THE BEST OFFENSE IS A GOOD DEFENSE: HOW THE
WASHINGTON REDSKINS OVERCAME CHALLENGES TO
THEIR REGISTERED TRADEMARKS*

Lynette Paczkowski*

I. INTRODUCTION

In 1999, the Trademark Trial and Appeal Board (“TTAB”) decided Harjo v. Pro-Football, Inc., in which a group of Native Americans (the “Petitioners”) alleged that the term “Redskin(s)” was a pejorative, derogatory, degrading, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for a Native American person; the marks owned by Pro-Football, Inc. (“Pro-Football”), were offensive, disparaging and scandalous; Pro-Football's use of the marks offended the petitioners and other Native Americans, causing them to be damaged by the continued registration of the marks; the marks consisted of or comprised of matter which disparages Native American persons and brings them into contempt, ridicule, and disrepute; and the marks consist of or comprise of scandalous matter. [1] In a lengthy opinion, the TTAB found that the marks were not scandalous, but they may be disparaging of Native Americans to a substantial composite of this group of people, [2] and therefore ordered that the registrations be canceled in due course. [3]

In September of 2003, the United States District Court for the District of Columbia (the “district court” or the “court”) reversed the TTAB's decision regarding disparagement in an equally long opinion holding that the TTAB's finding of disparagement was not supported by substantial evidence and also that the doctrine of laches precluded consideration of the case. [4] This article accordingly focuses on those same two issues, in particular the actual allegations raised by the Petitioners and the relative strengths and weaknesses of those claims; the standard employed by the TTAB and the decision ultimately reached by the TTAB according to that standard; and the TTAB's reversal by the district court. This article will also posit alternative arguments and viewpoints in addition to assessing the actual effects of this case. Moreover, because the district court did not challenge the standard articulated by the TTAB for evaluating a disparagement claim, [5] whether and how to reconcile laches and secondary meaning may continue to be an issue in the future. Therefore, in the final section of this article, a standard is proposed for analysis of disparagement claims. This standard reconciles tensions and effectively balances laches, “as of the date of registration,” and secondary meaning. It also modifies that part of the standard which articulates what the TTAB and the court concluded was the relevant segment of the population when evaluating disparagement claims. Under the standard proposed, the Petitioners' claims would be defeated, and Pro-Football's registrations would be upheld.

II. BACKGROUND - THE TTAB AND DISTRICT COURT OPINIONS

A. The TTAB Decision

This case began in 1992 with a group of Native American persons and enrolled members of federally recognized Indian tribes bringing a cancellation proceeding before the TTAB. [6] The target of the proceeding was Pro-Football, the corporate owner of the Washington Redskins, a National Football League (“NFL”) team located in the Washington, D.C. metropolitan area. Pro-Football was also the owner of the 6 registered marks that were the subjects of the petition to cancel. [7] In response to the Petitioners' claims, Pro-Football asserted that through long, substantial and widespread use, advertising and promotion in support thereof, and media coverage, the marks acquired a strong secondary meaning identifying the entertainment services provided by Pro-Football in the form of professional games in the NFL, and that the marks sought to be canceled cannot reasonably be understood to refer to the Petitioners or to any of the groups or organizations to which they belong. [8]

Prior to actually deciding the case on its merits, the TTAB confronted the equitable defense of laches. The doctrine of laches bars relief to those who delay the assertion of their claims for an unreasonable time and is founded on the notion that equity aids the vigilant and not those who slumber on their rights. [9] Despite the fact that the
marks challenged by the Petitioners had enjoyed registration, for as many as 25 years, [10] the TTAB dismissed Pro-
Football's arguments, finding that there existed a broader interest, even beyond the personal interest asserted by the
Petitioners, in preventing a party (Pro-Football) from receiving the benefits of registration where a trial might show
that the marks hold a substantial segment of the population (the Petitioners and others) up to public ridicule. [11]
Thus, the case moved forward.

In 1998, the TTAB finally conducted a hearing on the matter. In ultimately deciding the issue, the TTAB
relied on its precedent in concluding that the standard for disparagement involved looking at the marks as of the
dates of their registrations. [12] In this case, the dates of registration spanned from 1967 to 1990. [13] Thus, the
TTAB had to decide whether, at the times Pro-Football was issued each of its challenged registrations, i.e. at each
particular point in time the registration was issued during the 1967-1990 time period, were Pro-Football's registered
marks consisted of or comprised of matter which may disparage Native American persons. Looking at the marks as
of the date of registration appears to be the TTAB's attempt to right past wrongs. Similar to declaring a contract void
ab initio, using the “as of the date of registration” standard allows the TTAB to cancel the registrations of the marks
as of the dates of their registrations, expunging the validation that granting registered status gave to disparaging,
non-registerable marks.

Once the TTAB determined the appropriate time period of reference, it needed to look to the ordinary and
common meaning of “disparage.” [14] Since there was little precedent before it on he disparagement claim, the
TTAB could not determine the meaning of “disparage” by reference to prior court and TTAB decisions as it could
when determining the meaning of “scandalous.” However, the TTAB could establish meaning by reference to
dictionary definitions of the word “disparage.” [15] The TTAB cited the following dictionary definitions of the word
“disparage”: (1) “to dishonor by comparison with what is inferior; to speak slightingly of; to deprecate; to undervalue,” [16] (2) “to degrade; lower; also (chiefly passively), to discourage by a sense of inferiority;” [17] (3)
“to regard or speak of slightingly;” [18] (4) “to affect or injure by unjust comparison, as with that which is
unworthy, inferior, or of less value or importance;” [19] and (5) “(rare) to degrade in estimation by detractive
language or by dishonoring treatment; lower; disonor.” [20] Consolidating these five definitions and in reference to
the meaning of “disparage” at the time the Lanham Act was passed, [21] the TTAB concluded that it must determine
whether, in relation to identified persons, living or dead, institutions, beliefs, or national symbols, the matter in
question may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust
comparison. [22]

The TTAB reasoned that reference to the perceptions of the referenced group, rather than considering the
views of the general population was logical. [23] Based on precedence, the TTAB stated that these perceptions may
be reasonably determined by a substantial composite of the referenced group. [24] In order to make this
determination, the TTAB stated that it must consider the relationship between the subject matter in question and the
other elements that make up the mark in its entirety, the nature of the goods and/or services, and the manner in
which the mark is used in the marketplace in connection with the goods and/or services. [25]

By way of example, Pillsbury's famous Doughboy character is registered with the United States Patent and
Trademark Office (“PTO”); [26] yet the PTO, in the 1950's, denied registration of “Dough-Boy” for an anti-venereal
medication, finding that the mark “Dough-Boy,” a name for American soldiers in World War I, would be
disparaging as used in connection with the identified goods, particularly in view of the packaging which featured a
picture of an American soldier. [27] Clearly, context is key, and some terms that in one context may be disparaging
may be granted registration given another context where the manner in which they are used is not itself disparaging.
The TTAB registered “Jap” for women's clothing [28] and “Moonies” for dolls that drop their pants when squeezed
in the proper place [29] because the TTAB determined that the marks, as used in connection with the goods they
referred to, could not be associated with the groups that challenged these registrations so as to disparage such
groups. [30] Yet, in other contexts, these same terms are clear references to specific groups of people, and such
references tend to be at least slightly disparaging of the group(s) to which they refer.

In this case, assessing the claims, on the one hand that the inherent nature of the word “redskins” and Pro-
Football's use of the marks involved in the dispute perpetuated the devastating and harmful effects of negative ethnic
stereotyping, [31] and on the other hand that the long use, advertising and promotion of Pro-Football's registered
marks had clearly caused the public to associate and identify the marks in question solely with the Washington
Redskins football franchise, the TTAB stated several points. First, “redskins” clearly referred both to Native American peoples and to the Washington Redskins professional football franchise. Second, such reference may be disparaging of Native Americans to a substantial composite of this group of people. Finally, Pro-Football's registrations for the marks in question should be cancelled.

B. The District Court Decision

The district court ultimately reversed the holding of the TTAB stating the TTAB's finding of disparagement was not supported by substantial evidence, and, moreover, laches precluded consideration of the case. The district court was bound by the substantial evidence standard, which required it to determine whether a reasonable mind could accept the evidentiary record as adequate to support the conclusion ultimately reached by the lower court (here, by the TTAB). It did not challenge the standard articulated by the TTAB for evaluating a disparagement claim; rather, it concluded that the TTAB's finding of disparagement was unsupported by substantial evidence, was logically flawed, and failed to apply the correct legal standard to the TTAB's own findings of fact. The court criticized the TTAB for what it felt was an inferential decision that failed to make findings of fact in several areas, and instead just pieced together bits of limited, undisputed evidence. Moreover, although the TTAB properly determined that it should look to the views of the referenced group when deciding a disparagement claim, it also wrongly relied on the views of the general public for probative value. In addition, the TTAB wrongly considered evidence concerning the actions and words of Redskins fans and the media when assessing the case against Pro-Football. The district court opined that under a standard that attributes to a team responsibility for the actions of its fans and the media who cover it, no team would ever be able to keep its mark if any fans or media did or said anything that could be construed as insulting to the group referenced by the team's mark.

The district court also criticized the TTAB's conclusion that “redskins” ultimately came to refer to both Native Americans and Pro-Football's professional football team since the evidence indicated that from the 1950's to the present there had been minimal examples of “redskins” as used to reference Native Americans; whereas there were significant instances of the term used in reference to the NFL team. The district court said that in light of such evidence, it could not support the TTAB in its inference unsupported by any amount of evidence. If the term dropped out of usage, it must have been because it was derogatory. The district court also said even if “redskins” was held to be disparaging or offensive when referencing Native Americans generally, it does not automatically follow that “redskins” is disparaging or offensive when used in the context of the Washington Redskins NFL franchise, which the district court pointed out would have been the proper inquiry for the TTAB to have undertaken in this case.

Not only did the district court find insufficient evidence on the record to support the TTAB's rationale, the court also found that the doctrine of laches should have barred the Petitioners' claims from even being considered. The marks in question were registered between 1967 and 1990, but the Petitioners did not file a complaint against Pro-Football until 1992. According to the district court, the best time to resolve the case would have been 1967 or shortly thereafter. It feared that without laches, a party could theoretically delay bringing a cancellation proceeding indefinitely. The court noted that such a threat would effectively undermine the entire point of seeking trademark protection in the first place.

In reaching its decision, the district court modified the typical application of laches to the particular facts and procedural history of this dispute and case. The court held that Pro-Football must satisfy three elements to fulfill its burden and raise a successful laches defense: (1) Petitioners delayed substantially before commencing their challenge to the marks; (2) Petitioners were aware of the marks during the period of delay; and (3) Pro-Football's ongoing development of goodwill during the period of delay engendered a reliance interest in the preservation of the marks. According to the court, given that the Petitioners had both actual and constructive notice of the marks, that Pro-Football engaged in widespread use of the marks, that 25 years had passed between first notice of the first mark and the filing of the complaint, and that the Petitioners made no excuses for their delay in filing the complaint, the court could do nothing but uphold Pro-Football's laches defense, if Pro-Football could assert some detriment due to the delay. Here, the court found that the amount (time, money, and effort) Pro-Football invested in the marketing and development of its marks was more than adequate to demonstrate the losses that would occur if Pro-Football's registrations were cancelled.
In its analysis, the district court examined the delay in filing a claim as it applied to each particular registration at issue. [57] The court found that for the marks registered in 1967, 1974, and 1978, the delay in filing was so facially substantial that no further inquiry was necessary. [58] It then noted that for the mark registered in 1990, the delay in filing was only 2 years; however, given the circumstances, this, too, was too substantial of a delay to be entitled further consideration. [59] For one thing, though the mark was not registered until 1990, it had actually been in use since 1962, and, moreover, the mark existed within the context of the other marks, which were facially precluded from review. [60] Because laches is an equitable defense, the court felt free to consider all of the facts and circumstances surrounding the issue, arriving at the conclusion that results in the least amount of prejudice and harm to both parties. [61] The court felt that the Petitioners had sat on their rights to their own detriment, and, thus, 11 years after the initial complaint was filed, the Petitioners' claims were denied.

II. ISSUES AND IMPLICATIONS

A. Analysis of the TTAB Decision

One of the main arguments raised by Pro-Football against cancellation of their marks was that the marks had acquired a strong secondary meaning, such that no reasonable person would or could conceive that the marks referred to the Petitioners or any member of their respective groups. This defense is basically precluded, however, if the standard applied by the TTAB involves analyzing the marks and their meanings as of the date of registration (i.e., prior to the acquisition of secondary meaning). Also, if the relevant segment of the population is the referenced group, Pro-Football would have needed to argue that no reasonable member of the referenced group would so conceive the marks. At any rate, secondary meaning as a defense is only applicable if the TTAB is considering the meaning that the marks possessed as of the date of trial.

The reason for concern about the secondary meaning defense being barred is that if the owner of a registered trademark cannot assert that the claim is time-barred, and if the owner cannot assert secondary meaning such that the mark, even if once disparaging, no longer is, then he is effectively left with no defense at all. Stripping the trademark owner of these two claims means that his only hope of success is that the marks are found to not have been disparaging at the date of registration in the opinion of the referenced group. A finding of fact that the mark was disparaging at the date of registration in the opinion of the referenced group would automatically translate into the holding of the case, and the owner of a trademark who innocently selected the mark (whether or not it was even he who selected the mark), and who invested time, money, and effort to develop the mark and the goodwill surrounding the mark, would lose all benefits and protection surrounding the mark. Additionally, he would never be able to recoup the time, money, and effort spent to obtain those benefits and protections. In this scenario, there would be no balancing and weighing of the interests; equity would only serve the petitioners, and equity to one party only is not equity at all.

As to the relevant segment of the population, the TTAB had relied on precedent in determining who the relevant portion of the population was in deciding disparagement claims. [62] There were two problems with this approach, however. First, as the district court pointed out, despite setting its standard as a substantial composite of the referenced group, in its application and analysis, the TTAB seemed to consider not only the views of the referenced group, but also those of the general population. [63] Moreover, its findings as to what the referenced group believed were based, in substantial part, on inferences and assumptions from the views of the general population. [64] Moreover, its findings as to what the referenced group believed were based, in substantial part, on inferences and assumptions from the views of the general population. [64]

The second problem, which the district court ignored, is with the standard itself. If the TTAB looks solely to the perceptions of a substantial composite of the referenced group, it effectively discards all other facets of the case, including that part of the standard that purportedly looks to the totality of circumstances and the context in which the mark is used. For example, regardless of how “Redskins” is used by Pro-Football, Native Americans may still understand the word to refer to them. Even if they understand that Pro-Football's use of the mark is not intended to refer to them in a derogatory fashion, it is still conceivable that a substantial composite of the group will have a stronger association between the word and themselves than between the word and the football team. While it is appropriate to give strong weight to the feelings and perceptions of the referenced group, perhaps the standard
should be modified to a reasonable person standard, i.e. a reasonable person under the same or similar circumstances as the petitioner.

As stated above, another key factor in deciding disparagement claims is the ability to distinguish between the mark itself and the manner in which the mark is being used. Understanding that context is key would seem to give some added protection to the owner of the mark such that so long as the owner's use of the mark is not itself disparaging, then the fact that the mark in another context could be disparaging would be irrelevant. The protection that this factor affords the trademark owner, however, is negated by a separate portion of the disparagement analysis.

As opposed to the scandalous analysis, where in order for the mark's registration to be cancelled the Board must find that the mark is scandalous, for a disparagement claim to survive, petitioners need only prove that the mark may be disparaging. [65] Given that in deciding whether the mark may be disparaging, the Board will look not to American society as a whole (as determined by a substantial composite of the general population), but instead only to the views of the referenced group, [66] the standard for disparagement is ultimately low, easily surmounted by groups challenging the registration of marks on disparagement grounds.

The TTAB also effectively lowered the standard even further in that despite its earlier claim that precedent required consideration of the totality of circumstances, the nature of the goods and/or services, and the manner in which the mark is used in the marketplace in connection with the goods and/or services, [67] it failed to actually apply that standard to the facts of the case. [68] The ultimate inquiry should have been whether the marks were disparaging when used in connection with Pro-Football's team and services, [69] but the TTAB never actually undertook this step in its analysis.

Perhaps the biggest TTAB blunder in this case, was the manner in which it drew its conclusion that “redskins” ultimately came to refer to both Native Americans and Pro-Football's professional football team, [70] and also the weight that it gave to this conclusion. From the 1950's to the present, there are minimal examples of “redskins” as used to reference Native Americans; whereas there are significant instances of the term referring to the NFL team. [71] The period from the 1950's to the present is encompassed within the relevant time period for the disparagement analysis in this case, and with fewer and fewer actual references to Native Americans, it becomes increasingly difficult to prove that the term in the context in which it is being used by Pro-Football is disparaging to Native American persons. The TTAB made the faulty inference that since “redskins” may be viewed by Native Americans as derogatory when referencing Native Americans, “redskins” must be disparaging when used in the marks to reference the Washington Redskins professional football team. [72] The TTAB never developed its rationale as to how Pro-Football's use of the marks in connection with its services disparages Native Americans, [73] and what evidence the TTAB did attempt to use in rendering its decision was misplaced. [74]

B. Analysis of the District Court Decision

In its review of the case before it, the district court ultimately reached the right outcome, reversing the cancellation of Pro-Football's registrations. [75] The district court was correct in its assessments of the TTAB's findings, i.e. lack of evidence and faulty inferences, but the district court did not challenge the standard employed by the TTAB; it only challenged the TTAB's application of that standard. The standard employed by the TTAB is not the best possible standard. The district court should have examined this standard in detail as its failure to do so could result in the TTAB applying the same faulty standard to future disparagement claims.

Though the court ultimately reached the right result, there are aspects of its analysis, too, that could prove problematic in the future. Aside from the fact that the court did not challenge the TTAB standard, thus failing to provide guidance for the future and rectify or clarify some of the issues raised by the TTAB's analysis, the court's own decision on the laches claim is also subject to scrutiny. The court required that three elements be proved, the first of which was that the Petitioners delayed substantially prior to commencing their challenge to the marks, [76] but the court failed to adequately describe just what is meant by “substantial.” [77] The district court found that three of the registration dates in question were facially substantial and the other was substantial given the context of its use. [78] The context of the mark's use included actual use as of a date that was facially substantial, and,
moreover, use in conjunction with marks that had already been found to involve substantial delay in raising the claim against them. [79] These findings, however, do little to prepare the TTAB for rendering future decisions on whether or not a delay was so substantial as to bar consideration of the claim.

In addition to this problem with the first prong of its test, the third element needed to be proven in a laches defense is that the ongoing development of goodwill during the period of delay engendered a reliance interest in the preservation of the marks. [80] Again, though, the court failed to adequately define its terms. It is possible that a trademark owner's reliance on the development of goodwill is misplaced. For example, it is entirely possible that an owner will promote a mark in a manner other than how he believes that he is promoting the mark, such that no goodwill is actually developing around the mark. Alternatively, the TTAB or a court may find that the owner has not expended enough time or money such that he would be irreparably injured if cancellation of his marks is ordered. Thus, it would have been helpful for the court, short of a bright line test, to more thoroughly explain itself and develop its concepts before passing its decision on.

C. Broader Implications of the TTAB and District Court Decisions

Although the district court relied on the lack of evidence on the record and laches to overturn the TTAB, there are yet other interesting questions and arguments related to this dispute that deserve attention and exploration. One such question is, given the now-acquired strong secondary meaning in Pro-Football's marks, if the cancellation of the marks had been upheld on the grounds that the marks were disparaging at the time of registration, could the marks be re-registered today? Taking the first mark to be registered, “The Redskins,” if laches was not an issue, and if secondary meaning was not a defense, and if “redskins” may have been disparaging to Native Americans in 1967, the mark would have been cancelled. Assume, though, that through the acquisition of a strong secondary meaning, “The Redskins” no longer posed the potential for disparagement today. Presumably, the mark could be re-registered as of today. If this is true, it makes little sense to go through 11 years of litigation and cancel the mark; the owner could submit another application for registration and ultimately succeed in getting the mark registered, and all of the protections the petitioner just succeeded in stripping the owner of would be returned in full force and effect.

One of the oft-mentioned issues concerning team names and logos is just how many marks being used could ultimately be found disparaging. [81] At least five professional sports teams have Native American names and mascots. [82] Countless more colleges and universities, [83] high schools, middle schools and junior highs, and elementary schools also possess such nicknames and mascots. [84] Presumably, success of the Petitioners' claims could ultimately open the floodgates for a large number of other, related lawsuits. Dozens of high schools and colleges have already taken the preemptive measure of changing their nicknames and mascots, abandoning those that could be found discriminatory and disparaging. [85]

Who determines what is discriminatory and disparaging, though? Some experts who testified at the TTAB hearing concluded that, as used by Pro-Football, “Redskins” sent a message that Native American people are ferocious, strong, war-like, and brave, [86] even savage. [87] Although ferocious, war-like, and savage, taken individually, are not positive characteristics, if the focus is on strong and brave, and especially in the context in which Pro-Football uses the marks, the overall picture is one of inspiration and encouragement for the players and the fans. Even the TTAB admitted that words can have multiple definitions and meanings, and connotations tend to be quite dependent upon the context in which they appear. [88]

Not only is context a factor that should be adequately considered, [89] but also the speaker and the speaker's intent should be factored into the analysis. For example, a southerner may call a northerner a Yankee, with the most disparaging of intentions; yet New Yorkers proudly identify with their beloved Yankees. Although the term itself may have originated with a negative connotation, and although the term may still be used in certain instances to deride the referenced group, it is clearly far from the only meaning and understanding of the term. Under the standard employed by the TTAB, it might have to grant standing to any group of people from the northeastern region of the United States, allowing any number of people to bring suit challenging the validity of the mark.

Another example of a mascot that has been questioned is Florida State University's Seminole. [90] Florida State's use of the Seminole was presumably introduced because the state of Florida is the Seminole State. Assuming,
arguendo, that this is how and why Florida State University (“FSU”) selected its mascot, this does not mean that a disparagement claim is necessarily precluded. According to the TTAB standard enunciated in Harjo, intent, or lack thereof, is not dispositive on the issue of disparagement. [91] No evidence was introduced that Pro-Football intended to disparage Native Americans or that their decisions regarding choice of team name and mascot were guided by malicious intent or ill-will, yet neither was this lack of evidence enough to dismiss the claim against them. So, the question becomes whether or not there is something (i.e., anything) that makes “Seminole” a better, more acceptable term, nickname, and mascot than “redskin.”

Some Native Americans and others have argued that the difference lies in whether you reference an actual tribal name, or whether, on the other hand, you employ a term that does not, in itself, reference a particular group of Native Americans, but instead references the Native American nation and certain attitudes toward and stereotypes of that nation. [92] For example, one commentator, in explaining the problem with the term “Redskin,” supposed that the origin of the term came from European and Algonquian references to the Delaware Indians, who streaked their faces and bodies with bright red ochre and bloodroot, and who had a fondness for wearing ‘makeup’ made from fat mixed with berry juice. [93]

Drawing such a clear-cut distinction between actual tribal names and other references to Native Americans seemingly oversimplifies the matter, however. It ignores the crux of the issue, that is, how the mark is used in connection with the owner’s goods and/or services, to say that one can draw such a clear, black and white line between acceptable and unacceptable Native American references and marks. For example, although “Seminole” may not be disparaging by nature, the fact that the FSU mascot, prior to home football games, rides out onto the field on a horse and forcefully drives and stakes a spear into the ground means that the personification of the Seminole is not that different, if at all, from the fierce, war-like image complained of by the Petitioners in Harjo. [94] In fact, this use of “Seminole” does not seem to be any less ‘disparaging’ to Native Americans than the Petitioners claimed “Redskins” was, yet the chairman of the Seminole Tribe of Florida (the “Tribe”) has asserted FSU’s use of the Seminole mascot has been an ego boost to the Tribe, and a great homage to and pride in the Tribe by FSU. [95]

One could also argue that even the TTAB itself waivers in regard to deciding what types of marks may be disparaging. The TTAB decided Harjo in April 1999, holding that “Redskins” was disparaging to the Petitioners, a group of Native Americans. [96] Just one month earlier, however, the PTO registered the “Fighting Illini” mark on behalf of the University of Illinois. [97] If the concern is truly with portrayal of Native Americans as wild savages, [98] certainly the word ‘Fighting’ contained directly in the mark would seem to preclude registration of the mark. “Fighting Illini” was granted registration, however.

As difficult as it may be to draw lines among Redskins and Seminoles and Fighting Illini, and the uses of such marks, adding a team like the Cleveland Indians and their mascot, Chief Wahoo, to the equation complicates things even further. According to the racial epithet argument, the Cleveland Indians mark would appear to survive challenge. “Indians” seems neutral on its face, not calling into question the honor and ‘humaness’ of Native Americans. However, although “Indian” may not be disparaging by nature, the Cleveland Indians’ mascot, Chief Wahoo, has certainly brought the Cleveland Indians and their registered marks under attack. [99] As much as Native Americans have protested being portrayed as “wild savages,” [100] so, too, have they taken offense to portrayal as a grinning caricature with exaggerated features. [101]

Moving away from solely Native American logos, nicknames, monikers, and mascots, if someone were to compile a listing of mascots and team names, it could undoubtedly be argued that many of these mascots and team names were chosen based on geography and/or ethnic backgrounds. For example, the NFL boasts the Dallas Cowboys, the Minnesota Vikings, the New England Patriots, the Pittsburgh Steelers, and the San Francisco 49ers. The National Basketball Association (“NBA”) is home to the Boston Celtics. Major League Baseball (“MLB”) hosts the Milwaukee Brewers, the New York Yankees, and the Seattle Mariners. While these examples are not an exhaustive cataloguing of team names with geographic and/or ethnic meaning, they do provide not insignificant evidence that, at least to a certain extent, team names may be chosen as a tribute or homage to the people of the city, state, or region that the team will call home. In addition, Division I colleges and universities feature such mascots as the Fighting Irish, [102] Spartans, [103] and Trojans. [104] Such nicknames, rather than trying to convey a message about a certain group of people, attempt to instill a sense of competition and team spirit. They send a message to
opposing teams that there will be a battle on the field. As at least one commentator has pointed out, team names are often chosen so as to encourage and rally the team, but certainly not to demean the players or those connected with the chosen name. [105]

Those who oppose use of Native American references for team names and mascots often attempt to draw analogies to other minority groups. [106] In other words, such commentators urge consideration of probable outcomes, e.g., public outrage, if a team were to be christened with a name and/or mascot that related to, for example, African Americans, or Asian Americans, or Mexican Americans. [107] What such commentators fail to recognize, however, is that other classes of people, including African-, Asian-, and Mexican-Americans, do not own the same portion or type of history in our country as Native Americans do. In this case, for example, Pro-Football's executive Vice-President had argued that, in playing football in the NFL and representing the nation's capital in so doing, the Washington Redskins' team name and logo reflect the positive attributes of Native Americans, including dedication, courage and pride. [108] For better or for worse, the history and attributes of other cultural groups in American society are not as readily accessible and visible, and tend to not enjoy the same prominence in our history books as do Native American peoples. Any identifying terms that could be used to refer to, for example, African-, Asian-, and Mexican Americans are facially disparaging, and would not be entitled to any protection.

It is also worth exploring what good this case really would have done had the cancellations been upheld. If the district court ultimately affirmed the TTAB, then Pro-Football's registrations of the marks would have been cancelled. [109] That being so, Pro-Football would still be able to use the marks, and, moreover, may even have had common law protection available to them at both the state and federal levels. [110] Given the 11-year run this case had in the court system, it seems like an awful lot for a petitioner to go through for very nominal results. It is hard to believe that the public statement that yes, these marks do disparage the referenced group, is worth the long (and presumably expensive) legal battle obtaining such a public statement entails.

Other than the aforementioned public statement however, the Petitioners, if ultimately successful, would have received little, if any, benefit. Therefore, some commentators have argued that perhaps the Native Americans themselves should be afforded ownership of the marks that reference them. [111] On the one hand, this position at least seems to provide some form of an actual reward for a successful petitioner. On the other hand, however, given the uncertain status of laches, allowing a petitioner to acquire ownership of the marks could become the most egregious of all wrongs. Assuming that, as the TTAB did, laches does not preclude consideration of disparagement claims, then there would be nothing to prevent a potential petitioner from not only sitting on his rights until he felt ready to bring a cancellation proceeding before the TTAB, but also such a standard would practically encourage a potential petitioner to wait even longer, allowing the mark's owner to continue to build up the reputation and good will of the mark, resulting in a maximum payoff for a successful petitioner.

III. PROPOSED MODIFICATIONS

The district court's analysis was guided by the standard of review it needed to employ when considering what the TTAB had already done during the initial hearing. [112] Whether the district court's review provides any guidance to the TTAB should a similar case arise again remains to be seen. It is certainly an unfortunate situation when a group of people feels injured or slighted by something that brings as much enjoyment and pride to others as the Washington Redskins football team does. Moreover, if a group of people like the Petitioners actually possesses a valid legal claim, we should not be quick to dismiss this claim. However, given the indefiniteness of the claim at issue here and in similar cases, we must also protect the interests and goodwill of the trademark owner who has diligently marketed, promoted, protected, and policed his mark during this period of ownership free from challenge. What follows is the hypothetical analysis and outcome of this same case under the standard the author proposes should be used by the TTAB when considering disparagement claims. It rejects the findings of the TTAB, and modifies the ruling of the district court insofar as the district court failed to provide guidance to the TTAB on the standard to be applied in future disparagement cases.

Given the sensitive nature of the issues at stake in a cancellation proceeding based on disparagement, and given the potential result of significant economic prejudice, the TTAB should not pick and choose which facts and arguments to consider. If the basis of allowing disparagement claims at such a late date and time is equity, it seems entirely inequitable to deny a trademark owner the ability to raise as strong of a defense as he can. Even someone
who has practically definitive DNA evidence against him, or someone who clearly breached a valid contract by failing to perform under the terms of that contract, is entitled to raise a defense. Among the most basic tenets of our legal system are the notions that everyone is entitled to their day in court and that a defendant has the right to confront his accuser, and there is no reason to treat the trademark owner any differently. Thus, the TTAB should consider all of the facts and circumstances relevant to and surrounding the case. In other words, the TTAB should allow all reasonable arguments and defenses to be raised, and should examine all claims and defenses as of the date of the suit.

If the TTAB employed such a standard, taking into account all possible arguments and defenses thereto, the doctrine of laches would effectively merge with the affirmative defense of secondary meaning. > In other words, the TTAB could give the petitioner leeway with laches, but, in exchange, the petitioner would be taking its chances that the defendant could mount a persuasive secondary meaning defense.

An added benefit of this approach is that in highly sensitive cases such as this, the reason(s) for failure to bring the claim sooner may speak directly to the effects of disparagement. That is, perhaps the reason the Petitioners lacked the confidence or ability to bring the claim sooner had to do with the lack of respect and equality they felt, which, in turn, might speak directly to the public's (including the trademark owner's) perceptions of the group. [113] Thus, without penalizing potential petitioners for what could possibly be viewed as part and parcel of the disparagement claim, the TTAB could also provide an innocent and good-intentioned trademark owner with a solid opportunity to defend itself against the disparagement claim.

In this case, again, it is undisputed that Petitioners sat on their rights for 2 to 25 years, depending on which mark in question you are referring to. [114] The Petitioners may have done so for any number of reasons, some legitimate, some not. Without debating the merits of this delay, the TTAB could accept this delay without question, in part because the longer the Petitioners sat on their rights, the longer Pro-Football had to develop, market, and brand its marks. [115] Moreover, Pro-Football would be allowed to show that, via this period of delay/development, regardless of how “Redskins” may have been viewed at the time of registration, the marks have acquired such strong secondary meaning that “Redskins,” especially as applied to Pro-Football's goods and services, can no longer be found to disparage Native Americans. In effect, allowing a defense of secondary meaning requires the TTAB to alter its standard to measure disparagement as of the date of the suit.

As to who the relevant segment of the population is for deciding disparagement claims, while the TTAB's decision that a substantial composite of the referenced group went unchallenged by the district court, [116] perhaps a better approach would be to employ a reasonable person standard. If the standard involved looking at the viewpoint of a reasonable person under the same or similar circumstances as the petitioner, then, again, all of the interests at stake in the cancellation proceeding are balanced as well as possible. “Under the same or similar circumstances” would allow the TTAB to consider the history of the Native American people, including their experiences with the word “Redskins” and the perceptions and connotations the word carries for them. This would be balanced, however, by a “reasonable person,” meaning that the TTAB would also be free to consider whether or not those perceptions and connotations are rational in light of the context in which the mark is used and the manner in which the owner has developed the mark over the years, including the acquisition of secondary meaning. Native Americans, despite secondary meaning, may still hear the term “Redskins” and believe that the term does apply to them, and does so in a disparaging manner. Clearly, this alternative approach is not perfect, but neither is any approach that has been proposed or utilized. Each approach works to the benefit of one party at the expense of the other. The approach proposed here seeks to balance these factors in a way that minimizes the prejudices experienced by the parties.

A potential problem with the proposed standard is that if the TTAB measures disparagement as of the date of the suit, this may allow suits against marks that were not disparaging as of the date of registration, but that have become disparaging over time. Ultimately, however, this is not a problem. A mark will not become disparaging if the owner has succeeded in fostering goodwill around the mark. A mark will only become disparaging over time if the owner of the mark portrays the mark in a disparaging way and is not effective in monitoring how the mark is being used. Such owners should not be entitled to the protections afforded innocent owners of marks who have been engaging in legitimate use of the marks and who have been cultivating goodwill towards the mark. In a case where the mark has become disparaging, the interests of the petitioners and the owner would still be balanced and weighed,
but the scale would tip in favor of the petitioners.

The approach just proposed considers a number of issues, and it favors allowing a group of petitioners to bring a claim whenever they so choose, while sending such group a message that the longer they sit on their rights, the more protection the trademark owner will receive. Under such a scenario, the trademark owner would not be guaranteed a victory against disparagement claims, but he would be afforded some protection. Two wrongs do not make a right, and a group of petitioners should not be able to inflict what could be substantial injury on a trademark owner because they themselves have felt injured over a given period of time. Here, under the standard just proposed, although the Petitioners' claims would not have been barred by the doctrine of laches, given the fact that “Redskins” no longer clearly refers to Native Americans (the term has now been found to refer predominantly to Pro-Football's goods and services), Pro-Football would have mounted a successful defense to Petitioners' claims.

*B.A., University of Notre Dame; J.D. Candidate, Boston College Law School. The author would like to thank Professor Liu for an inspiring class and all of his encouragement in letting her run with this paper.


[2]. Id. at 153, 157.

[3]. Id. at 157.


[5]. See id. at 81.


[7]. Id. at 8.

[8]. Id. at 5.


[10]. See n.13, infra.


[14]. Id. at 112. The TTAB prefaced this portion of its opinion by saying that “there is relatively little published precedent or legislative history to offer [it] guidance in interpreting the disparagement provision in Section 2(a).” Although separate and distinct from a scandalous claim, the TTAB believed it proper to undertake an analysis similar to that undertaken in relation to scandalousness.

[15]. Id. at 112-13.

[17]. See id.


[19]. See id.

[20]. See id.

[21]. See id. at 113, n.99.

[22]. Id. at 113-14.

[23]. Id. at 117-18.

[24]. Id. at 118.

[25]. Id. at 117.

[26]. A search of the PTO website (www.uspto.gov) as of September of 2003 indicates that Pillsbury owns 12 live trademarks that refer to its now famous Doughboy character, plus 4 dead marks that were, at one time, used in connection with this character.


[30]. See id.; Condas, 188 USPQ 544.

[31]. 1999 TTAB LEXIS 181 at 47.

[32]. 1994 TTAB LEXIS 9 at 11-12. Pro-Football had asserted that even in the unlikely event that the marks were reasonably understood by the general public to refer in the abstract to Native Americans in a disparaging manner when adopted many decades ago, such is no longer the case.

[33]. See 1999 TTAB LEXIS 181 at 132.

[34]. Id. at 153.

[35]. Id. at 157.


[37]. Id.
[38]. *Id.* at 51; *see* Consolidated Edison Co. v. NLRB, 305 U.S. 197, 229 (1938); Dickinson v. Zurko, 527 U.S. 150, 162 (1999).


[40]. *Id.* at 82.

[41]. *See id.* at 89.

[42]. *See id.* at 91-92.

[43]. *See* 1999 TTAB LEXIS 181 at 128-30.


[45]. 1999 TTAB LEXIS 181 at 132.


[47]. *Id.* at 100.

[48]. *Id.* at 96.

[49]. *See id.* at 113-138.

[50]. *Id.* at 114.


[52]. *Id.* at 122.

[53]. *See id.* at 115-16.

[54]. *Id.* at 116.

[55]. *See id.* at 124-32.

[56]. *See id.* at 136-37.

[57]. *See id.* at 124-27.

[58]. *Id.* at 125.

[59]. *See id.* at 125-26.

[60]. *Id.*

[61]. *See id.* at 128-30.


[64]. See id. at 91-92, 94.

[65]. 1999 TTAB LEXIS 181 at 115.

[66]. Id. at 117-18.

[67]. See id. at 117.

[68]. See 2003 U.S. Dist. LEXIS 17180 at 100.

[69]. Id.

[70]. 1999 TTAB LEXIS 181 at 132.


[72]. See id. at 105.

[73]. Id. at 106.

[74]. See id. at 107-09. Despite the fact that the TTAB found an increasingly respectful portrayal of Native Americans by Pro-Football and its marks, it still concluded “redskins” was disparaging in Pro-Football's context. The TTAB also cited portrayals of Native Americans in the media when referring to the Washington Redskins and by Washington Redskins fans. However, not only are the perceptions of the general public irrelevant, so too are their actions when considering the effect of the actual marks on Native Americans.

[75]. Id. at 141.

[76]. See id. at 114-17.

[77]. See id. at 124-27.

[78]. Id. at 125-27.

[79]. Id. at 125-26.

[80]. See id. at 114-16.


[83]. According to one commentator, the number of colleges and universities with Native American mascots is approximately 100. See Brown, supra note 81, at 116.

[85]. *A Public Accommodations Challenge*, supra note 82, at 905.

[86]. 1999 TTAB LEXIS 181 at 73.

[87]. Id. at 88.

[88]. Id. at 109, citing *In re Mavety Media Group Ltd.*, 33 F.3d 1367 (Fed. Cir. 1994).

[89]. See, e.g., 2003 U.S. Dist. LEXIS 17180 at 100.

[90]. See, e.g., Guggenheim, supra note 81, at 304.


[92]. “Native Americans have long asserted that the Redskins trademark is particularly derogatory, because, unlike some of the other names ostensibly based on Native American culture, it is an actual racial epithet.” Guggenheim, supra note 81, at 291.

[93]. See id. at 301.

[94]. See 1999 TTAB LEXIS 181 at 47-51.

[95]. Guggenheim, supra note 81, at 302.

[96]. 1999 TTAB LEXIS 181.


[98]. See 1999 TTAB LEXIS 181 at 51 (Petitioners asserted that some team names, including “Redskins,” are chosen to sound fierce and ferocious, harkening images of violence and savagery).


[100]. See Guggenheim, supra note 99, at 234.

[101]. See id. at 212.

[102]. University of Notre Dame

[103]. Michigan State University

[104]. University of Southern California
[105]. See Guggenheim, supra note 99, at 234.

[106]. See, e.g., Brown, supra note 81, at 128-29.

[107]. Id.

[108]. 1999 TTAB LEXIS 181 at 76.

[109]. Id. at 157.


[113]. See, e.g., Guggenheim, supra note 99, at 222, 225 (discussing the fact that a disparaging or degrading symbol may have the effect of stigmatizing the referenced group, preventing members of the group from effectively participating in mainstream society; discussing the Native American's argument that, as a group, they feel discriminated against and ignored when they try to call attention to their society's problems, such as poverty, alcoholism, and suicide); Cathryn L. Claussen, Ethnic Team Names and Logos - Is there a Legal Solution?, 6 Marq. Sports L. J. 409, 412-13 (1996) (discussing the argument that the Chief Wahoo mark is a cause of low self-esteem in Native American children).


[115]. See id. at 132-38.

[116]. See id. at 81-82.