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Sports & Entertainment Spotlight

U.S. Patent Office Cancels Washington Redskins Trademark

By Claire Hawkins on 6.23.14 | Posted in Sports, Trademark

In a 2-1 ruling last Wednesday, June 18, the Trademark Trial and Appeal Board (TTAB) of the United States Patent and Trademark Office (USPTO) resolved an opposition proceeding in favor of five Native American plaintiffs who sought to cancel six trademark registrations that contain the word REDSKINS and are owned by Pro Football, Inc., the owners of the National Football League's Washington, D.C. team.

Some of the opposed marks had been registered since 1967, and all had been cancelled in 1999, *Harjo v. Pro Football, Inc.,* 50 USPQ2d 1705 (TTAB 1999) when a similar opposition proceeding, brought by Susan Shown Harjo in 1992 was decided. In 2003, the 1999 cancellation was found to be invalid after appeals determined the plaintiffs did not have sufficient standing to oppose because of a finding of laches, an inappropriate delay in filing the opposition. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 68 USPQ2d 1225, 1263 (D.D.C. 2003).

This time, the new set of plaintiffs were able to focus the issue to whether the term "redskins" inappropriately disparages Native Americans under Sections 2(a) and 14(3) of the Trademark Act, which prohibits registration of a mark which may "disparage… persons…or bring them into contempt, or disrepute." The TTAB determined that the rule in deciding that issue is that it should look not to the American public as a whole, but to the views of a substantial composite of the referenced group. Considering the evidence presented, the TTAB found that Pro Football, Inc. had made continuous efforts to associate its football services with Native American imagery, and dismissed Pro Football, Inc.'s claim that the term "REDSKINS" has a separate meaning as the name of a football team. The TTAB also found that the disparaging aspect of the term "REDSKINS" was not ameliorated by Pro Football, Inc.'s alleged honorable intent and manner of use, and that going back to 1966, even dictionary entries indicated that the term was noted to be "often offensive."

The TTAB further found that the term was not a neutral synonym for Indian, that in 1993 the Executive Council of the National Congress of American Indians (NCAI) passed a resolution that the term "has always been and continues to be a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation," that there had been over the years numerous letters of protest from a representative cross-section of Native Americans, and that this and the other evidence provided by the plaintiffs supported

cancellation of the Pro Football, Inc. REDSKINS marks. Based on this, all six registrations at issue were cancelled.

Unlike in the 1999 *Harjo* case, the current decision thoroughly addresses the issues of laches and whether there has been any economic prejudice due to the alleged delay. Nevertheless, Wednesday's precedential ruling is likely to be appealed by Pro Football, Inc. Administrative Trademark Judge Bergsman's dissent, which presented the legal question of whether there is sufficient evidence to establish that the term "'REDSKINS' was disparaging to a substantial composite of Native Americans at the time each of the challenged registrations issued" and, in his opinion, found that there had not been a "preponderance of evidence" may preview issues that will be raised in Pro Football, Inc.'s appeal. If Pro Football, Inc. decides to appeal, the appeal will be due within two months.

Confirmation of this ruling will not mean that the NFL must change the name of its team, a name it has had since 1930. Bob Raskopf, a trademark lawyer for the team, said: "We've seen this story before. And just like last time, today's ruling will have no effect at all on the team's ownership of and right to use the Redskins name and logo." The ruling will however severely impact the NFL's ability to protect the economic interests generated through merchandising. Wednesday's ruling hinders Pro Football, Inc. in seeking the assistance of the U.S. Customs and Border Patrol when addressing counterfeit, pirated and/or infringing merchandise. On the heels of a decision with bottom line implications, whether Pro Football, Inc. continues to use the marks will be an issue to watch.

Stay tuned for more information on the effects and developments of this case. If you have any questions please contact Claire Hawkins.

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Tags: Bob Raskopf, Inc., Judge Bergsman, National Congress of American Indians, National Football League, Native American, NCAI, NFL, ProFootball, REDSKINS, Trademark registration, Trademark Trial and Appeal Board, TTAB, United States Patent and Trademark Office