

# REDSKINS RULING IS CONSISTENT WITH TTAB PRECEDENT

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In *Blackhorse v. Pro-Football Inc.*,<sup>1</sup> the U.S. Patent and Trademark Office once again canceled various registrations for trademarks used by the Washington Redskins football team as being disparaging to Native Americans. While this highly publicized decision may have taken some by surprise, the holding is in line with several other recent PTO decisions involving the Lanham Act's prohibition on the registration of disparaging marks, decisions which received far less media attention and public comment.

On June 18, 2014, the Trademark Trial and Appeal Board issued a decision in the second proceeding brought by a group of Native Americans to cancel registrations for various "Redskins" marks used by the National Football League and the Washington Redskins. The board held that the marks were disparaging to a substantial composite of Native Americans as of the registration date of each mark, in violation of Section 2(a) of the Lanham Act, which prohibits registration of a mark that "may disparage" persons or "bring them into contempt or disrepute."<sup>2</sup> As a result, the board ordered the cancellation of six Redskins trademark registrations owned by Pro-Football Inc., the parent company of the Washington Redskins, issued between 1967 and 1990.

This is not the first time that the board has considered whether a mark is disparaging to a particular group, nor is this the first time the board has considered whether these particular marks are disparaging to Native Americans.

## Harjo Line of Cases

In 1992, a different group of Native Americans filed a petition to cancel<sup>3</sup> the same registrations on virtually identical grounds. Pro-Football denied that the Redskins marks were disparaging and asserted various affirmative defenses, including laches. After striking all of Pro-Football's affirmative defenses, the board issued a decision on the merits in 1999, holding that the marks were disparaging when registered and ordering the registrations canceled.<sup>4</sup> Pro-Football appealed to the District Court for the District of Columbia.

On a motion for summary judgment, the district court reversed the cancellation, stating that the Board's finding of disparagement was not supported by substantial evidence and that the doctrine of laches precluded consideration of the case.<sup>5</sup> The petitioners appealed to the Court of Appeals for the District of Columbia Circuit, which ruled that the lower court had applied the wrong standard in evaluating the laches defense as to one of the petitioners.<sup>6</sup>

On remand, the district court held that the claim still was barred by laches (even with application of the correct laches standard)<sup>7</sup>, and the D.C. Circuit affirmed.<sup>8</sup> Thus, Harjo was resolved solely on the procedural issue of laches and the D.C. Circuit never evaluated the board's ruling that the Redskins marks were disparaging when registered or the district court's reversal of the original finding on the merits.

### Test for Disparagement

The Blackhorse proceeding was filed in 2006 by six different Native Americans, two of whom had very recently turned 18 (the date from which laches begins to run). Given these petitioners' minimal delay in filing the cancellation, as well as the broader public policy interest at stake in the case, the board in Blackhorse dispensed with Pro-Football's laches argument in relatively short order, focusing its opinion almost entirely on the threshold question of disparagement.

Determining whether a mark is disparaging under Section 2(a) of the Lanham Act, involves a two-step inquiry:

1. What is the meaning of the particular term, as it appears in the mark and as that mark is used in connection with the goods and services identified in the registration?
2. Is such meaning one that is disparaging to a substantial composite (which is not necessarily a majority) of the group identified by the particular term?

In deciding the second part of the test, the most relevant views are

those of the identified group, not necessarily the views of the American public as a whole. Moreover, both questions must be answered as of the registration date of the mark. Thus, in both Harjo and Blackhorse, the board was charged with determining, as of 1967, 1974, 1978 and 1990 (the registration dates of the marks at issue), the meaning of the term "redskins" as used in Pro-Football's marks and in connection with professional football-related services, and whether such meaning was disparaging to a substantial composite of Native Americans.

### Evidentiary Record

The parties to the Blackhorse proceeding stipulated that nearly the entire Harjo record be submitted into evidence through a notice of reliance, reserving the right to object to such evidence solely on the basis of relevance. All other possible admissibility objections, including hearsay, were waived. As a result, in the Blackhorse proceeding, the content of the admitted Harjo evidence could be considered for the truth of the matters asserted, a potentially critical distinction with regard to some evidence found to be hearsay or to lack foundation in Harjo.

As to the first part of the disparagement test, the board in Blackhorse held that the evidence overwhelming supported a determination that the term "redskins," as it appears in Pro-Football's various marks, means "Native Americans." Although the term also refers to the Washington Redskins football team, even when used in the context of Pro-Football's marks and in connection with football-related services, the term still carries the allusion to

Native Americans inherent in its original definition.

With regard to the second part of the test, the board found that the evidence supported a determination that the term "redskins" was disparaging to a substantial composite of Native Americans during the relevant time period of 1967-1990. The most probative evidence for the board fell into two categories: (1) a general analysis of the word drawn primarily from dictionary definitions and media references, and (2) the specific views of various Native Americans themselves.

In particular, the record included excerpts from multiple dictionaries whose definition of "redskin" included a restrictive usage label identifying the term as "often offensive" and expert testimony from both sides that the adoption of usage labels by dictionary editors usually reflects the influence of sociopolitical pressure groups. The board found that the dictionary evidence showed a clear trend, beginning in 1966 and continuing to 1990, to label the term "redskin" as "offensive."

The record further showed a simultaneous and marked decrease in media usage of the term "redskin" to refer to Native Americans, with evidence of widespread usage of the term prior to the late 1960s but very little usage of the term in this context after 1970. In the board's view, this evidence clearly demonstrated that during the relevant period of 1966-1990 there was increasing public recognition that the term "redskin" was offensive and disparaging to Native Americans.

With respect to firsthand views

of Native Americans, the record contained a 1993 resolution adopted by the National Congress of American Indians (“NCAI”), a nationwide intertribal organization founded in 1944, stating that “the term REDSKINS is not and has never been one of honor and respect, but instead has always been and continues to be a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation” for Native Americans. Deposition testimony from NCAI’s executive director in 1996 indicated that membership at the time of the 1993 resolution was approximately 150 tribes, or roughly 30 percent of Native Americans.

The board found the NCAI resolution to be a credible and reliable document representing the views of a substantial composite of Native Americans. While the resolution was adopted three years after the relevant timeframe, the board found it to be persuasive evidence of the views of Native Americans during the relevant timeframe, given the particular language of the resolution setting forth the past and ongoing viewpoints of the membership of NCAI.

The record also included evidence of a 1972 meeting between Edward Bennett Williams, then president and part-owner of the Washington Redskins football team, and a delegation of seven representatives from various Native American organizations (including NCAI), at which meeting the representatives voiced their objections to the Redskins team name as disparaging. In addition to deposition testimony from at least one meeting attendee, the record contained various news articles

from 1972 about the meeting, the topics discussed, and the views asserted by the Native American attendees.

Finally, the record included numerous letters from individual Native Americans protesting Pro-Football’s use of the Redskins name as offensive. Again, many of such letters were written at the end of, or just after, the relevant time period however, the board found them to be persuasive evidence of the writers’ viewpoints during the relevant time period.

### **Majority Decision**

The board concluded that the evidence of record in Blackhorse established that, at the times of the various registrations, the term “redskins” was an ethnic term meaning “Native Americans” that was disparaging to at least 30 percent of Native Americans (the approximate membership of the NCAI), which percentage is a “substantial composite” of that group.

In the majority opinion, Administrative Trademark Judge Karen Kuhlke noted that neither Pro-Football’s alleged honorable intent with regard to use of the term “redskins” nor the generally inoffensive nature of football-related services precluded these findings. Moreover, she noted that although a portion of the American public (and even some portion of Native Americans) may not have found the term “redskins” to be disparaging in the context of football during the relevant time period, those differing opinions do not erase the perceptions of the substantial composite of Native Americans who did find the term to be disparaging.

### **Dissent**

In his dissent, Judge Marc Bergsman argued strenuously that the evidence of record did not support the majority’s findings, specifically “that the dictionary evidence relied upon by the majority is inconclusive and there is no reliable evidence to corroborate the membership of the National Council of American Indians.” He chastised the petitioners for simply reusing the Harjo trial record without substantial augmentation (a record that he characterized as stale and nothing more than a “database dump” with “no order or structure ... that told a compelling story or presented a coherent case”) and criticized the majority for basing its conclusions on such insufficient evidence.

In particular, Judge Bergsman argued that evidence of just two dictionary entries from the late 1960s and early 1970s labeling the term “redskin” as “often offensive” leaves open the possibility that the term is not “always offensive” and may not be offensive when used in connection with the name of a football team. With regard to the 1972 meeting between Native American representatives and Edward Bennett Williams, Judge Bergsman argued that newspapers articles and the deposition testimony of only one meeting attendee were insufficient evidence as to what transpired at the meeting, the particular organizations participating in the meeting, or the people represented by those organizations.

Finally, he argued the evidence of record did not adequately substantiate the membership of NCAI at the relevant time periods or the organization’s authority to take, on behalf of its members, the position

on the disparaging nature of the term “redskins” set forth in the 1993 NCAI resolution. According to Judge Bergsman, the evidence supporting the majority’s finding that NCAI represented approximately 30 percent of Native Americans during the relevant time period “is a house of cards that collapses upon examination.”

### **Accord With Board Decisions in Heeb and Geller**

While the majority ruling in Blackhorse may have taken some people by surprise, the decision is squarely in line with two other recent TTAB decisions, *In Re Heeb Media LLC*[9] and *In Re Pamela Geller and Robert B. Spencer*,<sup>10</sup> issued quietly with little media coverage or public fanfare, in which the board found the marks at issue to be disparaging under Section 2(a) of the Lanham Act. Although these cases each involved the ex parte appeal of an examining attorney’s refusal to register the mark, they nevertheless are instructive of the quantum of evidence the board has deemed sufficient to show that a term is disparaging to a substantial composite of the identified group.

*In re Heeb Media* concerned an application to register the mark “Heeb” for clothing. In her refusal to register the mark on the basis that it was disparaging to a substantial composite of Jewish people, the examining attorney presented several dictionary definitions defining “Heeb” as a derogatory term for a Jewish person, and various news articles reporting that people representing Jewish groups or speaking in their individual capacity as Jews considered the term to be disparaging.

*Heeb Media*, who also publishes a magazine directed to the Jewish community under the title “Heeb,” contended that a finding of disparagement should not be based on “isolated editorial comments made by members of one organization or one vocal individual whose opinions do not represent Jewish popular thought or the cultural mainstream.” In particular, the applicant submitted a 2005 dictionary excerpt that defined the term as “Jewish” with no restrictive usage label, and statements from various Jewish organizations and individuals who did not find the term offensive.

Despite the conflicting evidence, the three-judge panel unanimously affirmed the refusal in a precedential opinion written by Judge Kuhlke. The board found the dictionary definitions to be persuasive evidence of the term’s derogatory meaning (despite being not entirely unanimous in their inclusion of a restrictive usage label), and while the record reflected disparate views within the Jewish community as to whether the term was disparaging, the board found clear evidence that a substantial composite of Jewish people held such view.

The examining attorney has presented evidence from various segments of the Jewish community, including the Anti-Defamation League, a university professor, rabbis, a talk-show host and ordinary citizens. Although perhaps among many of the college-age population to whom applicant’s magazine is directed the word HEEB may not have the same derogatory connotation, the

evidence is clear that, at a minimum, among the older generation of Jews the term retains its negative meaning. The post-college age Jewish population must be considered a substantial composite for purposes of our analysis.

Similarly, in *In re Pamela Geller* decided early last year in a nonprecedential opinion, the board inferred the opinion of a substantial composite of the referenced group by extrapolating the stated opinion of a few group representatives as to the disparaging nature of the mark. In that case, applicants Pamela Geller and Robert Spencer sought to register the mark “Stop the Islamisation of America” in connection with “providing information regarding understanding and preventing terrorism.”

The examining attorney introduced dictionary definitions indicating that the term “Islamisation” means “converting or conforming to Islam” and argued that the overall mark would be understood to mean that action must be taken to cease the conversion of Americans to Islam. When viewed in the context of applicant’s services, the examining attorney argued the mark conveys the further message that such action is necessary to prevent terrorism.

Applicants argued that the term “Islamisation” has a much narrower meaning — relating only to conformity with Islamic law — and therefore the mark refers only to halting the “sectarianization of a political society through efforts to make it subject to Islamic law.” Although applicants cited several uses of the term in this context by

academic, political and legal experts, the board agreed with the examining attorney that the dictionary definitions were more reflective of the current understanding of the term and that many people would view the mark to mean that the spread of Islam in America is undesirable and should be stopped in order to avoid or reduce terrorism.

The board then turned to the second inquiry of the disparagement test to determine whether the mark is disparaging to a substantial composite of American Muslims. The board noted that the mark creates a direct association between Muslims and terrorism, and concluded that “the majority of Muslims are not terrorists and are offended by being associated as such” on the basis of various newspaper articles quoting the express opinion of Muslims speaking in their individual capacities or reporting that such opinion is held by “a record number” of American Muslims. The board therefore concluded that the mark “Stop the Islamisation of America” is disparaging to a substantial composite of American Muslims.

The U.S. Court of Appeals for the Federal Circuit agreed, and issued an order this spring affirming the board’s refusal to register the mark.<sup>11</sup> The appellate court referred to the board’s listing of “multiple sources where Muslims stated they were concerned by ... ‘anti-Muslim sentiment that automatically associates Islam with terrorism’ ” and concluded that the board’s finding that the mark is disparaging to a substantial composite of American Muslims was supported by substantial evidence.

### Extra Scrutiny in Blackhorse

The majority ruling in Blackhorse appears consistent with these recent board decisions. The second prong of the test for disparagement under Section 2(a) of the Lanham Act may be satisfied with a rather modest evidentiary showing. In both Heeb and Geller, the board inferred the opinion of a substantial composite of the identified group by extrapolating the stated opinion of a few group representatives without seriously scrutinizing the representative capacity of those individuals or requiring a strict mathematical calculation of the number of persons on whose behalf they purportedly were speaking.

For example, the board in Heeb relied on a quote from Ken Jacobson, the associate national director of the Anti-Defamation League, that the term “Heeb” “is offensive to many Jews” without questioning the authority of the ADL or Jacobson to speak for Jews or requiring any evidence that “many Jews” is a substantial composite of the group. Similarly, the board in Geller relied on a quote from Maajid Nawaz, director of the Quilliam Foundation, a counter-extremism think tank based in the U.K., that “the majority of Muslims are not Islamists,” without requiring further evidence as to Nawaz’s authority to speak for any Muslims, much less a majority thereof.

Yet this is the type of evidentiary foundation the Blackhorse dissent appears to require as a prerequisite to finding that any statement made by the National Congress of American Indians or an NCAI representative was, in fact, the opinion of anyone other than the individual speaker, let

alone the opinion of a substantial composite of Native Americans.

Although the majority opinion details, at great length, the evidence supporting its determination that, at a minimum, the membership of the NCAI (roughly 30 percent of Native Americans) found the term “redskins” to be disparaging on the relevant dates and that such group represented a “substantial composite” of Native Americans, the dissent characterizes the majority’s analysis as mere “gyrations.”

To show that a substantial composite of Native Americans held a particular opinion in 1967, it could be argued that Judge Bergsman requires a near person-by-person poll of Native Americans living at that time: “It is astounding that the petitioners did not submit any evidence regarding the Native American population during the relevant time frame, nor did they introduce any evidence or argument as to what comprises a substantial composite of that population thereby leaving it to the majority to make the petitioners’ case have some semblance of meaning.”

There likely are several circumstances that underlie the heightened scrutiny of the evidence in Blackhorse. Undoubtedly, the inter partes nature of the proceeding was a factor. The Blackhorse petitioners were required to prove their claim by a preponderance of the evidence, while a lower standard of proof is required in ex parte cases, such as Heeb and Geller. The examining attorneys in those cases had only to put forth “substantial evidence” or “more than a scintilla of evidence” in support of their prima facie case.

In addition, the politicized and high-profile nature of the topic likely played a role. The PTO anticipated that the Blackhorse decision would bring intense scrutiny and public comment and therefore issued, simultaneously with the announcement of the decision, a list of media talking points and an “Official USPTO Statement” clarifying that the decision relates only to Pro-Football’s right to maintain its federal registrations and “does not, however, require

the trademarks in the involved registration to be changed or no longer be used by Washington, D.C.’s pro football team.”

Finally, however, the Blackhorse decision and the surrounding firestorm seem to betray the lingering existence of the concept of the “noble savage” in American culture — the romantically idealized portrayal of Native Americans that may fuel the opinion of some, including

Washington Redskins owner Dan Snyder, that the team name honors and celebrates Native Americans rather than demeans them. Of course, the opinions of the team’s owner — now and when the “Redskins” registrations were issued — are irrelevant to the legal analysis in Blackhorse. Nevertheless they seem to reflect the persistent belief of some that there remains a place in American popular culture for a term which many Native Americans consider a racial epithet.

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## Endnotes

- <sup>1</sup> Cancellation No. 92046185 (June 18, 2014).
- <sup>2</sup> 15 U.S.C. § 1052(a).
- <sup>3</sup> Cancellation No. 92021069.
- <sup>4</sup> Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999).
- <sup>5</sup> Pro-Football Inc. v. Harjo, 284 F.Supp.2d 96; 68 U.S.P.Q.2d 1225 (D.D.C. 2003).
- <sup>6</sup> Pro-Football Inc. v. Harjo, 415 F.3d 44; 75 U.S.P.Q.2d 1525 (D.C. Cir. 2005).
- <sup>7</sup> Pro-Football Inc. v. Harjo, 567 F.Supp.2d 46; 87 U.S.P.Q.2d 1891 (D.D.C. 2008).
- <sup>8</sup> Pro-Football Inc. v. Harjo, 565 F.3d 880; 90 U.S.P.Q.2d 1593 (D.C. Cir. 2009).
- <sup>9</sup> 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008).
- <sup>10</sup> Serial No. 77940879 (February 7, 2013) (not precedential).
- <sup>11</sup> In re Geller, 751 F.3d 1355; 110 U.S.P.Q.2d 1867 (C.A Fed. 2014).

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