

NFL REDSKINS FEDERAL TRADEMARK REGISTRATIONS CANCELLED



BY: ERNEST V. LINEK

On June 18, 2014, in a 2-1 decision in *Blackhorse v. Pro Football, Inc.*, the Trademark Trial and Appeal Board (TTAB)

of the United States Patent and Trademark Office (USPTO) cancelled six federal registrations for trademarks that include the term “Redskins.”

In the Federal Trademark Cancellation Action (No. 92046185) before the TTAB, two judges held in an 81-page majority opinion that the Native American Indian petitioners had successfully shown that these six REDSKINS trademarks were disparaging to Native American Indians.

Under the Federal Trademark Act of 1946 (Lanham Act), these six trademarks were deemed to have been obtained contrary to the provisions of Section 2(a) of the statute (15 U.S.C. 1052(a)), which prohibits registration of any mark that may disparage persons or bring them into contempt or disrepute, and the TTAB ordered that the registrations be cancelled.

A dissenting opinion was filed by one of the three judges on the TTAB panel, based on that judge’s opinion that there was insufficient evidence presented by the petitioners to support the claim of disparagement by the marks. In his dissenting opinion, Judge Bergsman stated:

This case is *not* about the controversy, currently playing out in the media, over whether the term “redskins,” as the name of Washington’s professional football team, is disparaging to Native Americans *today*. The provisions of the

statute under which the Board must decide this case — §§ 2(a) and 14(3) of the Trademark Act, 15 U.S.C. §§ 1052(a) and 1064(3) — require us to answer a much narrower, legal question: whether the evidence made of record in this case establishes that the term “redskins” was disparaging to a substantial composite of Native Americans *at the time each of the challenged registrations issued*.

See generally *Consortio del Prosciutto di Parma v. Parma Sausage Prods., Inc.*, 23 USPQ2d 1894, 1898-99 (TTAB 1992) (discussing the language of Lanham Act § 14(3) and explaining that the “registration was obtained” language Congress used to specify when a registration for a mark may be cancelled under the enumerated statutory provisions, such as § 2(a), “shows an intent that only if it should not have issued in the first place should a registration more than five years old be cancelled”).

In the majority opinion, the TTAB found that based on the evidence presented by the parties and on applicable law, the *Blackhorse* petitioners carried their burden of proof.

By a preponderance of the evidence, the petitioners established that the term “Redskins” was disparaging of Native Americans, when used in relation to professional football services, at the times the various registrations involved in the cancellation proceeding were issued. Thus, in accordance with applicable law, the federal registrations for the “Redskins” trademarks involved in this proceeding must be cancelled.

[MORE ►](#)

[NFL REDSKINS, FROM PAGE 9]

EXACTLY WHAT IS A TTAB CANCELLATION PROCEEDING?

A cancellation proceeding is an action held before the TTAB in which a party seeks to cancel an existing registration of a mark. Such an action is a mini-trial conducted under specific rules of practice before the TTAB, including parts of the Federal Rules of Evidence and the Federal Rules of Civil Procedure.

Under the Trademark Act, a person (including any legal entity) who believes he will be damaged by the continuing registration of a mark may file a petition with the TTAB to cancel the registration, asserting one or more grounds for cancellation.

Most USPTO cancellation proceedings assert grounds for cancellation under Section 2 of the Trademark Act, 15 U.S.C. § 1052, which specifies a variety of types of terms or marks that Congress has determined to be ineligible for federal registration, including those that are determined, as in this case, to disparage an individual or group.

CAN ANY REGISTERED TRADEMARK BE THE SUBJECT OF A CANCELLATION PROCEEDING?

Yes. According to federal trademark law, even a long-standing registration can be the subject of a cancellation proceeding *at any time*, if an appropriate ground for cancellation is asserted.

A claim that a registered trademark was *disparaging* of an individual or group at the time it was originally registered is one such example of a claim that can be appropriately brought at any time, regardless of the age of the registration.

CAN THE TRADEMARK OWNER APPEAL?

Yes. A party dissatisfied with the TTAB's decision has two initial options to seek further judicial review:




(1) One option is to file an appeal to the U.S. Court of Appeals for the Federal Circuit in Washington, D.C.; or

(2) Another option is to file a civil action in the U.S. District Court for the Eastern District of Virginia, which has jurisdiction over civil actions seeking review of TTAB cancellation proceedings.

ARE THE SIX REDSKINS REGISTRATIONS NOW CANCELLED?

No. This decision by the TTAB is not the final decision for these trademarks. The trademark owner, Pro Football, Inc., has now sought review by the U.S. District Court for the Eastern District of Virginia.

THESE SIX FEDERAL REGISTRATIONS FOR TRADEMARKS THAT INCLUDE THE TERM "REDSKINS" WERE CANCELLED IN JUNE:

1.Registration No. 836122 (1967):	2. Registration No. 978824 (1974):	3.Registration No. 986668 (1974):	4. Registration No. 987127 (1974):	5. Registration No. 1085092 (1978):	6. Registration No. 1606810 (1990):
	WASHINGTON REDSKINS			REDSKINS	REDSKINETTES

Accordingly, these six REDSKINS registrations will remain “on the federal register of marks” and not be listed in the USPTO’s records as “cancelled” until after all judicial reviews have been completed. This could include a final appeal to the U.S. Supreme Court.

WHAT DOES THE TTAB DECISION MEAN FOR THESE TRADEMARKS?

If the cancellation of the registrations for the trademarks involved in this case is affirmed following all possible reviews in the federal courts, Pro Football, Inc., as record owner of the involved registrations, would lose the legal benefits conferred by federal registration of the marks. Such lost benefits include:

- (a) the legal presumptions of ownership and of a nationwide scope of rights in these trademarks;
- (b) the ability to use the federal registration ® symbol, and;
- (c) the ability to record the registrations with the U.S. Customs and Border Patrol Service so as to block the importation of infringing or counterfeit foreign goods.

WHAT DOES THE TTAB DECISION NOT MEAN FOR THESE TRADEMARKS?

This decision does not require the Washington D.C. professional football team to change its name or stop using the trademarks at issue in this case.

Cancellation of the federal registration of a trademark does not mean that the owner loses all legal rights in the mark. This is because trademark rights in the United States come from use of the mark on or in conjunction with goods or services, not merely from the additional, and optional, step of federal registration.

The TTAB decision — if upheld by the federal courts — determines only whether a mark can be registered with the federal government (and

thus gain the additional legal benefits thereof), not whether it can be used.

Regardless of the federal registration status, the trademark owner retains its rights in the mark based on use of the mark. Such rights are known as “common law” rights, and those use-based rights will continue to exist even if a federal registration is cancelled.

PRO FOOTBALL APPEALS TTAB DECISION

On August 14, 2014, Pro Football Inc., the owner of the subject Washington Redskins trademarks, filed a federal lawsuit seeking to overturn the USPTO’s cancellation of its trademark registration on grounds that the name is disparaging to Native Americans, calling the agency’s decision “replete with errors of fact and law” and additionally, unconstitutional.

The complaint, filed in the U.S. District Court for the Eastern District of Virginia, claimed that the TTAB ruling against the team violated the First and Fifth Amendments of the U.S. Constitution. It urged the court to reverse the TTAB’s decision, declare that the word “Redskins” and the team’s marks do not disparage Native Americans, and deem part of the Lanham Act unconstitutional under the First Amendment, among other remedies.

According to the complaint:

“The Redskins Marks, as designations of the professional football team, do not disparage Native Americans or bring them into contempt or disrepute under any analysis of the terms ‘disparage,’ ‘contempt,’ or ‘disrepute.’ To the contrary, the name ‘Redskins,’ when used in association with professional football — as it has been for over 80 years — *denotes only the team* and connotes the history and tradition of the club.” [MORE ►](#)

[NFL REDSKINS, FROM PAGE 11]

In the appeal, Pro Football seeks an Order of the Court regarding the following:

- (1) Reversing the TTAB Order scheduling the cancellation of the Redskins Marks;
- (2) Declaring that the word “Redskins” or derivations thereof contained in the Redskins Marks, as identifiers of the Washington, D.C. professional football team, do not consist of or comprise matter that may disparage Native Americans;
- (3) Declaring that Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), is unconstitutional, both on its face and as applied to Pro Football by the TTAB, under the First Amendment of the U.S. Constitution, and is void for vagueness;
- (4) Declaring that the TTAB Order violates Pro Football’s rights under the Fifth Amendment of the U.S. Constitution; and
- (5) Declaring that Defendants’ petition for cancellation in the TTAB challenging the Redskins Marks under Section 2(a) was barred at the time it was brought by the doctrine of laches.

According to the Complaint, errors made by the TTAB include its failure to restrict its analysis to the relevant time frame of 1967-1990, when the registrations were first issued. As articulated by the dissent:

It is astounding that the petitioners did not submit any evidence regarding the Native American population during the relevant time frame, nor did they introduce any evidence or argument as to what comprises a substantial composite of that population thereby leaving it to the majority to make petitioners’ case have some semblance of meaning (Bergsman, A.T.J., dissenting).

WHAT HAPPENS NOW?

This case is far from over. The petitioners now have 60 days to respond to the complaint, just as Pro Football did after the TTAB’s decision.

New evidence can be presented to the district court by both parties — and it is expected that this will be done by both sides. The district court case will proceed according to a schedule set by the court, much like the previous district court case, *Harjo v. Pro-Football Inc.*, based on another TTAB decision that cancelled several REDSKINS trademark registrations.

The reputation of the Eastern District of Virginia court as a “rocket docket” will likely mean that this case will be decided on a faster track than the previous case handled by the U.S. District Court for the District of Columbia. In 1999, the TTAB ruled that the name Washington Redskins was disparaging in the *Harjo* case but the decision was reversed on appeal because the TTAB’s finding of disparagement was not supported by substantial evidence and the suit was barred by laches.

The new venue is a result of the America Invents Act, as cases from the TTAB are now reviewed at the Eastern District of Virginia court. Will there be enough evidence this time or is the dissenting judge in the TTAB correct?

Stay tuned. ■