

ARTICLES

The Impact of *Pro-Football, Inc. v. Harjo* on Trademark Protection of Other Marks

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INTRODUCTION

During the 1991 World Series, featuring the Atlanta Braves, and the 1992 Super Bowl, featuring the Washington Redskins, activists opposing the use of these and other names derived from Native American names protested vehemently.¹ That was just the beginning of an intense national debate that continues today.²

Many collegiate and professional teams use mascots, logos, and names derived from Native American names and terms.³

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¹ Laurel R. Davis, *Protest Against the Use of Native American Mascots: A Challenge to Traditional American Identity*, 17 J. SPORT & SOCIAL ISSUES 9, 11 (1993).

² The Native American mascot controversy has been called “sport’s thorniest word problem.” See *infra* note 28 and accompanying text.

³ At one time, over 2,600 teams in the United States used Native American names or symbols. Kristin E. Behrendt, *Cancellation of the Washington Redskins’ Federal Trademark Registrations: Should Sports Team Name, Mascots, and Logos Contain Native American Symbolism?*, 10 SETON HALL J. SPORTS L. 389, 396 n.34 (2000). Since 1969, over 600 high school, college, and minor league teams have eliminated these uses, most because of political pressure. *Id.*; see also Mark Gokavi, *Pride or Contempt?*, DAYTON DAILY NEWS, June 7, 2001, at 10D; S.L. Price, *The Indian Wars*, SPORTS ILLUSTRATED, Mar. 4, 2002, at 66. Some of the teams that have changed their names include the University of Oklahoma “Big Red” in 1970, the Stanford “Indians” in 1972, the Dartmouth “Indians” in 1974, the Saint John’s University “Redmen” in 1994, the

Although several articles discuss the issue of Native American names used as sports team names generally,⁴ this Article focuses on the recent decision of the U.S. District Court for the District of Columbia, which reversed the Trial Trademark and Appeal Board's cancellation of the "Redskins" trademark.⁵

This Article considers the use of Native American terms and images as mascots, logos, and names of sports teams in the wake of the recent *Harjo* decision.⁶ Part I of this Article gives a broad overview of the Native American mascot controversy, the structure of professional and collegiate licensing, and the attempts to limit use of Native American terms as mascots, logos, and names. Part II reviews trademark law generally and the prohibition of trademark protection for disparaging and scandalous marks. Part III discusses the *Harjo* case history, while Part IV considers the impact of trademark law generally and the *Harjo* decision specifically on the use of Native American mascots, logos, and names. This Article concludes in Part V that (1) the court's decision not to cancel the "Redskins" trademark will not affect most other Native American mascots, logos, and names, (2) other marks using Native American mascots, logos, and names could

Miami of Ohio "Redskins" in 1996, as well as the Sioux City Iowa "Soos" (minor league baseball) and the Marquette University "Warriors"; some Native American team names that remain in use include the Atlanta "Braves" (baseball), the Chicago "Blackhawks" (hockey), the Cleveland "Indians" (baseball), the Kansas City "Chiefs" (football), the Washington "Redskins" (football), the Florida State University "Seminoles" (college), the University of Illinois "Fighting Illini" (college), and the University of North Dakota "Fighting Sioux" (college). Behrendt, at 395-96 & nn.34-36; Bruce C. Kelber, Note, "Scalping the Redskins: Can Trademark Law Start Athletic Teams Bearing Native American Nicknames and Images on the Road to Racial Reform?", 17 *HAMLIN L. REV.* 533, 540-41 (1994); Gokavi, at 10D; Price, at 70-71; Jose Miguel Romero, *Panel Calls for End to Indian Names*, *SEATTLE TIMES*, Apr. 14, 2001, at D1.

⁴ See, e.g., Kristine A. Brown, *Native American Team Names and Mascots: Disparaging and Insensitive or Just a Part of the Game?*, 9 *SPORTS LAW. J.* 115, 128 (2002) ("[I]t may be the economic impact resulting from favorable rulings for trademark challengers that will have a more direct effect on professional sports organizations."); Kelber, *supra* note 3, at 575 ("[T]rademark law has the ability to respond to the social ills of racism in cases where owners of Native American team marks have ignored their responsibility."); see also *infra* note 5.

⁵ *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 99 (D.D.C. 2003).

⁶ *Id.*

still be cancelled, and (3) non-legal avenues may be more fruitful to change Native American mascots, logos, and names.

I. THE NATIVE AMERICAN MASCOT CONTROVERSY AND
ATTEMPTS TO LIMIT THE USE OF NATIVE AMERICAN
MASCOTS, LOGOS, AND NAMES

Native American names and images are frequently used as mascots, logos, and names of sports teams.⁷ For example, the athletic teams at Florida State University are known as the Seminoles, and the school mascot is Chief Osceola.⁸ At the beginning of every home football game, a student, representing Chief Osecola, “wearing moccasins, a tasseled leather ‘Indian’ outfit, face paint, and a large bandanna, hoisting a large feathered lance . . . ‘charges down the field riding an appaloosa horse named Renegade and hurls a flaming lance at midfield.’”⁹ The student body sings the “war chant” and engages in the infamous “tomahawk chop.”¹⁰

Critics have suggested that “[t]o characterize the indigenous Seminole people or any other Native nation of North America as

⁷ See *supra* note 3. Other sports team names are also derived from ethnic terms, including the Minnesota “Vikings,” the Montreal “Canadiens,” the Notre Dame “Fighting Irish,” the Bethany College “Swedes,” the Edinboro University “Fighting Scots,” the Iona “Gael,” the Sonoma State University “Cossacks,” the Idaho “Vandals,” the Southern California “Trojans,” the Mississippi “Rebels,” the Louisiana-Lafayette “Ragin’ Cajuns,” the Pennsylvania “Quakers,” the Alaska “Nanooks,” and the San Diego State University “Aztecs”; see also Tom Dangelo, *Look. Hard. Are You Offended?*, PALM BEACH POST, Apr. 4, 2002, at C1.

⁸ C. Richard King & Charles Fruehling Springwood, *The Best Offense . . . Dissociation, Desire and the Defense of the Florida State University Seminoles*, in *TEAM SPIRITS: THE NATIVE AMERICAN MASCOTS CONTROVERSY* 130–31 (2000) (Chief Osceola is “the famous Seminole who led an armed resistance against the United States in the 1830s.”).

⁹ *Id.* at 130. It is considered an honor to be chosen to impersonate Chief Osceola. *Id.* at 138–39. The student chosen must display a “high moral character” and serve a two-year apprenticeship. *Id.*

¹⁰ *Id.* at 131. Fans of other teams, such as the Braves, also engage in the “tomahawk chop.” Julie Cart, *What’s in a Nickname? The Ability to Stir Players and Fans Is Taking a Back Seat to Heightened Sensibilities*, L.A. TIMES, Oct. 24, 1991, at C1.

warlike or bellicose dehumanizes and demonizes them.”¹¹ Supporters, however, quickly point out that neither James E. Billie, chair of the Seminole Tribe of Florida, nor the Seminole people disapprove of the logo, name, or mascot.¹² Interestingly, Florida State University reportedly earns as much as \$1.8 million each year selling merchandise with the team name and mascot.¹³

A. Professional and Collegiate Mascots, Logos, and Names

Teams that use Native American terms as mascots, logos, and names include the Atlanta “Braves” professional baseball organization,¹⁴ the Chicago “Blackhawks” professional hockey organization,¹⁵ the Cleveland “Indians” professional baseball

¹¹ King & Springwood, *supra* note 8, at 141; see also Terence Dougherty, *Group Rights to Cultural Survival: Intellectual Property Rights in Native American Cultural Symbols*, 29 COLUM. HUM. RTS. L. REV. 355, 376 (1998) (“Use of these [trademarked] names and images, some more than others, is dehumanizing to many Native Americans.”); Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse*, 27 CONN. L. REV. 1003, 1010–11 (1995). Native American stereotypes reinforce “the fact that [Native Americans] are presented as ahistorical and contextless.” *Id.* Furthermore, “by rendering native people as inhuman, timeless, and essentialized, these images help promote the myth of the vanishing Indian and in so doing, deprive Indians not just of their history but of their present reality.” *Id.*

¹² King & Springwood, *supra* note 8, at 144. Florida State University has the approval of the Seminole tribe to use the “Seminole” name. Dangelo, *supra* note 7, at C1.

¹³ King & Springwood, *supra* note 8, at 145.

¹⁴ Among others, the Atlanta National League Baseball Club owns the following trademarks: U.S. Trademark Registration Numbers 1,596,052 (registered May 15, 1990) (“Braves”); 1,562,115 (registered Oct. 24, 1989) (“Braves”); 1,561,774 (registered Oct. 24, 1989) (“Atlanta Braves”); 1,484,697 (registered Apr. 12, 1988) (“Atlanta Braves”); 845,032 (registered Feb. 27, 1968) (“Braves”); 829,310 (registered May 23, 1967) (picture of a head of a Native American screaming with a Mohawk and a single feather in his hair); 829,309 (registered May 23, 1967) (“Braves”) (“Braves” in script below a Native American man’s screaming head with a single feather in his hair and a Mohawk); and 829,308 (registered May 23, 1967) (“Braves”). This information is available on the Trademark Electronic Search System, at <http://www.uspto.gov/main/trademarks.htm> (“TESS”) (last visited Feb. 10, 2004).

¹⁵ Among others, the Chicago Blackhawk Hockey Team owns the following trademarks: U.S. Trademark Registration Numbers 1,959,134 (registered Feb. 27, 1996) (“Black Hawks Chicago”) (circle with the words “Black Hawks Chicago” around the profile of a Native American man with feathers in his hair and braids); 1,671,825 (registered Jan. 14, 1992) (profile of a Native American man with feathers in his hair); 1,671,824 (registered Jan. 14, 1992) (“Blackhawks”); 893,053 (registered June 16, 1970) (profile of a Native American man with feathers in his hair); and 893,052 (registered June 16, 1970) (“Blackhawks”). See TESS, *supra* note 14.

organization,¹⁶ the Kansas City “Chiefs” professional football organization,¹⁷ the Florida State University “Seminole,”¹⁸ the University of Illinois “Fighting Illini,”¹⁹ and the University of

¹⁶ Among others, the Cleveland Indians own the following trademarks: U.S. Trademark Registration Numbers 2,569,766 (registered May 14, 2002) (head of a large smiling, big-nosed Native American man with a single feather in his hair); 1,719,618 (registered Sept. 22, 1992) (“Indians”) (fat, cartoonish Native American man with a very large nose wearing an “Indians” jersey and leaning on a baseball bat); 1,711,810 (registered Sept. 1, 1992) (the head of a large-smiling, big hook-nosed Native American man with a single feather in his hair and a small braid); 1,592,740 (registered Apr. 24, 1990) (“Indians”); 1,590,703 (registered Apr. 10, 1990) (head of a large-smiling, big-nosed Native American man with a single feather in his hair); 1,568,426 (registered Nov. 28, 1989) (profile of a Native American man wearing a large feather headdress); 1,543,339 (registered June 13, 1989) (“Indians”); 1,259,795 (registered Dec. 6, 1983) (the head of a large-smiling, big-nosed Native American man with a single feather in his hair); 1,031,410 (registered Jan. 27, 1976) (the head of a large-smiling, big-nosed Native American man with a single feather in his hair). See TESS, *supra* note 14. The visage of the Cleveland Indians’ mascot, Chief Wahoo, has been described by “grinning buck teeth and [a] hook nose.” Jack Achiezer Guggenheim, *The Indians’ Chief Problem: Chief Wahoo as State Sponsored Discrimination and a Disparaging Mark*, 46 CLEV. ST. L. REV. 211, 214 (1998). Scholars have suggested that Chief Wahoo is scandalous and disparaging, but without significant analysis. *Id.* at 232–33. The Cleveland franchise is currently worth a considerable amount of money, and in 1999, the team was sold for \$320 million cash. See Chris Havel, *Brewers Need New Owners, Not a New Manager*, GREEN BAY PRESS-GAZETTE, Apr. 19, 2002, at C1.

¹⁷ Among others, the Kansas City Chiefs Football Club owns the following marks: U.S. Trademark Registration Numbers 1,849,868 (registered Aug. 16, 1994) (“KC”) (football helmet with an arrowhead on it with the initials “KC” in the arrowhead); 1,807,453 (registered Nov. 30, 1993) (“Kansas City Chiefs”); 1,085,091 (registered Feb. 7, 1978) (“Chiefs”); 981,462 (registered Mar. 26, 1974) (“KC Chiefs”) (football helmet with an arrowhead on it with the initials “KC” in it and the word “Chiefs” below the helmet); 982,132 (registered Apr. 9, 1974) (“Kansas City Chiefs KC”); and 974,207 (registered Nov. 27, 1973) (“Kansas City Chiefs”). See TESS, *supra* note 14.

¹⁸ The Florida Board of Regents owns several marks for and on behalf of Florida State University, including U.S. Trademark Registration Number 2,641,958 (registered Oct. 29, 2002) (“FSU”) and Serial Number 76,219,843 (filed Mar. 5, 2001) (“Seminole”). See TESS, *supra* note 14.

¹⁹ The Board of Trustees of the University of Illinois owns several trademarks, including U.S. Trademark Registration Numbers 2,230,527 (registered Mar. 9, 1999) (“Fighting Illini”), 2,232,024 (registered Mar. 16, 1999) (the head of a Native American wearing a very large circular feather headdress), and 1,725,610 (registered Oct. 20, 1992) (“IlliniBook”). See TESS, *supra* note 14. The mascot of the University of Illinois, the “Illini,” is Chief Illiniwek. David Prochaska, *At Home in Illinois: Presence of Chief Illiniwek, Absence of Native Americans*, in TEAM SPIRITS: THE NATIVE AMERICAN MASCOTS CONTROVERSY 157–85 (C. Richard King & Charles Fruhling Springwood eds., 2000) (discussing Chief Illiniwek and the pro- and anti-chief movements in great detail). The University of Illinois already has been punished as violating free speech when it

North Dakota “Fighting Sioux.”²⁰ Sales of professional team apparel generate over a billion dollars a year,²¹ and several major college teams earn millions each year.²² Although most professional teams and many college teams own trademarks on their names and logos, most high schools and amateur teams do not own trademarks.²³

To discourage any one team from gaining a significant financial advantage over other teams based solely on its logo, many professional leagues engage in profit-sharing.²⁴ For

prohibited its staff members who disapprove of the mascot from discouraging recruits. See Associated Press, *Opponents of American Indian Mascot Win Damages; U of Illinois Must Pay \$5,000*, ST. LOUIS POST-DISPATCH, July 23, 2002, at B4.

²⁰ The Ralph Engelstad Arena, Inc., the organization that built the hockey arena of the University of North Dakota “Fighting Sioux” with money donated by Ralph Engelstad, applied for the U.S. Trademark Serial Number 76,197,760, filed on January 22, 2001 (“Ralph Engelstad Arena Home of the Fighting Sioux”) (text circling a profile of a Native American with feathers in his hair), but abandoned the mark on June 13, 2003. See TESS, *supra* note 14. Engelstad, a North Dakota alumnus and the school’s largest benefactor, donated over a hundred million dollars to the school, and repeatedly threatened to cut off funding if the school changed its mascot. Richard Meryhew, *N.D. Arena Benefactor Ralph L. Engelstad Dies at 72: UND’s Largest Donor was Center of Indian Mascot Controversy*, STAR TRIB. (Minneapolis-St. Paul), Nov. 28, 2002, at B1. It is unclear whether his death will affect the school’s decision to retain the name. *Id.*

²¹ Calvin Sims, *It’s Not Just How Well You Play the Game . . .*, N.Y. TIMES, Jan. 31, 1993, § 3, at 5 (pointing out that in 1992 alone, estimates suggest that Major League Baseball sold about \$2.4 billion in licensed merchandise, the National Football League sold about \$2.1 billion, the National Basketball Association sold about \$1.4 billion, and the National Hockey League sold about \$600 million). When the Minnesota Twins won the World Series in 1987, retail sales of postseason merchandise hit \$40 million. Susan Feyder, *Twins Fever: Some Businesses Have It; Others Sweat It Out*, STAR TRIB. (Minneapolis-St. Paul), Oct. 1, 1991, at A1; see also Tony Munroe, *Burgundy and Gold Sales Super—So Long as the Redskins Win*, WASH. TIMES, Jan. 11, 1992, at C6 (“Souvenir hawkers are racking up sales as the Redskins enjoy their best season ever.”).

²² See Kelber, *supra* note 3, 549–50 (“The Collegiate Licensing Company, which coordinates licensing agreements for 126 colleges and universities, estimates that college merchandising has reached nearly \$1.5 billion in sales during 1992.”). Furthermore, many college teams rely on licensing their trademarks for revenue. *College Report: New Saluki Emblem Makes Its Debut*, ST. J. REG. (Springfield, IL), Aug. 12, 2001, at 20 (“The new logo is expected to increase revenue for the university through licensing agreements with manufacturers who produce sweatshirts, caps and similar items. Licensing the use of one official trademark will enhance the visibility of the athletics program and also lead to additional merchandise sales, university officials said.”); see also *supra* note 13 and accompanying text.

²³ See, e.g., *supra* notes 14–20.

²⁴ See *infra* notes 25–27 and accompanying text.

example, the National Football League (“NFL”) grants licenses on the trademarked names, and profits are shared evenly between all of the franchises.²⁵ Other professional leagues, such as Major League Baseball (“MLB”) and the National Hockey League (“NHL”), similarly engage in profit-sharing.²⁶ College teams,

²⁵ See PAUL C. WEILER & GARY R. ROBERTS, *SPORTS AND THE LAW* 459 (2d ed. 1998); see also Jamie Beckett, *NFL's Big Merchandising Play*, S.F. CHRON., Sept. 10, 1990, at C1 (“NFL Properties, which licenses products for the 49ers and the other 27 NFL teams, ambitiously plans for these and other new products to draw \$1 billion in retail sales this year, up from \$650 million last year. . . . In all, NFL Properties has signed up 385 licensees—79 more than last year and more than any other Professional sports concern Major League Baseball is second with 350. To get a product licensed by the NFL, companies generally must pay an amount equal to 9 percent of the wholesale price of the item The NFL has come a long way since 1964, the year then-league Commissioner Pete Rozell (who later developed the Super Bowl) formed NFL Properties to license and manage team trademarks.”); Brooke A. Masters, *Redskins Lose Right to Trademark Protection*, WASH. POST, Apr. 3, 1999, at A1 (“A portion of revenue from the sale of NFL merchandise is kept by the league, and the rest is distributed evenly among all the teams, generating about \$5 million a year for each club.”); Price, *supra* note 3, at 70. The National Football League made \$650 million in retail sales during the 1989 football season. Beckett, at C1. Ten of the twenty-eight teams accounted for about seventy percent of the total sales. *Id.* The sixth highest grossing team with 5.4 percent of the total retail sales was the Washington Redskins. *Id.* Many scholars have failed to address the impact of profit-sharing in their suggestion that financial motives will cause the Redskins to cease using the name. See, e.g., Behrendt, *supra* note 3, at 413 (“Consequently, it is possible that the [Redskins] will lose a large sum of money from royalties that they would have otherwise obtained if the marks were licensed.”).

²⁶ See Don Walker, *Baseball Making Pick Move: It Wants Vendors of Fake Merchandise Out at All-Star Plate*, MILWAUKEE J. SENTINEL, June 25, 2002, at 1C (“Major League Baseball . . . generally receives 10% to 12% of the wholesale price of products it licenses to use team or league trademarks.”); David Naylor, *CFL Moving to Own All Team Names and Logos*, GLOBE & MAIL (Toronto, Can.), Oct. 30, 2001, at S3 (“Bernadette Mansur, vice-president of communications for the National Hockey League, confirmed that in professional hockey, the league, not the teams, owns the respective trademarks and logos.”); see also Danny O’Neil, *Buyers Beware on Merchandise*, SEATTLE TIMES, July 8, 2001, at I4 (discussing the problem of unlicensed vendors generally). Major League Baseball uses an organization, Major League Baseball Properties, Inc., to license for it. See *D’Angelo v. Boston Red Sox Baseball Club L.P.*, No. 97-12446-GAO, 2001 U.S. Dist. LEXIS 18233 (D. Mass. July 9, 2001); *Major League Baseball Props., Inc. v. Sed Olet Denarius, Ltd.*, No. 90 CIV. 2170, 1990 U.S. Dist. LEXIS 13108 (S.D.N.Y. Oct. 5, 1990). The National Hockey League teams use an organization, National Hockey League Services, Inc., to license trademarks for them. See *Boston Prof’l Hockey Ass’n, Inc. v. Dallas Cap & Emblem Mfg., Inc.*, 360 F. Supp. 459 (N.D. Tex. 1973).

however, license their own trademarks and do not engage in profit-sharing.²⁷

B. Attempts to Limit the Use of Native American Mascots, Logos, and Names

The use of Native American names and images has been called “sport’s thorniest word problem.”²⁸ The U.S. Commission on Civil Rights passed a resolution condemning the use of Native American nicknames for sports teams.²⁹ Many types of legal arguments have been suggested to challenge the use of Native American terms as sports names, including (1) public accommodations claims under Title II of the Civil Rights Act of 1964,³⁰ (2) hostile environment claims under Title VI of the Civil Rights Act of 1964,³¹ (3) arguments that names are “insignia” that

²⁷ Actually, many college teams hire a corporation, such as the Collegiate Licensing Company (“CLC”), the largest collegiate licensing corporation, to license trademarks for the colleges. *See* Collegiate Licensing Company, at <http://www.clc.com> (last visited Feb. 12, 2004). Florida State University, the University of Illinois, and the University of North Dakota use CLC to license. *Id.* To obtain a license, applicants must pay significant amounts of money to the CLC for services ranging from the application fee to marketing and product development costs. *See id.* Although the fees vary depending on the school the applicant wishes to license, Florida State University, the University of Illinois, and the University of North Dakota each charge an eight percent royalty rate. *See id.* From July 1, 2001 to June 30, 2002, Florida State University was ranked seventh among the top-selling CLC member colleges (following University of North Carolina, University of Michigan, University of Tennessee, University of Nebraska, University of Florida, and Pennsylvania State University). *See id.* University of Illinois was twenty-first, and University of North Dakota was last, at fiftieth. *Id.* Although the exact rankings vary from year to year, these results are consistent with past rankings. *See supra* notes 13, 22, 26 and accompanying text.

²⁸ Price, *supra* note 3, at 68.

²⁹ Press Release, U.S. Comm’n on Civil Rights, Statement of the U.S. Commission on Civil Rights on the Use of Native American Images and Nicknames as Sports Symbols (2001), available at <http://www.usccr.gov/press/prsndx.htm> (last visited Jan. 29, 2004).

³⁰ 42 U.S.C. § 2000a (2003); *see* Scott R. Rosner, *Legal Approaches to the Use of Native American Logos and Symbols in Sports*, 1 VA. SPORTS & ENT. L.J. 258, 266–67 (2002); Note, *A Public Accommodations Challenge to the Use of Indian Team Names and Mascots in Professional Sports*, 112 HARV. L. REV. 904, 906 (1999) (arguing that “a Title II challenge should succeed if a claimant can make a factual showing that the name or mascot of a sports team deters the patronage of a substantial number of American Indians”).

³¹ 42 U.S.C. § 2000d (2000); *see* Daniel J. Trainor, *Native American Mascots, Schools, and the Title VI Hostile Environment Analysis*, 1995 U. ILL. L. REV. 971 (1995).

should not be allowed trademark protection under section 2(b) of the Lanham Act,³² (4) tribal court actions,³³ (5) commercial speech and First Amendment challenges,³⁴ (6) challenges to state laws on license plates,³⁵ (7) claims of intentional infliction of emotional distress,³⁶ (8) claims of equal protection under the Fourteenth Amendment,³⁷ and (9) challenges using hate speech codes and discrimination laws.³⁸

Arguably, the most successful legal challenges to date involve attacking the propriety of the trademark protection of the mark under section 2(a) of the Lanham Act.³⁹ In addition to legal options, Native American advocates have staged protests surrounding major sporting events and spoken out in the media.⁴⁰ While these protests also have been successful in changing some

³² 15 U.S.C. § 1052(b) (2002); see Maury Audet, *Native American Tribal Names as Monikers and Logos: Will These Registrations Withstand Cancellation Under Lanham Act § 2(b) After the Trademark Study on Official Insignia of Native American Tribes?*, 2 J. INTELL. PROP. 4 (2000).

³³ See Newton, *supra* note 11, at 1005.

³⁴ See Michelle B. Lee, *Section 2(A) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 SPORTS LAW. J. 65 (1997); see also Guggenheim, *supra* note 16, at 223 (arguing that “Chief Wahoo violates the First Amendment by chilling the desire and ability of Native Americans to exercise fully their First Amendment rights”); Rosner, *supra* note 30, at 259–62. For a discussion of the relation of First Amendment law to trademark law, see Justin Blankenship, 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, 419–20 (2001); Jeffrey Lefstin, Note, *Does the First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665 (2000).

³⁵ See *McBride v. Motor Vehicle Div. of Utah State Tax Comm’n*, 977 P.2d 467, 468 (Utah 1999); see also Andre Douglas Pond Cummings, “*Lions and Tigers and Bears, Oh My*” or “*Redskins and Braves and Indians, Oh Why*”: *Ruminations on McBride v. Utah State Tax Commission, Political Correctness, and the Reasonable Person*, 36 CAL. W. L. REV. 11 (1999).

³⁶ See Aaron Goldstein, Note, *Intentional Infliction of Emotional Distress: Another Attempt at Eliminating Native American Mascots*, 3 J. GENDER RACE & JUST. 689, 691 (2000).

³⁷ See Guggenheim, *supra* note 16, at 211.

³⁸ See *id.*; Rosner, *supra* note 30, at 262–66.

³⁹ See, e.g., *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. Apr. 2, 1999). The *Harjo* decision was the first case in which a federal agency came down on the side of Native Americans. See Masters, *supra* note 25, at A1. The *Harjo* decision, and its subsequent reversal, will be discussed in great detail later in this Article.

⁴⁰ See, e.g., Brown, *supra* note 4, at 118–19; Davis, *supra* note 1, at 11.

school mascots and team names, they have had little effect on changing professional team names.⁴¹

II. TRADEMARK LAW

Trademark protection exists under both state and federal law.⁴² Federal trademark law, under the Lanham Act,⁴³ defines a trademark as “any word, name, symbol, or device, or any combination thereof . . . [used] to identify and distinguish . . . goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”⁴⁴ A trademark owner has the right to exclude others from using any mark when there is a likelihood of confusion as to the origin or sponsorship of goods or services.⁴⁵

The Lanham Act is premised on the recognition that when a party has expended resources to develop an identification for its product, it is not equitable to allow another, who has made no such expenditure, to use the unique symbol and to trade on the original party’s goodwill and reputation to promote his or her own goods or services.⁴⁶ There are several benefits to federal trademark registration, including nationwide constructive notice and incontestability of the mark after five years.⁴⁷ There can be many registrations for a single word, as some of the registrations might be for different goods, or different symbols or drawings that

⁴¹ See Kelber, *supra* note 3, at 538–44 (discussing the impact of protesters on the changing of names); *Indian Nickname Dropped*, ST. PAUL PIONEER PRESS, NOV. 25, 1993, at B6 (noting that protesters convinced thirty-one of fifty Minnesota high schools with Native American team names to cease use); see also *supra* note 3 (outlining the history of schools changing their Native American team names). *But see* Blankenship, *supra* note 34, at 456 (noting that to date no professional teams have changed their names).

⁴² If a mark loses federal trademark protection for public policy reasons, it likely will not qualify for state protection either. See *De Nobili v. Scanda*, 198 F. 341 (W.D. Pa. 1912); see also Blankenship, *supra* note 34, at 452–53 & nn.231–32.

⁴³ 15 U.S.C. §§ 1051–1129 (2002).

⁴⁴ 15 U.S.C. § 1127.

⁴⁵ 15 U.S.C. § 1114.

⁴⁶ *Boston Prof'l Hockey Ass'n, Inc. v. Dallas Cap & Emblem Mfg, Inc.* 510 F.2d 1004, 1110–11 (5th Cir. 1975); *Minneapolis Co. v. Normandin*, 338 N.W.2d 18, 22 (Minn. 1983); see also 74 AM. JUR. 2D *Trademarks and Tradenames* § 1 (2003).

⁴⁷ 15 U.S.C. § 1065.

accompany the word. Similarly, a mark can obtain secondary meaning if the new meaning subsumes its original meaning, and the public associates the mark with the new meaning and not the original one.⁴⁸

A petitioner may obtain a federal trademark by filing a trademark application with the U.S. Patent and Trademark Office (“USPTO”).⁴⁹ To obtain federal trademark protection, the mark must be used in commerce,⁵⁰ and must not violate certain statutory provisions.⁵¹ If the USPTO rejects the trademark application, the petitioner may appeal the decision to the Trademark Trial and Appeal Board (“TTAB”).⁵² Decisions from the TTAB may be appealed to either the U.S. District Court for the District of Columbia or to the U.S. Court of Appeals for the Federal Circuit.⁵³

A. Overview of Disparaging and Scandalous Marks

Section 2(a) of the Lanham Act forbids the registration of any mark that “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions,

⁴⁸ Merriam v. Saalfield, 198 Fed. 369, 373 (6th Cir. 1912) (noting that secondary meaning “contemplates that a word or phrase originally, and in that sense primarily, incapable of exclusive appropriation with reference to an article on the market, because geographically or otherwise descriptive, might nevertheless have been used so long and so exclusively by one producer . . . the word or phrase had come to mean that the article was his product; in other words . . . the word had come to be . . . his trademark.”).

⁴⁹ See 15 U.S.C. § 1051.

⁵⁰ See *id.*

⁵¹ See 15 U.S.C. § 1127. Under section 2(a) of the Lanham Act, trademark protection will be denied if the mark “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” 15 U.S.C. § 1052(a).

⁵² See 15 U.S.C. § 1070. Cancellations of existing trademarks may also be appealed to the board. *Id.* Protection under various state trademark laws is not affected by board decisions. Some courts have suggested, however, that if a mark is not entitled to federal registration because of the mark’s content, the mark is also not entitled to state trademark protection. See, e.g., *De Nobili v. Scanda*, 198 F. 341 (W.D. Pa. 1912).

⁵³ See 15 U.S.C. § 1071. Under 15 U.S.C. § 1071, a party can appeal from a decision of the Trademark Trial and Appeal Board (“TTAB”) to the Court of Appeals for the Federal Circuit, or commence a civil action in the District of Columbia, if the action is between parties who reside in different states.

beliefs, or national symbols, or bring them into contempt, or disrepute”⁵⁴ In order for a mark to be cancelled under section 2(a), the mark must have been scandalous or disparaging when it was originally granted.⁵⁵

Several older decisions considered scandalousness and disparagement under section 2(a) as a single issue,⁵⁶ and marks that were canceled using section 2(a) were “predominantly risqué or vulgar depictions of bodily functions.”⁵⁷ In recent years, however, the distinctions between scandalous and disparaging marks have been clarified, and section 2(a) has been used to cancel a variety of scandalous and disparaging trademarks.⁵⁸

1. Scandalous Marks Are Not Afforded Protection

Courts have held that for a trademark to be denied registration as scandalous, it must offend a “substantial composite of the general population”⁵⁹ in the context of contemporary norms.⁶⁰ The mark must shock a sense of truth, decency, or propriety, as well as be disgraceful, offensive, or disreputable, while “giving offense to the conscience or moral feelings; . . . [or] calling out [for] condemnation.”⁶¹ Courts first evaluate the meaning of the

⁵⁴ 15 U.S.C. § 1052(a).

⁵⁵ 15 U.S.C. § 1064(3).

⁵⁶ See, e.g., *In re Waughtel*, 138 U.S.P.Q. 595 (T.T.A.B. 1963); *In re Reemtsma CigarettenFabriken G.m.b.H.*, 122 U.S.P.Q. 339 (T.T.A.B. 1959).

⁵⁷ Jendi B. Reiter, *Redskins and Scarlet Letters: Why “Immoral” and “Scandalous” Trademarks Should Be Federally Registrable*, 6 FED. CIR. B.J. 191, 192 (1996).

⁵⁸ See, e.g., *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. Apr. 2, 1999). This case will be discussed in great detail later in this Article. For a detailed discussion of marks found to be disparaging or scandalous, see Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man’s Vulgarity Be Another’s Registered Trademark?*, 54 OHIO ST. L.J. 331 (1993), and for a detailed discussion on the standards of what is scandalous or disparaging, see Ethan G. Zlotchew, “Scandalous” or “Disparaging”? *It Should Make a Difference in Opposition and Cancellations Actions: Views on the Lanham Act’s Section 2(a) Prohibitions Using the Example of Native American Symbolism in Athletics*, 22 COLUM.-VLA J.L. & ARTS 217 (1998).

⁵⁹ *In re Mavety Media Group Ltd.*, 33 F.3d 1367, 1371 (Fed. Cir. 1994) (citing *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981)).

⁶⁰ *Id.* (citing *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216, 1219 (T.T.A.B. 1993)).

⁶¹ *Id.* (citing *In re Riverbank Canning Co.*, 95 F.2d 327, 328 (C.C.P.A. 1938)).

term in question, and then determine whether it is scandalous to a substantial composite of the general public.⁶²

Using this standard, the Federal Circuit in *In re Mavety Media Group Ltd.* held that the use of the trademark “black tail” in connection with adult magazines was not scandalous.⁶³ The *Mavety* court⁶⁴ referred to other marks that courts had found not to be scandalous, including “Old Glory Condom Corp.” and its stars and stripes design on its condoms,⁶⁵ “Moonies” for dolls whose pants drop,⁶⁶ “Big Pecker Brand” for tee-shirts,⁶⁷ “Badass” for bridges of stringed musical instruments,⁶⁸ “Week-end Sex” for magazines,⁶⁹ “Acapulco Gold” (which is a synonym for marijuana) for suntan lotion,⁷⁰ and “Libido” for perfume.⁷¹ In contrast, in 1938 the U.S. Court of Customs and Patent Appeals (the predecessor to the Federal Circuit) held that the use of the trademark “Madonna” on wine was scandalous.⁷² Other marks that courts have found to be scandalous include “Dickheads” for restaurant services,⁷³ “Bullshit” for personal accessories,⁷⁴ a “cartoon-like representation of a melancholy, unclothed male figure ruefully contemplating an unseen portion of his genitalia”

⁶² *Id.* (citing *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981)) (alteration in original).

⁶³ *Id.* at 1370.

⁶⁴ *Id.*

⁶⁵ *Id.* at 1371 (citing *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993)).

⁶⁶ *Id.* (citing *In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d 1653 (T.T.A.B. 1990)). The court also found that this mark was not disparaging to people of the Unification Church. *Id.*

⁶⁷ *Id.* (citing *In re Hershey*, 6 U.S.P.Q.2d 1470 (T.T.A.B. 1988)).

⁶⁸ *Id.* (citing *In re Leo Quan Inc.*, 200 U.S.P.Q. 370 (T.T.A.B. 1978)).

⁶⁹ *Id.* (citing *In re Madsen*, 180 U.S.P.Q. 334 (T.T.A.B. 1973)).

⁷⁰ *Id.* (citing *In re Hepperle*, 175 U.S.P.Q. 512 (T.T.A.B. 1972)).

⁷¹ *Id.* at 1372 (citing *Ex parte Parfum L'Orle, Inc.*, 93 U.S.P.Q. 481 (Pat. Off. Exam'r-in-Chief 1952)).

⁷² *Id.* (citing *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938)); see also *In re P.J. Valckenbeg, G.m.b.H.*, 122 U.S.P.Q. 334 (T.T.A.B. 1959) (also holding that use of the mark “Madonna” for wine was scandalous).

⁷³ *In re Wilcher Corp.*, 40 U.S.P.Q.2d 1929 (T.T.A.B. 1996).

⁷⁴ *Mavety*, 33 F.3d at 1372 (citing *In re Tinseltown, Inc.*, 212 U.S.P.Q. 863 (T.T.A.B. 1981)).

for penis corrective implements,⁷⁵ “Bubby Trap” for brassieres,⁷⁶ “Messias” for wine and brandy,⁷⁷ “Agnus Dei” for metallic tabernacles,⁷⁸ and “Queen Mary” for women’s underwear.⁷⁹

2. Disparaging Marks Are Not Afforded Protection

A trademark will not be granted protection if it is held to be disparaging.⁸⁰ A mark is disparaging if it would “dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.”⁸¹ When evaluating disparagement, courts as well as the TTAB consider “only the perceptions of those referred to, identified or implicated in some recognizable manner by the involved [trade]mark”⁸² which is to be evaluated as of the date of registration of the mark.

Using this standard, the TTAB has found a variety of marks to be disparaging. The trademark and design for “Budda Beachwear” clothing was held to be disparaging in view of a particular

⁷⁵ *In re Thomas Labs, Inc.*, 189 U.S.P.Q. 50, 51–52 (T.T.A.B. 1975); see also *In re McGinley*, 660 F.2d 481, 482 (C.C.P.A. 1981) (holding that a “photograph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia” for “Newsletter Devoted to Social and Interpersonal Relationship Topics” and “Social Club Services” was scandalous).

⁷⁶ *Mavety*, 33 F.3d at 1372 (citing *In re Runsdorf*, 171 U.S.P.Q. 443 (T.T.A.B. 1971)).

⁷⁷ *Id.* (citing *In re Sociedade Agricola E. Comercial Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. 275 (T.T.A.B. 1968)).

⁷⁸ *Id.* (citing *Ex parte Summit Brass & Bronze Works, Inc.*, 59 U.S.P.Q. 22 (Comm’r Pats. 1943)). The *Summit* court suggested that “[t]o commercialize an emblem of such highly sacred religious significance would . . . be offensive to most individuals of the Christian faith, and thus scandalous within the meaning of the statute.” *Summit*, 59 U.S.P.Q. at 23.

⁷⁹ *Mavety*, 33 F.3d at 1372 (citing *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. 156 (Comm’r Pats. 1938)).

⁸⁰ *In re Hines*, 31 U.S.P.Q.2d 1685, 1688 (T.T.A.B. 1994), *vacated on other grounds*, 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994).

⁸¹ *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1738 (T.T.A.B. Apr. 2, 1999).

⁸² *Hines*, 31 U.S.P.Q.2d at 1688. Although earlier cases held that a “reasonable person of ordinary sensibilities” must consider the trademark offensive or objectionable, see, e.g., *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635, 1639 (T.T.A.B. 1988), the law appears well settled that only the perceptions of the allegedly disparaged group matters. *Hines*, 31 U.S.P.Q. at 1688; see Jack Achiezer Guggenheim, *Renaming the Redskins (and the Florida State Seminoles?): The Trademark Registration Decision and Alternative Remedies*, 27 FLA. ST. U. L. REV. 287 (1999) [hereinafter Guggenheim, *Renaming the Redskins*].

religious group because of the depiction of Buddha.⁸³ The trademark “Doughboy” and a picture of a soldier for an anti-venereal medication was found to be disparaging to World War I soldiers.⁸⁴ The trademark “Senussi” for cigarettes was determined to be disparaging to a small Muslim sect of the same name that forbade the use of tobacco.⁸⁵ Additionally, a trademark consisting of a design of a large “X” over a hammer and sickle design for “patriotic educational services, namely, dissemination of information relative to United States laws concerning activities of the communist party” was found to disparage the national symbol of the Soviet Union.⁸⁶ On the other hand, the trademark “Amish” as used for cigars was found not to be disparaging to Amish people because of evidence that the Amish faith permits smoking, and at least seventy-five percent of Amish men smoke.⁸⁷ Further, the trademark “Jap” for women’s clothing was held not to disparage Japanese people.⁸⁸

III. THE DEVELOPMENT OF *HARJO*

In 1994, several Native American petitioners filed a complaint with the TTAB seeking the cancellation of the trademark “Redskins” and several other derivations of the term under section 2(a) of the Lanham Act.⁸⁹ The trademark “Redskins” belongs to the NFL franchise in Washington, D.C.⁹⁰

⁸³ *Hines*, 31 U.S.P.Q.2d at 1688.

⁸⁴ *Doughboy Indus., Inc. v. Reese Chemical Co.*, 88 U.S.P.Q. 227 (T.T.A.B. 1951).

⁸⁵ *In re Reemtsma Cigarettenfabriken GmbH*, 122 U.S.P.Q. 339 (T.T.A.B. 1959). This mark was also held to be disparaging. *Id.* The court in this case appears to consider scandalousness and disparagement under section 2(a) as a single issue. *See Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1737 (T.T.A.B. Apr. 2, 1999).

⁸⁶ *In re Anti-Communist World Freedom Congress, Inc.*, 161 U.S.P.Q. 304, 305 (T.T.A.B. 1969).

⁸⁷ *In re Waughtel*, 138 U.S.P.Q. 594 (T.T.A.B. 1963). This mark was also held not to be scandalous. *Id.* The court in this case appears to consider scandalousness and disparagement under Section 2(a) as a single issue. *See Harjo*, 50 U.S.P.Q.2d (BNA) at 1737.

⁸⁸ *In re Condas*, 188 U.S.P.Q. 544 (T.T.A.B. 1975).

⁸⁹ *Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. Mar. 11, 1994). Each of the plaintiffs was an enrolled member of a federally recognized Native American tribe. *Id.* The plaintiffs included Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A.

In support of their petition for cancellation, the Native American petitioners suggested that the marks were “pejorative, derogatory, degrading, offensive, scandalous, contemptuous, disreputable, disparaging and racist” in violation of section 2(a) of the Lanham Act.⁹¹ Respondent Pro-Football, owner of the “Redskins” trademark, replied with several affirmative defenses, including (1) the petition failed to state a claim upon which relief may be granted, (2) petitioners lacked standing, (3) the petition was barred by the doctrine of equitable estoppel, (4) the petition was barred by laches, (5) the trademarks acquired had a strong secondary meaning, (6) petitioners had not been harmed, (7) petitioners failed to state special damages, (8) the use of the trademarks was protected by the First Amendment, and (9) section 2(a) of the Lanham Act was unconstitutionally overbroad and unconstitutionally vague.⁹²

After considering the respondent’s arguments, the TTAB quickly dispensed with most of the affirmative defenses.⁹³ The TTAB held that the “petitioners [had] pleaded a legitimate interest in the outcome of this proceeding” because the petitioners were Native Americans and the term “Redskin” offended them.⁹⁴ The TTAB further held that the defenses of laches and estoppel were not available because of public policy concerns and that there was

Means, and Manley A. Begay, Jr. *Id.* at 1829. The lead plaintiff, Suzan Shown Harjo, is a Cheyenne and Hodulgee Muskogee, and the great-great-granddaughter of Chief Bull Bear, a Cheyenne peace chief. See Adrienne T. Washington, *Indian Activist Tackles Football*, WASH. TIMES, Apr. 26, 1999, at C4. She is also a lecturer, curator, award-winning journalist, and public-policy analyst, championing such causes as Native American land rights and Native American policy and law. *Id.* She also acted as a special assistant for Native American legislation and liaison to President Jimmy Carter and as executive director of the National Congress of Native Americans. *Id.* In the early 1970s, she went to a Washington Redskins football game and was horrified at the portrayal of Native Americans. *Id.* At the game, she was subject to hair pulling, pointing, and poking. *Id.*

⁹⁰ *Harjo*, 30 U.S.P.Q.2d (BNA) at 1829.

⁹¹ *Id.*

⁹² *Id.* at 1830.

⁹³ *Id.*

⁹⁴ *Id.* at 1830–31.

no requirement that actual damages be proven.⁹⁵ The TTAB did not address the constitutional defenses, ruling that the defenses were outside of the TTAB's authority.⁹⁶ Moreover, the TTAB at that time did not decide whether the challenged marks were scandalous or disparaging.

A. The TTAB's Decision That the Trademark Was Disparaging

In 1999, the cancellation proceeding was again before the TTAB.⁹⁷ The petitioners challenged the "Redskins" trademark and other variations of that trademark.⁹⁸ The petitioners again asserted that the trademarks were "pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for a Native American person."⁹⁹ This time, however, they also asserted that the "registrant's use of the [trademarks] in the identified registrations offends petitioners and other Native Americans" and that "the [trademarks] in the identified registrations consist of or comprise matter which disparages Native American persons, and brings them into contempt, ridicule, and disrepute."¹⁰⁰ As such, petitioners asserted that the trademarks violated section 2(a) of the Lanham Act.¹⁰¹

In support of their petition to cancel the trademarks, the petitioners offered a variety of evidence. Petitioners first contended that the word "redskin"—which they asserted was a deeply offensive racial slur—rarely appeared in formal writings in reference to Native Americans.¹⁰² Petitioners then presented

⁹⁵ *Id.* The TTAB held that the laches defense was unavailable after determining that the plaintiffs were advocating on behalf of a broad public interest, while the defendant's interests were private. *Id.* at 1831.

⁹⁶ *Id.* at 1833.

⁹⁷ *See Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (T.T.A.B. Apr. 2, 1999).

⁹⁸ *Id.* at 1707. The challenged words and marks are U.S. Trademark Registration Numbers 1,606,810 ("Redskinettes"), 1,085,092 ("Redskins"), 987,127 ("The Redskins"), 986,668 ("Washington Redskins"), 978,824 ("Washington Redskins"), and 836,122 ("The Redskins"). *Id.* at 1705.

⁹⁹ *Id.* at 1708.

¹⁰⁰ *Id.* (citations omitted).

¹⁰¹ *Id.*

¹⁰² *Id.* at 1719.

testimony from a linguistics expert that lexicographers had considered the word disparaging since the 1960s and that the term was not used because it was “a loaded pejorative term.”¹⁰³ In addition, they presented testimony from a historian who suggested that the term is “an artifact of an earlier period during which the public at large was taught to believe that American Indians were a backward and uncivilized people.”¹⁰⁴ Petitioners also proffered evidence that the word “has been and is used with connotations of violence, savagery, and oppression” and “suggests a power relationship, with the whites in control, and the Indians in a position of servitude or capture.”¹⁰⁵ The petitioners noted that when the term had been used in film, it was frequently “coupled with negative adjectives such as ‘dirty,’ or ‘lying’; or that the word was used in the context of violence, savagery, or dishonesty.”¹⁰⁶ The petitioners suggested that “sports team names are chosen to reflect the team’s location or to sound fierce . . . so as, in a symbolic way, to strike fear into the hearts of opponents.”¹⁰⁷ They presented expert testimony that the use of the term “redskin” perpetuates stereotypes, and that racial stereotyping “can lead to serious psychological disturbance such as depression [and] low self-esteem.”¹⁰⁸ Finally, the petitioners introduced a resolution from the National Congress of American Indians condemning the word.¹⁰⁹

Furthermore, the petitioners offered the results of a telephone survey, where randomly selected adults were asked whether the terms “Native American,” “buck,” “brave,” “redskin,” “Injun,” “Indian,” and “squaw” were offensive to them or others, and, if so, why.¹¹⁰ Of the general population, the term “Injun” was the most offensive (with 49.5 percent of respondents claiming it was offensive to them), followed by “redskin” (46.2 percent), “squaw” (36.2 percent), “buck” (36.5 percent), “brave” (10.0 percent),

¹⁰³ *Id.* at 1720 (citation omitted).

¹⁰⁴ *Id.* at 1726 (citation omitted).

¹⁰⁵ *Id.* at 1720 (citations omitted).

¹⁰⁶ *Id.* at 1732.

¹⁰⁷ *Id.* (citation omitted).

¹⁰⁸ *Id.* at 1727 (citation omitted).

¹⁰⁹ *Id.* at 1709.

¹¹⁰ *Id.* at 1732–33.

“Indian” (2.7 percent), and “Native American” (2.0 percent).¹¹¹ Of Native Americans surveyed, the term “Injun” was the most offensive (50.6 percent), followed by “squaw” (47.2 percent), “redskin” (36.6 percent), “buck” (27.7 percent), “Indian” (7.8 percent), “brave” (7.0 percent), and “Native American” (2.8 percent).¹¹²

The respondents denied that the term “redskins” was scandalous or disparaging:

[T]hrough long, substantial and widespread use, advertising and promotion in support thereof and media coverage, [the terms] have acquired [] secondary meaning . . . and . . . the [terms] . . . cannot reasonably be understood to refer to the Petitioners or to any of the groups or organizations to which they belong [as] the [trademarks] refer to the Washington Redskins football team . . . and . . . cannot be interpreted as disparaging any of the Petitioners or as bringing them into contempt or disrepute.¹¹³

The respondents also argued that “disparagement requires intent on the part of the speaker and that its intent in adopting the team name was entirely positive as the team name has, over its history, reflected positive attributes of the American Indian such as dedication, courage and pride.”¹¹⁴

In its decision, the TTAB examined the type of evidence that often is considered by courts when determining scandalousness and disparagement.¹¹⁵ The evidence included dictionary definitions, history, and linguistic analysis.¹¹⁶ Before the TTAB could decide whether the trademark was scandalous or disparaging, it first had to define scandalous and disparaging.¹¹⁷

¹¹¹ *Id.* at 1733. Not surprisingly, the petitioner’s own expert criticized the methodology of the survey. *Id.* at 1734.

¹¹² *Id.* at 1733.

¹¹³ *Id.* at 1708.

¹¹⁴ *Id.* at 1721 (citations omitted).

¹¹⁵ *Id.* at 1744.

¹¹⁶ *Id.*

¹¹⁷ *Id.* at 1735–38.

The TTAB defined scandalous as “[g]iving offense to the conscience or moral feelings” or “shocking to the sense of truth, decency, or propriety.”¹¹⁸ For a trademark to be scandalous it must be offensive to “American society as a whole” in order to be denied registration.¹¹⁹ The TTAB subsequently applied a two-step analysis to determine whether the trademark was scandalous.¹²⁰ First, it evaluated “the likely meaning of the matter in question,” and second, it determined whether “the matter [was] scandalous to a substantial composite of the general public.”¹²¹ Ultimately, the TTAB held that the term “redskins” was not scandalous.¹²² The TTAB suggested that the term “redskins” had a strong secondary meaning because people associated it with the football team and did not consider it a derogatory or racist term, and that a substantial composite of the general public would not find the term shocking and that the word would not offend the conscience, excite reprobation, or call out for condemnation.¹²³

The TTAB, relying on the dictionary, defined disparaging as matter that “may dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.”¹²⁴ Although a trademark must be offensive to society as a whole to be denied registration as scandalous, the TTAB suggested that only the views of the referenced group, here the Native Americans, should be considered when determining whether the trademark was disparaging.¹²⁵ The TTAB again used a two-step analysis to evaluate whether the trademark was disparaging.¹²⁶ First, the TTAB asked “[w]hat is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the services identified in the

¹¹⁸ *Id.* at 1735 (citing *In re McGinley*, 660 F.2d 481, 211 U.S.P.Q. 668, 673 (C.C.P.A. 1981)).

¹¹⁹ *Id.* at 1738.

¹²⁰ *Id.* at 1736.

¹²¹ *Id.*

¹²² *Id.* at 1748–49.

¹²³ *Id.*

¹²⁴ *Id.* at 1738 (quoting WEBSTER’S NEW INTERNATIONAL DICTIONARY (2d ed. 1947)). In its analysis, the TTAB considered a survey that showed the term “redskin” to be offensive to 46.2 percent of the general public. *Id.* at 1738.

¹²⁵ *Id.* at 1739.

¹²⁶ *Id.* at 1740.

registrations” and second, the TTAB asked whether the trademark would disparage Native Americans.¹²⁷

In response to the first question, the TTAB determined that although the trademark had acquired a secondary meaning, it was still a term used to refer to Native Americans.¹²⁸ The TTAB considered the dictionary meaning of the term, and stated that “[i]t is clear from the dictionary definitions and other evidence of record herein, and respondent does not dispute, that one denotative definition of ‘redskin(s)’ is a Native American person.”¹²⁹ The TTAB also recognized that the term “redskins” as used by respondents was often used in connection with a portrait of a Native American profile.¹³⁰ The TTAB, therefore, found that this was not a case where the term “redskins” had lost—through its use in professional football—its meaning as a reference to Native Americans and, thus, had gained an entirely independent meaning as the name of the franchise.¹³¹

In response to the second question, the TTAB found that “the word ‘redskin,’ as it appears in respondent’s marks in those registrations and as used in connection with the identified services, may disparage Native Americans, as perceived by a substantial composite of Native Americans.”¹³² Because only the views of the referenced group are considered, the TTAB only considered how Native Americans perceived the trademark.¹³³ Therefore, even though the TTAB found that the trademark had obtained a strong secondary meaning, the negative meaning that Native Americans associate with the trademark was enough to find the term disparaging.¹³⁴ The TTAB held that the challenged trademark was

¹²⁷ *Id.* at 1740–41.

¹²⁸ *Id.* at 1740–42. The TTAB noted that, although the vast majority of the uses of “redskin(s)” had been in the press and other media since at least the 1960s referring to the professional football team rather than to Native Americans. *Id.* At the same time, it found that the football team’s registered marks bore substantial evidence of Native American imaging. *Id.*

¹²⁹ *Id.* at 1741.

¹³⁰ *Id.* at 1740–41.

¹³¹ *Id.* at 1742.

¹³² *Id.* at 1743.

¹³³ *Id.*

¹³⁴ *Id.* at 1747.

disparaging to Native Americans and, therefore, was not entitled to trademark protection.¹³⁵ Based on the “cumulative effect of the entire record,” the TTAB held that the “disparaging connotation of ‘redskin(s)’ as a term of reference for Native Americans extend[ed] to the word ‘Redskin(s)’ as it appear[ed] in subject marks and as used in connection with respondent’s identified services.”¹³⁶

The TTAB was careful to announce that it was deciding only the narrow question of “whether, under the Section 2(a) grounds asserted, the service marks that [were] the subjects of the six registrations in this proceeding shall remain registered.”¹³⁷ Although the TTAB invalidated the trademarks on the term “Redskins” and its derivatives, the TTAB found that there was no evidence that graphics used by Pro-Football were disparaging because petitioners had not established under section 2(a) that the spear design and the portrait of a Native American profile that appeared in two of the registered marks disparaged Native Americans.¹³⁸

The TTAB found no support in the record—and, thus, rejected—the proposition that the use of Native American references or imagery by non-Native Americans was *per se* disparaging to Native Americans or that such use in connection with football was *per se* disparaging.¹³⁹ Therefore, although the TTAB held that the trademark should be cancelled, it did not rule that the use of Native American names and images was *per se* disparaging to Native Americans.¹⁴⁰

B. The U.S. District Court for the District of Columbia’s Reversal of the TTAB’s Decision

Pro-Football appealed the TTAB decision to the U.S. District Court for the District of Columbia.¹⁴¹ Pro-Football argued several

¹³⁵ *Id.* at 1749.

¹³⁶ *Id.* at 1743, 1748.

¹³⁷ *Id.* at 1740.

¹³⁸ *Id.* at 1743.

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ *Pro-Football, Inc. v. Harjo*, 57 U.S.P.Q.2d (BNA) 1140 (D.D.C. 2000).

reasons why the court should overturn the TTAB's decision. First, it argued that the trademarks did not disparage Native Americans and did not bring Native Americans into contempt or disrepute.¹⁴² Second, it asserted that section 2(a) of the Lanham Act was unconstitutional because it was a vague, overbroad, content-based restriction on speech.¹⁴³ It further argued that section 2(a) was unduly vague in violation of the Fifth Amendment.¹⁴⁴ Finally, Pro-Football contended that the cancellation petition was barred by the doctrine of laches.¹⁴⁵

The district court considered cross-motions for summary judgment.¹⁴⁶ Pro-Football moved for summary judgment, arguing that the trademarks were not disparaging, that the trademarks did not and would not bring Native Americans into contempt or disrepute, and that laches barred the suit.¹⁴⁷ The Native Americans also moved for summary judgment, arguing the district court should affirm the TTAB decision and that the laches claim should be rejected.¹⁴⁸ Neither party appealed the issue of scandalousness.¹⁴⁹ After considering motions from parties and the evidence on the record, the district court held that the TTAB's finding of disparagement was not supported by substantial evidence and the suit was barred by laches, and consequently reversed the TTAB decision.¹⁵⁰

In reaching its holding, the district court first considered the standard of review that should be afforded to administrative decisions of the TTAB.¹⁵¹ The district court held that a court should review decisions from the TTAB under the substantial evidence test, which means that a court should reverse a TTAB's findings of fact only if they are "unsupported by substantial

¹⁴² *Id.* at 1142.

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

¹⁴⁶ *Harjo v. Pro-Football, Inc.*, 284 F. Supp. 2d 96, 99 (D.D.C. 2003).

¹⁴⁷ *Id.* at 100.

¹⁴⁸ *Id.* at 102.

¹⁴⁹ *Id.* at 124.

¹⁵⁰ *Id.* at 141.

¹⁵¹ *Id.* at 114.

evidence.”¹⁵² The district court stated that “[t]he substantial evidence standard requires the reviewing court to ask whether a ‘reasonable mind might accept’ a particular evidentiary record as ‘adequate to support a conclusion.’”¹⁵³ Although the appellant bears the burden of arguing that the TTAB decision was not supported by substantial evidence, the court reviews the TTAB’s legal conclusions *de novo*.¹⁵⁴ Whether a trademark is disparaging “is ultimately a fact-bound conclusion that rests with the fact-finder.”¹⁵⁵ The reviewing court assesses the application of the legal principles to the TTAB’s findings of fact under the substantial evidence test.¹⁵⁶ The district court also noted that challengers, at the agency level, “needed to demonstrate by a preponderance of the evidence that the challenged trademarks ‘may disparage’ Native Americans or ‘bring them into contempt, or disrepute.’”¹⁵⁷

Next, the district court bifurcated its analysis. It first evaluated the meaning of the term “redskins” as it appeared in the trademarks in connection with the services identified by those marks. Second, the district court asked whether the meaning may disparage Native Americans.¹⁵⁸ As to the first consideration, it held that the TTAB’s determination that the word “redskins” referred both to

¹⁵² *Id.* at 102.

¹⁵³ *Id.* at 115–16 (quoting *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938)).

¹⁵⁴ *Id.* at 116.

¹⁵⁵ *Id.* at 117. Neither of the parties argued that the TTAB’s decision to treat “disparage” in the same manner as “contempt or disrepute” was error, so the court reviewed the issue of whether the marks “may disparage” Native Americans as whether the marks “bring Native Americans into contempt or disrepute.” *Id.* at 114. The court found no error in the TTAB’s legal determination of the meaning of the term. *Id.* at 124–25.

¹⁵⁶ *Id.* at 115.

¹⁵⁷ *Id.* at 122. The court also suggested that, although the standard of proof does not change, “in the context of cancellation proceedings where a lengthy period of time ensues between registration and the cancellation request, the [TTAB] is required to pay even closer attention to the proof adduced to buttress the cancellation request.” *Id.* at 123. The court went on to state that “the longer a party waits, after the time for bringing an opposition has expired, to commence a cancellation proceeding, the greater may be the number of facts (e.g., evidence of actual confusion) to be considered in determining the quantum of proof required.” *Id.* (quoting *Massey Junior Coll., Inc. v. Fashion Inst. of Tech.*, 492 F.2d 1399, 1402 (C.C.P.A. 1974)).

¹⁵⁸ *Id.* at 126.

Native Americans and the Washington football team was supported by substantial evidence.¹⁵⁹ Regarding the second consideration, however, the district court held that the TTAB's determination that the six trademarks may disparage Native Americans was not supported by substantial evidence.¹⁶⁰

The district court concluded that the TTAB's determination was logically flawed and that the TTAB "failed to apply the correct legal standard to its own findings of fact."¹⁶¹ The district court's rationale for its conclusion was that "there [was] no *direct* evidence in the findings that answer[ed] the legal question posed by the [TTAB]."¹⁶² The district court indicated that the TTAB erred in failing to consider direct evidence that the trademark disparaged Native Americans in connection with the use of the trademark during the time the trademark was issued.¹⁶³

In addition, the district court held the TTAB's use of dictionary evidence, historical evidence, and survey evidence to conclude that "redskins" was derogatory was not sufficient evidence to support the TTAB's determination.¹⁶⁴ It suggested that the TTAB's conclusion that the word was offensive because the dictionaries provided usage labels indicating that the use of the word was offensive or slang was "without any basis because there [was] no evidence in the record that was credited as to the purpose and methodology for including or not including usage labels in dictionaries or an explanation as to the basis for their conclusion."¹⁶⁵ Thus, the district court held that the TTAB's "findings related to the significance of the dictionary evidence [were] not supported by substantial evidence."¹⁶⁶ The historical evidence was likewise found to be inadequate, as no evidence supported the conclusion that "the drop-off of the use of the term" was correlated to a determination that the term was pejorative.¹⁶⁷

¹⁵⁹ *Id.*

¹⁶⁰ *Id.* at 127.

¹⁶¹ *Id.* at 125–26.

¹⁶² *Id.* at 127.

¹⁶³ *Id.*

¹⁶⁴ *Id.* at 135–36.

¹⁶⁵ *Id.* at 130.

¹⁶⁶ *Id.* at 131.

¹⁶⁷ *Id.* at 132.

The district court further held that the TTAB erred in dismissing criticism of the survey evidence.¹⁶⁸ Pro-Football's expert witness suggested that the questions in the survey were leading and not neutral, that the lists of words referring to Native Americans contained an insufficient number of terms, that the use of the term "offensive" in the survey questions did not determine the necessary information for a determination of disparagement under section 2(a) of the Lanham Act, and, finally, that the questions about what others thought led to ambiguous results.¹⁶⁹ The expert concluded that (1) the Native American sample was too geographically limited to be representative, (2) the method used to determine whether a participant was a Native American was flawed, (3) the sample method used violated the randomness of the survey, (4) the age requirements for the survey included participants who could not reflect the state of mind of people in 1967, and (5) there was a less than fifty percent response rate to the survey, which made it a very weak probability survey.¹⁷⁰ The district court held that the TTAB's findings were in error because the survey—which consisted of contemporary attitudes as of the time of the survey—was not a sound nor an adequate representation of the views of the two populations sampled.¹⁷¹ The district court held that "there is substantial evidence for the narrow conclusion that the survey represents nothing more than a survey of current attitudes at the time the survey was conducted."¹⁷² Because the TTAB did not consider the relevant criticism of the survey, the district court held that "[l]eft completely unexplained, the [district court] cannot accept that the . . . [s]urvey is a sufficient proxy for the views of Native Americans as a whole."¹⁷³

Finally, the district court held that the TTAB's finding that "within the relevant time periods, the derogatory connotation of the word 'redskin(s)' in connection with Native Americans extends to the term 'Redskin(s)' as used in [Pro-Football's] marks in

¹⁶⁸ *Id.*

¹⁶⁹ *Id.* at 110.

¹⁷⁰ *Id.* at 110–11.

¹⁷¹ *Id.* at 119–20 (citing *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1734 (T.T.A.B. Apr. 2, 1999)).

¹⁷² *Id.* at 119 (citation omitted).

¹⁷³ *Id.* at 120.

connection with the identified services, such that [Pro-Football's] marks may be disparaging of Native Americans to a substantial composite of this group of people" was not supported by substantial evidence.¹⁷⁴ The district court held that the TTAB did little analysis as to how Native Americans were disparaged by the use of the trademarks in connection with Pro-Football's services.¹⁷⁵ Essentially, the TTAB found the name to be pejorative, and then assumed that the marks were disparaging, without observing actual evidence of such.¹⁷⁶ The district court also found that, in the alternative, because of the delay in challenging the trademark, laches barred the petitioners' suit.¹⁷⁷

In addition, the district court was troubled that the TTAB did not consider evidence of attitudes during the relevant time period and evidence of the use of the trademark in connection with the services it represents. The district court thus held that the evidence that the TTAB considered was not sufficient to support cancellation.

C. *The Impact of Harjo*

Although the trademark "Redskins," arguably the most offensive Native American name used for professional or collegiate sports teams,¹⁷⁸ was not cancelled, opponents of the use

¹⁷⁴ *Id.* at 133 (citing *Harjo*, 50 U.S.P.Q.2d (BNA) at 1748).

¹⁷⁵ *Id.*

¹⁷⁶ *Id.*

¹⁷⁷ *Id.* at 136.

¹⁷⁸ See Jay Cooper & Omer Gillham, *When Mascot Names Offend*, TULSA WORLD, May 17, 2001, at A13 (noting that Ross Swimmer, former Cherokee chief and former director of the U.S. Bureau of Indian Affairs, states that he does not mind the name "Chieftain" for a team name, although other Native Americans may not like it, but that for him the term "Redskin" for a team name is particularly offensive); Gokavi, *supra* note 3, at 1D (explaining that Jim Harding, who is part-Native American, does not "like the name Redskins" but has no problem "with Warriors or Chieftains or Braves"); John J. Miller, *Civil Rights Panel Should Get It Right: Indian Nicknames a Badge of Honor*, INVESTOR'S BUS. DAILY, Apr. 11, 2001, at A22 (suggesting that team names are a "sign of respect" and that protesters' concerns "may be reasonable in a few isolated cases, such as the Washington Redskins or a high school using the name Savages in conjunction with a cartoonish Indian mascot"); Price, *supra* note 3, at 70 (stating that "[w]hile those who support names such as the Seminoles (Florida State) and Braves can argue that the words celebrate Native American traditions, applying that claim to the Redskins is absurd."); *Mascots in the News*, CHICAGO TRIB., Mar. 27, 2001, at C3 ("Tim Lane, who headed the

of Native American names and caricatures for team names, logos, and mascots argue that such usage is morally wrong and denies Native Americans dignity and self-respect.¹⁷⁹ Scholars argued that in the wake of the TTAB decision in *Harjo*, owners of trademarked Native American names and images would be in danger of losing their protection.¹⁸⁰ They proposed that trademark law may provide the means for reform because it could be used to “remove the financial incentives, or ‘business considerations’ team owners rely on to justify their decision to maintain Native American team names.”¹⁸¹ Although the district court reversed the TTAB’s decision to cancel the trademark, it based its analysis on the insufficiency of the evidence.¹⁸² It did not hold that any other mark using Native American terms could not be cancelled as disparaging.¹⁸³ In other words, other marks may still be attacked.

Other possible targets of trademark cancellation include the Atlanta “Braves,” the Chicago “Blackhawks,” the Cleveland “Indians,” the Kansas City “Chiefs,” the Florida State University

Huntley [high school] Booster Club for several years, is of Delaware Indian descent and doesn’t mind the name [Redskins for the high school].”). Suzan Harjo went on record as saying that “[Redskin] is the worst name you can call Native Americans in the English language.” Kalpana Srinivasan, *Washington Redskins to Appeal Decision Over Trademark Loss*, CHATANOOGA TIMES FREE PRESS, Apr. 4, 1999 at A17.

¹⁷⁹ See Behrendt, *supra* note 3, at 397; see also U.S. Comm’n on Civil Rights, *supra* note 29 (calling for an end to the use of Native American images and team names and suggesting that they “are particularly inappropriate and insensitive in light of the long history of forced assimilation that American Indian people have endured in this country”).

¹⁸⁰ Behrendt, *supra* note 3, at 390, 414 (“The [TTAB] decision to cancel the Washington Redskins’ marks will likely persuade nonprofessional sports teams with Native American names, mascots and logos to do away with their Native American symbolism.”). Behrendt also suggests that “[a] likely result of the cancellation of the Washington Redskins’ trademarks will be the promotion of public sympathy in favor of abandoning discriminatory names, mascots and logos.” *Id.* at 391–92; see also Guggenheim, *supra* note 16, at 213 (pointing out that the Redskins decision “may be instructive as to the success of challenging Chief Wahoo’s [the Cleveland Indian’s mascot] registration rights”).

¹⁸¹ Kelber, *supra* note 3, at 551. Kelber suggests that “[d]ue to the lack of protection available for marks that are deemed scandalous, immoral, or disparaging, trademark law can force owners of Native American team marks to carefully reconsider their use. In so doing, trademark law has the ability to respond to the social ills of racism in cases where owners of Native American team marks have ignored their responsibility.” *Id.* at 576.

¹⁸² See *supra* Part III.C.

¹⁸³ *Id.*

“Seminoles,” the University of Illinois “Fighting Illini,” and the University of North Dakota “Fighting Sioux.” The first obstacle that opponents of the use of Native American terms as team names will face in a trademark cancellation proceeding is proving that the mark is indeed scandalous or disparaging. As proponents of such use point out, although many Native American leaders and activists oppose the marks, most people, including Native Americans generally, do not find the use of Native American tribal names and images as team names and mascots offensive.¹⁸⁴ The remainder of this Article will consider whether these marks would be found disparaging if challenged, and whether trademark cancellation would cause the use of such marks to cease.

IV. THE DIFFICULTY OF PROVING THAT THE TRADEMARKS ARE DEROGATORY AND THAT THEY ACTUALLY REFER TO NATIVE AMERICANS

Opponents of the use of Native American terms and images as team names and mascots have a difficult case to prove. If opponents want to argue that the trademarked terms are disparaging and should be cancelled, they must first prove that the terms indeed refer to Native Americans.¹⁸⁵ That might be an easy

¹⁸⁴ See Joseph Perkins, *Let's Get Real in This Silly Debate Over Team Mascots*, VENTURA COUNTY STAR, May 20, 2002, at B06 (suggesting that “four of five American Indians said that professional teams—like the Redskin[s]—should not stop using Indian nicknames, mascots or symbols”); see also Price, *supra* note 3, at 68–69. Betty Ann Gross, a member of the Sisseton-Wahpeton Sioux tribe “wants Indian mascots and the tomahawk chop discarded, but she has no problem with team names like the Fighting Sioux (University of North Dakota) or even the Redskins.” *Id.* Leigh J. Kuwanwisiwma, director of the Hopi Cultural preservation and “avid devotee of the Atlanta Braves,” is not offended by the tomahawk chop or Native American nicknames “as long as they’re not meant to be derogatory.” *Id.* at 69. A poll conducted by *Sports Illustrated* suggests that eighty-one percent of Native Americans do not think that college and high school teams should stop using Native American names and mascots, and eighty-three percent do not think pro teams should stop. *Id.*; see also Masters, *supra* note 25, at A1 (“Because [the *Harjo*] decision focused very sharply on the term ‘redskin’ and its linguistic history, it does not necessarily make other teams with Native American names vulnerable to similar challenges, lawyers said. The same survey that showed nearly half of respondents consider ‘redskin’ offensive found that only ten percent of those surveyed felt the same way about the word ‘braves.’”); *supra* note 12 and accompanying text.

¹⁸⁵ See *supra* note 121 and accompanying text.

task for the trademark “Indians,” but may be more challenging for trademarks like “Braves.” Even if the first requirement is met, opponents must prove that Native Americans find the term derogatory. This task was difficult for the trademark “Redskins”—arguably the most offensive term in use—and might be nearly impossible for a term like “Braves.”

Even if both of the requirements are met and the trademark is cancelled, the use of the mark will not necessarily cease. Trademark cancellation does not mean that the owner must stop using a mark; it simply means that the owner may not stop others from using the mark. In theory, if the owner is obtaining revenue from the mark, then there exists a financial motive to cease using the cancelled mark and to begin using another mark. Although this would stop profitable enterprises like professional sports from using the marks in theory, this may not be the result in practice. Because of the financial structure of the NFL, individual football teams will see little financial impact from the cancellation of their trademarks. Other, less profitable organizations, such as school teams, might see no financial impact at all.

A. Proving That the Trademarks Actually Refer to Native Americans

Opponents attempting to cancel a trademarked Native American term as disparaging must first prove that the term actually refers to Native Americans. In the *Harjo* case, the TTAB considered several types of evidence to determine whether the term “Redskins” referred to Native Americans. The TTAB suggested that the term had to have “one denotative definition” of a Native American, and did not find that the only definition had to be a Native American.¹⁸⁶ The TTAB considered dictionary definitions, historical use of the term, and the use of a Native American profile in connection with the trademark.¹⁸⁷ The district court agreed with

¹⁸⁶ *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1741 (T.T.A.B. Apr. 2, 1999); *see supra* note 129 and accompanying text.

¹⁸⁷ *Harjo*, 50 U.S.P.Q.2d (BNA) at 1740–43; *see supra* notes 128–31.

the TTAB's determination that "Redskins" referred to Native Americans.¹⁸⁸

Each of the teams named "Braves," "Blackhawks," "Indians," "Chiefs," "Seminoles," "Illini," and "Sioux" arguably refer to Native Americans. The term "Indian" is used interchangeably with the term "Native American." The terms "Blackhawks," "Seminoles," "Illini," and "Sioux," are proper names for Native American tribes. The terms "Braves" and "Chiefs," however, are words in common usage and can be argued to contain secondary meaning.

In *Webster's Third New International Dictionary*, "Indian" has several definitions, including "American Indian."¹⁸⁹ From the dictionary definition, it is clear that it is a term referring to Native Americans. Because each of the terms "Blackhawks," "Seminoles," "Illini," and "Sioux" are proper tribal names, a court likely would determine that these terms also reference Native Americans.¹⁹⁰ "Brave" has three main definitions, the third being "one who is brave," with "American Indian warrior" given as a specific example.¹⁹¹ "Chief" has three main definitions in the dictionary.¹⁹² The first definition is "the head or leader of any body of men . . . a headman (as of a tribe, clan, or family)," but the dictionary does not make specific reference to Native Americans.¹⁹³

The analysis does not end merely by looking at the dictionary definitions. The TTAB in *Harjo* also considered historical use of the term.¹⁹⁴ Each of the terms above has been used historically to refer to Native Americans. Also, the use of Native American pictures or caricatures in association with the terms is indicative of

¹⁸⁸ *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 126–27 (D.D.C. 2003); *see supra* note 159 and accompanying text.

¹⁸⁹ WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY 1149 (3d ed. 1961). The TTAB in *Harjo* considered several dictionaries, including *Webster's Third New International Dictionary. Harjo*, 50 U.S.P.Q.2d (BNA) at 1738.

¹⁹⁰ *See, e.g.*, Guggenheim, *Renaming the Redskins*, *supra* note 82, at 304 ("Cleary, the name 'Seminoles' refers to the Native American tribe.").

¹⁹¹ WEBSTER'S THIRD NEW INTERNATIONAL DICTIONARY, *supra* note 189, at 269.

¹⁹² *Id.* at 378.

¹⁹³ *Id.*

¹⁹⁴ *Harjo*, 50 U.S.P.Q.2d (BNA) at 1741; *see supra* notes 128–29.

their meaning. The use of both Native American caricatures and Native American terms likely would sway any court to hold that the terms refer to Native Americans.¹⁹⁵ In *Harjo*, the TTAB appeared to be particularly swayed by the use of a Native American profile in connection with the word-mark.¹⁹⁶ Because each of the teams uses Native American images in connection with its word-marks, a court likely would determine that each above term refers to Native Americans.¹⁹⁷

Although the terms “Braves” and “Chiefs” have several meanings that might indicate that the terms have developed secondary meanings, a court likely would find that those terms refer to Native Americans. Neither the TTAB nor the district court in *Harjo* were persuaded that the evidence of secondary meaning of “Redskins” outweighed the proof that the term referred to Native Americans.¹⁹⁸ Therefore, because similar proof exists for “Braves” and Chiefs,” a court considering only the definitions of the terms probably would find that each of these terms refer to Native Americans.

In sum, a court considering the definitions of the terms, the historical usage of the terms, and the use of Native American images in connection with the terms likely would find that each of the terms actually refer to Native Americans. The possibility that some of the terms might have obtained a secondary meaning is unlikely to outweigh the evidence that the terms refer to Native Americans because of the use of images in connection with the terms.

B. Even If the Mark Does Refer to Native Americans, It Might Not Be Derogatory

The second element that opponents of a trademark must show in order to cancel a mark as disparaging is that the term is derogatory to Native Americans. A disparaging mark is one that dishonors by association with that which is inferior or slight, or

¹⁹⁵ See *supra* notes 14–20.

¹⁹⁶ *Harjo*, 50 U.S.P.Q.2d (BNA) at 1740–41; see *supra* note 130.

¹⁹⁷ See Guggenheim, *supra* note 16, at 232 (“There is no question that the Chief Wahoo image refers to Native Americans.”).

¹⁹⁸ *Harjo*, 50 U.S.P.Q.2d (BNA) at 1738; see *supra* note 124.

that deprecates, degrades, or injures by unjust comparison.¹⁹⁹ When evaluating whether a term is derogatory enough to be cancelled, only the views of the referenced group at the time the mark was filed are considered.²⁰⁰

1. The Use of Native American Terms Likely Is Not Derogatory

Given that “Redskins”—arguably the most demeaning term for Native Americans—was not found to be derogatory in *Harjo*, other less demeaning marks likely would also be upheld if challenged.²⁰¹ That “Redskins” is the most demeaning can be inferred from the fact it was the first Native American team name trademark to be challenged. Also, the survey provided by the petitioners in *Harjo* suggested that the term is the most offensive in use. In the petitioner’s survey, “redskin” was found offensive by 36.6 percent of Native Americans surveyed, in comparison with 7.8 percent for “Indian” and 7.0 percent for “brave.”²⁰² Yet, the TTAB refused to cancel the challenged trademark on the Native American profile,²⁰³ and rejected the suggestion “that the use of Native American references or imagery by non-Native Americans [was], essentially, *per se* disparaging to Native Americans”²⁰⁴ The petitioners in *Harjo* also argued that the word “Redskin” had a “negative connotation . . . which [was] not conveyed by such terms as ‘Indian,’ ‘Native American,’ or ‘American Indian.’”²⁰⁵

Other evidence also indicates that Native Americans might not find other team names as offensive as “Redskins.” In a poll conducted by *Sports Illustrated*, eighty-one percent of Native Americans questioned did not think that college and high school teams should stop using Native American mascots, logos, and names, and eighty-three percent did not think professional teams

¹⁹⁹ *Harjo*, 50 U.S.P.Q.2d (BNA) at 1738.

²⁰⁰ *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 128–29 (D.D.C. 2003); *see also Harjo*, 50 U.S.P.Q.2d (BNA) at 1743.

²⁰¹ *See supra* note 178.

²⁰² *Harjo*, 50 U.S.P.Q.2d (BNA) at 1733; *see supra* text accompanying note 112.

²⁰³ *Harjo*, 50 U.S.P.Q.2d (BNA) at 1743; *see supra* note 138.

²⁰⁴ *Harjo*, 50 U.S.P.Q.2d (BNA) at 1743; *see supra* note 139.

²⁰⁵ *Harjo*, 50 U.S.P.Q.2d (BNA) at 1720.

should stop.²⁰⁶ Many other Native Americans suggest that the term “redskin” offends them, but terms like “braves,” “Seminoles,” and “Sioux” do not.²⁰⁷ Suzan Harjo called the term “redskin” “the worst name you can call Native Americans in the English language.”²⁰⁸

Whether Native Americans find the trademarks “Braves,” “Blackhawks,” “Indians,” “Chiefs,” “Seminoles,” “Illini,” or “Sioux” derogatory will require fact specific questions. The surveys presented in the *Harjo* case and *Sports Illustrated*, as well as individual testimonials, indicate that many Native Americans probably do not find the uses derogatory. As the discussion above indicates, none of the dictionary definitions includes a usage that warns of any derogatory meaning. Further, none of the terms have the same historically-unfortunate impact as the term “Redskins” does. In *Harjo*, the TTAB explicitly rejected the suggestion that the use of Native American terms for sports team names was *per se* derogatory.²⁰⁹ Similarly, the district court held that the voluminous evidence provided by the petitioners was not enough to prove that the term was derogatory.²¹⁰ Therefore, it appears unlikely that the other marks will face trademark cancellation.²¹¹

2. The Use of Native American Images Might Be Derogatory

Even though the team names alone might not be derogatory, the use of Native American-derived mascots and logos might be found to be derogatory. The TTAB in *Harjo* found that the challenged drawings were not disparaging, but those marks were described as simple, benign profiles of Native Americans.²¹²

²⁰⁶ Price, *supra* note 3, at 69; *see supra* note 184.

²⁰⁷ *See supra* notes 178–84.

²⁰⁸ Kalpana Srinivasan, *Federal Trademark Panel Rules to Cancel Logo Registration*, WASH. POST, Apr. 3, 1999, at A1; *see supra* note 184.

²⁰⁹ *Harjo*, 50 U.S.P.Q.2d (BNA) at 1720.

²¹⁰ *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 113 (D.D.C. 2003).

²¹¹ *See Blankenship, supra* note 34, at 455 (“Although it is too soon to tell what effect [the TTAB’s] decision will have on other sports teams, it seems unlikely that many institutions will be subject to the same sort of legal action that the Redskins have been, simply because there are few names and logos that are as offensive as REDSKINS. The decision itself was limited to the mark REDSKINS in its various forms.”).

²¹² *Harjo*, 50 U.S.P.Q.2d (BNA) at 1743; *see supra* note 138.

Neither the district court nor the TTAB held that other, less benign images could not be found disparaging.

Many teams trademark drawings of their mascots.²¹³ For example, the Atlanta Braves own several trademarks on images of Native American men's heads with Mohawks and feathers in their hair.²¹⁴ The trademarked visage of the Cleveland Indians' mascot, Chief Wahoo, has been described as "grinning buck teeth and [a] hook nose."²¹⁵ The Cleveland Indians own several other trademarks on images, including a fat, cartoonish Native American man with a very large nose wearing an "Indians" jersey and leaning on a baseball bat,²¹⁶ the head of a large-smiling, hook-nosed Native American man with a single feather in his hair and a small braid,²¹⁷ and the head of a large-smiling, big-nosed Native American man with a single feather in his hair.²¹⁸ Although the trademarked words might not be prone to cancellation, these images are ripe for trademark cancellation proceedings.

Whether the marks are derogatory to Native Americans likely will hinge on the proof provided. Based on the results of the surveys from the *Harjo* case and *Sports Illustrated*, and evidence from other sources, it appears that Native Americans consider the names derogatory. None of the surveys considered the nature of some of the trademarked images however. Although many of the trademarked images appear to be as benign as the images considered in *Harjo*, some of the trademarked images are well outside of what the TTAB and district court examined, and, thus, may be deemed derogatory material.

²¹³ See *supra* notes 14–20.

²¹⁴ U.S. Trademark Reg. Nos. 829,309 and 829,310; see TESS, *supra* note 14; see also *supra* note 14.

²¹⁵ Guggenheim, *supra* note 16, at 214; see *supra* note 16.

²¹⁶ U.S. Trademark Reg. No. 1,719,618; see TESS, *supra* note 14; *supra* note 16.

²¹⁷ U.S. Trademark Reg. No. 1,711,810; see TESS, *supra* note 14; *supra* note 16.

²¹⁸ U.S. Trademark Reg. Nos. 2,569,766, 1,590,703, 1,543,339, 1,259,795, and 1,031,410; see TESS, *supra* note 14; *supra* note 16.

C. In Many Cases, There May Be No Financial Motive to Change the Name

The reason trademark law has the potential to be the most effective legal route for opponents in the mascot controversy is because it may result in a serious negative financial impact on the trademark owner. Without federal trademark protection, the team is still allowed to use the mark, but may not preclude others from using it.²¹⁹ For example, if the trademark had been cancelled, the Redskins franchise would have to compete with unlicensed vendors for tee-shirt sales and other royalties.²²⁰

1. Financial Impact on Professional Football Teams

Although the cancellation of federal trademark protection can have a negative financial impact on the trademark owner generally, this likely is not the result for professional football teams. Because of the unique profit-sharing of the NFL, the financial impact on any one franchise will be minor.

Most scholars who have addressed the issue have been under the assumption that the cancellation of the “Redskins” trademark would cause a chain reaction wherein every team with an offensive name would suddenly stop using it.²²¹ If the “Redskins” trademark had been cancelled, this likely would not have been the case. Because the NFL licenses marks and divides the proceeds evenly among the franchises, the cancellation of one or two trademarks would not impact the profits of an individual franchise or the league very much.²²² If the trademark had been cancelled, other teams’ owners that could have lost money might have attempted to pressure the Redskins to change its name, but such an assertion is

²¹⁹ The franchise may still pursue claims under state law, but as discussed above, federal trademark registration is superior to state protection. In addition, it is probable that states will follow the decision not to protect the marks.

²²⁰ See Masters, *supra* note 25 (noting that Stephen R. Baird, one of the attorneys for the plaintiffs, suggested that the *Harjo* decision “is going to create all kinds of . . . legal defenses for anyone who wants to rip off Redskins T-shirts”).

²²¹ See *supra* notes 180–81 and accompanying text.

²²² See *supra* note 25 and accompanying text.

speculative.²²³ The cancellation of the “Redskins” trademark probably would not even have the financial effect of ending the Washington team’s use of the term. The only other Native American name in the NFL is used by the Kansas City Chiefs. The Chiefs take part in the same profit-sharing plan as does the Washington team, and so a challenge to its trademark likely would have a minor financial impact. Clearly, challenging the mark of any one team would have no real results.

2. Financial Impact on Other Professional Sports Teams

Just as teams in the NFL likely would not feel a significant financial impact from the cancellation of trademarks because of the profit-sharing structure of the NFL, the potential effect on other sports teams is also minimal. Two MLB teams and one NHL team have Native American names and logos: the Atlanta “Braves,” the Cleveland “Indians,” and the Chicago “Blackhawks.” MLB uses Major League Baseball Properties, Inc., an organization acting in the interest of both MLB and the individual teams, to license all the team trademarks.²²⁴ The NHL also engages in profit-sharing, with National Hockey League Services, Inc. licensing NHL team trademarks.²²⁵ Even if the Atlanta, Cleveland, and Chicago franchises lose their trademarks, the franchises will not be forced to bear the financial burden alone. Whether the teams would be pressured to change their names by their respective leagues or would change their names for other reasons is also speculative. Although trademark cancellation has a theoretical negative financial impact on the trademark owner, the teams would not see a significant financial impact due to profit-sharing.

²²³ Blankenship, *supra* note 34, at 453–54 (“[I]t is quite possible that other owners would pressure [the Redskins’ owner] into finally changing the name. It is difficult, however, to speculate as to what such an eclectic group of wealthy multi-millionaires will choose to do.”).

²²⁴ *See supra* note 26.

²²⁵ *See id.*

3. Financial Impact on Collegiate Teams

Unlike professional sports teams, collegiate teams do not engage in profit-sharing.²²⁶ Three collegiate teams, the University of Illinois “Fighting Illini,” the University of North Dakota “Fighting Sioux,” and the Florida State University “Seminoles,” use Native American names and logos. Trademark cancellation, therefore, has the potential to financially affect these teams.

The University of Illinois owns several trademarks, including the trademark “Fighting Illini” and a trademark on the symbol of the head of a Native American wearing a large, circular, feather headdress.²²⁷ Because the school relies on these trademarks to generate revenue, cancellation of these trademarks does have the potential to affect the school’s ability to collect revenue on the trademarks.

In contrast, the University of North Dakota does not own a registered trademark, although one trademark application is currently pending on the “Ralph Engelstad Arena Home of the Fighting Sioux.”²²⁸ Therefore, any effort to cancel its trademark in an attempt to exert financial pressure on the school to change the name and logo of its sports teams is for naught.

Florida State University reportedly earns as much as \$1.8 million a year selling merchandise with its name and mascot.²²⁹ While the Florida Board of Regents owns several marks on behalf of Florida State University, including the trademark “FSU,”²³⁰ the school does not currently own any marks on “Seminoles,” though one is pending.²³¹ Even if the school were to obtain a trademark on the name, cancellation of the trademark will not stop the school from licensing the trademarked mark “FSU.” Because the school is not presently relying on a trademark on “Seminoles” for revenue—it is either selling merchandise covered by other trademarks or selling “Seminoles” merchandise without trademark

²²⁶ See *supra* note 27.

²²⁷ See *supra* note 19.

²²⁸ See *supra* note 20.

²²⁹ See *supra* note 13.

²³⁰ See *supra* note 18.

²³¹ See *id.*

coverage—cancellation of the pending “Seminoles” trademark likely will not have a financial impact on the team.

The alleged negative financial impact that would encourage teams to change their names due to trademark cancellation does not exist for most professional and collegiate teams in any meaningful way. As such, trademark cancellation would not be a viable avenue to encourage many other teams, such as high schools and amateur teams, to change their names—given that most do not own trademarks. Because of the nature of professional sports profit-sharing and the fact that many colleges rely little, if at all, on their trademarks for profit, the actual financial impact of trademark cancellation is minor. Therefore, trademark cancellation alone does not have the ability to force a team to change its name.

V. ALTERNATIVES TO USING TRADEMARK ALONE

Although it is debatable whether a majority of Native Americans find the use of Native American mascots, logos, and names offensive within the necessary definition for trademark law, it is a fact that many Native Americans, and other non-Native Americans, do find the uses insulting.²³² It is possible that the law alone will not provide a solution to the Native American mascot controversy. Many commentators have hailed trademark law as the legal avenue that will provide the answers, as it is designed to deny protection to “offensive” terms as determined by the referenced group.²³³ It is likely, however, as this Article has argued, that trademark law cannot provide the answer that opponents to the uses desire. Although trademark law may not be designed to handle the issue, it does not mean that the issue is not important.

Likewise, this Article is not suggesting that trademark cancellation proceedings are without merit. Although the financial impact may be minor in some cases, it still exists. While it is speculative whether other team owners will pressure the owners of the challenged trademarks to change their names, it is likely that

²³² See, e.g., Goldstein, *supra* note 36.

²³³ 15 U.S.C. § 1052(a) (2002).

some owners will be concerned with any possible decrease in revenue. It is likely that some owners will attempt to pressure the team of the cancelled trademark to change its name.

More importantly, trademark cancellation proceedings raise public awareness that some people find the uses offensive. When the “Redskins” trademark was cancelled, newspapers across the country ran headlines such as “Redskins Is Offensive, Team Loses Trademark” and “Redskins Are Denied Trademarks.”²³⁴ Although the TTAB’s decision to cancel the trademark was later overturned, this type of publicity has caused many primary, secondary, and collegiate teams to change their names.²³⁵ If opponents can force the cancellation of many different marks, including the trademarked images that are ripe for cancellation proceedings, they can send a message to teams and the public that the use of Native American mascots, logos, and names is unacceptable.

Although trademark law arguably has been the most successful legal avenue to date, it is possible that the problem is not going to be solved by legal means. Non-legal avenues such as protests, lobbying for legislation, and other methods of political pressure have been successful in raising awareness that the use of Native American mascots, logos, and names is offensive to many people. These protests have also been successful in forcing the change of names of many non-professional team names. The best solution may be to continue to bring legal challenges to raise public awareness, whether they succeed or not, combined with protests and other means of political pressure.

Even though the Native American population in the United States is statistically small, people like Suzan Harjo have been able to lead grassroots movements to decrease significantly the perceived racist uses of Native American symbols by sports teams. Once there were over 2,600 schools using mascots and names of Native Americans; now there are less than 600.²³⁶ Although trademark law may not provide the answer, opponents certainly will continue to protest the use of Native American mascots, logos,

²³⁴ See Masters, *supra* note 3, at A1.

²³⁵ See *supra* note 180 and accompanying text.

²³⁶ *Id.*

and names, and may even be successful in ending the use of many of them.

CONCLUSION

This Article has focused on the likely impact of the district court's decision in *Pro-Football, Inc v. Harjo* on other Native American mascots, logos, and names. It has provided an overview of the Native American mascot controversy, the structure of professional and collegiate licensing, and the attempts to limit use of Native American terms as mascots, logos, and names. It also has reviewed trademark law generally and the prohibition of trademark protection for disparaging and scandalous marks. The Article has concluded that the decision not to cancel the "Redskins" trademark probably will not affect most other Native American mascots, logos, and names. Finally, this Article has suggested that legal and non-legal means combined may be the most effective avenue for challenging the offensive use of Native American names and images in professional team trademarks.