addressing the Board's finding of disparagement on the merits.").

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grounds that the term *redskin(s)*, as used in connection with the goods and services offered under the marks, is disparaging to Native Americans.<sup>150</sup>

In 2011, both parties stipulated that the entire record of the Harjo Litigation may be submitted into evidence,<sup>151</sup> provided however, that the parties did not stipulate that any particular evidence from the Harjo Litigation was relevant to the Blackhorse Litigation,<sup>152</sup> and therefore both parties could object to any evidence introduced from the Harjo Litigation on that basis.<sup>153</sup>

First, the TTAB adopted the two-part test laid out in the Harjo Litigation to determine disparagement:

(a) *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 registrations?*

(b) *Is the meaning of the marks one that may disparage Native Americans?*<sup>154</sup>

Again, the TTAB stressed that these questions are to be resolved according to the views existing at the time of the respective registration dates, and only with respect to the views of the referenced group, Native Americans.<sup>155</sup> Finally, the TTAB reiterated that a “substantial composite” of the referenced group must find the mark as used disparaging.<sup>156</sup>

The TTAB began by noting that its decision did not rely on the Ross Survey, a key piece of evidence in the Harjo Litigation deemed irrelevant by the district court.<sup>157</sup> Like the previous TTAB and the district court in the Harjo Litigation, the TTAB held that the evidence overwhelmingly supported the determination that *redskin(s)*, as used in the marks at issue, retains the meaning Native American.<sup>158</sup> In coming to this conclusion, the TTAB reviewed evidence from the relevant time periods, showing Native American imagery used by Pro-Football to promote the Redskins football team.<sup>159</sup> The TTAB concluded that *redskin(s)* used in connection

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150. *Id.* at \*72.

151. *Id.* at \*3. The only exception was the deposition testimony of the petitioners in the Harjo Litigation. *Id.* at \*5.

152. This was an important stipulation, as the TTAB rejected Pro-Football’s hearsay and other objections to certain evidence without examination, citing this stipulation as the basis. *See id.* at \*17.

153. *Id.*

154. *Id.* at \*4 (citing Pro-Football v. Harjo, 284 F. Supp. 2d 96, 125–26 (D.D.C. 2003)).

155. *Id.* at \*9.

156. *Id.* at \*10.

157. *Id.* at \*5.

158. *Id.* at \*9.

159. *Id.* at \*8. The TTAB also cited the district court’s identical conclusion on this point. *Id.*

with the football team retained its “core meaning’ identifying a ‘race of people[.]’”<sup>160</sup>

The TTAB then turned to the second prong of the test: whether the term *redskin(s)* was disparaging to a substantial composite of Native Americans in the context of the goods and services.<sup>161</sup> The TTAB clarified that a substantial composite does not necessarily mean the majority.<sup>162</sup> In terms of the good and services, the TTAB elucidated that the context of the goods and services may do one of three things.<sup>163</sup> First, the context may turn a non-disparaging term into a disparaging one.<sup>164</sup> Second, the context may turn a potentially disparaging term into a non-disparaging term.<sup>165</sup> And third, the context may have no effect on a term’s disparaging meaning.<sup>166</sup>

Both parties conceded that the term *redskin(s)* means Native American even when used in conjunction with the football team.<sup>167</sup> Thus, the TTAB determined that *redskins* fell into category three, i.e., that the

*alleged honorable intent and manner of use of the term do not contribute to the determination of whether a substantial composite of the referenced group found REDSKINS to be a disparaging term in the context of [Pro-Football’s] services during the time period 1967–1990, because the services have not removed the Native American meaning from the term and intent does not affect the second prong.*<sup>168</sup>

Thus, the only question was whether *redskin(s)* was disparaging at the time of the respective registrations.<sup>169</sup>

The TTAB grouped the petitioners’ evidence into two categories: (1) general

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160. *Id.* at \*11 n.50.

161. *Id.* at \*9.

162. *Id.* at \*5 (citing *In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071, 1074 (T.T.A.B. 2008); *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 1279 n.12 (T.T.A.B. 2006); *Ritchie v. Simpson*, 179 F.3d 1091, 50 U.S.P.Q.2d 1023, 1024 (Fed. Cir. 1999)).

163. *Id.* at \*9.

164. *Id.* (citing *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1223 (T.T.A.B. 2010) (holding that the term *KHORAN*, while not otherwise disparaging, disparages religion and beliefs of Muslim Americans when used for wine)).

165. *Id.* (citing *In re Squaw Valley*, 80 U.S.P.Q.2d at 1267 (holding that *SQUAW* in relation to ski equipment means only the geographic location and did not mean Native American women)).

166. *Id.* (citing *In re Heeb*, 89 U.S.P.Q.2d at 1077 (finding that the term *HEEB* in the context of goods and services is disparaging, regardless of the applicant’s good intent and inoffensive goods)).

167. *Id.* at \*9.

168. *Id.* at \*10.

169. *Id.*

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analysis of the term *redskin(s)*; and (2) specific views of the referenced group.<sup>170</sup> The TTAB focused particularly on expert testimony, dictionary definitions, and reference books in the first category.<sup>171</sup> The TTAB placed emphasis on the decreased media usage of the term, and the corresponding increase in labels such as “offensive” or “derogatory” added to the dictionaries’ definitions of *redskin(s)* throughout the relevant time period.<sup>172</sup>

In the second category, the petitioners’ main piece of evidence was the NCAI Resolution (“the Resolution”).<sup>173</sup> Pro-Football argued that the Resolution was irrelevant because it was not passed during the pertinent time period.<sup>174</sup> The TTAB rejected this argument, finding that the “mere fact that an opinion is voiced in 1993 does not mean the opinion was not held by that group or individual in the 1967–1990 time period.”<sup>175</sup> The TTAB placed great weight on the NCAI Resolution and stated that the Resolution “*throughout the relevant time period* represented approximately thirty percent of Native Americans[.]”<sup>176</sup> If individual testimony about past-held views is acceptable, the TTAB continued, then group statements about past-held views are also relevant.<sup>177</sup> The TTAB then addressed the letters written by various chiefs and Native American communities that disagreed that the term *redskin(s)* was offensive in connection with the football team, although the TTAB spent considerably less time noting this evidence.<sup>178</sup>

After discussing the relevant evidence, the TTAB made thirty-nine separate findings of fact.<sup>179</sup> Initially, the TTAB found that the word *redskin(s)* is and always has been a racial designation that refers to the skin color of Native Americans.<sup>180</sup> The TTAB also noted that before 1966, dictionaries included no usage label for the *redskin(s)* entry, but beginning in 1966, and continuing through 1990, dictionaries began including usage labels that the term was offensive and disparaging.<sup>181</sup> The remaining findings of fact concluded that the NCAI represented the views of a great number of Native American tribes, and that their respective members and the

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170. *Id.*

171. *Id.*

172. *Id.* at \*11–16.

173. *Id.* at \*17. The court also considered depositions, newspaper articles, reports, official records, and letters in the second category. *Id.* at \*18–25.

174. *Id.* at \*18.

175. *Id.*

176. *Id.* (emphasis added).

177. *Id.* The TTAB also cited excerpts from letters and newspapers from the relevant time period to support its conclusion that the representation numbers were accurate. *Id.* at \*18 n.117.

178. *Id.* at \*22–23.

179. *Id.* at \*25–28. This was likely in response to the district court’s criticism in the Harjo Litigation that the TTAB had made few findings of fact.

180. *Id.* at \*25.

181. *Id.* at \*26.

NCAI had been opposed to the name of the team during the respective time period.<sup>182</sup> Focusing on the NCAI Resolution, the TTAB found that “*at a minimum* approximately thirty percent of Native Americans found the term [redskin(s)] used in connection with [Pro-Football’s] services to be disparaging” in the relevant time period, and furthermore, that thirty percent is “without a doubt a substantial composite.”<sup>183</sup> It also noted that the existence of Native Americans who hold an opposing view does not change the conclusion that a substantial composite find the term disparaging and thus, in a 2-1 vote, the TTAB concluded that the trademarks should be cancelled.<sup>184</sup>

#### IV. LIKELIHOOD OF REVERSAL IN THE CURRENT ACTION<sup>185</sup>

Soon after the TTAB issued its decision, Pro-Football filed suit in the federal District Court for the Eastern District of Virginia seeking to have the decision overturned.<sup>186</sup> The narrow legal question determined by the TTAB was whether the evidence establishes that the term “redskin(s)” was disparaging to a substantial composite of Native Americans, in connection with football-related services, at the time each of the challenged registrations were issued. As discussed above, the six registrations were issued between 1967 and 1990. Thus, the Blackhorse petitioners needed to demonstrate, by a preponderance of the evidence, that a substantial composite of Native Americans found the marks disparaging in 1967, 1974, 1978, and 1990.<sup>187</sup> The question in this action will likely be whether the TTAB’s decision to cancel the trademarks is unsupported by substantial evidence, otherwise known as the substantial evidence test.<sup>188</sup>

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182. See *id.* at \*26–28.

183. *Id.* at \*29.

184. *Id.* Judge Bergsman wrote a dissent, in which he noted that the record was essentially the same as the record when the district court reversed the cancellation in the original *Harjo* decision. *Id.* at \*35 (Bergsman, J., dissenting). The views in the dissent will be more thoroughly presented in Section IV. See *infra* Part IV.

185. As of this writing, some preliminary motions have been filed. Blackhorse filed a motion to dismiss for failure to state a claim, alleging that Pro-Football sued the wrong party. Defs’ Mot. to Dismiss, Sept. 22, 2014, ECF 18. Although a novel argument, this motion was dismissed by the judge in its entirety. Order on Mot. to Dismiss, Nov. 25, 2014, ECF 40.

186. As previously noted, any party disagreeing with the TTAB’s decision may appeal to the Federal Circuit, or conversely, may file a suit in the relevant federal district court. See *supra* notes 67–75 and accompanying text. This makes strategic sense for Pro-Football, as the district court review allows the introduction of new evidence. Although reviewed *de novo*, the district court may only overturn the TTAB’s decision if it is unsupported by substantial evidence. Granted, the district court could also determine that the TTAB’s legal framework was incorrect, but this is highly unlikely as the two-prong test used by the TTAB has been adopted by the Federal Circuit.

187. See *Blackhorse v. Pro-Football*, 111 U.S.P.Q.2d (BNA) 1080, 2014 WL 2757516, at \*29 (T.T.A.B. June 18, 2014).

188. Pro-Football’s complaint also raises a number of other issues, but for the purposes of this Article, only the main issue, whether the marks are disparaging, shall be addressed. Pro-Football also argues that the

The petitioners made the strategic decision to submit the entire Harjo evidentiary record, and augmented this record with some additional deposition testimony along with evidence the dissent regarded, “charitably,” as “a database dump.”<sup>189</sup> In the Harjo Litigation, the D.C. Circuit reviewed nearly identical evidence, and determined that the evidence was insufficient to support the claim of disparagement.<sup>190</sup> Even though this district court opinion is not precedential, it is persuasive, and will likely be considered by the Eastern District of Virginia. Additionally, because the evidence is nearly identical, the Eastern District of Virginia could very well come to the same conclusion, unless petitioners produce new evidence not submitted to the TTAB below.

An examination of the major pieces of evidence relied on by the petitioners in the Blackhorse Litigation, the original district court’s opinion, and the dissenting opinion of Judge Bergsman reveals that the Blackhorse petitioners may not have proven by a preponderance of evidence that the Redskins’ marks are disparaging and therefore, the TTAB decision to cancel the marks is unsupported by substantial evidence.<sup>191</sup> As such, and similar to the initial Harjo Litigation, the TTAB’s decision to cancel the marks will likely be reversed, especially if the Blackhorse petitioners do not submit additional evidence, and the Eastern District is persuaded by the reasoning used in the original D.C. Circuit decision.

#### *A. The Dictionary Evidence Offered is Inconclusive*

Petitioners submitted several dictionary definitions to support the proposition that the term *redskin(s)* was a disparaging term for Native Americans.<sup>192</sup> The TTAB concluded that the usage labels attached by these dictionaries demonstrated that the term *redskin(s)* was “offensive, disparaging, contemptuous or not preferred.”<sup>193</sup>

The majority’s reliance on the dictionary evidence is problematic for a number of reasons. For one, dictionaries show the viewpoint of dictionary editors and perhaps society as a whole, but not Native Americans, the relevant group.<sup>194</sup>

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“substantial evidence” standard is not applicable as it is a *de novo* review. See Pl.’s Compl. 16, Aug. 8, 2014, ECF No. 1. However, as discussed previously in this Article, although it is called a *de novo* review, that name is a bit of a misnomer. The law applied by the TTAB will be reviewed *de novo*, while the TTAB’s findings of fact will be reviewed under the substantial evidence test.

189. *Blackhorse*, 111 U.S.P.Q.2d (BNA), 2014 WL 2757516, at \*36 (Bergsman, J., dissenting).

190. See *Harjo v. Pro-Football, Inc.*, 284 F. Supp. 2d 96, 136 (D.D.C. 2003).

191. See *infra* Part IV.A–D.

192. *Blackhorse*, 111 U.S.P.Q.2d (BNA), 2014 WL 2757516, at \*12 (majority opinion).

193. *Id.* at \*27.

194. See, e.g., *id.* at \*12 (noting that Mr. Barnhart, an expert lexicographer, testified that usage labels are a “[r]eflection of the opinion of the editor in chief”); *The OED and Oxford Dictionaries*, OXFORD ENGLISH DICTIONARY, <http://public.oed.com/about/the-oed-and-oxford-dictionaries/> (last visited Jan. 16, 2015) (explaining that the dictionary content in Oxford Dictionaries focuses on current English and includes modern meanings and uses of words).

Additionally, some of the definitions provided were from outside of the relevant time frame of the dates of registration of the marks.<sup>195</sup> As Pro-Football's expert argued, the restrictive usage labels within the dictionary definitions leave open the interpretation of the term *redskin(s)*, and do not conclusively establish its interpretation.<sup>196</sup> Thus, the weight the TTAB majority places upon the dictionary evidence is too great and fails to show that the term *redskin(s)* was disparaging to Native Americans in the context of football related services.

Prior to 1965, the TTAB noted, there was no evidence of restrictive usage labels for the term *redskin* in dictionaries.<sup>197</sup> The TTAB stated that there was a clear trend toward employing the terms "offensive" and "disparaging" in dictionary usage labels after 1966.<sup>198</sup> The record evidence, however, demonstrated that only two dictionaries before 1980 showed such labels.<sup>199</sup> At the time THE REDSKINS (stylized) mark was registered in 1967, there was only one dictionary with a usage label stating that the word *redskin* was "often offensive."<sup>200</sup> The dictionary definitions offered after 1980 were from 1980, 1987, and 1989, arguably not during the relevant time period for five of the registered marks.<sup>201</sup> The dictionary definitions cited used the restrictive label "often offensive" or "often disparaging and offensive."<sup>202</sup> The key word is "often." "Often" implies that there are circumstances in which *redskin(s)* is not offensive.<sup>203</sup> Since it is not "always" offensive, it can be argued that *redskin(s)* as used in connection with football related activities, is not offensive or disparaging. Additionally, the linguistic experts did not specifically research the Native American viewpoint of the word *redskin* in connection with football-related services during any time period.<sup>204</sup>

Further, linguistic experts testified that the adoption of usage labels by dictionary editors is a reflection of the opinion of the editor-in-chief, but some editors are influenced by non-editorial sources.<sup>205</sup> Sociopolitical groups, such as sociologists, historians, and anthropologists, can influence editors to adopt a usage label.<sup>206</sup> However, presumably the experts themselves are not all Native American, nor are

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195. See *Blackhorse*, 111 U.S.P.Q.2d (BNA), 2014 WL 2757516, at \*12.

196. *Id.* at \*13.

197. *Id.* at \*12.

198. See *id.* The TTAB determined that there was no difference between "offensive" and "disparaging" for the purpose of analyzing dictionary definitions. *Id.* at \*13.

199. See *id.* at \*12.

200. *Id.* at \*38 (Bergsman, J., dissenting).

201. *Id.* at \*12 (majority opinion). Five of the marks were registered from 1967–1978. *Id.*

202. *Id.*

203. *Id.* at \*38 (Bergsman, J., dissenting). "Often" means "many times" or "frequently," but not always. See MERRIAM-WEBSTER'S COLLEGIATE DICTIONARY 862 (11th ed. 2004).

204. *Blackhorse*, 111 U.S.P.Q.2d (BNA), 2014 WL 2757516, at \*10 n.49 (majority opinion).

205. *Id.* at \*12, \*26 n.184.

206. See *id.* at \*13.

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the dictionary editors and publishers, or the sociologists, historians, or anthropologists, as pointed out by Judge Bergsman in his dissent.<sup>207</sup> Therefore, the usage labels reflect the perception of dictionary editors and publishers and society as a whole, not Native Americans, the only group whose opinion is relevant.

As stated in the dissent, the evidence does not support the finding of fact No. 7, that “beginning in 1966 and continuing to 1990, usage labels in dictionaries indicating the term REDSKINS to be offensive, disparaging, contemptuous or not preferred appear and grow in number” as applied to the marks registered from 1967–1978.<sup>208</sup>

*B. The NCAI Resolution is Outside the Relevant Time Frame and is not Evidence of the Opinion of a Substantial Composite of Native Americans*

As addressed in the Eastern District of Virginia complaint and the TTAB dissent, the NCAI Resolution, which purports to provide the view of Native Americans held at the relevant time period, is not supported by reliable evidence as to the number of Native Americans who attended the meeting or that were members of the organization during the relevant time frame.<sup>209</sup> In the Harjo Litigation, the district court disregarded the same evidence for the same problems noting: “All of these resolutions were made after the relevant time frame, with no explanation by the TTAB as to how they ‘shed light’ on the relevant time period, and thus, are irrelevant to the calculus.”<sup>210</sup>

The NCAI Resolution was passed in 1993; three years outside of the relevant time frame for the most recently registered mark at issue.<sup>211</sup> The TTAB determined that the NCAI Resolution was probative of the view Native Americans held during the relevant time period because the NCAI represented approximately 30% of Native Americans.<sup>212</sup> The TTAB also placed great emphasis on the Resolution language, which stated that it represented the “past and ongoing viewpoint of the Native Americans it represents[.]”<sup>213</sup> However, there is no evidence in the record of the number of Native Americans or tribes that attended the meeting or any membership information for the necessary time period.<sup>214</sup> The phrase “past and ongoing viewpoint[s]” is broad and undefined. Without determining how far into

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207. See *id.* at \*36 (Bergsman, J., dissenting).

208. *Id.* at \*39.

209. *Id.* at \*40.

210. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 135 (D.D.C. 2003) *aff'd on other grounds*, 565 F.3d 880 (D.C. Cir. 2009).

211. See *Blackhorse*, 111 U.S.P.Q.2d (BNA), 2014 WL 2757516, at \*17 (majority opinion).

212. *Id.* at \*18.

213. *Id.*

214. *Id.* at \*40 (Bergsman, J., dissenting). The evidence from newspaper stories is also not very compelling since it is double hearsay. See *id.* at \*6 n.21 (majority opinion).

the past the opinions go, it is difficult to apply the evidence to ascertain the opinion of Native Americans during 1974, 1976, 1978, and 1990.

Just as importantly, the TTAB determined that the 1993 resolution represented the views of 30% of the Native American population.<sup>215</sup> This is a broad leap from the facts of record. The TTAB concluded from scant evidence that the NCAI member tribes comprised 30% of the Native American population in 1993.<sup>216</sup> The TTAB dismissed evidence that NCAI resolutions may come to a vote with only a quorum present.<sup>217</sup> Per NCAI rules, only one-third of tribes, through their appointed representative, need to be present to establish a quorum, and then only a majority vote of the one-third in attendance is required to pass a resolution.<sup>218</sup> There is no evidence in the record of which tribes were present or how many tribes voted.

Examining this issue closer, the petitioners submitted evidence that the NCAI represented 150 tribes, representing thirty percent of the total Native American population, when the Resolution passed.<sup>219</sup> Thus, at a *maximum*, if all 150 tribes were present when the Resolution passed, and all 150 tribes voted yes, then the Resolution may have represented thirty percent of the Native American population. The TTAB summarily accepts that this statistically improbable maximum number is the correct number.<sup>220</sup> In contrast, due to the NCAI quorum rules, at a minimum, the Resolution could have been passed if a majority of one-third of the member tribes were present and voted yes, or 26 tribes.<sup>221</sup> Furthermore, only a single representative of the tribe is required to vote for the entire tribe.<sup>222</sup> Depending on the respective populations of the tribes present and voting yes, this vote could actually represent a very small percentage of Native Americans.

Testimony offered to support the NCAI Resolution also falls short. JoAnn Chase, the Executive Director of the NCAI, testified about the NCAI Resolution, but she did not become the Executive Director until 1994.<sup>223</sup> She testified that she was not at the meeting when the Resolution was passed, she was not aware of any meeting minutes, she was not aware of whether a quorum was present for voting, and had no record of the people in attendance.<sup>224</sup> Additionally, she did not know what the membership of the organization was at the time of the NCAI Resolution and could

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215. *Id.* at \*18.

216. *Id.*

217. *Id.* at \*40 (Bergsman, J., dissenting).

218. *Id.* at \*26–27 (majority opinion).

219. *Id.* at \*17.

220. *See id.* at \*26–27 (accepting Chase’s testimony and therefore accepting the calculations).

221. *See id.* at \*26.

222. *Id.*

223. *Id.* (“Since 1994, Jo Ann Chase has been the Executive Director of the NCAI.”).

224. *Id.* at \*40 (Bergsman, J., dissenting).

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not identify the number of tribe members.<sup>225</sup> Even though Chase could not identify membership numbers, the TTAB found, from her testimony, that “there were between 100–400 members at the time the resolution was taken.”<sup>226</sup>

To support the Board’s findings that “approximately 150 tribes were members [of the NCAI] in 1993” and that “[t]he NCAI members throughout the time period represent approximately 30 percent of Native Americans,”<sup>227</sup> evidence was offered that again, is unsubstantiated. For example, a letter in 1991 from Dale Pullen, publisher of the U.S. Congress Handbook, to Charlie Drayton, the VP of Communications for the Washington Redskins football team, states that, “[t]he National Congress of American Indians represent [sic] Indians living on reservations (the remaining 30 percent).”<sup>228</sup> Since this evidence is not coming directly from the NCAI, it is difficult to prove its accuracy. The majority also relies on a statement made by Dr. Britton Harwood from minutes of the Miami University Senate that the NCAI represented approximately 150 tribal governments.<sup>229</sup> However, the minutes are not supported by evidence that identifies Dr. Harwood, how he is knowledgeable about the membership of the NCAI, or the source used to quantify the membership. Without this information, the minutes merely are probative of his beliefs.<sup>230</sup>

The TTAB majority too easily dismisses these shortcomings in the NCAI Resolution evidence. These shortcomings were laid out by both the TTAB dissent, and the District Court of Columbia in the original proceeding.<sup>231</sup> Most importantly, the Eastern District must accept, as the TTAB did, that although the NCAI Resolution was passed outside the relevant time period, it still represents the view held by Native Americans during the relevant time period.<sup>232</sup> If the Eastern District of Virginia agrees with the original D.C. Circuit decision, and concludes that the NCAI Resolution is not relevant evidence or should not be given the weight it was given by the TTAB, it is far more likely that the Eastern District will determine that the TTAB decision was unsupported by substantial evidence, as the NCAI Resolution was the cornerstone of the TTAB’s analysis.

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225. *Id.*

226. *Id.* at \*21 (majority opinion).

227. *Id.* at \*27, \*28.

228. *Id.* at \*21.

229. *Id.*

230. *See id.* at 41 (Bergsman, J., dissenting).

231. *See id.* at \*36–43; *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 121 (D.D.C. 2003) *aff’d on other grounds*, 565 F.3d 880 (D.C. Cir. 2009).

232. *See Blackhorse*, 111 U.S.P.Q.2d (BNA), 2014 WL 2757516, at \*18 (majority opinion).

C. “Substantial Composite” Needs to be Defined

Even if the NCAI Resolution can be substantiated to represent 30% of Native Americans, is 30% a “substantial composite” of Native Americans? The TTAB concluded that the relevant group for assessing whether a mark is disparaging is a “substantial composite” of Native Americans, but failed to define the term.<sup>233</sup> Petitioners did not introduce any evidence regarding the Native American population as a whole during the relevant time frame, nor did they provide any argument as to what comprises a substantial composite of that population. Without this important information, it is nearly impossible to evaluate the meaning of the evidence submitted.<sup>234</sup>

Further, the finding by the TTAB that 30% of the Native American population constituted a “substantial composite” conflicts with the findings in the *Harjo* decision, namely, that 36.6% of the Native American population amounted to a “substantial composite.”<sup>235</sup> Considering the TTAB was evaluating nearly identical evidence, this finding may not withstand further scrutiny. In the current action, the term “substantial composite” will need to be defined for the Eastern District to determine the sufficiency of the evidence submitted by the petitioners.

D. Evidentiary Standard and TTAB Precedent

In inter partes proceedings before the TTAB, disparagement under Section 2(a) of the Lanham Act must be proven by a preponderance of the evidence.<sup>236</sup> Since *Harjo*, the TTAB has issued two recent decisions denying registration of two trademark applications as disparaging—*In re Heeb Media*<sup>237</sup> and *In re Geller*.<sup>238</sup> In these cases, the TTAB ruled that the marks were disparaging based on the opinion of a few group representatives “without seriously scrutinizing the representative capacity of those individuals or requiring a strict mathematical calculation of the number of persons whose behalf they purportedly were speaking.”<sup>239</sup> These opinions were determined to represent a substantial composite of the relevant group.<sup>240</sup> However, the *Heeb* and *Geller* cases were ex parte cases in which a lower standard of proof is

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233. See *id.* at \*5, \*29.

234. *Id.* at \*36 (Bergsman, J., dissenting).

235. See *Pro-Football, Inc., v. Harjo*, 284 F. Supp. 2d 96, 133 n.32 (D.D.C. 2003).

236. See *supra* Part II.C.

237. *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 1080 (T.T.A.B. 2008).

238. *In re Geller*, 2013 WL 2365001, at \*11 (T.T.A.B. Feb. 7, 2013).

239. Patricia Cotton, *Redskins Ruling is Consistent with TTAB Precedent*, LAW360 (July 29, 2014, 10:37 AM), <http://www.law360.com/articles/561283/redskins-ruling-is-consistent-with-ttab-precedent> (arguing that the TTAB’s decision was actually consistent with its recent rulings, yet recognizing that the inter partes nature of the Blackhorse Litigation may require heightened scrutiny).

240. See *In re Heeb Media*, 89 U.S.P.Q.2d at 1079; *In re Geller*, 2013 WL 2365001, at \*10.

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required.<sup>241</sup> In an inter partes proceeding, the standard is much higher: a preponderance of the evidence.<sup>242</sup> Meaning, the Blackhorse petitioners needed to prove disparagement by a preponderance of the evidence.<sup>243</sup>

### V. CONCLUSION

The burden for the Blackhorse petitioners was to demonstrate by a preponderance of the evidence that the term *redskin(s)*, as used in connection with football-related services, is perceived as disparaging by a substantial composite of Native Americans during the relevant time period. According to the TTAB majority, the petitioners met this burden.<sup>244</sup> However, in its decision, the TTAB reached similar conclusions, by analyzing nearly identical evidence as the TTAB in the initial Harjo Litigation.<sup>245</sup> And despite the numerous findings of fact, the evidence upon which these findings are based suffers from the same problems, inconsistencies, and shortcomings as it did in the Harjo Litigation. In the Harjo Litigation, these shortcomings were exposed by the opinion of the D.C. Circuit.<sup>246</sup> In the most recent TTAB decision, the dissent reiterated these same problems.<sup>247</sup>

The D.C. Circuit's decision, although not precedential, is persuasive,<sup>248</sup> and will likely be considered by the Eastern District. The Eastern District may also consider the well-reasoned dissent. In sum, the lack of direct evidence from the relevant time period, and the overreliance by the petitioners on the NCAI Resolution, which will be deemed irrelevant if the D.C. Circuit's original reasoning is followed by the Eastern District, weighs in favor of reversal of the TTAB's decision, and ultimately in favor of the Washington Redskins. Even if the substantial evidence test is indeed used, the deference that must be given to the TTAB's findings of fact under such a standard will probably not be enough to overcome the evidentiary deficiencies.

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241. See *In re Geller*, 751 F.3d 1355, 1356–57 (Fed. Cir. 2014) (requiring only substantial evidence when affirming the TTAB's decision); *In re Heeb Media*, 89 U.S.P.Q.2d at 1077 (“In evaluating the examining attorney's evidence we must be cognizant of the USPTO's limitations in amassing evidence and ‘we look only for substantial evidence, or more than a scintilla of evidence, in support of the PTO's prima facie case.’”(internal citations omitted)).

242. See 35 U.S.C. § 316(e) (2012) (“In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.”).

243. See *Cotton*, *supra* note 239.

244. See *supra* Part III.D.

245. See *supra* Part III.D.

246. See *Pro-Football v. Harjo*, 284 F. Supp. 2d 96, 130–36 (2003) (reviewing the dictionary, historical, and survey evidence and finding insufficient evidence on record).

247. See *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080, 2014 WL 2757516, at \*35–43 (T.T.A.B. June 18, 2014) (Bergsman, J., dissenting). Judge Bergsman pointed out that the dictionary evidence relied upon by the majority was inconclusive and that there was insufficient evidence to “corroborate the membership of the National Council of American Indians.” *Id.* at \*35.

248. See *supra* Part IV.

It is also important to understand that the cancellation of the federal trademarks does not preclude use of the trademarks, and the Washington football team can continue to operate under their current name and logos.<sup>249</sup> The Redskins have used the marks in commerce for many years, some as early as the 1930's, and have acquired common law trademark rights that remain enforceable regardless of the outcome of the current action.<sup>250</sup> Enforcing common law trademarks will be more challenging, and without the enumerated benefits of federal registration, there certainly will be a financial hit, but the Redskins will be able to use the marks just as they had prior to cancellation.<sup>251</sup>

Administrative Trademark Judge Bergsman summed it up nicely by saying in his dissenting opinion:

*To be clear, this case is **not** about the controversy, currently playing out in the media, over whether the term “redskins,” as the name of Washington’s professional football team, is disparaging to Native Americans **today**. . . . [The narrower legal question is] whether the evidence made of record in this case establishes that the term “redskins” **was** disparaging to a substantial composite of Native Americans **at the time each of the challenged registrations issued**.*<sup>252</sup>

Even though the opinion of the media and general public is irrelevant to the trademark analysis, it is the court of public opinion that may ultimately determine whether the team changes its name. Recently, President Obama and 50 senators called for the team to change its name.<sup>253</sup> Senate Majority Leader Harry Reid (D-Nev.) has been the most vocal, recently stating he would not attend a Redskins game until the team changed its name.<sup>254</sup> A long list of journalists and publications

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249. See *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387, 1391 (Fed. Cir. 2010) (“[C]ancellation of a trademark registration does not necessarily translate into abandonment of common law trademark rights.”); see also MCCARTHY, *supra* note 44, at § 20:40.

250. See *In re Trade-Mark Cases*, 100 U.S. 82, 92 (1879) (“The right to adopt and use a symbol or device to distinguish the goods or property made or sold by the person whose mark it is, to the exclusion of use by all other persons, has long been recognized by the common law. . . . This exclusive right was not created by the act of Congress, and does not now depend upon it for its enforcement.”); see also *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 372 (1st Cir. 1980) (“[F]ederal registration does not create the underlying right in a trademark. That right, which accrues from the use of a particular name or symbol, is essentially a common law property right.”).

251. See *supra* Part II.C.

252. *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080, 2014 WL 2757516, at \*35 (T.T.A.B. June 18, 2014) (Bergsman, J., dissenting).

253. Donna Cassata, *Harry Reid Won’t Attend a Redskins Game Until the Team Changes its Name*, HUFFINGTON POST (June 16, 2014, 6:41 PM), [http://www.huffingtonpost.com/2014/06/16/harry-reid-redskins\\_n\\_5501293.html](http://www.huffingtonpost.com/2014/06/16/harry-reid-redskins_n_5501293.html).

254. *Id.*

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CHALLENGE-FLAG THROWN

refuse to use the name “Redskins” including *The Washington Post*, *New York Daily News*, *San Francisco Chronicle*, *Slate*, and *The New Republic*.<sup>255</sup> Even though Dan Snyder remains adamant that he has no intention of changing the name, if the tide of public opinion continues in opposition to the name, the fans and sponsors may have the ultimate say: with their wallets.

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<sup>255</sup> Andrew Beaujon, *Here's a List of Journalists Who Won't Use the Name 'Redskins'*, POYNTER (June 19, 2014, 11:30 AM), <http://www.poynter.org/news/mediawire/256258/heres-a-list-of-outlets-and-journalists-who-wont-use-the-name-redskins/>.