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**BLACKHORSE’S LAST STAND?: THE FIRST AMENDMENT  
BATTLE AGAINST THE WASHINGTON “REDSKINS”  
TRADEMARK AFTER MATAL V. TAM**

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## ABSTRACT

*On September 7, 2018, the United States Patent and Trademark Office (USPTO) reopened questions affecting the Washington “Redskins” trademark when it filed a Supreme Court cert petition concerning the constitutionality of the Lanham Act’s “immoral or scandalous” clause. Previously, in 2014, Amanda Blackhorse and several other Native Americans succeeded in getting six federal registrations of the Washington “Redskins” trademark cancelled. The Eastern District of Virginia agreed with Blackhorse that the term “Redskins” was disparaging to Native Americans in violation of the Lanham Act’s “disparagement” clause. However, after the Supreme Court held in *Matal v. Tam* that the “disparagement” clause was unconstitutional, the Fourth Circuit vacated the order of the Eastern District of Virginia, and the trademark suit against the “Redskins” was dropped. But now that the Supreme Court granted the USPTO’s cert petition in *In re Brunetti* on January 4, 2019, the “Redskins” trademark may again face the question of whether it violates the Lanham Act. That is, can the “Redskins” trademark get re-cancelled, not for being disparaging, but for being immoral or scandalous? Although the Supreme Court has yet to answer this question, plaintiffs like Blackhorse face the following obstacles in their battle against the “Redskins” trademark: (1) it is unclear whether the term “Redskins” meets the traditional definition of the words “immoral or scandalous”; (2) the method of analyzing terms under the “immoral or scandalous” clause comes dangerously close to committing what caused the “disparagement” clause to get struck down in *Tam*; and (3) as a matter of public policy, courts have been cautious to avoid rulings that would upset the “marketplace of ideas” in the realm of trademarks. These obstacles, however, might be overcome if the term is shown to be vulgar, obscene, or shocking to the sense of truth, decency or propriety to a substantial composite of the general population.*

## I. INTRODUCTION

On June 18, 2014, Amanda Blackhorse and several other Native Americans succeeded in getting six federal registrations of the Washington “Redskins” trademark cancelled.<sup>1</sup> The Trademark Trial and Appeal Board (TTAB) in *Blackhorse v. Pro-Football, Inc.*<sup>2</sup> and the

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<sup>1</sup> *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080, 1082 (T.T.A.B. 2014) (“[T]hese registrations must be cancelled because they were disparaging to Native Americans at the respective times they were registered, in violation of Section 2(a) of the Trademark Act of 1946 . . .”).

<sup>2</sup> *Id.*

Eastern District of Virginia in *Pro-Football, Inc. v. Blackhorse*<sup>3</sup> agreed with Blackhorse that the term “Redskins” violated Section 2(a) of the Lanham Act.<sup>4</sup> Specifically, the courts found that the term consisted of “matter which may disparage” Native Americans, after reviewing editorial and scholarly sources that equated the term “Redskins” with “savageness,” “subhuman brutality,” and a “racial epithet” as derogatory to Native Americans as the “K-word” is to Jews and the “N-word” is to African Americans.<sup>5</sup>

However, on June 19, 2017, Blackhorse’s battle against the “Redskins” came to a stop when the Supreme Court held in *Matal v. Tam* that the “disparagement” clause of the Lanham Act was unconstitutional.<sup>6</sup> Pursuant to two opinions authored by Justice Alito and Justice Kennedy, the justices reasoned that because the “disparagement” clause discriminated against certain trademarks based on viewpoint, it violated the Free Speech Clause of the First Amendment.<sup>7</sup> Although some individuals might find the mark “offensive,” the giving of an offense, according to Justice Alito, is a viewpoint that is constitutionally protected.<sup>8</sup> Following the Court’s decision in *Tam*, the Fourth Circuit vacated the district court’s order in *Pro-Football, Inc. v. Blackhorse* and remanded for further proceedings consistent with *Tam*.<sup>9</sup> Disheartened by the Supreme Court’s ruling,

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<sup>3</sup> 112 F. Supp. 3d 439 (E.D. Va. 2015).

<sup>4</sup> Section 2(a) of the Lanham Act states: “No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) 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 . . .” 15 U.S.C. § 1052 (2012); see *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 490 (E.D. Va. 2015) (affirming the TTAB’s ruling in *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1080, that the “Redskins” trademark violated Section 2(a) of the Lanham Act).

<sup>5</sup> *Pro-Football, Inc.*, 112 F. Supp. 3d at 448 (ruling in favor of Blackhorse’s claim that the “Redskins” trademark “may disparage” Native Americans); *Blackhorse*, 111 U.S.P.Q.2d (BNA) at 1111–12 (holding that “a substantial composite of Native Americans found the term REDSKINS to be disparaging”).

<sup>6</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017) (holding that the Lanham Act’s “disparagement” clause violates the Free Speech Clause of the First Amendment).

<sup>7</sup> *Id.* at 1763 (“[I]n the sense relevant here, that is viewpoint discrimination: Giving offense is a viewpoint.”); *id.* at 1765 (Kennedy, J., concurring) (“As the Court is correct to hold, §1052(a) constitutes viewpoint discrimination—a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny.”).

<sup>8</sup> *Id.* at 1763.

<sup>9</sup> *Pro-Football, Inc. v. Blackhorse*, 709 F. App’x. 182, 183–84 (4th Cir. 2018) (vacating the district court’s order and remanding for further proceedings consistent with *Tam*).

Blackhorse withdrew her trademark suit against the Washington Redskins, but nevertheless vowed that “the fight is not over.”<sup>10</sup>

Although the “fight” against the Washington Redskins appeared all but over after *Tam*, the Supreme Court reopened questions affecting the “Redskins” trademark when it granted the cert petition of the United States Patent and Trademark Office (USPTO) concerning the constitutionality of the Lanham Act’s “immoral or scandalous” clause.<sup>11</sup> A big question now is whether *Tam* invalidated all of Section 2(a) of the Lanham Act including the “immoral or scandalous” clause, or only part of it, namely the “disparagement” clause? Can the USPTO cancel the “Redskins” trademark this time for being “immoral” or “scandalous” instead of “disparaging”? Where does the Lanham Act’s “immoral or scandalous” clause fit within the Supreme Court’s First Amendment jurisprudence? Although the Supreme Court has yet to answer these questions, the subject matter has been a hot topic of debate.

From one perspective, the trademark battle *is* over because, following the Supreme Court’s holding in *Tam*, both the “derogatory” and “immoral/scandalous” provisions of the Lanham Act have no constitutional basis.<sup>12</sup> Judge Moore’s majority opinion in the 2017 Federal Circuit case *In re Brunetti* essentially adopted this position.<sup>13</sup> From another perspective, the fight is *not* over because the Supreme Court’s holding in *Tam* invalidated only a part of Section 2(a), namely the “disparagement” clause, while the rest of Section 2(a) remains in effect.<sup>14</sup> The USPTO currently maintains this view and has continued to evaluate trademark applications under the “immoral or scandalous” provision.<sup>15</sup> Judge Dyk similarly suggested in his concurring opinion

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<sup>10</sup> Nathan J. Fish, *Advocates to Fight Washington Team’s Name, Despite Court Ruling in Similar Case*, CRONKITE NEWS (June 20, 2017), <https://www.dailyyonder.com/advocates-fight-redskins-name-despite-court-ruling-similar-case/2017/06/20/19964/>.

<sup>11</sup> See *Iancu v. Brunetti*, No. 18-302, 2019 U.S. LEXIS 2, \*1 (2019); see also Petition for Writ of Certiorari, *In re Brunetti*, 15 U.S.L.W. 1109 (2018) (No. 18-302).

<sup>12</sup> See *In re Brunetti*, 877 F.3d 1330, 1341 (Fed. Cir. 2017) (following the Supreme Court’s decision in *Matal v. Tam* to conclude that the Lanham Act’s “immoral or scandalous” clause is unconstitutional, despite the government’s argument that *Tam* did not resolve the constitutionality of that clause).

<sup>13</sup> *Id.*

<sup>14</sup> See Petition for Writ of Certiorari at 12, *In re Brunetti*, 15 U.S.L.W. 1109 (2018) (No. 18-302). (claiming that the Supreme Court’s holding in *Matal v. Tam* is not controlling in its case concerning the constitutionality of the “immoral or scandalous” clause).

<sup>15</sup> United States Patent and Trademark Office, *Trademark Alert: New Examination Guide Issued on Section 2(a) after Matal v. Tam*, USPTO SUBSCRIPTION CENTER (June 26, 2017, 4:46 PM), <https://content.govdelivery.com/accounts/USPTO/bulletins/1a57a0f> (stating in

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in *In re Brunetti* that some aspects of the “immoral or scandalous” clause are still valid.<sup>16</sup> Furthermore, aside from these two perspectives, others have commented on the “Redskins” trademark issue outside the context of trademark law. For example, one commentator has claimed that the “Redskins” trademark should be discontinued for reasons grounded in dignity and morality.<sup>17</sup> Meanwhile, another commentator has argued that market forces and consumer preferences will determine whether the term is so “scandalous” that it should be discontinued for monetary purposes.<sup>18</sup>

This Comment attempts to join this debate by arguing that it will be difficult in the short term to legally prove that the meaning of the term “Redskins” is “immoral or scandalous.” However, if more evidence is gathered that the meaning of “Redskins” is “shocking to the sense of truth, decency or propriety” to a “substantial composite of the general population,” there will be greater grounds for courts to hold that the term is “immoral” or “scandalous.” This Comment proceeds in Part II with a historical review of the trademark battle involving Blackhorse, the Washington Redskins, and the Lanham Act. Part III analyzes *Matal v. Tam* and *In re Brunetti* and their effects on Blackhorse’s trademark suit against the “Redskins.” Part IV evaluates whether the “Redskins” trademark can be cancelled for being “immoral” or “scandalous” under the Lanham Act. Finally, Part V concludes with a review of the implications and recommendations of this study to plaintiffs like Blackhorse.

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Examination Guide 2-18 that the USPTO will continue to “examine applications for compliance with the scandalousness provision while the constitutionality of the provision remains subject to potential U.S. Supreme Court review”).

<sup>16</sup> *Brunetti*, 877 F.3d at 1359 (Dyk, J., concurring) (“[W]e can appropriately narrow the immoral-scandalous provision’s scope to obscene marks in order to preserve its constitutionality, and we are obligated to do so.”).

<sup>17</sup> Victoria Phillips, *Dignity Takings and Dignity Restoration Beyond Trademark: The Washington Redskins Case and the Search for Dignity*, 92 CHI.-KENT L. REV. 1061, 1086 (2018) (arguing that the federal registration of the “Redskins” trademark “make[s] clear that the harm done to the Native community is very real and rises to the level of a dignity taking”).

<sup>18</sup> Jake MacKay, Article, *Racist Trademarks and Consumer Activism: How the Market Takes Care of Business*, 42 LAW & PSYCHOL. REV. 131, 147 (2018) (“Companies should be allowed to register racist or derogatory trademarks under federal law, and those trademarks should be protected like any other. Any issues of indecency or harm that arise from negative, derogatory trademarks or other hate speech will be solved by consumers in a free marketplace, who will make decisions not to purchase goods that have trademarks that are unacceptable.”).

*continued . . .*

## II. HISTORICAL BACKGROUND OF THE TRADEMARK BATTLE AGAINST THE WASHINGTON REDSKINS

Although Amanda Blackhorse is known for having challenged the Washington “Redskins” trademark beginning in 2006, the first legal battle against the team took place approximately twelve years prior in *Harjo v. Pro Football, Inc.*<sup>19</sup> Because *Blackhorse* incorporated findings of fact from *Harjo*,<sup>20</sup> any study of *Blackhorse* must begin with a review of *Harjo*.

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

On September 10, 1992, Suzan Harjo and six other Native Americans filed a petition to cancel six federal registrations of the Washington “Redskins” trademark on the grounds that they violated Section 2(a) of the Lanham Act.<sup>21</sup> Specifically, Harjo claimed that the “Redskins” trademarks (1) “consist[ed] of or comprise[d] matter which disparage Native American persons, and [brought] them into contempt, ridicule, and disrepute,” and that (2) the “marks consist[ed] of or comprise[d] scandalous matter.”<sup>22</sup> In response, Pro Football denied Harjo’s claims and asserted eleven affirmative defenses, including laches.<sup>23</sup> The Trademark Trial and Appeal Board (TTAB) denied all of Pro Football’s affirmative defenses and held that the “Redskins” trademark was “disparaging” to Native Americans.<sup>24</sup> Although the TTAB’s finding of disparagement was enough to get the registrations cancelled,<sup>25</sup> the TTAB included in its holding that the “Redskins” trademark did not consist of “scandalous matter.”<sup>26</sup>

To determine whether the term “Redskins” was “scandalous,” the TTAB applied a two-step test from *In re Mavety Media Group Ltd.*<sup>27</sup> First, the TTAB determined the likely meaning of the term based on considerations of the term in relation to (i) “any other element that makes up the mark in its entirety” and (ii) the “goods and/or services and the manner in which the mark is used in the marketplace in

<sup>19</sup> *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999).

<sup>20</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 451 (E.D. Va. 2015) (applying findings of fact from *Harjo*, 50 U.S.P.Q.2d (BNA) at 1705, after the parties agreed that the entire *Harjo* record could be entered into evidence).

<sup>21</sup> *Harjo*, 50 U.S.P.Q.2d (BNA) at 1705 n.1.

<sup>22</sup> *Id.* at 1708.

<sup>23</sup> *Id.* at 1708 n.11.

<sup>24</sup> *Id.* at 1743.

<sup>25</sup> *Id.*

<sup>26</sup> *Id.* at 1748–49.

<sup>27</sup> *Id.* at 1748.

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connection with those goods and/or services.”<sup>28</sup> Second, the TTAB determined whether the term “Redskins” was “scandalous to a substantial composite of the general public.”<sup>29</sup> A term is “scandalous” to a “substantial composite” of the general public if enough members of the public, who do not necessarily make up a majority,<sup>30</sup> find the term “shocking to the sense of truth, decency, or propriety” or “offens[ive] to the conscious or moral feelings.”<sup>31</sup> As to the first step, the TTAB determined that the likely meaning of the term “Redskins,” as used by the Washington Redskins football team, “clearly carri[e]d the allusion to Native Americans.”<sup>32</sup> As to the second step, the TTAB determined that the term was not “scandalous” to a substantial composite of the general public during the relevant time periods.<sup>33</sup> The TTAB reasoned that due to the “continuous renown in the sport of football and acceptance of the word “Redskin(s)” in connection with [the] football team,” it would be inconsistent to find that the term was “shocking to the sense of truth, decency, or propriety” to, or “offens[ive] to the conscious or moral feelings [of], a substantial composite of the general population.”<sup>34</sup>

But because the TTAB accepted Harjo’s alternative claim that the term was “disparaging,” the TTAB entered judgment for the six registrations to be cancelled.<sup>35</sup> According to the TTAB, the term “Redskins” was “disparaging” to Native Americans because, as of the relevant times, a substantial composite of Native Americans perceived the term as “derogatory.”<sup>36</sup> The TTAB based its decision on findings from dictionaries, encyclopedias, graphics, and newspapers, which portrayed Native Americans in an especially pejorative manner up until the 1960s.<sup>37</sup> Although those sources eventually began to restrain their use of Native American imagery, many of them still portrayed Native Americans in connection with the Washington Redskins as either “aggressive savages” or “buffoons.”<sup>38</sup> Statements from Native American groups, such as the National Congress of American Indians

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<sup>28</sup> *Id.* at 1736.

<sup>29</sup> *Id.*

<sup>30</sup> *Id.* at 1746; *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 485 (E.D. Va. 2015).

<sup>31</sup> *Harjo*, 50 U.S.P.Q.2d (BNA) at 1735 (citing *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981)).

<sup>32</sup> *Id.* at 1742.

<sup>33</sup> *Id.* at 1748–49.

<sup>34</sup> *Id.* at 1749.

<sup>35</sup> *Id.* at 1743.

<sup>36</sup> *Id.*

<sup>37</sup> *Id.* at 1744.

<sup>38</sup> *Id.* at 1747.

(NCAI) and the Oneida Tribe, also indicated that a substantial number of Native Americans found the term offensive.<sup>39</sup> Taken together, the media publications, dictionary definitions, and individual statements were compelling enough for the TTAB to conclude that the “Redskins” trademark violated the “disparagement” clause of the Lanham Act.<sup>40</sup>

On appeal, the United States District Court of the District of Columbia reversed the TTAB for two reasons. First, the district court found that the TTAB’s finding of disparagement was unsubstantiated because the evidence demonstrated that the term “Redskins” was viewed not solely as a sign of derogation but often as a sign of respect.<sup>41</sup> At best, the evidence demonstrated that Pro-Football’s fans and the media have *not always* equated the Washington Redskins with Native Americans in a respectful manner.<sup>42</sup> Second, the district court ruled that “the doctrine of laches preclude[d] consideration of the case” because Harjo’s delay in bringing suit was unreasonable and prejudicial to Pro-Football.<sup>43</sup> Given that the first “Redskins” trademark was registered in the 1960s, the court determined that an approximately twenty year “delay” in bringing suit was “substantial” and “economically prejudicial” to the football team.<sup>44</sup> On appeal, the D.C. Circuit affirmed the district court’s ruling that laches barred the claim, but did not address the TTAB’s finding of disparagement on the merits.<sup>45</sup> The D.C. Circuit also was not presented with the question of whether the “Redskins” trademark was “immoral” or “scandalous.”<sup>46</sup> Thus, by the time Amanda Blackhorse filed her trademark suit against the Washington Redskins in 2006, the question of whether the “Redskins” trademark violated the Lanham Act’s “disparagement” clause or “immoral or scandalous” clause was never answered at the federal circuit court level.

## **B. Blackhorse v. Pro-Football, Inc**

On August 11, 2006, while Harjo was pending, Amanda Blackhorse and four members of other Native American tribes filed a petition in *Blackhorse v. Pro-Football, Inc.* to cancel the same six registrations of

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<sup>39</sup> *Id.*

<sup>40</sup> *Id.*

<sup>41</sup> *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 134 (D.D.C. 2003).

<sup>42</sup> *Id.* (emphasis added).

<sup>43</sup> *Id.* at 145.

<sup>44</sup> *Id.* at 143–44.

<sup>45</sup> *Pro-Football, Inc. v. Harjo*, 565 F.3d 880, 881 (D.C. Cir. 2009).

<sup>46</sup> *Id.* (limiting its case to the issue of whether the district court improperly assessed evidence of prejudice in applying laches to the facts at issue).



the Washington “Redskins” trademark.<sup>47</sup> After reviewing the evidence, the TTAB denied Pro-Football’s laches defense and again ordered, like it did in *Harjo*, for the registrations to be cancelled for violating the Lanham Act’s “disparaging” clause.<sup>48</sup> The TTAB ruled that the laches defense did not apply because, as an equitable defense, laches would not serve the broader “public interest in removing from the register marks that are disparaging to a segment of the population beyond the individual petitioners.”<sup>49</sup> Although the D.C. Circuit previously held in *Harjo* that laches barred “disparagement” claims by Native Americans, the TTAB ruled that, following the enactment of the America Invents Act in 2011,<sup>50</sup> the TTAB was no longer bound to D.C. Circuit decisions.<sup>51</sup> Because the act changed the venue for TTAB appeals from the D.C. Circuit to the Fourth Circuit, the TTAB was able to distinguish the D.C. Circuit’s application of laches in *Harjo*.<sup>52</sup>

The TTAB in *Blackhorse* also distinguished *Harjo*’s denial of Suzan Harjo’s “disparagement” claim by pointing to new findings of fact in its case. Most notably, the TTAB emphasized the NCAI’s passage of Resolution 93-11, which read “the 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].”<sup>53</sup> After considering the resolution, the TTAB ruled that the “Redskins” trademark was “disparaging” to a substantial composite of the reference group, given that the NCAI represented approximately 30% of the Native American population from 1967 to 1990.<sup>54</sup> Accordingly, unlike the district court in *Harjo*, the TTAB in *Blackhorse* ordered for the cancellation of the six trademark registrations.<sup>55</sup>

On appeal to the District Court for the Eastern District of Virginia, Pro-Football presented for the first time constitutional challenges against Section 2(a) of the Lanham Act. Specifically, Pro-Football claimed that Section 2(a) violated the First Amendment because it

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<sup>47</sup> *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d (BNA) 1080, 1082 (T.T.A.B. 2014).

<sup>48</sup> *Id.*

<sup>49</sup> *Id.* at 1113.

<sup>50</sup> Leahy-Smith America Invents Act of 2011, Pub. L. No. 112-29, § 9(a), 125 Stat. 284 (2011) (to be codified at 15 U.S.C. § 1071(b)(4)).

<sup>51</sup> *Id.* at 1112.

<sup>52</sup> *Id.*

<sup>53</sup> *Id.* at 1098.

<sup>54</sup> *Id.* at 1110–11.

<sup>55</sup> *Id.* at 1111–12.

restricted Pro-Football's right to free speech.<sup>56</sup> Pro-Football also claimed that its trademarks did not violate the "disparagement" clause of the Lanham Act because it was unclear whether the term was disparaging to a substantial composite of Native Americans.<sup>57</sup> Pro-Football further contended that laches barred Blackhorse's disparagement claim.<sup>58</sup>

The district court ultimately denied all of Pro-Football's contentions. First, as to Pro-Football's First Amendment claim, the district court ruled that cancelling a registration under Section 2(a) of the Lanham Act would not violate Pro-Football's First Amendment rights because such a cancellation would not prevent the Washington Redskins from "speaking"; that is, using the mark in commerce.<sup>59</sup> The Washington Redskins could still technically use the term in its commercial affairs, just without federal protections.<sup>60</sup>

The district court also ruled that the federal trademark registration program could not be challenged on First Amendment grounds because the program constituted "government speech."<sup>61</sup> The government speech doctrine holds that the First Amendment cannot regulate "speech that conveys or has the effect of conveying government messages" because a government entity has the right to "speak for itself."<sup>62</sup> A government entity cannot be told what it can and cannot say; otherwise, it would not be able to function if it could only express those views with which every citizen agreed.<sup>63</sup> For example, in *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*, the Supreme Court held that the state of Texas was entitled to bar an individual from displaying a confederate flag-themed license plate on his car.<sup>64</sup> The Court reasoned that the words inscribed on state license plates constitute "government speech" after articulating a three-factor test to determine whether an act or statement constitutes government speech.<sup>65</sup> The first factor the Court considered was whether the medium of expression had a history of communicating messages from the state.<sup>66</sup> The second consideration

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<sup>56</sup> Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439, 447–48 (E.D. Va. 2015).

<sup>57</sup> *Id.*

<sup>58</sup> *Id.*

<sup>59</sup> *Id.* at 457.

<sup>60</sup> *Id.*

<sup>61</sup> *Id.* at 448.

<sup>62</sup> *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239, 2246–50 (2015).

<sup>63</sup> *Pleasant Grove City v. Summum*, 555 U.S. 460, 468 (2009).

<sup>64</sup> *Walker*, 135 S. Ct. at 2244.

<sup>65</sup> *Id.* at 2248.

<sup>66</sup> *Id.*

was whether the medium was “often closely identified in the public mind with the state.”<sup>67</sup> Finally, the third factor was the extent to which the state effectively controlled the messages conveyed.<sup>68</sup> Because all three factors weighed in favor of regarding state license plates as government speech, the Court ruled that state license plates were entitled to government speech protections and, therefore, could not be challenged on First Amendment grounds.<sup>69</sup>

In *Blackhorse*, the district court applied the same three factor test from *Walker* and ultimately concluded that, like state license plates, the federal trademark registration program constituted government speech.<sup>70</sup> First, the district court found that the registration program had a “history of communicat[ing] the message that the federal government . . . approved the trademark.”<sup>71</sup> Second, the district court ruled that “the public closely associate[d] federal trademark registration with the federal government as the insignia for federal trademark registration.”<sup>72</sup> Finally, the district court determined that the federal government “exercise[d] editorial control over the federal trademark registration program.”<sup>73</sup> Because all three factors weighed in favor of classifying federal trademarks as government speech, the district court ruled that the USPTO could not be told by the Washington Redskins what it could and could not register as a trademark.<sup>74</sup> Neither could the Washington Redskins charge the USPTO of violating the team’s First Amendment rights for cancelling the “Redskins” trademark.<sup>75</sup>

The court in *Blackhorse* then moved on to hold that the meaning of the mark, in the context of the “Washington Redskins” football team, was one that “may disparage” a substantial composite of Native Americans in violation of Section 2(a) of the Lanham Act.<sup>76</sup> The court based its decision on “(1) dictionary definitions and accompanying editorial designations; (2) scholarly, literary, and media references; and (3) statements of individuals and group leaders of [Native American tribes].”<sup>77</sup> For example, the district court noted that eleven well-known dictionaries characterized the term “Redskins” as either “offensive or

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<sup>67</sup> *Id.* at 2248–49.

<sup>68</sup> *Id.* at 2249.

<sup>69</sup> *Id.*

<sup>70</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 458 (E.D. Va. 2015).

<sup>71</sup> *Id.*

<sup>72</sup> *Id.* at 458–59.

<sup>73</sup> *Id.* at 459.

<sup>74</sup> *Id.*

<sup>75</sup> *Id.* at 457–58.

<sup>76</sup> *Id.* at 487.

<sup>77</sup> *Id.* at 472.

contemptuous.”<sup>78</sup> Other “well respected source[s],” such as the *Encyclopedia Britannica*, *Washington Daily*, *Washington Post*, and academic journals, “contemplated the poor standing of the term ‘Redskins.’”<sup>79</sup> The court also placed great weight on NCAI statements as well as on new statements issued by the American Indian Movement, National Indian Youth Council, Americans for Indian Opportunity, and the Washington Bureau of the American Indian Press Association.<sup>80</sup> The array of sources ultimately persuaded the court to rule that between 1967 and 1990, the “Redskins” trademarks consisted of matter that “may disparage” a substantial composite of Native Americans.<sup>81</sup> The court also denied Pro-Football’s laches defense because the “public interest” weighed against the application of laches.<sup>82</sup>

Overall, the district court denied Pro-Football’s First Amendment claim and agreed with the TTAB that the “Redskins” trademark violated the “disparagement” clause of the Lanham Act.<sup>83</sup> Pro-Football appealed to the Court of Appeals for the Fourth Circuit, but the case was later postponed when the Supreme Court granted certiorari in *Lee v. Tam*.<sup>84</sup> Because both *Tam* and *Blackhorse* involved nearly identical legal issues,<sup>85</sup> Pro-Football requested that its case be postponed until after the Supreme Court decided *Tam*.<sup>86</sup> The Fourth Circuit agreed and did not hear arguments or deliver an opinion until after the completion of *Tam*.<sup>87</sup>

### III. BLACKHORSE AFTER MATAL V. TAM

By the time the Supreme Court granted certiorari in *Lee v. Tam*,<sup>88</sup> the existing body of caselaw provided the following answers concerning the “Redskins” trademark and Section 2(a) of the Lanham Act: (1) the “Redskins” trademark was not “scandalous or immoral” to a substantial

<sup>78</sup> *Id.* at 475.

<sup>79</sup> *Id.* at 479–80.

<sup>80</sup> *Id.* at 480–81.

<sup>81</sup> *Id.* at 485.

<sup>82</sup> *Id.* at 488.

<sup>83</sup> *Id.* at 487.

<sup>84</sup> *Lee v. Tam*, 137 S. Ct. 30 (2016).

<sup>85</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1755 (2017) (deciding the similar question of whether the “disparagement clause” is facially invalid under the Free Speech Clause of the First Amendment).

<sup>86</sup> Request For Postponement of Argument in Light of *Lee v. Tam* by Appellant Pro-Football, Inc., *Pro-Football, Inc. v. Blackhorse*, 709 F. App’x. 182 (4th Cir. 2018) (No. 15-1874).

<sup>87</sup> Order Filed [999968144] Placing Case in Abeyance. Case 15-1874 Placed in Abeyance Pending Decision in 15-1293 from U. S. Supreme Court, *Pro-Football, Inc. v. Blackhorse*, 709 F. App’x. 182 (4th Cir. 2018).

<sup>88</sup> *Lee*, 137 S. Ct. at 30.

composite of the general public;<sup>89</sup> (2) the “Redskins” trademark was “disparaging” to a substantial composite of Native Americans;<sup>90</sup> (3) the cancellation of the “Redskins” trademark did not violate the free speech rights of the Washington Redskins;<sup>91</sup> and (4) the defense of laches could not save the “Redskins” trademark from cancellation.<sup>92</sup> Although *Matal v. Tam* did not concern the registration of a professional sports team name like the Washington Redskins, it mirrored *Pro-Football, Inc. v. Blackhorse* in that it concerned the constitutionality of the Lanham Act’s “disparagement” clause.

### A. *Matal v. Tam*

In *Matal v. Tam*, the Supreme Court reviewed for the first time the constitutionality of Section 2(a) of the Lanham Act.<sup>93</sup> Specifically, the Supreme Court looked to determine, like the district court did in *Blackhorse*, whether the federal trademark registration program constituted “government speech”; whether federal trademarks warranted relaxed First Amendment scrutiny under the doctrine of “commercial speech”; and whether the USPTO’s cancellation of the petitioner’s trademark violated the First Amendment.<sup>94</sup> The Supreme Court’s answers were important to Amanda Blackhorse because a ruling in favor of the petitioner, Simon Tam, would fortify the position of Pro-Football and the Washington Redskins.<sup>95</sup>

The petitioner Simon Tam was the lead singer of a rock band called “The Slants” and, like the Washington Redskins, he claimed that the USPTO violated his free speech rights when it denied the registration of his band’s name.<sup>96</sup> Tam chose the band name “The Slants” to “reclaim” the term and “drain it of its denigrating force as a derogatory term” to Asian persons.<sup>97</sup> The USPTO denied registration of the term

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<sup>89</sup> *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1748–49 (T.T.A.B. 1999).

<sup>90</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 487 (E.D. Va. 2015).

<sup>91</sup> *Id.* at 459.

<sup>92</sup> *Id.* at 488.

<sup>93</sup> *See Matal v. Tam*, 137 S. Ct. 1744, 1749–50 (2017); *see also* 15 U.S.C. § 1052 (2012).

<sup>94</sup> *Id.*

<sup>95</sup> Motion by Appellant Pro-Football, Inc. to Continue/Reschedule Oral Argument (Local Rule 34(c)), *Pro-Football, Inc. v. Blackhorse*, 709 F. App’x. 182 (4th Cir. 2018) (No. 15-1874).

<sup>96</sup> *Tam*, 137 S. Ct. at 1751.

<sup>97</sup> *Id.* Simon Tam later published an article to review his experience and motivations for taking his case to the Supreme Court. *See* Simon Tam, *First Amendment, Trademarks, and “The Slants”: Our Journey to the Supreme Court*, 12 BUFF. INTELL. PROP. L.J. 1, 2 (2018) (“I started the band with [sic] as a deliberate

on the grounds that “The Slants” was a mark that “may disparage” or bring into “contempt or disrepute” Asian persons in the United States.<sup>98</sup> Tam contested the USPTO’s decision, claiming that it constituted viewpoint discrimination in violation of the First Amendment.<sup>99</sup> Ultimately, the Supreme Court agreed with Tam’s position.<sup>100</sup>

Unlike the district court in *Blackhorse*, the Supreme Court, in an opinion written by Justice Alito, held that the USPTO was *not* exempt from First Amendment challenges because the federal trademark registration program was *not* “government speech.”<sup>101</sup> The Court reasoned that federal trademarks do not convey or have the effect of conveying messages on behalf of the government.<sup>102</sup> Specifically, the government does not “dream up the trademarks registered by the [US]PTO,” nor does it “edit marks submitted for registration.”<sup>103</sup> If, hypothetically, federal trademarks constituted government speech, then the government through its trademarks would be “babbling prodigiously and incoherently” and “saying many unseemly things.”<sup>104</sup> For example, the government would be “babbling incoherently” if government speech included the marks “Think different” (Apple), “Just do it” (Nike), or “Have it your way” (Burger King).<sup>105</sup> Furthermore, unlike state license plates,<sup>106</sup> federal trademarks did not pass the *Walker* three factor test, according to the Court, because they (1) do not convey government messages, but rather private speech; (2) are not often closely identified in the public mind with the state, since trademarks are understood to be private creations, and (3) are not directly controlled, edited, or manufactured by the government.<sup>107</sup>

In a non-binding portion of the opinion, Justice Alito, writing for himself, Chief Justice Roberts, Justice Thomas, and Justice Breyer, also ruled for the first time that federal trademarks are not subject to relaxed First Amendment scrutiny for being “commercial speech.”<sup>108</sup> Although Justice Alito refrained from stating whether federal trademarks constitute “commercial speech,” he found that even if federal

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way to challenge racial stereotypes. Our name, The Slants, actually refers to our collected perspective as people of color.”).

<sup>98</sup> *Tam*, 137 S. Ct. at 1751.

<sup>99</sup> *Id.*

<sup>100</sup> *Id.*

<sup>101</sup> *Id.* at 1760.

<sup>102</sup> *Id.*

<sup>103</sup> *Id.* at 1758.

<sup>104</sup> *Id.*

<sup>105</sup> *Id.* at 1759.

<sup>106</sup> *Id.* at 1760.

<sup>107</sup> *Id.*

<sup>108</sup> *Id.* at 1764–65.

trademarks did, the “disparagement” clause did not qualify for relaxed First Amendment scrutiny under the *Central Hudson* test.<sup>109</sup> Under that test, a restriction of an individual’s “commercial speech” is permissible as long as the restriction (1) serves a substantial government interest and (2) is narrowly drawn.<sup>110</sup> Although the USPTO claimed that the restriction of “disparaging” trademarks passed the *Central Hudson* test because the government had a “substantial interest” in denying disparaging speech that would “disrupt” the “orderly flow of commerce,”<sup>111</sup> Justice Alito disagreed because the “disparagement” clause was not “narrowly drawn.”<sup>112</sup> Given that the disparagement clause covered “any trademark that disparages *any person, group, or institution,*” the clause went “much further than [was] necessary to serve the interest asserted.”<sup>113</sup> As such, Justice Alito concluded that the “disparagement” clause was not entitled to relaxed First Amendment scrutiny.<sup>114</sup>

Furthermore, having ruled that the “disparagement” clause was not entitled to “government speech” or “commercial speech” protections, Justice Alito as well as Justice Kennedy, who wrote a concurring opinion in which Justice Ginsburg, Justice Sotomayor, and Justice Kagan joined, moved on to hold that the USPTO’s denial of the mark “The Slants” violated the First Amendment.<sup>115</sup> Specifically, Justice Kennedy wrote that the denial amounted to viewpoint discrimination, which is met when the government singles out, within the relevant subject category, a “subset of messages for disfavor based on the view expressed.”<sup>116</sup> Because the Lanham Act’s “disparagement” clause singled out a subset of messages that the USPTO found “offensive” to the subject category of “persons, living or dead, institutions, beliefs, or national symbols,” the justices ruled that the clause impermissibly

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<sup>109</sup> *Id.* at 1764; *see Cent. Hudson Gas & Elec. Corp. v. Public Serv. Comm’n*, 447 U.S. 557, 569–70 (1980) (establishing a two-part test that permits restrictions of commercial speech if the restriction (1) serves a substantial government interest and (2) is narrowly drawn).

<sup>110</sup> *Tam*, 137 S. Ct. at 1764; *Cent. Hudson Gas & Elec. Corp.*, 447 U.S. at 569–70.

<sup>111</sup> *Tam*, 137 S. Ct. at 1764.

<sup>112</sup> *Id.* at 1764–65.

<sup>113</sup> *Id.* at 1765.

<sup>114</sup> *Id.* at 1764–65.

<sup>115</sup> *Id.* at 1763 (“[I]n the sense relevant here, that is viewpoint discrimination: Giving offense is a viewpoint.”); *id.* at 1765 (Kennedy, J., concurring) (“As the Court is correct to hold, §1052(a) constitutes viewpoint discrimination—a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny.”).

<sup>116</sup> *Id.* at 1766 (Kennedy, J., concurring); *see also id.* at 1763.

discriminated in a viewpoint specific manner.<sup>117</sup> Contrary to the USPTO's contention that it lawfully denied marks in a viewpoint *neutral* manner,<sup>118</sup> the justices determined that the USPTO's policy of permitting registration of only "positive or benign mark[s] but not . . . derogatory one[s]" was the "essence of viewpoint discrimination."<sup>119</sup> By mandating only positivity, the "disparagement" clause threatened to "silence dissent and distort the marketplace of ideas."<sup>120</sup> The USPTO could not prohibit the public expression of ideas merely because the ideas are themselves "offensive to some of their hearers."<sup>121</sup>

Although the Supreme Court did not reference *Blackhorse* in its *Tam* decision, the Court's final ruling ultimately ended Amanda Blackhorse's case.<sup>122</sup> Like the band name "The Slants," the "Redskins" trademark could no longer be denied registration on the ground that it was "disparaging," given that the disparagement clause was struck down in *Tam*.<sup>123</sup> Accordingly, following the *Tam* decision, the Fourth Circuit vacated the district court's order in *Pro-Football, Inc. v. Blackhorse* and remanded for further proceedings consistent with *Tam*.<sup>124</sup> Shortly thereafter, Amanda Blackhorse withdrew her trademark suit against the Washington Redskins.<sup>125</sup>

## B. In re Brunetti

After the Supreme Court's holding in *Matal v. Tam*, all hope seemed lost for Blackhorse. The "Redskins" trademark, like the term "The Slants," could no longer be denied registration for violating the Lanham Act's "disparagement" clause, because the clause was ruled unconstitutional.<sup>126</sup> However, whether the USPTO could still deny trademark registrations on the basis of other provisions of Section 2(a)

<sup>117</sup> *Id.* at 1763; *see also id.* at 1765 (Kennedy, J., concurring).

<sup>118</sup> *Id.* at 1766 (Kennedy, J., concurring).

<sup>119</sup> *Id.* (Kennedy, J., concurring); *see also id.* at 1763.

<sup>120</sup> *Id.* at 1766 (Kennedy, J., concurring).

<sup>121</sup> *Id.* at 1763.

<sup>122</sup> *Pro-Football, Inc. v. Blackhorse*, 709 F. App'x. 182 (4th Cir. 2018) (vacating the district court's order and remanding for further proceedings consistent with *Tam*).

<sup>123</sup> *Id.* at 183.

<sup>124</sup> *Id.* at 183–84.

<sup>125</sup> Response/Answer by Amanda Blackhorse, Marcus Briggs-Cloud, Phillip Gover, Jillian Pappan and Courtney Tsotigh to Notice Requesting Response at 1, *Pro-Football, Inc. v. Blackhorse*, 709 F. App'x. 182 (4th Cir. 2018) (No. 15-1874).

<sup>126</sup> *See id.* (agreeing with *Pro-Football, Inc.* that the *Tam* decision essentially ended Blackhorse's case); *see also* Response/Answer by *Pro-Football, Inc.* to Notice Requesting Response, *Pro-Football, Inc. v. Blackhorse*, 709 F. App'x. 182 (4th Cir. 2018) (15-1874) (claiming that the *Tam* decision is dispositive to Blackhorse's case).



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of the Lanham Act was not decided in *Tam*.<sup>127</sup> Because the *Tam* decision ruled only on the constitutionality of the “disparagement” clause, the USPTO has continued to deny registration for marks found to be “immoral or scandalous.”<sup>128</sup> When the USPTO ultimately filed a Supreme Court cert petition concerning the constitutionality of the “immoral or scandalous” clause on September 7, 2018, it reopened the question of whether the “Redskins” trademark could be re-canceled for violating Section 2(a) of the Lanham Act.<sup>129</sup>

The USPTO filed its cert petition after the Federal Circuit held in *In re Brunetti*<sup>130</sup> that the “immoral or scandalous” clause, like the “disparaging” clause, was unconstitutional.<sup>131</sup> In that case, the petitioner appealed the USPTO’s decision to deny registration of the term “FUCTION.”<sup>132</sup> The USPTO denied the term on the ground that it violated the “immoral or scandalous” clause of the Lanham Act.<sup>133</sup> Although the Federal Circuit ultimately agreed that the term was “scandalous,” it nevertheless ruled that the USPTO’s denial of the mark violated the First Amendment.<sup>134</sup> Citing *Tam*, the Federal Circuit reasoned that denying the term based on the “immoral or scandalous” clause constituted impermissible content-based discrimination.<sup>135</sup> The Federal Circuit also denied the USPTO’s claims that the “immoral or scandalous” clause was entitled to “government speech” or “commercial speech” protections.<sup>136</sup> The lack of a “reasonable definition” of the statutory terms “immoral or scandalous” further convinced the Federal Circuit that the clause was unconstitutional.<sup>137</sup>

In a concurring opinion, Judge Dyk agreed that some regulations under the “immoral or scandalous” clause were unconstitutional;

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<sup>127</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1768 (2017) (Kennedy, J., concurring) (“This case does not present the question of how other provisions of the Lanham Act should be analyzed under the First Amendment.”).

<sup>128</sup> United States Patent and Trademark Office, *Trademark Alert: New Examination Guide Issued on Section 2(a) after Matal v. Tam*, USPTO SUBSCRIPTION CENTER (June 26, 2017, 4:46 PM), <https://content.govdelivery.com/accounts/USPTO/bulletins/1a57a0f>.

<sup>129</sup> See Petition for Writ of Certiorari, *In re Brunetti*, 15 U.S.L.W. 1109 (2018) (No. 18-302) (claiming that the Supreme Court’s holding in *Matal v. Tam* is not controlling in case concerning the constitutionality of the “immoral or scandalous” clause).

<sup>130</sup> 877 F.3d 1330 (Fed. Cir. 2017).

<sup>131</sup> *Id.* at 1341.

<sup>132</sup> *Id.* at 1337.

<sup>133</sup> *Id.*

<sup>134</sup> *Id.* at 1339–40.

<sup>135</sup> *Id.* at 1341–42.

<sup>136</sup> *Id.* at 1350.

<sup>137</sup> *Id.* at 1355–56.

however, he argued that a “saving construction” of the “immoral or scandalous” clause was possible and that the Federal Circuit should have adopted that construction.<sup>138</sup> Specifically, Judge Dyk claimed that the Court was obliged to consider ways in which to construe the clause that would protect its constitutionality.<sup>139</sup> One such construction was to construe the clause narrowly to apply to only “obscene” marks.<sup>140</sup> Such a construction, according to Judge Dyk, was “fairly possible” and “reasonable,” given the Supreme Court’s “long history of narrowing the scope of similarly worded statutes to cover only obscene speech.”<sup>141</sup> Because the First Amendment does not protect obscene speech, denying marks on the basis of Judge Dyk’s “obscenity standard” would be permissible under the First Amendment.<sup>142</sup>

Although the Federal Circuit ultimately struck down the “immoral or scandalous” clause as unconstitutional, the Supreme Court has yet to speak on the issue.<sup>143</sup> Now that the Supreme Court granted the USPTO’s cert petition concerning the constitutionality of the “immoral or scandalous” clause on January 4, 2019, it is up to the Supreme Court to decide whether the USPTO can continue to deny trademarks for being “immoral or scandalous.”<sup>144</sup> The Supreme Court’s decision will affect the question of whether the Washington “Redskins” trademark can be cancelled for being “immoral” or “scandalous” under the Lanham Act.

#### IV. IS THE “REDSKINS” TRADEMARK SCANDALOUS OR IMMORAL?

Whether the USPTO should be permitted to deny marks on the basis of the “immoral or scandalous” clause is now a topic of much debate. The question is especially important to plaintiffs like Amanda Blackhorse and Suzan Harjo because it has opened up the possibility of re-canceling the Washington “Redskins” trademark for violating Section 2(a) of the Lanham Act. Although the Supreme Court has yet to address this question, an “immoral or scandalous” claim against the “Redskins” trademark would face the following legal obstacles: (1) it is unclear whether the term “Redskins” meets the traditional definition of

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<sup>138</sup> *Id.* at 1357–58 (Dyk, J., concurring).

<sup>139</sup> *Id.* at 1358 (Dyk, J., concurring).

<sup>140</sup> *Id.* (Dyk, J., concurring).

<sup>141</sup> *Id.* (Dyk, J., concurring).

<sup>142</sup> *Id.* at 1360–61 (Dyk, J., concurring).

<sup>143</sup> United States Patent and Trademark Office, *Trademark Alert: New Examination Guide Issued on Section 2(a) after Matal v. Tam*, USPTO SUBSCRIPTION CENTER (June 26, 2017, 4:46 PM), <https://content.govdelivery.com/accounts/USPTO/bulletins/1a57a0f>.

<sup>144</sup> See *Iancu v. Brunetti*, No. 18-302, 2019 U.S. LEXIS 2, \*1 (2019); see also *Petition for Writ of Certiorari, In re Brunetti*, 15 U.S.L.W. 1109 (2018) (No. 18-302).

the words “immoral or scandalous”; (2) the method of analyzing terms under the “immoral or scandalous” clause comes dangerously close to committing what caused the “disparagement” clause to get struck down in *Tam*; and (3) as a matter of public policy, courts in trademark law have been cautious to avoid rulings that would upset the “marketplace of ideas.”

### A. Traditional Meaning of “Immoral or Scandalous”

It is unclear whether the term “Redskins” qualifies as “immoral or scandalous” under the traditional legal definition of those terms. Courts have traditionally regarded a term as “immoral or scandalous” when a “substantial composite” of the general public finds the term “shocking to the sense of truth, decency, or propriety” or “offens[ive] to the conscious or moral feelings.”<sup>145</sup> Because the TTAB already determined in *Harjo* that the term “Redskins” did not qualify as “immoral or scandalous” from the 1960s to the 1990s,<sup>146</sup> new evidence will likely be needed to prove that the term is now “immoral or scandalous.”

In *Harjo*, the TTAB determined that the term “Redskins” was not “immoral or scandalous” after considering a “voluminous number of references . . . by a substantial number of fans and the media.”<sup>147</sup> The TTAB’s ruling ultimately set a high bar for what qualifies as “immoral or scandalous,” given that the TTAB made its decision despite being presented with the following evidence: (1) language experts testifying that the term had been used in “contexts of savagery, violence and racial inferiority”;<sup>148</sup> (2) at least twenty major films that used the term with negative adjectives such as “dirty” or “lying” in the context of “violence, savagery, or dishonesty”;<sup>149</sup> and (3) market research surveys showing that at least 46% of respondents believed the term “Redskins” to be offensive.<sup>150</sup> Despite these findings, the TTAB required more evidence to conclude that the term “Redskins” was “immoral or scandalous.”<sup>151</sup>

In *Blackhorse*, Amanda Blackhorse presented such additional evidence, after both parties agreed that the entire *Harjo* record could be entered into evidence.<sup>152</sup> Blackhorse’s additional evidence consisted of

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<sup>145</sup> *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1735 (T.T.A.B. 1999) (citing *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981)).

<sup>146</sup> *Id.* at 1748–49.

<sup>147</sup> *Id.* at 1749.

<sup>148</sup> *Id.* at 1729.

<sup>149</sup> *Id.* at 1732.

<sup>150</sup> *Id.* at 1733.

<sup>151</sup> *Id.* at 1748.

<sup>152</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 450 (E.D. Va. 2015).

more dictionary definitions, editorial designations, academic writings, and media publications. For example, the district court received additional scholarly and media references claiming that the term “Redskins”: (1) “relegate[d] the Indian to an inferior status”;<sup>153</sup> (2) was as offensive to Native Americans as the N-word was to African Americans”;<sup>154</sup> and (3) should be dropped as the team’s nickname, similar to how the nicknames were dropped at Stanford University, Dartmouth College, Syracuse University, and the University of Utah.<sup>155</sup>

The most compelling new evidence presented in *Blackhorse* consisted of declarations by prominent Native American organizations and leaders in the Native American community. Raymond Apodaca, for example, was the Tribal Administrator for the Yselta Del Sur Pueblo and held several leadership positions in the NCAI.<sup>156</sup> He expressed that “[R]edskin,’ both the term and the professional football team name, was a racial slur against Native Americans since the 1960s.”<sup>157</sup> Leon Cook similarly opposed the team’s name for being “bigoted, discriminatory, and offensive to Native Americans” and voted in favor of a resolution calling for the “Washington Redskins” to change its team name.<sup>158</sup> Cook was the Tribal Representative of the Red Lake Nation and President of the NCAI from 1971 to 1972.<sup>159</sup> Eventually, Cook, Apodaca, and several other Native American leaders helped pass NCAI Resolution 93-11, which read “the 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].”<sup>160</sup> Although the district court decided only the issue of “disparagement” and not the “immoral or scandalous” issue, it placed great weight on the NCAI’s statement because the NCAI represented approximately 30% of the Native American population from the 1960s to the 1990s.<sup>161</sup>

Even with the additional evidence presented in *Blackhorse*, however, it will be difficult to prove that the term “Redskins” qualifies as “immoral or scandalous” under the traditional meaning of those terms.<sup>162</sup> In regard to the “subject group” prong of the “immoral or

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<sup>153</sup> *Id.* at 477.

<sup>154</sup> *Id.* at 479.

<sup>155</sup> *Id.* at 477.

<sup>156</sup> *Id.* at 481.

<sup>157</sup> *Id.* at 481–82.

<sup>158</sup> *Id.* at 482.

<sup>159</sup> *Id.*

<sup>160</sup> *Id.* at 483.

<sup>161</sup> *Id.* at 481.

<sup>162</sup> Though there is no recognized test, courts have regarded a term as “immoral  
*continued . . .*

scandalous” clause, *Blackhorse* did not prove that a “substantial composite of the *general public*” viewed the term “Redskins” as scandalous.<sup>163</sup> Because the evidence in *Blackhorse* was gathered solely to determine whether the term was “disparaging” to Native Americans, *Blackhorse* provides limited value as to whether the term was “scandalous” to the “general public.”<sup>164</sup> The *Blackhorse* evidence merely measured the attitudes of the “disparagement” clause’s subject group, Native Americans, and not that of the “immoral or scandalous” clause’s subject group, the general public.<sup>165</sup> For example, the collective statements in *Blackhorse* were given by Native American organizations, such as the NCAI, and they described how Native Americans felt about the term “Redskins.”<sup>166</sup> The *Blackhorse* court was not presented with sufficient evidence about the general public’s feelings about the term. Without additional evidence concerning broader public sentiment, courts will likely not be convinced that the “Redskins” trademark is “immoral or scandalous” based on the evidence in *Blackhorse*.

It is also unclear whether the term “Redskins” falls under one of the categories of marks that has traditionally satisfied the “shocking” prong of the “immoral or scandalous” clause.<sup>167</sup> For example, marks concerning sexual references such as “Jack Off,”<sup>168</sup> violence such as “Wife Beater,”<sup>169</sup> and profanity such as “Shit” or “Fuck,”<sup>170</sup> have regularly been dismissed as “scandalous” on the grounds that they are

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or scandalous” when the term satisfies both of two prongs: (1) a “subject group” prong and (2) “shocking” prong; that is, a term is “immoral or scandalous” when (1) a “substantial composite” of the general public (2) finds the term “shocking to the sense of truth, decency, or propriety” or “offens[ive] to the conscious or moral feelings.” See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1735 (T.T.A.B. 1999) (citing *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981)).

<sup>163</sup> *Pro-Football, Inc.*, 112 F. Supp. 3d at 480–81 (emphasis added).

<sup>164</sup> *Id.*; see also Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare: Marks That May Be Scandalous or Immoral*, 101 TMR 1476 (2011) (stating that the subject category of “persons, living or dead, institutions, beliefs, or national symbols” under the “disparagement” clause is narrower than the subject category of “general public” under the “immoral or scandalous” clause).

<sup>165</sup> *Pro-Football, Inc.*, 112 F. Supp. 3d at 474–75 (stating that the subject group under the “immoral or scandalous clause is the “general public” while the subject group under the “disparagement” clause is “Native Americans”).

<sup>166</sup> *Id.* at 483.

<sup>167</sup> The marks that have traditionally been deemed “shocking” under the “immoral or scandalous” clause involve religion, sexual references, drug references, violence, patriotism, and profanity. See LaLonde & Gilson, *supra* note 164.

<sup>168</sup> *In re Boulevard Entertainment, Inc.*, 334 F.3d 1336 (Fed. Cir. 2003).

<sup>169</sup> *In re Love Bottling Co.*, 2005 TTAB LEXIS 261 (T.T.A.B. 2005).

<sup>170</sup> See LaLonde & Gilson, *supra* note 164, at 1489.

“vulgar.”<sup>171</sup> Even foreign words that become “vulgar” when translated into English, such as “De Puta Madre” (“Fucking Great”), have been denied registration.<sup>172</sup> To be sure, the USPTO has refrained from denying marks that simply refer to certain parts of the human anatomy or that become non-vulgar when considered in context.<sup>173</sup> For example, the USPTO accepted for registration an image of a large bird next to the phrase “Big Pecker” because the placement of the phrase next to the bird indicated that the phrase referred to the bird and not its other vulgar meaning.<sup>174</sup> But in the context of professional football, it is unclear whether the term “Redskins” rises to the same level of “vulgarity” as profanity, violence, and sexual references.<sup>175</sup> The term, at most, may have been associated with violence in the past, for example, with the team’s fight song lyrics “Scalp em, Swamp em” and “Fight for old Dixie.”<sup>176</sup> But since the early 1960s those words have changed to “Run or pass and score” and “Fight for old D.C.”<sup>177</sup>

Because the term “Redskins” does not clearly satisfy either the “subject group” prong or the “shocking” prong of the “immoral or scandalous” clause, it is unclear whether the term qualifies as “immoral or scandalous.” Unless more members of the general public demonstrate that they view the term as vulgar or obscene, the “Redskins” trademark will likely remain registered.

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<sup>171</sup> *Id.*; see also *In re Big Effin Garage, LLC*, 2010 TTAB LEXIS 418, \*3 (T.T.A.B. 2010); *In re RK Netmedia, Inc.*, 2009 TTAB LEXIS 389, \*3 (T.T.A.B. 2009).

<sup>172</sup> *In re Mexico 69 SRL*, 2006 TTAB LEXIS 358, at \*12 (T.T.A.B. 2006).

<sup>173</sup> *In re Hershey*, 6 U.S.P.Q.2D (BNA) 1470, 1471 (T.T.A.B. 1988).

<sup>174</sup> *Id.* at 1472.

<sup>175</sup> To disassociate the term “Redskins” from notions of vulgarity, the Washington Redskins football team has largely substituted football imagery for Native American imagery on its game program covers, and the Native American imagery that actually appears consists of actual or realistic portraits of Native American individuals. The football team also modified its “Hail to the Redskins” fight song by replacing the lines “Fight for old Dixie” and “Scalp em, Swamp em” with “Fight for old D.C.” and “Run or pass and score.” See Locke Peterseim, *Not Just Whistling Dixie in D.C.*, ESPN (Mar. 16, 2002, 2:48 AM), <http://www.espn.com/espn/print?id=1351493&type=page2Story>.

<sup>176</sup> *Id.*

<sup>177</sup> *Id.*; see also *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 481 (E.D. Va. 2015).

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## B. Method of Analyzing Terms Under the “Immoral or Scandalous” Clause

Given the Supreme Court’s ruling in *Tam*, courts will likely be slow to hold that the term “Redskins” is “immoral or scandalous.” A big reason why is that the method of evaluating ethnicity-related marks under the “immoral or scandalous” clause comes dangerously close to committing what caused the “disparagement” clause to get struck down in *Tam*: viewpoint discrimination in violation of the First Amendment.<sup>178</sup>

The similarities are evident in *Harjo*, where the TTAB used the same findings of fact from its “disparagement” clause analysis in its “immoral or scandalous” clause analysis concerning the term “Redskins.”<sup>179</sup> Specifically, the TTAB used the same references from dictionaries, encyclopedias, graphics, and newspapers to resolve both the “disparagement” clause and “immoral or scandalous” clause inquiries.<sup>180</sup> The problem with this overlap is that, like the method of evaluating terms under the “disparagement” clause, the method of evaluating ethnicity-related terms like “Redskins” under the “immoral or scandalous” clause involves “highly subjective” and “viewpoint specific” considerations.<sup>181</sup> In *Harjo*, for example, the TTAB considered the views of not just Native Americans, but also those of team officials who believed the term to be a mark of respect.<sup>182</sup> Their differences in views made it difficult for the TTAB to gauge the level of “scandalousness” inherent in the term “Redskins.”<sup>183</sup> When the TTAB ultimately concluded that the term was not scandalous on the grounds that the word was “accepted” in connection with the football team,<sup>184</sup> the TTAB admitted that its determination was “necessarily a highly subjective one.”<sup>185</sup> In other words, the process necessarily

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<sup>178</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

<sup>179</sup> *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1748 (T.T.A.B. 1999) (“[W]e incorporate by reference the analysis of the facts in the discussion, *supra*, of whether the matter in question may disparage Native Americans”); *see also* *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 474 (E.D. Va. 2015) (stating that findings of fact from “scandalous matter actions [are] instructive . . . in the ‘may disparage’ context”).

<sup>180</sup> *Harjo*, 50 U.S.P.Q.2d at 1748.

<sup>181</sup> *Id.* at 1737 (“As with scandalousness, the determination of whether matter may be disparaging is highly subjective and, thus, general rules are difficult to postulate.”).

<sup>182</sup> *Id.* at 1748–49; *see also* *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 133–34 (D.D.C. 2003).

<sup>183</sup> *Harjo*, 50 U.S.P.Q.2d at 1748–49.

<sup>184</sup> *Id.* at 1749.

<sup>185</sup> *Id.* at 1737 (“As with scandalousness, the determination of whether matter

required the TTAB to single out a “subset of views” for favor or disfavor, which the Supreme Court Justices struck down as unconstitutional viewpoint discrimination in *Tam*.<sup>186</sup>

To be sure, it could be argued that, unlike the “viewpoint *specific*” manner of denying marks under the “disparagement” clause, the manner of denying marks under the “immoral or scandalous” clause is “viewpoint *neutral*.”<sup>187</sup> The USPTO, for example, has argued that “restrictions on the use of profanity and sexual images” under the “immoral or scandalous” clause are not unconstitutional because such restrictions are “viewpoint neutral”; that is, they do not single out a subset of views for favor or disfavor but rather preclude “a combination of letters that stands for a vulgar or obscene term.”<sup>188</sup> But because the method of determining “scandalousness” for *ethnicity*-related terms is different than it is for obscene or vulgar terms such as “shit” or “fuck,”<sup>189</sup> it is difficult to determine whether the term “Redskins” is “immoral or scandalous” without favoring or disfavoring a subset of views. For example, unlike the term “FUCTION,” which has hardly any other meaning than its vulgar one when considered in context, the term “Redskins” has multiple meanings, allegedly both good and bad, when considered in the context of professional football.<sup>190</sup> As such, any decision as to whether the term “Redskins” is “immoral or scandalous” may show favor to either the “good” or “bad” subset of views.

The legislative history of Section 2(a) of the Lanham Act further indicates that the method of evaluating *ethnicity*-related marks under the “immoral or scandalous” clause is nearly identical to the method of evaluating marks under the “disparagement” clause. In 1905, Congress passed the Trademark Act, which was the first federal statute that barred registration of specific types of trademarks.<sup>191</sup> Although the act

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may be disparaging is highly subjective and, thus, general rules are difficult to postulate.”).

<sup>186</sup> See *Matal v. Tam*, 137 S. Ct. 1744, 1763 (2017) (“[I]n the sense relevant here, that is viewpoint discrimination: Giving offense is a viewpoint.”); *id.* at 1765 (Kennedy, J., concurring) (“As the Court is correct to hold, §1052(a) constitutes viewpoint discrimination—a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny.”).

<sup>187</sup> See Petition for Writ of Certiorari at 19, *In re Brunetti*, 15 U.S.L.W. 1109 (2018) (No. 18-302) (arguing that “unlike the disparagement provision that the Court struck down in *Tam*, the scandalous-marks provision is viewpoint-neutral”).

<sup>188</sup> *Id.*

<sup>189</sup> *LaLonde & Gilson*, *supra* note 164, at 1513 (“The [TTAB] has looked at trademarks that might disparage certain ethnicities under the scandalousness provision as well, though after the *Lebanese Arak* decision, it will focus instead on the disparagement provision in future cases.”).

<sup>190</sup> *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1748–49 (T.T.A.B. 1999).

<sup>191</sup> The 1905 Trademark Act states: “[N]o mark by which the goods of the

*continued . . .*



contained language forbidding “immoral or scandalous” trademarks, it lacked any language barring marks that were “disparaging” to persons living or dead.<sup>192</sup> Instead, trademarks alleged to be offensive to certain categories of people were challenged on the basis of the “immoral or scandalous” clause.<sup>193</sup> But when it later became evident that a different standard was needed for marks considered “scandalous” to specific groups of people,<sup>194</sup> Congress passed Section 2(a) of the Lanham Act in 1946, which explicitly contained a “disparagement” clause.<sup>195</sup> Because Congress revised the Trademark Act by explicitly adding a “disparagement” clause, it is clear that Congress intended for ethnicity-related marks to have a different evaluation standard.<sup>196</sup> Now that that standard was ruled unconstitutional in *Tam*,<sup>197</sup> the method of evaluating ethnicity-related marks under the “immoral or scandalous” clause may get struck down as well.

Because *Tam* ruled that denying marks on the basis of the “disparagement” clause constituted impermissible viewpoint discrimination, courts will likely be slow to cancel the term “Redskins” on the basis of the “immoral or scandalous” clause. Like the method of evaluating terms under the “disparagement” clause, the method of evaluating ethnicity-related terms under the “immoral or scandalous” clause comes dangerously close to singling out a subset of views for favor or disfavor. Because such evaluation methods constitute viewpoint discrimination, courts will likely be hesitant to rule in the short term that the term “Redskins” is immoral or scandalous.

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owner of the mark may be distinguished from other goods of the same class shall be refused registration as a trade--mark on account of the nature of such mark unless such mark-- (a) Consists of or comprises immoral or scandalous matter.” Trademark Act of 1905 § 5, 15 U.S.C. § 1051 (2012).

<sup>192</sup> *See id.*

<sup>193</sup> *LaLonde & Gilson*, *supra* note 164, at 1510–14 (stating that before the passage of the Lanham Act in 1946, challenges against trademarks alleged to be offensive against categories of people were raised under the “immoral or scandalous” clause).

<sup>194</sup> *Ex parte Summit Brass & Bronze Works, Inc.*, 59 U.S.P.Q. 22 (Comm’r Pats. 1943); *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938).

<sup>195</sup> *See* 15 U.S.C. § 1052 (2012).

<sup>196</sup> *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2D (BNA) 1215, 1217 (T.T.A.B. 2010) (“[I]t has become clear that the proper ground for refusing marks which would offend the sensibilities of an ethnic or religious group is that the matter is disparaging to the members of that group, rather than that the matter is offensive or scandalous.”).

<sup>197</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1751 (2017).

### C. Public Policy Concerns

In the realm of trademark law, courts have been especially cautious to avoid rulings that would upset free speech and the “marketplace of ideas.”<sup>198</sup> Traditionally, courts have looked to protect the “marketplace of ideas” in a metaphorical sense in the context of news, public speeches, and the media.<sup>199</sup> But in the realm of trademarks, that metaphor becomes a “tangible, powerful reality.”<sup>200</sup> As Justice Kennedy stated in *Tam*, the marketplace of ideas in the trademark context “make[s] up part of the expression of everyday life” for entertainment groups, broadcast networks, designer clothing, newspapers, and so on.<sup>201</sup> Even nonprofit organizations rely on trademarks to “compete” in a real economic sense by using their names to persuade others to join and contribute funds to their cause.<sup>202</sup> If trademark law made it overly difficult for applicants to register their chosen marks, then many individuals would be unable to compete in their respective markets and innovation would be stifled.<sup>203</sup> Furthermore, courts have emphasized that the First Amendment protects more than just the right to identify with a particular side.<sup>204</sup> It also protects the right to create and present views for a particular position in particular ways, as the speaker chooses.<sup>205</sup> Overly restrictive trademark laws would “silence and distort the marketplace of ideas” and might even permit unlawful “government censorship.”<sup>206</sup>

However, on the opposite side of the spectrum are three traditional policy justifications for restricting certain trademarks. One is that the federal government should not create the appearance that it “favors or approves the use of scandalous, immoral and disparaging trademarks.”<sup>207</sup> Another policy objective is for the federal government

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<sup>198</sup> *Id.* at 1767–68 (Kennedy, J., concurring) (citing *Abrams v. United States*, 250 U.S. 616, 630 (1919) where Justice Holmes made reference to the “free trade in ideas” and the “power of . . . thought to get itself accepted in the competition of the market”).

<sup>199</sup> *See, e.g.*, *Miami Herald Pub. Co., Div. of Knight Newspapers, Inc. v. Tornillo*, 418 U.S. 241, 248 (1974).

<sup>200</sup> *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring).

<sup>201</sup> *Id.* (Kennedy, J., concurring).

<sup>202</sup> *Id.* (Kennedy, J., concurring).

<sup>203</sup> *Id.* (Kennedy, J., concurring).

<sup>204</sup> *Id.* at 1766 (Kennedy, J., concurring).

<sup>205</sup> *Id.* (Kennedy, J., concurring).

<sup>206</sup> *Id.* (Kennedy, J., concurring).

<sup>207</sup> Megan M. Carpenter & Kathryn T. Murphy, *Calling Bullshit on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 365, 468 (2010) (citing Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral*

to “promote the public health, welfare, and morals” by discouraging the use of immoral and disparaging trademarks.<sup>208</sup> Finally, the third policy justification is that the federal government should “protect the sensitivities of those in public who might be offended by such trademarks.”<sup>209</sup> Taken together, these policy considerations have been counterbalanced against the policy concerns for less restrictive trademark laws.<sup>210</sup>

After *Tam*, however, the balance of policy concerns has tilted in favor of lighter trademark restrictions. For example, concerns about the need to restrict certain trademarks to “protect the sensitivities” of those who might be “offended” has now given way to Justice Alito’s decision in *Tam* that “the giving [of an] offense” is a constitutionally protected “viewpoint.”<sup>211</sup> Justice Kennedy’s emphasis in *Tam* on the need to protect the “marketplace of ideas” in the realm of trademarks has also elevated the policy justifications for less restrictive trademark laws.<sup>212</sup> Against this background, the Washington “Redskins” trademark is currently in a favorable position to survive policy challenges against its registration. Justice Kennedy’s emphasis on the need to protect the “marketplace of ideas” coupled with Justice Alito’s deemphasize on the need to restrict “offensive” viewpoints has placed trademarks like “Redskins” in a strong policy position, at least for the short term.

#### **D. Conclusion: The Future of the Redskins Trademark**

Plaintiffs like Blackhorse face the following obstacles in their battle against the “Redskins” trademark: (1) it is unclear whether the term “Redskins” meets the traditional definition of the words “immoral or scandalous”; (2) the method of analyzing terms under the “immoral or scandalous” clause comes dangerously close to committing what caused the “disparagement” clause to get struck down in *Tam*; and (3) as a matter of public policy, courts have been cautious to avoid rulings that would upset the “marketplace of ideas” in the realm of trademarks.

Going forward, however, these obstacles can be overcome. The term “Redskins” might eventually satisfy the traditional definition of the words “immoral or scandalous” if more evidence is found that the *general public* views the term as “shocking to the sense of truth,

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*Trademarks*, 83 TRADEMARK REP. 661, 674–75 (1993)).

<sup>208</sup> *Id.*

<sup>209</sup> *Id.*

<sup>210</sup> *Id.*

<sup>211</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1763 (2017) (“Giving offense is a viewpoint.”).

<sup>212</sup> *Id.* at 1768 (Kennedy, J., concurring).

decency, or propriety.”<sup>213</sup> Because the evidence in *Blackhorse* predominantly focused on the attitudes of Native Americans,<sup>214</sup> that evidence will likely not be broad enough to satisfy the “subject group” prong of the “immoral or scandalous” clause. In order to satisfy this prong, plaintiffs like *Blackhorse* should gather more evidence concerning the broader public’s sentiment about the term “Redskins.”

The term “Redskins” might also satisfy the “shocking” prong of the “immoral or scandalous” clause if the term is shown to be “obscene” or “vulgar.”<sup>215</sup> Although the term “Redskins” is commonly associated more with “ethnicity” than with “profanity,” “violence,” or “sexual references,” the mere fact that the term is ethnicity-based does not preclude it from qualifying as “shocking to the sense of truth, decency, or propriety.” Like the “N-word” or the “K-word,” the term “Redskins” could be shown to be—if not already—so vulgar or obscene to the general public that cancellation of the mark would be warranted.<sup>216</sup>

If the term “Redskins” ultimately surpasses the obscenity/vulgarity threshold to become “immoral or scandalous,” then the cancellation of the term arguably would not constitute discrimination based on viewpoint. Instead, such a cancellation would constitute no more than a viewpoint *neutral* restriction on speech because it would not grant favor or disfavor to a subset of views;<sup>217</sup> such a cancellation would merely target “a combination of letters” that stands for a vulgar or obscene term. Furthermore, as a public policy matter, cancelling such a term would not upset the “marketplace of ideas” because it would prevent vulgar and obscene terms from disrupting the “orderly flow of commerce.”<sup>218</sup> Indeed, the federal government has a strong interest in shielding the sensibilities of the public from vulgar and obscene

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<sup>213</sup> *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1746 (T.T.A.B. 1999) (a term is “scandalous” to a “substantial composite” of the general public if enough members of the public, who do not necessarily make up a majority, find the term “shocking to the sense of truth, decency, or propriety” or “offens[ive] to the conscious or moral feelings”).

<sup>214</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439, 480–81 (E.D. Va. 2015).

<sup>215</sup> Marks found to be “vulgar” are generally regarded as “scandalous. *See In re Big Effin Garage, LLC*, 2010 TTAB LEXIS 418, at \*3 (T.T.A.B. 2010); *In re RK Netmedia, Inc.*, 2009 TTAB LEXIS 389, at \*3 (T.T.A.B. 2009).

<sup>216</sup> *LaLonde & Gilson*, *supra* note 164, at 1489 (stating that if a mark in context is extremely offensive, it is scandalous).

<sup>217</sup> *Petition for Writ of Certiorari, In re Brunetti*, 15 U.S.L.W. 1109 (2018) (No. 18-302) (arguing that restricting speech in a viewpoint-neutral manner does not violate the First Amendment).

<sup>218</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017) (acknowledging that the government has an interest in the orderly flow of commerce).

speech.<sup>219</sup>

Plaintiffs like Blackhorse might also consider how the Supreme Court may distinguish the application of *Tam* in the context of professional sports team names. Unlike band names such as “The Slants” or company slogans such as “Just do it” or “Have it your way,” professional sports team names could arguably be regarded as “government speech” or “commercial speech” and, therefore, warrant relaxed First Amendment restrictions. On one hand, it could be argued that professional sports team names qualify as government speech under the *Walker* three-factor test: first, professional sports team names such as the Washington Redskins arguably have a history of communicating the message that the government and host state approve the use of those names;<sup>220</sup> second, professional sports team names are “often closely identified in the public mind with the state,” given that each team name is linked with a state or city;<sup>221</sup> finally, the government and host states often exercise some control over the messages conveyed through professional sports team names.<sup>222</sup> Although the Supreme Court in *Tam* held that federal trademarks do not qualify as government speech, the Court has a history of granting exceptions in the context of professional sports.<sup>223</sup> Similar to how professional baseball is exempt from antitrust

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<sup>219</sup> LaLonde & Gilson, *supra* note 164, at 1486 (stating that the government has an interest in protecting the public from vulgar or obscene speech).

<sup>220</sup> Bob Heere & Jeffery D. James, *Sports Teams and Their Communities: Examining the Influence of External Group Identities on Team Identity*, 21 J. SPORT MGMT. 319, 326 (2007) (reviewing economic impact studies that emphasize that a sports team is an instrument for showing community pride by expressing the bond between the team and its city).

<sup>221</sup> *Id.*

<sup>222</sup> For example, the host state often exercises control over the venues where the team’s name is displayed in public. See Chris Isidore, *NFL Gets Billions in Subsidies from U.S. Taxpayers*, CNN (Jan. 30, 2015, 10:53 AM), <https://money.cnn.com/2015/01/30/news/companies/nfl-taxpayers/index.html> (stating that twenty new NFL stadiums have opened since 1997 with the help of \$4.7 billion in funds from government); Cecilia Kang, *How the Government Helps the NFL Maintain its Power and Profitability*, WASH. POST (Sept. 16, 2014), [https://www.washingtonpost.com/news/business/wp/2014/09/16/how-the-government-helps-the-nfl-maintain-its-power-and-profitability/?utm\\_term=.8ef85a7671e2](https://www.washingtonpost.com/news/business/wp/2014/09/16/how-the-government-helps-the-nfl-maintain-its-power-and-profitability/?utm_term=.8ef85a7671e2) (discussing how subsidies from local governments and states have helped NFL teams fund new stadiums and all the infrastructure around them).

<sup>223</sup> Professional baseball is renowned for being exempt from federal antitrust laws. See Samuel A. Alito, Jr., *The Origin of the Baseball Antitrust Exemption: Federal Baseball Club of Baltimore, Inc. v. National League of Professional Baseball Clubs*, 34 J. SUP. Ct. HIST. 183, 190–93 (2009) (reviewing the history of professional baseball’s exemption from federal antitrust law). Exemptions have also been extended to agreements covering the telecasting of sports contests and the combining of professional football leagues. See 15 U.S.C. §§ 1291–1295 (2012).

suits under the Sherman Act,<sup>224</sup> the registration of professional sports team names could get exempt from the Court's general rule set in *Tam*.

Furthermore, the Supreme Court might alternatively regard the registration of professional sports team names as "commercial speech" and, therefore, permit the USPTO to restrict the "Redskins" trademark in accordance with the *Central Hudson* test. Under the *Central Hudson* test, the "Redskins" trademark, as "commercial speech," could arguably be restricted if the term qualifies as "immoral or scandalous."<sup>225</sup> Such a restriction would (1) serve a "substantial government interest" by ensuring that "immoral or scandalous" trademarks do not disrupt the "orderly flow of commerce";<sup>226</sup> it could also be argued that (2) the "immoral or scandalous" clause is "narrowly drawn," given that the standard for determining whether a mark is "immoral or scandalous" is narrow and favors the applicant.<sup>227</sup> Although the Court in *Tam* chose not to permit the restriction of "disparaging" marks under the *Central Hudson* test, *Tam* left open the possibility of restricting terms in commerce found to be "immoral or scandalous."<sup>228</sup>

Blackhorse's battle against the Washington Redskins trademark appeared all but over after the Supreme Court's ruling in *Tam*. But whether that case stands for Blackhorse's last stand is uncertain now that the Supreme Court granted the USPTO's cert petition in *In re Brunetti*. Although it is unclear whether the term "Redskins" will qualify as "immoral or scandalous" in the short term, there will be greater grounds for courts to cancel the term if the meaning of "Redskins" is shown to be vulgar, obscene, or shocking to the sense of truth, decency or propriety to a substantial composite of the general population. As Blackhorse stated, "the fight is not over."<sup>229</sup>

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<sup>224</sup> See *Fed. Baseball Club of Balt., Inc. v. Nat'l League of Prof'l Baseball Clubs*, 259 U.S. 200, 208–09 (1922) (holding that professional baseball is exempt from federal antitrust law); see also *Flood v. Kuhn*, 407 U.S. 258, 285 (1972) (ruling consistent with *Federal Baseball* and *Toolson* by preserving professional baseball's exemption from federal antitrust law); *Toolson v. N.Y. Yankees, Inc.*, 346 U.S. 356, 357 (1953) (upholding professional baseball's exemption from federal antitrust law).

<sup>225</sup> Under the *Central Hudson* test, restriction of commercial speech is permitted if the restriction (1) serves a substantial government interest and (2) is narrowly drawn. See *Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n*, 447 U.S. 557, 569–70 (1980).

<sup>226</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1764 (2017).

<sup>227</sup> *LaLonde & Gilson*, *supra* note 164, at 1507.

<sup>228</sup> *Tam*, 137 S. Ct. at 1768 (Kennedy, J., concurring) ("This case does not present the question of how other provisions of the Lanham Act should be analyzed under the First Amendment.").

<sup>229</sup> *Fish*, *supra* note 10.