

## Can Trademark Law Help Minority Groups Eliminate Negative Stereotypes?

Jeremy Elman  
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Social movements and the law do not always see eye to eye, but a group of Native American activists believe that they have found a way to make the law work to their benefit. Specifically, these activists have engaged in a 14-year struggle to cancel the trademarks of the Washington Redskins (six separate trademark registrations collectively referred to as "the Redskins trademark")<sup>1</sup>, a team in the National Football League recently valued by *Forbes* magazine as the most valuable sports franchise in the United States, at \$1.4 billion.<sup>2</sup>

The activists started with a petition to the Trademark Trial and Appeal Board in 1992, went all the way to the U.S. Court of Appeals for the D.C. Circuit in 2003, and in August 2006 brought another petition hoping to restart their campaign to eliminate negative stereotypes of Native Americans. They believe that the Redskins trademark portrays Native Americans in a negative fashion as savage and ferocious.<sup>3</sup> This is reinforced by the NFL team's use of the Redskins trademark "to strike fear into the hearts of opponents."<sup>4</sup>

While it is estimated that as many as 1500 institutions have changed their Native American nicknames and mascots since the 1970s,<sup>5</sup> the activists believe that the NFL team's steadfast refusal to change the Redskins trademark contributes to negative stereotyping. Thus, the goal of this lengthy battle is to remove the valuable protection of the Redskins trademark, valued at \$5 million per year in merchandising alone, and to pressure the NFL team to change its name.<sup>6</sup> A provision of the Lanham Act, 15 U.S.C. §1052(a), may allow the activists to win if the Redskins trademark is found to be disparaging to Native Americans.

### TTAB PROCEEDING

In 1999, seven years after the initial 1992 petition to cancel the Redskins trademark registered to the NFL team, in a case entitled *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (TTAB 1999), the activists successfully argued to the TTAB that the Redskins trademark was disparaging to Native Americans under 15 U.S.C. §1052(a). Under § 1052(a), a trademark can be cancelled if it "may be disparaging" because it brings a group into "contempt or disrepute." Disparagement, defined by the Court as "dishonor by

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<sup>1</sup> Registration Nos. 978,824; 1,085,092; 1,606,810; 836,122; 986,668; and 987,127.

<sup>2</sup> Kurt Badenhausen, Michael K. Ozanian and Maya Roney, "The Business of Football," *Forbes*, August 31, 2006.

<sup>3</sup> C. Richard King, "Defensive dialogues: Native American mascots, anti-Indianism, and educational institutions," *Studies in Media & Information Literacy Education*, University of Toronto Press, February 2002, Volume 2, Issue 1, at 8 ("mascots trap native nations within the many overlapping tropes of savagery ... [a]t one extreme are romantic renditions of bellicose warriors ... [a]t the other extreme are perverse burlesque parodies of the physical or cultural features of Indians."); see also *American Heritage Dictionary* (4th Ed. 2000) (defining redskin as "[o]ffensive slang used as a disparaging term for a Native American").

<sup>4</sup> *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (TTAB 1999), paginated at 1999 TTAB LEXIS 181, \*88 (petitioner's expert testified that "'redskin(s)' conveys a savage, ferocious impression and this original association is relied upon for its efficacy as the name of the football team").

<sup>5</sup> King, "Defensive dialogues: Native American mascots, anti-Indianism, and educational institutions," at 12.

<sup>6</sup> Carol D. Leonnig, "Judge Nears Ruling in Redskins Name Fight," *Washington Post*, July 24, 2003 (quoting the NFL team's attorneys as claiming that "cancellation of the trademark registration could cost the club an unknown amount of money if it has to legally battle every entrepreneur who wants to print a Redskins T-shirt").

comparison with what is inferior,"<sup>7</sup> must be proved by a preponderance of evidence.<sup>8</sup> The TTAB cancelled the Redskins trademark using a combination of "cumulative evidence" to find that the Redskins trademark may be disparaging, including: (1) the testimony of the activists; (2) historical evidence showing the term to be disparaging (linguistics analysis, dictionary meanings and historical data); and (3) a survey finding that 36 percent of Native Americans and 46 percent of the U.S. population found the word "Redskin" offensive.<sup>9</sup>

## **NFL TEAM'S APPEAL TO DISTRICT COURT**

The NFL team appealed to the District Court for the District of Columbia in *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003). Their motion for summary judgment was granted in 2003, reversing the TTAB's cancellation. The district court held that the TTAB's factual findings were not supported by substantial evidence because: (1) there was no direct evidence of intentional disparagement by the football team; (2) the historical evidence that was relied upon was simply the TTAB's observations as to the conflicting evidence presented by both parties; and (3) the evidence, especially the survey, was flawed because it did not consider how a substantial composite of Native Americans viewed the word "Redskins," but merely assumed how Native Americans should feel.<sup>10</sup>

The district court also held that the activists were barred by the doctrine of laches, which prevents a party from waiting an unreasonable amount of time to file suit to vindicate its rights.<sup>11</sup> The court found that all but one of the petitioners could have brought suit in 1967 or shortly thereafter when the first Redskins trademark was originally filed, and thus their 1992 petition was barred.<sup>12</sup>

## **ACTIVISTS' APPEAL TO THE COURT OF APPEALS**

The activists appealed to the D.C. Circuit in *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005). The circuit court affirmed the district court, but limited its analysis to the laches issue. The D.C. Circuit ruled that the activists had "slumber[ed] on their rights" since 1967 and were therefore barred from prevailing under the doctrine of laches.<sup>13</sup> However, since minors cannot be barred by laches because they have not reached an age at which they can file suit, the circuit court remanded the case back to the district court because one of the petitioners was a minor in 1967. That case is still pending.

A new group of young Native American activists filed a cancellation proceeding with the TTAB on August 11, 2006.<sup>14</sup> The young activists are all within the ages of 18 through 24, and are able to avoid the laches bar faced by the original *Harjo* petitioners because they could not have brought this case until recently due to their age. The young activists believe avoiding the laches bar will enable them to win the case on the merits.<sup>15</sup>

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<sup>7</sup> *Harjo*, 1999 TTAB LEXIS 181, at \*113-\*114.

<sup>8</sup> *Id.* at \*105.

<sup>9</sup> *Id.* at \*136-\*153.

<sup>10</sup> *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 128 (D.D.C. 2003) ("the TTAB's approach is flawed because ... the inferences are predicated on assumptions that are not contained anywhere in the record.")

<sup>11</sup> *Id.* at 136 ("[t]he best time to resolve this case was 1967 or shortly thereafter.")

<sup>12</sup> *Id.* at 139 ("[d]efendants waited over twenty-five years to bring this case.")

<sup>13</sup> *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 47-48 (D.C. Cir. 2005).

<sup>14</sup> Petition for Cancellation filed with TTAB by Amanda Blackhorse, Marcus Briggs, Philip Gover, Shquanebin Lone-Bentley, Jillian Pappan and Courtney Tsothigh, dated August 11, 2006.

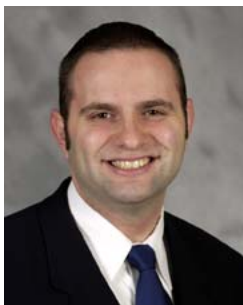
<sup>15</sup> "Native Americans Renew Demand for U.S. Patent Office to Cancel Derogatory 'Redskins' Trademark", *PR Newswire*, August 11, 2006 (quoting Philip Mause, counsel for the new petitioners, that "these new petitioners make it much more likely that this matter will ultimately be resolved on the merits, rather than on the basis of laches").

## ANALYSIS

The young activists are playing an essentially unwinnable game if the court follows the *Harjo* decisions, however. Since the circuit court did not rule on the merits, the district court's decision denying the original petition is precedent. Following that precedent, the young activists must not only demonstrate that Native Americans feel disparaged by the Redskins trademark, but also show that the NFL team intends to disparage Native Americans. The district court essentially reads an intent requirement into §1052(a) by stating that the Redskins trademark did not disparage because the NFL team has increasingly used it in a "respectful manner."<sup>16</sup> Examples of the NFL team's "respectful manner" include changing the lyrics to its theme song "Hail to the Redskins" and a policy mandating a "tasteful" portrayal of Native Americans with licensees such as McDonald's.<sup>17</sup> The young activists are therefore unlikely to successfully demonstrate that the NFL team actually intended to disparage.

However, the young activists can argue that §1052(a) has no intent requirement.<sup>18</sup> The young activists can argue that case law states the test for §1052(a) as whether a substantial composite of the relevant population considers the mark to be disparaging, not whether the trademark holder intends to disparage.<sup>19</sup> If the young activists can create a survey which shows that a substantial composite of Native Americans considers the mark to be disparaging when used in connection with the NFL team, then the young activists may prevail with their new cancellation proceeding. The original TTAB decision stated that such a survey would be extremely relevant to show disparagement.<sup>20</sup> This survey would need to be representative, unbiased and unimpeachable, which will be difficult but not impossible. Given the strong sentiment in the Native American community in support of this cause (and survey findings that 36 percent of Native Americans found the word "Redskin" offensive), this may well occur.

The answer to the question posed at the beginning of this article is still up for debate. The young activists' new petition will likely succeed at some point -- once a court overturns the *Harjo* court's incorrect reading of §1052(a), and an appropriate survey of a substantial composite of Native Americans can be fashioned in a way that demonstrates disparagement. While the young activists face a steep climb given both the difficulty in assembling this survey evidence and the long history of this case, there are no signs this struggle will end any time soon. If nothing else, this groundbreaking litigation will encourage minority groups to consider trademark cancellation proceedings as a tool for social movements to eliminate negative stereotypes.



*Jeremy T. Elman is an associate in the Miami office of McDermott Will & Emery. He is a member of the Intellectual Property, Media & Technology Department where his practice focuses on intellectual property disputes and complex commercial litigation.*

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<sup>16</sup> *Pro-Football*, 284 F. Supp. at 134.

<sup>17</sup> *Harjo*, 1999 TTAB LEXIS 181, at \*75-\*76.

<sup>18</sup> 15 U.S.C. §1052(a) ("no trademark ... shall be refused registration ... unless it ... consists of ... matter which may disparage.").

<sup>19</sup> *Ritchie v. Simpson*, 170 F.3d 1092, 1094 (Fed. Cir. 1999) (Section 1052(a) looks to a substantial composite of persons of the relevant viewpoint to determine whether a mark violates that section); *In Re Hines*, 31 U.S.P.Q.2d 1685, 1688 (TTAB 1994) ("we focus our Section 2(a) analysis on the perceptions of the followers of Buddha.")

<sup>20</sup> *Harjo*, 1999 TTAB LEXIS 181, at \*103 ("a survey that considered participants' views of the word 'redskin(s)' as used by respondent, the media and fans in connection with respondent's football team would have been extremely relevant.").