

TRADEMARK TALK



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Foul play over US trademark

The Washington Redskins name has attracted fierce debate over the years. **Edward Lee** and **Douglas Masters**, attorneys at Loeb & Loeb, discuss the latest attempt to revoke the mark

US trademark law prohibits the registration of a trademark that “[c]onsists of or comprises immoral, deceptive, or scandalous matter which may disparage... persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute...”

Companies wanting to assure themselves that a brand will not be denied protection under this provision, or worse yet, be taken away years later, struggle with the idiosyncratic application of this law. How do you evaluate whether a mark is too offensive, provocative, or in such bad taste that it cannot be federally protected? To whom does the mark have to be offensive? Is it permissible to offend only a certain group of people? Or some portion of a group of people? And how does a trademark owner make sure it can defend its brand in the future given that such a challenge has no statute of limitations?

These are some of the questions at issue in a long running dispute between Native Americans and the Washington DC professional football team known as the ‘Redskins’, where a ruling is expected later this year.

The first decision that a mark was disparaging involved the attempted registration of ‘Dough-boy’ for “a prophylactic preparation for the prevention of venereal diseases”. While Dough-boy was not scandalous or disparaging *per se*, registration was refused because it was deemed disparaging to American soldiers, called doughboys during World War I. Cases

shed little light on contours of this provision until the 1990s when a group of Native Americans, led by Suzan Harjo, sought cancellation of the Redskins marks as disparaging to Native Americans. They met with initial success, but ultimately were denied cancellation due to procedural obstacles. A second attack on these registrations by another group of Native Americans was recently argued and is pending decision.

In *Harjo*, to determine whether a mark may be disparaging, the Trademark Trial and Appeal Board applied a two-part test: (1) “The likely meaning of the matter in question” and (2) “Whether, in view of the likely meaning, the matter ‘may disparage’ the referenced group”. This inquiry was distinguished from the test for “scandalous” marks, for which the second question would ask whether the matter would offend a substantial composite of the general public.

The Board concluded that Redskins may be disparaging of Native Americans to a substantial composite of Native Americans. However, by the same evidence that showed widespread use of Redskins to refer to Respondent’s football team, the Board concluded that Redskins was not scandalous to a substantial composite of the general public. The marks were ordered to be cancelled.

The parties disputed the significance of the decline in use of Redskins after the 1950s, with the respondent arguing that Redskins only connoted the football team, and petitioners arguing that the term had fallen out of favor

due to its offensiveness. The Board agreed with Petitioners.

Petitioners also presented a survey inquiring whether Redskins was considered offensive. The Board found the survey “relevant” but noted that a better survey would have studied perceptions of Redskins at the time of the registrations (1967-1990), or whether the use of Redskins for the football team was offensive. In other words, disparagement must be measured at the time of the application, and as used for the goods or services offered. Regardless, due to the “significant” percentage of participants who found Redskins offensive to Native Americans in 1996, the Board found that the survey supported petitioners.

Petitioners also offered testimony from individuals and expert witnesses on history, linguistics, and social sciences who found the term disparaging. The Board considered this testimony despite being outside of the relevant time period, reasoning that the word’s significance before and after the relevant period “may shed light” on the relevant periods.

Respondent argued that the marks acquired secondary meaning through widespread use since 1933, and were thus associated with the football team and “could not be understood to refer to the petitioners”. Furthermore, respondent argued that Redskins was neutral and denotative, synonymous with Native American or American Indian, and that it did not intend to disparage Native Americans.

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The Board found that intent, or lack thereof, may be relevant but not dispositive.

On appeal, the District Court granted summary judgment to respondent, holding that (1) the Board's conclusion that Redskins may disparage generally could not extend to its use in connection with respondent's football team, and that petitioners had failed to present sufficient evidence that the marks were disparaging at the time of registration; and (2) The petitioners' challenge was barred by laches.

First, the court held that the Board lacked sufficient evidence to find that Redskins may disparage a substantial composite of Native Americans as used for respondent's football team, as the survey did not ask whether Redskins was offensive when used in connection with a football team, nor did it inquire as to whether Redskins was offensive at the time of registration.

The court also rejected the Board's conclusion that the drop-off in usage of Redskins was due to pejorative meaning. As there was conflicting evidence of why Redskins had decreased in use, and the board had not made a finding of fact regarding this conflict, the board's finding was not supported by the evidence. Nor could this decline in use, even if reflecting public opinion, be extrapolated to stand for the opinions of Native Americans.

Secondly, the court held that petitioners impermissibly delayed in seeking cancellation, since the first mark was registered in 1967, yet Petitioners' waited twenty-five years to challenge the registration. During that time, respondent expended significant resources investing in its marks, and were thus greatly prejudiced by Petitioners' unjustified delay. Accordingly, laches barred the petition.

On appeal, the circuit court held that laches was inappropriately applied to one petitioner, who was only one year old in 1967. The clock for laches, and thus any delay in bringing suit, could not begin until the petitioner had reached the age of majority.

Respondent argued that such a ruling would lead to perpetual insecurity in its trademark since new claimants could be born every day. The court rejected this argument, stating that the legislature's refusal to include a statute of limitations may have been to discourage the use of such marks. In other words, it is respondent's choice to continue using a mark that may disparage an ever-increasing population.

Ultimately, the last *Harjo* petitioner's claims were also denied for laches, as even the youngest petitioner waited two years before bringing suit.

The *Harjo* two-part test was later applied to an application for 'Squaw' on ski clothing; squaw being a pejorative term for Native American women. The Board held that the word squaw when used on applicant's products connoted the Squaw Valley ski resort in California, and not Native American women. Since the "likely meaning" of the mark was a ski resort, the board did not assess the second prong – whether the mark may have been disparaging to Native American women.

In 2006, while the appeal of *Harjo* was pending, a second action was brought by five younger Native Americans, led by Amanda Blackhorse. The parties agreed that the *Harjo* evidence would serve as the record in *Blackhorse*. Proceedings were suspended in *Blackhorse* until March 2010, pending *Harjo*'s final resolution.

The trial evidence in the *Blackhorse* case illustrates the difficulty in both proving and defending against this type of claim. Petitioners' trial brief reviewed the evidence presented in *Harjo*, including that only 36.6% of Native Americans surveyed were personally offended by *Redskin*, and 60.3% of Native Americans surveyed perceived *Redskin* to be offensive to others. These figures stand in contrast to petitioners' arguments that Redskins for a football team would be as offensive as any other racial slur.

This argument has recurred throughout the Redskins litigation – how many Native Americans must find Redskins disparaging in order to deny registration? This inquiry highlights the distinction between whether a mark "may disparage" Native Americans, as opposed to whether a word is scandalous to the entire public, and illustrates that trademarks may be offensive to a subset of the American population yet still be allowed federal registration.

In opposition, respondent argued that there was insufficient evidence that a substantial composite of Native Americans were offended by Redskins at the relevant time period, despite the fact that "some non-representative fraction of Native Americans *today* wish the team name to be changed". In essence, even if a trademark becomes disparaging over time, such changing sensibilities should not affect its federal registration status.

Similarly, respondent argued that other Native Americans supported the use of Redskins for the football team because it symbolized "strength, virility and courage", and even used *Redskin* for street and business names on Native American reservations. This raises the question of "who" or "how many" of a group must be offended in order for a mark to be denied registration.

Respondent noted that petitioners' evidence pertained, at best, to Redskins in general, not as used for respondent's football team. To that point, respondent pointed out petitioners' expert testimony that *Redskin* was not offensive when used for a motorcycle. So again, since the word may have been disparaging only to some Native Americans and not the public, it should be viewed in light of its use in connection with a football team.

Respondent also referred to the approval of the Redskins marks by the United States Patent and Trademark Office as evidence of social acceptance of the marks at the relevant periods. While petitioners claimed this was circular logic (that the marks were registered is not evidence that they should have been registered), this seems a persuasive argument since the Board may reject applications *ex parte* if the examiner deems the trademark disparaging or scandalous.

All of these cases behoove a trademark applicant to consider when adopting a mark whether it may be disparaging to some group of people then or in the future. *Harjo* established that, if a trademark becomes disparaging even decades after its adoption and registration, it can be subject to attack (albeit viewed from when it was registered). Even if the Redskins marks survive *Blackhorse*, the process for its registrant has been arduous, and may happen again.

Regardless of whether a mark may be disparaging to a certain group of people, or scandalous to the general public, there remain business concerns with using a mark that some may find offensive. Even if the Redskins marks are cancelled, their owners may continue to use them in light of their common law rights. But if the board has deemed Redskins too disparaging for federal registration, is it wise to essentially deem the disparaged group too marginal to warrant rebranding? In light of the Washington Redskins' success for over eighty years, that may be the case.