Cooley

Federal Court Upholds Cancellation of REDSKINS Trademark Registration

July 9, 2015

On July 8, 2015, a federal district court in Virginia upheld a ruling canceling six federal trademark registrations incorporating the term REDSKINS owned by the Washington, D.C. football team. The court agreed with the Trademark Trial and Appeal Board (TTAB) that the team's registrations were issued contrary to a federal law prohibiting registration of marks that "may disparage" a person or group. The decision in *Pro-Football, Inc. v. Blackhorse*, No. 1:14-cv-01043-GBL-IDD (E.D. Va.) does not bar the team from using the marks, but strips it of the legal protections of federal registration.

Background

The district court's summary judgment in favor of the Native American petitioners who sought to cancel the registrations is the latest chapter in litigation that has been ongoing since 1992, when a group led by Suzan Shown Harjo asked the TTAB to cancel the registrations under Section 2(a) of the Lanham Trademark Act as "scandalous" and disparaging. The TTAB ruled in their favor, but an appeals court reversed that decision for delay in bringing the challenge in *Pro-Football, Inc. v. Harjo*, 595 F.3d 880 (D.C. Cir. 2009).

Meanwhile, a group of young Native Americans including Navajo social worker Amanda Blackhorse filed their own petition to cancel the registrations, which the TTAB granted last year in *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014). On appeal to the district court, the team challenged Section 2(a) as an unconstitutional restraint on its speech, and the federal government intervened to defend the law's constitutionality.

Practical considerations

Section 2(a) permits refusal of any mark that "may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols or bring them into contempt, or disrepute." The court ruled that only a "substantial composite" of the referenced group—not a majority—need to consider the mark "disparaging." But the mark must "disparage" as of the time of registration, in this case as early as 1967.

Evidence of dictionary definitions and accompanying editorial designations; scholarly, literary, and media references; and statements of individuals or group leaders of the referenced group going back to 1967 was relevant to show that the mark "may disparage," the court said.

First Amendment questions

The team argued that the ban on registering disparaging marks violated its First Amendment rights of free speech, but the court pointed out that the team was free to keep *using* its marks without registration. In addition, the court held that to require the trademark office to issue federal registration certificates for disparaging marks would violate the *government's* free speech rights—by making it give (literally) a seal of approval to such marks.

Citing the recent Supreme Court decision in *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015) – which upheld Texas' refusal to issue a Confederate flag license plate – the court held that "the federal trademark registration program is government speech" and that the public "closely associates" federal registration with the government.

But that reasoning may be in tension with precedent such as *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 at *5 n.3 (T.T.A.B. 1993), in which the TTAB noted "Just as the issuance of a trademark registration by this Office

does not amount to a government endorsement of the quality of the goods to which the mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a "good" one in an aesthetic, or any analogous, sense."

And this decision certainly will not be the last word. It probably will be appealed. In addition, the U.S. Court of Appeals for the Federal Circuit will soon hear oral argument on the constitutionality of Section 2(a) in *In re Simon Shiao Tam* (No. 14-1203), in which a music group comprised of Asian-Americans has appealed the TTAB's decision to refuse registration of its mark THE SLANTS as disparaging.

This content is provided for general informational purposes only, and your access or use of the content does not create an attorney-client relationship between you or your organization and Cooley LLP, Cooley (UK) LLP, or any other affiliated practice or entity (collectively referred to as "Cooley"). By accessing this content, you agree that the information provided does not constitute legal or other professional advice. This content is not a substitute for obtaining legal advice from a qualified attorney licensed in your jurisdiction, and you should not act or refrain from acting based on this content. This content may be changed without notice. It is not guaranteed to be complete, correct or up to date, and it may not reflect the most current legal developments. Prior results do not guarantee a similar outcome. Do not send any confidential information to Cooley, as we do not have any duty to keep any information you provide to us confidential. When advising companies, our attorney-client relationship is with the company, not with any individual. This content may have been generated with the assistance of artificial intelligence (AI) in accordance with our AI Principles, may be considered Attorney Advertising and is subject to our legal notices.

This information is a general description of the law; it is not intended to provide specific legal advice nor is it intended to create an attorney-client relationship with Cooley LLP. Before taking any action on this information you should seek professional counsel.

Copyright © 2023 Cooley LLP, 3175 Hanover Street, Palo Alto, CA 94304; Cooley (UK) LLP, 22 Bishopsgate, London, UK EC2N 4BQ. Permission is granted to make and redistribute, without charge, copies of this entire document provided that such copies are complete and unaltered and identify Cooley LLP as the author. All other rights reserved.