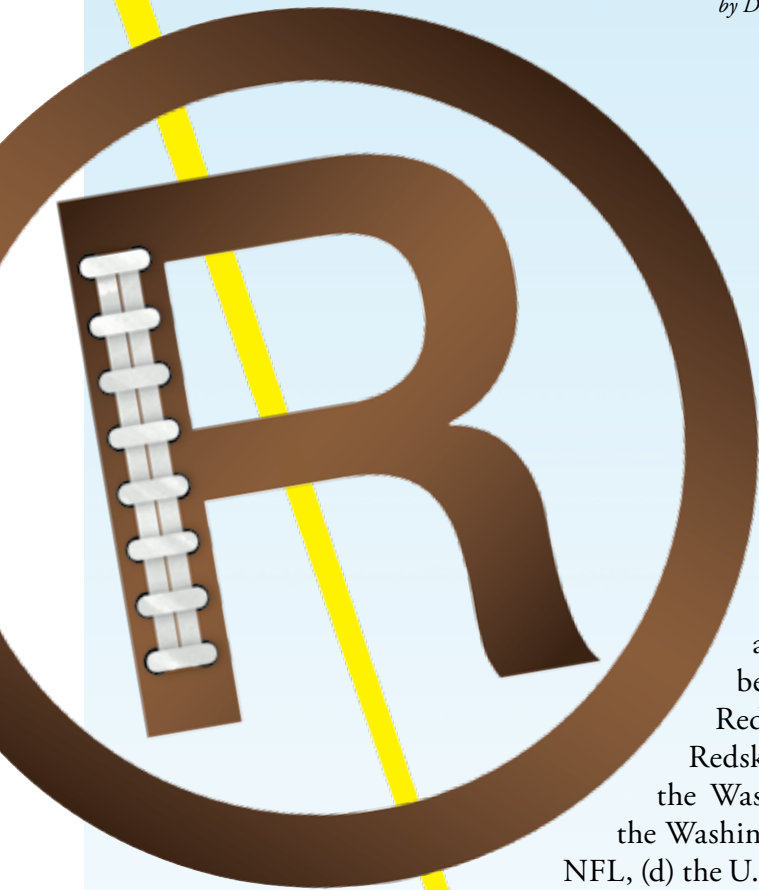


FOOTBALL FANS AND TRADEMARKS

by DAVID BAKER



If you've been living in a cave the last few months, then you probably haven't heard about the cancellation of the Washington Redskins' federal trademark registrations for the word REDSKINS. The cancellation of the NFL team's trademarks was based on a determination that the term REDSKINS is "disparaging" to Native Americans.

On the other hand, if you haven't been living in a cave, but you simply didn't bother to pay close attention to the media hysteria about what happened, then you may have been led to believe that (a) the Washington Redskins can't call themselves the Washington Redskins anymore for fear of being arrested, (b) the Washington Redskins are out of business, (c) the Washington Redskins have been kicked out of the NFL, (d) the U.S. Supreme Court should have better things to do with its time, or (e) all of the above. Well, as a matter of fact, none of these things actually resulted from the decision (I'll leave it to you to decide how the Supreme Court should

spend its time).

Here's what really happened and why it should be of interest to you.

On June 18, the Trademark Trial and Appeal Board (TTAB) issued a ruling in the TTAB case of *Blackhorse v. Pro Football, Inc.* (TTAB Cancellation No. 92046185) *cancelling* the federal registrations for the REDSKINS trademarks based on section 2(a) of the Trademark Act (15 U.S.C. § 1052(a)), more commonly known as the "Lanham Act." Specifically, section 2(a) prohibits its federal registration of any trademark that: "consists 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."

The TTAB is the federal administrative branch of the U.S. Patent and Trademark Office (PTO) that has jurisdiction over trademark disputes, especially those disputes involving the question of whether or not a particular mark may be issued federal registration in the United States. A cancellation proceeding is essentially an adversarial administrative proceeding in which a third party requests the TTAB to revoke or cancel a prior federal trademark registration over the objections of the owner of the registered mark. Such proceedings commonly are based on fraud, but, in this instance, it was based on the alleged disparagement of Native Americans.

It should be noted that in challenging the propriety of an existing trademark registration, the TTAB is tasked with trying to determine if the grounds for cancellation existed at the time of the original registration(s) of the mark(s) in dispute.

Pro Football, Inc., the corporation that owns the Washington Redskins football franchise as well as the REDSKINS trademarks associated with the team, first applied for registration of trademarks using the term REDSKINS in 1966. Consequently, when it issued its June ruling, the TTAB had to determine if REDSKINS was considered derogatory within the meaning of the Lanham Act beginning in 1967. It also had to consider whether or not the term was derogatory when additional REDSKINS marks using REDSKINS were registered

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in subsequent years (1967 to 1990). Admittedly, this was no easy task.

This wasn't the first time the issue had been presented for consideration. Litigation involving the REDSKINS trademark registrations dates back to 1992, when a small group of Native Americans filed a cancellation action against the same six trademarks now at issue (including both REDSKINS and REDSKINETTES, the name for the team's cheerleading squad).

In that earlier action, the TTAB found the marks to be disparaging at the time of registration and even-

tually issued a cancellation order in 1999. However, the U.S. District Court for the District of Columbia disagreed and overturned the cancellation order based on its determination that the TTAB's finding of disparagement was "not supported by substantial evidence" and that the doctrine of laches precluded consideration of the disparagement claim. On appeal, the U.S. Court of Appeals affirmed the lower court ruling only on the basis of laches.

Dissatisfied with the outcome of the earlier litigation, another group of Native Americans filed suit in 2006, again arguing that REDSKINS is derogatory and, as such, should be grounds for the cancellation of all the team's registered trademarks. And, as it did in its earlier ruling, the TTAB once again used a two-pronged test to decide the issue of disparagement as follows:

1. 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?

2. Is the meaning of the marks one that may disparage Native Americans?

The TTAB looked to expert reports and testimony, dictionary definitions and reference books, as well as deposition testimony, newspaper articles, reports, official records, letters of protest, and the National Congress of American Indians' (NCA) 1993 Resolution 93-11 before it determined that (a) the NFL team has always used REDSKINS as a reference to Native Americans, and (b) Native Americans, by and large, consider the term derogatory. It then issued its controversial cancellation order on June 18, 2014.

However, anticipating the controversy and recognizing the need to educate the media about what they

had done, the PTO took the extraordinary step of also issuing a “Media Fact Sheet” which attempts to explain some of the fundamental underlying concepts and likely effects of the decision. For example, the Media Fact Sheet explains:

- The decision does not require the football team to change its name or stop using the trademarks at issue in the case;
- Losing the federal registration of a trademark does not necessarily mean that the owner of the team loses all legal rights in the mark because U.S. trademark rights come from use of a mark on or in conjunction with goods or services, not just from federal registration;
- The TTAB determines only whether a mark can be registered with the federal government, not whether it can be used; and
- The football team may still have rights in the mark based on use, known as “common law” rights, and those rights may continue to exist even after cancellation of federal registration.

Of course, if the registration cancellation is not appealed, or if affirmed following review by a federal court, Pro Football, Inc. will lose the legal benefits conferred by federal registration of the marks. These benefits include:

- The legal presumptions of ownership and of a nationwide scope of rights in these trademarks;
- The ability to use the federal registration ® symbol; and
- The ability to record the registrations with the U.S. Customs and Border Patrol Service in order to block the importation of infringing or counterfeit foreign goods.

These explanatory points were largely ignored by various media in the rush to politicize the issue and to cover the reactions of politicians scrambling to their respective sides of political correctness. Instead, the media covered the political grandstanding and television network pandering while they ignored critical issues of free speech and First Amendment rights.

It is also likely you heard nothing of dissenting Administrative Trademark Judge, Marc Bergsman, who explained his dissent as follows:

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 provisions of the statute under which the Board must decide this case—Sections 2(a) and 14(3) of the Trademark Act 15 U.S.C. Section 1052(a) and 1064(3)—require us

to answer a much narrower, legal question: 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.

Further, Judge Bergsman found it compelling that the evidence presented in the current proceeding was virtually identical to that presented in the 1992 proceeding and, as such, remained “insufficient” to support cancellation.

To no one’s surprise, Pro Football, Inc. has vowed to appeal the decision, this time to the U.S. District Court

for the Eastern District of Virginia, and many commentators and trademark pundits already predict the TTAB cancellation order will be overturned. And, of course, the filing of an appeal will stay the enforcement of the order for the duration of the appellate proceeding, resulting in (you guessed it) no change whatsoever in the registration status of the REDSKINS trademarks.

At the end of the day, it is important to understand that even if the appeal is unsuccessful and the federal registrations for all of the REDSKINS trademarks eventually are cancelled, Pro Football, Inc. can still choose to call its team the Washington Redskins, and can still enforce its trademarks against anyone who infringes them. But the much larger issues found in the intersection of First Amendment rights in commercial speech will remain regardless of the outcome.



ON POINT
The decision does not require the football team to change its name.

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