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**DOES BUDDA BEACHWEAR ACTUALLY FIT?
AN ANALYSIS OF FEDERAL REGISTRATION FOR ALLEGEDLY
DISPARAGING TRADEMARKS IN THE NON-CORPORATE CONTEXT**

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ABSTRACT

The Trademark Trial and Appeals Board (“TTAB”) has experienced an uptick in challenges to the federal registration of trademarks as disparaging to discernable groups of individuals brought before it in recent years. Under § 2(a) of the Lanham Act, disparaging marks cannot be placed on the Principle Register. While the TTAB has developed its disparaging mark jurisprudence with respect to individuals as a distinct bar to registration over the last twenty years; the Federal Courts have only considered the TTAB’s treatment of these allegedly disparaging marks once during the same span of time. The TTAB’s decisions regarding allegedly disparaging trademarks subsequent to the Federal Courts’ approval of the basic two-prong test for finding a trademark disparaging have uncovered the flaws with the TTAB’s approach to these marks. These flaws create insurmountable hurdles for petitioners seeking to cancel a disparaging mark. Ideally a Federal Court will address these hurdles in the inevitable appeal of the TTAB’s decision in *Blackhorse v. Pro-Football, Inc.* This article seeks to identify these hurdles to resolving whether or not a trademark is in fact disparaging in degradation of the Lanham Act and proposes pragmatic means for minimizing these hurdles.

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I. INTRODUCTION

Throughout history, derogatory labeling and ethnic slurs have provided a means for the dominate majority to subordinate and disparage minorities.¹ Although the law cannot generally prohibit the use of slurs or other pejorative terms,² American trademark creates a significant disincentive against the use of pejorative terms as trademarks by prohibiting their federal registration.³ This prohibition on registering disparaging marks has received mainstream media attention in recent years as a result of the drawn-out legal struggle of seven American Indians seeking to compel the cancellation of the federal registration of the Washington Redskins' trade and service marks.⁴ These cancellation proceedings, initiated in 1992 by Suzan Harjo⁵ and six other American Indians, spanned over seventeen years and reached the Court of Appeals for the District of Columbia Circuit on two occasions.⁶ The central contention of the American Indians' claim is that the REDSKINS family of marks is disparaging, in derogation of the requirements for federal trademark registration. Despite the seemingly endless nature of the litigation, this central contention remains effectively unresolved, given that the American

¹ IRVING LEWIS ALLEN, *UNKIND WORDS: ETHNIC LABELING FROM REDSKIN TO WASP* 8 (1990) ("A primitive belief lingers in all societies that if one can name or attach a label to an object, in this case an ethnic individual or group, then one can wield power over it simply by calling its name.").

² *See, e.g., Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686, 695 (6th Cir. 1981) (holding use of the mark "Sambo's," a pejorative term for African-Americans, for pancake houses is protected commercial free speech).

³ 15 U.S.C. § 1052(a) (2006).

⁴ *See, e.g., Lester Munson, Scandal, Slurs, Sex . . . Happy Holiday!*, ESPN.COM, Nov. 25, 2009, <http://sports.espn.go.com/espn/commentary/news/story?page=munson/091125>; Bill Mears, *Court Rejects Appeal over Redskins Trademark*, CNN.COM, Nov. 16, 2009, <http://www.cnn.com/2009/CRIME/11/16/scotus.redskins/index.html>.

⁵ Suzan Shown Harjo is a prominent American Indian activist and an author for INDIAN COUNTRY TODAY. *See* Suzan Shown Harjo, *Harjo: Dirty Word Games*, INDIAN COUNTRY TODAY, Sept. 10, 2008, <http://www.indiancountrytoday.com/archive/28165049.html> for her perspective of the litigation. *See also* Suzan Shown Harjo, *Harjo: Get Educated* (June 3, 1999), *in* ESPN.COM: OTL, <http://espn.go.com/otl/americans/harjochat.html> for a transcript of an online chat conducted by ESPN between Harjo and members of the public.

⁶ The case involved two decisions by the TTAB (one precedential), two orders with associated opinions rendered by the District Court for the District of Columbia, an appeal to the Court of Appeals for the District of Columbia Circuit, a subsequent remand back to the District Court for the District of Columbia, another appeal to the Court of Appeals for the District of Columbia Circuit, and ultimately a denial of certiorari by the Supreme Court of the United States of America. These proceedings will be identified and discussed in further detail *infra*.

Indians' challenge was ultimately dismissed on procedural grounds.⁷ This article seeks to address the substantive hurdles to resolving whether or not a mark is in fact disparaging in degradation of the Lanham Act.

Part II of this article briefly describes the foundation of American federal trademark law, dealing specifically with the requirements for registering a mark on the Principal Register pursuant to the Lanham Act and the procedures for subsequently removing a mark from Principal Register under certain circumstances. Part III tracks the evolution of the Trademark Trial and Appeal Board's ("TTAB") and the federal courts' disparaging mark jurisprudence, with particular focus on the litigation surrounding the REDSKINS family of marks used in connection with professional football. Part IV then explores the necessity of addressing the deficiencies of the TTAB's and the court's current disparaging mark jurisprudence. Furthermore, this section discusses the impact leaving these deficiencies unresolved will have on other marks which are highly susceptible to being challenged as disparaging. Lastly, Part V of this article presents possible modifications to the TTAB's current disparaging mark jurisprudence in an attempt to provide historically disadvantaged minority groups, particularly American Indians, with a realistic opportunity to successfully cancel a registered mark on the grounds the mark is disparaging to said minority group, as well as minimize disparate outcomes for the same mark regardless of if the mark is challenged *ex parte* or *inter partes*.

II. REGISTRATION & CANCELLATION OF MARKS UNDER THE LANHAM ACT

The law regarding the protection of trade and service marks at the federal level in the United States is governed by the Lanham Act.⁸ The Lanham Act was enacted pursuant to Congress' commerce clause powers⁹ in 1946,¹⁰ in part, to protect consumers from confusion when

⁷ Pro-Football, Inc. v. Harjo (*Harjo Appeal II*), 565 F.3d 880, 881 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

⁸ 15 U.S.C. §§ 1051-1141n (2006).

⁹ Melissa E. Roth, Note, *Something Old, Something New, Something Borrowed, Something Blue: A New Tradition in Nontraditional Trademark Registrations*, 27 CARDOZO L. REV. 457, 471 n.82 (2005).

¹⁰ Brian L. Landry, *From Book Covers to Domain Names: Searching for the True Meaning of the Cliffs Notes Temporal Test for Parody*, 7 J. HIGH TECH. L. 19, 21 n.10 (2007).

identifying the source of goods or services.¹¹ Trademark law provides this consumer protection by affording the owners of a federally registered mark the “exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein.”¹² In order for a mark to be registered on the Principle Register¹³ the owner of the mark must file an application for registration with the United States Patent and Trademark Office (“USPTO”),¹⁴ the mark must be used in interstate commerce,¹⁵ the mark must be distinguishable from another’s mark,¹⁶ and the mark must not abridge the content limitations set forth in § 2 of the Lanham Act.¹⁷ The most important of these limitations, with respect to this article, is the prohibition against registering a mark comprising a “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.”¹⁸

Even if a mark is successfully registered on the Principle Register, it may subsequently be removed from the Principle Register by the TTAB or the courts through a cancellation proceeding.¹⁹ Numerous grounds for cancellation exist;²⁰ however, this article only addresses the cancellation of a “registered mark . . . [when] its registration was obtained fraudulently or contrary to the provisions of . . . subsection (a) . . . of section 1052 of this title for a registration under this chapter”²¹ Generally, a cancellation proceeding must

¹¹ Keith Aoki, *Balancing Act: Reflections on Justice O'Connor's Intellectual Property Jurisprudence*, 44 HOUS. L. REV. 965, 985 (2007) (citing *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 32 (2003) (Scalia, J.)).

¹² 15 U.S.C. § 1115 (2006). Generally, a mark’s registration is “subject to . . . conditions or limitations” when the mark has concurrent users. *See id.* § 1052(d) (“In issuing concurrent registrations, the Director shall prescribe conditions and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.”).

¹³ In addition to the Principle Register, the United States Patent and Trademark Office maintains a second register for marks, the Supplemental Register. *Id.* §§ 1091-96. A mark may be registered on the Supplemental Register if it would otherwise satisfy the requirements for registration on the Primary Register except for lacking distinctiveness. *Id.* § 1091(a).

¹⁴ *Id.* § 1051(a)(1).

¹⁵ *Id.*

¹⁶ *Id.* § 1052.

¹⁷ *Id.* § 1052(a)-(e).

¹⁸ *Id.* § 1052(a).

¹⁹ *Id.* §§ 1064, 1119.

²⁰ *Id.* § 1064.

²¹ *Id.* § 1064(3). The prohibition against registering a disparaging mark is contained in subsection (a) of title fifteen, § 1052. *Id.* § 1052(a).

be brought before the TTAB.²² The actual procedures for a cancellation proceeding before the TTAB parallel those of a civil suit in federal court.²³ A party to a cancellation proceeding may appeal the TTAB's decision directly to the United States Court of Appeals for the Federal Circuit²⁴ or may seek redress of the TTAB's decision via a civil cause of action in federal district court.²⁵

Cancellation of federally registered mark only prevents a mark owner from enjoying the benefits of registration on the Principal Register.²⁶ Consequently, a mark's status as disparaging does not necessarily invalidate any common law rights the mark owner may have with respect to the mark.²⁷ Furthermore, protection of a mark under state law is generally not contingent upon federal registration of the mark.²⁸ As such, if a mark's federal registration is cancelled, the owner of the mark may still have enforceable rights under the common law or state law.²⁹ Even if the owner of a mark lacks any enforceable

²² *Id.* § 1064; 37 C.F.R. § 2.111(a)-(b) (2009). In addition to a cancellation proceeding brought before the TTAB pursuant to § 14 of the Lanham Act, a court may cancel a mark pursuant to § 37 of the Lanham Act. 15 U.S.C. § 1119. Although the district courts have concurrent jurisdiction with the TTAB to cancel a mark, there must be an underlying basis for the district court's jurisdiction over the proceedings. *E.g.* *Ditri v. Coldwell Banker Residential Affiliates, Inc.*, 954 F.2d 869, 873-74 (3d Cir. 1992). Thus, a party wishing to cancel a mark's registration without an additional and independent means to be heard in federal court must bring their cancellation proceedings pursuant to § 14 of the Lanham Act.

²³ A cancellation proceeding is commenced with the filing of a cancellation petition and the applicable fee with the TTAB. 37 C.F.R. § 2.111(a) (2009). The petition need only state "a short and plain statement" as to the grounds on which cancellation is based, that the petitioner is damaged by the registration and the name and address of the current owner of the registered mark. *Id.* § 2.112(a). The respondent must file an answer to avoid default judgment. *Id.* § 2.114(a)-(b)(1). The actual cancellation proceedings, including discovery, are governed by the Federal Rules of Civil Procedure, except for certain limitations on their applicability laid out in the Code of Federal Regulations. *Id.* §§ 2.116, 2.120(a)(1).

²⁴ 15 U.S.C. §1071(a)(1) (2006).

²⁵ *Id.* §1071(b)(1).

²⁶ Paul E. Loving, *Native American Team Names in Athletics: It's Time to Trade These Marks*, 13 LOYOLA L.A. ENT. L.J. 1, 35 (1992).

²⁷ *Id.* Some academics, including the reporters of the First Restatement of Torts, have argued that trademarks which are against public policy should not enjoy common law protection. RESTATEMENT (FIRST) OF TORTS §§ 715(d), 726 (1938); Loving, *supra* note 26, at 36. Furthermore, it has been argued marks unregistrable under § 2(a) of the Lanham Act are against public policy, and as such shouldn't receive common law protection. Loving, *supra* note 26, at 36.

²⁸ Christian Dennie, *Native American Mascots and Team Names: Throw Away the Key; The Lanham Act is Locked for Future Trademark Challenges*, 15 SETON HALL J. SPORTS & ENT. L. 197, 218-19 (2005).

²⁹ Landry, *supra* note 10, at 21 n.10 (citing *PETA v. Doughney*, 263 F.3d 359, 362 (4th Cir. 2001)). In enacting the Lanham Act, Congress "clearly intended" to allow the continued and concurrent existence of at least some state trademark law. ROBERT

property interest in a mark, the law does not prohibit the use of the mark in commerce,³⁰ so long as it does not interfere with the rights of a third party.

III. THE EVOLUTION OF FEDERAL DISPARAGING MARK JURISPRUDENCE

Although the Lanham Act provides individuals and entities the ability to cancel a mark's registration on the basis that the mark is disparaging,³¹ there is a dearth of individuals or entities which have sought cancellation on such grounds.³² Further complicating any analysis of the TTAB's disparaging mark jurisprudence is the TTAB's and the courts' tendency to obfuscate whether their decision is based on the scandalous nature or the disparaging nature of the mark in question.³³ Muddling this area of the law even further is the differential treatment of allegedly disparaging marks that reference

P. MERGES ET AL., INTELLECTUAL PROPERTY IN THE NEW TECHNOLOGY AGE 852 (3d ed. 2003).

³⁰ *In re Boulevard Entm't, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (“[T]he refusal to register a mark does not . . . not affect the applicant's right to use the mark in question”).

³¹ 15 U.S.C. §§ 1052(a), 1064(3) (2006).

³² Ethan G. Zlotchew, “Scandalous” or “Disparaging”? *It Should Make a Difference in Opposition and Cancellations Actions: Views on the Lanham Act's Section 2(a) Prohibitions Using the Example of Native American Symbolism in Athletics*, 22 COLUM.-VLA J.L. & ARTS 217, 230 (1998). Subsequent to Mr. Zlotchew's article, the TTAB has considered if five families of marks were disparaging to specific groups of individuals. *In re Lebanese Arak Corp.*, 94 USPQ2d (BNA) 1215 (T.T.A.B. 2010); *In re Heeb Media LLC*, 89 U.S.P.Q.2d (BNA) 1071 (T.T.A.B. 2008); *In re Squaw Valley Development Co.*, 80 U.S.P.Q.2d 1264 (T.T.A.B. 2006); *Order Sons of Italy in Am. v. Memphis Mafia Inc.*, 52 U.S.P.Q.2d (BNA) 1364 (T.T.A.B. 1999); *Harjo v. Pro-Football, Inc. (Harjo II)*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999). This number does not include challenges in which the TTAB considered if the mark was disparaging to a corporate entity or the status of an allegedly mark was ultimately resolved on other grounds without consideration of the mark's disparaging nature. *E.g.*, *Boston Red Sox Baseball Club Limited Partnership v. Sherman*, 88 U.S.P.Q.2d (BNA) 1581, 1582-83, 1593 (T.T.A.B. 2008) (holding the applied for mark, “Sex Rod,” disparaging to Major League Baseball's Boston Red Sox); *McDermott v. S.F. Women's Motorcycle Contingent*, 81 U.S.P.Q.2d (BNA) 1212, 1212, 1216 (T.T.A.B. 2006) (dismissing the petitioner's opposition to the mark “Dykes on Bikes” on the grounds the petitioner did not establish that he would be damaged by the mark).

³³ *See Harjo v. Pro-Football, Inc. (Harjo II)*, 50 U.S.P.Q.2d (BNA) 1705, 1737 n.97 (T.T.A.B. 1999) (“This is notwithstanding the fact that a number of older decisions appear to consider scandalousness and disparagement under Section 2(a) as a single issue wherein the questionable matter is determined to be scandalous, or not, because it is, or is not, disparaging”); *See also*, Zlotchew, *supra* note 32, at 230 (noting that courts have sometimes treated disparaging and scandalous as synonymous).

corporate entities and allegedly disparaging marks that reference groups of individuals.³⁴ Notwithstanding the foregoing, over the last twenty years the TTAB has resolved the registration status of at least six families of marks solely on the grounds of whether or not the marks were disparaging to an identifiable group of people.

A. *IN RE HINES*³⁵

The TTAB established its current disparaging mark jurisprudence with respect to identifiable groups of individuals in the 1994 case *In re Hines*. The applicant in *Hines* sought to register the mark BUDDA BEACHWEAR for certain apparel.³⁶ The examining attorney denied the mark registration on the grounds that the mark “disparage[d] . . . the religion of Buddhism.”³⁷ In determining if the mark in question did in fact disparage the religion of Buddhism, the TTAB considered the perception of the mark by “those referred to, identified or implicated in some recognizable manner by the involved mark” because “the portion of Section 2(a) proscribing disparaging marks targets certain persons, institutions or beliefs.”³⁸ Of particular importance when considering future disparaging mark cancellation proceedings, the TTAB recognized that the opinions of the general public were “irrelevant” to the determination of if a mark disparages an identifiable group.³⁹

After considering the practices of Buddhists and Buddhists’ perception of Guatama Buddha in general, the TTAB, based on encyclopedia passages and its own opinions,⁴⁰ determined that “[t]o depict Buddha in the manner shown in applicant’s mark slights and

³⁴ Compare *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988) (applying an objective standard to determine if an allegedly disparaging mark disparaged a corporation), with *In re Hines (Hines II)*, 32 U.S.P.Q.2d (BNA) 1376, 1377 (T.T.A.B. 1994) (applying a subjective standard to determine if an allegedly disparaging mark disparaged a religion).

³⁵ 31 U.S.P.Q.2d (BNA) 1685 (T.T.A.B. 1994), *vacated on other grounds*, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994).

³⁶ *In re Hines (Hines I)*, 31 U.S.P.Q.2d (BNA) 1685, 1685-86 (T.T.A.B. 1994).

³⁷ *Id.* at 1686.

³⁸ *Id.* at 1688. A number of the cases cited by the TTAB for this proposition pertained to if the mark in question was scandalous. *Id.* The TTAB relied on these cases notwithstanding its earlier recognition that a number of these cases dealt with scandalous marks, which is a distinct grounds for cancellation or denial of registration. *Id.* at 1687. It should be noted though, that at least one of the relied upon cases was the unsuccessful 1976 challenge to the mark JAP as scandalous. *Id.* at 1688 (citing *In re Condas S.A.*, 188 U.S.P.Q. (BNA) 544 (T.T.A.B. 1975)).

³⁹ *Id.*

⁴⁰ *Id.* at 1688-89.

cheapens the image to which Buddhists pay devotion.”⁴¹ The TTAB held this was sufficient evidence to show the mark BUDDA BEACHWEAR disparaged Buddhists, and therefore denying the mark registration was proper.⁴²

Approximately three months after the TTAB’s initial decision to deny the registration of the BUDDA BEACHWEAR mark, the TTAB, “upon further reflection” and a petition to reconsider, elected to allow the mark to pass to publication.⁴³ This decision was precipitated by the Court of Appeals for the Federal Circuit’s decision in *In re Mavety Media Group, Ltd.*⁴⁴ Although the mark in *Mavety Media Group* was challenged as being “scandalous,” the TTAB interpreted the Federal Circuit’s opinion to mandate the TTAB to consider more than just its own opinions and dictionaries in determining the opinion of “a substantial composite of the general public.”⁴⁵ Given that the TTAB had relied almost exclusively on “personal opinions and encyclopedic sources,” to determine the views of Buddhists, the TTAB vacated its previous decision.⁴⁶ In sum, the TTAB’s reconsideration of *Hines* left the legal analysis and standards applicable to determining if a mark is disparaging untouched, but clarified the type of evidence required to show a mark is disparaging.

B. *HARJO V. PRO-FOOTBALL, INC.*⁴⁷

To date, the highest-profile case involving allegedly disparaging marks has been a litigation which began in 1992 when a group of American Indians filed a cancellation petition with the TTAB seeking the cancellation of six marks involving in some way the term “redskins.”⁴⁸ The petitioners specifically alleged that the term

⁴¹ *Id.* at 1689.

⁴² *Id.* at 1691.

⁴³ *In re Hines (Hines II)*, 32 U.S.P.Q.2d (BNA) 1376, 1376 (T.T.A.B. 1994).

⁴⁴ *Id.*

⁴⁵ *Id.* at 1376-77 (citing *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994)).

⁴⁶ *Id.* at 1377. As a historical note, BUDDA BEACHWEAR was never registered on the Principle Register even though the applicant, Richard Hines, spent almost five years (from filing to publication for opposition) trying to register the mark. USPTO TARR Server, *Latest Status Info*, <http://tarr.uspto.gov/servlet/tarr?regser=serial&entry=74037972>. The mark was ultimately deemed abandoned because Hines failed to file a statement of use after the notice of allowance was issued. *Id.*

⁴⁷ *Harjo v. Pro-Football, Inc. (Harjo II)*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999), *rev'd*, 284 F. Supp. 2d 96 (D.D.C. 2003), *aff'd in part and rev'd in part*, 415 F.3d 44 (D.C. Cir. 2005), *remanded to* 567 F. Supp. 2d 46 (D.D.C. 2008), *aff'd*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

⁴⁸ *Pro-Football, Inc. v. Harjo (Harjo IV)*, 284 F. Supp. 2d 96, 99 (D.D.C. 2003).

“redskin” was a “pejorative, derogatory, degrading, offensive, scandalous, contemptuous, disreputable, disparaging, and racist designation for a Native American person.”⁴⁹ In response, Pro-Football, Inc. asserted a number of affirmative and constitutional defenses,⁵⁰ and in 1994, the TTAB struck Pro-Football’s affirmative defenses.⁵¹ More importantly, the TTAB specified that the “critical dates” for determining whether the marks were disparaging would be the dates that the marks were issued; thus any evidence must show that the marks were disparaging at the date of issuance rather than the date of the cancellation petition.⁵² In reaching this decision, the TTAB relied on three previous decisions where the TTAB required the petitioners to show the marks in question were geographically descriptive, suggested a false connection to the petitioner, or were merely descriptive at the time of registration and not at the time of the cancellation petition.⁵³

Five years after striking Pro-Football’s affirmative defenses and settling the relevant time period, the TTAB delivered its decision on the question of whether the REDSKINS family of marks were in fact disparaging.⁵⁴ In a lengthy opinion written by Administrative Trademark Judge Waters, the TTAB cancelled all six of the challenged marks.⁵⁵ While making overtures to its existing scandalousness jurisprudence, but in keeping with its then-current disparagement jurisprudence, the TTAB utilized a two-step analysis to

⁴⁹ *Harjo v. Pro-Football, Inc. (Harjo I)*, 30 U.S.P.Q.2d (BNA) 1828, 1829 (T.T.A.B. 1994).

⁵⁰ *Id.* at 1829-30. Specifically, Pro-Football alleged the affirmative defenses of failure to state a claim, lack of standing, equitable estoppel, laches, and secondary meaning. *Id.* Pro-Football raised the constitutional defenses that § 2 of the Lanham Act was vague and overbroad, and that cancellation of these marks would contravene Pro-Football’s free speech rights. *Id.* at 1830.

⁵¹ *Id.* at 1833. Notably, the TTAB was careful to observe that laches and estoppel were allowable defenses in cancellation proceedings, but not on these facts. *Id.* at 1831 (“Our decision here should not be taken as a general rule concerning the availability of the equitable defenses of laches and estoppel against a claim, under Section 2(a), that a mark disparages or is scandalous. Our decision here is only that the allegations of the present petition for cancellation are such that, in this case, the asserted equitable defenses are not available.”). The TTAB also declared it lacked the authority to deal with any defenses relating to the constitutionality of the Lanham Act. *Id.* at 1833.

⁵² *Id.* at 1832. With respect to the REDSKINS marks in question, the relevant dates were 1967, 1974, 1978 and 1990. *Id.* at 1829.

⁵³ *Id.* at 1832.

⁵⁴ *Harjo v. Pro-Football, Inc. (Harjo II)*, 50 U.S.P.Q.2d (BNA) 1705, 1749 (T.T.A.B. 1999)), *rev’d*, 284 F. Supp. 2d 96 (D.D.C. 2003), *aff’d in part and rev’d in part*, 415 F.3d 44 (D.C. Cir. 2005), *remanded to* 567 F. Supp. 2d 46 (D.D.C. 2008), *aff’d*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

⁵⁵ *Harjo II*, 50 U.S.P.Q.2d at 1707, 1749.

determine if the REDSKINS family of marks were disparaging: first, considering “the likely meaning of the [mark] in question and, second, whether that meaning may be disparaging” to the referenced group.⁵⁶

The TTAB concluded the first step of its analysis as expected, finding that the REDSKINS family of marks “clearly” refers to the professional football team and “carries the allusion to Native Americans inherent in the original definition of [redskin].”⁵⁷ This conclusion explicitly rejected Pro-Football’s argument that their use of the term was a “purely denotative term of reference for the ... team [with] no connotative meaning whatsoever.”⁵⁸ Unfortunately for Pro-Football, it had inadvertently undermined its contention that the term “redskins” was devoid of references to American Indians by explicitly arguing that the team’s name “reflect[s] positive attributes of the American Indian such as dedication, courage and pride.”⁵⁹ Furthermore, the Board recognized that it would be “disingenuous” not to recognize Pro-Football’s use of American Indian imagery in promoting its team, or to acknowledge that at the time the name was first adopted by the team, the term “redskins” did not refer to anything or anyone other than American Indians.⁶⁰

In resolving the second step of the analysis, the TTAB framed the issue as a question of whether the term “redskins,” during the relevant times, would be considered disparaging by “a substantial composite” of Native Americans.⁶¹ As an initial matter, the TTAB quickly discarded the petitioners’ argument that any use of Native American imagery, or any use of this imagery in connection with football by a non-native was *per se* disparaging.⁶² The TTAB also concluded that the use of graphical images, such as a spear and a profile portrait of a Native American were not disparaging.⁶³ These preliminary decisions left only the issue of whether the actual term “redskin(s)” was disparaging as used by Pro-Football.⁶⁴

The TTAB’s analysis of the evidence in the record led to a conclusion that, at the relevant times, a substantial composite of the Native American population would have found the REDSKINS mark to be disparaging.⁶⁵ In coming to that conclusion, the TTAB identified a number of relevant items in the record. First, the TTAB observed

⁵⁶ *Id.* at 1737, 1739.

⁵⁷ *Id.* at 1742.

⁵⁸ *Id.*

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ *Id.* at 1742-43.

⁶² *Id.* at 1743 (“We find no support in the record for either of these views.”).

⁶³ *Id.*

⁶⁴ *Id.*

⁶⁵ *Id.* at 1749.

that numerous dictionaries from 1966 onward included a “usage label” with the term “redskin” indicating that the term could have an offensive connotation.⁶⁶ Next, the TTAB considered the testimony of the American Indians’ linguistics expert, and concluded that from the 1960s onward the term “redskins” had decreased in literary usage because the term was perceived by Native Americans and the general population as a pejorative term.⁶⁷ Finally, the TTAB considered the American Indians’ survey evidence.⁶⁸ After recognizing that the survey had “several ... flaws ... that [limited] its probative value” such that the survey was “of limited applicability,” the TTAB nonetheless found that the sample of Native Americans represented in the survey was “significant” enough to be “supportive of other evidence in the record.”⁶⁹

To conclude its evidentiary analysis, the TTAB permitted the survey, dictionary, historical, and literary usage evidence regarding the views of the general population to suffice *by inference* for the views of the targeted Native American population.⁷⁰ Therefore, although claiming to apply the *Hines* standard the TTAB effectively circumvented *Hines*’ subjective approach by returning the focus to the perceptions of the general public and allowing those perceptions to be imputed by inference to the referenced group.⁷¹ Based on its findings that the marks specifically referred to Native Americans as the referenced population and that a substantial composite of Native Americans would find the marks to be disparaging as of the critical dates, the TTAB cancelled the registration of all six of the marks in question.⁷²

Following the TTAB’s cancellation of Pro-Football’s marks, Pro-Football sought redress of the TTAB’s decision in the District Court for the District of Columbia.⁷³ Pro-Football alleged, in part, that the REDSKINS family of marks did not disparage Native Americans

⁶⁶ *Id.* at 1744.

⁶⁷ *Id.* at 1745.

⁶⁸ *Id.* at 1745-46. The survey indicated that 46.2% of the general population considered the term “redskin” to be offensive, whereas only 36.6% of the Native American population surveyed considered the term offensive. *Id.* at 1745.

⁶⁹ *Id.* at 1745-46.

⁷⁰ *Id.* at 1746.

⁷¹ Recall that under the *Hines* standard the “perceptions of the general public are irrelevant...only the perceptions of those referred to...or implicated...are relevant.” *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1688 (T.T.A.B. 1994), *vacated on other grounds*, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994).

⁷² *Harjo II*, 50 U.S.P.Q.2d at 1749.

⁷³ *Pro-Football, Inc. v. Harjo (Harjo III)*, No. 99-1385, 2000 WL 1923326, at *1 (D.D.C. Dec. 11, 2000). As previously noted, the Lanham Act provides for a civil remedy when a party is dissatisfied with the party’s results before the TTAB. 15 U.S.C. § 1071(b)(1) (2008).

and that the doctrine of laches barred the American Indians' cancellation petition altogether.⁷⁴ Approximately three years after denying the American Indians' motion for judgment on the pleadings in an unpublished memorandum opinion,⁷⁵ the court nullified the American Indians' previous TTAB victory by overturning the cancellation of Pro-Football's marks.⁷⁶ The district court overturned TTAB's decision on two alternative grounds: 1) that the TTAB's decision was unsupported by substantial evidence; and 2) that the American Indians' cancellation petition was barred by laches.⁷⁷

⁷⁴ *Harjo III*, 2000 WL 1923326, at *2. Pro-Football actually alleged five grounds under which the TTAB had erred in cancelling the marks in question: 1) the trademarks did not disparage Native Americans; 2) the trademarks did not bring Native Americans into disrepute or contempt; 3) Lanham Act § 2(a) is a "vague, overbroad, and content based restriction on speech" in violation of the First Amendment; 4) Lanham Act § "2(a) is unduly vague in violation of the Fifth Amendment;" and 5) the doctrine of laches barred the American Indians' cancellation petition. *Id.* The American Indians' challenge to Pro-Football's constitutional claims was dismissed without prejudice under the avoidance doctrine. *Id.* at *4.

⁷⁵ *Id.* at *8.

⁷⁶ *Pro-Football, Inc. v. Harjo (Harjo IV)*, 284 F. Supp. 2d 96, 99 (D.D.C. 2003) *aff'd in part and rev'd in part*, 415 F.3d 44 (D.C. Cir. 2005), *remanded to* 567 F. Supp. 2d 46 (D.D.C. 2008), *aff'd*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

⁷⁷ *Harjo IV*, 284 F. Supp. 2d at 145. The court did not reach Pro-Football's constitutional claims because the controversy was settled via Pro-Football's non-constitutional claims. *Id.* ("The Court [sic] has no need to reach the constitutional claims raised by Pro-Football, these claims are rendered moot."). Without going into an in-depth constitutional analysis which would be beyond the scope of this article, it appears a court would likely reject both of Pro-Football's constitutional claims. Pro-Football's first constitutional claim was that its First Amendment free speech rights would be violated if its trademarks were cancelled. *Id.* at 100. However, under Federal Circuit precedent, the cancellation of a mark does not contravene a party's First Amendment free speech rights. *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (holding that the refusal to allow the registration of a mark does not prevent an individual from using said mark and thus does not suppress the individual's First Amendment free speech rights); *see also, In re Boulevard Entertainment, Inc.*, 334 F.3d 1336, 1343 (Fed. Cir. 2003) (reaffirming *In re McGinley*). Pro-Football's second constitutional claim was that its Fifth Amendment due process rights would be violated by enforcing § 2(a) of the Lanham Act because it was unduly vague. *Harjo IV*, 284 F. Supp. 2d at 100. However, courts have previously rejected Fifth Amendment due process challenges to other grounds for cancellation in this section of the Lanham Act. *In re McGinley*, 660 F.2d at 484-85 (holding that the term "scandalous" in 15 U.S.C. § 1052(a) is sufficiently precise as to comply with the Fifth Amendment). Given that the terms in section 2(a) of the Lanham Act are not defined by the Act itself, it is doubtful that the court would find the phrase "may disparage" unduly vague when other similar terms in the same subsection of the statute have been found not to be unduly vague. Therefore, it does not appear that Pro-Football would succeed on its constitutional claims, if they were to be considered by the courts.

Although the court provided alternative grounds for reversing the TTAB's decision, this article is only concerned with the former basis of reversal.⁷⁸

As a preliminary matter, the court found no error with the TTAB's use of the analysis set forth in *Hines*⁷⁹ or the TTAB's determination that Pro-Football's marks referred to Native Americans.⁸⁰ In finding no error with the TTAB's selection to follow the analysis set forth in *Hines*, the court recognized neither party specifically disputed the TTAB's selection of this analysis.⁸¹ In considering the actual application of this standard, however the court found numerous errors and deficiencies with respect to the TTAB's analysis of the evidence used to support its decision to cancel Pro-Football's marks.

The district court found the TTAB erred by relying on the views of the general population in its analysis instead of the views of Native Americans themselves. As previously noted, the TTAB adopted the views of the general population as those of Native Americans, because there was an absence of evidence preventing such an inference even though there was a disjoint between the two.⁸² This effectively placed on Pro-Football the evidentiary burden of disproving that the general population's views were sufficiently equivalent to Native Americans' views as to allow such an inference.⁸³ Such a placement would be improper, since the burden of establishing such a relationship rests on the party seeking cancellation and not the party opposing cancellation.⁸⁴ Unfortunately for the American Indians, they failed to put forth enough evidence to support the application by inference of the general public's views to serve by proxy as the prevailing view of the targeted Native American population.⁸⁵

Furthermore, the district court found that even if the TTAB had correctly focused its overall analysis on the general public's opinions, the TTAB's cancellation of Pro-Football's trademarks was not

⁷⁸ For a discussion of the application of laches in the context of disparaging marks and specifically *Harjo*, see generally Dennie, *supra* note 28.

⁷⁹ *Harjo IV*, 284 F. Supp. 2d at 125.

⁸⁰ *Id.* at 126-27. The court did not consider whether the TTAB's treatment of Pro-Football's "contempt or disrepute" claims were the same as their disparagement claims, as neither party appealed the TTAB's determination as to this matter. *Id.* at 114.

⁸¹ *Id.* at 125.

⁸² *Id.* at 128-29 (noting that 46.2% of the general population found the term "redskin" offensive whereas 36.6% of Native Americans found the term offensive).

⁸³ *Id.* at 129.

⁸⁴ *Id.*

⁸⁵ *Id.*

supported by substantial evidence. In coming to this decision, the district court considered the TTAB's findings regarding the dictionary evidence, the historical evidence, and the survey evidence independently.

First, the district court considered the TTAB's findings regarding the America Indians' dictionary evidence.⁸⁶ Although some dictionaries made references to the sometimes offensive nature of the term "redskin," the district court took issue with the lack of evidence as to how these dictionaries determined if a term was offensive.⁸⁷ Without evidence of the dictionaries' methodology, the court concluded it would be pure speculation as to who found the term offensive, and what constituted an offensive term.⁸⁸ Therefore, the district court held that the TTAB's findings with respect to the dictionary evidence were unsupported by substantial evidence.⁸⁹

Second, the district court considered the TTAB's findings regarding the American Indians' historical evidence.⁹⁰ The court noted that the TTAB found reduced usage of the term "redskin(s)" subsequent to the 1960s and that the term was pejorative; however the court also noted that the TTAB made no findings as to the causal relationship between the nature of the term and the reduction in its use.⁹¹ Because the TTAB did not provide support for this causal relationship, the court found the finding unsupported by substantial evidence.⁹²

Third, the district court considered the TTAB's findings regarding the American Indians' survey evidence.⁹³ The court found the survey measured *current* attitudes and not attitudes at the relevant times.⁹⁴ Without evidence of how current attitudes could be substituted for historical attitudes, the court held the survey evidence was "entirely irrelevant" and therefore failed to support the cancellation of Pro-Football's marks.⁹⁵ Furthermore, the district court made note of the lack of evidence as to whether or not the survey's

⁸⁶ *Id.* at 130-31.

⁸⁷ *Id.* at 130.

⁸⁸ *Id.*

⁸⁹ *Id.* at 131.

⁹⁰ *Id.* at 131-32.

⁹¹ *Id.* at 131.

⁹² *Id.* at 132.

⁹³ *Id.* at 132-33.

⁹⁴ *Id.* at 132.

⁹⁵ *Id.* at 132-33.

sample was a representative sample and therefore could be extrapolated to the Native American population at large.⁹⁶

Lastly, the court found the American Indians failed to show that the derogatory connotation of the word “redskin(s)” extended to Pro-Football’s use of REDSKINS at the time the marks were filed.⁹⁷ The court held that the TTAB’s only finding of fact supporting such a conclusion was the testimony of the original petitioners’ testimony that Pro-Football’s use of the REDSKINS mark “seriously offended” them.⁹⁸ However, the court found there was no evidence that the views of these seven American Indians could serve as a proxy for the views of the 2.41 million Native Americans living in the United States.⁹⁹ The court also rejected the resolutions put forth by assorted Native American interest groups objecting to Pro-Football’s use of the REDSKINS mark on the grounds that these resolutions were not indicative of Native Americans’ opinions at the time the marks were filed.¹⁰⁰ Furthermore, the court found that third party acts associated with the Washington Redskins, for example media reports or the actions of fans, which may disparage Native Americans could not be considered part of Pro-Football’s use of the marks.¹⁰¹ In consideration of the foregoing, the court held that the American Indians failed to establish that the disparaging nature of the term “redskin(s)” extended to Pro-Football’s use of REDSKINS.¹⁰²

Unsurprisingly, the battle over the REDSKINS family of marks did not end with the District Court for the District of Columbia’s 2003 order overturning the marks’ cancellation. The American Indians appealed this order to the Court of Appeals for the District of Columbia Circuit.¹⁰³ Without taking a position on the district court’s decision regarding the disparaging nature of the marks, the appeals court determined that laches barred six of the American Indians’ from instigating the cancellation proceedings.¹⁰⁴ However, the court of appeals remanded the record back to the district court to evaluate whether laches barred the youngest petitioner’s claims.¹⁰⁵ On remand,

⁹⁶ *Id.* at 120. Of particular concern for the court was the lack of Native Americans surveyed from Alaska and Hawaii given the large Native American populations in those two states. *Id.*

⁹⁷ *Id.* at 133-36.

⁹⁸ *Id.* at 135.

⁹⁹ *Id.*

¹⁰⁰ *Id.* (noting that the adoption of these resolutions occurred after the petition for cancellation was filed in 1992).

¹⁰¹ *Id.*

¹⁰² *Id.* at 135-36.

¹⁰³ Pro-Football, Inc. v. Harjo (*Harjo Appeal I*), 415 F.3d 44, 46 (D.C. Cir. 2005).

¹⁰⁴ *Id.* at 49-50.

¹⁰⁵ *Id.* at 49-50.

the district court held that the youngest petitioner's claims were also barred by laches,¹⁰⁶ a finding which was affirmed by Court of Appeals for the District of Columbia Circuit.¹⁰⁷ The Supreme Court of the United States declined to hear the youngest petitioner's appeal,¹⁰⁸ thus preventing the Court of Appeals for the District of Columbia Circuit the opportunity to disturb the District Court for the District of Columbia's disparaging mark jurisprudence, for the time being.

C. *ORDER SONS OF ITALY IN AMERICA V. MEMPHIS MAFIA INC.*¹⁰⁹

American Indians were not the only ethnic group challenging allegedly disparaging marks in the 1990s. The Order Sons of Italy in America, an Italo-American fraternal organization, sought the cancellation of the mark THE MEMPHIS MAFIA on the grounds that the mark disparaged their organization and implicitly Italo-Americans as a whole.¹¹⁰ The mark in question was used by a group of individuals who "perpetuate[d] the memory of Elvis Presley."¹¹¹ The petitioners relied on uncontested evidence regarding the Department of Justice's refusal to use the term "mafia" because of its disparaging connotation,¹¹² previous marks which had been denied registration on the grounds that the marks were disparaging to Italian-Americans,¹¹³ a study regarding the public's perception of Italian-Americans in general with respect to organized crime,¹¹⁴ and the testimony of three expert witnesses who testified, in effect, that the use of the mark in question disparaged the petitioners as well as perpetuated a disparaging stereotype of Italian-Americans in general.¹¹⁵

¹⁰⁶ *Pro-Football, Inc. v. Harjo (Harjo Remand)*, 567 F. Supp. 2d 46, 62 (D.D.C. 2008).

¹⁰⁷ *Pro Football, Inc. v. Harjo (Harjo Appeal II)*, 565 F.3d 880, 886 (D.C. Cir. 2009).

¹⁰⁸ *Harjo v. Pro-Football, Inc.*, 130 S. Ct. 631 (2009).

¹⁰⁹ 52 U.S.P.Q.2d (BNA) 1364 (T.T.A.B. 1999).

¹¹⁰ *Id.* at 1365, 1367.

¹¹¹ *Id.* at 1367.

¹¹² *Id.* at 1366.

¹¹³ *Id.* at 1367. It should be noted though that the oppositions to this mark's registration were all filed by a sister organization of the petitioner and default judgment was entered with respect to each of these oppositions. *Id.*

¹¹⁴ *Id.* The petitioners attempted to use this study and an associated position paper to show that "since organized crime encompasses persons of all races and national origins, it should not be equated with Italian-Americans, as is the effect of using the word 'mafia.'" *Id.*

¹¹⁵ *Id.*

The TTAB, applying the first step of the two-step analysis outlined in its opinion in *Harjo*,¹¹⁶ took judicial notice of definitions of the term “mafia” not put forth by either party.¹¹⁷ The TTAB, recognized that the term “mafia” was not *per se* disparaging to any ethnic group, and that there was no connection between the services associated with the marks in question and the definition of the term “mafia” defining the term as “as an organization dedicated to criminal activities composed of persons of Italian origin.”¹¹⁸ Given that the mark in question was used by a “group [consisting] of persons close to Elvis Presley,” the TTAB concluded the only relevant definition of the term “mafia” was the one that defined the term as an “exclusive, or small and powerful, group or clique.”¹¹⁹

In coming to its decision, the TTAB explicitly rejected the petitioner’s survey and expert witness evidence on the grounds that the evidence failed to show that the term “mafia” is always an epitaph with Italian-Americans.¹²⁰ The TTAB also rejected the petitioner’s expert witness testimony on the grounds that their testimony was unpersuasive as said witnesses were members of the petitioning organization, and as such their testimony could not “be viewed as [anything] other than reflecting the objectives of the petitioner.”¹²¹ The survey evidence was rejected on the grounds that the survey only illustrated the public’s general association of Italian-Americans and organized crime, without reference to the term “mafia,” and as such was insufficient to show the general public’s associated the term “mafia” with Italian-Americans and organized crime.¹²² Given that the TTAB found the mark in question did not reference the petitioners, the TTAB determined the petitioners failed to prove that the mark THE MEMPHIS MAFIA may disparage either the Order Sons of Italy in America or Italian-Americans in general when used in connection with the respondent’s entertainment services.¹²³

¹¹⁶ *Harjo v. Pro-Football, Inc. (Harjo II)*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. 1999). The District Court for the District of Columbia did not address the REDSKINS family of marks until four years after *Order Sons*. *Pro-Football, Inc. v. Harjo (Harjo IV)*, 284 F. Supp. 2d 96 (D.D.C. 2003), *aff’d in part and rev’d in part*, 415 F.3d 44 (D.C. Cir. 2005), *remanded to* 567 F. Supp. 2d 46 (D.D.C. 2008), *aff’d*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

¹¹⁷ *Order Sons*, 52 U.S.P.Q.2d at 1368.

¹¹⁸ *Id.* at 1368-69.

¹¹⁹ *Id.* at 1369.

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *Id.* This does not contravene the analysis set forth in *Hines* and *Harjo* requiring the fact finder determine if a substantial composite of the referenced group finds the mark disparaging because the question before the TTAB here was if there was an association between the mark and the supposedly referenced group.

¹²³ *Id.*

D. *IN RE SQUAW VALLEY DEVELOPMENT CO.*¹²⁴

Although the *Harjo* litigation has garnered a lot of public attention, American Indians also challenged another mark as disparaging in recent years. In 2006, the TTAB considered the denial of the registration for the marks SQUAW and SQUAW ONE in connection with clothing, ski equipment, and retail sports store services.¹²⁵ The applicant, Squaw Valley Ski Resort, previously registered the marks SQUAW VALLEY and SQUAW VALLEY USA for apparel and, effectively, ski resort accommodations.¹²⁶ In reconsidering its prior decision overturning the examining attorney's refusal to register the marks in question, the TTAB clarified its prior application of the two-step analysis set forth in *Hines* and *Harjo*.¹²⁷ The TTAB reconsidered whether each mark was disparaging in the context of each class for which registration was sought.¹²⁸

In reconsidering and reapplying the first step of its analysis, the TTAB determined that with respect to the class encompassing ski equipment, the likely meaning of the mark would be associated with applicant's skiing operations and not a female American Indian.¹²⁹ This decision was based upon the use of numerous newspaper articles and encyclopedia references evidencing that the term "squaw," when used in connection with skiing equipment, referenced the ski resort.¹³⁰ With respect to the class encompassing clothing and accessories and the class encompassing retail stores, the TTAB did not reconsider its prior decision that the marks referenced Native American women given that the examining attorney had previously satisfied a higher burden than necessary.¹³¹ In its earlier opinion, the TTAB determined there was nothing about the applicant's use of the marks containing the term "squaw" in these contexts which would indicate the mark was

¹²⁴ 80 U.S.P.Q.2d (BNA) 1264 (T.T.A.B. 2006).

¹²⁵ *Id.* at 1266. The TTAB had previously reversed the examining attorney's refusal to register the marks in a nonpresidential opinion. *In re Squaw Valley Development Co.*, Serial Nos. 76511144 & 76511145, 2005 WL 2543626 (T.T.A.B. Sept. 26, 2005). The examining attorney sought reconsideration of this earlier reversal pursuant to *In re Ferrero S.p.A.*, 24 U.S.P.Q.2d (BNA) 1061 (T.T.A.B. 1992), essentially arguing that the TTAB misapplied the *Harjo* standards for finding a mark disparaging. *Squaw Valley*, 80 U.S.P.Q.2d at 1266, 1268.

¹²⁶ *Squaw Valley*, 80 U.S.P.Q.2d at 1266-67. As a note of interest, Squaw Valley Ski Resort was the host of the 1960 Winter Olympics. *Id.* at 1266.

¹²⁷ *See Id.* at 1268 (explaining that the TTAB's supposed errors were errors of law in applying *Harjo* and that only the supposed errors would be addressed by the TTAB).

¹²⁸ *Id.* at 1283.

¹²⁹ *Id.* at 1282.

¹³⁰ *Id.* at 1280-81. The TTAB found this evidence rebutted the examining attorney's dictionary evidence. *Id.* at 1282.

¹³¹ *Id.* at 1272.

being used in connection with skiing facilities and services and not the term's dictionary definition of an American Indian woman.¹³² As such, the TTAB only reconsidered the second prong of its disparaging mark analysis with respect to these two classes of goods and services.¹³³

In reconsidering the second prong of its analysis, the TTAB considered whether or not the term "squaw" was disparaging to a substantial composite of Native Americans when used in the context of the applicant's identified goods and services.¹³⁴ The examining attorney put forth numerous newspaper articles and statements by American Indians regarding the offensive and disparaging nature of the term "squaw."¹³⁵ Some, but not all, of these statements dealt specifically with the applicant's use of the term "squaw" in connection with its skiing operations and the surrounding town, Squaw Valley, California.¹³⁶ The examining attorney also put forth legislation from various states prohibiting the names of geographic areas from containing the term "squaw."¹³⁷ This evidence was sufficient to establish a *prima facie* case that the mark was disparaging under the circumstances, which the applicant failed to rebut.¹³⁸ Thus, with respect to the classes encompassing clothing, accessories, and retail stores, the marks were found to be disparaging, and the TTAB affirmed the examining attorney's refusal to register the marks for these classes.¹³⁹

E. *IN RE HEEB MEDIA LLC*¹⁴⁰

In re Heeb Media LLC, dealt with the USPTO's refusal to register the mark HEEB for apparel and, essentially, event planning.¹⁴¹ The examining attorney refused to register the mark on the grounds that it was disparaging to a substantial composite of Jewish people

¹³² *In re Squaw Valley Development Co.*, Nos. 76511144 & 76511145, 2005 WL 2543626, at *8 (T.T.A.B. Sept. 26, 2005).

¹³³ *Squaw Valley*, 80 U.S.P.Q.2d at 1272-79.

¹³⁴ *Id.* at 1270.

¹³⁵ *Id.* at 1272-75.

¹³⁶ *Id.*

¹³⁷ *Id.* at 1274.

¹³⁸ *Id.* at 1277-79. The applicant actually failed to put forth any evidence regarding the disparaging nature of the term, but instead argued that applicant's use of the term did not implicate American Indian women, and therefore could not be disparaging to said individuals. *Id.* at 1278. Unfortunately for the applicant, this argument was only applicable to the first step of the disparaging mark analysis and not the second step. *Id.*

¹³⁹ *Id.* 1283.

¹⁴⁰ 89 U.S.P.Q.2d (BNA) 1071, 1071-72 (T.T.A.B. 2008).

¹⁴¹ *Id.*

even though the applicant already owned the registered mark HEEB for the “publication of magazines.”¹⁴² The examining attorney relied on dictionary evidence¹⁴³ and news articles containing quotes regarding the disparaging and offensive nature of the term “heeb.”¹⁴⁴ After citing the two-step analysis outlined in *Harjo* for determining if a mark is disparaging, the TTAB clarified that a “substantial composite of the referenced group” was not necessarily a majority of said group.¹⁴⁵ With respect to the first step of the analysis, neither party contested meaning of the term “heeb” or that the term referenced Jewish people.¹⁴⁶

With respect to the second step of its disparaging mark analysis, the TTAB claimed to consider how all individuals within the referenced group, that is to say all Jewish individuals, perceive the HEEB mark when used in the context of clothing and event planning services.¹⁴⁷ Relying on the *Cassel Dictionary of Slang*, the TTAB concluded the term does not have “a separate non-derogatory character.”¹⁴⁸ Furthermore, relying on the applicant’s own evidence, the TTAB concluded there were disparate views within the Jewish community, generally along generational lines, as to whether the term “heeb” was disparaging.¹⁴⁹ Although no specific percentage or segment of the Jewish population was determined to find the mark disparaging, the TTAB imputed the disparate views of those entered into evidence by both the examining attorney and the applicant to the entire “post-college age Jewish population” without additional evidence.¹⁵⁰ Essentially, by finding that some Jewish people found the term “heeb” itself objectionable, the TTAB found the evidence sufficient to establish a *prima facie* case that the mark was disparaging and that the applicant’s evidence failed to rebut said *prima facie* case.¹⁵¹ As such, the TTAB affirmed the examining attorney’s refusal

¹⁴² *Id.* at 1072.

¹⁴³ *Id.* at 1072 (defining the term “heeb” as “a [derogatory] term for a Jew”).

¹⁴⁴ *Id.* at 1072-73.

¹⁴⁵ *Id.* at 1074-75.

¹⁴⁶ *Id.* at 1075.

¹⁴⁷ *Id.*

¹⁴⁸ *Id.* at 1076.

¹⁴⁹ *Id.* (“[A]pplicant’s own evidence shows that not all [Jewish individuals] find the term HEEB to be unobjectionable. On the contrary, the letters submitted by applicant recognize that some [Jewish individuals] find the term derogatory, and suggest that there is a generational divide in the perception of this term.”)

¹⁵⁰ *Id.* at 1077. Although no evidence was put forth that this segment of the Jewish population was in fact a substantial composite of the Jewish population, the conclusion is logical that there would be more members of any ethnic or established religion which are of “post-college age” than those “college age” or younger.

¹⁵¹ *Id.* (recognizing that the USPTO has limited ability to amass evidence during *ex parte* proceedings, and as such needs only to establish a *prima facie* case).

to register the applicant's mark on the grounds that the mark was disparaging in degradation of § 2(a) of the Lanham Act.¹⁵²

F. *IN RE LEBANESE ARAK CORP.*¹⁵³

The most recent precedential TTAB decision concerning an allegedly disparaging mark dealt with the refusal to register the mark KHORAN for alcoholic beverages, specifically wine.¹⁵⁴ The examining attorney refused to register the mark on the grounds that the mark was disparaging to the beliefs of Muslims because Islam prohibits the consumption of alcohol.¹⁵⁵ Both the majority and dissent applied the two step analysis set forth in *Hines*.¹⁵⁶ The difference in opinion between the majority and dissent, as well as the examining attorney and the registrant, involved the first prong of the *Hines* test, what was the likely meaning of the mark KHORAN.¹⁵⁷

Although the majority conceded that the general public would perceive KHORAN to mean Koran, the Islamic holy text,¹⁵⁸ it repeatedly emphasized that Muslim Americans would also regard the mark as referencing the Koran.¹⁵⁹ The majority rationalized the acceptability of considering whether Muslims would perceive KHORAN to mean Koran on the grounds that *in the future* a mark may come before the TTAB which “would be clearly understood by members of a religious group as being significant in their worship, but would not be known or understood by the public at large” and that the Lanham Act’s “prohibition against registration of disparaging marks would [not] ignore such situations.”¹⁶⁰ In coming to this rationalization, the TTAB relied on its decision to cancel the mark SENUSSI¹⁶¹ in 1959 on the grounds the mark was scandalous.¹⁶²

¹⁵² *Id.* at 1078.

¹⁵³ 94 U.S.P.Q.2d (BNA) 1215 (T.T.A.B. 2009).

¹⁵⁴ *Id.* at 1215. “Khoran” is the Armenia word for “alter.” *Id.* at 1219.

¹⁵⁵ *Id.* at 1216.

¹⁵⁶ *Id.* at 1217, 1221.

¹⁵⁷ *Id.* at 1219.

¹⁵⁸ *Id.* at 1219. TTAB precedent has established that the mere misspelling of a word does not conclusively avoid a finding that a mark is disparaging or merely descriptive. See *In re Carlson*, 91 U.S.P.Q.2d (BNA) 1198, 1200 (T.T.A.B. 2009) (“In general, a mere misspelling of a word is not sufficient to change a merely descriptive term into an inherently distinctive trademark.”); *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685 (T.T.A.B. 1994), *vacated on other grounds*, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994) (making no reference to the fact that the mark in question BUDDA BEACHWEAR, contained a misspelling of Buddha).

¹⁵⁹ *Lebanese Arak*, 94 U.S.P.Q.2d at 1219-20.

¹⁶⁰ *Id.* at 1219.

¹⁶¹ *Id.*

¹⁶² Zlotchew, *supra* note 32, at 242.

With respect to the second step of the analysis, the majority relied on a record “replete with evidence” regarding Islam’s prohibition on alcohol and held that Muslims would find the use of a mark phonetically equivalent to their holy text to be disparaging.¹⁶³ As such the majority refused registration of the mark.¹⁶⁴

Effectively the dissent disagreed with the majority in two respects. First, the dissent argued the meaning of KHORAN should be determined based on the views of the general public and not Muslims.¹⁶⁵ While this statement of the law is defensible, if not correct, in light of the practice of the Federal Courts,¹⁶⁶ the dissent’s disagreement with the majority is somewhat unfounded given that the majority found the general public would find KHORAN to mean the Islamic holy text, the Koran. The majority just emphasized that Muslims would also find the mark referenced the Koran. The dissent’s second contention was that the general public would not attach any particular meaning to the mark KHORAN in connection with wine, and as such the first prong of *Hines* was not satisfied.¹⁶⁷ This position seems less defensible, particularly given that there are numerous ways to transliterate Koran from Arabic to English and readers (i.e. the general public) could very easily interpret KHORAN to be a misspelling or alternative transliteration of Koran.¹⁶⁸ Although the dissent raises a valid point with respect to the appropriate group for determining the meaning of the mark in question, it will likely be of little consequence in future disparaging mark challenges given that ultimately the dissent found insufficient evidence to support the finding as to if the meaning of the mark references the Koran and Islam in general.

IV. IMPLICATIONS OF THE CURRENT STATUS OF DISPARAGING MARK JURISPRUDENCE

The current status of disparaging market jurisprudence, as it relates to identifiable groups, is relatively clear. To determine if a

¹⁶³ *Lebanese Arak*, 94 U.S.P.Q.2d at 1218, 1221.

¹⁶⁴ *Id.* at 1221.

¹⁶⁵ *Id.* at 1222.

¹⁶⁶ *See, e.g., Prof-Football, Inc. v. Harjo (Harjo IV)*, 284 F. Supp. 2d 96, 126-27 (D.D.C. 2003) *aff’d in part and rev’d in part*, 415 F.3d 44 (D.C. Cir. 2005), *remanded to* 567 F. Supp. 2d 46 (D.D.C. 2008), *aff’d*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009) (relying on the judge’s own opinion and dictionary definitions of the term, which presumably reflect the views of the general public, to determine the meaning of the term “redskins”).

¹⁶⁷ *Lebanese Arak*, 94 U.S.P.Q.2d at 1223.

¹⁶⁸ *Id.* at 1218-19.

mark is disparaging to an identifiable group of individuals, the TTAB or a court must determine:

1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the market place in connection with the goods or services; and 2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to substantial composite of the referenced group.¹⁶⁹

While the TTAB's recent decision in *Lebanese Arak* may have raised the question of if the allegedly referenced group can determine the meaning of the mark in question, the more controversial question which remains relatively unresolved is what constitutes a "substantial composite" of the referenced group necessary to establish a mark is disparaging to said group. Further complicating the determination as to what constitutes a "substantial composite" of the referenced group is the different evidentiary burdens required to establish a mark as disparaging depending on if the proceedings are *ex parte* or *inter partes*. In *ex parte* proceedings, the examining attorney needs only to establish a *prima facie* case that the mark is disparaging, which can be accomplished by extrapolating the views of individuals and dictionaries regarding the term's disparaging character to the referenced group.¹⁷⁰ However, in *inter partes* proceedings, the petitioner needs to actually establish by direct evidence that a substantial composite of the relevant group finds the mark's use disparaging.¹⁷¹ Given the higher evidentiary burden for cancelling a registered mark as opposed to refusing to register a mark, a mark which was registered numerous years ago could survive a cancellation

¹⁶⁹ *In re Heeb Media LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1074 (T.T.A.B. 2008) (citing *In re Squaw Valley Development Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1267 (T.T.A.B. 2006); *Harjo v. Pro-Football, Inc. (Harjo II)*, 50 U.S.P.Q.2d (BNA) 1705, 1740-41 (T.T.A.B. 1999), *rev'd* 284 F. Supp. 2d 96, (D.D.C. 2003), *remanded*, 415 F.3d 44 (D.C. Cir. 2005), *on remand*, 567 F. Supp. 2d 46 (D.D.C. 2008), *cert. denied*, 130 S. Ct. 631 (2009)).

¹⁷⁰ *E.g.*, *Squaw Valley*, 80 U.S.P.Q.2d at 1271-75.

¹⁷¹ *Harjo IV*, 284 F. Supp. 2d at 144.

proceeding, but if the same mark or a derivative of that mark were to be applied for today, it could easily be refused registration.

These differing evidentiary burdens have far-reaching implications, especially in the arena of athletic team nicknames. Using the ongoing challenge to the REDSKINS family of marks as a guide, the following discussion explores the interests actually at stake when an athletic team's mark is challenged as disparaging to an ethnic group and why the current *Blackhorse* challenge to the REDSKINS marks will likely make its way to the D.C. Circuit. The second portion of this discussion explores the future implications of the TTAB's disparaging mark jurisprudence for professional sports teams in general, particularly those teams employing nicknames which may be found disparaging in degradation of the Lanham Act, if the REDSKINS family of marks are cancelled as being disparaging or if the standards remain the same.

A. INTERESTS UNDERLYING THE BATTLE
OVER THE REDSKINS FAMILY OF
MARKS

As previously mentioned, the most prominent challenge to a mark's registration on the grounds that the mark is disparaging is the ongoing proceedings regarding the registration of the REDSKINS family of marks. Although the initial challenge to the REDSKINS family of marks finally ended in late 2009,¹⁷² another cancellation petition for the REDSKINS family of marks is pending before the TTAB.¹⁷³ In order to understand why the registration of these marks has been so vigorously contested since 1992, one needs only to consider the competing social and economic interests at stake. Cast solely in the narrow question of these marks, the American Indians sought only to cancel the registrations of marks containing a term which, they argue, has always been an inflammatory racial slur.¹⁷⁴ In a broader sense, however, the American Indians' case illustrates the assertion that the use of racially-inspired marks, especially for commercial gain, perpetuates continued social subordination of

¹⁷² See *Pro-Football, Inc. v. Harjo (Harjo Appeal II)*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

¹⁷³ Complaint for Petitioner at 1, *Blackhorse v. Pro-Football, Inc.*, Cancellation No. 92046185 (T.T.A.B. Aug. 11, 2006). This cancellation proceeding had been stayed pending the resolution of the then ongoing challenge to the REDSKINS family of marks. *Blackhorse v. Pro-Football, Inc.*, Cancellation No. 92046185 (T.T.A.B. March 31, 2008) (order suspending proceedings until final resolution of the *Harjo* civil action).

¹⁷⁴ *Harjo v. Pro-Football, Inc. (Harjo I)*, 30 U.S.P.Q.2d (BNA) 1828, 1829 (T.T.A.B. 1994).

minority groups through cultural norms.¹⁷⁵ Essentially, the cause championed by the American Indians in *Harjo* is the embodiment of one of the hot-button social-policy goals of our time: eliminating the use of negative race-based imagery by taking away the commercial gain secured through federal registration of racist marks.¹⁷⁶

Conversely, Pro-Football, Inc. embodies the immense economic interests at stake. Pro-Football, Inc. is, quite simply, a massive financial force.¹⁷⁷ Cancellation of the REDSKINS marks and the subsequent inability to exercise sole nationwide control over the use of these marks could pose a substantial financial impact on the organization.¹⁷⁸ Recent scholarly analysis indicates that the merchandising value of the Washington Redskins name is especially strong amongst NFL teams, and that the negative public relations of the American Indian protests and litigation has had no detrimental effects on the team's sales.¹⁷⁹

Some scholars have argued that cancellation of the REDSKINS marks would have only a minor impact given the profit-sharing

¹⁷⁵ See K.J. Greene, *Trademark Law and Racial Subordination: From Marketing of Stereotypes to Norms of Authorship*, 58 SYRACUSE L. REV. 431, 436-37 (2008) (“Proceedings under Section 2(a) reinforce my contention that a ‘race-neutral’ or colorblind approach to IP issues fosters subordination. It should seem self-evident that a mark such as ‘Redskins’ fosters long-held stereotypes about Native Americans, and even an institution as conservative as the U.S. Supreme Court ‘has consistently taken notice of the consequences of negative racial stereotypes . . . [and] invalidated legislation based on impermissible racial stereotypes.’”).

¹⁷⁶ *Id.*

¹⁷⁷ According to Forbes, the Redskins are the second most valuable team in the NFL overall, with an estimated value of 1.6 billion dollars. Of this, 148 million dollars comes from brand management. #2 *Washington Redskins*, FORBES, Sept. 2, 2009, http://www.forbes.com/lists/2009/30/football-values-09_Washington-Redskins_300925.html (last visited Jan. 10, 2010).

¹⁷⁸ Andre Cummings, *Progress Realized?: The Continuing American Indian Mascot Quandary*, 18 MARQ. SPORTS L. REV. 309, 324 (2008).

¹⁷⁹ Mark S. Nagel & Daniel A. Raschler, *Washington “Redskins”—Disparaging Term or Valuable Tradition?: Legal and Economic Issues Concerning Harjo v. Pro-Football, Inc.*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 789, (2007). This is likely due, in part, to the marginalization of American Indians in American society. See Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPP. L. REV. 7, 16 (1994) (“In addition, because Native Americans represent a relatively small segment of the American population, they don't wield the same consumer buying power that has enabled other minorities to force companies to change trademarks which they find offensive. Trademark owners can afford to offend and alienate Native Americans because they are not dependent on them for their economic survival.”).

structure of the NFL.¹⁸⁰ Currently licensing revenues are distributed among all thirty-two NFL teams, which, it is argued, diminishes the incentive for the team to change its nickname because its lost profits would be absorbed by all thirty-two teams in the league.¹⁸¹ However, the Supreme Court's recent decision in *American Needle, Inc. v. National Football League* has called into question the legality of the NFL's licensing structure.¹⁸² If the NFL's licensing structure is ultimately found to violate federal antitrust law, the losses resulting from cancellation of the REDSKINS family of marks would not be absorbed by all thirty-two teams in the league. Therefore, if trademark protection is about simple economic efficiency and protection from unfair competition, Pro-Football has little to no incentive to forfeit the protection of their rights in the REDSKINS family of marks and risk incurring the resulting costs.

However, it is clear from the provisions of § 2(a) of the Lanham Act that there is more to trademark law than simple economic efficiency and protection from unfair competition. The question posed by the REDSKINS mark cancellation proceedings then becomes exactly how far courts should go in enforcing the social protections of the Lanham Act with respect to racial stereotyping in sports marketing. To this point, private market and social forces have reduced the prevalence of derogatory marks in the marketplace more so than the concerted action by the courts or the TTAB.¹⁸³

Further complicating the social policy issues underlying the question of racial-group disparagement is the argument that the use of American Indian imagery is not intended to be denigrating, but rather to be a representation of honor and tradition, both of the team and the tribe.¹⁸⁴ In this view, trademark law is not circumventing social

¹⁸⁰ E.g., Rachel Clark Hughey, *The Impact of Pro-Football, Inc. v. Harjo on Trademark Protection of Other Marks*, 14 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 327, 362 (2004)

¹⁸¹ *Id.* at 332-33, 362-63.

¹⁸² See *American Needle, Inc. v. National Football League*, 130 S. Ct. 2201, 2206-07 (2010) (holding that the NFL's joint intellectual property marketing and licensing agent is subject to federal antitrust law).

¹⁸³ See Greene, *supra* note 175, at 437. ("The marketplace of social norms, not Section 2, has had the most influence on the recession of racially derogatory trademarks."). Even those who have seen progress in the area admit that the progress has been "halting at best," carried on in "fits and starts." Cummings, *supra* note 178, at 316.

¹⁸⁴ See, e.g., *Id.* at 312-313 ("Still, some university administrations and many professional sports franchises strenuously eschew calls to remove these racially insensitive mascots, believing that their moniker represents tradition and honor and as such remains a vital part of school or team tradition. These proponents argue that the elimination of their Native American mascot at their sporting events would

progress but rather protecting an organization's right to maintain the valuable goodwill, sentiment, and tradition associated with their long-utilized marks.¹⁸⁵

In light of these underlying competing interests, it is likely the *Blackhorse* cancellation proceedings will drag on for some years as did the *Harjo* cancellation proceeding. Furthermore, even after the ultimate resolution of *Blackhorse* on the merits, any resulting economic or social affects, especially as they relate to the use of the REDSKINS marks themselves, will not be instantaneous. However, the ultimate resolution of *Blackhorse* under the *Harjo* standard may serve as the catalyst to other marks being challenged as disparaging or even the voluntary discontinued use of marks particularly susceptible to being challenged.

B. IMPLICATIONS FOR OTHER ATHLETIC TEAMS IF THE AMERICAN INDIANS WIN IN *BLACKHORSE*

Given the varying opinions as to the offensive or disparaging nature of these marks in general and as used by athletic teams, it is unlikely a court will render a *per se* opinion as to the eligibility for registration of these marks during the course of *Blackhorse*.¹⁸⁶ However, a successful cancellation of the REDSKINS family of marks as a result of the *Blackhorse* cancellation proceedings will call into the question the eligibility for registration of other sports teams' registered marks. Currently there are four sports teams in the "major" American

destroy the cultural fabric of their respective institutions. Therefore, the use of these mascots is justified in the minds of these proponents.")

¹⁸⁵ *Id.*

¹⁸⁶ See, e.g. *Harjo v. Pro-Football, Inc. (Harjo II)*, 50 U.S.P.Q.2d (BNA) 1705, 1733 (T.T.A.B. 1999), *rev'd* 284 F. Supp. 2d 96, (D.D.C. 2003), *remanded*, 415 F.3d 44 (D.C. Cir. 2005), *on remand*, 567 F. Supp. 2d 46 (D.D.C. 2008), *cert. denied*, 130 S. Ct. 631 (2009) (quoting the results of the American Indians' survey evidence in which the percentage of respondents finding a given term offensive as a term for Native Americans ranged from 50.6% for the word "Injun" to 2.8% for the phrase "Native American"); Jason Finkelstein, *What the Sioux Should Do: Lanham Act Challenges in the Post-Harjo Era*, 26 *Cardozo Arts & Ent. L.J.* 301, 312 (2008). In fact, during the course of the *Harjo* cancellation proceedings, the District Court for the District of Columbia twice clarified that its "opinion[s] should not be read as [] making any statement on the appropriateness of Native American imagery for team names." *Pro-Football, Inc. v. Harjo (Harjo Remand)*, 567 F. Supp. 2d 46, 48 (D.D.C. 2008), *cert. denied*, 130 S. Ct. 631 (2009) (quoting *Pro-Football, Inc. v. Harjo (Harjo IV)*, 284 F. Supp. 2d 96, 144-45 (D.D.C. 2003), *aff'd in part and rev'd in part*, 415 F.3d 44 (D.C. Cir. 2005), *remanded to* 567 F. Supp. 2d 46 (D.D.C. 2008), *aff'd*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009)).

professional sports leagues¹⁸⁷ other than the Washington Redskins whose nicknames imply Native American imagery: Major League Baseball's Cleveland Indians and Atlanta Braves, the National Hockey League's Chicago Blackhawks, and the National Football League's Kansas City Chiefs.¹⁸⁸

The success of a challenge to these other marks rests largely on the threshold for finding "a substantial composite" of the referenced group finds the mark disparaging and the results of the petitioners' direct survey evidence. According to the American Indians' survey evidence put forth in *Harjo*, none of these other four teams' nicknames were offensive to more than 7.8% of the surveyed Native Americans, independent of their use in athletics.¹⁸⁹ Furthermore, a *Sports Illustrated* survey recently found 83% of the Native Americans sampled did not find the use of Native American nicknames for professional sports teams offensive or a practice which should be

¹⁸⁷ For the purposes of this discussion, the four "major" professional American sports leagues are Major League Baseball, the National Football League, the National Hockey League and the National Basketball Association.

¹⁸⁸ See, e.g., Kelly P. O'Neil, Note & Comment, *Sioux Unhappy: Challenging the NCAA's Ban on Native American Imagery*, 42 TULSA L. REV. 171, 184 (2006). Aside from these five teams, there are other lesser-known professional sports teams, such as the Canadian Football League's Edmonton Eskimos, which have federally registered trademarks referencing Native Americans. U.S. Trademark No. 1,010,202 (filed Dec. 21, 1972). The use of American Indian imagery by members of the NCAA is a rather complex situation outside the scope of this article given NCAA regulations generally prohibit the use of American Indian imagery by its members. See generally, Glenn George, *Playing Cowboys and Indians*, 6 VA. SPORTS & ENT. L.J. 90 (2006). Furthermore, unlike professional sports teams, not all universities using American Indian imagery have registered their marks. For example, Searches in the United States Patent and Trademark Office's Trademark Electronic Search System (TESS), <http://tess2.uspto.gov>, for marks registered to the University of North Dakota or the state of North Dakota, as well the mark "Fighting Sioux" failed to produce any currently registered marks pertaining to University of North Dakota athletics. There are also approximately 1,900 high schools across the United States using Native American mascots. Gavin Clarkson, *Racial Imagery and Native Americans: A First Look at the Empirical Evidence Behind the Indian Mascot Controversy*, 11 CARDOZO J. INT'L & COMP. L. 393, 395 (2002). It is doubtful that many, if any, high schools have a federally registered trademark for their nick-name, let alone a high school using a Native American mascot, given the requirement that the mark be used in interstate commerce. 15 U.S.C. § 1051(3)(C) (2006). Native Americans are not the only ethnic or otherwise identifiable group of individuals implicated by the registered marks of a professional sports team that may be considered disparaging. For example, the term "canuck" is a derogatory term for a French-Canadian, but it is also the nickname of Vancouver's National Hockey League team. IRVING LEWIS ALLEN, *THE LANGUAGE OF ETHNIC CONFLICT* 128 (1983); U.S. Trademark No. 956,683 (filed Jan. 17, 1972) (registration for the wordmark CANUCKS for professional ice hockey exhibitions).

¹⁸⁹ *Harjo II*, 50 U.S.P.Q.2d at 1733 (noting that that 7.8% of the sample found the term "Indian" offensive and 7.0% of the sample found the term "brave" offensive).

altered.¹⁹⁰ Therefore, even if the REDSKINS marks are successfully cancelled, there might not be enough support within the American Indian community to support the cancellation of the marks for these other four professional sports teams'; unless a "substantial composite" is approximately 20%.

There is, however, some indication that Native Americans find the stereotypical portrayal of Native Americans more offensive than terminology which refers to Native Americans,¹⁹¹ and therefore this imagery, usually in the form of a mascot or logo, may be susceptible to cancellation proceedings even when the underlying team nickname is not necessarily legally disparaging. The most notorious mascot still in use, with registered live trademarks, is the Cleveland Indians' Chief Wahoo.¹⁹² Activists have referred to Chief Wahoo as "the most offensive racial icon in the country."¹⁹³ The Cleveland Indians' use of Chief Wahoo, "a grinning Indian face caricature with a feather and bright red face," was challenged in court in 1972 under a theory of group libel, but was settled out of court.¹⁹⁴ Given that Chief Wahoo has already been challenged once before in the courts, and is viewed as one of the "most offensive" uses of Native American imagery in the United States, it is highly likely that the Chief Wahoo marks will be challenged in the courts if there is successful cancellation of the REDSKINS" family of marks or the Indians seek registration of a new mark depicting Chief Wahoo.

Chief Wahoo marks may be the most obvious team mascot or insignia to be challenged as disparaging; however, other teams have

¹⁹⁰ Jason Finkelstein, *What the Sioux Should Do: Lanham Act Challenges in the Post-Harjo Era*, 26 Cardozo Arts & Ent. L.J. 301, 312 (2008) (citing S.L. Price, *The Indian Wars*, Sports Illustrated, Mar. 2, 2002, at 66).

¹⁹¹ Clarkson, *supra* note 188, at 399. (citing Peter Harris Research Group, Final Results, at questions 5c, 6b, Jan. 31, 2002 (on file with article's author)) (noting 36% of Native Americans living on a reservation were offended by the term "Redskin" whereas 58% of Native Americans living on a reservation found mascots portraying Native Americans in a stereotypical fashion objectionable).

¹⁹² The Cleveland Indians have at least six registered trademarks containing the likeness of Chief Wahoo. U.S. Trademark No. 2,569,766 (filed Feb. 15, 2001); U.S. Trademark No. 1,031,410 (filed Jan. 23, 1974); U.S. Trademark No. 1,711,810 (filed Dec. 13, 1990); U.S. Trademark No. 1,590,703 (filed Sept. 6, 1989); U.S. Trademark No. 1,593,109 (filed Nov 18, 1988); U.S. Trademark No. 1,259,795 (filed June 1, 1981).

¹⁹³ David Briggs, *Chief Wahoo Should Go*, CLEVELAND PLAIN DEALER, Apr. 5, 2008, http://blog.cleveland.com/lifestyles/2008/04/chief_wahoo_should_go.html (last visited Jan. 10, 2010) (quoting founding board member of the National Coalition on Racism in Sports and the Media, Charlene Teters).

¹⁹⁴ Glenn George, *Playing Cowboys and Indians*, 6 VA. SPORTS & ENT. L. J. 90, 93 (2006). The out of court settlement ended the use of a "live" Chief Wahoo mascot, but allowed the Cleveland Indians to continue to use the Chief Wahoo imagery. *Id.*

registered marks for their mascots or insignia that may very well be disparaging to American Indians. In 1991, the National Basketball Association's Golden State Warriors registered, and still maintain, a mark for the cartoon image of an American Indian dribbling a basketball¹⁹⁵ even though the team stopped using Native American imagery twenty years earlier, in 1971.¹⁹⁶ The Atlanta Braves maintain a registered trademark for the image of an American Indian warrior's head letting out a battle cry.¹⁹⁷ Although the Atlanta Braves no longer use the "screaming brave" on a regular basis, the team still markets baseball caps containing the image as part of its "Cooperstown Collection."¹⁹⁸ Although the current financial interests found in the above mentioned teams' currently used marks dwarf the financial interests in these older marks, challenging these older marks as disparaging would promote the social policy goal of removing racist marks from the stream of commerce.¹⁹⁹

V. REVISING THE TTAB'S CURRENT DISPARAGING MARK JURISPRUDENCE

The TTAB's steadfast application of the two-step analysis set forth in *Hines* and *Harjo*, notwithstanding the variation of *Lebanese Arak*, poses substantial, if not insurmountable, hurdles for groups seeking to cancel the registration of an allegedly disparaging mark. These hurdles may be particularly challenging with respect to groups which have traditionally been isolated or which are seeking the cancellation of marks registered farther back in time.²⁰⁰ Collecting accurate survey evidence under these circumstances is complicated by the passage of time. Furthermore, the diverse cultural, social, and geographical backgrounds of individuals within certain populations

¹⁹⁵ U.S. Trademark No. 1,744,595 (filed Apr. 10, 1991).

¹⁹⁶ Warriors Logo History, http://www.nba.com/warriors/history/logo_history.html (last visited Jan. 10, 2010).

¹⁹⁷ U.S. Trademark No. 829,310 (filed Mar. 14, 1966).

¹⁹⁸ See, e.g., Braves Shop: Atlanta Braves Retro Logo Pastime Cap, <http://shop.mlb.com> (product search: 3138088) (last visited Jan. 10, 2010). Cooperstown, New York is the location of the Baseball Hall of Fame. See, e.g., *Hall of Fame Elections: History*, in TOTAL BASEBALL, THE OFFICIAL ENCYCLOPEDIA OF MAJOR LEAGUE BASEBALL, 228, 228 (John Thorn, et al. eds., 5th ed. 1997).

¹⁹⁹ By challenging said marks, a petitioner can reduce the financial incentive to produce merchandise with these old marks and thus the presence of said trademarks in the public sector. Such a reduction in the presence of material that disparages American Indians may further American Indians' and their supporters' goal in reducing social inequality with respect to American Indians.

²⁰⁰ See *Pro-Football, Inc. v. Harjo (Harjo IV)*, 284 F. Supp. 2d 96, 145 (D.D.C. 2003) ("[I]t [is] difficult for any fact-finder to affirmatively state that in 1967 the trademarks were disparaging.").

necessitates expansive, and thus expensive, surveying techniques in order to satisfy the *Harjo* standard. These challenges, although serious, may be rectified through small changes in the TTAB's current disparaging mark jurisprudence, as illustrated below.

A. UNDER LIMITED CIRCUMSTANCES ALLOW
A SHOWING THAT THE GENERAL PUBLIC
VIEWS THE MARK AS DISPARAGING TO
ESTABLISH THE REBUTTABLE
PRESUMPTION THAT THE MARK IS VIEWED
AS DISPARAGING WITHIN THE
REFERENCED GROUP

It is disingenuous to state that a mark, considered disparaging and offensive by the general public, is not disparaging for the purposes of the Lanham Act simply because it may not be economically or physically feasible to accurately survey the referenced group. Courts should cease the strict adherence to the *Hines & Harjo* standard and instead adopt a more workable standard. Petitioners should be able to show the mark disparages the referenced group by showing either a substantial composite of the referenced group *or* a substantial composite of the general population would find the mark disparages the referenced group. If the petitioner avails itself of the objective means of establishing the mark disparages the referenced group, the mark owner or applicant should be able to rebut this showing by establishing that no substantial composite of the referenced group finds the use of the mark disparaging to the referenced group.

Additionally, if a petitioner proves a term or image is inherently disparaging, then the court should find the petitioner has sufficiently established the mark itself is also disparaging. This finding would shift the burden onto the mark holder or registrant to prove the overall use of the mark does not disparage the group in question even though the term or image alone may disparage the group. Essentially, the mark holder or registrant would need to show the mark had a distinct meaning independent of the inherently disparaging meaning. Such a rule would eliminate a hurdle to cancellation of marks of which the members of the group are unaware of the mark's overall use.

Effectively, this standard would hold petitioners to a standard more akin to that of the examining attorney in an *ex parte* proceeding before the TTAB. Furthermore, allowing petitioners the option of establishing that a mark disparages a referenced group using an objective standard would make the law consistent with similar areas of law. The prevailing standard for determining if a mark disparages a

corporation is a “reasonable man” general-population approach.²⁰¹ Likewise, the Utah Supreme Court has applied a “reasonable person” standard in holding that license plates bearing the terms “REDSKIN”, “REDSKNS”, and “RDSKIN” were violations of a state statute prohibiting custom license plates bearing “vulgar, derogatory, profane, or obscene” terms.²⁰² A similar approach by the TTAB with respect to marks which allegedly disparage discrete groups of individuals in *inter partes* proceedings would better serve the policy goals of eliminating the use of racial stereotypes as a mechanism of marketing and commerce, while still requiring a convincing display of evidence that the challenged marks were significantly disparaging.

Commentators have suggested that all disparaging cancellation proceedings should be governed solely by an objective standard.²⁰³ While such an alternative may reduce the effects of divergent views within the implicated group, may be simpler to apply than a subjective standard, and may bring disparagement jurisprudence in line with scandalous mark jurisprudence and tort law,²⁰⁴ an objective standard would undermine the promotion of the underlying policy justifications for prohibiting the registration of disparaging marks as well as common sense. Ethnic labeling is a rather effective means to subordinate a minority group by a majority.²⁰⁵ It seems illogical to establish a system whereby the majority which may perpetuate the use of a pejorative term may also determine the standard used when judging whether the term is disparaging. Furthermore, a purely objective standard would not allow for reappropriation of slurs or other pejorative terms.²⁰⁶

²⁰¹ *E.g.* Greyhound Corp. v. Both Worlds, Inc. 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1988).

²⁰² McBride v. Motor Vehicle Div. of Utah State Tax Comm'n, 977 P.2d 467 (Utah 1999) (emphasis added).

²⁰³ *See, e.g.* William N. Wright, Note, *Not in Whose Name?: Evidentiary Issues in Legal Challenges to Native American Team Names and Mascots*, 40 CONN. L. REV. 279, 313-14 (2007).

²⁰⁴ *Id.* at 310-13.

²⁰⁵ IRVING LEWIS ALLEN, UNKIND WORDS: ETHNIC LABELING FROM REDSKIN TO WASP 8 (1990).

²⁰⁶ *See* Todd Anten, Note, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(A) of the Lanham Act*, 106 COLUM. L. REV. 388 (2006) (arguing that the registration of self-disparaging marks should be treated differently than other disparaging marks).

B. INCREASE THE LEVEL OF SPECIFICITY IN IDENTIFYING THE REFERENCED GROUP

Without additional judicial clarification, or a change in the applicable standard, semantics and political correctness will determine the scope of membership in the references group, and thus whose opinions must be considered in determining if a mark is disparaging. Determining who is a member of the group implicated by a mark is a relatively easy task when “membership” in, or association with, the group is voluntarily.

Determining the scope of membership in the referenced group is more challenging and less predictable when the mark implicates a group containing a large and diverse population, such as an ethnic group or some other broad category like “protestants.” The District Court for the District of Columbia’s 2003 opinion in *Harjo* illustrates this challenge. The court found the petitioning American Indians’ survey evidence insufficient to serve as a proxy for the views of Native Americans as a whole because the survey excluded the views of Native Americans in Alaska and Hawaii without explanation.²⁰⁷ Generally, the federal statutory definition of Native Americans includes “American Indians, Native Hawaiians, other Native American Pacific Islanders (including American Samoan Natives), and Alaska Natives.”²⁰⁸ Because the district court classified the referenced group as “Native Americans,” the court’s consideration of Native Alaskans’ and Native Hawaiians’ opinions in the survey data was not necessarily incorrect given its consistency with the federal definition of “Native Americans.” Granted, all Native American tribes are anthropologically distinct, however, Native Alaskan tribes and Native Hawaiian tribes are significantly distinct from other Native Americans tribes in the lower forty-eight states.²⁰⁹

²⁰⁷ *Pro-Football, Inc. v. Harjo (Harjo IV)*, 284 F. Supp. 2d 96, 111 (D.D.C. 2003) *aff’d in part and rev’d in part*, 415 F.3d 44 (D.C. Cir. 2005), *remanded to* 567 F. Supp. 2d 46 (D.D.C. 2008), *aff’d*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

²⁰⁸ *See, e.g.*, 42 U.S.C. § 2991(a) (2006).

²⁰⁹ Michael Yellow Bird, *What Do We Want to Be Called: Indigenous Peoples’ Perspectives on Racial and Ethnic Identity Labels*, 23 No. 2 American Indian Quarterly 1, 3 (1999). Native Alaskans’ distinctiveness is due, in part, to being relatively ignored by both the general American public and the government until Alaska received statehood and their relative isolation from other Native American tribes. ROGER L. NICHOLS, *AMERICAN INDIANS IN U.S. HISTORY* 209 (2003). Native Hawaiians’ distinctiveness is due, in part, to being descendants of Polynesians and Hawaii’s status as a sovereign kingdom before annexation. Kathryn Nalani Setsuko Hong, *Understanding Native Hawaiian Rights: Mistakes and Consequences of Rice v. Cayetano*, 15 ASIAN AM. L.J. 9, 11-12 (2008). With respect to Native Hawaiians, these distinctions have, in part, lead to Indigenous Peoples from the other forty-nine

Therefore, it is questionable, and inconsistent with the rationale underlying the subjective standard, to require the opinions of all Native Americans as to if a mark is disparaging, when realistically the mark may only refer to a limited subset of Native Americans or Native American tribes. Furthermore, with respect to the REDSKINS family of marks, it is anomalous to require the opinions of Native Hawaiians in the cancellation of these marks when said marks were registered before Native Hawaiians were classified as Native Americans by the federal government.²¹⁰ Thus, it is advisable that the courts require petitioners seeking cancellation of a registered mark prove with some specificity the scope of the group implicated by the mark in question.

C. SHIFT THE RELEVANT TIME PERIOD TO
THE TIME OF THE CHALLENGE IN *INTER*
PARTES PROCEEDINGS

When the registration of a mark is denied by an examining attorney or opposed by an aggrieved party on the grounds that the mark is disparaging, logically the determination is made as to if the mark is disparaging at that time.²¹¹ However, under the current law, when a petitioner seeks to cancel an already registered mark, the relevant time period for determining if the mark is disparaging is the time at which the mark was originally registered.²¹² Even before the TTAB cancelled the REDSKINS marks in 1999,²¹³ commentators have argued that under certain circumstances the relevant time period for determining if a mark is disparaging should be the time of the challenge.²¹⁴ These commentators tend to rely on the evolution of society and language as the basis for their argument.²¹⁵ Words,

states to object to the classification of Native Hawaiians as Native Americans by the federal government. *Yellow Bird*, *supra* note 209, 3-4.

²¹⁰ Legislation explicitly classified Native Hawaiians as “Native Americans” beginning in the 1970s. *Hong*, *supra* note 209, at 16. The first of Pro-Football’s trademarks in question was filed in 1966. U.S. Trademark No. 836,122 (filed July 14, 1966).

²¹¹ *See, e.g. In re Squaw Valley Development Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1270 n. 5 (T.T.A.B. 2006).

²¹² *Harjo IV*, 284 F. Supp. 2d at 125.

²¹³ *Harjo v. Pro-Football, Inc. (Harjo II)*, 50 U.S.P.Q.2d (BNA) 1705, 1749 (T.T.A.B. 1999), *rev’d*, 284 F. Supp. 2d 96 (D.D.C. 2003), *aff’d in part and rev’d in part*, 415 F.3d 44 (D.C. Cir. 2005), *remanded to* 567 F. Supp. 2d 46 (D.D.C. 2008), *aff’d*, 565 F.3d 880 (D.C. Cir. 2009), *cert. denied*, 130 S. Ct. 631 (2009).

²¹⁴ *Zlotchew*, *supra* note 32, at 244 (arguing that once a mark was found to be disparaging, it could never be registered regardless of changing notions of disparagement; however a mark which was initially not disparaging but became disparaging could be cancelled).

²¹⁵ *Id.* at 236-37, 244.

phrases, images, and the like which may have been acceptable for public use at one point in time might not be acceptable at a future point in time.²¹⁶ Moreover, the Lanham Act already anticipates that the meaning of words, phrases, and the like can change over time.²¹⁷

Aside from the evolution of language, a more pragmatic reason exists for considering the time of the mark's challenge as the relevant time period. Petitioners seeking to cancel a mark may very well have trouble gathering evidence proving the marks were disparaging at the time of registration. With respect to sports team marks implicating American Indians this is particularly challenging given the fact that many of these marks were registered in the 1960s.²¹⁸ As the proceedings in *Harjo* demonstrate, the farther removed in time from registration the cancellation proceedings are brought, the harder it is to collect reliable evidence as to the views of individuals at the relevant time.²¹⁹ The technological and physical isolation of some American Indian tribes during the relevant time periods,²²⁰ further compounds the difficulty in determining the views of members of these tribes during the relevant time period. Although some tribes were aware of the marks,²²¹ other, more isolated, tribes may have been wholly unfamiliar with Pro-Football's use of the REDSKINS marks during the relevant time period or even the nature of the term "redskins."

In light of the above, the courts should determine if a mark is disparaging at the time the petition was filed. Realistically, this would be complicated under the current language of § 14(3) of the Lanham Act, which implies the relevant time period is the time of registration.²²² In theory the TTAB could elect to disregard this language, but such disregard for established law would likely be overturned on appeal. However, the TTAB could begrudgingly determine if the mark was disparaging at the time of registration, but also call for Congress to amend the Lanham Act to permit courts to

²¹⁶ See Pace, *supra* note 179, at 9-10 (discussing the evolution of how Quaker Oats portrayed Aunt Jemima in order to reflect changing societal views).

²¹⁷ See 15 U.S.C. § 1064(3) (allowing for the cancellation of a mark that becomes the generic name for goods or services but was not generic at the time of registration).

²¹⁸ See, e.g., U.S. Trademark No. 893,052 (filed May 26, 1969) (registration of the mark "Blackhawks" for professional hockey); U.S. Trademark No. 829,308 (filed Mar. 14, 1966) (registration of the mark "Braves" for professional baseball).

²¹⁹ See, *Harjo IV*, 284 F. Supp. 2d at 127-36 (rejecting the American Indian's evidence as insufficient to support a finding that the REDSKINS family of marks were disparaging to Native Americans).

²²⁰ See, Therese Bissell, *The Digital Divide Dilemma: Preserving Native American Culture While Increasing Access to Information Technology on Reservations*, 2004 J. L. Tech. & Pol'y 129 (2004) (discussing the isolated nature of American Indian reservations and the historical lack of technology on many reservations).

²²¹ *Harjo IV*, 284 F. Supp. 2d at 112.

²²² 15 U.S.C. § 1064(3) (2008).

consider the evolution of language under these circumstances. Such an amendment would require only a simple change in language; Congress could amend the Lanham Act to allow for the cancellation of a mark if it *becomes* contrary to § 2(a) of the Lanham Act, and not when the mark *was registered* contrary to § 2(a). Such lobbying by the TTAB is more likely to garner Congressional attention with respect to this problem than an article published in a legal academic publication.

Courts can avoid constant challenges to marks by applying established legal doctrines and civil procedure. Furthermore, if such a change were to be enacted legislatively, Congress could include limits on how often cancellations could be attempted. For example, if a mark is determined to not be disparaging to a specific group, its disparaging nature may not be challenged for a proscribed period of time. This would not be inconsistent with the Lanham Act given that § 14 already limits the circumstances under which a mark's registration may be cancelled.²²³

VI. CONCLUSION

As this article discusses, the TTAB has had few opportunities to develop its disparaging mark jurisprudence with respect to identifiable groups. Given the dearth of disparaging mark challenges brought before the TTAB, the Article III courts have had almost no opportunity to consider the flaws in the TTAB's disparaging mark jurisprudence. Even when the opportunity to consider the TTAB's disparaging mark jurisprudence arose in the *Harjo* proceedings, neither party objected to the analytical process applied by the TTAB. Considering the drawn-out nature of the *Harjo* challenge to the REDSKINS family of marks, it is highly probable that the *Blackhorse* challenge to the same marks will likely end up before a federal district court, regardless of which party prevails before the TTAB.²²⁴ Thus, a federal court will likely have an opportunity to revisit and revise the TTAB's disparaging mark jurisprudence with respect to marks implicating an identifiable group of individuals. The question thus becomes whether the courts will give § 14 of the Lanham Act teeth

²²³ 15 U.S.C. § 1064 (2006).

²²⁴ It is unlikely the Washington Redskins will be changing their name during the course of the *Blackhorse* proceedings, thus rendering the proceedings effectively moot. The team's current owner, Daniel Snyder, has steadfastly refused to change the team's nickname voluntarily. See, e.g. *The Novak Zone: Interview With Daniel Snyder* (CNN television broadcast Jan. 11, 2003), <http://transcripts.cnn.com/TRANSCRIPTS/030111/smn.20.html> ("I'll never change the name of the Redskins. You have my word on that.").

with respect to allegedly disparaging marks, or whether § 14 will remain a paper tiger.

Furthermore, the resolution of *Blackhorse* on the merits will forecast the utility of trademark law as a vehicle for attempting to affect social change through challenges to the use of ethnic stereotyping in the branding of other athletic teams. The limited number of athletic teams with federally registered trademarks tempers such utility, but if trademark law protection is removed for pejorative marks in the sports arena, this could still provide another tool in the activists' arsenal for affecting social change through arguing by analogy to other markets.. Regardless of the ultimate utility of the Lanham Act in this context, these challenges will likely be just another footnote in this country's long history of tenuous race relations being played out in the legal system.