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Varying Vernaculars: How to Fix the Lanham Act's Weakness Exposed by the Washington Redskins

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Varying Vernaculars: How to Fix the Lanham Act's Weakness Exposed by the Washington Redskins

VARYING VERNACULARS: HOW TO FIX THE LANHAM ACT'S WEAKNESS EXPOSED BY THE WASHINGTON REDSKINS

DUSTIN OSBORNE*

ABSTRACT

In a relatively recent well-publicized decision, the Washington Redskins' trademark registration was stripped under the Trademark Act of 1946, also known as the Lanham Act. With the team currently appealing to the 4th Circuit Court of Appeals, however, this cancellation does not take place until the judicial review is complete. This Note critiques the Lanham Act and argues that the test should be whether the mark is disparaging today as opposed to when it was originally registered.

This Note asserts that because language is constantly changing in society, it makes more sense to look at how a term or phrase is viewed in today's society. A bill was proposed in the House in 2013, attempting to amend the Lanham Act to specifically deem "Redskin" a disparaging term. This Note suggests that this is too under-inclusive and that such a measure would not prevent this issue from recurring.

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INTRODUCTION

As of 2016, the Washington Redskins stand to lose much more than just the NFC East – they could lose their name. On June 18, 2014, the U.S. Patent and Trademark Office (“USPTO”) cancelled six trademark registrations for the team on the grounds that the name is “disparaging to Native Americans.”¹ In this determination, the Trademark Trial and Appeal Board (“TTAB”) looked at evidence such as the logo appearing prominently on the team’s helmets, the marching band wearing Native American headdresses as part of its uniform, the dance team wearing costumes suggestive of Native Americans, and the press guides displaying Native American imagery.²

Furthermore, on July 8, 2015, the District Court for the Eastern District of Virginia upheld the TTAB decision, finding that the challengers had met the legal requirements to prove “disparagement.”³ If this decision is upheld again on appeal, then federal law will prohibit the trademark protection for “Redskins.”⁴ The debate over the name “Redskins,” however, has continued to escalate over the years and throughout the appeal with both sides of the argument standing their ground.

On the one side, the argument is that the term “Redskins” disparages Native Americans. At the forefront of this argument are the groups of Native Americans protesting the use of the “Redskins” name.⁵ The largest of these protests occurred on November 2, 2014, when the demonstrators stood outside of the Washington stadium and yelled the question “[w]ho are we?” and responded with “[n]ot your mascots!” to the hundreds of Redskins

¹ *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080, 1114 (T.T.A.B. 2014).

² *Id.* at 1088-89.

³ *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 447 (E.D. Va. 2015).

⁴ See *Official United States Patent and Trademark Office Statement on the Trademark Trial and Appeal Board’s (TTAB) Decision in Blackhorse v. Pro Football, Inc. (TTAB Cancellation No. 92046185)*, 2014, USPTO.GOV, http://www.uspto.gov/news/USPTO_Official_Statement_on_TTAB_decision_in_Blackhorse_v_Pro_Football_Inc.pdf [hereinafter *Statement*].

⁵ John Woodrow Cox, *In Minnesota, Thousands of Native Americans Protest Redskins’ Name*, WASH. POST (Nov. 2, 2014), http://www.washingtonpost.com/local/in-minnesota-native-americans-march-rally-to-protest-redskins-name/2014/11/02/fc38b8d0-6299-11e4-836c-83bc4f26eb67_story.html.

fans.⁶ Additional evidence that “Redskins” is disparaging is presented by the Navajo Nation Council, which formally opposed the use of the “Redskins” name due to the potential negative psychological effects on American Indians.⁷ For example, clinical psychologist Michael Friedman has stated that this use of Native American imagery promotes and supports bullying in the form of racial slurs.⁸ Furthermore, a case has been made that significant negative effects are felt in schools, where the term “Redskins” creates an “unwelcome and hostile learning environment” that “directly results in lower self-esteem and mental health” for young Native American students.⁹ This argument finds further support in the fact that Native American young adults aging from fifteen to twenty four have a suicide rate that is two and a half times higher than the national average.¹⁰

However, it is not simply Native American nations that oppose this name. For example, several media outlets have already stopped printing and using the name, including the *San Francisco Chronicle* and *The Seattle Times*.¹¹ Furthermore, in 2014, National Football League (“NFL”) announcers used the name “Redskins” 472 fewer times in the regular season than they had used it in 2013, a decrease of 27%.¹² Finally, President Barack Obama further weighed in on the matter, officially stating that, were it his choice to make, he would “think about changing” the name and that

⁶ *Id.*

⁷ Associated Press, *Council Opposes Redskins' Name*, ESPN.COM (Apr. 11, 2014, 9:22 AM), http://espn.go.com/nfl/story/_/id/10766413/navajo-nation-council-opposes-washington-redskins-name.

⁸ Michael Friedman, *The NFL is Teaching Us How to Bully Native American Children*, Psychology Today (Oct. 6, 2014), <http://www.psychologytoday.com/blog/brick-brick/201410/the-nfl-is-teaching-us-how-bully-native-american-children>.

⁹ Erik Stegman & Victoria Phillips, *Missing the Point: The Real Impact of Native Mascots and Team Names on American Indian and Alaska Native Youth*, CENTER FOR AMERICAN PROGRESS (July 22, 2014), <https://www.americanprogress.org/issues/race/report/2014/07/22/94214/missing-the-point/>.

¹⁰ *Id.*

¹¹ *Id.*

¹² Timothy Burke, “Redskins” Mentions Down 27% on NFL Game Broadcasts in 2014, REGRESSING (Dec. 12, 2014, 10:15 AM), <http://regressing.deadspin.com/redskins-mentions-down-27-on-nfl-game-broadcasts-in-1676147358/+bubbaprog>.

nostalgia may not be a good enough reason to keep a name in place when it offends a “sizable group of people.”¹³

On the other side, the opposing argument is that “Redskins,” as used today, honors Native Americans.¹⁴ Dan Snyder, the owner of the Washington NFL team, has repeatedly defended the use of the “Redskins” name, stating, “while he respects the opinions of those who are offended by the team name . . . we cannot ignore our 81-year history.”¹⁵ He has also stood a more combative ground in this debate, vowing that he would “never change the name” and that the press “can use caps [on ‘never’].”¹⁶ This kind of “legacy” argument is also constantly used in this debate, arguing that the term “redskins” is a part of the area’s identity and is much more than just a racial slur.¹⁷

Additionally, the commissioner of the NFL, Roger Goodell, has stated that more people, including Native Americans, support the team keeping their name than oppose it.¹⁸ He supported this announcement by saying that “if you look at the numbers, including native American communities, nine out of [ten] supported the name. Eight out of [ten] in the general American

¹³ Associated Press, *Obama Weighs in on ‘Redskins’*, ESPN.COM (Oct. 5, 2013, 4:35 PM), http://espn.go.com/nfl/story/_/id/9772653/president-obama-washington-redskins-legitimate-concerns.

¹⁴ Erik Brady, *Poll: 71% Don’t Think Redskins Should Change Name*, USA TODAY SPORTS (Jan. 2, 2014, 9:00 PM), <http://www.usatoday.com/story/sports/nfl/redskins/2014/01/02/team-name-controversy-public-policy-polling/4297665/>.

¹⁵ Anny’s Shin & Dan Steinberg, *Daniel Snyder Defends Redskins in Emotional Letter to Fans*, WASH. POST (Oct. 9, 2013), http://www.washingtonpost.com/local/snyder-defends-redskins-name-in-emotional-letter-to-fans/2013/10/09/9a161b06-30fa-11e3-8627-c5d7de0a046b_story.html.

¹⁶ Erik Brady, *Daniel Snyder Says Redskins Will Never Change Name*, USA TODAY SPORTS (May 10, 2013, 8:14 AM), <http://www.usatoday.com/story/sports/nfl/redskins/2013/05/09/washington-redskins-daniel-snyder/2148127/>.

¹⁷ Sean R. Patterson, *Why the “Redskins” Matter*, SB NATION (May 10, 2013, 7:21 AM), <http://www.hogshaven.com/2013/5/10/4314478/why-the-redskins-matter>.

¹⁸ Steve Keating, *Most Support Washington Redskins Keeping Name, Says Goodell*, YAHOO! SPORTS (Jan. 31, 2014, 5:41 PM), <http://sports.yahoo.com/news/most-support-washington-redskins-keeping-name-says-goodell-203053685--nfl.html>.

population would not like us to change the name.”¹⁹ While many have questioned the validity of Goodell’s statistical claim,²⁰ Public Policy Polling found that, of 741 registered voters, 71% believe that the Redskins should keep their name, while 18% said that the team should change it, and 11% said they are undecided.²¹

In Part I, this Note first examines the Lanham Act and how it currently lays out the standards for cancellation of registration. This includes a brief overview of the Lanham Act as a whole, the process and purpose of registering a mark as a trademark, the process and requirements for canceling a trademark and an equitable defense that can be raised, the overall impact of a cancelled trademark, and the current status of the “Redskins” trademark. Part II then looks in depth at the recent leading cases dealing with the “Redskins” trademark, the latter of which is still in the process of judicial review. Part III then compares the evidence utilized in the aforementioned cases to the evidence that this Note suggests that the Board should consider in actions for cancellation of a trademark. Additionally, Part III proposes that the Lanham Act adopt this new inquiry as to whether the mark is viewed as disparaging today, rather than when registration was first sought, and argues that as to how this new inquiry will help the disparagement issue in future cases.

I. THE LANHAM TRADEMARK ACT

The Trademark Act, commonly referred to as the Lanham Act, provides protection to trademark owners.²² Under the authority of the Commerce Clause, Congress enacted the Lanham Act in 1946.²³ The intent of this Act is to regulate commerce within the control of Congress by making deceptive and misleading use of marks actionable; to protect registered marks

¹⁹ *Id.*

²⁰ Mike Chiari, *Roger Goodell Claims 9 out of 10 Native Americans Support Redskins Nickname*, BLEACHER REPORT (Jan. 31, 2014), <http://bleacherreport.com/articles/1943682-roger-goodell-claims-9-out-of-10-native-americans-support-redskins-nickname>.

²¹ Brady, *supra* note 14.

²² *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 46 (D.C. Cir. 2005) (citing 15 U.S.C. §§ 1051-1127, 1141-1141n).

²³ *Lanham Act*, LEGAL INFO. INST., http://www.law.cornell.edu/wex/lanham_act (last visited January 14, 2014).

from interference by the State; to protect persons engaged in such commerce against unfair competition, to prevent fraud and deception by the use of reproductions of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trademarks entered into between the United States and foreign nations.²⁴ Under the Lanham Act, the term “trademark” includes any word, name, symbol, or device, or any combination thereof used by a person to identify and distinguish his or her goods.²⁵ The Act provides for a national system of trademark registration, “protecting the owner of a federally registered mark against the use of similar marks if such use is likely to result in consumer confusion...”²⁶ The scope of the Lanham Act, however, is independent of and concurrent with state statutes and state common law.²⁷

A trademark owner must register his or her trademark in order to take advantage of many of the Lanham Act’s provisions.²⁸ However, the USPTO must deny registration to any marks that “may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”²⁹ The Federal Circuit has found a trademark disparaging if it may “slight, deprecate, degrade, or affect or injure by unjust comparison.”³⁰

Furthermore, the Act also provides for cancellation of registration of a trademark that has already been granted.³¹ Under the Act, “[a] petition to cancel a registration of a mark . . . may . . . be filed . . . by any person who believes that he is or will be damaged . . . [a]t any time if . . . its registration was obtained . . . contrary to the provisions of . . . subsection (a) . . . of section 1052 of this title.”³² Registration is obtained contrary to the provisions of section 1052(a) of this title when the mark consists of matter that may disparage people.³³ The TTAB then interprets the

²⁴ 15 U.S.C. § 1127.

²⁵ *Id.*

²⁶ *Id.*

²⁷ *Id.*

²⁸ *Statement, supra* note 4.

²⁹ 15 U.S.C. § 1052(a).

³⁰ *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014).

³¹ 15 U.S.C. § 1064(3).

³² *Id.*

³³ § 1052(a).

evidence presented and determines whether to cancel the mark.³⁴ Essentially, this cancellation determination hinges on whether the mark should have been allowed registration when the trademark owner originally applied for it.³⁵ Finally, in these proceedings, equitable principles such as laches may be considered and applied.³⁶

Laches is an equitable doctrine that “is founded on the notion that equity aids the vigilant and not those who slumber on their rights.”³⁷ The defendant raising the defense has the burden of proving this equitable defense.³⁸ In order for the defendant to meet this burden of proof, the laches defense “requires proof of (1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense,” with the prejudice caused by the delay.³⁹

Due to the publicity surrounding this controversial mark, “Redskins,” the impact of this decision has been blown out of proportion.⁴⁰ First, the registrations will not appear as cancelled in the USPTO’s official records until after any judicial review is complete;⁴¹ thus, as of the drafting of this Note, the appeals process is still ongoing and the registrations have not been listed as officially cancelled.⁴² Additionally, contrary to popular belief, cancellation of a trademark’s registration does not prevent the trademark owner from using the mark.⁴³ While the registration of a mark may be cancelled, the owner’s rights to the mark still exist, and the owner may enforce those rights under state, common, and even federal law under the Lanham Act.⁴⁴ The Patent and Trademark Office makes this distinction clear, stating that “[f]ederal registration is not required to establish rights in a

³⁴ See 15 U.S.C. § 1067.

³⁵ See § 1064(3).

³⁶ 15 U.S.C. § 1069.

³⁷ *Harjo*, 415 F.3d at 47 (citing *NAACP v. NAACP Legal Def. & Educ. Fund, Inc.*, 753 F.2d 131, 137 (D.C. Cir. 1985)).

³⁸ See *id.*

³⁹ *Id.* (citing *AMTRAK v. Morgan*, 536 U.S. 101, 121-22 (2002)).

⁴⁰ See Amanda Catelli, *Washington Redskins Trademark Registration Canceled*, Inside Couns., June 24, 2014.

⁴¹ *Statement*, *supra* note 4.

⁴² *Id.*

⁴³ See Catelli, *supra* note 40.

⁴⁴ *Id.* Suit for infringement of unregistered marks can be brought under § 43(a) of the Lanham Act.

trademark. Common law rights arise from actual use of a mark and may allow the common law user to successfully challenge a registration or application.”⁴⁵ Thus, contrary to some reports,⁴⁶ the general public cannot begin producing and selling products that feature an unregistered trademark. A person cannot infringe another’s trademark whether or not registered, and the owner will likely enforce his or her rights to recover damages resulting from this infringement.⁴⁷

As far as state law is concerned, the team will definitely have protection, as states have their own independent laws governing infringement.⁴⁸ While this raises issues of policing infringing activity and researching varying state laws, the state laws provide at least some sort of protection.⁴⁹ The team will accordingly have common law trademark protections,⁵⁰ and these protections are established as soon as the mark is used in connection with the sale of goods or services and become stronger as the mark becomes more deeply associated with the source, here being the Washington professional football team.⁵¹ The length of use of the brand and the ease with which consumers can identify the brand are two factors that help establish whether a source has

⁴⁵ *Frequently Asked Questions about Trademarks*, USPTO.GOV, http://www.uspto.gov/faq/trademarks.jsp#_Toc275426712 (last visited Nov. 24, 2014).

⁴⁶ *See, e.g., Darren Rovell, Patent Office: Redskins ‘Disparaging’*, ESPN.COM, http://espn.go.com/nfl/story/_id/11102096/us-patent-office-cancels-washington-redskins-trademark (last updated June 18, 2014, 6:33 PM) (stating erroneously that “[w]ithout protection, any fan can produce and sell Washington Redskins gear without having to pay the league or the team for royalties and wouldn’t be in violation of any law for doing so.”).

⁴⁷ Darren Heitner, *Loss of Redskins Trademark Registration is Overblown*, FORBES (June 18, 2014, 12:53 PM), <http://www.forbes.com/sites/darrenheitner/2014/06/18/loss-of-redskins-trademark-registration-is-overblown/>.

⁴⁸ Travis Waldron, *The Redskins Just Had Their Trademark Canceled. Here’s What Happens Next.*, THINKPROGRESS (June 19, 2014, 11:43 AM), <http://thinkprogress.org/sports/2014/06/19/3450729/redskins-trademark-decision-cost-lots-of-money/>.

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.*

common law protections;⁵² in this case, it seems as though these factors would benefit the team strongly.⁵³

II. LEADING CASES DEALING WITH “REDSKINS”

As of 2015, there have been two leading cases dealing specifically with the term “redskin(s).” In the first of these cases, *Pro-Football, Inc. v. Harjo*,⁵⁴ the Board decision came in 1999, the initial appeal ended in 2003, and the case did not conclude until 2009 when the Supreme Court ultimately decided not to hear it.⁵⁵ In the second of these leading cases, *Blackhorse v. Pro-Football, Inc.*,⁵⁶ the Board’s decision came in 2014. The appeals process also began in 2014 and is still ongoing,⁵⁷ but if *Harjo* is any indication, it may be a significant amount of time before the ultimate effect of this litigation materializes.

A. *Pro-Football, Inc. v. Harjo*

In 1992, seven Native Americans filed a complaint with the USPTO’s TTAB.⁵⁸ Led by Suzan Harjo, they requested that the TTAB cancel the Washington Redskins trademark.⁵⁹ As grounds for cancellation, they alleged that the term “redskin(s)” offended and disparaged Native Americans,⁶⁰ violating the Lanham Act.⁶¹ This would mean that, under the Lanham Act, the term should not have been registered in the first place.⁶² The registration dates back to 1967 in the case of “redskin(s).”⁶³

In response, Pro-Football argued that laches barred the plaintiffs’ claim.⁶⁴ However, the TTAB rejected this argument, finding the laches defense inapplicable due to the broader interest

⁵² *Id.*

⁵³ Waldron, *supra* note 48.

⁵⁴ 415 F.3d.

⁵⁵ Waldron, *supra* note 48.

⁵⁶ 111 U.S.P.Q.2d (BNA) at 1114.

⁵⁷ Waldron, *supra* note 48.

⁵⁸ *Harjo*, 415 F.3d at 46.

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ § 1052(a).

⁶² See §§ 1052(a), 1064(3).

⁶³ *Harjo*, 415 F.3d at 47.

⁶⁴ *Id.*

of preventing a party from benefiting from this registration.⁶⁵ Finally, in 1999, the TTAB ruled in favor of the plaintiffs, finding that the trademark had disparaged Native Americans since at least 1967.⁶⁶ This ruling did not prevent Pro-Football from using the marks, but it limited its ability to sue infringers under the Lanham Act.⁶⁷

Accordingly, Pro-Football appealed to the United States District Court for the District of Columbia.⁶⁸ In 2003, the district court held that the plaintiffs had failed to establish disparagement and that the action was barred under laches due to the plaintiffs' failure to bring the claim in a timely fashion.⁶⁹ Ultimately, after an appeal to the Court of Appeals for the District of Columbia, a remand to the District Court, and an affirmation by the Court of Appeals, the Court of Appeals held that laches barred the claim.⁷⁰ However, the Court of Appeals never declared whether the TTAB or the district court was correct on the issue of disparagement.⁷¹ This lack of analysis left the issue open for vast debate and led to the next important lawsuit.

B. Blackhorse v. Pro-Football, Inc.

In 2006, five young Native Americans filed a complaint similar to that filed in *Harjo*.⁷² They alleged that six registrations were obtained contrary to the Lanham Act, ranging from the years of 1967 to 1990.⁷³ These six registrations consisted of the marks "The Redskins" and "Washington Redskins," the marks and designs of "The Redskins" and "Washington Redskins," and the marks "Redskins" and "Redskinettes."⁷⁴ The Board first addressed the case of *Harjo*, acknowledging its analysis of the laches defense,

⁶⁵ *Id.*

⁶⁶ *Id.*

⁶⁷ *Id.*

⁶⁸ *Harjo*, 415 F.3d at 47.

⁶⁹ *Id.*

⁷⁰ *Id.*; J. Gordon Hylton, *Before the Redskins were the Redskins: The Use of Native American Team Names in the Formative Era of American Sports*, 86 N.D. L. REV. 879, 883 (2010).

⁷¹ *Id.*

⁷² *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1082.

⁷³ *Id.*

⁷⁴ *Id.* at 1083.

but also realizing that the court did not address the Board's finding of disparagement on the merits.⁷⁵ Additionally, most of the evidence in this case was re-submitted from *Harjo*, as the parties stipulated that the entire record from *Harjo* might be submitted into evidence with certain exceptions.⁷⁶

In determining whether disparagement exists, the Board utilized a two-step analysis: (1) determining 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; and (2) determining the meaning of the marks and whether that meaning is one that may disparage Native Americans.⁷⁷ The Board dealt quickly with the latter half of the first step, finding it clear that the disparagement claim only pertains to the term "redskins" and that it clearly refers both to the professional football team and alludes to Native Americans.⁷⁸ In its analysis of "meaning of the matter in question," the Board found the evidence overwhelmingly supports a determination that the term "redskins," as it appears in the marks, means "Native Americans."⁷⁹ The Board looked at evidence such as the logo appearing prominently on the team's helmets, the marching band wearing Native American headdresses as part of its uniform, the dance team wearing costumes suggestive of Native Americans, and the press guides displaying Native American imagery.⁸⁰ Thus, the Board found the first step of the test clearly satisfied.⁸¹

Accordingly, the Board proceeded to the second step of the test, whether the meaning of the mark at the time of registration may have disparaged Native Americans.⁸² Under the Board's

⁷⁵ *Id.* at 1084.

⁷⁶ *Id.* ("[A]ll evidence submitted with a Note of Reliance, as well as all deposition transcripts and exhibits thereto submitted by any party, in *Harjo* . . . shall be admissible in this proceeding unless the [TTAB] ruled in *Harjo* that the evidence was not admissible, in which case all arguments as to admissibility are preserved.").

⁷⁷ *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1087-88.

⁷⁸ *Id.* at 1088.

⁷⁹ *Id.*

⁸⁰ *Id.* at 1088-89.

⁸¹ *Id.* at 1089.

⁸² *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1089.

precedent, there are three contexts of goods or services in which a mark may be found disparaging.⁸³ The mark could be:

- (1) an innocuous term that in the context of the goods or services is disparaging . . . ;
- (2) a disparaging term that may have a non-disparaging meaning in a specific context . . . ; or
- (3) a disparaging term that has no non-disparaging meanings in any context, and remains disparaging despite the applicant's goods or services, actual use or intent⁸⁴

Applied to this case, the Board found that neither the alleged honorable intent nor the manner of the use of the term by the trademark owner affects the determination of whether a substantial portion of Native Americans found "redskins" to be disparaging in the context of the owner's services provided during the time period of 1967-1990.⁸⁵ These services provided by the owner have not purged the Native American meaning from the mark, and intent has no effect on the second prong of this test.⁸⁶

1. The Board's Analysis

In an effort to prove that the term was disparaging during the relevant time periods, even when the term was used solely in regard to football and cheerleading services, the plaintiffs presented two categories of evidence: a general analysis of the term and the specific views of the referenced group.⁸⁷ With regards to the general analysis of the term, the Board focused on expert reports and testimony, dictionary definitions, and reference books.⁸⁸ Overall, many of the dictionary definitions from the relevant time period labeled the term as "often offensive," with the trend beginning in 1966 and becoming unanimous among dictionaries by 1986.⁸⁹ Additionally, linguistics experts disagreed

⁸³ See *In re Shiao Tam*, 108 U.S.P.Q.2d (BNA) 1305, 1309-10 (T.T.A.B. 2013).

⁸⁴ *Id.*

⁸⁵ *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1091.

⁸⁶ *Id.*

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ *Id.* at 1094.

on the value of these labels and as to the declining use of the term in the media.⁹⁰

For the specific views of Native Americans, the Board focused on the National Congress of American Indians' ("NCAI") 1993 Resolution 93-11, depositions, and various articles, reports, official records and letters.⁹¹ The relevant portion of the resolution includes:

NCAI is the oldest and largest intertribal organization nationwide representative of and advocate for national, regional, and local tribal concerns;

[T]he term REDSKINS is not and has never been one of honor or respect, but instead, it *has always been* and continues to be a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for Native American's [sic]; and

[T]he use of the registered service marks identified in Exhibit B to this resolution by the Washington Redskins football organization, has always been and continues to be offensive, disparaging, scandalous, and damaging to Native Americans.⁹²

The Board relied on the NCAI Executive Director's deposition to support the credibility, reliability, and trustworthiness of this resolution.⁹³ It further relied on this deposition for the fact that roughly 150 tribes were represented by the NCAI and that at least one third of the tribal members were present in order to pass the resolution.⁹⁴ The Board also responded to, and overruled, the defendant's relevancy objection, stating that although this resolution was passed in 1993 and thus after the relevant time period at issue, "the mere fact that an opinion is voiced in 1993 does not mean the opinion was not held by that group or individual

⁹⁰ *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1095.

⁹¹ *Id.* at 1091.

⁹² *Id.* at 1098.

⁹³ *Id.*

⁹⁴ *Id.*

in the 1967-1990 time period.”⁹⁵ Ultimately, the Board used this resolution as representing the views of a substantial composite of Native Americans.⁹⁶

Additionally, the Board relied on several protest letters written at the end or just after the relevant time period by Native Americans.⁹⁷ The Board reasoned that they provided evidence as to the opinion of individual Native Americans across the United States, thus providing a collective viewpoint.⁹⁸ However, they did not use the approximate 150 letters from non-Native Americans; they held limited probative value because it is disparagement in the eyes of the group allegedly disparaged that is relevant.⁹⁹

In response, the defendants offered evidence of various letters from individuals, such as the chiefs of many Native American nations.¹⁰⁰ Collectively, these presented opinions that the term was actually used in honor and respect.¹⁰¹ The Board, however, saw this as no more than “a handful of individuals . . . who have their own individual opinion.”¹⁰² The final decision turned on “whether the evidence shows that a substantial composite of the Native American population found the term ‘[r]edskins’ to be disparaging when the respective registrations issued.”¹⁰³ The Board reasoned that once the evidence has established this substantial composite, the existence of differing opinions could not alter the conclusion – a substantial composite, not unanimity, is required.¹⁰⁴ Thus, the Board held that the six registrations must be cancelled under the Lanham Act.¹⁰⁵

Finally, the defendants raised the laches defense, as seen in *Harjo*.¹⁰⁶ The determination of whether to allow the laches defense is a factual one,¹⁰⁷ and the Board decided that because this

⁹⁵ *Blackhorse*, 111 U.S.P.Q.2d at (BNA) 1098.

⁹⁶ *Id.* at 1110.

⁹⁷ *Id.* at 1104.

⁹⁸ *Id.*

⁹⁹ *Id.*

¹⁰⁰ *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1105.

¹⁰¹ *Id.*

¹⁰² *Id.* at 1110.

¹⁰³ *Id.* at 1111.

¹⁰⁴ *Id.*

¹⁰⁵ *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1111-12.

¹⁰⁶ *Id.* at 1112.

¹⁰⁷ *See id.*

litigation was essentially a repeat of the litigation in *Harjo*, it would follow the court's precedent and allow the defense to be raised.¹⁰⁸ Ultimately, however, the Board held that the defense of laches did not apply in this case.¹⁰⁹ First, laches is an equitable defense, and the Board explained that to apply laches to this type of claim would give the trademark owner's financial interest more weight than the human dignity being harmed.¹¹⁰ Second, the Board stated that the defense does not apply when there exists a broader public interest at issue.¹¹¹ The Board proceeded to find that because the plaintiffs had already proved that a substantial composite of Native Americans found the term to be disparaging, the term undisputedly fell within the "broader public interest" category.¹¹² Finally, the Board determined that the plaintiffs showed nothing more than a minimal delay in seeking cancellation, as they were young adults and had not had a fair chance to file the petition sooner.¹¹³ Thus, the Board found that the equitable laches defense failed and granted the petition for cancellation.¹¹⁴

2. Bergman's Dissent

In his dissent, Bergsman, the Administrative Trademark Judge, stated that he would find the evidence insufficient to prove that the term "redskins" was disparaging in the relevant time period.¹¹⁵ To be clear, he stated that he did not hold that the term was not actually disparaging in the relevant time period.¹¹⁶ Rather, he found that the dictionary evidence produced was inconclusive and that there was no reliable evidence to corroborate the membership of the NCAI, and as such, that the plaintiffs failed to prove disparagement in that time period.¹¹⁷

In regard to the dictionary definitions, he rejected the majority's finding of a "clear trend beginning in 1966 to label this

¹⁰⁸ *Id.*

¹⁰⁹ *Id.*

¹¹⁰ *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1112.

¹¹¹ *Id.* at 1113.

¹¹² *Id.*

¹¹³ *Id.* at 1114.

¹¹⁴ *Id.*

¹¹⁵ *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1114-15.

¹¹⁶ *Id.* at 1115.

¹¹⁷ *Id.*

term as offensive.”¹¹⁸ He instead rationalized that only two dictionaries in the relevant time period labeled the term as offensive, and that “[t]wo does not make a trend.”¹¹⁹ Thus, he found this evidence was not sufficiently probative to justify the cancellation of the registrations.¹²⁰

Furthermore, in regard to the NCAI evidence, he found no reliable evidence as to the number of Native Americans or tribes in attendance at the meeting or the membership numbers during the relevant time period.¹²¹ He analyzed all of the evidence presented to the Board, including the depositions, articles, reports, and statements upon which the majority relied.¹²² Ultimately, however, he determined this evidence insufficient, deeming it a “house of cards that collapses upon examination.”¹²³

Thus, after his “careful study of all the facts” and “due caution,” he held that the plaintiffs “failed to show by a preponderance of the evidence that a substantial composite of Native Americans found the term REDSKINS to be disparaging in connection with respondent’s services during the relevant time frame of 1967-1990[.]” and as such, the six registrations should not have been cancelled under the Lanham Act.¹²⁴

3. District Court Upholds TTAB Decision

Most recently, on July 8, 2015, U.S. District Judge Gerald Bruce Lee affirmed the USPTO’s decision.¹²⁵ In doing so, Judge Lee essentially rehashes the same rationales made in the TTAB decision, ultimately holding that the meaning of the six marks in question is a reference to Native Americans.¹²⁶ He further agreed that the marks “may disparage” a substantial composite of Native Americans during the relevant time period of 1967 and 1990 according to the same evidence utilized by the USPTO.¹²⁷

¹¹⁸ *Id.* at 1118.

¹¹⁹ *Id.*

¹²⁰ *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1118.

¹²¹ *Id.* at 1119.

¹²² *Id.* at 1120-21.

¹²³ *Id.* at 1121.

¹²⁴ *Id.*

¹²⁵ *Pro-Football, Inc.*, 112 F. Supp. 3d 439, 447.

¹²⁶ *Id.* at 469.

¹²⁷ *Id.* at 472-88.

Finally, Judge Lee rejected the idea that laches barred the plaintiffs' claim, finding that to the extent that Blackhorse appellees did delay in filing their petition to cancel the marks, the delay was not unreasonable.¹²⁸ Furthermore, the court held that laches did not apply because of the overriding public interest in removing the disparaging marks.¹²⁹

III. NEW INQUIRY

As the discrepancies between the majority and the dissent in the first *Blackhorse* decision makes clear, evidence pertaining to various time periods throughout history is not only difficult to come by, but also difficult to properly analyze. Thus, the Lanham Act should be amended to reflect a new standard for disparaging marks. The test should be whether a mark is disparaging *now*, as opposed to during the time period when the mark was originally registered.

A prime example of this proposition's potential success is that of Florida State University ("FSU").¹³⁰ In 2005, the National Collegiate Athletic Association ("NCAA") distributed "self-evaluations" to thirty-one colleges in an effort to clarify an institution's position on a Native American mascot.¹³¹ While acknowledging that it did not possess the authority to ban the use of Native American nicknames and mascots, the NCAA prohibited institutions from displaying the images during post-season play and from hosting post-season tournaments if the images were found to be hostile or abusive.¹³² However, the NCAA has also

¹²⁸ *Id.* at 489.

¹²⁹ *Id.*

¹³⁰ Steve Wieberg, *NCAA Allowing Florida State to Use Its Seminole Mascot*, USA TODAY (Aug. 23, 2005, 11:19 PM), http://usatoday30.usatoday.com/sports/college/2005-08-23-fsu-mascot-approved_x.htm.

¹³¹ Michelle Brutlag Hosick, *Mascot Matter Fits Into Proper-Environment Discussion*, NCAA NEWS ARCHIVE (Mar. 14, 2005, 5:20 PM), <http://fs.ncaa.org/Docs/NCAANewsArchive/2005/Association-wide/mascot%2Bmatter%2Bfits%2Binto%2Bproper-environment%2Bdiscussion%2B-%2B3-14-05%2Bncaa%2Bnews.html>.

¹³² Myles Brand, *NCAA Correctly Positioned as a Catalyst for Social Change*, NCAA NEWS ARCHIVE (Oct. 24, 2005, 3:48 PM), <http://fs.ncaa.org/Docs/NCAANewsArchive/2005/Editorial/ncaa%2Bcorrectly%>

relied upon a statement by the NCAI supporting the use of Native American nicknames in certain circumstances, which states that:

[i]n general, NCAI strongly opposes the use of derogatory Native sports mascots. However, in the case where mascots refer to a particular Native nation or nations, NCAI respects the right of individual tribal nations to work with universities and athletic programs to decide how to protect and celebrate their respective tribal heritage.¹³³

Under this NCAI principle, the NCAA granted FSU a waiver for their mascot, the Seminole, removing FSU from the list of colleges whose sports teams used hostile or abusive imagery.¹³⁴ Bernard Franklin, the NCAA senior vice president, released a statement that “[t]he decision of a namesake sovereign tribe, regarding when and how its name and imagery can be used, must be respected even when others may not agree.”¹³⁵ He further explained that the staff review committee analyzed the unique relationship between FSU and the Seminole Tribe of Florida and considered it a significant factor in permitting this waiver.¹³⁶ Furthermore, the chief and general council president of the Seminole Tribe of Florida said that it was an “honor” to be associated with FSU.¹³⁷

This is a clear example of the amendment to the Lanham Act proposed in this Article already being employed, albeit by the NCAA. FSU started using the Seminole as its mascot symbol in 1947 with depictions showing a Native American holding a tomahawk.¹³⁸ Rather than attempt to gather evidence as to whether this term “Seminole” was disparaging in 1947, a difficult feat as

2Bpositioned%2Bas%2Ba%2Bcatalyst%2Bfor%2Bsocial%2Bchange%2B-%2B10-24-05%2Bncaa%2Bnews.html.

¹³³ *Anti-Defamation & Mascots*, NAT’L CONGRESS OF AM. INDIANS, <http://www.ncai.org/policy-issues/community-and-culture/anti-defamation-mascots>.

¹³⁴ Wieberg, *supra* note 130.

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *Id.*

¹³⁸ L.V. Anderson, *When Did People Start Doing the Tomahawk Chop? And It Is Racist, Right?*, SLATE (Sept. 26, 2012, 6:12 PM), http://www.slate.com/articles/news_and_politics/explainer/2012/09/origins_of_the_tomahawk_chop_scott_brown_s_staffers_mocking_elizabeth_warren_are_continuing_a_long_tradition_.html.

demonstrated by *Blackhorse*, evidence as to how the term is viewed today was used.¹³⁹ In this case, that consisted of weighing the 2005 public opposition to the term “Seminole” against the vocalized support of the Seminole Tribe of Florida. Ultimately, although some were appalled by the NCAA’s decision,¹⁴⁰ the fact that the namesake sovereign tribe supported the use of “Seminole” was decisive.¹⁴¹ This serves as a good example of some present-day evidence that could be utilized under the proposed amendment to the Lanham Act, namely support from potentially offended Native American tribes.

This proposition could also help diffuse the oft-raised slippery slope argument.¹⁴² This slope would simply allow for subjective judgments of whether a term has been offensive throughout its equivocal history since its registration.¹⁴³ For example, although it is admittedly not a trademark, the state of Oklahoma serves as an example of this principle.¹⁴⁴ In 1886, a member of the Choctaw tribe, Reverend Allen Wright, suggested the name Oklahoma to mark the federal territory of the Native American nations and tribes.¹⁴⁵ In Choctaw language, “okla” means “people” while “homma” or “humma” means “red.”¹⁴⁶ Thus, the name “Oklahoma” was meant to signify “Red People” in the Choctaw language.¹⁴⁷ Even though it was a member of the Choctaw tribe who suggested the name, no evidence clarifies whether the tribe as a whole would have found the name “Oklahoma” disparaging to their people. Today, however, Oklahoma is clearly viewed as the name of a state and is noncontroversial.

¹³⁹ See Wieberg, *supra* note 130.

¹⁴⁰ See *id.*

¹⁴¹ See *id.*

¹⁴² See Robert Tracinski, *Why the Redskins Trademark Ruling Should Terrify You*, *The Federalist* (June 19, 2014), <http://thefederalist.com/2014/06/19/why-the-redskins-trademark-ruling-should-terrify-you/>.

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ Muriel H. Wright, *Contributions of the Indian People to Oklahoma*, *CHRON. OF OKLA.* (June, 1936), <http://digital.library.okstate.edu/Chronicles/v014/v014p156.html>.

¹⁴⁶ *Id.*

¹⁴⁷ *Id.*

Now to address the name causing the greatest current controversy, “Redskins.” On March 20, 2013, a bill was introduced in the United States House of Representatives,¹⁴⁸ which would have amended the Lanham Act to state that:

[A] mark that uses the term “redskin” or any derivation of that term consists of matter which may disparage persons if: (1) it has been, is, or is intended to be used in commerce in connection with references to or images of Native Americans; or (2) the Director of the United States Patent and Trademark Office (Director) determines that the term as included in the mark is commonly understood to refer to Native Americans.¹⁴⁹

It would also require the Director to cancel the registration of a mark containing the term “redskin.”¹⁵⁰ The problem with this proposed amendment, however, is that it addresses the issue on too small a scale – the term “redskin” is thereby dealt with, but what of other potentially disparaging marks? It is certainly plausible that an issue could arise in the future with respect to another unrelated mark, bringing us back to square one. If an amendment is to be made to the Lanham Act, it needs to have broader application, such as this Note’s proposed amendment.

Under this Note’s proposed amendment to the Lanham Act, the TTAB would consider evidence as to whether the term is disparaging *now*, as opposed to when it was originally registered, and make a factual decision accordingly. In the case of the Washington Redskins, there is plentiful evidence on both sides, and it would likely be a close determination.

In support of not canceling the registration, the “legacy” of the name and team is likely substantial evidence. Every franchise in the NFL is a storied franchise, and changing something as substantial as the team name or mascot ultimately changes the entire legacy of the franchise, including anything good that is

¹⁴⁸ Non-Disparagement of Native American Persons or Peoples in Trademark Registration Act of 2013, H.R. 1278, 113th Cong. (2013).

¹⁴⁹ *Id.*

¹⁵⁰ *Id.*

associated with the team.¹⁵¹ Furthermore, as stated by higher officials such as Dan Snyder and Roger Goodell, there is a large amount of support for keeping this name as a way of honoring Native Americans.¹⁵² This is evident from the few statistics by Public Policy Polling that are currently available on the matter, finding that of 741 registered voters, 71% believe that the Redskins should keep their name, while 18% said that the team should change it, and 11% said they are undecided.¹⁵³ Even though this poll is not a poll of Native Americans, it is still important to weigh the evidence of the general public; were neither Native American nations nor the general public or fans of the NFL team in support of keeping this name, it would present a much steeper uphill battle for Dan Snyder.

Ultimately, however, in support of changing the name, the evidence currently available seems to outweigh the evidence in support of retaining the registration. The argument here, of course, is that the term “redskins” disparages Native Americans. This is strongly supported by the fact that groups of Native Americans are protesting the use of the “Redskins” name,¹⁵⁴ such as the Navajo Nation Council formally opposing the use of the “Redskins” name,¹⁵⁵ with the largest of these protests just occurring on November 2, 2014.¹⁵⁶ Not only are these protests occurring and getting larger, it is clear that the Native Americans in protest feel as though they are currently the team’s mascot, yelling the question “[w]ho are we?” and responding with “[n]ot your mascots!”¹⁵⁷ This also cuts against any support that the team might draw from the NCAI, as it is hard to argue that you have the support of the Native American people when they are constantly initiating larger protests. Were the team to obtain more support from Native American nations, or arrive at a compromise did as

¹⁵¹ See, e.g., Patterson, *supra* note 16 (“Maybe ‘Redskins’ is not the best name for a football team, but one cannot ignore all of the good associated with the Washington Redskins”).

¹⁵² See Shin, *supra* note 15; Keating, *supra* note 18.

¹⁵³ Brady, *supra* note 14.

¹⁵⁴ Cox, *supra* note 5.

¹⁵⁵ Associated Press, *supra* note 7.

¹⁵⁶ Cox, *supra* note 5.

¹⁵⁷ *Id.*

the Atlanta Braves amid public outcry,¹⁵⁸ then the USPTO would more likely take a similar stance to that of the NCAA in weighing this support heavily.

Moreover, there are the potential negative psychological effects that could further weigh heavily against retaining the registration of “Redskins.”¹⁵⁹ The case has been made that the term “redskins” creates an “unwelcome and hostile environment” that “directly results in lower self-esteem and mental health” for young native students.¹⁶⁰ Although this is a less frequently used argument in opposition to the term “redskins,” the evidence that Native American students aging from fifteen to twenty four have a suicide rate that is two and a half times higher than the national average cannot be ignored.¹⁶¹

Furthermore, in contrast to the poll evidence offered by Roger Goodell – although not statistically supported – and by Public Policy Polling, the general public is not entirely in accord with retention of federal registration. First, in the Public Policy Polling statistics, there are still 18% of the 741 registered voters that oppose the team keeping the name, with another 11% still undecided about the matter.¹⁶² This raises the question of, how many people need to be offended for it to be considered too many? Second, several media outlets have already stopped printing and using the name.¹⁶³ This includes NFL announcers, the people who would use the team name more than most, who used the term in 2014 27% less than they did in the 2013 regular season – a number that is likely to continue increasing.¹⁶⁴ Finally, in further support of changing the name, President Barack Obama officially stated that he would “think about changing” the name and that nostalgia

¹⁵⁸ Doug Williams, *Chief Noc-A-Homa Still a Braves Legend*, ESPN.COM (July 30, 2012, 10:59 AM), http://espn.go.com/blog/playbook/fandom/post/_id/6743/chief-noc-a-homa-still-dancing. Before each home game, Chief Noc-A-Homa, the mascot of the Atlanta Braves, would dress in a Native American costume, do a dance on the pitcher’s mound, and head out to left field where he would watch the game from a tepee. *Id.* Ultimately, due to public outcry and in an effort to eliminate criticism, the team decided to retire Chief Noc-A-Homa in January of 1986. *Id.*

¹⁵⁹ See Associated Press, *supra* note 7.

¹⁶⁰ Stegman, *supra* note 9.

¹⁶¹ *Id.*

¹⁶² Brady, *supra* note 14.

¹⁶³ Stegman, *supra* note 9.

¹⁶⁴ Burke, *supra* note 12.

may not be a good enough reason to keep the name in place when it offends a “sizable group of people.”¹⁶⁵ Taken independently, it is difficult for these pieces of evidence to prove anything. However, when looking at the grand scheme of things and combining the evidence, it is difficult to argue that a “legacy” argument supported by a general public poll outweighs the grand total of it.

CONCLUSION

In sum, it is a difficult conclusion to predict, regardless of whether the Lanham Act is to change. However, as raised by the dissent in the first *Blackhorse* decision, any evidence produced thus far in regard to the relevant 1967-1990 time period was arguably inconclusive and unreliable, simply supporting a “house of cards that collapses upon examination.”¹⁶⁶ In addition, quantitatively, there is simply not much evidence available from that time period.¹⁶⁷ The majority in *Blackhorse* essentially relied on the two dictionary definitions that labeled “redskin” offensive during the time period along with expert analysis,¹⁶⁸ the NCAI evidence dealing with the resolution that labeled “redskin” as disparaging,¹⁶⁹ and several protest letters that were written at the end or just after the relevant time period by Native Americans.¹⁷⁰ As a result, this amount of evidence pales in comparison to the evidence available in 2015 on either side of the debate, let alone the combination of both.

By using the statistical data, protests, potential psychological harms, and statements by public figures and Native American nations under this Note’s proposed amendment to the Lanham Act, the USPTO could make a much more well-informed decision as to whether to cancel the “Redskins” mark’s federal registration. Furthermore, unlike the amendment proposed by the United States House of Representatives, this amendment would provide that registrations of disparaging marks be cancelled if

¹⁶⁵ Associated Press, *supra* note 13.

¹⁶⁶ *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1115.

¹⁶⁷ *Id.* at 1118.

¹⁶⁸ *Id.* at 1118.

¹⁶⁹ *Id.* at 1098.

¹⁷⁰ *Id.* at 1104.

those marks are proven to be disparaging at the time of the attempted cancellation. Ultimately, while the result of the “Redskins” case would likely not change and the mark would still be cancelled under this improved Lanham Act, the proposed amendment would prove critical for solving these issues of disparagement as they arise.