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CLIENT ALERT

TTAB Grants Petition to Cancel REDSKINS Registrations

Jun.19.2014

In the latest development in a controversial dispute that has been ongoing for over 20 years, the United States Trademark Trial and Appeal Board has granted a petition to cancel six federal trademark registrations for variations of the mark REDSKINS, owned by Pro-Football, Inc. (the Washington professional football team), on the grounds that the term was disparaging to a substantial composite of Native Americans as of the dates the registrations issued. *Blackhorse v. Pro-Football, Inc.* __ USPQ2d __(TTAB 2014) (Cancellation No. 92046185, June 18, 2014). Pro-Football, Inc. has already stated that it will appeal. While the decision does not affect the football team's right to use the mark, the decision – if it survives appeal – may impact the team's ability to prevent others from doing so.

The six registrations include: REDSKINS, THE REDSKINS, WASHINGTON REDSKINS, REDSKINETTES, and design marks for WASHINGTON REDSKINS and THE REDSKINS. The registrations had issued between 1967 and 1990.

Section 2(a) of the Lanham Act prohibits the registration of any trademark which "may disparage" persons or otherwise bring them into contempt or disrepute. 15 USC §1052(a). A challenged registration must be canceled if it is found to be disparaging *as of the date of registration*. In a 2 to 1 decision ordering the cancellation of the registrations, the Board concluded that the term "redskin(s)" refers to Native Americans and was disparaging, at the time of each registration, to a "substantial composite" of Native Americans. In reaching this opinion, the majority relied on a myriad of evidence, including dictionaries, expert witnesses, testimony of Native Americans and resolutions of Native American interest groups. It concluded that, based on the record, at least 30 percent of Native Americans found the term disparaging. It stated that this is "without a doubt" a substantial component of the referenced group. The dissent was primarily based on the grounds that Petitioners failed to prove that the registrations were disparaging as of the date the registrations issued.

This is the second time the Board has ordered the cancellation of these registrations. In 1999, the Board reached the same conclusion in a cancellation proceeding brought by a different set of Native Americans. See *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999). That decision was ultimately reversed by the United States District Court for the District of Columbia on the grounds that those petitioners were barred by laches. *Pro-Football, Inc. v. Harjo*, 567 F.Supp.2d 46 (D.D.C. 2008), *aff'd*, 565 F.3d 880 (D.C. Cir 2009). While that case was pending, additional younger petitioners commenced the proceeding that resulted in this week's ruling. In this case, the Board rejected the laches defense, holding that "laches does not apply to a disparagement claim where the disparagement pertains to a group of which the individual plaintiff or plaintiffs simply comprise one or more members." The Board also noted that if laches can apply in this situation, then it still would not be applicable here because Pro-Football had not shown that petitioners had unreasonably delayed in bringing the petition. As was the case with prior decision, the Board is not expected to have the last word on this matter.

For more information, please contact the professional(s) listed below, or your regular Crowell & Moring contact.

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