

OFFENSIVE LINEMEN:
HOW PRO FOOTBALL, INC.'S
RESPONSES TO THE CANCELLATION OF
THE REDSKINS REGISTRATIONS
SHOULD BE INCORPORATED INTO THE
USPTO'S FUTURE ANALYSES OF
DISPARAGING TRADEMARKS[♦]

INTRODUCTION	499
I. THE <i>BLACKHORSE</i> DECISION.....	502
A. <i>The Harjo Petitioners</i>	502
B. <i>The TTAB's Ruling</i>	503
1. Linguistic Evidence.....	505
2. Views of the Substantial Composite	506
C. <i>The Dissent</i>	508
II. PFI'S APPEAL.....	510
III. REFINING THE STANDARDS	515
CONCLUSION.....	523

INTRODUCTION

Baseball may be the national pastime, but professional football is America's religion. Millions of Americans regularly watch NFL games and cheer for their favorite teams as they head toward the end zone.¹ Naturally, the focus is on the teams' scores rather than their names. One notable exception, however, is the Washington Redskins. Team owner Dan Snyder and NFL Commissioner Roger Goodell face intense pressure to change the team's name due to its disparaging nature

[♦] Permission is hereby granted for noncommercial reproduction of this Note in whole or in part for education or research purposes, including the making of multiple copies for classroom use, subject only to the condition that the name of the author, a complete citation, and this copyright notice and grant of permission be included in all copies.

¹ See Press Release, Sarah Bibel, *NFL 2013 TV Recap: 205 Million Fans Tuned In; 34 of 35 Most Watched Shows This Fall* (Jan. 8, 2014), <http://tvbythenumbers.zap2it.com/2014/01/08/nfl-2013-tv-recap-205-million-fans-tuned-in-34-of-35-most-watched-shows-this-fall/227726/> (indicating high NFL viewership statistics); see also Michael David Smith, *34 of America's 35 Most Watched Fall TV Shows were NFL Games*, NBC SPORTS PRO FOOTBALL TALK (Jan. 8, 2014, 3:52 PM), <http://profootballtalk.nbcsports.com/2014/01/08/34-of-americas-35-most-watched-fall-tv-shows-were-nfl-games/> (reporting that the Super Bowl is the most watched show on television every year).

towards Native Americans.² This pressure came to a head on June 18, 2014, when the Trademark Trial and Appeal Board (“TTAB”)³ granted a petition to cancel several disparaging registrations⁴ owned by Pro-Football, Inc. (“PFI”), owner of the Washington Redskins.⁵ Filed by Navajo Amanda Blackhorse and four other Native Americans, the petition sought to cancel six trademarks registered between 1967 and 1990 that included the term “redskin.”⁶ Two of the marks included an image of a Native American,⁷ and all were used in connection with entertainment services pertaining to professional football.⁸

The TTAB granted the petition after conducting the United States Patent and Trademark Office’s (“USPTO”) two-part disparagement analysis.⁹ First, the TTAB considered the likely meaning of the term “redskin,” evaluating it in relation to the other elements of the marks.¹⁰ As part of this first prong, the TTAB also considered the goods and services for which the marks were registered, and the ways in which consumers use the marks in relation to those goods and services.¹¹ The TTAB then employed the second part of the test by using cultural and linguistic evidence to evaluate whether the likely meaning of the term would be disparaging to a substantial composite of the referenced group (i.e., Native Americans).¹² After completing both prongs of the analysis, the TTAB concluded that all six registrations disparaged Native Americans at the time of registration and therefore violated the Lanham Act.¹³ On this basis, the TTAB granted the petition to cancel.¹⁴

² Christine Haight Farley, *Whether to Challenge or Protect Offensive Trademarks*, AL JAZEERA (Mar. 24, 2013, 2:50 PM), <http://www.aljazeera.com/indepth/opinion/2013/03/2013324115535268.html>; see also Igor Bobic, ‘Racial Slur’: 50 Senators Urge NFL To Change Washington Redskins’ Name, THE HUFFINGTON POST (May 22, 2014, 9:33 AM), http://www.huffingtonpost.com/2014/05/22/washington-redskins-senators_n_5371908.html.

³ The TTAB is an administrative board within the United States Patent and Trademark Office (“USPTO”) that functions as a specialized trademarks court. It is the body to which one appeals if his application for registration has been repeatedly refused by the USPTO.

⁴ *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014).

⁵ *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 46 (D.C. Cir. 2005). PFI is the owner of the Washington Redskins.

⁶ *Petition for Cancellation, Blackhorse v. Pro-Football, Inc.* (T.T.A.B. 2006) [hereinafter *Petition for Cancellation*].

⁷ *Blackhorse*, 111 U.S.P.Q.2d at 1083.

⁸ *Id.*

⁹ TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.03(b)(i) (2015), http://tmep.uspto.gov/RDMS/detail/manual/TMEP/current/d1e2.xml#/result/RDMS/detail/manual/TMEP/current/ch1200_d1ff5f_1203_03bi.xml?q=disparaging&start=1&ccb=on&ncb=off&icb=off&fcb=off&ver=Apr2014&sort=relevance&syn=adj&cnt=10&results=compact&index=2#highlight.

¹⁰ *Blackhorse*, 111 U.S.P.Q.2d at 1088-89.

¹¹ *Id.* at 1089.

¹² *Id.* at 1091-1110.

¹³ *Id.* at 1111-12. The Lanham Act “is the governing trademark statute in the United States and provides guidelines for registration of trademarks, causes of action for misuse, and civil remedies for infringement.” Alexis Weissberger, *Is Fame Alone Sufficient To Create Priority Rights: An International Perspective On The Viability of the Famous/Well-Known Marks Doctrine*, 24

Within two months PFI appealed the cancellation by bringing a civil action in the United States District Court for the Eastern District of Virginia.¹⁵ In its complaint, PFI advanced several arguments as to why the registrations were not disparaging.¹⁶ In so doing, PFI went well beyond the USPTO's two-prong framework. First, it repeatedly applied the standards used to determine whether a trademark is *offensive*, rather than disparaging; it considered not how a substantial composite of the referenced group would view the marks, but rather, how a substantial composite of the *general public* would view them.¹⁷ In addition, PFI analyzed the likely meaning of the marks when used in connection with goods not included in the registrations, even though the disparagement analysis encompasses only the applied-for goods and services.¹⁸ PFI also analyzed the term's meaning according to contemporary standards, rather than those in place at the registration dates.¹⁹

This Note explores the TTAB's 2014 cancellation decision, PFI's appeal, and the ways in which that response digressed from the USPTO's disparagement framework. This Note will show that, although PFI's analysis did not follow USPTO standards, PFI made valid points that reveal the flaws in those standards. These flaws demand that the USPTO incorporate PFI's standards into its future analyses. In so doing, the USPTO will create a new framework that can benefit trademark applicants and minority groups. When put on notice that the general public *currently* takes offense to a mark in connection with *any* goods or services, trademark applicants will refrain from wasting money on applications destined for rejection on disparagement grounds.

They will also refrain from wasting money spent in connection with the manufacture and sale of those goods and services, practices sanctioned by common law trademark rights. Knowing of the widespread animosity towards the mark, applicants would refrain from manufacturing the goods or offering the services altogether, thus never wasting money on a product or service they will have to pull out of the market. Minority groups thus enjoy protection as well; if the

CARDOZO ARTS & ENT. L.J. 739, 749 (2006).

¹⁴ *Blackhorse*, 111 U.S.P.Q.2d at 1111-12.

¹⁵ Complaint, *Pro-Football, Inc. v. Blackhorse*, 62 F. Supp. 3d 498 (E.D. Va. 2014) (No. 1:14-cv-01043-GBL-IDD) [hereinafter *Pro-Football Appeal*]. When appealing a T.T.A.B. decision, a party may either appeal to the United States Court of Appeals for the Federal Circuit, per 15 U.S.C. §1071(a) (2011), or it may bring a civil action in district court, per 15 U.S.C. §1071(b) (2011). PFI opted for the latter.

¹⁶ *Pro-Football Appeal*, *supra* note 15, at ¶¶ 58-71; ¶¶ 73-105.

¹⁷ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9. The disparagement analysis is concerned only with the views of the referenced group, not the general public.

¹⁸ *Id.* The disparagement analysis does not encompass use in relation to classes of goods and/or services not included in the trademark application.

¹⁹ *Id.* The disparagement analysis focuses on whether the mark would be disparaging to a substantial composite of the referenced group at the time of registration, and should not consider whether they have shed their disparaging meanings over time.

disparaging marks never enter the market, no one, much less the minority groups, will ever encounter those marks.

Part I of this Note will discuss the *Blackhorse* decision, including the *Harjo* decisions leading to it. Part II will discuss PFI's appeal, exploring the flaws in PFI's arguments and the ways in which they exceeded the scope of the USPTO's disparagement test. Part III will discuss the validity of those digressions, and how they can and should be incorporated into the TTAB's future evaluations of disparaging trademarks, given today's social climate.

I. THE *BLACKHORSE* DECISION

A. *The Harjo Petitioners*

The 2-1 decision in *Blackhorse v. PFI, Inc.* marked the turning point in a decades-long legal battle.²⁰ In 1992 Suzan Harjo and six other Native Americans petitioned to cancel the six marks at issue in *Blackhorse* on the grounds that they disparaged Native Americans at the time of registration, therefore violating federal law.²¹ In 1999 the TTAB found that "a preponderance of the evidence showed the term 'redskin' as used by Washington's football team had disparaged Native Americans from at least 1967 onward."²² However, PFI successfully appealed to the U.S. District Court for the District of Columbia ("District Court") in 2003.²³ The court granted PFI's motion for summary judgment on the grounds that laches barred the petition²⁴ and that petitioners had presented insufficient evidence of disparagement.²⁵ When petitioners appealed to the United States Court of Appeals for the District of Columbia Circuit ("D.C. Circuit") in 2005, that court held

²⁰ *Blackhorse*, 111 U.S.P.Q.2d at 1080.

²¹ *Harjo v. Pro Football Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999). Under 15 U.S.C.A. § 1052(a), a trademark will be barred from registration if it "consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute . . ." 15 U.S.C.A. § 1052(a) (West 2006).

²² *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 47 (D.C. Cir. 2005). Evidence included "dictionary entries for 'redskin' . . . book and media excerpts from the late nineteenth century through the 1940s that used the term 'redskin' and portrayed Native Americans in a pejorative manner . . . [and] results from a 1996 survey of the general population and Native Americans that asked whether various terms, including 'redskin,' were offensive . . ." *Id.*

²³ *Pro-Football Inc. v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003).

²⁴ *Id.* "Laches" is defined as "[a] doctrine in equity that those who delay too long in asserting an equitable right will not be entitled to bring an action." *Laches*, LEGAL INFO. INST., CORNELL U. L. SCH., <http://www.law.cornell.edu/wex/laches>. As stated in *Harjo*, the doctrine "is founded on the notion that equity aids the vigilant and not those who slumber on their rights." *Harjo*, 415 F.3d at 47 (quoting *NAACP v. NAACP Legal Def. & Educ. Fund, Inc.*, 753 F.2d 131, 137 (D.C. Cir.1985)). In order to assert the defense of laches, a party must prove: "(1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense." *Id.* (quoting *Nat'l R.R. Passenger Corp. v. Morgan*, 536 U.S. 101, 121–22 (2002)).

²⁵ *Harjo*, 284 F. Supp. 2d at 145.

that the District Court had improperly evaluated the laches claim with respect to the youngest petitioner²⁶ and remanded to the District Court to determine whether laches, in fact, barred his claim.²⁷ In 2008 the District Court held that it did.²⁸ The following year the D.C. Circuit affirmed,²⁹ never addressing the evidence of disparagement.³⁰ When the *Harjo* plaintiffs petitioned the Supreme Court for a writ of certiorari later that year, they were denied.³¹

Thus marked the end of the *Harjo* case, allowing the *Blackhorse* petitioners to resume their crusade against the Redskins.³² Although they had already attempted to cancel the registrations in 2006,³³ the TTAB had suspended the proceedings until the resolution of the *Harjo* case.³⁴ When the proceedings resumed in 2010, the *Blackhorse* petitioners did not face the same barriers as their *Harjo* predecessors. First and foremost, they did not fall prey to PFI's laches defense; because the new petitioners would have been too young to bring suit, they could not be accused of unreasonable delay.³⁵ The *Blackhorse* petitioners, all Native Americans,³⁶ "laid out two categories of evidence to prove that the term REDSKINS, even when considered solely as used with football and cheerleading services, was disparaging during the relevant time periods: (1) a general analysis of the word; and (2) the specific views of the referenced group."³⁷

B. The TTAB's Ruling

The TTAB had extensive work to do in evaluating the petition; because the D.C. Circuit decided *PFI, Inc. v. Harjo*³⁸ on the laches issue,³⁹ the court did not evaluate the TTAB's earlier holding in *Harjo v. PFI, Inc.*⁴⁰ that the Redskins' registrations disparaged Native Americans.⁴¹ For the TTAB's consideration, the *Blackhorse* petitioners

²⁶ *Harjo*, 415 F.3d at 48.

²⁷ *Pro-Football Inc. v. Harjo*, 567 F. Supp. 2d 46 (D.D.C. 2008).

²⁸ *Id.* at 54.

²⁹ *Pro-Football Inc. v. Harjo*, 565 F.3d 880, 886 (D.C. Cir. 2009).

³⁰ *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014).

³¹ Petition for Writ of Certiorari, *Harjo*, 565 F.3d 880 (No. 09-326), cert. denied, 558 U.S. 1025 (2009).

³² *Pro-Football Appeal*, *supra* note 15, at ¶ 26–27.

³³ *Petition for Cancellation*, *supra* note 6.

³⁴ *Blackhorse*, 111 U.S.P.Q.2d at 1084.

³⁵ Aryane Garansi, *Offensive Trademarks: When Should a Different Trademark Be Used?*, AM. BAR ASS'N, <http://lsag-aba-ipl.tumblr.com/post/85081946740/offensive-trademarks-when-should-a-different-trademark> (last visited Apr. 16, 2016).

³⁶ See *Blackhorse*, 111 U.S.P.Q.2d at 1082.

³⁷ *Id.* at 1091.

³⁸ *Pro-Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009).

³⁹ See *Blackhorse*, 111 U.S.P.Q.2d at 1114 (discussing the laches defense as applied in *Pro-Football, Inc. v. Harjo*, 565 F.3d 880 (D.C. Cir. 2009)).

⁴⁰ *Harjo v. Pro Football Inc.*, 50 U.S.P.Q.2d 1705, 1743 (T.T.A.B. 1999).

⁴¹ See *Blackhorse*, 111 U.S.P.Q.2d at 1084.

presented evidence that included most of the *Harjo* record, the petitioners' depositions and exhibits, and the respondent's registration files.⁴² The *Harjo* record contained multiple print sources such as newspaper articles, letters, and resolutions.⁴³ The TTAB evaluated the evidence according to the two-prong USPTO disparagement test.⁴⁴ They first considered "the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the goods and services identified in the registrations," and then whether that meaning could be construed as disparaging to Native Americans as of the registration dates.⁴⁵ The TTAB thus employed forty-year-old standards in its analysis, ultimately answering both prongs in the affirmative.⁴⁶

In considering the first prong, the TTAB easily established that "[t]he term REDSKINS in the registered marks when used in connection with professional football retains the meaning Native Americans."⁴⁷ Perhaps the most convincing evidence is the fact that several of the registrations use Native American imagery.⁴⁸ In particular, the TTAB considered numerous images, taken over many years, of players' helmets bearing the conspicuous team logo of a Native American chief.⁴⁹ The TTAB also cited a 1980s photograph of the team's marching band wearing Indian headdresses, pointing out that these headdresses comprised part of their uniforms from 1960s until the 1990s.⁵⁰ Similarly, the TTAB cited a 1962 photograph of the team's cheerleaders, the Redskinettes, which shows the cheerleaders in Native American-style uniforms.⁵¹ Lastly, the TTAB considered team press guides issued during the 1960s and 1970s. The guides' covers show Native American images, such as a teepee.⁵² In light of the evidence, the TTAB concluded that the "[r]espondent has made continuous efforts to associate its football services with Native American imagery."⁵³

Having established this fact, the TTAB proceeded to the second prong of analysis: whether the marks could be construed as disparaging at the time of registration.⁵⁴ When evaluating disparagement, the TTAB considers only the views of the referenced group, not those of the entire

⁴² *Id.* at 1085.

⁴³ *Id.* at 1086.

⁴⁴ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9.

⁴⁵ See *Blackhorse*, 111 U.S.P.Q.2d at 1088–89.

⁴⁶ *Id.* at 1110.

⁴⁷ *Id.* at 1089.

⁴⁸ *Id.* at 1088–89.

⁴⁹ *Id.* at 1088.

⁵⁰ *Id.*

⁵¹ See *Blackhorse*, 111 U.S.P.Q.2d at 1088.

⁵² *Id.* at 1089.

⁵³ *Id.*

⁵⁴ *Id.*

American public.⁵⁵ These views are “reasonably determined by the views of a substantial composite thereof.”⁵⁶ Within the context of the disparagement analysis, a “substantial composite” is not necessarily synonymous with a “majority.”⁵⁷ The TTAB determines what the substantial composite is at trial, considering primarily “the views of the entire referenced group who may *encounter* [respondent’s services] in any ordinary course of trade for the identified goods and services.”⁵⁸ Whether or not the applicant *intends* for the mark to be offensive is irrelevant as to the second prong.⁵⁹ Having established that the term “redskin” refers to Native Americans in any context,⁶⁰ the TTAB evaluated two types of evidence presented by the petitioners to determine whether the term was disparaging during the period of registration (1967–1990): evidence regarding the general meaning of the word “redskin,” and evidence indicating the sentiments of the substantial composite toward the term.⁶¹

1. Linguistic Evidence

To evaluate the meaning of the term “redskin,” the TTAB reviewed the reports and testimony of linguistic and lexicographical experts, examining research on “the derivation of the word redskin(s), dictionary usage labels and usage of the term ‘redskin(s)’ over the years in various media.”⁶² With respect to the derivation of “redskin,” respondents’ experts confirmed that the term refers to Native Americans and, more specifically, to their skin color.⁶³ The TTAB rejected respondents’ argument that the term had acquired secondary meaning⁶⁴ with respect to sports.⁶⁵

⁵⁵ *Id.* at 1085 (“[W]e look not to the American public as a whole, but to the views of the referenced group (*i.e.*, Native Americans).”).

⁵⁶ See *Blackhorse*, 111 U.S.P.Q.2d at 1085 (quoting *Pro-Football, Inc. v. Harjo*, 68 U.S.P.Q.2d 1225, 1247 (D.D.C. 2003)).

⁵⁷ See *Blackhorse*, 111 U.S.P.Q.2d at 1085 (citing *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 1074 (T.T.A.B. 2008)).

⁵⁸ *Id.* (quoting *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 1075 (T.T.A.B. 2008)).

⁵⁹ *Id.* at 1091.

⁶⁰ *Id.* at 1096–97.

⁶¹ *Id.* at 1091.

⁶² *Id.* at 1092. Petitioners called Dr. Geoffrey Nunberg, a linguistics expert “specializing in lexical semantics.” *Id.* Respondent called Dr. Ronald R. Butters, also a linguistics expert, who was tasked with researching the ways in which the meaning of the term “redskin” has changed over time. Respondent also called David K. Barnhart, a lexicographical expert, to explore the contemporary meaning of the term “redskins,” particularly as it relates to sports.

⁶³ See *Blackhorse*, 111 U.S.P.Q.2d at 1092.

⁶⁴ A term acquires secondary meaning when it is used in connection with products or services to such an extent that the term takes on a new meaning as a source indicator of those products and services. See Lee B. Burgunder, *Opportunistic Trademarking Of Slogans: It’s a Clown Issue, Bro*, 31 CARDOZO ARTS & ENT. L.J. 769, 777 (2013).

⁶⁵ See *Blackhorse*, 111 U.S.P.Q.2d at 1092 n.50 (The court noted that “[b]ecause REDSKINS used in connection with respondent’s services while meaning a football team, retains its ‘core meaning’ identifying a ‘race of people,’ the meanings are not legally separate for the purposes of

The TTAB then examined several dictionary definitions of the term “redskin,” published between 1967 and 1990, focusing on their restrictive usage labels.⁶⁶ The TTAB found that “[b]eginning in 1966 and continuing to 1990, usage labels in dictionaries indicating the term REDSKIN to be offensive, disparaging, contemptuous or not preferred, first appear and then grow in number.”⁶⁷ The TTAB concluded that the appearance of the usage labels, coupled with the decrease in the use of the term itself, revealed a growing recognition that “redskin” was disparaging as of the marks’ respective registration dates.⁶⁸

Finally, the TTAB examined the use of the term “redskin” in various media outlets, noting that between the mid-1960s and the mid-1990s, it had largely disappeared in both written and spoken references to Native Americans.⁶⁹ Both petitioners’ and respondents’ experts searched electronic databases for uses of the term in documents such as newspapers and magazines during the relevant time period.⁷⁰ In all instances, the term “redskin” was rarely used in reference to Native Americans; it was used mostly in reference to the football team.⁷¹ The TTAB interpreted the dramatic decrease in use with respect to Native Americans as evidence that it had become a disparaging term during the period in question.⁷²

2. Views of the Substantial Composite

To measure the views of a substantial composite of Native Americans, the TTAB examined, among other things, a resolution passed by the Executive Council of the National Congress of American Indians (“NCAI”),⁷³ which is described as the “oldest, largest, and most representative American Indian and Alaska Native organization serving the broad interests of tribal governments and communities.”⁷⁴ In 1993 it passed a resolution entitled “Resolution in Support of the Petition for Cancellation of the Registered Services Marks of the Washington Redskins AKA Pro-Football Inc.”⁷⁵ In it, the NCAI maintained that the term “redskin” had always been a disrespectful one, describing it as

determining disparagement under Section 2(a).”).

⁶⁶ See *id.* at 1093. While some of the dictionary references contain no caveats whatsoever, others bear such labels as “often offensive,” “often disparaging and offensive,” and “contemptuous.” *Id.*

⁶⁷ *Id.* at 1106.

⁶⁸ *Id.* at 1111.

⁶⁹ *Id.*

⁷⁰ See *Id.* at 1097.

⁷¹ See *Blackhorse*, 111 U.S.P.Q.2d at 1119.

⁷² See *Id.* at 1097. Regarding Dr. Nunberg’s findings, the TTAB noted, “[m]ore significant than the relatively small number of uses as a reference to Native Americans, and many of those in the context of racial slurs, is the relative absence of use of the term to describe a person.” *Id.*

⁷³ *Id.* at 1098–99.

⁷⁴ NAT’L CONG. OF AM. INDIANS, <http://www.ncai.org/about-ncai> (last visited Apr. 1, 2016).

⁷⁵ See *Blackhorse*, 111 U.S.P.Q.2d at 1098.

pejorative, denigrating and disparaging.⁷⁶ NCAI extended this description to PFI's registered trademarks.⁷⁷ The TTAB rejected respondent's argument that the resolution was irrelevant on the grounds that it was made after the 1967–1990 time period, noting that this did not necessarily indicate that Native Americans did not hold this opinion during that time period.⁷⁸ The TTAB added:

We find that a resolution passed by an organization such as NCAI, which throughout the relevant time period represented approximately thirty percent of Native Americans, setting forth the past and ongoing viewpoint of the Native Americans it represents is clearly probative of the views of Native Americans held at the referenced time period.⁷⁹

Overall, the TTAB concluded that the resolution adequately represented the views of the substantial composite.⁸⁰ In addition to the fact that NCAI represented 30% of the relevant population, the TTAB found compelling the fact that NCAI's member tribes could be found throughout the country.⁸¹ Because the tribes articulated their collective views through such resolutions, the TTAB found the resolution to be a reliable gauge of Native American opinion.⁸²

In addition to the NCAI resolution, petitioners submitted letters protesting respondent's use of the term "redskin" and demanding that the football team change its name.⁸³ Included in the record were nearly twenty letters from Native Americans residing in various states across the country, as well as those from several Indian organizations and one tribe.⁸⁴ In its formal decision, the TTAB presented a compelling "representative sample of excerpts" that effectively communicated the

⁷⁶ *Id.*

⁷⁷ *Id.* ("[T]he use of the registered service marks . . . by the Washington Redskins football organization, has always been and continues to be offensive, disparaging, scandalous, and damaging to Native Americans.").

⁷⁸ *Id.* at 1098–99. *See also Blackhorse*, 2014 WL 2757516, at *44–46, the Deposition of Harold Gross, former Director of Indian Legal Information Development Service (a legislative oversight committee consisting of Native Americans). In 1972, the committee commenced efforts to change the name of the Washington Redskins when it sent a letter to, and then met with, Edward Bennett Williams, then president and part-owner of the team [hereinafter "the 1972 meeting"]. Gross testified that Leon Cook, then president of NCAI (which at that time "represented approximately 30 percent of Native Americans"), attended the meeting. The T.T.A.B. interpreted Cook's attendance as clear evidence that "NCAI's opposition to use of the word 'redskins' with respondent's services existed as early as 1972, well in advance of the 93-11 resolution and during the relevant time period."

⁷⁹ *Id.* at 1099.

⁸⁰ *Id.* at 1110.

⁸¹ *See Blackhorse*, 111 U.S.P.Q.2d at 1110.

⁸² *Id.*

⁸³ *Id.* at 1102–04.

⁸⁴ *Id.* at 1102.

writers' disdain for the team name.⁸⁵ The TTAB pointed out that even though nearly every letter had been written at the end of or after the registration period, they nonetheless represented nationwide Native American opinions, and thus further demonstrated the degree to which the resolution represented a substantial composite.⁸⁶

Based on the above evidence, two of the three TTAB judges ruled that petitioners demonstrated "by a preponderance of the evidence that a substantial composite of Native Americans found the term REDSKINS to be disparaging in connection with respondent's services during the relevant time frame of 1967–1990."⁸⁷

C. *The Dissent*

In his dissent, Administrative Trademark Judge Mark Bergsman took issue with the linguistic evidence, as well as the evidence regarding the substantial composite of the Native American community.⁸⁸ With respect to the linguistic evidence, Bergsman noted that the experts on the record "specifically researched the Native American viewpoint of the word 'redskin(s)' in connection with football-related services during any time period."⁸⁹ Bergsman cited several examples of Native Americans' use of the term "redskin" in connection with their own sports teams.⁹⁰ Regarding such team names, Bergsman wrote:

We can imply from the use of "Redskins" by Native Americans in connection with the name of sports teams that the context in which "Redskins" is used changes the perception of the term. Thus, for example, when a dictionary usage label says "often offensive," the usage label would not encompass use of the term "Redskins" in connection with a team name because that would not be offensive to Native Americans who identify their teams with the name "Redskins."⁹¹

Bergsman also referenced numerous Native American teams that

⁸⁵ *Id.* at 1103. One letter commented, "I would suggest a change in name. In sticking to your ethnic theme, I would suggest the Washington Niggers as a start," while another stated, "I feel you've gotten off lightly with the concerns for this issue because the Indian population is not as large or vocal as the other minorities of this country. Because we are not highly visible that does not mean you can count us out of the human race." *Id.*

⁸⁶ *Id.* at 1104.

⁸⁷ See *Blackhorse*, 111 U.S.P.Q.2d at 1111.

⁸⁸ *Id.* at 1115–21 (Bergsman, J., dissenting).

⁸⁹ *Id.* at 1115.

⁹⁰ *Id.* at 1116. One such example is the Lady Redskins, a Florida basketball team. Bergsman noted, "[t]o the extent that post-1990 evidence has any relevance, it shows that Native Americans using the term 'Redskins' in a prideful way to identify their teams." *Id.*

⁹¹ *Id.* at 1116.

do not use the term “redskin” specifically, but employ other Native American terms and imagery.⁹² Based on their continuing usage of such imagery and the lack of evidence to the contrary, Bergsman noted a dissonance between the linguistic evidence and the evidence regarding Native Americans’ use of “redskin” in connection with their own sports teams.⁹³

Regarding dictionary usage labels, Bergsman pointed out that when five of the six marks were registered, only two dictionaries classified the term “redskin” as “often offensive.”⁹⁴ Bergsman argued that, contrary to what the majority holds, two dictionaries hardly show a “clear trend” of labeling the term “redskin” as offensive, and the description “often offensive” suggests that the term may not be offensive in the context of football.⁹⁵ Bergsman reached a similar conclusion regarding the various media references to redskins.⁹⁶ Reiterating the high usage of the term “redskin” in connection with sports, as well as one of the expert’s conclusions that these results indicated the acceptability of use of the term in connection with sports teams, Bergsman concluded that the record did not support the majority’s finding that its decrease in usage results directly from its disparaging nature.⁹⁷

Finally, Bergsman took issue with both the NCAI resolution and Harold Gross’s deposition regarding Leon Cook’s testimony at the 1972 meeting, pointing out what he felt were weaknesses regarding NCAI’s membership statistics.⁹⁸ With respect to the resolution, he indicated the lack of conclusive evidence regarding the number of people who attended the meeting, their tribal make up, and whether they were members during the relevant timeframe.⁹⁹ Regarding Gross’s testimony, Bergsman indicated that Leon Cook did not personally testify as to the

⁹² See *id.* at 1117. Examples include the Flandreau Indian School’s use of an Indian head logo in connection with their “Lady Indians” and “Mighty Braves” athletic teams, as well as the Round Rock Public School’s “Fighting Braves” team that also uses an Indian logo.

⁹³ See *Blackhorse*, 111 U.S.P.Q.2d at 1117.

⁹⁴ *Id.* (Bergsman, J., dissenting).

⁹⁵ *Id.* at 1118–19 (“The dictionary evidence is not sufficiently probative to justify cancelling respondent’s registrations when, as noted by the majority, any cancellation of a registration should be granted only with due caution and after a most careful study of all the facts.”) (citations omitted).

⁹⁶ *Id.* at 1119.

⁹⁷ *Id.*

⁹⁸ *Id.* at 1119–20.

⁹⁹ See *Blackhorse*, 111 U.S.P.Q.2d at 1119–20 (Bergsman, J., dissenting). Bergsman notes that JoAnn Chase, who became NCAI’s Executive Director in 1994 and testified about the 1993 resolution, was not a reliable source; she was not present at the meeting and, “that she did not know if any minutes of the meeting were taken . . . had no record of the number of tribes who had delegates to the organization [during the relevant time period] . . . [and] had no letters or correspondence concerning the use of the word ‘redskins’ or ‘Washington Redskins’ with respect to the football team between 1967 and 1992.” *Id.* at 1119.

NCAI membership at the time of the meeting.¹⁰⁰ Instead, the majority relied on a newspaper article about the meeting that reported NCAI's membership to be 300,000.¹⁰¹ Bergsman questioned the legitimacy of the article as a source, pointing out its failure to substantiate the numerical figure and the fact that it did not actually quote Leon Cook as saying that NCAI had that many members.¹⁰²

II. PFI'S APPEAL

PFI's central argument in its complaint appealing the TTAB's decision was that "[t]he TTAB's decision [was] replete with errors of fact and law, including its failure to restrict its analysis to the relevant time frame of 1967–1990, when the registrations were first issued," and that the evidence presented to the TTAB did not support a finding of disparagement.¹⁰³ In its analysis of whether the TTAB reached incorrect conclusions, PFI often utilized the standards used to evaluate offensive trademarks and explored elements excluded from the USPTO's framework, such as the marks' likely meanings at present and their likely meanings when used on and in connection with goods and services not registered.¹⁰⁴ Thus, PFI's analysis directly contradicted the conditions laid out by the USPTO.¹⁰⁵ As discussed in Part III, however, these standards more accurately reflect societal realities and could better protect both the referenced group and trademark applicants if applied by the USPTO.¹⁰⁶

With regard to the term "redskin," PFI criticized the TTAB's "internally inconsistent" reliance on evidence like dictionary usage labels and media references, reiterating that the Native American viewpoint is the only relevant one for purposes of the analysis.¹⁰⁷ While PFI correctly asserted that only the opinions of the Native American community are relevant,¹⁰⁸ it then tried to use dictionary entries to its advantage by adopting the dissent's argument that the dictionary usage labels on record fail to show a "clear trend" towards classifying the term

¹⁰⁰ *Id.* at 1120 (Bergsman, J., dissenting).

¹⁰¹ *Id.*

¹⁰² *Id.* It is also important to note that the majority relied on another newspaper article quoting Gross as saying that NCAI's membership in 1972 was 350,000. Bergsman determined this estimate to be unreliable, as Gross "was not employed by the NCAI in 1972 . . . and the article does not provide any information to conclude that Mr. Gross had accurate knowledge about the membership of the NCAI in 1972." *Id.*

¹⁰³ *Pro-Football Appeal*, *supra* note 15, at ¶ 1.

¹⁰⁴ *Id.* at ¶¶ 76-99. At ¶ 76, PFI argues that "'redskin' . . . was not and is not *per se* disparaging," thereby conducting its analysis outside the relevant timeframe. In ¶ 98, PFI cites the high volume purchase of clothing bearing the Redskins marks as evidence that people do not find the marks disparaging, yet clothing was not one of the applied-for classes in any of the registrations at issue.

¹⁰⁵ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9.

¹⁰⁶ *See infra* Part III.

¹⁰⁷ *Pro-Football Appeal*, *supra* note 15, at ¶ 59.

¹⁰⁸ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9.

“redskin” as offensive, as the majority contends.¹⁰⁹ Like Bergsman, PFI made a two-fold argument concerning the two dictionary entries labeled as “often offensive;” its intention was to point out the low instance of entries during the relevant time period, as well as the fact that “often” does not mean “always,” and that the context of sports is one that would be excluded from the offensive use category.¹¹⁰

Aside from the fact that “redskin” is “often offensive,” the argument’s primary flaw is that PFI advanced no specific evidence that the term would *not* be disparaging in the context of sports by failing to account for the opinions of the referenced group—the precise issue it took with the TTAB’s holding.¹¹¹ In doing so, PFI appeared to adopt the standard used for determining whether a trademark is offensive, not disparaging. In addition to prohibiting the registration of disparaging marks, Section 2(a) of the Lanham Act bars registration of “immoral, deceptive, or scandalous matter.”¹¹² Such terms are usually characterized simply as “offensive.”¹¹³ Focusing on the sort of vulgarity that anyone considers offensive, and not just a particular group, the evaluation is to be made from the viewpoint of a substantial composite of the general public, and “in the context of contemporary attitudes.”¹¹⁴ Dictionary entries may in and of themselves serve as sufficient evidence that a word or phrase is offensive, provided that numerous dictionaries classify the term as vulgar and the trademark in question retains such a vulgar meaning.¹¹⁵ Because “dictionary definitions represent an effort to distill the collective understanding of the community with respect to language,”¹¹⁶ traditional dictionary entries likely incorporate the views of a substantial composite of the general public and thus warrant no further analysis. But because the disparagement analysis focuses only on the views of a substantial composite of the referenced group, USPTO standards require further evaluation with respect to that particular group.¹¹⁷ PFI engaged in no such analysis, seemingly adopting the

¹⁰⁹ *Pro-Football Appeal*, *supra* note 15, at ¶ 18.

¹¹⁰ *Id.*; see also *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 1118–19 (T.T.A.B. 2014) (Bergsman, J., dissenting).

¹¹¹ *Pro-Football Appeal*, *supra* note 15, at ¶¶ 89–90. PFI argues that the marks have acquired a secondary meaning through widespread use in association with professional football, and thus are no longer disparaging. However, PFI does not demonstrate how acquired secondary meaning among Americans as a whole translates to acquired secondary with respect to a substantial composite of Native Americans.

¹¹² Lanham Act § 2, 15 U.S.C. § 1052 (2012).

¹¹³ TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.01 (2015), <https://tmep.uspto.gov/RDMS/TMEP/current#/result/TMEP-1200d1e3054.html?q=offensive&ccb=on&ncb=off&icb=off&fcb=off&ver=current&syn=adj&reults=compact&sort=relevance&cnt=10&index=3>.

¹¹⁴ *Id.*

¹¹⁵ *Id.*

¹¹⁶ *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340 (Fed. Cir. 2003).

¹¹⁷ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9.

methodology used to evaluate offensive marks; not only did it consider the definitions at face value, but it interpreted the sheer amount—or lack thereof—of “offensive” usage labels as evidence that the term was not disparaging.¹¹⁸ Under the offensive marks standard, the lack of labels could be dispositive.¹¹⁹ Here, however, an additional inquiry must be made as to whether a substantial composite of the referenced group would find that meaning disparaging.¹²⁰ In neglecting to do so, PFI failed to show that the term “redskin” is not disparaging, much less in the context of sports.

Similarly, PFI incorrectly extended its scope of analysis to the general public by arguing that the term “redskin” had acquired secondary meaning through years of association with the football team. Of course, this argument also mistakenly extends the required temporal scope by failing to consider the marks’ disparaging nature as of their registration dates. The argument thus departed from USPTO standards on two counts. PFI posited that, after decades of advertising and broadcasting football games, the term “redskin” had come to identify the team, as well as PFI’s entertainment services in connection with that team.¹²¹ In acquiring this secondary meaning, the term evolved from a derogatory ethnic one into a positive one used only in connection with the football team.¹²² Further, PFI pointed to the public’s support of the term based on high sales of memorabilia bearing the team name and logo.¹²³

In advancing these arguments, PFI again neglected the views of the substantial composite of the referenced group—Native Americans—at the time of registration, looking to the present-day opinions of the public at large.¹²⁴ In its complaint, PFI made almost no references to the past or current opinions of the American Indian population.¹²⁵ Again, we see the use of the offensive trademark evaluative scheme, where the relevant test is whether “a substantial portion of the *general public*

¹¹⁸ *Pro-Football Appeal*, *supra* note 15, at ¶ 66.

¹¹⁹ TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.01 (2015), <http://tmep.uspto.gov/RDMS/detail/manual/TMEP/current/d1e2.xml#/result/RDMS/detail/manual/TMEP/current/TMEP-1200d1e3054.xml?q=offensive&start=1&ccb=on&ncb=off&icb=off&fcb=off&ver=July2015&sort=relevance&syn=adj&cnt=10&results=compact&index=1#highlight>.

¹²⁰ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9.

¹²¹ *Pro-Football Appeal*, *supra* note 15, at ¶ 89.

¹²² *Id.* at ¶ 90.

¹²³ *Id.* at ¶ 98.

¹²⁴ *Id.* at ¶¶ 97–99.

¹²⁵ *Id.* at ¶ 96 (“The T.T.A.B. erroneously discounted evidence that there are Native Americans, including tribal chiefs and recognized leaders, who react positively to ‘Redskins’ as used to denote the professional football team from Washington D.C., including during the relevant time period of 1967-1990, and have supported the team name.”). PFI failed to elaborate or present any sort of evidence as to how these chiefs or leaders represent a substantial composite of the Native American population.

would consider the mark to be scandalous in the context of . . . the relevant marketplace.”¹²⁶ Given that the “relevant marketplace” here is professional football, healthy sales of merchandise bearing the questionable marks would seem to indicate that a substantial composite of the general public does not find the mark offensive. After all, would so many Americans buy Washington Redskins memorabilia if they found it offensive? Therefore, if PFI were attempting to prove that the marks were not *offensive*, it may have had a valid argument. However, because the analysis centers on disparagement and not offensiveness, one of the main concerns is how a substantial composite of Native Americans views the marks. PFI offered no statistics on the relevant group, nor did it clarify whether and how many Native Americans comprise the “many members of the consuming public” to which it refers.¹²⁷

The other primary concern is the “likely meaning of the [marks]” at the time of registration.¹²⁸ Even if the meaning evolved over time or became less disparaging, it would still be considered disparaging for purposes of this analysis. Furthermore, as the TTAB established, the meaning of the term “redskin” has not actually changed. Regardless of context, it still refers to Native Americans and is still disparaging. PFI thus ignored the core requirements of the disparagement analysis by: (1) failing to evaluate the term’s meaning within the proper timeframe, and (2) expanding the population of which they are measuring the substantial composite, thus utilizing the standard for evaluating offensive, rather than disparaging, trademarks.

PFI also failed to follow the USPTO’s requirement of focusing only on the referenced group in its analysis of what “substantial composite” actually means, particularly in its consideration of quantity and not makeup.¹²⁹ PFI echoed the dissent’s argument that the TTAB failed to satisfactorily define the term “substantial composite,” therefore “leaving it to the majority to make petitioners’ case have some semblance of meaning.”¹³⁰ PFI was primarily concerned with the 1993 NCAI resolution,¹³¹ as well as the testimony regarding the 1972 meeting during which several leaders of Native American tribes and organizations met with the owner of the Washington Redskins to

¹²⁶ See TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 119.

¹²⁷ *Pro-Football Appeal*, *supra* note 15, at ¶ 98. PFI merely refers to the “consuming public,” with no specific detail as to who makes up that public. *See id.*

¹²⁸ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9; *see also* *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 1091 (T.T.A.B. 2014).

¹²⁹ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9. The Manual states that a substantial composite is “not necessarily a majority.” *Id.*

¹³⁰ *Pro-Football Appeal*, *supra* note 15 at ¶ 4 (quoting *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014) (Bergsman, J., dissenting)).

¹³¹ *Id.* at ¶ 63.

discuss changing the team's name.¹³² PFI argued that the NCAI resolution did not accurately depict the views of the substantial composite during the registration period,¹³³ and that the TTAB used pure conjecture in concluding that NCAI's membership as of 1993 represented 30% of the Native American population.¹³⁴ As to the 1972 meeting, PFI maintained that "[t]he record is devoid of any evidence showing that the views of these seven individuals accurately reflected the views of—or, indeed, were even shared by—the membership body of their respective groups."¹³⁵ In attacking these portions of the record, PFI implied that sheer quantity is the driving force behind the "substantial composite" by focusing on the number of people rather than their identity.¹³⁶ According to *In re Heeb*, it is the first question and not the second that determines the substantial composite with respect to a finding of disparagement.¹³⁷ Like PFI, applicant HEEB Magazine argued that the examining attorney unfairly rejected its application, because only a minority of the Jewish population found the term "heeb" disparaging.¹³⁸ In contrast, the magazine emphasized its wide distribution among Jewish students, as well as the lack of complaints surrounding its name.¹³⁹ Thus, as evidenced by its references to its high circulation figures, HEEB Magazine's losing arguments mirror PFI's belief that quantity makes or breaks the finding of a substantial composite.¹⁴⁰ The TTAB, however, was not persuaded.¹⁴¹ Reiterating the point that a "substantial composite" need not be a majority of the referenced group, it found that the examining attorney had shown disparagement by offering evidence representing nearly all facets of the Jewish community; among the parties represented were members of the religious and academic communities, as well as ordinary citizens.¹⁴² Note that the TTAB did not reference the specific amount of rabbis or

¹³² *Id.* at ¶ 65.

¹³³ *Id.* at ¶ 63.

¹³⁴ *Id.* at ¶ 64.

¹³⁵ *Id.* at ¶ 65.

¹³⁶ *Pro-Football Appeal*, *supra* note 15 at ¶¶ 64–65. PFI focuses on the amount represented by the 1993 NCAI membership and the individuals present at the 1972 meeting. PFI ignores the framework laid out in *In re Heeb Media, LLC*. See *infra* note 137.

¹³⁷ *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071, 1077 (T.T.A.B. 2008) (citing *In re McGinley*, 211 U.S.P.Q. 668 (C.C.P.A. 1981)).

¹³⁸ *Id.* at 1076. Applicant stated, "It simply defies logic, and the spirit of the Lanham Act, that a small group of determined naysayers can veto the use of a source of pride to what even the examiner characterizes as a young and progressive social movement, further endorsed and supported by Jewish foundations and organizations, as well as the business community."

¹³⁹ *Id.* at 1074–75.

¹⁴⁰ Like PFI's problematic analysis and use of the NCAI data, the losing arguments in *In re Heeb Media, LLC* focused on the amount represented by high circulation figures, ignoring the fact that the term "substantial composite" refers to different facets of the referenced group without necessarily requiring a high amount of each facet. *Id.* at 1076.

¹⁴¹ *In re Heeb Media, LLC*, 89 U.S.P.Q.2d, at 1075–78.

¹⁴² *Id.* at 1077.

ordinary citizens heard from.¹⁴³ Thus, the TTAB's ruling in this case demonstrates that it is not the number, but rather, the variety of members of the referenced group that determines whether the "substantial composite" requirement has been satisfied.

The types of parties comprising the substantial composite in *In re Heeb* were strikingly similar to those in this case; here again, we see a mixture of regular citizens and community leaders.¹⁴⁴ Therefore, like in *In re Heeb*, various strata of the referenced group voiced their opinions against the allegedly disparaging term. Even if PFI were correct in arguing that the TTAB had not satisfactorily proven that NCAI represented 30% when it passed the resolution,¹⁴⁵ or that the attendees of the 1972 meeting represented the views of their entire organizations,¹⁴⁶ these facts need not be proven. The focus belongs on the variety of groups represented, not the amount of people comprising those groups.¹⁴⁷ Thus, in analyzing whether the TTAB improperly established that a substantial composite of Native Americans find the term "redskin" disparaging, PFI once again lost focus of the relevant group. It did not mistakenly apply offensiveness standards, or altogether neglect to discuss the Native American population, as it did in attacking the dictionary evidence or arguing that the term "redskin" has acquired secondary meaning. Nonetheless, PFI again failed to properly narrow its analysis.¹⁴⁸

III. REFINING THE STANDARDS

In analyzing its arguments as to why the court should reverse the TTAB's cancellation order, it is apparent that PFI went outside and beyond the USPTO framework in determining whether the term "redskin" is disparaging. However, given the modern marketplace, it is not entirely incorrect in its approach. In rejecting the current analytical scheme, PFI considered relevant factors that are not currently accounted for, but should be. Such factors include the general population's present-day feelings towards the marks, as well as their use in association with goods or services not included in the trademark applications. If the USPTO were to adopt similar standards, it would in essence create a shield for both future trademark applicants and minorities. If a trademark applicant knew that the larger public takes offense at a disparaging mark regardless of context, it would probably not spend money on federal trademark applications. It would also

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *Pro-Football Appeal*, *supra* note 15, at ¶ 64.

¹⁴⁶ *Id.* at ¶ 65.

¹⁴⁷ *In re Heeb Media, LLC*, 89 U.S.P.Q.2d, at 1077.

¹⁴⁸ *Id.*

refrain from spending money on common-law-sanctioned practices, such as manufacturing and selling goods bearing the offensive trademark. Knowing that the sale of those goods would result in widespread backlash, the trademark applicant would potentially foresee having to pull them from the market, and would likely refrain from making and selling them in the first place. Keeping them out of the market altogether virtually guarantees that the entire public, much less the disparaged group, will never see them. Thus, the modified disparagement analysis prevents harm to both trademark applicants and minority groups.

Perhaps the most fundamental element of the adapted framework is the inclusion of the general public in the current disparagement analysis, one of the main ways in which PFI strayed from the USPTO's guidelines.¹⁴⁹ As an applicant, knowing that a substantial composite of the general population takes offense at your mark provides a powerful incentive *not* to spend money on that application.¹⁵⁰ If, for example, PFI knew that well over 1.7% of the population finds its marks disparaging,¹⁵¹ PFI would likely refrain from filing these applications. In this way, the USPTO would protect the applicant from spending futile trademark filing expenses.

Additionally, the USPTO would alert organizations to the nationwide unpopularity of the mark, an issue that affects such common law trademark rights as manufacturing and selling merchandise. It is important to understand what these rights entail and how they are obtained, given that a mark need not be federally registered to enjoy use or protection.¹⁵² For example, the Washington Redskins may continue

¹⁴⁹ *Pro-Football Appeal*, *supra* note 15, at ¶ 98.

¹⁵⁰ See TRADEMARK APPLICATION FEE STRUCTURE (Aug. 22, 2015, 7:44 AM), <http://www.uspto.gov/trademarks-application-process/filing-online/trademark-application-fee-structure>. If an applicant knew that the public takes offense at a certain trademark, and thus would be uninterested in purchasing merchandise bearing that trademark, he may not find the trademark application fees to be a worth investment.

¹⁵¹ See Tina Norris, Paula L. Vines, & Elizabeth M. Hoeffel, *The American Indian and Alaska Native Population: 2010*, U. S. CENSUS BUREAU (Jan. 2012), <https://www.census.gov/prod/cen2010/briefs/c2010br-10.pdf> (last visited Apr. 25, 2016).

¹⁵² In the *Blackhorse* decision, the TTAB confirms, “[t]his decision concerns only the statutory right to *registration* under Section 2(a). We lack statutory authority to issue rulings concerning the right to *use* trademarks.” *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 1082–83 (T.T.A.B. 2014). The T.T.A.B. cites a case where the United States Court of Customs and Patent Appeals held, “[i]t is beyond the powers of the PTO and of this court to prevent appellant’s use of its composite mark.” *In re Franklin Press, Inc.*, 597 F.2d 270, 273 (C.C.P.A. 1979). The court adds: “[I]t is clear that appellant’s common law rights in the composite mark as used in commerce will remain unaffected without regard to deletion or disclaimer of the phrase in question or to the procurement of a federal registration.” *Id.* Per 15 U.S.C. § 1051(a), “The owner of a trademark used in commerce *may* request registration of its trademark on the principal register . . .” 15 U.S.C.A. § 1051(a) (West 2002) (emphasis added). The use of the term “may” implies that federal registration of a mark is not a prerequisite for its use in commerce.

to use its name and generate merchandise bearing that name.¹⁵³ Additionally, because individuals may bring infringement actions under common law, PFI may also prevent third parties from creating and selling goods bearing the Redskins marks despite cancellation.¹⁵⁴ Thus, many believe that the TTAB cancellation is not particularly impactful, and that the team will neither change its name nor cease selling Washington Redskins memorabilia.¹⁵⁵

Based on the public's reactions, however, this is not necessarily the case. While it is true that PFI may continue to use its marks and sell Redskins merchandise, people may not want to buy it. Some non-Native American citizens find the name to be extremely disparaging,¹⁵⁶ and the team is facing enormous political pressure to change the name. In an interview President Obama said, "[i]f I were the owner of the team and I knew that there was a name of my team – even if it had a storied history – that was offending a sizeable group of people, I'd think about changing it."¹⁵⁷ On June 12, 2014, Nevada Senator Harry Reid wrote a letter to Washington Redskins President Bruce Allen declining his invitation to attend a game in Washington until the team's name changed.¹⁵⁸ In the preceding months, Reid had publicly criticized the

¹⁵³ See *Official United States Patent and Trademark Office Statement on the Trademark Trial and Appeal Board's (T.T.A.B.) Decision in Blackhorse v. Pro Football, Inc. (T.T.A.B. Cancellation No. 92046185)*, U.S. PAT. & TRADEMARK OFF., http://www.uspto.gov/sites/default/files/news/USPTO_Official_Statement_on_TTAB_decision_in_Blackhorse_v_Pro_Football_Inc.pdf (last visited Apr. 1, 2016). The USPTO noted that "[t]he decision does not . . . require the trademarks in the involved registrations to be changed or no longer be used by Washington, D.C.'s pro football team." *Id.*

¹⁵⁴ Susan Neuberger Weller, *Let's Set the Record Straight . . . the Redskins Still Own the REDSKINS Trademarks*, COPYRIGHT & TRADEMARK MATTERS (June 19, 2014), <http://www.copyrighttrademarkatters.com/2014/06/19/lets-set-the-record-straight-the-redskins-still-own-the-redskins-trademarks/>. See also David Weild III & Carolyn Gouges d'Agincourt, *Curbing the Copyists*, 28 WORLD TRADEMARK REV. 96 (2011), <http://www.worldtrademarkreview.com/Magazine/Issue/28/Country-correspondents/United-States-Edwards-Angell-Palmer-Dodge>. The authors note that "[p]roof of infringement under common law follows the same principles as under federal law," except that "[u]nlike at common law, a plaintiff suing for infringement of an unregistered mark under Section 43(a) must establish that the mark has been used in interstate commerce – the only commerce which is regulated by Congress." *Id.*

¹⁵⁵ *Id.*; see also Marc Randazza, *Why Redskins Decision is Wrong*, CNN (June 21, 2014, 2:36 PM), <http://www.cnn.com/2014/06/20/opinion/randazza-redskins-constitutional/>.

¹⁵⁶ Bobic, *supra* note 2. See also Mark Boslough, *11 Reasons the Redskins Should Become the Washington Americans*, HUFFINGTON POST (July 1, 2014, 12:15 PM), http://www.huffingtonpost.com/mark-boslough/ten-reasons-the-redskins-_b_5541820.html. One of the reasons Boslough lists for changing the team name is that "[s]portscasters would be able to utter the team's name on live TV without sounding like ignorant racists." *Id.*

¹⁵⁷ David Nakamura, *Obama: 'I'd Think About Changing' Washington Redskins Team Name*, WASH. POST (Oct. 5, 2013), http://www.washingtonpost.com/politics/obama-id-think-about-changing-washington-redskins-team-name/2013/10/05/e8d5cb4a-2dcd-11e3-b139-029811dbb57f_story.html.

¹⁵⁸ Ed O'Keefe, *Harry Reid to Redskins: Thanks, but no Thanks.*, WASH. POST (June 16, 2014), <http://www.washingtonpost.com/blogs/post-politics/wp/2014/06/16/harry-reid-to-redskins-thanks-but-no-thanks/>. In his letter to Bruce Allen, Reid wrote, "I will not stand idly by while a

team for failing to institute such a change.¹⁵⁹ He and nearly fifty other senators wrote letters to Roger Goodell urging him and the NFL to do so.¹⁶⁰ At the same time, there are many who feel the team name should not be changed despite this mounting political pressure.¹⁶¹

This data demonstrates how gauging the general public's sentiment, in addition to the affected minority group's, can assist a trademark applicant in deciding whether to invest in merchandise. In general, an organization would not want to invest in merchandise that it will likely have to pull from stores due to its controversial nature. For example, knowing that approximately fifty senators oppose its marks¹⁶² may incentivize a trademark applicant to withhold unpopular products from the marketplace and save money. At the same time, the referenced group would never encounter the disparaging trademarks, because the merchandise on which they appear would never enter the marketplace. In this way, both trademark applicants and minority groups enjoy protection. Such protection is less feasible, however, by performing the traditional disparagement analysis that includes only the referenced group. Thus, in looking beyond such a group, PFI created a new, invaluable standard. While the opinions of the general public are inconsequential according to the current framework, it is a standard that contemplates practical, contemporary concerns and should therefore be added to the disparagement analysis.

Another way in which the USPTO could protect both minorities and trademark applicants would be to evaluate disparagement as of the cancellation date, among both the referenced group and the general public. This is another standard that PFI used in its complaint, one that contrasted with the current requirement that disparagement be evaluated as of the mark's registration date.¹⁶³ The USPTO determined that the term "redskin" was disparaging as of each of the individual registration

professional sports team promotes a racial slur as a team name and disparages the American people." As a Nevada senator, Reid represents nearly thirty tribes and has "a duty to ensure that the United States uphold centuries-old treaty and trust obligations towards Native Americans." *Id.*
¹⁵⁹ *Id.*

¹⁶⁰ Mark Maske, *Senate Democrats urge NFL to Endorse Name Change for Redskins*, WASH. POST (May 22, 2014), http://www.washingtonpost.com/sports/senate-democrats-urge-nfl-to-endorse-name-change-for-redskins/2014/05/22/f87e1a4c-e1f1-11e3-810f-764fe508b82d_story.html.

¹⁶¹ According to a May 2013 poll conducted by Associated Press-GfK, 79% of Americans "favor keeping the name," while a mere 11% "think it should be changed." Ben Nuckols, *Washington Redskins Name Change: Poll Shows Widespread National Support For Team Name*, HUFFINGTON POST (May 2, 2013, 1:21 PM), http://www.huffingtonpost.com/2013/05/02/washington-redskins-name-change_n_3202115.html. See also a 2013 Washington Post poll revealing "61 percent of D.C. area residents support the Redskins' name." Will Wrigley, *Majority of Washingtonians Support Redskins' Name, Washington Post Poll Finds*, HUFFINGTON POST (June 25, 2013, 11:14 AM), http://www.huffingtonpost.com/2013/06/25/majority-support-redskins-name_n_3496552.html.

¹⁶² Bobic, *supra* note 2.

¹⁶³ *Pro-Football Appeal*, *supra* note 15, at ¶ 76.

dates¹⁶⁴ and had not become less so by acquiring secondary meaning.¹⁶⁵ In making these determinations, the USPTO completely discounted the present-day opinions of both Native Americans and non-Native Americans. With respect to the latter, we derive no sense of how they would react upon seeing these marks in the current marketplace. In evaluating whether or not a mark is disparaging at the time of registration, the views of the substantial composite are determined “in the context of contemporary attitudes.”¹⁶⁶ Typically, “contemporary” and “the time of registration” are one and the same.¹⁶⁷ *Blackhorse* presents an unusual situation in that the TTAB ruled the marks disparaging decades after the registration dates, meaning that what is “current” for purposes of the analysis is not necessarily “current” in the typical sense of the word.¹⁶⁸ Based on the number of Native Americans protesting the Redskins marks, we can safely assume that the group finds the mark to be disparaging as of the present.¹⁶⁹ However, it would seem more appropriate that the “relevant time period” be the time of cancellation, and not necessarily the registration date. While these periods are typically one and the same, there may be the occasional instance—as in *Blackhorse*—where the two dates fall decades apart, thus encompassing two completely different sets of sensibilities. Assessing the views of the substantial composite at the time of cancellation will only further strengthen protections for trademark applicants and minority groups alike. Because the TTAB would be considering the current sentiments of the referenced group, trademark applicants would have a better understanding of what will likely offend consumers at present. Obtaining this information can prevent those individuals from spending money on trademark applications they know will meet federal opposition, in addition to merchandise they will not sell due to public outcry. Consequently, the minority group disparaged by the mark will never encounter it in commerce. In this way, the TTAB may shield trademark applicants and minorities from harm.

¹⁶⁴ *Id.* at ¶ 37, 63.

¹⁶⁵ *Id.* at ¶ 68.

¹⁶⁶ *In re Heeb Media, LLC*, 89 U.S.P.Q.2d, at 1074.

¹⁶⁷ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9. § 1203.03(b)(i) requires that the disparagement analysis be performed “in the context of contemporary attitudes.” However, note that a USPTO examining attorney conducts the analysis for pending marks in order to decide whether that mark is suitable for registration. Thus, because the attorney will be viewing the mark within a context that is in place shortly before registration, “contemporary attitudes” and the registration date are one and the same. *See id.*

¹⁶⁸ *Blackhorse*, 111 U.S.P.Q.2d at 1082. The TTAB performed its analysis in 2014, yet the marks were registered during the period 1967-1990.

¹⁶⁹ *See* John Woodrow Cox, *In Minnesota, Thousands of Native Americans Protest Redskins’ Name*, WASH. POST (Nov. 2, 2014), http://www.washingtonpost.com/local/in-minnesota-native-americans-march-rally-to-protest-redskins-name/2014/11/02/fc38b8d0-6299-11e4-836c-83bc4f26eb67_story.html (reporting on a Native American protest at a Redskins game, with attendees ranging into the thousands).

In order to further strengthen that shield, the TTAB should consider the present-day opinions not only of the referenced minority but, again, of the general public. Knowing that the majority and minority disapprove of a mark would likely incentivize an applicant to reconsider applying for its registration *and* using it in commerce. The applicant would thus save money by not filing an ill-fated application, and not manufacturing goods that it will need to pull from stores. PFI undertook such an analysis by pointing out its high merchandise sales as an indication of the general public's acceptance of the term "redskin."¹⁷⁰ In this argument, PFI neglected to mention the number of members of the referenced group buying this merchandise. However, given the size of the Native American population relative to the general population, it is unlikely that its members comprise a particularly large portion, if any, of the consuming public. Non-Native Americans would be purchasing the majority of the merchandise. Thus, it is essential that PFI gauge the general population's sentiments *at present*, meaning, the date of cancellation. In this situation, knowing the group's opinions at the time of registration provides no insight, as the newest registration was issued in 1990.¹⁷¹ Only through having the most current information would an applicant know whether applying for trademarks and using them in the marketplace would be wise business decisions.

Furthermore, evaluating disparagement against a modern-day backdrop is the only way to effectively protect the referenced group. If a trademark applicant knows that the *modern-day* majority does not find a mark disparaging, the applicant is likelier to produce or purchase merchandise bearing that mark. Consequently, the referenced group is more likely to be exposed to that disparaging trademark. Conversely, if the applicant knows that the general public finds the marks disparaging, the applicant is likelier to refrain from investing in manufacturing and selling goods bearing the mark, for fear of losing money. In PFI's case, such a decision would have been on target, as sales of Redskins merchandise have significantly decreased in recent history.¹⁷² If the applicant decides to forego the sale and manufacture of goods because it

¹⁷⁰ *Pro-Football Appeal*, *supra* note 15, at ¶ 98.

¹⁷¹ See *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, 1082 (T.T.A.B. 2014).

¹⁷² See Chris Isidore, *Redskins Gear Stiff-Armed by Fans*, CNN (Sep. 4, 2014, 3:57 PM), <http://money.cnn.com/2014/09/04/news/companies/redskins-merchandise/>. Isidore reports, "[s]ales of Redskins items plunged 35% in the most recent quarter, despite a 3% rise in sales of NFL merchandise overall, according to SportsSourceOne, a service that tracks licensed merchandise sales nationwide." While a spokesman for the team speculated that this decrease could be attributed to the team's poor performance during the most recent season, SportsSourceOne analyst Matt Powell believes that the racist team name was the primary factor, pointing out that "other teams with similarly bad records didn't suffer the magnitude of the drop suffered by Washington." Although he doesn't have data to support this theory, he suspects that the decrease in sales resulted in part from "manufacturers and retailers pulling back on the production and stocking of them . . ." *Id.*

suspects that it will either lose money in sales or have to pull the items off shelves due to public condemnation, the referenced group will never encounter the mark in commerce.

Thus, in cases such as these where the present day and the date of registration are not synonymous, it is essential that the TTAB consider whether both a substantial composite of the referenced group and the majority find a mark disparaging as of the cancellation date (i.e., the present), not the registration date. As a result, trademark applicants and referenced groups enjoy protection. The former will be able to make better business decisions. They will save money on applications they know will be denied, because they know that both the general public and the minority in question *currently* find them disparaging. Having this information at their disposal will also inspire applicants not to sell or manufacture goods bearing the disparaging mark. As a result, the minority to which the disparaging mark refers will never encounter that mark. This is because the applicants have decided, based on the most current information, not to inject items bearing those disparaging marks into commerce.

Another critical way in which PFI expanded upon the disparagement analysis was by considering goods not included in the registrations. As part of the first prong of the disparagement test, the USPTO requires an analysis of the likely meaning of the mark that includes, among other factors, a consideration of the nature of the applied-for goods and services, as well “the manner in which the mark is used in the marketplace in connection with the goods or services.”¹⁷³ All six of the cancelled registrations are for entertainment services.¹⁷⁴ In accordance with the USPTO’s framework, PFI argued that the marks are not disparaging when used in connection with these services.¹⁷⁵ However, in arguing that the term “redskin” has acquired secondary meaning, PFI alluded to goods and services not included in the registrations.¹⁷⁶ For example, PFI referenced its healthy sales of merchandise to which the Redskins name and logo are affixed and the fact that many members of the public wear and use such products.¹⁷⁷ While PFI did not specify what these products are, one can see from the NFL’s website that such wearable and usable products include jerseys,

¹⁷³ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9.

¹⁷⁴ *Blackhorse*, 111 U.S.P.Q.2d at 1083. More specifically, five of the six registrations are for “entertainment services—namely, presentations of professional football contests.” *Id.*

¹⁷⁵ See *Pro-Football Appeal*, *supra* note 15, at ¶ 83 (“Professional football games are neither of questionable morality nor *per se* offensive to or prohibited by Native American religious or cultural practices”); *id.* at ¶ 85 (“When used in connection with professional football games, the word ‘Redskins’ bears only positive associations.”).

¹⁷⁶ See *Pro-Football Appeal*, *supra* note 15, at ¶¶ 36 and 98. Although the registrations were for entertainment services pertaining to professional football, PFI discusses the level of Redskins merchandise (like clothing and memorabilia) sold.

¹⁷⁷ *Id.*

key chains, and bumper stickers, all of which are clearly not entertainment services.¹⁷⁸

In referencing the widespread sale of such items, PFI considered a broader scope of goods and services than the USPTO permits. In doing so, however, PFI employed a standard that allows for a more thorough analysis. The economic realities necessitating such a test are similar to those warranting the inclusion of the general public in the disparagement analysis. As a trademark applicant, knowing that the public takes offense at your trademark in *any* context (and not just in connection with the applied-for goods and services) would likely incentivize you to neither file the trademark application for any goods or services, nor manufacture and sell goods in connection with any goods or services.

In particular, the USPTO should consider goods and services that the applicant will likely sell in high quantities. If an applicant has not included those goods or services in the current application, perhaps the USPTO could look to similar organizations as a frame of reference. For instance, if a sports team were to apply for a potentially disparaging trademark, the USPTO could look to the Redskins case for guidance. Regardless of which goods and services are included in the application, the USPTO would look to the Redskins example and see that, although the canceled registrations were for entertainment services, apparel and other memorabilia bearing the redskins name and logo have sold in mass quantities. The NFL's online store indicates that the highest-selling Redskins merchandise currently consists of jerseys.¹⁷⁹

Based on a review of such data, perhaps the USPTO would conclude that the team will likely attempt to register the trademark for clothing in the future. Therefore, when evaluating "the manner in which the mark is used in the marketplace,"¹⁸⁰ the USPTO should consider, based on sales potential and the consequent likelihood of production, goods and services not included in the application. Under the proposed framework, the USPTO would thus consider the nature of apparel, and the manner in which the Redskins marks would be used in connection with them.¹⁸¹ If the USPTO decided to deny the application based on its findings, perhaps it could include a disclaimer that it will refuse any future applications for the mark should it include apparel.

Overall, the new framework would protect both trademark applicants and minority groups. Knowing that it will be denied future

¹⁷⁸ See generally NFL SHOP, http://www.nflshop.com/Washington_Redskins_Gear (last visited Apr. 17, 2016). Other products unrelated to the registered entertainment services include lawn ornaments, drink ware, and license plate frames.

¹⁷⁹ *Id.* The "Hottest Selling For Him" and "Hottest Selling For Her" tabs indicate the most popular merchandise to be apparel bearing the Redskins name and logo.

¹⁸⁰ TRADEMARK MANUAL OF EXAMINING PROCEDURE, *supra* note 9.

¹⁸¹ *Id.*

registrations for lucrative goods and services, the applicant will likely refrain from filing the applications. The applicant may also decide not to apply in the knowledge that the general public takes issue with that mark, regardless of the goods or services. Awareness of the public's negative feelings towards the mark may, in turn, inspire the applicant to refrain from using it in connection with any good or service. For instance, it will not want to manufacture and sell clothing that it knows no one will buy, or that it will have to pull off shelves. In this way, the modified framework will prevent applicants from spending unnecessarily. The decision to keep the disparaging goods and services out of the marketplace altogether will also serve to protect minority groups. Because the applicant will not use the disparaging mark in connection with any goods or services, the minority groups will at no time encounter them in the marketplace.

CONCLUSION

It is difficult to ignore the negative connotations of the term "redskin," even if the term brings to mind the professional football team. When the TTAB decided to cancel the six Redskin registrations, it took into consideration countless pages of evidence and utilized the framework that the Lanham Act meticulously laid out. To its detriment, PFI repeatedly strayed from this framework in its response by failing to consider the views of a substantial composite of only the referenced group, analyze the meaning of the marks as of the time they were registered, and limit its focus to the applied-for services. By following its own rules, PFI in essence created a broader framework that allowed for a more thorough analysis. By considering the opinions of both the general public and the referenced group, evaluating disparagement within the context of contemporary times, and considering goods and services not included in the application, PFI modified the disparagement analysis into one that could protect both trademark applicants and minority groups. Trademark applicants will have a better understanding of the social and political landscape, one that will prevent them from wasting money on applications that will not mature to registration, as well as the sale and manufacture of merchandise that will not sell. By refraining from selling such merchandise, trademark applicants will in turn protect minority groups from ever encountering disparaging goods or services in their everyday lives; if a good or service never proceeds to production, it is virtually sight unseen as far as the affected ethnic groups are concerned. Thus, should the USPTO decide to adapt its disparagement analysis in accordance with PFI's framework, it could offer both groups unprecedented protections.

Right or wrong, PFI's arguments have paved the way for a future disparagement test that will more accurately reflect the world in which

524 CARDOZO ARTS & ENTERTAINMENT [Vol. 34:499

we live.

*Stella Silverstein**

* *Symposium Editor*, Cardozo Arts & Ent. L.J. Vol. 34, J.D. Candidate, Benjamin N. Cardozo School of Law (2016); B.A., English, Wellesley College (2007). I would like to thank my AELJ editors, particularly Jennifer Yeh, Elise Michael, Kenneth Eng, and Mikaela Gross for their invaluable assistance with this note. To Mom, Dad, and all of my amazing friends: thank you for all of your guidance and support. © 2016 Stella Silverstein.