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## NOTES

### DISPARAGING TRADEMARKS: AN ANALYSIS OF SECTION 2(A)'S DISPARAGEMENT STANDARD AND THE STANDARD'S APPLICATION FROM *HARJO* TO *BLACKHORSE*

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#### I. INTRODUCTION

There seems to be an endless list of possibly offensive terms, symbols, and monikers.<sup>1</sup> This is true in all contexts, not just with pejorative terms of race or ethnicity. For example, the University of Miami, nicknamed the “Hurricanes,” was surprised to receive reports that its name was insensitive and offensive to those harmed by Hurricane

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1. See, e.g., George F. Will, *Out with 'Redskins' — and Everything Else!*, WASH. POST (Sept. 4, 2015), [https://www.washingtonpost.com/opinions/cleaning-up-history-one-name-at-a-time/2015/09/04/21ead5d4-525b-11e5-8c19-0b6825aa4a3a\\_story.html](https://www.washingtonpost.com/opinions/cleaning-up-history-one-name-at-a-time/2015/09/04/21ead5d4-525b-11e5-8c19-0b6825aa4a3a_story.html) [https://perma.cc/Y2BC-RPJW].

Andrew.<sup>2</sup> Complaints like that one demonstrate the ease with which allegations of offense or disparagement can occur in a society with a heightened sense of political correctness. Indeed, “[w]e have a new national passion for moral and historical hygiene, a determination to scrub away remembrances of unpleasant things, such as the name Oklahoma, which is a compound of two Choctaw words meaning ‘red’ and ‘people.’”<sup>3</sup>

Speaking of Oklahoma, “any true Texan would find the ‘University of Oklahoma’ [emblem] to be beyond the pale of *any* standard of human decency.”<sup>4</sup> That example is, of course, offered in jest, but it is not hard to imagine other similarly frivolous complaints. The inability to properly identify and assess meritorious claims of disparagement is a problem that has plagued trademark law and trademark owners for nearly two decades. Where, if ever, will it stop? Unless this problem is addressed, today’s trademark owners will continue to wonder when their marks—the ones they have spent years developing—might confront a frivolous challenge. Absent congressional intervention, the answers to these questions are dependent on the judicial treatment of current trademark law and the associated disparagement standard in both present and future trademark cases—one of which involves a series of trademarks utilized by the Washington Redskins.<sup>5</sup>

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2. Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPP. L. REV. 7, 52–53 (1994).

3. *Id.*; see also Ed Doney, *If Redskins Change Name, Should Oklahoma Change Its Name Too?*, KFOR.COM (June 19, 2014, 6:35 PM), <http://kfor.com/2014/06/19/if-redskins-change-name-should-oklahoma-change-its-name-too/> [<http://perma.cc/FPT8-78TW>].

4. Brief of *Amici Curiae* Cato Institute, P.J. O’Rourke, Nat Hentoff, Martin Garbus, Nadine Strossen, and the Comic Book Legal Defense Fund, in Support of Respondents at 7, *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015) (No. 14-144), 2015 WL 721235, at \*7.

5. See *Pro-Football, Inc. v. Blackhorse (Blackhorse II)*, No. 1:14-cv-01043-GBL-IDD, 2015 WL 4096277 (E.D. Va. July 8, 2015), *aff’g* 111 U.S.P.Q.2d (BNA) 1080 (T.T.A.B. 2014); *In re Tam*, 600 F. App’x 775 (Fed. Cir.) (mem.), *vacating per curiam* 85 F.3d 567 (Fed. Cir. 2015), *aff’g* 108 U.S.P.Q.2d (BNA) 1305 (T.T.A.B. 2013); see also Michael Phillips, *Redskins Trademark Case Appeal Will Be Heard in 2016*, DAILY PROGRESS (Aug. 14, 2015, 1:42 PM), [http://www.dailyprogress.com/news/local/redskins-trademark-case-appeal-will-be-heard-in/article\\_cad1f6ce-42ab-11e5-ad16-c39091e63484.html](http://www.dailyprogress.com/news/local/redskins-trademark-case-appeal-will-be-heard-in/article_cad1f6ce-42ab-11e5-ad16-c39091e63484.html) [<http://perma.cc/VR76-RZCM>]. At the time of this writing, *Blackhorse* is set to be heard by the United States Court of Appeals for the Fourth Circuit. See *id.* The contentious issue in this highly publicized case has received attention from many prominent individuals. See, e.g., Dan Steinberg, Theresa Vargas & Ian Shapira, *Where People Stand on the Redskins’ Name*, WASH. POST (Aug. 20, 2014), <http://www>.

This Note focuses on the disparagement standard derived from our nation's convoluted and arguably problematic trademark statutes; the only way to ensure that legal rulings properly identify and assess meritorious allegations of disparagement and avoid an inordinate level of political correctness is to analyze the legal standard at the center of it all.<sup>6</sup> Part II addresses the Lanham Act, providing a discussion of the federal registration process for trademarks and the associated benefits. It also chronicles the disparagement standard from its enunciation in *Harjo v. Pro-Football, Inc. (Harjo I)*<sup>7</sup> to its most recent application in *Pro-Football, Inc. v. Blackhorse (Blackhorse II)*.<sup>8</sup> Part III focuses on *Blackhorse*, criticizing the application of the disparagement standard and the overall analysis as duplicative of that seen in *Harjo I* and rejected in *Pro-Football, Inc. v. Harjo (Harjo II)*.<sup>9</sup> Part IV highlights the weaknesses of the current standard and proposes modifications to help facilitate appropriate and consistent application. In particular, it suggests that reviewing entities<sup>10</sup> should incorporate modern perceptions into the disparagement analysis as a factor for consideration. Furthermore, it asserts that those entities should discard the highly subjective

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washingtonpost.com/wp-srv/special/sports/redskins-name-opinions/ [http://perma.cc/RR28-5VC8]. In fact, it has even made its way into some very important political discussions. See Steve Ginsburg, *Congressional Bill Aims to Get NFL to Change the Name 'Redskins,'* REUTERS (Sept. 10, 2015, 5:45 PM), <http://www.reuters.com/article/2015/09/10/us-nfl-redskins-congress-idUSKCN0RA2HG20150910> [http://perma.cc/KY3H-FYTN] (“The District of Columbia’s non-voting congressional delegate introduced a bill . . . to strip the NFL of its federal antitrust protection as long as it allows Washington’s football team to use the name ‘Redskins,’ a moniker some see as racist.”); Melanie Mason, *California Schools Barred from Using ‘Redskins’ as Team Name or Mascot,* L.A. TIMES (Oct. 11, 2015, 2:08 PM), <http://www.latimes.com/politics/la-me-pc-redskins-mascot-banned-20151011-story.html> [http://perma.cc/7YS5-W9KP] (“As of Jan. 1, 2017, all [California] public schools will be barred from using the term ‘Redskin,’ which many Native Americans consider a racial slur.”).

6. This Note should not be read as addressing or commenting on the appropriateness of any of the terms referenced herein. It is intended only to be a comprehensive discussion of the disparagement standard and the standard’s weaknesses.

7. *Harjo v. Pro-Football, Inc. (Harjo I)*, 50 U.S.P.Q.2d (BNA) 1705, 1737, 1740–41 (T.T.A.B. 1999), *rev’d on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003).

8. *Blackhorse II*, 2015 WL 4096277, at \*21; *see also* *Blackhorse v. Pro-Football, Inc. (Blackhorse I)*, 111 U.S.P.Q.2d (BNA) 1080, 1085 (T.T.A.B. 2014), *aff’d*, 2015 WL 4096277 (E.D. Va. July 8, 2015).

9. *See* *Pro-Football, Inc. v. Harjo (Harjo II)*, 284 F. Supp. 2d 96, 144–45 (D.D.C. 2003).

10. The term *reviewing entities* is used throughout this Note as a reference to any and all of the entities that may apply the disparagement standard to an allegedly disparaging trademark and then issue a ruling regarding the trademark’s status.

“substantial composite” language and base all future findings on a majority of the referenced group. This Note concludes by briefly considering the broad implications of the discretionary disparagement standard for trademarks similar to those challenged in *Harjo* and *Blackhorse*.<sup>11</sup>

## II. THE DISPARAGEMENT STANDARD: HISTORY AND DEVELOPMENT

Generally speaking, trademark law has two goals:<sup>12</sup> “[It] serves to protect . . . consumers from deception and confusion over trade symbols *and* to protect the plaintiff’s infringed trademark as property.”<sup>13</sup> Trademarks make it possible for consumers to classify goods and services based on quality and the amount of satisfaction produced by the goods or services.<sup>14</sup> They also reduce the time and expense associated with purchasing decisions.<sup>15</sup> In other words, trademarks encourage their owners to produce and offer high-quality goods and services.<sup>16</sup>

A distinctive mark has significant value that requires the strongest available protection. Trademark owners can settle for common-law protection, or they can procure stronger protection for their marks through registration—either state or federal.<sup>17</sup> In order to acquire common-law protection, an owner must simply select and use a mark; nothing more is required.<sup>18</sup> Likewise, an owner may be able to procure state<sup>19</sup> and federal protection (without registration) by simply using the

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11. In *Harjo* and *Blackhorse*, the discussion involved several trademarks and how they relate to American Indians. Out of respect for individual and regional preferences, the terms *American Indian* and *Native American* are used interchangeably throughout this Note.

12. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:2, at 2-4 (4th ed. 2015).

13. *Id.*; *see also* Weil Ceramics & Glass, Inc. v. Dash, 878 F.2d 659, 672 (3d Cir. 1989) (“[W]e discern two broad policy goals that Congress sought to foster by this legislation: (1) protection against consumer deception (i.e., purchase of a good that is not what the consumer intended to purchase, but because of packaging or other deceptive imitation of the trademark appears to be the genuine trademarked good); (2) protection of the trademark holder’s investment in goodwill and noteworthiness that has been generated by the holder’s advertisements and quality from imitative goods over which the trademark holder has no control of quality.”).

14. *See* MCCARTHY, *supra* note 12, § 2:3, at 2-6.

15. *Id.* § 2:3, at 2-5 to -6. *See generally id.* § 2:5.

16. *Id.* § 2:3, at 2-5 to -6. *See generally id.* § 2:4.

17. *See* Pace, *supra* note 2, at 17-19.

18. *Id.*

19. There are trademark statutes and registration schemes in every state. *Id.* at 17 n.61.

trademark in commerce.<sup>20</sup> These three avenues provide varying levels of protection, but a trademark's protection is strongest when the owner successfully registers the mark.<sup>21</sup> This Note focuses on the *federal* aspect of registration and protection—the Trademark Act of 1946 (“Lanham Act”)<sup>22</sup>—and the associated case law.

### A. The Lanham Act

Congress's first several attempts to establish some federal trademark laws proved either unsuccessful or ineffective.<sup>23</sup> For example, the Federal Trademark Act of 1905 adopted the view that an individual's right to a trademark was dependent on the common law.<sup>24</sup> Indeed, that statutory scheme classified trademark protection as “a matter of state concern.”<sup>25</sup> The obvious result was the existence of a wide variation in trademark rights, which caused a tremendous amount of confusion and uncertainty.<sup>26</sup>

In 1946, Congress attempted to remedy its previous failures by enacting the Lanham Act.<sup>27</sup> This new statutory scheme included various sources of protection that overlapped and expanded the common law.<sup>28</sup> By passing the Lanham Act, Congress intended to enlarge a registrant's procedural and substantive trademark rights.<sup>29</sup> Essentially, Congress

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20. DONALD S. CHISUM & MICHAEL A. JACOBS, UNDERSTANDING INTELLECTUAL PROPERTY LAW § 5C, at 5-11 (1992) (“[A] person acquires mark ownership by taking the steps trademark law prescribes—adoption and use of a distinctive mark . . . . A person may have exclusive mark rights under both state and federal law without registering the mark.”).

21. See *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 193–94 (1985).

22. The Trademark Act of 1946, also known as the Lanham Act, is the current statutory scheme that governs federal trademark registration. See Trademark Act of 1946 (Lanham Act), ch. 540, 60 Stat. 427 (codified as amended at 15 U.S.C. §§ 1051–1141n (2012)).

23. See Ethan Horwitz & Benjamin Levi, *Fifty Years of the Lanham Act: A Retrospective of Section 43(a)*, *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 59, 60–63 (1996).

24. *Park 'N Fly*, 469 U.S. at 193.

25. *Id.*

26. *Id.*

27. *Id.*

28. CHISUM & JACOBS, *supra* note 20; see also 15 U.S.C. § 1125 (2012) (codifying aspects of common-law rights and protections).

29. See 3 MCCARTHY, *supra* note 12, § 19:8, at 19-31 to -32; see also *Park 'N Fly*, 469 U.S. at 193 (“Among the protections created by the Lanham Act were the statutory provisions that allow a federally registered mark to become incontestable.”).

recognized the need to provide trademarks with the greatest possible protection.<sup>30</sup> While they continue to protect unregistered marks, the federal trademark laws afford special, distinct protections to trademarks that achieve registered status.<sup>31</sup>

At common law, a mark's owner enjoys the "enforceable right of exclusivity . . . in the geographic area in which the mark is used."<sup>32</sup> That right also seems to exist in codified form under the Lanham Act.<sup>33</sup> "This means that the first [person] to use a trademark is the mark's owner in the area of use, and has the right to exclude all others from using trademarks that would be confusingly similar."<sup>34</sup> On the other hand, a federal registrant—an applicant who completes the federal registration process—has access to a more valuable, expansive set of protections and benefits.<sup>35</sup> "Federal registration serves as nationwide constructive notice of a trademark's ownership."<sup>36</sup> In other words, the registrant may exercise his or her right to exclusivity on a national level instead of doing so in a more limited geographic area.<sup>37</sup> So the distinction is between (1) receiving protection in geographic areas where the mark is actually in use and (2) having protection throughout the United States, regardless of geographic use.

Federal registration also serves as "prima facie evidence of the validity of the registered mark and of the registration of the mark, of the owner's ownership of the mark, and of the owner's exclusive right to use the registered mark in commerce on or in connection with the [specific] goods or services."<sup>38</sup> Furthermore, it allows the registrant to rely on a federal court for the resolution of all claims or actions associated with the registered trademark.<sup>39</sup> A registrant can also use customs services "to bar

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30. *See Park 'N Fly*, 469 U.S. at 193.

31. *See id.*

32. Pace, *supra* note 2, at 18.

33. *See generally* 15 U.S.C. § 1125.

34. Pace, *supra* note 2, at 18 (citing *Modular Cinemas of Am., Inc. v. Mini Cinemas Corp.*, 348 F. Supp. 578 (S.D.N.Y. 1972)).

35. *Id.* at 19.

36. *Id.* "Registration of a mark on the principal register . . . shall be constructive notice of the registrant's claim of ownership thereof." 15 U.S.C. § 1072; *see also id.* § 1057(c) ("Contingent on the registration of a mark on the principal register . . . , the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration . . .").

37. Pace, *supra* note 2, at 19.

38. 15 U.S.C. § 1057(b).

39. *Id.* § 1121.

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the importation of any goods bearing an infringing trademark.”<sup>40</sup> Additionally, after registration and five consecutive years of continuous use, a trademark may become incontestable.<sup>41</sup> Finally, if a violation occurs, there are several generous remedies available to a federal registrant.<sup>42</sup> It is important to emphasize that the benefits and protections associated with federal registration are unavailable unless the mark’s owner successfully completes the registration process.<sup>43</sup>

If an individual wishes to register a trademark on the principal register, he or she must file an application with the United States Patent and Trademark Office (“PTO”).<sup>44</sup> After the applicant satisfies all of the filing requirements, an examiner begins reviewing the application.<sup>45</sup> The examiner will then determine, based on his or her review of the application, whether the mark is entitled to registration.<sup>46</sup> If it is entitled to registration, the PTO will publish the mark “in the Official Gazette.”<sup>47</sup>

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40. Pace, *supra* note 2, at 20; *see also* 15 U.S.C. § 1124.

41. *See* 15 U.S.C. § 1065. “Incontestability is conclusive evidence of ownership and validity of a mark[,] and it limits the defenses to an action brought for trademark infringement.” Pace, *supra* note 2, at 20 (footnote omitted). *See generally* Park ’N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189 (1985). This particular concept is not directly relevant for purposes of this Note; its inclusion serves only to highlight it as one of the many benefits that may be available to a federal registrant.

42. *See* 15 U.S.C. § 1114.

43. *See* Pace, *supra* note 2, at 21 (“Once regulation is *granted*, all of the benefits afforded federal registration attach, including the presumption that the trademark is valid.” (emphasis added)).

44. 15 U.S.C. § 1051. If the submitted application fails to satisfy the registration criteria for the principal register, the applicant may still be able to register the trademark on the supplemental register. *See id.* § 1091. To register the mark on the supplemental register, an applicant must be “capable of meeting [the principal register’s] requirements in the future.” Pace, *supra* note 2, at 20 n.81.

The principal register provides the registrant with several substantive rights (a luxury not afforded by the supplemental register); therefore, inclusion on the principal register is much more desirable to trademark owners. *See id.* “However, the [s]upplemental [r]egister does give the trademark owner access to the federal courts for infringement claims[,] and it could be a prerequisite for foreign registration since many countries require some form of registration in the applicant’s home country before they will protect a mark abroad.” *Id.*

It is important to note that “[t]he term ‘principal register’ refers to the register provided for by sections 1051 to 1072 of [title 15], and the term ‘supplemental register’ refers to the register provided for by sections 1091 to 1096 of th[at] title.” 15 U.S.C. § 1127. The remainder of this Note pertains to trademarks associated with the principal register.

45. 15 U.S.C. § 1062(a).

46. *Id.*

47. *Id.*

Conversely, if the examiner concludes that the mark is not fit for registration, the applicant has the option to reply or amend his or her application at some point within the following six months.<sup>48</sup> The applicant may also choose to appeal the examiner's decision to the Trademark Trial and Appeal Board ("TTAB").<sup>49</sup> After the correction of any application defects, the completion of any unsuccessful opposition proceedings, or the conclusion of any successful appeals, the examiner will register the mark.<sup>50</sup> Registration denotes the end of the federal registration process, but a registered trademark still remains vulnerable to attack and cancellation.<sup>51</sup>

During the first five years of a trademark's registration, people who believe that a trademark has damaged them (or will damage them in the future) can file a petition to challenge the mark's validity and cancel its registration.<sup>52</sup> After the first five years, a person can still file a petition to cancel a mark's registration—albeit in a more restricted fashion.<sup>53</sup> Once the first five years have passed, a person can file a petition to cancel the registration "if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to either the provisions of [15 U.S.C. §] 1054" or the prohibitions contained in "subsection (a), (b), or (c) of [15 U.S.C. §] 1052."<sup>54</sup>

Section 1052 (commonly and hereinafter referred to as "section 2") enumerates several restrictions to registration.<sup>55</sup> The restrictions contained in "subsections 2(a), (b), and (c) are absolute."<sup>56</sup> Section 2(a)—the focus of the *Harjo* and *Blackhorse* proceedings—calls for refusal or cancellation of a mark's registration if it "[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or

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48. *Id.* § 1062(b).

49. *Id.* § 1070.

50. *Id.* § 1063(b).

51. *See id.* § 1064 (outlining the cancellation process).

52. *Id.* § 1064(1)–(2).

53. *See id.* § 1064(3).

54. *Id.* There are, of course, other avenues for cancelling a mark's registration after the first five years have passed. *See id.* § 1064(4)–(5).

55. *See id.* § 1052. Because of their refusal to register trademarks pursuant to this provision, the PTO and its examiners have been dubbed the "niceness police." Will, *supra* note 1.

56. Pace, *supra* note 2, at 21–22.

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dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.”<sup>57</sup> Section 2(a) thus enumerates two distinct clauses: (1) the immoral, deceptive,<sup>58</sup> or scandalous clause; and (2) the disparagement clause. Scholars have repeatedly referenced and agreed on four specific justifications for these restrictions:

The federal government (1) “should not create the appearance that it favors or approves the use of [any] scandalous, immoral and disparaging trademarks”; (2) “should not squander its precious time and resources” on such marks; (3) “should promote the public health, welfare, and morals by discouraging the use” of them; and (4) “should protect the sensitivities of those in public who might be offended” by them.<sup>59</sup>

Despite the general agreement among scholars about these justifications, there are a number of other issues that remain open to scholarly interpretation.

Congress failed to provide much clarification about its intent regarding section 2(a).<sup>60</sup> The Lanham Act’s legislative history contains

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57. 15 U.S.C. § 1052(a). Some legislators have proposed amending this provision to include the following language:

“A mark consisting of or including the term ‘redskin’ or any derivation of the term ‘redskin’ shall be conclusively presumed to consist of matter which may disparage persons if (1) the mark has been, is, or is intended to be used in commerce in connection with references to or images of one or more Native American persons or peoples, or to Native American persons or peoples in general; or (2) the Director determines that the term as included in the mark is commonly understood to refer to one or more Native American persons or peoples, or to Native American persons or peoples in general.”

H.R. 684, 114th Cong. (2015). This proposal would become effective on the date of its enactment and would apply to “(1) any mark that is registered under the Trademark Act of 1946 before, on, or after such date; and (2) any application to register a mark under that Act that is pending on, or filed on or after, such date.” *Id.*

58. Deceptiveness is part of the provision’s first clause, but courts use it as a separate ground for refusal. *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1216 (T.T.A.B. 2010). In fact, it has a separate test that differs from the one used to determine whether a mark is immoral or scandalous—“terms that are typically discussed as though basically synonymous.” *Id.*

59. Megan M. Carpenter & Kathryn T. Murphy, *Calling Bulls\*\*t on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks*, 49 U. LOUISVILLE L. REV. 465, 468 (2011) (quoting Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 788 (1993)).

60. *Id.* at 467–68.

very little information about the congressional intent of section 2(a), and it fails to define the provision's key words—*scandalous*, *immoral*, and *disparaging*.<sup>61</sup> Therefore, when presiding over cancellation proceedings, reviewing entities are forced to speculate about congressional intent and the meanings of those key terms.<sup>62</sup> In fact, the TTAB has specifically noted that there are many “problems [with] making these content-based determinations.”<sup>63</sup> It has even referred to the statute's guidelines and terms as “somewhat vague” and “highly subjective.”<sup>64</sup> These problematic provisions have been major hurdles to effective interpretation and analysis, leading to the creation and modification of tests for each of section 2(a)'s clauses.<sup>65</sup> Unfortunately, these tests—as used in *Harjo* and *Blackhorse*—are no more useful than the two clauses they purport to interpret and satisfy.

### B. *Harjo: The Disparagement Standard Rears Its Ugly Head*

On September 10, 1992,<sup>66</sup> Suzan Shown Harjo and six other American Indians (“original petitioners”)<sup>67</sup> filed a petition with the PTO to cancel several registered trademarks related to the Washington Redskins and owned by Pro-Football, Inc. (“respondent”).<sup>68</sup> The original

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61. *Id.*; see also *Harjo I*, 50 U.S.P.Q.2d (BNA) 1705, 1735, 1737 (T.T.A.B. 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003). “[T]here is relatively little published precedent or legislative history to offer [the TTAB] guidance in interpreting the disparagement provision in [s]ection 2(a).” *Id.* at 1737.

62. Carpenter & Murphy, *supra* note 59, at 467–68.

63. *Id.* at 468; see also *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1736; *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990); *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1471 (T.T.A.B. 1988).

64. *In re Hershey*, 6 U.S.P.Q.2d (BNA) at 1471; see also *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1736; *In re In Over Our Heads*, 16 U.S.P.Q.2d at 1654–55 (“[I]n making our determination that applicant's mark is not scandalous or disparaging, we are not free of doubt. . . . Because the guidelines are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established.”).

65. See Carpenter & Murphy, *supra* note 59, at 467–68.

66. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1706 n.1.

67. *Id.* at 1707. The other original petitioners included Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr. *Id.*

68. See *id.* at 1707–08. Pro-Football, Inc. is “the corporate name of the Washington Redskins.” J. Gordon Hylton, *Before the Redskins Were the Redskins: The Use of Native American Team Names in the Formative Era of American Sports, 1857-1933*, 86 N.D. L.

petitioners asserted that the term *redskins*<sup>69</sup> is, and always has been, a racially offensive reference to American Indians.<sup>70</sup> Therefore, they claimed that each of the respondent's marks that included the term *redskins*, or a different variation of the same,<sup>71</sup> should be cancelled because those marks were scandalous; capable of bringing American Indians, including the original petitioners, into contempt or disrepute; and disparaging in violation of section 2(a) of the Lanham Act.<sup>72</sup>

The respondent's answer denied the petitioner's allegations and asserted that the term was more commonly understood as a reference to the secondary meaning that the term had acquired through its continued use in professional football.<sup>73</sup> Since the trademarks referred to the Washington Redskins, the respondent also asserted that it was not reasonable to associate the marks with the original petitioners or any group or organization with which the original petitioners were associated.<sup>74</sup> Therefore, the respondent claimed that the marks could not be classified as scandalous, capable of bringing the original petitioners into contempt or disrepute, or disparaging.<sup>75</sup> These arguments—related to scandalousness, contempt or disrepute, and disparagement—formed the three issues to be analyzed and answered.<sup>76</sup>

Prior to the *Harjo* litigation, the TTAB primarily used the scandalousness test to dispose of cases involving section 2(a).<sup>77</sup> Although scandalousness and its test are mostly outside the contours of this discussion, courts have struggled to divorce that concept from its section 2(a) counterpart (i.e., disparagement), frequently failing to

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REV. 879, 882 (2010).

69. In this Note, there are two variations of the term *redskins*: (1) the lowercased variation represents the term's generic, nonspecific form; and (2) the capitalized variation represents the term's use as a trademark or a sports-related moniker. Every use of the term throughout—whether lowercased or capitalized—should be read as including both the singular and plural forms of that particular variation.

70. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1708; see also Hylton, *supra* note 68, at 882.

71. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1707–08. The challenged marks included other variations of the term *redskins*, including *Washington Redskins* and *Redskinettes*—the term used for the team's cheerleaders. *Id.* at 1707.

72. *Id.* at 1708.

73. *Id.*

74. *Id.*

75. *Id.*

76. *Id.* at 1735; see also Justin Reiner, *Proud Traditions: Reflections of a Lifelong Washington Redskins Fan on the Harjo Decisions & the Use of Native American Names in Sports*, WILLAMETTE SPORTS L.J. 9 (Spring 2005), [http://www.willamette.edu/law/pdf/sportslaw/spring05/final\\_traditions.pdf](http://www.willamette.edu/law/pdf/sportslaw/spring05/final_traditions.pdf) [<http://perma.cc/S92G-7ZD5>].

77. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1735.

distinguish between the two tests.<sup>78</sup> To highlight the distinctions between the section 2(a) clauses and to ensure that they remain separate and independent throughout this analysis, it is important to provide a brief overview of scandalousness.<sup>79</sup>

Since Congress failed to provide definitions for section 2(a)'s key terms, the TTAB relies on the dictionary definition (i.e., the ordinary and common meaning) of the terms at the time of the enactment of the Lanham Act.<sup>80</sup> According to past opinions, the term *scandalous* at the time of the legislation's enactment was defined as being "[d]isgraceful to reputation" and "[g]iving offense to the conscience or moral feelings; exciting reprobation [and] calling out condemnation."<sup>81</sup> It was also defined as "shocking to the sense of truth, decency, or propriety; disgraceful, offensive; disreputable, as *scandalous* conduct."<sup>82</sup> Using these definitions as a starting point, the TTAB and the United States Court of Appeals for the Federal Circuit constructed the scandalousness test.<sup>83</sup>

Depending on the approach it chooses,<sup>84</sup> the reviewing entity may have to "consider the mark in the context of the marketplace as applied to only the goods described in [the] application for registration."<sup>85</sup> In

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78. Justin G. Blankenship, Case Note, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words That Offend?*, 72 U. COLO. L. REV. 415, 436 (2001). The Lanham Act clearly identifies disparagement as a "separate and distinct ground for refusing or canceling the registration of a mark under [s]ection 2(a)." *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1737. Therefore, the tendency to use these two tests interchangeably gives scandalousness an inappropriate place within the disparagement analysis. See Blankenship, *supra*.

79. "The predominant difference between the two analyses is that disparagement depends upon the mark's relation to a certain subject, which under the Lanham Act may be 'persons, living or dead, institutions, beliefs[,] or national symbols.'" Blankenship, *supra* note 78, at 436 (footnote omitted) (quoting 15 U.S.C. § 1052(a) (1994)); see also *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1735-40.

80. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1735.

81. *Id.* (quoting *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981)).

82. *Id.* (quoting *In re McGinley*, 660 F.2d at 486).

83. *Id.* at 1736.

84. There are two different approaches: "(1) the 'Rule of Association' approach; and (2) the 'Anti-Contextual Approach,' or the 'Per Se Rule.'" Blankenship, *supra* note 78, at 431 (footnote omitted). Under the Rule of Association, "a mark is not scandalous on its face, but it may become scandalous when placed in a certain context." *Id.*; see also *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938). On the other hand, the Per Se Rule disregards context and determines "whether the mark is scandalous on its face." Blankenship, *supra* note 78, at 433. See generally *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863 (T.T.A.B. 1981).

85. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1736 (quoting *In re Mavety Media Grp., Ltd.*,

addition, when determining whether a mark is composed of scandalous material, the reviewing entity must ascertain the “contemporary attitudes” of “a substantial composite of the general public,” which is “not necessarily a majority.”<sup>86</sup> Essentially, the test for determining when to classify a mark as scandalous is a two-pronged consideration of (1) “the likely meaning of the matter in question”<sup>87</sup> and (2) whether, in view of that meaning, “a substantial composite of the general public” considers the matter scandalous.<sup>88</sup>

“In *Harjo*, the [TTAB] adopted the ‘per se’ approach” for applying the scandalousness test.<sup>89</sup> The challenged marks were analyzed in isolation, essentially making their association with a professional football team meaningless.<sup>90</sup> In applying the first prong of the test, the TTAB assessed the likely meaning of *Redskins* and found that the word clearly alluded to American Indians.<sup>91</sup> The TTAB supported that conclusion by highlighting the designs and images found in the registered marks, namely, “the profile of a Native American and a Native American spear.”<sup>92</sup>

While this conclusion satisfied the first prong, the original petitioners failed to establish by a preponderance of the evidence that a substantial composite of the general public would classify the word as scandalous.<sup>93</sup> Indeed, the TTAB found a “clear acceptance by a substantial composite of the general population of the use of the word ‘Redskins’ as part of the name of respondent’s football team and in connection with its entertainment services, regardless of the derogatory nature of the word vis-a-vis Native Americans.”<sup>94</sup> As a result, the TTAB concluded that the

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33 F.3d 1367, 1371 (Fed. Cir. 1994)).

86. *Id.* (quoting *In re Mavety Media Grp.*, 33 F.3d at 1371).

87. *Id.* “[T]he meaning of the matter in question cannot be ascertained without considering (1) the relationship between that matter and any other element that makes up the mark in its entirety and (2) the goods and/or services and the manner in which the mark is used in the marketplace in connection with those goods and/or services.” *Id.*

88. *Id.* (quoting *In re Mavety Media Grp.*, 33 F.3d at 1371).

89. Blankenship, *supra* note 78, at 434; *see also supra* note 84.

90. Blankenship, *supra* note 78, at 434.

91. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1748.

92. *Id.*

93. *Id.* at 1748–49.

94. *Id.* at 1749. “[The] evidence include[d] the voluminous number of references, in both letters and news articles, to respondent’s football team by a substantial number of fans and the media over a long period of time from, at least, the 1940’s to the present.” *Id.* (footnote omitted).

challenged marks did *not* “consist of or comprise scandalous matter.”<sup>95</sup> The respondent successfully opposed the allegations of scandalousness; however, its marks were still vulnerable to cancellation via the disparagement theory.

The disparagement doctrine began developing—albeit narrowly—in a limited number of pre-*Harjo* cases.<sup>96</sup> It was not until *Harjo I* that the TTAB established and enumerated the current standard for a disparagement analysis.<sup>97</sup> As it did with scandalousness, the TTAB initiated the analysis by considering the term *disparage* within the context of its ordinary and common meaning.<sup>98</sup> Based on the available definitions, the TTAB concluded that when ascertaining whether a trademark is disparaging, the analysis must consider whether the mark “may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison”<sup>99</sup> any “persons, living or dead, institutions, beliefs, or national symbols.”<sup>100</sup> The TTAB then sought “to determine whether [the mark] may be disparaging . . . [by] undertak[ing] a two step process of considering, first, the likely meaning of the matter in question and, second, whether that meaning may be disparaging.”<sup>101</sup> From there, the TTAB shifted its focus to the major differences between scandalousness and disparagement<sup>102</sup> and then

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95. *Id.* “Such continuous renown in the sport . . . and acceptance of the word ‘Redskin(s)’ in connection with respondent’s football team is inconsistent with the sense of outrage by a substantial composite of the general population that would be necessary to find this word scandalous in the context of the subject marks . . .” *Id.*

96. *See generally In re Condas S.A.*, 188 U.S.P.Q. (BNA) 544, 544 (T.T.A.B. 1975) (reversing the examiner’s refusal to register the mark *Jap* for certain articles of clothing and supporting applicant’s contention that the term was not derogatory or capable of subjecting “Americans of Japanese ancestry to contempt, ridicule, or scandal”); *In re Reemtsma Cigarettenfabriken G.m.b.H.*, 122 U.S.P.Q. (BNA) 339, 339 (T.T.A.B. 1959) (denying the registration of the mark *Senussi* and holding that “[t]he application of the name of any religious order or sect to a product whose use is forbidden to the followers or adherents of such sect or order is an affront to such persons and tends to disparage their beliefs”); *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227, 227–28 (Patent Office Exam’r in Chief 1951) (concluding that the term *Dough-boy*, sought to be registered for a “prophylactic preparation,” was disparaging to American soldiers who were called “Doughboys” during World War I).

97. *See Harjo I*, 50 U.S.P.Q.2d at 1737–40.

98. *Id.* at 1737.

99. *Id.* at 1738.

100. 15 U.S.C. § 1052(a) (2012); *see also Harjo I*, 50 U.S.P.Q.2d (BNA) at 1738.

101. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1737.

102. *See id.* at 1738–39. Despite the TTAB’s passing nod to the differences associated with these concepts, the disparagement standard is largely constructed as a parallel to the scandalousness standard. *See id.* at 1735–40.

finalized a unique test that all subsequent disparagement cases would adopt and loosely utilize.<sup>103</sup>

Relying on a concededly deficient collection of precedent,<sup>104</sup> the TTAB decided to analyze all disparagement claims “in relation to the goods or services identified by the mark in the context of the marketplace.”<sup>105</sup> Furthermore, the analysis must include a consideration of “the relationship between the subject matter in question and the other elements that make up the mark in its entirety; the nature of the goods and/or services; and the manner in which the mark is used in the marketplace in connection with the goods and/or services.”<sup>106</sup> If these evaluations, which relate to the overall assessment of the meaning of the matter involved, indicate that the mark “refer[s] to an identifiable ‘[person or] persons, living or dead, institutions, beliefs, or national symbols,’” then the analysis proceeds to a second consideration—whether the mark is disparaging.<sup>107</sup> The analysis regarding whether the mark is disparaging focuses on what the trademark’s matter refers to and which views to consider.<sup>108</sup>

In *Harjo*, the TTAB assessed two different approaches.<sup>109</sup> The first approach, as used in *Greyhound Corp. v. Both Worlds, Inc.*,<sup>110</sup> considers the views and opinions of a “reasonable person of ordinary sensibilities.”<sup>111</sup> The second approach, as applied in *In re Hines*,<sup>112</sup> disregards the perceptions of the public and looks to the views and opinions of only the referenced group.<sup>113</sup> The TTAB favored the latter

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103. *See id.* at 1737–40; *see also infra* Section II.C.

104. *See Harjo I*, 50 U.S.P.Q.2d (BNA) at 1738 (“In seeking guidance for determining, under [s]ection 2(a), whether matter may be perceived as disparaging, we look to the limited precedent of the courts and the [TTAB] on the issue of disparagement, as well as to the previously enunciated precedent on the related issue of scandalousness.”); *see also id.* at 1737 (“[T]here is relatively little published precedent . . . to offer [the TTAB] guidance in interpreting the disparagement provision in [s]ection 2(a).”).

105. *Id.* at 1738.

106. *Id.* at 1739.

107. *Id.* (quoting 15 U.S.C. § 1052(a) (1994)).

108. *See id.*

109. *See id.* at 1739–40.

110. *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988).

111. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1739–40 (quoting *Greyhound*, 6 U.S.P.Q.2d (BNA) at 1639).

112. *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1688 (T.T.A.B.), *vacated on other grounds*, 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994).

113. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1739.

approach and concluded that the analysis for ascertaining whether a mark is disparaging must include a consideration of the group referenced by the trademark and the views of that referenced group, not those of the general population.<sup>114</sup>

In sum, the *Harjo I* test for disparagement claims requires two assessments: (1) the meaning of the matter involved—based on a consideration of “the relationship between the subject matter in question and the other elements that make up the mark in its entirety; the nature of the goods and/or services; and the manner in which the mark is used in the marketplace in connection with the goods and/or services”—and (2) if that meaning “refer[s] to an identifiable ‘[person or] persons, living or dead, institutions, beliefs, or national symbols,’” it must be disparaging to a substantial composite of the referenced group.<sup>115</sup> These assessments “are to be answered as of the dates of registration of the [challenged] marks.”<sup>116</sup> To be sure, this test is simply a loose variation of the previously enunciated scandalousness standard.<sup>117</sup>

Applying these new, less-than-dependable guidelines to *Harjo I*, the TTAB first determined that the marks in question clearly referred or alluded to American Indians even though the word *Redskins* had acquired a secondary meaning<sup>118</sup> based on its association with a professional football team.<sup>119</sup> The TTAB applied this conclusion to each of the relevant time periods—the years of registration for each trademark (1967, 1974, 1978, and 1990)—and extended it to the time of

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114. *Id.* at 1740.

The standard in [*Greyhound*], namely, the perception of a “reasonable person of ordinary sensibilities,” may be appropriate in cases involving alleged disparagement of individuals or commercial entities. However, the standard enunciated in *In re Hines*, namely, the perceptions of “those referred to, identified or implicated in some recognizable manner by the involved mark,” is appropriate for determining whether matter may disparage a non-commercial group, such as a religious or racial group, or beliefs or national symbols.

*Id.* (citation omitted) (first quoting *Greyhound*, 6 U.S.P.Q.2d at 1639; then quoting *In re Hines*, 31 U.S.P.Q.2d at 1688).

115. *Id.* at 1739 (quoting 15 U.S.C. § 1052(a) (1994)); see also *id.* at 1740–41.

116. *Id.* at 1741 (emphasis omitted).

117. See *supra* pp. 395–400.

118. *Harjo I*, 50 U.S.P.Q.2d (BNA) at 1741–42. The term *secondary meaning* indicates that a word has developed another connotation in addition to its original, generally accepted meaning. In this case, the TTAB found that the term *redskins* could reasonably refer to (1) American Indians or (2) the professional football team—the Washington Redskins. See *id.*

119. *Id.* at 1742.

litigation.<sup>120</sup> In the second part of its analysis (i.e., whether the matter involved was disparaging to a substantial composite of American Indians), the TTAB began by concluding that there was not enough evidence to classify the respondent's logos, namely, the spear and the profile portrait, as matter capable of disparaging American Indians.<sup>121</sup> However, it reached the opposite conclusion regarding the term *redskins* as used in conjunction with the respondent's marks and services.<sup>122</sup>

In reaching this conclusion, the TTAB first considered survey evidence that included the general public's views of the term *redskins*<sup>123</sup> and found it reasonable to infer that a substantial composite of American Indians shared those views.<sup>124</sup> Then, turning its attention to dictionary evidence, the TTAB found that about half of the dictionaries in the record contained a usage label classifying the term as an offensive, informal, or slang term.<sup>125</sup> Based on these dictionaries, it concluded that many members of the general populace have understood the term to be an offensive name for American Indians "since at least 1966."<sup>126</sup> In addition, relying on linguistic testimony, the TTAB concluded that the term carried a derogatory meaning during the late 1800s and early 1900s.<sup>127</sup> The evidence also indicated that the term became increasingly associated with the Washington Redskins "[f]rom the 1950's forward," achieving minimal use "as a reference to Native Americans."<sup>128</sup> But the TTAB attributed the term's minimal usage "as a synonym for 'Indian' or 'Native American'" to the general public's perception of the term as pejorative.<sup>129</sup>

Ultimately, the TTAB extended its finding—that the word *redskins* carried a derogatory or pejorative connotation—to the term as utilized by

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120. *Id.*

121. *Id.* at 1743 ("There [was] no evidence that th[o]se graphics [were] used in a manner that may be perceived as disparaging, or that a substantial composite of the Native American population in the United States so perceives these graphics as used in the subject marks in connection with the identified services.").

122. *Id.* at 1743–44.

123. *Id.* at 1745. "When read a list of seven words referring to Native Americans, 46.2% of participants in the general population sample . . . indicated that they found the word 'redskin' offensive as a reference to Native Americans." *Id.*

124. *Id.* at 1744–46.

125. *Id.* at 1744.

126. *Id.*

127. *Id.* at 1744–45.

128. *Id.* at 1745.

129. *Id.*

the respondent.<sup>130</sup> It found that the respondent's use of the term "may be disparaging . . . to a substantial composite of [American Indians]."<sup>131</sup> In support of this conclusion, the TTAB noted that the media and fans associated with the Washington Redskins acted "in a manner that often portray[ed] Native Americans as either aggressive savages or buffoons."<sup>132</sup> Despite acknowledging that the respondent was not responsible for such behavior, the TTAB considered this evidence as "probative of the *general public's* perception,"<sup>133</sup> seemingly adhering to the *Greyhound* standard that it explicitly rejected. For further support, the TTAB referenced several resolutions from the National Congress of American Indians ("NCAI"),<sup>134</sup> various news articles, a letter urging the team to change its name, and a 1972 meeting between eight American Indian representatives and the team's owner at the time, Edward Bennett Williams.<sup>135</sup>

Despite the problematic nature of the available evidence,<sup>136</sup> which included the results of a public-sentiment survey, dictionary definitions, and linguistic testimony about the use and meaning of the term throughout history and in the media,<sup>137</sup> the TTAB concluded that the respondent's marks, when analyzed within the relevant time periods, might disparage a substantial composite of American Indians.<sup>138</sup> It also used its disparagement analysis to determine "that the marks in each of the challenged registrations consist[ed] of or comprise[d] matter, namely, the word or root word, 'Redskin,' which may bring Native Americans into contempt and disrepute."<sup>139</sup> Accordingly, after many years of

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130. *Id.* at 1748.

131. *Id.*

132. *Id.* at 1747.

133. *Id.* (emphasis added).

134. "Throughout modern history, [the] NCAI has served as the unified force to protect against regular attempts, both unintentional and deliberate, to . . . dilute the intrinsic sovereign rights of tribal nations." *Seventy Years of NCAI*, NAT'L CONGRESS OF AM. INDIANS, <http://www.ncai.org/about-ncai/mission-history/seventy-years-of-ncai> [<http://perma.cc/K7ZH-V5R6>] (last visited Nov. 6, 2015).

135. *See Harjo I*, 50 U.S.P.Q.2d (BNA) at 1724, 1747.

136. In *Harjo II*, the district court highlighted the problematic nature of the evidence. *See Harjo II*, 284 F. Supp. 2d 96, 135 (D.D.C. 2003). One of the problems was the TTAB's failure to address or give weight to the different ways that the target population viewed the name. Instead, it simply highlighted "the existence of a controversy[, which] does not inform the [c]ourt as to whether the trademarks at issue are perceived of as disparaging by a substantial composite of Native Americans." *Id.*

137. *See Harjo I*, 50 U.S.P.Q.2d (BNA) at 1743-48.

138. *See id.* at 1748.

139. *Id.*

litigation, the TTAB stripped each of the respondent's challenged trademarks of their federal registrations.<sup>140</sup>

The respondents subsequently appealed the TTAB's ruling to the United States District Court for the District of Columbia, requesting de novo review in accordance with 15 U.S.C. § 1071(b).<sup>141</sup> After some preliminary hearings,<sup>142</sup> including a denial of the original petitioners' motion for judgment on the pleadings,<sup>143</sup> the court appeared poised and ready to address the merits of the case.<sup>144</sup> In *Harjo II*, Judge Kollar-Kotelly wasted little time in expressing her intention to avoid the "thicket of public policy" associated with the long-drawn-out litigation.<sup>145</sup> The court assessed only the evidentiary sufficiency of the TTAB's conclusions and whether the equitable defense of laches was available and appropriate.<sup>146</sup> After reviewing the entire record, "the [c]ourt conclude[d] that the TTAB's decision must be reversed."<sup>147</sup>

Before delving into that analysis, however, the court expressed its agreement with the required standard of proof,<sup>148</sup> the approaches chosen for analysis,<sup>149</sup> and the two-step test for disparagement.<sup>150</sup> Moreover, the court agreed that the respondent's use of the marks—especially those containing the spear and the profile portrait—referred or alluded to both the Washington Redskins and American Indians, finding that there was substantial evidence to support that conclusion.<sup>151</sup> Despite the agreement in these areas, the court found that the TTAB's overall conclusion

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140. *Id.* at 1749.

141. *Harjo II*, 284 F. Supp. 2d at 100; *see also* 15 U.S.C. § 1071(b) (2012).

142. *See generally* Pro-Football, Inc. v. Harjo (*Harjo Preliminary III*), 191 F. Supp. 2d 77 (D.D.C. 2002); Pro-Football, Inc. v. Harjo (*Harjo Preliminary II*), 57 U.S.P.Q.2d (BNA) 1140 (D.D.C. 2000).

143. *See Harjo Preliminary II*, 57 U.S.P.Q.2d (BNA) at 1141–42.

144. *See Harjo II*, 284 F. Supp. 2d at 99.

145. *Id.* The court indicated that its disposition of the case "should *not* be interpreted as reflecting, one way or the other, [the] [c]ourt's views as to whether the use of the term 'Washington Redskins' may be disparaging to Native Americans." *Id.*

146. *See id.* at 101–02.

147. *Id.* at 99.

148. *See id.* at 122.

149. *Id.* at 124. This is another example of a reviewing entity improperly conflating the scandalousness and disparagement tests. *See id.* ("After acknowledging the dearth of precedent to guide their hand in interpreting the disparagement clause of section 2(a), the TTAB approached the task as it would a charge of scandalousness under section 2(a). No party dispute[d] [that] approach and the [c]ourt finds no error in treating the two as similar for purposes of developing a conceptual framework." (citations omitted)).

150. *See id.* at 125.

151. *See id.* at 126–27.

regarding disparagement was “unsupported by substantial evidence[,] . . . logically flawed, and fail[ed] to apply the correct legal standard to its own findings of fact.”<sup>152</sup>

The court based its conclusion on a number of factors. Specifically, it discounted the linguistic expert testimony and the survey evidence—acquired approximately six years after the relevant time period<sup>153</sup>—as incapable of directly proving disparagement.<sup>154</sup> Ultimately, the court concluded that “[n]one of the findings of fact made by the TTAB [helped] to prove or disprove that the marks at issue ‘may disparage’ Native Americans, during the relevant time frame, especially when used in the context of [the respondent’s] entertainment services.”<sup>155</sup> The court also indicated that “many of [those] findings . . . simply summarized undisputed testimony.”<sup>156</sup> In other words, the TTAB made several “findings of fact [that] never involved weighing conflicting evidence or addressing [evidentiary] criticisms.”<sup>157</sup> Therefore, the court classified the overall declaration of disparagement as “inferential”<sup>158</sup> and concluded that the finding was incapable of “withstand[ing] even the deferential level of judicial scrutiny provided by the substantial evidence test.”<sup>159</sup> For purposes of clarity, the court went on to explain the deficiencies associated with each piece of evidence.

At the outset of that analysis, the district court criticized the TTAB for “focusing on the general public and inferring that the Native Americans would simply agree with those views.”<sup>160</sup> The court made it a priority to emphasize that those two views were “distinct,” stating that “the views of the Native Americans on this issue were not congruent

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152. *Id.* at 125–26.

153. *See id.* at 131–32.

154. *See id.* at 132.

155. *Id.* at 127.

156. *Id.* at 128.

157. *Id.*

158. *Id.* at 102 n.4 (“[T]he TTAB’s approach is problematic because the TTAB states that its entire legal conclusion is premised on ‘the cumulative effect of the *entire* record.’ However, by making minimal findings on the disputed evidence and focusing almost exclusively on the undisputed portion of the record, the TTAB’s finding of disparagement is supported by inferential fact-based judgments, unsubstantiated with concrete evidentiary proof.” (citation omitted) (quoting *Harjo I*, 50 U.S.P.Q.2d (BNA) 1705, 1743 (T.T.A.B. 1999) (emphasis added), *rev’d*, 284 F. Supp. 2d 96 (D.D.C. 2003))).

159. *Id.*

160. *Id.* at 129 (“By concluding that the views of the general public were probative, the TTAB erred.”).

with that of the population as a whole.”<sup>161</sup> The TTAB’s decision to partially rely on the views of the general public was based on a lack of evidence to the contrary.<sup>162</sup> In other words, it essentially turned a blind eye to the weakness of the original petitioners’ case, gave weight to the views of the general public, and impermissibly shifted the burden of proof to the respondent.<sup>163</sup> The TTAB did this despite the fact that the disparagement standard delineates the pertinent legal inquiry as a substantial composite of the referenced group, not society as a whole.<sup>164</sup> Thus, the court seemingly ignored its previous rejection of the “general populace” consideration from *Greyhound*.<sup>165</sup> The court also criticized the TTAB for failing to consider or provide independent, supplementary evidence—other than the original petitioners’ testimony—to support its ultimate conclusion.<sup>166</sup> The testimony of the seven original petitioners alone was clearly insufficient to “constitute a ‘substantial composite’ of Native Americans.”<sup>167</sup> Despite the plethora of evidentiary problems, the TTAB tried to support its conclusion by providing evidence of the term’s dictionary and historical meanings.<sup>168</sup>

With regard to the dictionary evidence, the court found several problems.<sup>169</sup> First, there was no evidence in the trial record to explain “the purpose and methodology for including usage labels in dictionaries.”<sup>170</sup> Moreover, since dictionaries often include or represent general perceptions, the TTAB again placed an impermissible reliance on the views of the general public.<sup>171</sup> Perhaps most importantly, the usage labels referred to the term as “usually offensive.”<sup>172</sup> That language indicates that there are certain contexts where the term would not be

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161. *Id.* at 128.

162. *Id.* at 129.

163. *See id.*

164. *Id.* at 128–29. “As the [TTAB] itself stated . . . ‘it is only logical that, in deciding whether the matter may be disparaging, we look, not to American society as a whole, as determined by a substantial composite of the general population, but to the views of the referenced group.’” *Id.* at 128 (quoting *Harjo I*, 50 U.S.P.Q.2d (BNA) 1705, 1739 (T.T.A.B. 1999) (emphasis added), *rev’d on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003)).

165. *See Harjo I*, 50 U.S.P.Q.2d (BNA) at 1740.

166. *Harjo II*, 284 F. Supp. 2d at 129.

167. *Id.*

168. *See id.* at 130–32.

169. *Id.* at 130–31.

170. *Id.* at 130.

171. *See id.* at 130–31.

172. *Id.* at 130.

offensive.<sup>173</sup> However, the TTAB did “not [include] a discussion of [that] possibility in [its] opinion.”<sup>174</sup>

As for the historical evidence, the court found that there was no support for the finding that the term’s diminished use was the result of a pejorative status.<sup>175</sup> The court also stated that the pertinent legal inquiry should focus on the disparaging nature of the term, not whether the term itself is pejorative.<sup>176</sup> Therefore, the court found a lack of support for the conclusions related to both the dictionary evidence and the historical evidence.<sup>177</sup>

The court also discredited the TTAB’s reliance on the other pieces of evidence, including the NCAI resolutions.<sup>178</sup> Specifically, the resolutions were discredited because each one of them came “after the relevant time frame.”<sup>179</sup> With “no explanation” to connect the resolutions with the applicable time frame, the court held that each resolution was “irrelevant to the calculus.”<sup>180</sup> The biggest problem, however, was the lack of substantial evidentiary support for the TTAB’s decision to equate the nature of the term *redskins* (in its generic form) with the respondent’s use of the term as the official name of a professional football team.<sup>181</sup>

The TTAB concluded “that because the *word* ‘redskin(s)’ may be viewed by Native Americans as derogatory when used as a reference for Native Americans, the trademarks [were] disparaging [merely] because they use that word.”<sup>182</sup> The court determined, however, that the evidence offered in support of that conclusion did not constitute a substantial composite of American Indians.<sup>183</sup> Ultimately, the court reversed the TTAB’s decision because it was “not supported by substantial evidence.”<sup>184</sup> Irrespective of that dispositive conclusion, the court’s analysis did not stop there.<sup>185</sup>

The court also issued an alternative conclusion, finding that the

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173. *Id.*

174. *Id.*

175. *Id.* at 132.

176. *Id.* at 131.

177. *Id.* at 131–32.

178. *Id.* at 135.

179. *See id.*

180. *Id.*

181. *See id.* at 133.

182. *Id.*

183. *See id.* at 135–36.

184. *Id.* at 136.

185. *See id.*

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equitable “defense of laches . . . also preclude[d] the cancellation of the [respondent’s] six trademarks.”<sup>186</sup> Although the court’s laches discussion has proven to be incredibly controversial,<sup>187</sup> the respondent was entitled to utilize the defense due to the original petitioners’ extensive delay in filing the lawsuit.<sup>188</sup> Overall, having found two sufficient grounds for disposition of the case—a disparagement finding not supported by substantial evidence and the equitable doctrine of laches—the court granted summary judgment for the respondent on its first, second, and fifth claims.<sup>189</sup>

The original petitioners appealed the district court’s decision to the United States Court of Appeals for the District of Columbia Circuit.<sup>190</sup> There, the court concluded that the district court erred in its application of the laches argument.<sup>191</sup> Specifically, it found “that the district court mistakenly started the clock for assessing laches in 1967—the time of the first mark’s registration—for *all* seven [original petitioners], even though one, Mateo Romero, was at that time only one year old.”<sup>192</sup> The court, therefore, remanded the case for determination of whether laches barred Romero’s claim.<sup>193</sup>

On remand, the district court found that “Romero waited almost eight years—seven years, nine months, to be precise—after reaching the age of majority before petitioning to cancel the six trademarks in question.”<sup>194</sup> That delay, according to the court, was unreasonable and

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186. *Id.*

187. *See, e.g.,* John R. Wallace, Note, *Discriminatory & Disparaging Team Names, Logos, & Mascots: Workable Challenges & the Misapplication of the Doctrine of Laches*, 12 RUTGERS RACE & L. REV. 203, 228 (2011) (“[T]he most troubling part of the ruling by the [d]istrict [c]ourt is that the common law affirmative defense of the doctrine of laches applies to discriminatory marks in this respect.”).

188. *See Harjo II*, 284 F. Supp. 2d at 136–44.

189. *Id.* at 145. Summary judgment was granted for the following claims: (1) The respondent’s “trademarks [did] not and will not disparage Native Americans”; (2) the respondent’s “trademarks [did] not and will not bring Native Americans into contempt or disrepute”; and (3) laches. *Id.* at 101–02. Since the court believed it was unnecessary to address the respondent’s other assertions, which included constitutional claims, they became moot. *Id.* at 145.

190. *Pro-Football, Inc. v. Harjo (Harjo III)*, 415 F.3d 44, 46 (D.C. Cir. 2005) (per curiam).

191. *Id.* at 48.

192. *Id.*

193. *Id.* at 50.

194. *Pro-Football, Inc. v. Harjo (Harjo IV)*, 567 F. Supp. 2d 46, 53–54 (D.D.C. 2008), *aff’d*, 565 F.3d 880 (D.C. Cir. 2009).

“demonstrate[d] a lack of diligence on his part.”<sup>195</sup> In addition, the court indicated that his delay so prejudiced the respondent “that it would be inequitable to allow” the request for cancellation of the trademarks’ registrations to continue.<sup>196</sup> As a result, the court once again granted summary judgment in favor of the respondent.<sup>197</sup> The District of Columbia Circuit eventually affirmed that decision,<sup>198</sup> and the United States Supreme Court denied certiorari—effectively ending the long-drawn-out *Harjo* litigation.<sup>199</sup> It is important to note that because the laches defense brought about the ultimate disposition of *Harjo*, the courts never addressed the deficiencies of the newly enunciated disparagement standard.<sup>200</sup> The lack of judicial scrutiny regarding this standard indirectly encouraged the TTAB to use it in future disparagement cases.

*C. The TTAB’s Application of the Disparagement Standard  
Between Harjo and Blackhorse*

During and after *Harjo*, the TTAB continued to evaluate disparagement claims without ever fully addressing the standard’s weaknesses and limitations. The following line of cases illustrates this point and provides some insight into the TTAB’s analytical approach under the current standard.

In *Order Sons of Italy in America v. Memphis Mafia, Inc.*, a fraternal order for Italian Americans (“Order”) sought to cancel the trademark *The Memphis Mafia* pursuant to section 2(a) of the Lanham Act.<sup>201</sup> It claimed that Italians and Italian Americans hate the term *mafia* and believe it to be offensive and insulting.<sup>202</sup> It also asserted that “call[ing] an honest Italian or Italian American a member of any ‘Mafia’ is a grave insult that

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195. *Id.* at 62.

196. *Id.*

197. *Id.*

198. See *Pro-Football, Inc. v. Harjo (Harjo V)*, 565 F.3d 880, 886 (D.C. Cir. 2009), *aff’g* 567 F. Supp. 2d 46 (D.D.C. 2008).

199. *Harjo v. Pro-Football, Inc. (Harjo VI)*, 558 U.S. 1025 (2009) (mem.), *denying cert. to* 565 F.3d 880. See Petition for Writ of Certiorari, *Harjo VI*, 558 U.S. 1025 (2009) (mem.) (No. 09-326), 2009 WL 2953014, for the bases on which the original petitioners sought certiorari.

200. See *Harjo IV*, 567 F. Supp. 2d at 52–53, 62; see also *Blackhorse II*, No. 1:14-cv-01043-GBL-IDD, 2015 WL 4096277, at \*4 (E.D. Va. July 8, 2015) (“The D.C. Circuit never addressed the TTAB’s finding of disparagement on the merits.”).

201. *Order Sons of It. in Am. v. Memphis Mafia, Inc.*, 52 U.S.P.Q.2d (BNA) 1364, 1365 (T.T.A.B. 1999).

202. See *id.*

disparages the character . . . of the individual by labeling him or her a criminal.”<sup>203</sup> Therefore, the Order petitioned for cancellation of the trademark because its use<sup>204</sup> allegedly “disparage[d] the members of the Order and br[ought] the Order as an institution into contempt or disrepute.”<sup>205</sup> In support of these allegations, the Order submitted a variety of uncontested evidentiary materials: (1) a letter from the Department of Justice, articulating an intention to avoid using the term *mafia* because of its disparaging nature;<sup>206</sup> (2) several comparable marks that were challenged as disparaging and denied registration;<sup>207</sup> (3) a survey indicating that a high percentage of the public associated organized crime with Italians;<sup>208</sup> and (4) testimony of three expert witnesses, confirming that the mark at issue “disparage[d] the members of the Order and br[ought] the Order as an institution into contempt and disrepute . . . and that it [would] have a negative impact on not only members of the Order, but all Americans of Italian descent.”<sup>209</sup>

In reaching its conclusion, the TTAB applied the new disparagement standard from *Harjo I.*<sup>210</sup> First, it considered “the likely meaning of the term,” taking judicial notice of several dictionary definitions.<sup>211</sup> Despite finding the predominant meaning of the term to be “that of a secret[, criminal] organization of Italian origin,” the TTAB said it was not “offensive or disparaging per se to any ethnic group.”<sup>212</sup> Moreover, “there [was] no connection whatsoever between [the] respondent’s entertainment services and the dictionary definition of” the term.<sup>213</sup> The only relevant meaning of the term, as it related to the trademark owner’s services, was an “exclusive, or small and powerful, group or clique.”<sup>214</sup>

Ultimately, the TTAB concluded that the term *mafia* was not always

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203. *Id.*

204. The owner used the trademark in connection with entertainment services (e.g., giving talks about popular music and music personalities, such as Elvis Presley). *Id.* at 1368–69.

205. *Id.* at 1365.

206. *Id.* at 1366.

207. *See id.*

208. *See id.* at 1367.

209. *Id.*

210. *Id.* at 1368.

211. *Id.*

212. *Id.* Indeed, the Order conceded that the word was appropriate and accurate when used in reference “to the specific international criminal organization.” *Id.*

213. *Id.* at 1369.

214. *Id.*

“a slur to the Italian-American ethnic group.”<sup>215</sup> In reaching this decision, the TTAB rejected the testimony of the Order’s “said to be experts” because they were actively involved in the Order; as a result, “[their] testimony [was] considered as potentially self-serving in nature and not necessarily as probative as, for example, the opinion of an [unassociated] expert witness.”<sup>216</sup> Moreover, the TTAB indicated that it must “reach its own conclusions with respect to the ultimate issue of disparagement, rather than relying upon the opinions of witnesses.”<sup>217</sup> Accordingly, it concluded that *mafia*, based on its use in the challenged trademark, was not disparaging to “either the members of the Order or Italian-Americans in general.”<sup>218</sup>

In *In re Squaw Valley Development Co.*, the trademark examiner refused to register two trademarks—*Squaw* and *Squaw One*—pursuant to section 2(a) of the Lanham Act.<sup>219</sup> The applicant, Squaw Valley Development Company,<sup>220</sup> sought to register these marks in connection with a variety of goods and services, including clothing, ski equipment, and retail store services.<sup>221</sup> Although the examiner initially denied the marks’ registrations, the TTAB reversed that decision for each of the proposed uses.<sup>222</sup>

In its analysis, the TTAB applied the *Harjo I* test.<sup>223</sup> With respect to the test’s first prong, the TTAB determined that *Squaw* and *Squaw One* were being “used in connection with the applicant’s” clothing and retail stores<sup>224</sup> in a way that meant or referred to “an American Indian woman or wife,” not the applicant or its actual resort.<sup>225</sup> The analysis continued with a determination of “whether [that] meaning may be disparaging to a substantial composite of Native Americans.”<sup>226</sup> After concluding that

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215. *Id.*

216. *Id.*

217. *Id.* (citing *Saab-Scania Aktiebolag v. Sparkomatic Corp.*, 26 U.S.P.Q.2d (BNA) 1709 (T.T.A.B. 1993)).

218. *Id.*

219. *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d (BNA) 1264, 1266 (T.T.A.B. 2006).

220. The applicant was the owner of *Squaw Valley*—the trademark for men’s, women’s, and children’s winter wear—and *Squaw Valley USA*—the trademark for various lodging and transportation services. *Id.* at 1266–67.

221. *Id.* at 1266.

222. *Id.* at 1267.

223. *Id.*

224. *Id.* The meaning of the matter involved, as used in connection with the skiing-related goods, referred either to the applicant or its resort. *Id.*

225. *Id.* at 1272.

226. *Id.*

there was no evidence to sustain a finding of that nature, the TTAB reversed the examiner's refusal to register.<sup>227</sup> Relying on *In re Ferrero S.p.A.*,<sup>228</sup> the examiner sought reconsideration of that decision.<sup>229</sup>

On reconsideration, the TTAB indicated that the examiner originally met a higher-than-necessary evidentiary burden for satisfying the first prong of the disparagement analysis.<sup>230</sup> Therefore, it refused to reassess its original conclusion—that the meaning of the matter involved, as utilized in connection with the clothing and retail stores, referred to “an American Indian woman or wife.”<sup>231</sup> It did, however, reconsider its analysis of the test's second prong with respect to these goods and services.<sup>232</sup> In doing so, the TTAB classified the available evidence (including newspaper articles and personal statements that highlighted the offensive and disparaging nature of the term)<sup>233</sup> as “sufficient to establish prima facie that applicant's marks disparage[d] a substantial composite of Native Americans when used in the context of applicant's goods and services.”<sup>234</sup> The applicant was able to rebut this evidence for the skiing-related goods, demonstrating that the likely meaning in that particular context referred only to the applicant or its actual resort.<sup>235</sup> The applicant was unable, however, to rebut the examiner's evidence with respect to the clothing and retail stores; therefore, the TTAB concluded that those marks were disparaging.<sup>236</sup>

The next disparagement case—*In re Heeb Media, L.L.C.*—involved a self-disparaging trademark.<sup>237</sup> While this type of case is factually

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227. *Id.* at 1267 (“[T]here [was] no evidence in the record that a substantial composite of Native Americans [found] applicant's use of its marks on its identified goods and services disparaging.” (first alteration in original) (quoting *In re Squaw Valley Dev. Co.*, Serial Nos. 76511144 & 76511145, 2005 WL 2543626, at \*13 (T.T.A.B. Sept. 26, 2005), *aff'd in part, rev'd in part on reconsideration*, 80 U.S.P.Q.2d (BNA) 1264 (T.T.A.B. 2006))).

228. *In re Ferrero S.p.A.*, 24 U.S.P.Q.2d (BNA) 1061 (T.T.A.B. 1992) (authorizing an examiner to seek reconsideration of a TTAB decision).

229. *In re Squaw Valley Dev.*, 80 U.S.P.Q.2d (BNA) at 1266.

230. *Id.* at 1272.

231. *Id.*

232. *See id.* at 1272–77.

233. *See id.*

234. *Id.* at 1276.

235. *See id.* at 1282.

236. *See id.* at 1279, 1282.

237. *See In re Heeb Media, L.L.C.*, 89 U.S.P.Q.2d (BNA) 1071, 1075 (T.T.A.B. 2008); *see also In re Tam*, 108 U.S.P.Q.2d (BNA) 1305, 1311 (T.T.A.B. 2013) (highlighting applicant's argument that he “intentionally adopted the mark because it is disparaging to some, [and the TTAB] should ignore that because he is [in the referenced

different than a disparagement case, it still incorporates the same test and helps illustrate the test's weaknesses and limitations.<sup>238</sup> In fact, the test's failures are seemingly accentuated in a situation where a member of the referenced group seeks to register the mark.<sup>239</sup> The applicant in this case, Heeb Media, L.L.C., filed an application to register the trademark *Heeb* for various types of clothing and entertainment services.<sup>240</sup> Despite the fact that the applicant already owned a similar mark,<sup>241</sup> the examiner denied the newly filed application because the trademark was "disparaging to a substantial composite of the referenced group, namely, Jewish people."<sup>242</sup> In reaching this decision, the examiner relied on several dictionary definitions and personal statements that classified the term as informal and offensive.<sup>243</sup>

On appeal, the TTAB—applying the *Harjo I* test—added that a finding of disparagement "must be determined from the standpoint of a substantial composite of the referenced group (although not necessarily a majority) in the context of *contemporary* attitudes."<sup>244</sup> This language differs from that of previous case law, which called for an assessment of the marks *at the time of registration*.<sup>245</sup> Despite this patent disparity, the

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group] and should not be perceived as intending to disparage other [members of the group] but, rather, as redefining the term in a positive way"), *aff'd*, 785 F.3d 567 (Fed. Cir.), *vacated per curiam*, 600 F. App'x 775 (Fed. Cir. 2015) (mem.); Todd Anten, Note, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388, 412 (2006) ("The applicant's purposeful use of a [self-disparaging trademark] is . . . persuasive evidence that the [mark] is no longer disparaging in all situations—the mark is transforming into a contextually disparaging mark that might not disparage a 'substantial composite' of the referenced group, depending on the context of use.").

238. See *In re Heeb Media*, 89 U.S.P.Q.2d (BNA) at 1074; see also Anten, *supra* note 237, at 410.

239. See Anten, *supra* note 237, at 410, 415–21.

240. *In re Heeb Media*, 89 U.S.P.Q.2d (BNA) at 1071–72.

241. *Id.* at 1072. The applicant owned a magazine entitled *Heeb*. Nevertheless, the court noted that it had to "determine how the term . . . [would] be perceived in connection with the goods and services listed in [the] application, which do not include magazines." *Id.*

242. Examining Attorney's Appeal Brief, *In re Heeb Media*, 89 U.S.P.Q.2d (BNA) 1071 (Serial No. 78558043), 2008 WL 8703458; see also *In re Heeb Media*, 89 U.S.P.Q.2d (BNA) at 1072.

243. See *In re Heeb Media*, 89 U.S.P.Q.2d (BNA) at 1072–73.

244. *Id.* at 1074 (emphasis added).

245. *Harjo I*, 50 U.S.P.Q.2d (BNA) 1705, 1735 (T.T.A.B. 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003) ("The [TTAB] must decide whether, *at the times* respondent was issued each of its challenged registrations, the respondent's registered marks consisted of or comprised scandalous matter, or matter which may

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TTAB commenced its disparagement analysis by noting that there was no dispute about the likely meaning of the term.<sup>246</sup> Indeed, the term referred to “a Jewish person and . . . has no other meaning pertinent to clothing or entertainment services.”<sup>247</sup> Moreover, neither the mark’s use in the marketplace nor any of its elements could be understood as altering that meaning.<sup>248</sup>

Turning to the second prong of the analysis, the TTAB collected several dictionary definitions of the term at issue.<sup>249</sup> However, it placed a unique focus on one specific dictionary—the *Cassell Dictionary of Slang*—finding “that, in referenc[e to] Jewish persons, the term [does not have] a separate non-derogatory character.”<sup>250</sup> In addition, the applicant’s own evidence indicated that the term was not completely “unobjectionable” among the “relevant public.”<sup>251</sup> Rather, there were disparate views about whether the term retained a disparaging character in the context of its use.<sup>252</sup>

Consequently, the TTAB relied on the “substantial composite” analysis to “balance [these] competing views within the referenced group.”<sup>253</sup> It highlighted the fact that such an analysis does not require “a fixed number or percentage” and does not have to equal a majority.<sup>254</sup> Continuing under that rationale, the TTAB found that because some of

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disparage [members of the referenced group], or matter which may bring [them] into contempt or disrepute.” (emphasis added)).

246. *In re Heeb Media*, 89 U.S.P.Q.2d (BNA) at 1075.

247. *Id.*

248. *Id.*

249. *See id.* at 1072–73, 1076.

250. *Id.* at 1076.

251. *Id.*

252. *Id.*

253. *Id.* at 1076–77. It is worth noting that with respect to the existence of differing views, the applicant argued as follows:

[Recent] treatment of the [*Harjo I*] test fails to satisfy the demands of the statute [by failing] to define what *actually* constitutes a “substantial composite,” . . . [and that treatment fails] to take account of how the [*Harjo I*] rule should work where some people may consider a term negatively, but many others find it a source of pride . . . [T]he rule [should] be sufficiently elaborated to take account of a situation where, as here, a term considered negatively by a small group of a larger community is a source of pride to another, perhaps even larger group.

*Id.* at 1076 (third alteration in original) (emphasis added) (quoting Applicant’s Reply Brief at 4–5, *In re Heeb Media*, 89 U.S.P.Q.2d (BNA) 1071 (Serial No. 78558043), 2008 WL 8703459).

254. *Id.* at 1077.

the referenced individuals found the term objectionable, the evidence indicated that a substantial composite of the referenced group considered the term to be disparaging in any context.<sup>255</sup> As a result, the TTAB affirmed the refusal to register.<sup>256</sup>

In 2006, the Lebanese Arak Corporation filed an application to register the word *Khoran* as a trademark for certain alcoholic drinks.<sup>257</sup> The examiner refused the registration, concluding that *Khoran* “is the phonetic equivalent of ‘Koran’; that the Koran is the sacred text of Islam; that the Koran forbids consumption of alcoholic beverages, including wine; and therefore . . . the use of [the term] for wine is disparaging to the beliefs of Muslims.”<sup>258</sup> On appeal, in *In re Lebanese Arak Corp.*, the TTAB demonstrated its continued adherence to the disparagement test from *Harjo I.*<sup>259</sup> Unlike other disparagement cases, however, there was no question that the examiner had satisfied the burden of proof related to the test’s second prong.<sup>260</sup>

In *In re Lebanese Arak Corp.*, the point of contention was associated with “the likely meaning of the matter in question.”<sup>261</sup> As mentioned, the examiner believed that the mark was phonetically similar to the word *Koran*.<sup>262</sup> The applicant asserted that the mark used an entirely different word, translated to mean “altar,”<sup>263</sup> but the examiner presented evidence that the term *Koran* is commonly spelled in many different ways, including *Khoran*.<sup>264</sup> Ultimately, the TTAB concluded that the mark “gives the commercial impression that it is the word [*Koran*], and that the public . . . in general, and Muslim Americans in particular, would regard the mark as referring to the holy text of Islam.”<sup>265</sup>

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255. *See id.*

256. *Id.* at 1078.

257. *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1215 (T.T.A.B. 2010).

258. *Id.* at 1216 (footnote omitted).

259. *See id.* at 1217.

260. *See id.* at 1217–18. “The evidence submitted by the examining attorney . . . [was] sufficient to show that the use of the name of the sacred text of Islam for a substance prohibited by that religion, indeed, a substance prohibited by that very text, would be disparaging to followers of Islam and their beliefs.” *Id.* at 1218.

261. *Id.*

262. *Id.*

263. *Id.*

264. *See id.* at 1218–19.

265. *Id.* at 1219. Despite highlighting “Muslim Americans in particular,” the TTAB—in yet another case—improperly conflated the views of the referenced group with those of the public “in general.” *Id.*

The dissent proffered several arguments against that finding.<sup>266</sup> Most notably, the dissent argued that the first prong of the test should be considered from the standpoint of the general public.<sup>267</sup> In rejecting that argument, the majority claimed that the analysis was not limited in that manner, mentioning the hypothetical situation where a religious group, not the general public, understood a term or symbol as being connected to their beliefs.<sup>268</sup> The majority concluded that—based on the phonetic similarity to the holy text of Islam—using the mark *Khoran* in connection with wine would be disparaging to the religious beliefs of Muslims.<sup>269</sup> Therefore, the TTAB upheld the examiner's decision to refuse registration.<sup>270</sup>

In *In re Prosynthesis Laboratories, Inc.*, the applicant appealed the denial of its application to register the trademark *China Free* for various nutritional supplements.<sup>271</sup> Specifically, the examiner reviewed the evidence and issued a final refusal that claimed the mark may have been disparaging under the provisions of section 2(a).<sup>272</sup> Throughout the examination and the subsequent appeal, “the examining attorney primarily argued that the person or institution referred to in the mark (and thus the target of the mark's alleged disparagement) [was] the nation of China.”<sup>273</sup> The TTAB accepted that argument<sup>274</sup> and began considering “whether the mark [was] disparaging to the People's Republic of China.”<sup>275</sup>

Applying the first prong of the *Harjo I* test, the TTAB found that the applicant was using the mark “to inform the prospective purchaser that applicant's goods contain[ed] no ingredients from China, and that [was] its likely meaning.”<sup>276</sup> Based on this conclusion, the TTAB believed “it

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266. See *id.* at 1221–24 (Mermelstein & Wellington, JJ., dissenting).

267. *Id.* at 1221–22.

268. *Id.* at 1219 (majority opinion). As an example, the majority referenced *In re Reemtsma Cigarettenfabriken*: “[I]t is unlikely that, at the time registration for the mark . . . was sought, the public in general was aware that Senussi was the name of a Muslim sect.” *Id.*

269. See *id.* at 1220–21.

270. *Id.* at 1221.

271. *In re Prosynthesis Labs., Inc.*, Serial No. 77902555, 2012 WL 1267929, at \*1 (T.T.A.B. Mar. 23, 2012).

272. *Id.*

273. *Id.* at \*2.

274. See *id.* at \*4 (“[F]or purposes of this opinion, we will assume that China is a person or institution within the meaning of Trademark Act [section] 2(a).”).

275. *Id.* at \*3.

276. *Id.* at \*6.

[was] readily apparent that the mark<sup>277</sup> referred to China (as a person or institution).<sup>278</sup> Turning to the second prong of the *Harjo I* test, the TTAB considered arguments from both the managing attorney and the applicant.<sup>279</sup> The managing attorney argued that the mark was disparaging to the foreign nation and its people because the mark characterized the nation's ingredients as inferior.<sup>280</sup> In response, the applicant agreed with the trademark's interpreted meaning but argued that it created the mark in response to "legitimate concerns about the wholesomeness of certain products from China."<sup>281</sup>

Straying from the contours of the disparagement analysis, the TTAB considered evidence from several different websites, including the applicant's,<sup>282</sup> and concluded that the evidence did not suggest that the mark was "wholly irrational or merely a pretext for animus."<sup>283</sup> The managing attorney tried to use the approach from *Greyhound*, arguing that the mark was disparaging to a reasonable person of ordinary sensibilities.<sup>284</sup> However, the TTAB looked to the views of the referenced group and determined that the evidence did not "shed light on whether China would find [the mark] as used on nutritional supplements to be disparaging."<sup>285</sup> Thus, concluding that a finding of disparagement "would be based entirely on speculation,"<sup>286</sup> the TTAB reversed the

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277. *Id.*

278. *Id.* (alterations in original) (quoting *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d (BNA) 1215, 1217 (T.T.A.B. 2010)).

279. *See id.* at \*6–8.

280. *Id.* at \*7.

281. *Id.* at \*8.

282. *See id.* at \*8–12.

283. *Id.* at \*13. In an unusual fashion, the TTAB included an assessment of the mark's rationality and underlying animus in its disparagement analysis. *See id.* Similarly, it randomly inserted and applied language that pertains to the applicant's intent: "[Disparagement] has been defined as the publication of a statement which the publisher intends to be understood, or which the recipient reasonably should understand, as tending 'to cast doubt upon the quality of another's land, chattles, or intangible things.'" *Id.* (quoting RESTATEMENT (SECOND) OF TORTS § 629 (AM. LAW INST. 1977)). Despite the fact that the words *animus*, *intent*, and *motivation* cannot be found in the disparagement standard, the TTAB continued to engage in this ad hoc analysis, stating that "it [was] hard to conclude on [the] record that applicant's position is clearly motivated by a dislike of China." *Id.* at \*15.

284. *Id.* at \*16.

285. *See id.*

286. *Id.* at \*17. "[T]here is . . . a difference between what one may not like and what is disparaging under the Trademark Act." *Id.* The court stated that "it is imperative that the [TTAB] be careful to avoid interposing its own judgment." *Id.* (emphasis added) (quoting *In re Hines*, 32 U.S.P.Q.2d (BNA) 1376, 1377 (T.T.A.B. 1994)).

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refusal to register the trademark.<sup>287</sup>

In 2014, the United States Court of Appeals for the Federal Circuit reviewed *In re Geller*<sup>288</sup>—the last major disparagement case before *Blackhorse*. In *In re Geller*, the applicants filed an application to trademark the phrase *Stop the Islamisation of America* for purposes of disseminating information about terrorism.<sup>289</sup> The TTAB rejected that application, concluding that the mark “contain[ed] ‘matter that might disparage’ a group of persons in violation of [section] 2(a) of the [Lanham] Act.”<sup>290</sup> In reaching this conclusion, the TTAB decided that the term *Islamisation* had distinct meanings in both political and religious contexts,<sup>291</sup> and it found that the term may be disparaging to Muslims (the referenced group) under both interpretations.<sup>292</sup> The TTAB believed that the mark associated Islam with terrorism and insinuated that Islamisation was negative and undesirable.<sup>293</sup> Therefore, the marks were denied registration.<sup>294</sup>

The applicants appealed that decision, arguing that there was not enough evidentiary support for a “finding that the proposed mark may be disparaging in violation of [section 2(a)].”<sup>295</sup> The court began its analysis with an acceptance of the disparagement standard that was established in *Harjo I* and reasserted in *In re Lebanese Arak Corp.*,<sup>296</sup> marking the most comprehensive enunciation and approval of the standard by a federal court since *Harjo II* (approximately eleven years).<sup>297</sup> Under the first prong of the test, the court affirmed that the term had a religious and a political meaning.<sup>298</sup> The applicants argued that the political meaning was the *sole* meaning, but the court referenced several forms of evidence to the contrary, including dictionary definitions, essays, comments posted on the applicants’ website that expressed a desire to immobilize

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287. *Id.* at \*19.

288. *In re Geller*, 751 F.3d 1355 (Fed. Cir. 2014).

289. *Id.* at 1356.

290. *Id.* at 1356–57; *see also* 15 U.S.C. § 1052(a) (2012).

291. *In re Geller*, 751 F.3d at 1357.

292. *Id.*

293. *See id.* at 1357–58.

294. *Id.* at 1358.

295. *Id.*

296. *See id.*

297. *Harjo II* was decided on September 30, 2003, and *In re Geller* was decided on May 13, 2014.

298. *See In re Geller*, 751 F.3d at 1358–60.

the religion, congressional testimony, and academic materials.<sup>299</sup>

Under the test's second prong, the court concluded that there was substantial evidence to support a finding of disparagement in the context of both possible meanings.<sup>300</sup> Specifically, with respect to the religious meaning, the term *stop*, as used in the trademark, assigned a negative and unpleasant connotation to Islam.<sup>301</sup> Moreover, in the context of both meanings, the mark generated the belief that a strong connection existed between the religion and terrorism.<sup>302</sup> The court noted that this apparent connection with terrorism was offensive to a majority of the referenced group.<sup>303</sup> The court ultimately affirmed the TTAB's refusal to register the mark.<sup>304</sup> Thus, between *Harjo* and *Blackhorse*, the TTAB continued to use the *Harjo I* test to resolve claims of disparagement that invoked section 2(a) of the Lanham Act. One federal court even decided to approve the test, which was at issue again in the much-anticipated sequel to *Harjo*.

*D. Blackhorse: Different Petitioners, Same Disparagement Standard*

During the *Harjo* litigation, five new petitioners ("new petitioners"),<sup>305</sup> led by Amanda Blackhorse, filed a petition to cancel the same trademarks related to the Washington Redskins and owned by Pro-Football, Inc.<sup>306</sup> The TTAB suspended that petition until the final resolution of *Harjo*, revisiting the new petitioners' claims in March 2010.<sup>307</sup> In *Blackhorse*, the record contained court documents and files, "deposition testimony of each of the [new] petitioners and the associated deposition exhibits, and nearly the entire *Harjo* record (except for the

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299. *Id.* at 1359–60.

300. *See id.* at 1361. In fact, the applicants "conceded at oral argument that their mark [was] disparaging under a religious meaning." *Id.*

301. *Id.*

302. *See id.*

303. *Id.* It is worth noting that the court mentions the term *majority*, not substantial composite, in this part of its analysis. *See id.*

304. *Id.* at 1362.

305. In this case, the new petitioners included Amanda Blackhorse, Marcus Briggs-Cloud, Philip Gover, Jillian Pappan, and Courtney Tsotigh. *Blackhorse I*, 111 U.S.P.Q.2d (BNA) 1080, 1080 (T.T.A.B. 2014), *aff'd*, 2015 WL 4096277 (E.D. Va. July 8, 2015). Originally, there were six petitioners, but "Shquanebin Lone-Bentley withdrew her petition for cancellation." *Id.* at 1084 n.8.

306. *Id.* at 1083–84.

307. *Id.* at 1084.

deposition testimony of the *Harjo* petitioners).<sup>308</sup>

Applying the *Harjo I* test, the TTAB concluded that the term *Redskins*, considered in the context of its use, “retain[ed] the meaning Native American.”<sup>309</sup> The parties conceded that the likely meaning of the term, “even when used in connection with the respondent’s services,” referred to both the Washington Redskins and American Indians.<sup>310</sup> The TTAB also highlighted the respondent’s tendency to utilize uniforms, titles, and imagery that associated its football services with American Indians.<sup>311</sup> With the first prong satisfied, there was only one question left to answer: Was the meaning of the marks, at the time of their respective registrations, disparaging to a substantial composite of American Indians?<sup>312</sup>

According to the TTAB, *Blackhorse* involved the same disparagement claim seen in “*Heeb* and the non-ski-related goods and services portion of *Squaw Valley*.”<sup>313</sup> In other words, the new petitioners argued that the term was disparaging because it was “a racial slur,” as opposed to “an innocent term where the nature of the goods or services render[ed] the mark disparaging.”<sup>314</sup> Therefore, the “respondent’s alleged honorable intent and manner of use of the term [did] not contribute to the determination of whether a substantial composite of the referenced group found [the mark] to be a disparaging term in the context of [the] respondent’s services during the time period 1967-1990.”<sup>315</sup> The TTAB focused on two different sets of evidence.<sup>316</sup> For a “general analysis of the word,” the evidence included expert testimony, dictionaries, and reference books.<sup>317</sup> “For the specific views of Native Americans” the evidence included a 1993 resolution from the NCAI, “the deposition of NCAI Executive Director, Ms. JoAnn Chase, the deposition of Harold Martin Gross, and various newspaper articles, reports, official records

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308. *Id.* at 1085. For reference, much of the evidence (and other related documents) can be viewed at <http://ttabvue.uspto.gov/ttabvue/v?qt=adv&pno=92046185> [<http://perma.cc/Y73C-BHPC>].

309. *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1087–89.

310. *Id.* at 1088, 1091.

311. *See id.* at 1088–89.

312. *Id.* at 1089.

313. *Id.* at 1091.

314. *Id.* at 1090–91.

315. *Id.* at 1091.

316. *See id.*

317. *Id.*

and letters.”<sup>318</sup> Of course, most of this evidence was previously included and considered in the *Harjo* proceedings.<sup>319</sup>

### 1. *Blackhorse I*: The Evidentiary Failures of the Disparagement Standard

In *Harjo II*, the district court made an express ruling with regard to the TTAB’s disparagement conclusion.<sup>320</sup> On multiple occasions, the court stated that there was not enough evidence to support the conclusion that the term *redskins* was disparaging to a substantial composite of American Indians.<sup>321</sup> However, since laches became the focus of the case, subsequent discussions have seemingly ignored the disparagement analysis.<sup>322</sup> The court’s disparagement conclusion was not a decision on the merits of the claim,<sup>323</sup> but it did highlight the deficiencies in *Harjo I*.<sup>324</sup> More importantly, these deficiencies, which appear to be reincarnated in *Blackhorse*, demonstrate how easy it is for insufficient evidence to satisfy the current disparagement standard.

While most, if not all, of the previously mentioned disparagement cases would serve as an excellent point of reference, it is best to review the evidentiary inadequacies through a *Blackhorse*-tinted lens. The new petitioners’ choice “to simply re-use the trial record from” *Harjo* may have been an effective maneuver had they augmented or strengthened that information.<sup>325</sup> Instead, they submitted and substantially relied on the same collection of evidence that the district court previously rejected as inadequate and unable to support a finding of disparagement.<sup>326</sup> The

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318. *Id.*

319. *See id.* at 1085–86; *id.* at 1115 (Bergsman, J., dissenting); *Blackhorse v. Pro-Football, Inc.* (*Blackhorse Preliminary I*), 98 U.S.P.Q.2d (BNA) 1633, 1633–34 (T.T.A.B. 2011) (“This proceeding mirrors prior litigation before the [TTAB] of a disparagement claim under [s]ection 2(a) . . . but brought by different plaintiffs. The pleadings in *Harjo* and in this cancellation proceeding are identical but for two additional affirmative defenses based on violations of respondent’s constitutional right to ‘due process.’” (citation omitted)).

320. *See Harjo II*, 284 F. Supp. 2d 96, 125–26 (D.D.C. 2003).

321. *See id.* at 125–26, 131, 134–36.

322. *See id.* at 136.

323. *See Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1084.

324. *See generally Harjo II*, 284 F. Supp. 2d at 127–36.

325. *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1115 (Bergsman, J., dissenting). The only major change was the addition of the new petitioners’ depositions, which expressed their disdain for the challenged marks. *Id.*

326. *Id.*

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circuit court did not overrule that characterization, nor had anything occurred to improve or repair the otherwise “stale record.”<sup>327</sup> However, the new petitioners were able to take advantage of the current standard’s weaknesses and limitations en route to obtaining a favorable result. Despite this apparent victory, the new petitioners’ case suffered from a deficient record because they failed to strengthen the insufficient evidence from *Harjo*.<sup>328</sup> Of course, this is not to say that the term *redskins* is or is not a disparaging term. The conclusion here is simply that the new petitioners have failed to adequately demonstrate that notion.

The record was replete with evidentiary inadequacies. First, the new petitioners relied on linguistic testimony that was substantially similar to the testimony in *Harjo I*.<sup>329</sup> In submitting this evidence, however, they failed to remedy the deficiencies expressed in *Harjo II*.<sup>330</sup> The new petitioners simply relied, as did their predecessors, on the expert testimony of three individuals who opined on how dictionary editors perceive the term *redskins*.<sup>331</sup> The experts’ testimonies also discussed the process that editors use to incorporate usage labels into their dictionaries.<sup>332</sup>

Although the usage-label testimony was responsive to the district court’s critiques, it still failed to remedy all of the expressed deficiencies and highlighted an even bigger problem. Specifically, the experts indicated that dictionary editors incorporate and adopt usage labels based on the sociopolitical influence of outside groups or individuals.<sup>333</sup> Therefore, by giving analytical weight to the dictionary’s usage labels, the TTAB indirectly placed its focus on the views of dictionary editors and the outside groups or individuals who exerted pressure on those editors. Stated differently, the TTAB focused on the general public’s perception of the term. Indeed, with respect to the dictionary evidence (usage labels), the record is seemingly devoid of discussion relating to the views or perceptions of American Indians.<sup>334</sup>

From 1966 to 1979, only two dictionaries incorporated a negative

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327. *Id.*

328. *Id.*

329. *See id.* at 1091–98 (majority opinion).

330. *See Harjo II*, 284 F. Supp. 96, 129–32 (D.D.C. 2003).

331. *See Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1093–95.

332. *See id.* at 1094–95.

333. *Id.* at 1094.

334. *See id.* at 1093–95.

usage label for the term.<sup>335</sup> Nevertheless, the TTAB concluded “that there [was] a ‘clear trend beginning in 1966 to label [the] term as offensive.’”<sup>336</sup> The dissent, however, correctly stated that “[t]wo does not make a trend.”<sup>337</sup> The dictionary evidence cannot and should not be “sufficiently probative to justify cancell[ation]” of the trademarks’ registrations.<sup>338</sup> Moreover, as mentioned above, the entire analysis of the dictionary evidence appears to be an indirect consideration of the general public’s views. This is a clear example of how difficult it is for the TTAB to restrict its analysis to the current standard’s guidelines. Since dictionary evidence was part of the analysis, however, it is important to highlight that most of the referenced usage labels refer to the term *redskins* as “often offensive,” implying the existence of contexts where the term is not considered offensive.<sup>339</sup> “[F]or 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.’”<sup>340</sup>

Considering that some American Indians have chosen to use the term *Redskins* for their sports teams, it naturally follows that a considerable section of that group does not consider the term to be disparaging within the context of team names,<sup>341</sup> such as the Washington Redskins. “This testimony and evidence introduced into [the] record by [the new] petitioners [was] relevant to show that the commercial impression or perception of a term or image changes in connection with its use.”<sup>342</sup> Moreover, “[t]he record [did] not show any evidence or testimony of any actual effort, past or present, at any of the named Native American schools to have the Indian namesakes or imagery changed as school nicknames and logos.”<sup>343</sup> Overall, the TTAB once again failed to properly consider or address both the divergent expert testimony and the evidence demonstrating American Indian use of the term *Redskins* in the context of their personal entertainment services, namely, sports teams.<sup>344</sup>

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335. *Id.* at 1118 (Bergsman, J., dissenting).

336. *Id.* (quoting *id.* at 1094 (majority opinion)).

337. *Id.*

338. *Id.* at 1118–19.

339. *Id.* at 1116–19; see also *Harjo II*, 284 F. Supp. 2d 96, 130 (D.D.C. 2003).

340. *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1116 (Bergsman, J., dissenting).

341. *Id.*

342. *Id.*

343. *Id.* at 1117.

344. See *id.* (“Based on [the] record, there is a difference between what [the new]

The TTAB's analysis was also deficient with respect to the term's usage by various media outlets.<sup>345</sup> The TTAB noted that "between 1969 and 1996 . . . the term 'redskin' or 'redskins' appeared in 143,920 articles"—mostly in reference to sports.<sup>346</sup> As in *Harjo I*, the TTAB again highlighted that the significant decrease in the use of the term as a reference to American Indians is demonstrative of its disparaging and pejorative nature.<sup>347</sup> However, when the TTAB made that statement in *Harjo I*, the district court concluded that there was no evidence in the record to support such a finding.<sup>348</sup> Since the new petitioners failed to augment that insufficient evidence, it follows that the conclusion in this case also lacks the support of substantial evidence.<sup>349</sup> At best, there is a disagreement about the significance of the term's decreased use as a reference to American Indians.<sup>350</sup> The majority unsatisfactorily addressed that disagreement; as a result, its conclusion lacks strong evidentiary support.<sup>351</sup> Indeed, the disparagement analysis continues to suffer from the same deficiencies enunciated in *Harjo II*.<sup>352</sup>

The discussion now turns to perhaps the most questionable and problematic form of evidence contained in the record—the NCAI resolution.<sup>353</sup> In 1993,<sup>354</sup> the Executive Council of the NCAI passed a resolution that supported the original petitioners' case for cancellation of the respondent's marks.<sup>355</sup> The TTAB classified this evidence as

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petitioners' linguistic expert conclude[d] regarding the meaning of the term 'Redskins' and the empirical evidence regarding how Native Americans use that term in connection with . . . sports teams.").

345. See *id.* at 1095–98 (majority opinion).

346. *Id.* at 1097.

347. *Id.* at 1108 ("The usage labels appear and the use of the word redskin(s) disappears because it is increasingly recognized that the term is offensive and disparaging during the relevant time period as Native Americans raise awareness about the offensive nature of the term redskin(s).").

348. *Harjo II*, 284 F. Supp. 2d 96, 130–31 (D.D.C. 2003).

349. See *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1119 (Bergsman, J., dissenting).

350. See *id.* at 1095–98 (majority opinion).

351. See *id.* Here, as in *Harjo I*, the TTAB again failed to demonstrate how "the drop-off of the use of the term 'redskin(s)' as a reference for Native Americans is correlative with a finding that the term is pejorative." *Harjo II*, 284 F. Supp. 2d at 131–32; see also *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1097 (simply stating that the drop-off is "relevant" without providing any explanation for that conclusion).

352. See *Harjo II*, 284 F. Supp. 2d at 131–32.

353. See *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1098–99.

354. *Id.* at 1098. This date is, in fact, *after* the relevant time period. In order for the date to be relevant to the analysis under the current standard, it must be between 1967 and 1990. See *id.* at 1082.

355. *Id.*

probative of the views and perceptions that American Indians held during the appropriate time period, namely, 1967–1990.<sup>356</sup>

However, “there is no reliable evidence supporting the number of Native Americans or tribes that attended the meeting or that were members of the organization during the relevant time frame between 1967 and 1990.”<sup>357</sup> The same is true regarding the number of those present at the time the organization passed the resolution.<sup>358</sup> In an attempt to provide some support or verification, the TTAB heavily relied on the problematic deposition testimony of JoAnn Chase.<sup>359</sup> Perhaps even more disturbing is the TTAB’s use of her equivocal and inexact testimony<sup>360</sup> to conclude that the NCAI’s membership was between 100 and 400 tribes at the time of the resolution.<sup>361</sup>

The TTAB’s analytical struggle regarding the NCAI resolution is the direct result of a disparagement standard that currently restricts the analysis to the time of a challenged mark’s registration. Since the current standard does not allow consideration of modern perceptions, the TTAB had to connect the 1993 resolution to the 1967–1990 timeframe. Indeed, in *Harjo II*, the district court criticized the NCAI resolutions as being “irrelevant to the calculus” because they came after the appropriate time period without any explanation for how they pertained to the applicable years.<sup>362</sup> Therefore, the TTAB emphasized the NCAI’s participation in

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356. *Id.* at 1098–99.

357. *Id.* at 1119 (Bergsman, J., dissenting).

358. *See id.* at 1119–20.

359. *See id.* at 1099 (majority opinion). Ms. Chase “became the Executive Director of the NCAI on April 1, 1994 and provided testimony about the resolution.” *Id.* at 1119 (Bergsman, J., dissenting). She was incapable of providing (1) a record that confirms “the number of tribes who had delegates to the organization” during the relevant years, (2) “any similar resolutions concerning the use of the name ‘Washington Redskins’ by the organization between 1967 and 1992,” or (3) any “correspondence [during the same time frame] concerning the use of the word ‘redskin’” in the context of professional football. *Id.* Despite these deficiencies, the TTAB used her deposition as support for classifying the resolution as clearly probative of the views and perceptions of American Indians. *See id.* at 1098–99 (majority opinion).

360. Ms. Chase stated, “*I do not know what the membership of the organization was at that time. I can tell you currently, if, for example, our membership is 206 tribes, it would be one-third. At that time the membership would have been 100 tribes. It could have been 400 tribes. I don’t know.*” *Id.* at 1119–20 (Bergsman, J., dissenting) (emphasis added) (quoting Deposition of JoAnn Chase at 53–54, *Blackhorse I*, 111 U.S.P.Q.2d (BNA) 1080 (Cancellation No. 92046185)). For reference, her deposition is available at <http://ttabvue.uspto.gov/ttabvue/v?pno=92046185&pty=CAN&eno=98> [<http://perma.cc/Z92K-CWTU>].

361. *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1119–20 (Bergsman, J., dissenting).

362. *Harjo II*, 284 F. Supp. 2d 96, 135 (D.D.C. 2003).

the 1972 meeting through its then-President, Leon Cook.<sup>363</sup> Furthermore, the TTAB extended Mr. Cook's views (that the respondent should cease using the name *Washington Redskins*) to the entire NCAI organization; as a result, the TTAB concluded that the NCAI expressed opposition to the name as early as 1972.<sup>364</sup>

Assuming, for the sake of argument, that this is an appropriate deduction, it still fails to remedy the most significant criticism proffered by *Harjo II* in relation to this evidence. Specifically, even when paired with other forms of evidence, the 1972 meeting does not "represent a 'substantial composite' of Native Americans."<sup>365</sup> It is safe to assume the district court knew that the individuals present at the meeting were representatives of larger organizations. Therefore, the court's finding leads to one of two possible conclusions: Either the district court (1) did not extend Mr. Cook's views to the entire NCAI organization; or (2) the court extended those views and found that the NCAI's membership<sup>366</sup> was not representative of a substantial composite.<sup>367</sup> Whatever the reason, this seems to break down the TTAB's analysis.<sup>368</sup>

The TTAB was simply trying to support the following declaration: "[T]he mere fact that an opinion is voiced in 1993 does not mean the opinion was not held by that group or individual in the 1967-1990 time period."<sup>369</sup> That statement, however, is nothing more than another

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363. *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1100-01.

364. *Id.*

365. *Harjo II*, 284 F. Supp. 2d at 135.

366. *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1100-01. Citing sources that indicate membership was between 300,000 and 350,000, the TTAB concluded that the "NCAI represented approximately 30 percent of Native Americans" in 1972. *Id.* at 1100. The court used this percentage and date to conclude that "a substantial composite of Native Americans" considered the term *redskins* disparaging throughout the relevant time period. *Id.* at 1110.

367. *See Harjo II*, 284 F. Supp. 2d at 135-36.

368. Indeed, it seems reasonable to conclude that the district court either (1) did not believe that Mr. Cook's views could extend to the entire organization, or (2) the court did not believe that thirty percent was a substantial composite. Whatever the case may be, the evidence does not satisfy the "substantial evidence" threshold and is, therefore, incapable of supporting a conclusion of disparagement. Nevertheless, the TTAB placed a heavy reliance on this evidence in reaching its ultimate conclusion. *See Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1110-12.

369. *Id.* at 1098; *see also* Ken Motolenich-Salas, *The Four Quarters of the Redskins Trademark Cancellations: The Revival of the Disparagement Doctrine*, ARIZ. ATT'Y, Oct. 2014, at 20 n.22 ("The author believes that [the respondent] will rely on this in any appeal as improper hindsight bias used to cancel the trademarks in violation of 15 U.S.C. § 1064 . . .").

inferential step—similar to those that the district court condemned in *Harjo II*.<sup>370</sup> The TTAB also relied on a report issued by the Michigan Civil Rights Commission in October 1988, which mentioned the NCAI's efforts to change the name of the Washington Redskins.<sup>371</sup> At best, this report demonstrates the NCAI's views prior to only the final registration (1990). The TTAB also referenced a "WTOP survey [that] shows 28 percent of tribal leaders . . . found the name offensive and wanted it changed."<sup>372</sup> However, the survey was problematic because it occurred "after the relevant time period [and related to] an act that took place after the relevant time period."<sup>373</sup> There was also no evidence "regarding how the survey company identified tribal leaders or verified that the [individual] was, in fact, a tribal leader." The evidence was equally deficient regarding "whether the interviews actually took place."<sup>374</sup>

Disregarding the disparities, the TTAB paired the NCAI resolution and the WTOP survey with a statement from a 1993 Miami University Senate meeting<sup>375</sup> and "a letter from Dale Pullen, publisher of the U.S. Congress Handbook, to Charlie Drayton, the Vice President of Communications for the Washington Redskins,"<sup>376</sup> to determine that the NCAI represented approximately 150 tribes—about thirty percent of the recognized tribes—in 1993.<sup>377</sup> Keeping with the trend, these additional sources of evidence are also plagued by discrepancy.<sup>378</sup> Overall, the TTAB's conclusion—that the NCAI represented 150 tribes, or close to thirty percent of Native Americans, in 1993—is nothing more than "a house of cards that collapses upon examination."<sup>379</sup>

The new petitioners not only failed to present evidence concerning the population of American Indians during the appropriate time frame, but they also neglected to discuss what would properly encompass a

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370. See *Harjo II*, 284 F. Supp. 2d at 128.

371. *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1101.

372. *Id.* at 1102 n.141. WTOP is a radio station in Washington, D.C. *Id.* at 1120 (Bergsman, J., dissenting). "The purpose of the survey was to see how tribal leaders and listeners felt about WTOP not using the name Washington Redskins to refer to the football team." *Id.*

373. *Id.*

374. *Id.*

375. See *id.* at 1101 (majority opinion).

376. See *id.* at 1102.

377. See *id.*

378. See *id.* at 1120–21 (Bergsman, J., dissenting).

379. *Id.* at 1121.

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substantial composite of that population.<sup>380</sup> Despite unloading an overabundance of information,<sup>381</sup> the new petitioners presented evidence that was largely unresponsive to the paramount inquiries of the disparagement standard.<sup>382</sup> Nevertheless, they were the beneficiaries of a standard with weaknesses and limitations that create avenues for factually flawed analyses and inferentially based conclusions. The TTAB (once again) concluded that the new petitioners had satisfied their evidentiary burden, finding that the term *Redskins* was disparaging to a substantial composite of American Indians “during the relevant time frame of 1967–1990.”<sup>383</sup> Then, as in *Harjo*, the TTAB turned its analysis to the respondent’s laches defense.<sup>384</sup>

Although the laches ruling in *Harjo III* established legal precedent, the new petitioners were able to avoid the laches defense in *Blackhorse I* because of some new procedural developments.<sup>385</sup> The TTAB found that the “public interest” exception precluded the respondent from asserting the defense.<sup>386</sup> However, after considering a hypothetical situation in which the defense was declared available on appeal, the TTAB found that the respondent still could not have made the necessary showing.<sup>387</sup> The TTAB then cancelled the trademarks for a second time.<sup>388</sup> In response, the respondent filed an appeal with the United States District Court for the Eastern District of Virginia.<sup>389</sup>

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380. *Id.*

381. *Id.* at 1115 (“The evidence submitted by [the new] petitioners can most charitably be characterized as a database dump.”).

382. *See id.* at 1121.

383. *Id.* at 1111–12 (majority opinion).

384. *See id.* at 1112–14.

385. *See id.* Since *Blackhorse* was “essentially a relitigation of . . . *Harjo*,” the TTAB originally chose to follow precedent and allowed the laches defense. *Id.* at 1112. Not long after this decision, however, Congress enacted the America Invents Act. *See id.* This new statutory scheme “changed the venue for appeals . . . from USPTO *inter partes* proceedings to the U.S. District Court for the Eastern District of Virginia from the U.S. District Court of the District of Columbia.” *Id.* Hence, judicial review of such trademark disputes now occur within the Fourth Circuit or the Federal Circuit—invoking a different set of binding authority. *Id.* In light of this development, the TTAB reconsidered the applicability of the laches defense and reversed its original decision. *See id.* at 1112–14. Since the Fourth Circuit seems to share the TTAB’s sentiments with respect to laches, this change could bode well for future trademark petitioners. *See generally* Sara Lee Corp. v. Kayser-Roth Corp., 81 F.3d 455 (4th Cir. 1996).

386. *See Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1113.

387. *See id.* at 1113–14.

388. *Id.* at 1114.

389. *See Blackhorse II*, No. 1:14-cv-01043-GBL-IDD, 2015 WL 4096277, at \*4 (E.D. Va. July 8, 2015).

2. *Blackhorse II*: The Same Old Story

On appeal, the district court disposed of the issues related to disparagement by granting summary judgment in favor of the new petitioners.<sup>390</sup> The court reached this decision using the same problematic evidence from *Blackhorse I*, finding that “the (1) dictionary evidence; (2) literary, scholarly, and media references; and (3) statements of individuals and groups in the referenced group show that the . . . [tradem]arks consisted of matter that ‘may disparage’ a substantial composite of Native Americans during the relevant time period.”<sup>391</sup> The court went on to explain how it reached this decision, but it first addressed “a threshold matter” that was relevant to the overall disposition of the case.<sup>392</sup> Specifically, the court found it necessary to clarify that the case’s central issue was about trademark registration and the corresponding benefits, not the actual trademarks themselves.<sup>393</sup> After clarifying that concept, the court did not waste any time before diving into the sea of challenges that were awaiting judicial resolution.<sup>394</sup>

Citing *Blackhorse I* and *In re Geller*, the court began its disparagement analysis by discussing the two-pronged standard.<sup>395</sup> The court spent little time wrestling with the first prong.<sup>396</sup> The respondent continued to “admit[] that ‘redskins’ refer[red] to Native Americans,”<sup>397</sup> and the court itself determined that the respondent “[had] made continuous efforts to associate its football team with Native Americans during the relevant time period.”<sup>398</sup> Therefore, the court had no qualms about declaring that “the meaning of the matter in question [was] a reference to Native Americans.”<sup>399</sup> The court then turned to the second prong of the disparagement analysis and engaged in a much more

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390. *Id.* at \*2.

391. *Id.* at \*2, \*6, \*20, \*39.

392. *See id.* at \*6 (“Just as Allen Iverson once reminded the media that they were wasting time at the end of the Philadelphia 76ers’ season [discussing things other than] . . . an actual professional basketball game, the Court [was] similarly compelled to highlight what [was] at issue in [the] case—trademark registration, not the trademarks themselves.”).

393. *Id.* at \*6–8.

394. *See id.* at \*1–2.

395. *Id.* at \*21.

396. *See id.* at \*22–23.

397. *Id.* at \*22.

398. *Id.* at \*23.

399. *Id.*

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detailed discussion.<sup>400</sup>

Unfortunately, as most of the other disparagement cases have demonstrated, more detail is associated with more problems. The district court declared that “[w]hen reviewing whether a mark ‘may disparage,’ the PTO does not, and practically cannot, conduct a poll to determine the views of the referenced group.”<sup>401</sup> Assuming that statement is accurate, it should not give a reviewing entity freedom to depart from the standard. It is not appropriate for reviewing entities to create a standard that requires an examiner to assess the views of a referenced group and then to stray from the contours of that standard to consider irrelevant evidence simply because it may be impractical to properly assess the referenced group’s views. However, that is essentially what has happened. The court noted that because it was not practical to assess the referenced group’s views, “three categories of evidence [were] weighed to determine whether a term ‘may disparage’: (1) dictionary definitions and accompanying editorial designations; (2) scholarly, literary, and media references; and (3) statements of individuals or group leaders of the referenced group regarding the term.”<sup>402</sup>

The court argued that dictionary evidence, including usage labels, was appropriate because the United States Court of Appeals for the Federal Circuit approved that type of evidence in *In re Boulevard Entertainment, Inc.*<sup>403</sup> In that case, “the Federal Circuit held that when a mark has only ‘one pertinent meaning[,] a standard dictionary definition and an accompanying editorial designation alone sufficiently demonstrate[] that a substantial composite of the general public’ considers a term scandalous.”<sup>404</sup> This language, quoted by the district court, actually supports the argument against dictionary evidence because that type of evidence is used to assess the views of the general public, not those of the referenced group. The use of this language and the court’s entire assessment of dictionary evidence further demonstrate how easily the scandalousness test can bleed over into a disparagement analysis.<sup>405</sup> Nevertheless, the court rejected the respondent’s arguments

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400. See *id.* at \*23–37.

401. *Id.* at \*23.

402. *Id.*

403. See *In re Boulevard Entm’t, Inc.*, 334 F.3d 1336, 1340–41 (Fed. Cir. 2003); see also *Blackhorse II*, 2015 WL 4096277, at \*21–22.

404. *Blackhorse II*, 2015 WL 4096277, at \*21 (alterations in original) (emphasis omitted) (quoting *In re Boulevard Entm’t*, 334 F.3d at 1340–41).

405. See *id.* at \*21, \*25.

against the dictionary evidence, finding that the definitions and their usage labels provided support for the conclusion that the challenged trademarks “consisted of matter that ‘may disparage’ a substantial composite of Native Americans.”<sup>406</sup>

The court reached the same conclusion regarding the scholarly, literary, and media evidence in the record,<sup>407</sup> listing twenty-seven examples “that weigh[ed] in favor of finding that ‘redskins’ ‘may disparage’ a substantial composite of Native Americans.”<sup>408</sup> However, that evidence did a poor job of demonstrating the views and opinions of the referenced group. For example, the court identified only *one* of the twenty-seven references as being composed by an American Indian.<sup>409</sup> More importantly, several of the references cited by the court did not have anything to do with the perceptions of American Indians.<sup>410</sup> It seems like nearly all of the scholarly, literary, and media references were composed by individuals who were not part of the referenced group, and many of those references included nothing more than a general discussion of public or societal perceptions.<sup>411</sup> There is no probative value for such evidence in the analysis of an allegedly disparaging trademark—like those in *Harjo* and *Blackhorse*.

The evidence of statements from individuals or group leaders is also deficient. The court correctly stated that it may “consider[] statements from individuals in the referenced group and leaders of organizations within that referenced group when it makes its ‘may disparage’ finding.”<sup>412</sup> However, it failed to address the evidentiary inadequacies that were seen in *Blackhorse I*. The problem with the evidence is that it fails to establish that the term may disparage a substantial composite of the referenced group. For example, the court turned to the “1972 meeting between [the respondent’s] president and a few major Native American organizations about the ‘Washington Redskins.’”<sup>413</sup> The court argued

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406. *Id.* at \*24, \*26.

407. *Id.* at \*26.

408. *Id.* at \*26–29.

409. *Id.* at \*29 n.22.

410. *See id.* at \*26–29.

411. *See id.* There is no better example than the court’s use of the *Encyclopedia Britannica* from 1911. *See id.* at \*26, \*29. The court does nothing to explain how this evidence demonstrates the perceptions of American Indians. *See id.* at \*29. Rather, the court simply chose to use the *Encyclopedia Britannica* because “[t]he Supreme Court has repeatedly relied on [it] as an authoritative source.” *Id.*

412. *Id.* at \*30.

413. *Id.*

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that the “meeting [was] probative on the issue” because the representatives from these organizations protested the name.<sup>414</sup> As previously mentioned, it is questionable whether the representatives’ views can be attributed to all of the members of their organizations. Assuming that they can, there is a strong argument that evidence of the meeting is still not enough to qualify as a substantial composite.

The court paired evidence of the meeting with the statements of four prominent American Indians—Raymond Apodaca, Leon Cook, Kevin Gover, and Suzan Shown Harjo.<sup>415</sup> According to the court, “the declarations from these prominent Native American individuals and leaders, replete with the actions of groups concerning the ‘Washington Redskins’ football team and anecdotes of personal experience with the term ‘redskin,’ show that the [tradem]arks consisted of matter that ‘may disparage’ a substantial composite of Native Americans.”<sup>416</sup> There are a few evidentiary issues with those declarations, but one issue stands out as the most problematic—the court treated these four individuals as though they were qualified to speak on behalf of the entire referenced group. To be sure, the evidence demonstrates that these prominent, well-respected individuals are leaders within the referenced group; however, their statements are “a reflection of their individual viewpoints and there is no evidence that [their] views are a reasonable proxy for a substantial composite of the entire Native American population.”<sup>417</sup>

The court then turned to the NCAI resolution, “find[ing] that this resolution is probative of NCAI’s constituent members’ collective opinion of the term ‘redskin’ and [the respondent’s] marks for many years, including when the last [tradem]ark was registered.”<sup>418</sup> As previously mentioned, the problem with this resolution is that it “was passed outside of the relevant time period.”<sup>419</sup> The court attempted to remedy this flaw by arguing that it “is just like any other testimony from individuals that was taken after the fact: witnesses testify about what they perceived in the past.”<sup>420</sup> Under that reasoning, a piece of evidence created twenty years after a trademark was registered could be considered relevant so long as the party seeking admission argues that

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414. *Id.*

415. *See id.* at \*30–33.

416. *Id.* at \*33.

417. *Harjo II*, 284 F. Supp. 2d 96, 135 (D.D.C. 2003).

418. *Blackhorse II*, 2015 WL 4096277, at \*33.

419. *Id.*

420. *Id.*

the evidence is nothing more than testimony about the relevant time period; there would be almost no limit to what a reviewing entity could consider. If that were the case, then what would be the point of having a standard that looks only to the time at which the marks were registered? The court must consider the views of the referenced group during the relevant time period.<sup>421</sup> The relevant time period in this case ended in 1990.<sup>422</sup> Any evidence that was created after 1990—like the NCAI resolution (passed in 1993)—is not relevant under the current standard.

The court rejected many of the respondent's arguments as "unpersuasive because [the] evidence d[id] not show that . . . there is *not* a substantial composite of Native Americans who find the matter was one that 'may disparage.'"<sup>423</sup> It further found that the new petitioners were entitled to summary judgment.<sup>424</sup> In doing so, the court was quick to mention that it had "the benefit of a supplemented record and post-2003 cases from the Federal Circuit and [the] TTAB applying [s]ection 2(a) of the Lanham Act—items that the district court in *Harjo II* was not privy to when it made its initial ruling."<sup>425</sup> However, the court only listed six items of "supplemental evidence," and that evidence was insignificant and unresponsive to most, if not all, of the district court's critiques of the evidence in *Harjo II*.<sup>426</sup> Nevertheless, the court found that the six challenged trademarks "'may disparage' a substantial composite of Native Americans during the relevant time period, 1967–1990, and must be cancelled."<sup>427</sup>

The respondent also lost on the laches claim, as the court similarly disposed of that issue by granting summary judgment in favor of the new petitioners.<sup>428</sup> The court held that "[t]he disparagement claim [was] not barred by laches because (1) [the new petitioners] did not unreasonably delay in petitioning the TTAB; and (2) the public interest at stake weigh[ed] against its application."<sup>429</sup> Accordingly, the court found that

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421. *See id.* at \*23 ("The relevant period for the disparagement inquiry is the time at which the marks were registered.").

422. *Id.*

423. *Id.* at \*34.

424. *Id.* at \*36.

425. *Id.*

426. *See id.* at \*36–37.

427. *Id.* at \*36.

428. *Id.* at \*37.

429. *Id.* "The [c]ourt [found] that the particular facts and circumstances of th[e] case . . . demonstrate[d] that the application of laches should be barred because of the public's interest in being free from encountering registered marks that 'may disparage.'"

the new petitioners were “entitled to summary judgment.”<sup>430</sup>

Since the respondent’s appeal was before a different federal court than the one that proffered the criticisms in *Harjo II*, the outcome was different. In *Blackhorse II*, the district court approved of the TTAB’s—albeit minimal and seemingly insignificant—efforts to improve the analysis of the *Harjo* record, and the court essentially affirmed the trademarks’ cancellations.<sup>431</sup> However, as the district court pointed out, cancellation does not mean that the respondent had to change its name or stop using the mark.<sup>432</sup> Rather, cancellation will simply keep the team from accessing the benefits associated with federal registration.<sup>433</sup> The respondent would still have some protections, such as exclusivity, but its protections are mostly limited to those enunciated in 15 U.S.C. § 1125.<sup>434</sup> “What actions, if any, [the respondent] takes going forward with the marks are a business judgment beyond the purview of [the c]ourt’s jurisdiction.”<sup>435</sup>

The respondent’s first action was to appeal the district court’s decision to the United States Court of Appeals for the Fourth Circuit.<sup>436</sup> Depending on how the case comes out under the Fourth Circuit, *Blackhorse* could make it all the way up to the United States Supreme Court. In addition to the disparagement claim, there are some constitutional issues that will be assessed as *Blackhorse* continues to make its way up the judicial ladder.<sup>437</sup> Those issues alone may be

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*Id.* at \*38.

430. *Id.*

431. *See id.* at \*20–37.

432. *Id.* at \*39; *see also In re Prosynthesis Labs., Inc.*, Serial No. 77902555, 2012 WL 1267929, at \*4–5 (T.T.A.B. Mar. 23, 2012); Pace, *supra* note 2, at 15.

433. *See In re Prosynthesis Labs.*, 2012 WL 1267929, at \*5; Pace, *supra* note 2, at 15; *see also* Kristin E. Behrendt, Comment, *Cancellation of the Washington Redskins’ Federal Trademark Registrations: Should Sports Team Names, Mascots and Logos Contain Native American Symbolism?*, 10 SETON HALL J. SPORT L. 389, 413 (2000).

434. *See* 15 U.S.C. § 1125 (2012).

435. *Blackhorse II*, 2015 WL 4096277, at \*39.

436. Notice of Appeal, *Pro-Football, Inc. v. Blackhorse*, No. 1:14-cv-1043-GBL-IDD (E.D. Va. Aug. 4, 2015).

437. *See* Eugene Volokh, *ACLU Argues that Cancellation of Redskins Trademark Violates the First Amendment*, WASH. POST: VOLOKH CONSPIRACY (Mar. 6, 2015), <https://www.washingtonpost.com/news/volokh-conspiracy/wp/2015/03/06/aclu-argues-th-at-cancellation-of-redskins-trademark-violates-the-first-amendment/> [<https://perma.cc/U66W-GJNL>]. Although constitutional law and constitutionally based challenges go beyond the contours of this discussion, it is important to briefly address the current developments on the constitutional side of the argument related to disparaging trademarks. On April 20, 2015, the Federal Circuit issued an opinion in *In re Tam*—another disparaging trademark

enough to put an end to all of the problematic trademark analyses and rulings. However, the disparagement standard and its associated analysis will continue to be relevant topics for one of two reasons: (1) if the constitutional challenges are not enough to bring down the statutes, courts should take a hard look at the current standard and attempt to

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case. See *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015), *vacated per curiam*, 600 F. App'x 775 (Fed. Cir. 2015) (mem.). In that case, as in most of the other disparaging trademark cases, the opinion included a questionable and analytically weak disparagement analysis; however, since the opinion was vacated just seven days later, a detailed discussion of that analysis would not be very beneficial. See *In re Tam*, 600 F. App'x 775 (Fed. Cir. 2015) (mem.) (per curiam). Instead, it is important to focus on the constitutional issues associated with the case.

In *In re Tam*, Judge Moore wrote a very brief opinion in which she found that the mark *The Slants*, as used in connection with a musical group, was “disparaging to a substantial composite of people of Asian descent.” *In re Tam*, 785 F.3d at 571. In reaching her ultimate conclusion, Judge Moore also rejected all of the trademark owner’s constitutionally based challenges. *Id.* at 571–73. She then decided to draft a separate opinion, which she titled “additional views.” See *id.* at 573–85 (Moore, J., additional views). There, she questioned the constitutionality of section 2(a) and the precedent of the Federal Circuit. See *id.* She specifically critiqued *In re McGinley*, where the court’s predecessor stated that “First Amendment rights would not be abridged by the refusal to register [the] mark.” *Id.* at 573 (quoting *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981)).

Judge Moore argued that “[t]he constitutionality of [section] 2(a) is an important and timely issue that raises a number of constitutional questions[, and t]he time has come to give th[at] issue the consideration it is due.” *Id.* at 574. She cited three reasons for her desire to revisit *In re McGinley*: (1) the predecessor court’s holding was “without citation to any legal authority”; (2) “[m]ore than thirty years have passed since *McGinley*, and in that time both the *McGinley* decision and [the court’s] reliance on it have been widely criticized”; and (3) “First Amendment jurisprudence on the ‘unconstitutional conditions’ doctrine and the protection accorded to commercial speech has evolved significantly since the *McGinley* decision.” *Id.* at 573–74. Based on these additional remarks, the court vacated its initial opinion and “voted for sua sponte en banc consideration.” *In re Tam*, 600 F. App'x at 775.

The en banc review is limited to whether section 2(a) violates the First Amendment. *Id.* The court’s decision on this issue is very important. Given that the court vacated its initial opinion for en banc consideration, it seems likely that the full court will declare section 2(a) unconstitutional. This same issue was before the district court in *Blackhorse II*, and it determined that “[s]ection 2(a) of the Lanham Act does not implicate the First Amendment.” *Blackhorse II*, 2015 WL 4096277, at \*8. Since the district court’s ruling has been appealed, the Fourth Circuit will soon proffer its thoughts. “If the en banc Federal Circuit splits, or results in a different outcome from the Fourth Circuit in the upcoming [*Blackhorse*] case, this issue will be ripe for Supreme Court review.” Samhitha C. Muralidhar, *A New SLANT on the First Amendment? In an En Banc Decision the Federal Circuit Will Decide Whether the Ban on Registration of “Disparaging Marks” Is Unconstitutional*, LEXOLOGY: FED. CIR. IP BLOG (Aug. 31, 2015), <http://www.lexology.com/library/detail.aspx?g=3101607b-e2cf-4630-8c98-5fd32a90ac63> [<http://perma.cc/932Q-K39N>].

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remedy its weaknesses and limitations; and (2) if the constitutional challenges prevail, the cases applying the standard will serve as an example of what happens when a discretionary, ineffective, and problematic analysis goes unchecked for nearly twenty years. In either case, it is important that reviewing entities learn from the last couple of decades and preclude such a standard from governing any area of law.

### III. THE DISPARAGEMENT STANDARD: REASSESSMENT AND REVISION

One of the federal court system's most recent, comprehensive enunciations of the disparagement standard presents the two-pronged test as follows:

- (1) what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
- (2) if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.<sup>438</sup>

Although gaining some acceptance, the *Harjo I* test is very broad and loosely crafted. In fact, it was created by an entity that possesses restricted authority<sup>439</sup> and accepted by courts without much critical review. In *Harjo II*, for example, the district court partly based its approval of the test on the fact that neither party challenged it.<sup>440</sup> Despite

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438. *In re Geller*, 751 F.3d 1355, 1358 (Fed. Cir. 2014) (quoting *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215, 1217 (T.T.A.B. 2010)).

439. *See Harjo v. Pro-Football, Inc. (Harjo Preliminary I)*, 30 U.S.P.Q.2d (BNA) 1828, 1833 (T.T.A.B. 1994) (“[T]o the extent that respondent is requesting that the [TTAB] find [s]ection 2(a) to be at odds with the First Amendment, such a finding is beyond the [TTAB’s] authority to make. An administrative tribunal such as the [TTAB] has no authority to declare provisions of the Lanham Act unconstitutional.”).

440. *See Harjo II*, 284 F. Supp. 2d 96, 125 (D.D.C. 2003); *see also* Lynette Paczkowski, *The Best Offense Is a Good Defense: How the Washington Redskins Overcame Challenges to Their Registered Trademarks*, B.C. INTELL. PROP. & TECH. F. 5 (June 8, 2004), <http://bciprf.org/wp-content/uploads/2011/07/36-PACZKOWSKI.pdf> [<http://perma.cc/M2LB-JFJD>] (“The standard employed by the TTAB is not the best possible standard. The district court should have examined this standard in detail as its

its origin, the principal problem is that the test's discretionary and heavily subjective nature opens the door for questionable, deficient, and factually flawed conclusions.

This portion of the discussion will address three of the test's most important components. First, it will address the "referenced group" requirement, arguing that it is one of the few analytically sound portions of the test. The remainder of this section will focus on the two most problematic and ineffective portions of the test: (1) the time period in which the group's perceptions are analyzed; and (2) the "substantial composite" language. The following argument asserts that the standard should incorporate modern perceptions into the overall analysis as a factor for consideration. It also advocates for the disposal of the highly subjective "substantial composite" language and urges courts to adopt an analysis that considers the majority of the referenced group.

*A. The "Referenced Group" Requirement: Views That Matter*

The TTAB was correct when it chose to consider the views of *only* the referenced group.<sup>441</sup> This is the one dependable portion of the disparagement standard. Although it may be difficult to identify members of the referenced group, reviewing entities can remedy this problem by requiring trademark petitioners to specifically identify "the scope of the group implicated by the mark in question."<sup>442</sup> Assuming that courts never create or use such a requirement, the "problem" of identifying group membership is still not enough to truly impair the analysis. For example, in an evaluation pertaining to American Indians, the incidental inclusion of Native Hawaiians seems much less deleterious than the inclusion of a highly diverse general populace.<sup>443</sup> Nevertheless, many scholars have proposed modifications to the "referenced group" requirement that are said to remedy the requirement's flaws. While some

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failure to do so [has] result[ed] in the TTAB applying the same faulty standard to [other] disparagement claims.").

441. See *Harjo I*, 50 U.S.P.Q.2d (BNA) 1705, 1739 (T.T.A.B. 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003).

442. Joshua R. Ernst & Daniel C. Lumm, *Does Budda Beachwear Actually Fit? An Analysis of Federal Registration for Allegedly Disparaging Trademarks in the Non-corporate Context*, 10 WAKE FOREST INTELL. PROP. L.J. 177, 211 (2010).

443. In *In re Lebanese Arak Corp.*, the majority used a similar argument in response to the dissent's belief that the analysis should be considered from the standpoint of the general public. *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d at 1219; see also *supra* note 268; *supra* pp. 414-15.

of these scholars have proposed persuasive modifications, others have failed to consider the implications of their suggestions.

One proposal would allow petitioners in future trademark-cancellation proceedings to demonstrate the disparaging nature of the mark “by showing *either* a substantial composite of the referenced group *or* a substantial composite of the general population would find the mark disparages the referenced group.”<sup>444</sup> However, the district court explicitly rejected this type of analysis in *Harjo II*.<sup>445</sup> There, the evidence demonstrated that “the views of Native Americans on this issue [are] not congruent with that of the population as a whole.”<sup>446</sup> This is also true outside the contours of *Harjo*. The views of the highly diverse general population could never accurately reflect the views of a specified group, such as an ethnic group.<sup>447</sup> A conglomeration of views or beliefs from an entire population cannot possibly give an accurate depiction of the views, perceptions, or sentiments of a specific group. Changing the standard to account for the views of the general population not only gives unaffected and uninvolved individuals a right to express their opinions but also puts the referenced group—likely to be a minority group—at an obvious disadvantage.

Essentially, these scholars center their argument on the fact that there are some situations where it “may not be economically or physically feasible to accurately survey the referenced group.”<sup>448</sup> Under that rationale, the scholars’ proposed solution to the feasibility problem fails. By their logic, is it not equally infeasible to survey the general population? Although this feasibility concept is a realistic concern, the already weak disparagement standard should not be worsened to account for the difficulties that a trademark petitioner may face in proving his or her claim. A disparagement standard that considers the views of a highly diverse general population would be weaker than the current analytical framework. First, it will likely, if not certainly, be more difficult for a referenced group to find a substantial composite of the general population that has parallel views. Moreover, it is important to note that incorporating the views of the general population into the calculus would continue to obfuscate the differences between the oft-conflated tests for

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444. Ernst & Lumm, *supra* note 442, at 208 (first emphasis added).

445. See *Harjo II*, 284 F. Supp. 2d at 128–29.

446. *Id.* at 128.

447. See Pace, *supra* note 2, at 34–35.

448. Ernst & Lumm, *supra* note 442, at 208.

scandalousness and disparagement.<sup>449</sup> To be sure, these scholars intended to improve a standard that they view as creating significant and potentially insurmountable hurdles for some groups.<sup>450</sup> However, allowing a demonstration of the general public's views creates more problems than it solves; most notably, it creates more disadvantages for a referenced group.

Alternatively, one scholar has suggested the incorporation of a reasonable person standard.<sup>451</sup> She would have the analysis consider the viewpoint of "a reasonable person under the same or similar circumstances as the [trademark] petitioner."<sup>452</sup> This proposition is much stronger than the suggestion to incorporate the general public's perceptions; however, it is not without flaws. First, since it seems to incorporate part of the scandalousness test, this suggestion fails to avoid, and actually encourages, the conflation of the scandalousness and disparagement analyses. Furthermore, it adds even more discretion to an already highly subjective and discretionary test. A reasonable person standard would, in fact, give the TTAB improper leeway in determining the views of the referenced group.

Moreover, in this type of analysis, it is very easy to conflate the views of the general public and the referenced group. A reasonable person standard is essentially a backhanded consideration of the general public's views. While this suggestion, like those of other scholars, intended to reduce the various prejudices that a trademark petitioner experiences,<sup>453</sup> it fell far short of properly considering the views of the referenced group. The "referenced group" requirement is a very important component of the *Harjo I* test. It is definitely the bright spot in an analysis that has a plethora of problems. One of the most significant problems is the time period that the test considers.

#### *B. The Relevant Time Period: Modern Perceptions as a Factor*

As enunciated in *Harjo I*, the disparagement standard attempts to determine the views and perceptions of the referenced group at the time

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449. See Carpenter & Murphy, *supra* note 59, at 471–72 (discussing the tendency for examiners to conflate the two standards).

450. Ernst & Lumm, *supra* note 442, at 208.

451. Paczkowski, *supra* note 440, at 4–5, 9–10.

452. See *id.* at 4–5.

453. See *id.* at 4–5, 9–10.

of a challenged mark's registration.<sup>454</sup> Although it is logical to engage in this analysis, the TTAB has repeatedly demonstrated how difficult it is to calculate. For example, it struggled with this assessment in *Blackhorse I*, relying substantially on, among other things, (1) the NCAI resolution (produced three years *after* the last registration),<sup>455</sup> (2) petition letters "written *at the end or just after* the relevant time period,"<sup>456</sup> and (3) limited dictionary evidence.<sup>457</sup> The TTAB placed too much focus on the *current* viewpoints of American Indians. Similarly, in *In re Heeb Media*, the TTAB abruptly abandoned the "at the time" analysis, seeking to determine the views and perceptions of the referenced group "in the context of contemporary attitudes."<sup>458</sup> In sum, this portion of the test is problematic. One scholar criticized the analysis as completely ineffective without the use of time travel.<sup>459</sup>

Other scholars suggest that the standard should instead require an assessment of the disparaging nature of a challenged mark at the moment a trademark petitioner files his or her petition.<sup>460</sup> Since the Lanham Act seems to set the relevant time period for a disparagement analysis at the time of a challenged mark's registration,<sup>461</sup> Congress would have to amend the statute's language to allow for consideration of a group's modern perceptions.<sup>462</sup> Of course, the TTAB could continue to circumvent this statutory requirement and consider any perception, regardless of time frame.<sup>463</sup> However, the obvious result of that decision would be a greater possibility of reversal on appeal—as seen in *Harjo II*.<sup>464</sup>

It appears that without an amendment to the statute, the "time frame" component is unlikely to change. Assuming that the statute is amended, a "modern perception" analysis should not completely replace the "at the time" language. Rather, the amendment should include modern

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454. *Harjo I*, 50 U.S.P.Q.2d (BNA) 1705, 1735 (T.T.A.B. 1999), *rev'd on other grounds*, 284 F. Supp. 2d 96 (D.D.C. 2003).

455. *See Blackhorse I*, 111 U.S.P.Q.2d (BNA) 1080, 1098–99 (T.T.A.B. 2014), *aff'd*, 2015 WL 4096277 (E.D. Va. July 8, 2015).

456. *Id.* at 1104 (emphasis added).

457. *See id.* at 1118 (Bergsman, J., dissenting).

458. *In re Heeb Media, L.L.C.*, 89 U.S.P.Q.2d (BNA) 1071, 1074 (T.T.A.B. 2008).

459. Reiner, *supra* note 76, at 24.

460. Ernst & Lumm, *supra* note 442, at 212.

461. *See* 15 U.S.C. § 1064(3) (2012).

462. *See* Ernst & Lumm, *supra* note 442, at 212–13.

463. *Id.* at 212.

464. *Id.*; *see also Harjo II*, 284 F. Supp. 2d 96, 144–45 (D.D.C. 2003).

perceptions as a factor, viewed in *addition* to any perceptions that existed at the time of a challenged mark's registration. Such an analysis would allow for a complete assessment of the term's nature—both past and present. Indeed, there may be situations where one point in time is more applicable to the calculus than the other; alternatively, the calculus may benefit from a dual assessment.<sup>465</sup> The benefits of such an amendment and the resulting standard are flexibility and the likelihood of producing factually sound decisions, as opposed to today's decisions that rely on evidence “with which a positive can be spun out of a negative and the reverse.”<sup>466</sup>

Under this proposal, a trademark petitioner could submit evidence that a mark, although not disparaging at the time of registration, has become disparaging over time. In fact, that evidence may actually “demonstrate the fact that the mark had the potential to be disparaging from the outset, and therefore, should never have been granted registration.”<sup>467</sup> Conversely, unlike the Washington Redskins and Pro-Football, Inc., future respondents could successfully assert a “secondary meaning” defense. In other words, future respondents could claim that a challenged mark had—over time—acquired a strong secondary meaning that could not reasonably be associated with, or disparaging to, a trademark petitioner or any member of a referenced group.<sup>468</sup>

Therefore, it is vitally important to incorporate a “modern perceptions” factor into the analysis. With the laches defense in a state of flux, respondents are effectively defenseless without the “secondary

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465. It is necessary to have a standard that is capable of accounting for the ever-changing nature of our society.

“If a trademark was registered in a time of more virulent racism, it is conceivable that either internalized racism or lack of hope for success prevented members of a disparaged group from bringing a challenge within the five-year period.” On the other hand, slang terms and nicknames that used to be socially acceptable and are now disparaging may not be seen as such under the [current] standard. This may be true even when a particular mark was disparaging all along, but not perceived as such by a substantial composite of the relevant group.

Carpenter & Murphy, *supra* note 59, at 478 (quoting Regan Smith, Note, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 481 (2007)); see also Pace, *supra* note 2, at 9–10 (referencing the fact that trademarks are fluid by nature and can change in accordance with society).

466. Reiner, *supra* note 76, at 24.

467. Pace, *supra* note 2, at 33.

468. See Paczkowski, *supra* note 440, at 4.

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meaning” defense.<sup>469</sup> The disparagement standard would certainly benefit from an analysis that considers the modern perceptions of a term or mark in addition to any perceptions that existed at the time of a challenged mark’s registration. A similar, perhaps greater, benefit would result from the disposal and replacement of the “substantial composite” language.

*C. The “Substantial Composite” Analysis:  
Nothing Less Than a Majority*

The weakest, most problematic element of the disparagement standard is the “substantial composite” language. The TTAB has never set forth any guidelines for determining what constitutes a substantial composite.<sup>470</sup> Instead, it simply reiterates that such a composite “is not necessarily a majority.”<sup>471</sup> Despite the TTAB’s consistent refusal to define a substantial composite, there has been very little criticism of this portion of the analysis. Although limited, the negative comments associated with the “substantial composite” language emphasize its imprecise and ambiguous nature.

In *In re Mavety Media Group, Ltd.*, the United States Court of Appeals for the Federal Circuit highlighted “the inherent difficulty in fashioning a single objective measure like a substantial composite of the general public [or referenced group] from the *myriad of subjective viewpoints*.”<sup>472</sup> Similarly, in *In re McGinley*—the case credited with introducing the “substantial composite” concept—the dissenters expressed animosity for this guideline and claimed that it did not have precedential support.<sup>473</sup> The dissenters were confused by the “substantial composite” concept and could not understand “how one can have a ‘composite’ of a class such as ‘the general public.’”<sup>474</sup>

The problem is that no court or agency has enunciated a guideline, not even a threshold percentage, to help shape the disparagement analysis. Rather, the reviewing entity (usually the TTAB) is simply asked to determine whether a substantial composite, not necessarily a majority,

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469. *See id.*

470. *See In re Heeb Media, L.L.C.*, 89 U.S.P.Q.2d (BNA) 1071, 1077 (T.T.A.B. 2008).

471. *Id.*

472. *In re Mavety Media Grp., Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (emphasis added) (citing *In re McGinley*, 660 F.2d 481, 487 (C.C.P.A. 1981) (Rich, J., dissenting)).

473. *See In re McGinley*, 660 F.2d at 487 (Rich, J., dissenting).

474. *Id.*

of the referenced group may be disparaged by the challenged marks. In doing so, it must determine—using only its judgment—what constitutes a substantial composite within the context of the particular case. Thus, under the current disparagement standard, the TTAB has the freedom to exercise an inordinate amount of discretion, which often leads to the enunciation of incorrect, unreasoned, and inconsistent holdings.

The problematic nature of this guideline is most apparent when considered in the context of *Harjo* and *Blackhorse*. First, there are several statements from American Indians on both sides of the argument, demonstrating a strong divide on the issue of whether the term *redskins* is offensive or disparaging.<sup>475</sup> This discord in the group's viewpoints is further highlighted by various studies, surveys, and evidence in the trial record. For example, the TTAB based its conclusion—that approximately thirty percent of American Indians classified the term *redskins* as offensive or disparaging—on one organization's resolution.<sup>476</sup> What about the views of the other seventy percent? Some surveys have shown that a large composite of "Native Americans apparently do not believe the use of Indian team names is objectionable."<sup>477</sup> For instance, a *Sports Illustrated* survey from 2002

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475. See Steinberg, Vargas & Shapira, *supra* note 5; see also Michael Martinez, *A Slur or Term of 'Honor'? Controversy Heightens about Washington Redskins*, CNN (Oct. 12, 2013, 4:11 PM), <http://www.cnn.com/2013/10/12/us/redskins-controversy/> [<http://perma.cc/4BX2-NPA6>]; Rick Reilly, *Have the People Spoken?*, ESPN (Sept. 18, 2013), [http://espn.go.com/nfl/story/\\_id/9689220/redskins-name-change-not-easy-sounds](http://espn.go.com/nfl/story/_id/9689220/redskins-name-change-not-easy-sounds) [<http://perma.cc/Y8YQ-GYVY>].

476. *Blackhorse I*, 111 U.S.P.Q.2d (BNA) 1080, 1108–12 (T.T.A.B. 2014), *aff'd*, 2015 WL 4096277 (E.D. Va. July 8, 2015).

477. Hylton, *supra* note 68, at 886. Survey evidence is incredibly important under the proposed disparagement standard. This type of evidence is the best way to demonstrate that a majority of the referenced group considers a certain mark to be disparaging. It is important to note, however, that the survey must be a proper and appropriate one, reducing the chance of inaccurate or tainted results—issues related to the surveys discussed in both *Harjo* and *Blackhorse*. See generally Johnson & Johnson \* Merck Consumer Pharm. Co. v. Smithkline Beecham Corp., 960 F.2d 294 (2d Cir. 1992). Again, in *Blackhorse II*, the district court declared that "[w]hen reviewing whether a mark 'may disparage,' the PTO does not, and practically cannot, conduct a poll to determine the views of the referenced group." *Blackhorse II*, 2015 WL 4096277, at \*23.

That statement is a bit conclusory. It certainly seems like the examiners can do more to get an accurate reading on the views of the referenced group. It may not be feasible to survey *every* member of the group, but the time and resources used to consider dictionary, media, and literary evidence need to be repurposed toward achieving a greater understanding of a referenced group's views and opinions. The reviewing entities should not assess evidence that is excluded by the standard simply because the standard they created is not practical. If they are struggling to assess evidence under this problematic

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indicated that a “significant majority of Native Americans supported the continued use of Native American team names.”<sup>478</sup> This finding is corroborated by evidence that some American Indians have chosen to use the term *redskins*, and other American Indian names, for their own teams.<sup>479</sup> Whatever the true nature and effect of the term, there is undoubtedly an opinion-based divide among American Indians.

Opposing viewpoints, like those discussed here, exist in nearly every disparagement case. In many situations, trademark petitioners are successful because they demonstrate that a certain composite—often a minority—of the referenced group shares their viewpoints, and the TTAB simply accepts that evidence as probative and substantial. But what happens when other parties produce alternative evidence that supports *their* position and demonstrates that as many or more members of the referenced group do not support or agree with a trademark petitioner’s expressed viewpoints? According to the TTAB, “once a substantial composite has been found, the mere existence of differing opinions cannot change the conclusion.”<sup>480</sup>

It is wrong for the TTAB to discredit evidence merely because a trademark petitioner has previously demonstrated that a certain number, such as thirty percent, of people disagree with the trademark or its use in the marketplace. The standard, therefore, must be altered to avoid that situation and the tendency for a term or mark to be classified as disparaging by a small subset of a larger community.<sup>481</sup> Indeed, “[i]t 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 another, more sizeable group.<sup>482</sup>

Since it is obviously difficult to reason through a “myriad of subjective viewpoints,”<sup>483</sup> the “substantial composite” assessment should

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standard, then it is time for a new one.

478. Hylton, *supra* note 68, at 886; *see also* Reilly, *supra* note 475 (“[A]n Annenberg Public Policy Center poll found that 90 percent of Native Americans were not offended by the [team’s] name . . .”).

479. Hylton, *supra* note 68, at 886.

480. *Blackhorse I*, 111 U.S.P.Q.2d (BNA) at 1111.

481. *See In re Heeb Media, L.L.C.*, 89 U.S.P.Q.2d (BNA) 1071, 1076–77 (T.T.A.B. 2008).

482. *Id.* (quoting Applicant’s Reply Brief, *supra* note 253, at 4–5); *see also Harjo II*, 284 F. Supp. 2d 96, 135 (D.D.C. 2003) (highlighting respondent’s argument that there was no way to equate or extend the original petitioners’ views to every other American Indian).

483. *In re Mavety Media Grp., Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994).

be removed from the calculus. In other words, the standard should require a majority, not a substantial composite. This is simply a more logical approach. If the majority of the referenced group finds a trademark disparaging, then it would arguably be appropriate in that situation to cancel or deny the mark's registration; however, the reverse is equally true. A trademark should not be cancelled or condemned unless it is clearly established that a majority of the referenced group may be disparaged by the mark. Reviewing entities can avoid improper decisions by ceasing to impose a standard that permits a finding of disparagement where the evidence has failed to demonstrate a consensus within the referenced group.<sup>484</sup>

If one replaces the "substantial composite" language with the term *majority*, then it becomes much harder for reviewing entities (currently free to determine what actually represents a substantial composite) to reach decisions based solely on inferential conclusions. For example, in *Blackhorse*, the TTAB considered and relied on the inferences stemming from the NCAI resolution to find a substantial composite, but it would, of course, have needed more evidence to find a majority. As this example demonstrates, evidentiary inferences would no longer be overly damaging. This aspect of the proposal is, therefore, responsive to the criticism that many of the TTAB's decisions are too inferential.<sup>485</sup>

Another advantage of the suggested standard is that it would make evidence obtained or created outside of the relevant time period, such as the NCAI resolution, relevant to the overall analysis. The currently problematic resolution would be pertinent to the analysis under the proposed "modern perceptions" factor. Hence, under the suggested standard, the TTAB would not have to jump through analytical hoops to make certain pieces of evidence appear applicable.

#### *D. Other Considerations: Procedural Inadequacies*

Beyond the standard, there are some deficient procedural practices that must also be reconsidered. First, examiners should be required to give precedential value to their prior decisions. Currently, the individuals examining the trademarks are not required to adhere to, or even loosely

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484. See Blankenship, *supra* note 78, at 447 (quoting Jendi B. Reiter, *Redskins and Scarlet Letters: Why "Immoral" and "Scandalous" Trademarks Should Be Federally Registrable*, 6 FED. CIR. B.J. 191, 204 (1996)).

485. See *Harjo II*, 284 F. Supp. 2d at 128.

follow, “other registration decisions when considering whether or not to register a mark, including decisions based on marks belonging to the same applicant.”<sup>486</sup> Moreover, there must be some limit on how often trademark petitioners can challenge the same marks.<sup>487</sup> For example, the Washington Redskins have been defending their trademarks for approximately twenty-three consecutive years. After almost seventeen years of litigation, they finally defeated the first challenge in 2009; however, they were immediately thrust into a second, identical challenge being asserted by a group of new petitioners. This is the direct result of the federal courts’ hesitance to address the merits of the disparagement claim in *Harjo*.<sup>488</sup>

It is strange and illogical for a legal system to allow two identical challenges to occur sequentially, forcing over twenty years of resource-depleting litigation upon any given trademark owner or applicant. Whether it is based on time (in years), type or nature of the claim, or a different option, there needs to be some type of limitation. Overall, the “somewhat vague” and “highly subjective” disparagement standard,<sup>489</sup> coupled with a collection of procedural inequities, places most trademark owners and applicants in an extremely difficult situation. For evidence of this claim, one needs to look no further than *Harjo* or, more recently, *Blackhorse*.

Unfortunately, the continued application of this highly discretionary standard is likely to result in more inference-heavy decisions that lack evidentiary support and provide little, if any, precedential value. The Lanham Act has been in effect for nearly seventy years; however, reviewing entities have yet to develop a consistent analysis with respect to disparagement claims. If the current standard is not remediated, other organizations—much less controversial than the Washington Redskins—may be subject to the same uncertain legal voyage.

*E. What Does This Mean for Other Organizations Using Trademarks Similar to Those Challenged in Harjo and Blackhorse?*

There are several professional sports teams that currently use

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486. See Carpenter & Murphy, *supra* note 59, at 479.

487. See Ernst & Lumm, *supra* note 442, at 213.

488. See *Blackhorse II*, No. 1:14-cv-01043-GBL-IDD, 2015 WL 4096277, at \*4 (E.D. Va. July 8, 2015).

489. *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990) (quoting *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1471 (T.T.A.B. 1988)).

monikers related to American Indians: the Atlanta Braves (MLB), Cleveland Indians (MLB), Chicago Blackhawks (NHL), Kansas City Chiefs (NFL), and, of course, the Washington Redskins (NFL).<sup>490</sup> Some argue that this list should include the Golden State Warriors (NBA); however, the team abandoned its American Indian imagery long ago—severing most, if not all, ties to the ethnic group.<sup>491</sup> The teams operating under these labels have experienced some backlash for their continued use of the terms *Braves*, *Indians*, *Blackhawks*, and *Chiefs*, even though those terms are not usually considered as distasteful or offensive as the term *Redskins*.<sup>492</sup> Many people claim that the terms continue to cause harm by inappropriately exploiting the American Indian culture.<sup>493</sup> For many years, those individuals could only express their views through public demonstration and protest; however, the inception of both *Harjo* and *Blackhorse* has forged legal “avenues” capable of serving “as a catalyst for change.”<sup>494</sup>

Since the four previously mentioned marks are usually perceived differently than those at issue in *Harjo* and *Blackhorse*, it is unlikely that the original disparagement standard or the standard proposed herein would be of much assistance to a trademark petitioner who chooses to assert that those four marks are disparaging. However, the proposed standard’s incorporation of modern perceptions would at least give trademark petitioners a better chance of successfully challenging these and other terms. Under the proposed standard, the TTAB could view the marks in the context of contemporary opinions, which currently include a strong sentiment against American Indian mascots.<sup>495</sup>

As previously mentioned, there is no legal requirement that can force

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490. Mark S. Nagel & Daniel A. Rascher, *Washington “Redskins”—Disparaging Term or Valuable Tradition?: Legal and Economic Issues Concerning Harjo v. Pro-Football, Inc.*, 17 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 789, 790–91 (2007); see also Erik Brady, *Redskins Not Only Team Targeted for Indian Nickname*, USA TODAY (May 5, 2014, 11:07 AM), <http://www.usatoday.com/story/sports/2014/05/04/redskins-mascot-nickname-indians-wahoo-chiefs-blackhawks-braves/8705159/> [<http://perma.cc/59DA-WSET>].

491. See Hylton, *supra* note 68, at 882.

492. See Blankenship, *supra* note 78, at 454.

493. *Id.*

494. See Steven R. Latterell, Note, *Stopping the “Savage Indian” Myth: Dealing with the Doctrine of Laches in Lanham Act Claims of Disparagement*, 80 IND. L.J. 1141, 1142 (2005).

495. See generally CHANGTHEMASCOT.ORG, <http://www.changethemascot.org/> [<http://perma.cc/ED9K-CMLY>] (last visited Nov. 7, 2015).

these particular teams to change their names.<sup>496</sup> Without a more promising form of legal recourse, public pressure seems to be the only way to bring about any desired change. As it relates to high schools and colleges, the use of public pressure has worked well to encourage the abandonment of American Indian names and mascots.<sup>497</sup> For example, in 1970, the University of Oklahoma started a trend when it dropped its American Indian mascot—"Little Red."<sup>498</sup> After that, many other colleges and universities abandoned their names, images, and mascots.<sup>499</sup> It is important to note that public pressure may be less likely to result in similar success when directed toward professional sports.

The implications of the current, less-than-adequate disparagement standard have the potential to extend well beyond the realm of sports. What about *Red Man*—the registered trademark for a brand of chewing tobacco?<sup>500</sup> This mark is arguably on the same analytical playing field as those in *Harjo* and *Blackhorse*.<sup>501</sup> At this point in the discussion, one would certainly be justified in assuming that the *Red Man* and *Redskins* trademarks have experienced similar fates. However, despite obvious similarities, the *Red Man* trademark has successfully completed the renewal process and is still registered.<sup>502</sup> This type of conflicting and confusing outcome is the result of a standard that provides reviewing

496. *Blackhorse II*, No. 1:14-cv-01043-GBL-IDD, 2015 WL 4096277, at \*6 (E.D. Va. July 8, 2015) (“[T]he TTAB itself [has] pointed out that it is only empowered to cancel the statutory registration of the marks under [s]ection 2(a); it cannot cancel the trademarks themselves.”).

497. See Blankenship, *supra* note 78, at 455.

498. See *History of Progress*, CHANGETHEMASCOT.ORG, <http://www.changethemascot.org/history-of-progress/> [<http://perma.cc/E7HK-CS2Q>] (last visited Nov. 7, 2015).

499. See *id.*; see also Nagel & Rascher, *supra* note 490, at 790. It is worth noting that one of the many colleges and universities to make a change was Oklahoma City University, changing its nickname from the “Chiefs” to the “Stars” in 1999. See *Our History*, OKLA. CITY U., <http://www.okcu.edu/about/history/index> [<http://perma.cc/3PQJ-5DY5>] (last visited Nov. 14, 2015).

500. See RED MAN, Registration No. 2142010; *Trademark Status and Document Retrieval*, U.S. PAT. & TRADEMARK OFF., [http://tsdr.uspto.gov/#caseNumber=75154639&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=75154639&caseType=SERIAL_NO&searchType=statusSearch) [<http://perma.cc/C7UW-ASVY>] (last visited Nov. 7, 2015) [hereinafter *Red Man Trademark Status*].

501. Compare *Red Man Trademark Status*, *supra* note 500 (showing that the *Red Man* trademark registration “has been renewed”), with *Trademark Status and Document Retrieval*, U.S. PAT. & TRADEMARK OFF., [http://tsdr.uspto.gov/#caseNumber=72435127&caseType=SERIAL\\_NO&searchType=statusSearch](http://tsdr.uspto.gov/#caseNumber=72435127&caseType=SERIAL_NO&searchType=statusSearch) [<http://perma.cc/CC3A-JZU9>] (last visited Nov. 7, 2015) (showing that there is “[a] cancellation proceeding pending” for the *Washington Redskins* trademark registration).

502. *Red Man Trademark Status*, *supra* note 500.

entities with very little guidance and an exorbitant amount of discretion. It is time to fix these problems and put an end to an analysis that has plagued trademark law for decades.

#### IV. CONCLUSION

In *Blackhorse II*, the district court had the opportunity to address the various weaknesses and limitations of the current disparagement standard. However, the court bypassed that opportunity and chose to essentially affirm the cancellation of the various trademarks, stripping several federal benefits from the Washington Redskins. With a pending trip to the Fourth Circuit and a potential stop at the United States Supreme Court, *Blackhorse* is far from over. At a minimum, if the constitutional challenges prevail against section 2(a), the cases applying the disparagement standard should serve as an example of the harm that can result from the reckless application of an unchecked standard. On the other hand, if the constitutional challenges fail, the courts need to reassess and revise the standard. In particular, they need to find a way to incorporate a referenced group's contemporary perceptions into the analysis and to replace the "substantial composite" language with the term *majority*. These changes would make the current standard much stronger, less discretionary, and more reliable. In today's society, a strong, workable standard is necessary to properly assess meritorious claims of disparagement and to dispose of those that are nothing more than frivolous assertions driven by a gratuitous sense of political correctness.