



United States Patent and Trademark Office Cancels “Disparaging” REDSKINS Trademark Registrations

The Trademark Trial and Appeal Board (“TTAB”) issued an order on June 18 directing that six trademark registrations for REDSKINS owned by Pro-Football, Inc. (“Pro-Football”) be cancelled. In a precedential decision, the TTAB granted the petition to cancel six trademark registrations incorporating the mark REDSKINS for football-related services on the grounds that they were disparaging to Native Americans when they were registered and thus incapable of registration pursuant to 15 U.S.C. § 1052(a).

Background

Between 1967 and 1990, the United States Patent and Trademark Office (“USPTO”) issued a series of registrations to Pro-Football, which owns and operates the Washington Redskins professional football franchise, for marks consisting in whole or in part of the term “redskins” for professional football-related entertainment services, including the “Redskinettes” name used by the Washington Redskins cheerleaders.

The legal battle over these trademarks dates back to 1992, when a group of Native Americans first petitioned the TTAB to cancel the marks under Section 2 of the Lanham Act, 15 U.S.C. § 1052(a), which prohibits the registration of trademarks “which may disparage [...]

persons [...] or bring them into contempt or disrepute.”

The TTAB cancelled the trademarks, but the decision was overturned by a federal district court in 2003 based upon a finding that the TTAB lacked “substantial evidence” that the marks were disparaging and that the doctrine of laches barred the plaintiffs from bringing their claims. See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999), rev’d, 284 F. Supp. 2d 96 (D.D.C. 2003). The case was ultimately resolved only on the issue of laches. *Pro-Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009).

The *Blackhorse v. Pro-Football, Inc.* Decision

In the current case, the petitioners, a separate group of Native Americans, brought a second cancellation proceeding based largely on the same arguments used in *Harjo v. Pro-Football, Inc.*, but seeking to avoid the technicalities of the laches defense successfully asserted by Pro-Football in the previous case.

In a 2–1 decision, the TTAB held that the six REDSKINS trademarks were “disparaging to Native Americans at the respective times they were registered” and should be cancelled. See *Blackhorse v. Pro Football, Inc.*, Cancellation No. 92046185 (T.T.A.B. June 18, 2014). In determining whether a mark is disparaging, the USPTO

uses a two-part inquiry: (i) what is the likely meaning of the mark as it is used; and (ii) if that meaning refers to an identifiable group, would a “substantial composite” of the group have found the meaning disparaging at the time of registration.

The TTAB first concluded that the term “redskin” as used by the Washington Redskins is meant to refer to Native Americans. The Board specifically rejected Pro-Football’s argument that the term had a “secondary meaning” denoting a football team, finding that any such secondary meaning “has not stripped the word ‘redskins’ of its ‘ethnic’ meaning.”

The TTAB also determined that a “substantial composite” of Native Americans would have found the term “redskins” disparaging at the time the marks were registered. In reaching this conclusion, the TTAB relied heavily upon a 1993 resolution passed by the National Congress of American Indians (“NCAI”) stating that the term “has always been and continues to be a [...] disparaging and racist designation for Native American’s [sic].” The Board noted that the resolution is “clearly probative” of the views of Native Americans held during the relevant time period, especially as the NCAI represents approximately 30 percent of Native Americans. The TTAB also relied on evidence provided by petitioners regarding the increased labeling of the term as offensive by dictionaries and lexicographers, the decline in usage of the term as a reference to Native Americans, and objections from Native American groups made during the second half of the 20th century.

Ramifications of the Decision

Importantly, the TTAB decision affects only the right to register the REDSKINS marks, not the ability to use the marks. And, for now, the registrations are still in effect while the matter is on appeal. Without federal registrations, it is still possible that Pro-Football will be able to enforce the REDSKINS trademarks. Given the long and widespread use of the REDSKINS trademarks dating back to 1932, we can expect that anyone seeking to enforce these marks will argue that such common law trademark rights should be considered strong.

Should the REDSKINS trademark registrations ultimately be cancelled, Pro-Football will face additional legal hurdles in protecting and enforcing their trademarks. For example, ownership of and exclusive rights to use the marks nationwide will no longer be presumed and will have to be proven. The team will also no longer have the ability to bring a federal trademark infringement action based on registered trademarks or to recover certain types of damages such as statutory damages for counterfeiting. In addition, Pro-Football will lose the ability to have the REDSKINS registrations recorded with the U.S. Customs and Border Protection to prevent importation of infringing goods. And, of course, the federal registration symbol “®” will have to be removed from references to the marks.

Of significant interest will be the TTAB decision’s effect on the value of the REDSKINS brand. Publicly available information suggests that the Washington Redskins has been rated as one of the most valuable team franchises in the world, with the value of the REDSKINS brand estimated at well over \$100 million. The cancellation of the team’s trademark registrations may undermine licensing arrangements, especially given a misperception that cancellation of trademark registrations results in the loss of trademark rights. The brand may also become less marketable following a decision labeling it as disparaging and offensive.

Next Steps for Pro-Football

Pursuant to 15 U.S.C. § 1071, a party to a cancellation action may appeal a TTAB decision to the United States Court of Appeals for the Federal Circuit (the “Federal Circuit”) or commence a civil action in a United States District Court. The Federal Circuit reviews the decision on the record before the USPTO, but new evidence may be submitted in a civil action.

Counsel for the Washington Redskins has already indicated that it will seek review of the TTAB decision by the United States District Court for the Eastern District of Virginia, setting the case up for an ultimate appeal to the United States Court of Appeals for the Fourth Circuit. Both parties will therefore be permitted to submit additional evidence. With the critiques of the evidence set forth in the majority and dissenting opinions, further discovery and evidence in the case appear likely.

Given that the TTAB decision will be appealed, the REDSKINS registrations at issue will not be cancelled until a final decision is rendered. The appeals process could take several years, meaning that a final decision on the issue is not likely in the near future. It is clear from the 81-page majority opinion issued by the TTAB, however, that the majority intended to rely upon “substantial evidence” of disparagement to avoid being overturned again by a district court on appeal.

Final Thoughts

The legal battle over the REDSKINS trademarks is ongoing in the legislative arena as well. In 2013, Representative Eni Faleomavaega (D–Am. Samoa) introduced the Non-Disparagement of Native American Persons or Peoples in Trademark Registrations Act of 2013 (H.R. 1278) into the House of Representatives. The bill prohibits “the disparagement of Native American persons or peoples through trademarks that use the term ‘redskin’” and would amend the Lanham Act to require cancellation of any existing trademark registrations containing the term “redskin.” Moreover, just last month, 50 U.S. senators signed a letter to the NFL Commissioner urging the NFL to endorse a name change for the team. The general manager of the Washington Redskins immediately responded that the name had a purposeful meaning and that the majority of Americans were in favor of keeping the team name.

There have been several cases involving disparagement as a basis for cancellation in the last several months. For example, the TTAB’s REDSKINS decision comes on the heels of the Federal Circuit affirming the refusal of a trademark application for STOP THE ISLAMISATION OF AMERICA as disparaging matter under § 2(a). *In re Geller*, 2014 U.S. App. LEXIS 8867 (Fed. Cir. May 13, 2014). It also follows the TTAB’s ruling last year refusing to register THE SLANTS for the applicant’s band name, determining the name was derived from an ethnic slur that was disparaging to persons of Asian descent. *In re Simon Shiao Tam*, 108 U.S.P.Q.2d 1305 (T.T.A.B. 2013). These cases, however, do not involve marks with the same type of history and brand value of the REDSKINS.

The decision offers valuable lessons for challenging a disparaging mark and responding to such a challenge. First, it is important to consider the meaning of the mark, and whether the mark suggests a meaning other than the referenced group. The TTAB rejected Pro-Football’s argument that REDSKINS had a secondary or alternate meaning as the name of a football team, finding that the evidence, including registrations with Native American imagery and prominence of a Native American in logos on team gear, showed the mark retained the meaning of Native Americans. However, an allegedly disparaging mark may have a separate meaning when applied to the relevant goods or services, such as a well-known geographical location.

It must also be established that a “substantial composite” of the referenced group views the mark as disparaging. As the *Blackhorse* decision makes clear, a “substantial composite” does not necessarily involve a majority of the referenced group, and 30 percent of the group is sufficient to be a “substantial composite.” These views are measured as of the date of the registration of the mark at issue. Thus, for registrants of potentially disparaging marks, it is important to collect and maintain information that would demonstrate a mark was not considered disparaging at the time of registration. For challengers, evidence that the mark was disparaging at the time of registration is vitally important.

Finally, the majority relied heavily on evidence of how the term “redskins” was labeled in dictionary definitions, as well as how the term was used in the popular media. Thus, evidence as to whether a dictionary entry for the term includes a label—such as “offensive,” “disparaging,” or “contemptuous”—reveals how the mark is widely viewed. Further, evidence of a decrease or increase in the usage of a mark for the referenced group in media provides strong evidence as to whether it is considered a disparaging term.

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