

Seton Hall University  
**eRepository @ Seton Hall**

---

Law School Student Scholarship

Seton Hall Law

---

2015

# The Redskins' Trademark Controversy and the Evidentiary Problems Associated with Proving Disparagement Under Section 2(a) of the Lanham Act

Frank J. Siclari

Follow this and additional works at: [https://scholarship.shu.edu/student\\_scholarship](https://scholarship.shu.edu/student_scholarship)



Part of the [Law Commons](#)

---

## Recommended Citation

Siclari, Frank J., "The Redskins' Trademark Controversy and the Evidentiary Problems Associated with Proving Disparagement Under Section 2(a) of the Lanham Act" (2015). *Law School Student Scholarship*. 809.  
[https://scholarship.shu.edu/student\\_scholarship/809](https://scholarship.shu.edu/student_scholarship/809)

THE REDSKINS' TRADEMARK CONTROVERSY  
AND THE EVIDENTIARY PROBLEMS ASSOCIATED WITH PROVING  
DISPARAGEMENT UNDER SECTION 2(a) OF THE LANHAM ACT

FRANK SICLARI

**I. Introduction**

This paper sets out to discuss the current controversy regarding the registration status of six federally registered trademarks registered to the Washington Redskins football team. Specifically, these marks have seen a series of two challenges raised by very similar petitioners who put forward a very similar record of evidence in an effort to show that the marks were disparaging, as defined in Section 2(a) of the Lanham Act, to a substantial composite of Native Americans when the marks were first registered.

Currently, the Washington Redskins, represented by Pro-Football, Inc. (Pro-Football), are litigating the second of these disparagement claims before the District Court for the Eastern District of Virginia, where Pro-Football hopes to win an appeal of the cancellation order recently issued by the United States Patent and Trademark Office's (USPTO) reviewing agency, the Trademark Trial and Appeal Board (TTAB). This paper takes the position that Pro-Football will likely prevail because the record of evidence is insufficient to support a finding under the strict burden of proof applied under the recently passed America Invents Act (AIA).

Although Pro-Football's claim includes the defense of laches, and a host of constitutional challenges, the research herein solely reviews the disparagement claim and the evidentiary burden which makes it difficult for petitioners for cancellation to prevail after long periods of time have passed. Furthermore, the research contained herein sets out to show that the most recent petitioners have pigeonholed themselves by refusing to supplement the record from the prior petition which ultimately failed.

## **II. Background of Trademark Law**

### **A. History and Basics**

A trademark is “any work, name, symbol, or device ... used by a person ... to identify and distinguish his or her goods, including a unique product, from those manufactured or sold to others and to indicate source of the goods, even if that source is unknown”.<sup>1</sup> A service mark is “a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others”.<sup>2</sup> Because both trademarks and service marks serve similar functions, they are both commonly referred to as trademarks.<sup>3</sup> Accordingly, this paper will refer to both types of marks as trademarks.

The Lanham Act creates a mechanism for trademark owners to obtain federal registration for their marks. In order to obtain a trademark or a service mark registration in the United States, the mark owner must submit an application with the USPTO, which is required to refuse registration of applications that do not meet the registration criteria of 1 U.S.C. §1052.<sup>4</sup>

If denied registration, the applicant may request reconsideration by appealing to the TTAB.<sup>5</sup> The TTAB is a component of the USPTO, and consists of the Director of the USPTO, the Commissioner for Patents, the Commissioner for Trademarks, and the administrative judges appointed by the Director.<sup>6</sup> As provided for in the Lanham Act, the TTAB sits in three-member panels to make its decisions.<sup>7</sup> The Lanham Act also creates provides competitors and others with a process to request review of an examining attorney’s decision to issue a registration that they believe is contrary to 15 U.S.C. § 1052. Accordingly, the TTAB reviews both oppositions and petitions to cancel registrations on behalf of the USPTO.<sup>8</sup>

The Lanham Act, and more generally the trademark law, was drafted with the intention of affording protection to both the consumer and the owner of the mark from unfair competition

that results when a third-party infringer appropriates the mark for their own benefit.<sup>9</sup> Trademark protection in the United States (U.S.) is granted to the first entity to use a particular mark in the geographic area where it operates, regardless of whether the mark is registered. A claim for infringement is usually based on the likelihood of confusion and an argument that the alleged infringer has created some kind of unfair competition.<sup>10</sup> Accordingly, trademarks serve several important global functions: to signify a product's source; to signify that the same source controls the relevant goods; to signify a consistent level of quality with the goods bearing the trademark; to serve as an advertisement tool; and to serve as an objective symbol of the trademark holder's goodwill.<sup>11</sup>

## **B. Disparagement**

While trademark law sets out to protect the holder of the mark from unfair competition, it also affords protection to the interests of persons who can show the TTAB that they are harmed by the mark's usage. Specifically, the Lanham Act bars the registration of a mark which "[c]onsists of or compromises 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".<sup>12</sup>

In order to prove "disparagement", the TTAB takes a two-pronged approach.<sup>13</sup> First, the board must determine the meaning of the relevant term, as it is used in connection with the products identified in the registration. To accomplish this end, the TTAB considers the dictionary definition of the term, the relationship of the term and other elements of the mark, the type of product upon which the mark appears, and how the mark will appear in the marketplace. Secondly, the board examines whether the meaning was disparaging to the referenced group. The latter prong of the test requires a "substantial composite" of the referenced group to find the

term disparaging. Furthermore, the petitioners must be able to show that the marks were offensive to a substantial composite of the referenced group at the time of registration.

### **C. America Invents Act**

After being signed into law by President Barack Obama on September 16, 2011, the AIA of 2011 fundamentally changed the treatment of intellectual property by the USPTO. Although the AIA most greatly affected the governance of patent registrations, most notably switching the U.S. patent system from a “first to invent” system to a “first inventor to file” system, it also provided for several changes to USPTO practices. Relevant to the issues discussed herein, the AIA changed the venue for appeals from USPTO inter partes proceedings from the U.S. District Court for the District of Columbia to the U.S. District Court for the Eastern District of Virginia.

## **III. Background of the Redskins’ Controversy**

### **A. History and Basics**

On July 9, 1932, the city of Boston, Massachusetts was awarded its first franchise in the National Football League (NFL). On October 2 of that same year, taking the namesake of the Major League Baseball (MLB) team with whom they shared a stadium, the Boston Braves took to the gridiron for their inaugural season under the ownership of Vincent Bendiz, Jay O’Brien, Dorlan Doyle, and George Preston Marshall. However, after reporting a loss on the season, three of the owners decided to cut their losses and to leave the franchise in the sole ownership of George Preston Marshall, who controlled the franchise’s operations for the next six decades.

Once in control of the franchise, Marshall, who previously enjoyed success in the laundromat business, began to make wholesale changes. Almost immediately, Marshall fired Head Coach Lud Wray after his middling 4-4-1 inaugural season to make way for the hiring of his next head coach, William Henry “Lone Star” Dietz. In a marketing attempt to distance

himself from one of Boston's professional baseball team's also known as the Braves, Marshall relocated his franchise's home stadium from Braves Field, home of the Braves baseball team, to Fenway Park, home of Boston's other professional baseball team, the Red Sox.

In taking no half measures, Marshall broke all ties with the baseball team with whom he formally shared a stadium by changing his team's namesake from the "Braves" to the "Redskins". Marshall, a promotional wiz, made sure to thrust this name change into the spotlight. For example, on July 6, 1933, the Boston Herald published an article announcing Marshall's decision which explained the change as one "made to avoid confusion with the Braves baseball team and that the team is to be coached by an Indian, Lone Star Dietz, with several Indian players".<sup>14</sup> Next, on the first day of practice that year, Marshall's coach and players posed for pictures dressed in headdresses and war paint. Notably, Coach Dietz maintained a similar dress code for each of the team's home games that season.

After two disappointing seasons under Coach Dietz, partially owing to rule changes which promoted passing offenses, Marshall decided it was time for another change and replaced Dietz with a new head coach, and another the following year. In 1937, struggling to find and maintain a fanbase, Marshall relocated his team to the Washington, D.C. area. In 1966, just under thirty years, twelve head coaches, and two championships later, Marshall and the Redskins' filed their first application to register the franchise's namesake. In 1967, the franchise's application for federal registration of its service mark was accepted. By 1990, the USPTO granted registrations to a total of six marks owned by Pro-Football, Inc. (hereinafter "Pro-Football") which contained the word "Redskins" or a derivative of the word.

## **B. Pro-Football, Inc.**

Pro-Football, Inc. is the corporate owner of the Washington Redskins, a National Football League football team located in the Washington, D.C. metropolitan area. Pro-Football is the owner of the six marks at issue in the matter analyzed herein.<sup>15</sup>

#### **IV. Procedural History**

##### **A. The Harjo Petition**

###### **1. Harjo Before the Trademark Trial and Appeal Board**

On September 10, 1992, twenty-five years after the Redskins' football team received its first federal registration, Suzan Shown Harjo and six other Native Americans [collectively, hereinafter the "Harjo Petitioners"] filed the first cancellation petition which challenged the Redskins' organization's namesake pursuant to Section 14 of the Trademark Act of 1946 [hereinafter the "Harjo Petition"].<sup>16</sup>

Specifically, the Harjo Petitioners challenged the six marks, *supra*, on grounds that the usage: 1) is "scandalous"; 2) "may... disparage" Native Americans; and 3) may cast Native Americans into "contempt or disrepute" in violation of 15 U.S.C. §1052(a).<sup>17</sup>

In its answer, Pro-Football denied: 1) that Section 2(a) of the Lanham Act unconstitutionally impinges on First Amendment speech rights; 2) that it also contravenes Fifth Amendment due process rights; and 3) that the Harjo Petitioner's challenge was barred by the equitable defense of laches.<sup>18</sup> However, in a pretrial order issued in March 1994, the TTAB struck each of Pro-Football's defenses.<sup>19</sup> The constitutional arguments were dismissed because, as the board explained, deciding on the constitutionality of a statute is beyond the scope of the board's authority.<sup>20</sup> The board also opined that the doctrine of laches was not available as a defense because the Harjo Petitioners advocated on behalf of a broad, public interest, while Pro-

Football's interests were distinctly private.<sup>21</sup> Thus, the board decided the matter based on the claims which related to the Lanham Act.

Five years later, in finding the record showed by "substantial evidence" that each relevant mark "may be disparaging of Native Americans to a substantial composite of this group of people" or "may bring Native Americans into contempt or disrepute," the TTAB issued a cancellation order for Pro-Football's six contested marks.<sup>22</sup>

With respect to the review of the meaning of the language found in Section 2(a), the board determined that such issues pertain only to the time periods when the relevant registrations were issued. The Harjo Board framed the issue before them as "whether, at the times [Pro-Football] was issued each of its challenged registrations, [Pro-Football's] registered marks consisted of or compromised scandalous matter, or matter which may disparage or bring Native Americans into contempt or disrepute".<sup>23</sup>

The *Harjo* Board's analysis began with a discussion of "scandalous matter", as defined in the relevant portion of Section 2(a). After noting that the vast majority of the relevant reported cases involving the relevant portion of Section 2(a) were decided principally on the basis of whether the marks consisted of scandalous matter<sup>24</sup>, the board concluded that the registrations in the current matter did not comprise "scandalous matter".<sup>25</sup>

Next, the board discussed the meaning of "may...disparage", which it recognized as a clear and distinct ground for refusing or cancelling the registration of a mark under Section 2(a).<sup>26</sup> On this term, the board admitted to having little precedent or legislative history for guidance in interpreting the disparagement provision and found the determination of whether matter may be disparaging to be "highly subjective".<sup>27</sup> As a result, the board chose to structure a



new two-pronged test for disparagement, as defined in Section 2(a).<sup>28</sup> Under this new test, the board's disparagement determination was depended on the following two inquiries:

- (1) What is the meaning of the matter in question, as it appears in the marks as used in connection with the goods and services identified in the registrations?
- (2) Is the meaning of the marks one that may disparage a substantial composite of Native Americans at the time of each mark's registration?<sup>29</sup>

Likewise, on the meaning of Section 2(a) "contempt or disrepute", the board concluded that:

The guidelines enunciated herein in connection with determining whether matter in a mark be disparaging are equally applicable to determining whether such matter brings 'persons, living or dead, institutions, beliefs, or national symbols into contempt or disrepute.'

As consequence, a finding of disparagement necessitates a finding of "contempt or disrepute".<sup>30</sup>

On this conflated issue, the board was offered the following record of evidence: witness testimony, which discussed resolutions passed by their respective organizations,<sup>31</sup>; an American history expert testimony<sup>32</sup>; a multicultural counseling issues expert testimony<sup>33</sup>; a Native American educational issues expert; linguistic expert testimony from both parties; a film expert<sup>34</sup>; survey expert testimony from both parties; and marketing expert testimony from both parties.<sup>35</sup>

After reviewing this record, the board made findings of fact which related to only two pieces of evidence, survey expert testimony and linguist expert testimony.<sup>36</sup>

Dr. Ivan Ross, the Harjo Petitioners' survey expert, testified that the relevant survey was conducted to "determine the perception of a substantial composite of the general population and of Native Americas to the word 'redskin(s)' as a reference to Native Americans".<sup>37</sup> In his effort

to obtain the necessary substantial composite, Dr. Ross surveyed three hundred and one (301) non-Native Americans and three hundred and fifty-eight (358) Native Americans.<sup>38</sup> Dr. Ross testified that the Native American participants represented “a stratified sample” of the Native American population, “wherein census reports were used to identify the twenty states with the largest numbers of Native Americans, from which the Native American sample was chosen according to a random sample plan”.<sup>39</sup>

Dr. Ross’ telephone survey was conducted by asking the participants, in varying order, whether they found the following “terms offensive”: “Native American”, “Buck”, “Brave”, “Redskin”, “Injun”, “Indian”, and “Squaw”.<sup>40</sup> Participants were then asked whether they, or others would be “offended” by the use of term and, if so, why. <sup>41</sup> Notably, Dr. Ross testified that, for the question, he chose the word “offensive” as most likely to reflect, to those unfamiliar with trademark law, the behavior concepts embodied in the terms “scandalous” and “disparaging” in trademark law.<sup>42</sup>

Ultimately, Dr. Ross’ survey concluded that 46.2% of the general population sample would be personally offended by the use of the term “redskin”, while only 36.6% percent of the Native American population sample would be personally offended by the usage.<sup>43</sup>

Although Pro-Football did not conduct its own survey, it did provide the expert witness, Dr. Jacob Jacoby, to discuss the survey on the record. <sup>44</sup> In his expert testimony, among offering various other procedural concerns with the sample selection process, including a challenge that the survey represented only two percent of all U.S. counties and that Hawaii and Alaska were erroneously excluded,<sup>45</sup> Dr. Jacoby challenged the validity of the survey for the following reasons: that the questions were leading and not neutral; the list contained an insufficient number of terms; that the term “offensive” as used to mean “disparaging” failed to answer the relevant

question under section 2(a); and the Native American sample was too geographically limited to serve as representative.

Ultimately, Dr. Jacoby concluded the survey was an “utter failure” because it did not ascertain the perceptions of the relevant population at the relevant time period, the time when the marks were first registered<sup>46</sup>, and because it failed to use the term “redskin(s)” in the context of Pro-Football’s entertainment services.<sup>47</sup>

In accordance with Dr. Jacoby’s testimony, the Harjo Board conceded that the survey was “not without flaws,”<sup>48</sup> As stated by the board:

We agree with Dr. Jacoby that a survey of attitudes as of the dates of registration of the challenged registrations would have been extremely relevant in this case, if such a survey could be credibly constructed. But neither party chose to undertake such a survey.<sup>49</sup>

However, despite finding “merit” behind Dr. Jacoby’s criticisms, the Harjo Board concluded that the record of evidence provided “ample support for the viability of the survey methodology used, including the sampling plan, the principal questions asked, and the manner in which the survey was conducted”.<sup>50</sup>

In making specific findings of fact based on the expert linguists’ testimony, the board mainly highlighted portions of the evidentiary record that were not disputed by the parties’ expert linguists.<sup>51</sup> With respect to the dictionary evidence offered by both parties, the board found the contradictory opinions of the opposing parties to be of “little value” in resolving the dispute.<sup>52</sup> Instead the board independently considered the dictionary definitions themselves as evidence which was relevant to the ultimate legal inquiry.<sup>53</sup>

Although the Harjo Board made no findings of fact regarding NCAI Resolution 93-11 or the depositions of the Executive Director of the NCAI, JoAnn Chase, and of the Director of Indian Legal Information Development Service (“ILDS”) Director, Harold Martin Gross, the Harjo Board opined that this evidence “reinforced” its prior disparagement determinations.<sup>54</sup>

Ultimately, on April 2, 1999, the board issued a cancellation order for each of the six contested trademarks after finding that each relevant mark “may be disparaging of Native Americans to a substantial composite of this group of people” or “may bring Native Americans into contempt or disrepute”.<sup>55</sup> On the remaining issue, the TTAB found the relevant marks to not be “scandalous”.<sup>56</sup>

## **2. Harjo in the United States District Court for the District of Columbia**

On June 1, 1999, less than a month after the TTAB’s decision by the *Harjo* Board, Pro-Football filed its first complaint with the United States District Court for the District of Columbia.<sup>57</sup> In its complaint, Pro-Football sought *de novo* review and presented the court with five causes of actions supporting its request to overturn the cancellation order: 1) the trademarks do not disparage Native Americans; 2) the trademarks do not bring Native Americans into contempt or disrepute; 3) Section 2(a) of the Lanham Act violates the First Amendment because it is a vague, overbroad, and content-based restriction on speech; 4) Section 2(a) of the Lanham Act is unduly vague in violation of the Fifth Amendment; and 5) Defendant’s cancellation petition was barred by the equitable doctrine of laches.<sup>58</sup>

On August 30, 1999, coinciding with their answer, the Harjo Petitioners filed a motion requesting the following relief: (1) to dismiss Pro-Football’s constitutional and laches claims; or, (2) in the alternative, for a judgment on the pleadings with regard to those claims. However, after conducting a motions hearing and receiving additional briefs from both parties, the court

denied without prejudice the Harjo Petitioners' motion with respect to both requests.<sup>59</sup> The court opined that the doctrine of constitutional avoidance required the court to first rule on the three non-constitutional claims, and only address the constitutional claims should Pro-Football not prevail on its other claims first.<sup>60</sup>

With respect to the Harjo Petitioners' motion to dismiss Pro-Football's laches claim, the court found that "the Lanham Act does not unequivocally bar laches claims and defenses raised in regard to petitions brought under section 2(a)" and the applicability of the doctrine of laches is "dependent upon the equities of the factual scenarios within it is raised".<sup>61</sup> Therefore, as the court opined, Pro-Football's laches claim should not be dismissed until the factual record could be further developed.<sup>62</sup>

On July 12, 2003, after an extensive discovery period, the parties filed cross motions for summary judgment. In its motion, Pro-Football sought summary judgment on its first, second, and fifth causes of action, arguing that Pro-Football's trademarks in dispute do not disparage Native Americans, that the trademarks do not and will not bring Native Americans into contempt or disrepute, and, that the doctrine of laches applies.<sup>63</sup> In their cross motion for summary judgment, the Harjo Petitioners argued that the court should affirm the TTAB's decision, that Pro-Football's laches claim should be rejected, and to dismiss Pro-Football's constitutional claims, should the court reach that issue.<sup>64</sup>

On September 30, 2003, the District Court for the District of Columbia granted Pro-Football's summary judgment motion and reversed the TTAB's order to cancel the six registered trademarks in question for two reasons:

The TTAB's finding of disparagement is not supported by substantial evidence and must be reversed. The decision should also be reversed because the doctrine of laches precludes consideration of the case.<sup>65</sup>

However, before discussing any of its findings, the board discussed the appropriate standard of review. On this point, the court found that "its review of the TTAB's findings shall be commensurate with the 'substantial evidence' standard of review articulated in the APA".<sup>66</sup> Under the substantial evidence standard, the court will reverse the TTAB's findings of fact if they are "unsupported by substantial evidence" or "more than a mere scintilla".<sup>67</sup>

In its analysis, the court criticized the limited factual findings of the TTAB and the great deal of summarization which the *Harjo* Board undertook instead. As explained by the court, "[e]ven though it spent fourteen pages cataloging the evidence in the case, the TTAB made findings of fact in only two areas: 1) linguists testimony and (2) survey evidence".<sup>68</sup>

With respect to the entire record of linguists' testimony, the TTAB made only five findings of fact recognizable to the district court.<sup>69</sup> As the court pointed out, the TTAB still failed to "make any findings of fact with regard to the usage labels contained in the some dictionary definitions" and "simply considered the dictionary definitions, themselves, in the context of its legal analysis, without relying on the experts' opinions".<sup>70</sup>

With respect to the survey evidence, the court found that the *Harjo* Board made three findings of fact.<sup>71</sup> With respect to these findings, the court found substantial evidence in support of the TTAB's "narrow" conclusion that the evidence represented nothing more than "a survey of current attitudes at the time the survey was conducted". However, the court found that the record lacked substantial evidence to support the *Harjo* Board's findings that the methodology was proper to extrapolate the survey results to the Native American population at large; thus, it

so followed, that the record also lacked substantial evidence to show that the survey represented the views of the two populations sampled.<sup>72</sup>

In response to the board's attempt to "reinforce" its conclusions with unsubstantiated resolutions and deposition testimony, the court explained:

To corroborate its ultimate conclusion, the TTAB cites to other evidence which this Court views as irrelevant because it has no correlation to the relevant time frame at issue and it does not add exponentially to the requirement that the marks, when used in connection with Pro-Football's services, are considered disparaging by a substantial composite of Native Americans. The TTAB noted that the record includes Resolutions indicating a present objection to the use of the word "redskin(s)" in connection with Pro-Football's services, from the National Congress of American Indians ("NCAI"), "a broad-based organization of Native American tribes and individuals" from the Oneida tribe, and from Unity 94, "an organization including Native Americans." All of these resolutions were made after the relevant time frame, with no explanation by the TTAB as to how they 'shed light' on the relevant time period, and thus, are irrelevant to the calculus ...

Moreover, the TTAB made no findings of fact about the strength of this evidence.

Ultimately, the court rejected the board's finding of disparagement because "the TTAB's finding that the marks at issue 'may disparage' Native Americans is unsupported by substantial evidence, is logically flawed, and fails to apply the correct legal standard to its own finding of fact".<sup>73</sup>

Notably, the court also concluded, "in the alternative," that the doctrine of laches barred the Harjo Petitions claims because "the record demonstrates both undue delay and economic

prejudice.”<sup>74</sup> Specifically, the board articulates the availability of laches only when the following three-pronged test is satisfied:

- 1) the Native Americans delayed substantially before commencing their challenge to the “redskins” trademarks;
- 2) the Native Americans were aware of the trademarks during the period of delay; and
- 3) Pro-Football’s ongoing development of goodwill during the period of delay engendered a reliance interest in the preservation of the trademarks.”<sup>75</sup>

Before answering each of the three prongs affirmatively, the court also denied the Harjo Petitioners’ argument that laches was barred by section 2(a) where a “public interest” is vindicated.<sup>76</sup> Instead, the court refused to interpret the Lanham Act to preclude laches and opined that the affirmative defense of laches in this case, like all laches claims, must be decided on its specific facts and circumstances.<sup>77</sup>

The Harjo Petitioners appealed the court rulings that the claim of disparagement was not supported by substantial evidence and that the defense of laches may be asserted against a disparagement claim to the D.C. Circuit Court, who found that the district court applied the wrong standard in evaluating laches with respect to one petitioner.<sup>78</sup> Accordingly, the DC Circuit ruled in favor of the Harjo Petitioners and remanded the matter to the district court to decide the narrow issue of whether laches barred the one petitioner’s claim.<sup>79</sup>

Specifically, the DC Circuit found that because the equitable doctrine of laches cannot begin to run before a party has reached the age of majority “the district court mistakenly started the clock for assessing laches in 1967 – the time of the first mark’s registration – for all appellants, even though the first Native American was at that time only one year old.”<sup>80</sup>



Therefore, in remanding the matter to the district court, the appellate court ruled that “[t]he district court should have measured both the first Native American’s delay and the resulting prejudice[both economic and trial] to the owner based on the period between his attainment of majority and the filing of the 1992 cancellation petition”.<sup>81</sup> The D.C. Circuit did not address the issue of whether substantial evidence supported the Board’s finding of disparagement.

On June 25, 2008, the court granted Pro-Football summary judgment on the sole issue of whether the claims brought by the one petitioner, who was born in 1966, was barred by laches.<sup>82</sup> After finding that “[the one petitioner] unreasonably delayed his bringing of a cancellation petition and that his eight year delay demonstrates a lack of diligence on his part”, the court also found that “the delay ... resulted in prejudice to Pro-Football, such that it would be inequitable to allow [the one petitioner] to proceed with his cancellation petition”.<sup>83</sup>

Once again, the Harjo Petitioners appealed the district court’s decision to the D.C. Circuit. However, in light of the narrow inquiry of the district court on remand, the Harjo Petitioners argued “only that the district court improperly assessed evidence of prejudice in applying laches to the facts at issue”.<sup>84</sup> On May 15, 2009, after reviewing the record, the D.C. Circuit found no error and affirmed the decision of the lower court on the issue of laches and stated that the petitioners “argue only that the District Court improperly assessed evidence of prejudice in applying laches to the facts at issue” and limited its decision “to that question.”<sup>85</sup> Thus, the D.C. Circuit resolved the case solely on the issue of laches, never addressing the Board’s finding of disparagement on the merits.

On November 16, 2009, the Harjo Petition failed for the last time when the United States Supreme Court denied a petition for writ of certiorari.

## **B. The Blackhorse Petition**

In August 2006, while the decision in *Harjo* was still pending, Amanda Blackhorse and four other, new Native Americans (collectively, hereinafter the “Blackhorse Petitioners”) filed a petition to cancel the same six registrations that were challenged in the Harjo Petition.<sup>86</sup> Like the Harjo Petitioners before them, the Blackhorse Petitioners argued “that the registrations were obtained contrary to Section 2(a), which prohibits registration of marks that may disparage persons or bring them into contempt or disrepute”.<sup>87</sup> However, unlike the Harjo Petitioners, the petitioners here were not yet born when the marks were originally registered.

### **1. Blackhorse Before the Trademark Trial and Appeal Board**

On June 19, 2014, after the proceedings in this matter were suspended pending the disposition of the Harjo action, a split TTAB ordered the cancellation of six trademarks owned by the Redskins organization after concluding that the marks “were disparaging to Native Americans at the respective times they were registered, in violation of Section 2(a) of the Trademark Act of 1946, 15 U.S.C. §1052(a)”.<sup>88</sup> The majority of the board also concluded, as the board did in deciding on the Harjo petition, that the Blackhorse Petitioners’ claim was not barred by the doctrine of laches.

To determine the disparagement claim at issue, the TTAB reiterated appropriateness of the two-pronged analysis articulated by the *Harjo* Board and upheld in the District Court’s review of that decision.<sup>89</sup> However, under the AIA, the *Blackhorse* Board’s review requires the more strict “preponderance of the evidence” review.<sup>90</sup>

In light of this higher burden of proof, the parties stipulated, with limited exceptions, that the entire record of evidence used by the *Harjo* Board may be submitted into evidence through a Notice of Reliance.<sup>91</sup> In a pertinent part, the stipulation provided that “all evidence submitted with a Notice of Reliance, as well as all deposition transcripts and exhibits

thereto submitted by any party, in *Harjo* ... shall be admissible in this proceeding unless the [TTAB] ruled in *Harjo* that the evidence was not admissible, in which case all arguments as to admissibility are preserved".<sup>92</sup> Thus, as stipulated, the parties only reserved the right to make objections based on the relevance of evidence admitted in the *Harjo* record and this case.<sup>93</sup>

Because it rejected the Harjo Petitioners' survey evidence, the board, in deciding the second prong, was forced to look to other available evidence which most directly reflected the sentiments of Native Americans. As such, for the general analysis of the word, the board reviewed and discussed the testimony and reports provided by the parties' respective experts, dictionary definitions, and reference books.<sup>94</sup> For the specific views of Native Americans, the board focused on the National Congress of American Indians' 1993 Resolution 93-11, the deposition of NCAI Executive Director, Ms. JoAnn Chase, the deposition of Dr. Harold Martin Gross, and various newspaper articles, reports, official records, and letters.<sup>95</sup>

After a review of the same record presented to the Harjo Board, the board in this matter concluded that the record was more than substantial on the follow basis: (1) "NCAI Resolution 93-11 represents the views of a substantial composite of Native Americans"<sup>96</sup>; (2) "[t]he trend in dictionary usage labels corroborates the time frame of the objections from Native Americans starting in the sixties and continuing through the nineties as lexicographers begin [to] uniformly label the term as 'offensive' or 'disparaging'"<sup>97</sup>; (3) "[the disparagement] is also demonstrated by the near complete drop-off in usage of 'redskins' as a reference to Native Americans beginning in the 1960's"<sup>98</sup>; and (4) "[t]he record establishes that, at minimum, approximately thirty percent of Native Americans found the term REDSKINS used in connection with respondent's services to be disparaging at all times including 1967, 1972, 1974, 1978, and 1990"<sup>99</sup>.

## **2. Blackhorse Before the District Court for the Eastern District of Virginia**

On August 8, 2014, Pro-Football filed a Complaint against Defendants before the court seeking *de novo* judicial review of the *Blackhorse* TTAB's decision to order the cancellation of six federally registered marks. Specifically, the Complaint raised the following seven causes of action: (1) Declaration of Non-Disparagement; (2) Declaration of Non-Contempt or Disrepute; Declaration that Section 2(a) of the Lanham Act Violates the First Amendment; (3) Declaration that Section 2(a) of the Lanham Act is Void for Vagueness; (5) Declaration that the TTAB Order Violates the Due Process Clause of the Fifth Amendment; (6) Declaration that the TTAB Order Violates the Takings Clause of the Fifth Amendment; and (7) Declaration that Defendant's Petition was Barred by the Doctrine of Laches.<sup>100</sup>

On September 22, 2014 the Blackhorse Petitioners responded with a motion for summary judgment in which they alleged that there was "no justiciable dispute" because the Blackhorse Petitioners have no direct stake in the outcome of the case. In accordance with this allegation, the Blackhorse Petitioners further alleged that the court lacked subject matter jurisdiction because the Blackhorse Petitioners are not "parties in interest".<sup>101</sup>

On November 25, 2014, the court handed down its decision to deny the Harjo Petitioners' Motion. In his Memorandum Opinion, Judge Gerald Bruce Lee provided four main reasons: (1) the legitimate interests of the parties in the cancellation of the mark are sufficient to establish jurisdiction under Article III of the U.S. Constitution; (2) §1071(b) of the Lanham Act provides review of a TTAB's decision in the Federal Circuit or a United States District Court, and the alleged harm or controversies decided in such administrative proceeding must carry over into the review of the proceeding; (3) the Harjo Petitioners' cancellation petition demonstrated that they have a sufficient interest in the registration to constitute §1071 "adverse parties" and "parties in

interest”; and, most significant to the analysis here, (4) the prior proceeding before the TTAB was an inter partes proceeding where the Harjo Petitioners were the sole adverse parties.<sup>102</sup>

#### **IV. Analysis of the Section 2(a) Disparagement Claim Currently Before the United States District Court for the Eastern District of Virginia**

Section 2(a) of the Lanham Act prohibits registration of a mark “which may disparage ... persons ... or bring them into contempt, or disrepute”.<sup>103</sup> As originally decided by the board in *Harjo*, the guidelines for determining whether the marks were disparaging are equally applicable to determine whether such matter brings persons or institutions into contempt or disrepute.<sup>104</sup> Since Pro-Football did not raise the board’s conflation of the inquiries as an issue on appeal to the court, the *Harjo* Court refused to consider the determination altogether.<sup>105</sup> Instead, the District Court in *Harjo* only reviewed “whether the marks at issue “may disparage” Native Americans, which then included whether the marks bring Native Americans into contempt or disrepute. <sup>106</sup> Likewise, after the board applied this same conflated analysis in the *Blackhorse* matter, Pro-Football did not raise the conflation as an issue before the court.<sup>107</sup> Thus, the court will likely apply the analysis articulated first by the board in *Harjo* and subsequently applied at each stage of the *Harjo* and *Blackhorse* matters where disparagement was at issue. However, since the parties in this matter agreed that the term “redskins” clearly refers to both the professional football team while retaining an allusion to Native Americans, the disparagement inquiry before the court will likely be limited to the second prong of the disparagement test: whether the meaning of the marks, as used in the context of Pro-Football’s services, is one that may disparage Native Americans at the time of each mark’s registration. <sup>108</sup>

With respect to the second prong, finding of a “substantial composite” of the referenced group is a fact to be determined at trial.<sup>109</sup> Significantly, the AIA heightened the burden of proof

since the Harjo Petition was resolved. In the current matter before the court, the court cannot make any findings of fact which are not supported by a “preponderance of the evidence” on the record, as opposed to the “substantial evidence” or “more than a mere scintilla” which was appropriate under the APA in the *Harjo* proceedings. In order to make a determination that the evidence satisfies the more burdensome preponderance of the evidence standard, the court will be “charged with taking into account the views of the entire referenced group who may encounter [Pro-Football’s services] in any ordinary course of trade for the identified goods and services”<sup>110</sup>

In the underlying action, the *Blackhorse* Board answered the second prong affirmatively. However, because the record does not substantiate its finding, by a preponderance of the evidence, that a substantial composite of Native Americans found the marks disparaging at the time of each registration, the court should find for Pro-Football on the disparagement issue and reverse the TTAB’s order to cancel the six marks.<sup>111</sup>

**A. The Record is Insufficient to Find, by a Preponderance of the Evidence, that a Substantial Composite of Native Americans at Any Point During the Relevant Time Period of 1966-1990 Found the Marks as Used in the Context of Pro-Football’s Services to be Disparaging.**

Through a joint notice of reliance, Pro-Football and the Blackhorse Petitioners stipulated that nearly the entire record of evidence offered in the *Harjo* proceedings – evidence which the District Court for the District of Columbia and the D.C. Circuit Court of Appeals already found insufficient to support the exact same claim – would be admitted into evidence for the board’s review.<sup>112</sup> The only evidence from the *Harjo* record that was not stipulated into this record was

the deposition testimony of the Harjo Petitioners.<sup>113</sup> This excluded evidence was, in effect, substituted out for the deposition testimony of the Blackhorse Petitioners.<sup>114</sup>

In an attempt to substantiate its conclusion that a substantial composite of Native Americans who found the term disparaging not only existed at the relevant time but can be substantiated by a preponderance of the evidence on the record, the *Blackhorse* TTAB made thirty-nine findings of fact.<sup>115</sup> All of these facts were based on two categories of evidence: 1) a general analysis of the word “redskins”; and 2) the specific views of some individuals in the referenced group.<sup>116</sup>

### **1. Evidence Related to the General Analysis of the Word “Redskins”**

With respect to the general analysis of the term “redskins”, the board leaned heavily on the dictionary research conducted by the Blackhorse Petitioner’s expert linguist, Mr. Barnhart.<sup>117</sup> In a pertinent part, Mr. Barnhart’s testimony indicated that dictionaries did not include a restrictive usage label for the term “redskin” until a single dictionary chose to in 1966.<sup>118</sup> While the record does not include a copy of that dictionary, it does include excerpts from twenty-eight other dictionaries published throughout the relevant time period.<sup>119</sup> Of these twenty-eight dictionaries, ten editors reported the term as “standard English”, while only two editors identified the same term as “disparaging”.<sup>120</sup>

After failing to explain its decision to ignore the twenty-six of twenty-eight dictionaries made available on the record which do not refer to the term “redskin” as “disparaging”, the Blackhorse board found it appropriate to base its finding that the usage labels found in two of the twenty-eight dictionaries on the record “show[s] a clear trend beginning in 1966 to label this term as offensive.”<sup>121</sup> However the majority of the board’s concept of a “clear trend” consists of two dictionaries. As stated by the *Blackhorse* dissent, “[t]wo does not make a trend.”<sup>122</sup>

Regardless of whether it actually does, the majority of the board's failure to provide an explanation not to draw findings from the first twenty-six dictionaries necessitates a finding that the majority's findings fell short of satisfying the appropriate standard of proof.

Likewise, the Blackhorse Board applied flawed reasoning when it found significance in the testimony offered by the Blackhorse Petitioners' expert witnesses, Dr. Geoffrey Nunberg, which pointed to a decrease in usage for the term "redskins" among media outlets after 1970.<sup>123</sup> Although Pro-Football offered a valid criticism that such indirect thinking lacks scientific basis, the board contended that "[it did] not rely on Dr. Nunberg's ultimate opinions and conclusions ... rather [the board looked] to the underlying data that is not in dispute which undeniably shows a drop-off in usage". While it is true that Mr. Barnhart's research reached a similar conclusion, this correlation does not necessitate the causation the Blackhorse Board attaches to it. In fact, the record provides no basis, scientific or otherwise, which suggests a connection between the drop in usage of the term and the meaning of the marks in the context of Pro-Football's services.<sup>124</sup> Therefore, once again, the majority's failure to explain the articulate any type of soundness in its judgment necessitates a finding that the majority's findings fell short of satisfying the appropriate standard of proof.

Moreover, the entirety of evidence which speaks to the general analysis of the word is irrelevant to the disparagement question left at issue. Simply put, the dictionary evidence found in the record is insufficient to satisfy the test for disparagement because it fails to provide insight into the disparagement question at issue. The relevant question is not whether the term "redskins" is generally offensive, or even whether the term is generally disparaging. Rather, the appropriate legal question to be answered is whether the term as used in the marks in the context of Pro-Football's services is disparaging.<sup>125</sup> To use the dictionary evidence made available on the



record to support of finding of disparagement would be to ignore the high-hurdle set by the preponderance of the evidence standard. Accordingly, the court should afford much more deference to evidence which pertains to how Native Americans perceived the term “redskins” when used in connection with the name of a football team.

## **2. Evidence Related to the Native American Perception of the Marks as Used in the Context of Pro-Football’s Services**

Instead of consulting the entirety of the record’s evidence pertaining to the perceptions Native Americans at the relevant times, as required under both substantial evidence review and preponderance of the evidence review, the majority of the board only extrapolated on evidence that supported its findings. As such, the majority of the *Blackhorse* Board found NCAI Resolution 93-11 to be “clearly probative” of the view of Native Americans held at the relevant time period because the NCAI “represented approximately thirty percent of Native Americans” and the resolution represents “a substantial composite” of Native Americans.”<sup>126</sup> However, outside an unsubstantiated claim offered within the resolution at issue that the “NCAI is the oldest and largest intertribal organization nationwide”, the *Blackhorse* Petitioners have failed to offer any reliable evidence which attested to either the NCAI’s members during the relevant time period or who attended the meeting in which Resolution 93-11 was voted on and passed.<sup>127</sup>

In an attempt to authenticate this resolution, the board was forced to supplement its findings with the deposition testimony of the Executive Director of the NCAI, JoAnn Chase, and of the Director of Indian Legal Information Development Service (“ILDS”) Director, Harold Martin Gross. Ms. Chase, who became Executive Director in 1994, testified that approximately 150 tribes were represented by the NCAI when the Resolution was passed in 1993.<sup>128</sup> However, Ms. Chase also testified that she was not in attendance at the meeting when the resolution was

passed and that she neither knew whether any minutes of the meeting were taken nor where to locate any record of the minute. Alarming, Ms. Chase also testified that she unaware of any indication that the necessary quorum of members was present for the vote. When asked about the NCAI's membership status throughout the relevant time period of 1967-1990, Ms. Chase testified that she did "not know what the membership of the organization at that time".

Despite the absence of the evidence which could put this approximate number of members into any sort of meaningful context for that year, such as evidence that would make it possible to calculate the percentage of the Native American population which the NCAI purported to represented, the majority of the *Blackhorse* Board chose to derive the percentage of Native Americans represented by the NCAI from Ms. Chase's approximation of 150 member tribes in 1993 and the list of federally recognized Native American tribes which was published for the year 1995.<sup>129</sup> Again, because of the multitude of unexplained leaps in its findings, the board's analysis failed to satisfy the appropriate standard of review.

First, leaving aside the relevance of the number and percentage of tribes the NCAI represented in 1993, the board's decision to derive this percentage of representation from a list of federally recognized tribes for a different year altogether, without offering any support for its mathematical premise, fails to satisfy even the "substantial evidence" standard, let alone the necessary "preponderance of the evidence" standard. Simply stated, the board inexplicably found it proper to compare the number of tribes the NCAI purported to have represented in 1993 to a list of recognized tribes for the year 1995 when the list of recognized tribes for the year 1993 was just as readily available to the petitioners. Thus, without providing any explanation for why this obviously inaccurate and illogical calculation would provide the board with a preponderance

of the evidence to rest the remainder of its findings on, the entire line of findings which follow this unsubstantiated conclusion should also be deemed insufficient by the court.<sup>130</sup>

Still, the Blackhorse Board made further errors worthy of note. For example, the board divided its approximation of 500 recognized tribes in 1995 by Ms. Chase's approximated 150 tribes which the NCAI purported to represent in 1993 to deduce a finding that the NCAI represented "approximately thirty-percent" or "one-third" of the Native American population.<sup>131</sup> Even after setting aside the fact one-third and thirty-percent are not interchangeable numbers, the board failed to explain why it approximated the "500" recognized tribes in the first place. A brief reading of the six pages from the 1995 Federal Register, would teach anyone with rudimentary mathematical skills that there were 540 federally recognized tribes in 1995.<sup>132</sup> Even assuming that Ms. Chase's representation of 150 tribes is fair and accurate and that the mathematical process applied by the board to obtain the percentage of representation is logically sound, the percentage of representation held by the NCAI would stall fall below twenty-eight percent. Regardless of whether any portion of that percentage can represent a substantial composite of the referenced population and whether any of the percentages can be sufficiently translated to the relevant time period, the board's failure to explain the basis for any of its loose and approximated mathematics causes it to fail the preponderance of evidence standard immediately.

In a second attempt to substantiate the validity of the NCAI's claims regarding the relevant time period, the *Blackhorse* Board majority turned on the deposition testimony of Mr. Gross. The majority of the board found relevance in Mr. Gross' testimony that Leon Cook, President of the NCAI, participated in a 1972 meeting with Edward Bennett Williams, then President and part-owner of the Washington Redskins, to discuss Mr. Williams' team namesake. Instead of deposing Mr. Cook to have him testify regarding NCAI membership in 1972, the

Blackhorse Petitioners only offered a newspaper article which discussed the meeting and claimed that the NCAI retained 300,000 members at that time.<sup>133</sup> However, as pointed out by the *Blackhorse* dissent, this article does not state that Mr. Cook or any other source provided this membership figure or even whether they spoke with the reporter at all.<sup>134</sup> As a result, reliance on this evidence to corroborate the findings of NCAI 93-11, is speculative at best and surely does not offer the court a “preponderance of evidence”, nor even “scintilla” which these findings can be supported with.

Ultimately, a careful examination of the evidence available on the record fails to show by a preponderance of the evidence that a substantial composite of Native Americans found the term to be disparaging in connection with Pro-Football’s services during the relevant time period of 1967-1990. As a necessary consequence of the deficiencies described above, the findings related to NCAI Resolution 93-11 should be rejected by the court.

Although the board repeatedly chose not to expand on the evidence which placed term in the proper context, the record does include evidence that reach this relevant point. For example, the record contains evidence that at least two Native American groups use the term “Redskin” as the name of their sports teams:

- 1) A sign at a Navajo Indian Reservation school: Red Mesa High School Home of the Redskins, with the photograph taken in 1989 and sent by Robert D. Kahn to Jack Kent Cooke on November 4, 1991; and
- 2) A sports article in the April 30, 2010 issue of the *Seminole Tribune* (Fla.), referencing the “Lady Redskins” as one of the teams involved in a tribal basketball tournament.<sup>135</sup>

Although the article was published after the relevant time period, it retains relevance because, like Navajo High School's sign, it displays a positive perception within the Native American population of the term "redskin" when used in the context of a sports team. Collectively, this evidence could provide the court with the necessary preponderance of evidence to conclude that the term "redskins" when used as the name of a sports team takes on a different meaning than the one warned about in the general usage labels used by the board in *Blackhorse* to condemn Pro-Football's registrations.

Should the evidence of the term's usage by these Native American sports teams not satisfy the court alone, the record also contains nine other letters and articles which display the sentiments of Native American populations who have not found the term's usage disparaging in the context sports' teams which are not predominantly consisting of Native Americans.<sup>136</sup> For example, a 1992 article in which the chief of the Choctaw Nation of Oklahoma sent a letter to the Washington Redskins organization which discussed the history of the Choctaws and how that history correlates with the usage of American Indian names and images by sports teams. In his letter, Chief Roberts stated that:

Sports teams traditionally adopt a namesake and image which they perceive as noble and powerful. The Washington Redskins is a team ... that Indian people can be proud to be identified with.<sup>137</sup>

In light of the evidence available on the record to put the term "redskins" into a relevant context, the board's decision, to value the testimony of Mr. Barnhart, a man who is neither Native American nor tasked with collecting the views of Native Americans, over such evidence, cannot be reasonably expected to clear the high-hurdle set by the preponderance of evidence standard.<sup>138</sup>

Furthermore, the Blackhorse Board's decision to not offer any deference to the evidence in support of Pro-Football's position because "it does not negate the opinions of those who find it disparaging", fails to satisfy the less stringent "preponderance of the evidence" standard. As explained by the court in its review of the *Harjo* TTAB's decision, the preponderance of the evidence standard "involves examination of the record as a whole, taking into account evidence that both justifies and detracts from an agency's decision".<sup>139</sup>

Thus, a review of the record reveals cognizable difference between the evidence used to substantiate the *Blackhorse* TTAB's conclusions and the empirical evidence regarding how Native Americans perceive the use of the term as the name of a sports team: the latter answers the question raised in the second prong of the disparagement test with a definitive no, while the former fails to even address the relevant issues.

## **B. Poorly Applied Precedent**

### **1. "Different" Meanings and "Stripped" Meanings**

In reviewing disparagement in the context of Pro-Football's goods and services, the *Blackhorse* TTAB found it necessary to determine "what type of disparagement case the facts of this limited case present."<sup>140</sup> In doing so, the *Blackhorse* TTAB limited itself to three potential outcomes. According to the *Blackhorse* TTAB, such a context can: (1) turn an innocuous term into a disparaging one; (2) strip the disparaging meaning from an otherwise disparaging term; or (3) have no effect on a term's disparaging meaning. In finding that the term at issue here fails to "strip the disparaging meaning from an otherwise disparaging term," the board inappropriately compared the facts of this case to those of from the *Squaw Valley* and *Heeb* matters.

In the matter of *In re Squaw Valley Development Company*, the TTAB was tasked with reviewing its previous decision to reverse the USPTO's refusal to register marks containing the

word “squaw.” Ultimately, the *Squaw Valley* TTAB affirmed its previous decision to register the marks “Squaw” and “Squaw One” as they related to ski-related goods but reversed, and rejected, the registrations as they related to non-ski-related goods and services. In a relevant section which was cited by the *Blackhorse* TTAB, the *Squaw Valley* TTAB stated the following:

the meaning of [‘Squaw’] and [‘Squaw One’], when used in connection with applicant's International Class 28 skiing-related goods, is applicant's Squaw Valley ski resort, and, when used in connection with the International Class 25 goods and the International Class 35 services, is ‘not applicant or its ski resort, but rather . . . the dictionary definition of [‘Squaw’], i.e., an American Indian woman or wife.’

In the *Blackhorse* TTAB’s decision to cancel the six marks at issue, the board cited this section as proof that a term used in the context of goods or services can “strip the disparaging meaning from an otherwise disparaging term.” but that is not remotely close to the finding articulated by the *Squaw Valley* board. In *Squaw Valley*, the board found that the ski-related goods referenced a geographic area, not Native Americans.<sup>141</sup> Accordingly, the *Squaw Valley* Board did not imply that the acceptable usage “stripped” the term of its meaning, the board explicitly stated that this usage derived from a different term altogether, the geographic area. For the *Blackhorse* Board to argue otherwise, it necessarily must be allowing the outside biases and preconceived notions of the decisionmaker to impact the final determination over the evidence made available on the record. In effect, the *Blackhorse* Board’s inability to view the record through an object lens, created an irrebutable presumption of disparagement.

*In re Heeb Media* concerned an application to register a mark containing the word “Heeb” for use on clothing. Ultimately, despite the clearly disparate generational views among

the Jewish community, the *Heeb* Board found the mark disparaging.<sup>142</sup> The *Blackhorse* Board used this case to exemplify when a term's usage has "no effect on the term's disparaging meaning". However, through the *Blackhorse* Board's own admission, the cited section does not support such a conclusion. In the *Blackhorse* Board's own words, "[Heeb Media's] good intent and inoffensive goods and services to not obviate findings that [the term] is disparaging in context of the goods and services."<sup>143</sup> This articulation does not shed light on when a mark has "no effect on term's disparaging meaning". Instead, it simply offers the *Heeb* Board's opinion that the intent of the usage is neither dispositive nor obsolete. Although a careful reading of this citation may have forced the *Blackhorse* Board to consider Pro-Football's intent, which it did not, it does not speak on when or how a board should determine that the mark's usage has "no effect on the term's disparaging meaning". Thus, it does not offer anything of value when determining the "type of disparagement case".

## **2. "Ex Parte" Proceedings and "Inter Partes" Proceedings**

Further, for *Blackhorse* Board's reliance on the *Squaw Valley* and *Heeb* matters ignores the different standards of proof required in *ex parte* and *inter partes* proceedings.<sup>144</sup> Both the *Squaw Valley* and *Heeb* proceedings were *ex parte* proceedings. In other words, both of those matters were initiated by petitioners who did not play an active role in the proceedings and left the dispute to be litigated between the mark holder and the USPTO. On the other hand, an *inter partes* proceeding is an adversarial action between parties in which the petitioner remains an active participant in the proceedings. Thus, in accordance with the findings of the court, the *Blackhorse* matter is an *inter partes* proceeding.<sup>145</sup>

In recognition of the less stringent burden which controls the outcome of an *ex parte* proceeding, the *Squaw Valley* Board explained:



In *ex parte* prosecution, the burden is initially on the Patent and Trademark Office (PTO) to put forth sufficient evidence that the mark for which registration is sought meets the above criteria of unregistrability. Mindful that the PTO has limited facilities for acquiring evidence – it cannot, for example, be expected to conduct a survey of the marketplace or obtain consumer affidavits – we conclude that the evidence of record here is sufficient to establish a *prima facie* case of deceptiveness.<sup>146</sup>

However, unlike the PTO in an *ex parte* proceeding, the Blackhorse Petitioners in this proceeding do not have such “limited facilities for acquiring evidence”. As a result, the Blackhorse Petitioners can be expected to “conduct a survey or obtain affidavits”.

The Blackhorse Petitioners’ failure to produce such evidence was strictly the result of their own decisionmaking. Instead of preparing their own evidence, the Blackhorse Petitioners opted not to.

Similar to the concerns raised by the board in *Squaw Valley* regarding the appropriate standard of proof in *ex parte* proceedings, the *Heeb* Board recognized the need to “be cognizant of the USPTO’s limitations in amassing evidence”.<sup>147</sup> This lesser burden allowed the *Heeb* Board to rely upon a quote from Ken Jacobson, in which he stated that he was the associate national director of the Anti-Defamation League and that the word “heeb” “is offensive to many Jews”, without finding any evidence on the record that related to the authority of said Anti-Defamation League, the authority of Jacobson to speak on behalf of the Jewish community, or the number of Jewish persons he claimed to represent. Thus, as applied by the board in *Heeb*, a substantial composite of the referenced group may be deduced from the statements of a few individuals who proclaimed themselves to be group representatives without requiring the TTAB

to examine the representative capacity of those individuals or requiring any mathematical calculation concerning the number of referenced persons these individuals purported to represent.

**C. Since the Evidence Offered from the Blackhorse Petitioners is Essentially Unchanged from the Record of Evidence in the *Harjo* Proceedings and Because the Harjo Petitioner's Same Claim Failed Under a Lesser Burden of Proof, the District Court for the Eastern District of Virginia's Findings Should Stay Consistent with the Findings of the District Court for the District of Columbia.**

Not only is the claim currently before the *Blackhorse* Court the same claim that was raised in the *Harjo* cancellation proceeding, but the new petitioners also decided to submit essentially the same record of evidence as well.<sup>148</sup> Despite the D.C. Circuit Court of Appeals' refusal to overturn the district court's ruling in the *Harjo* proceeding that the evidence on the record was insufficient to support the Board's finding of disparagement with substantial evidence, the only evidence from the *Harjo* record that was not stipulated into this record was the deposition testimony of the NUMBER Harjo Petitioners; however, the evidence was effectively replaced with the deposition testimony of the NUMBER Blackhorse Petitioners.<sup>149</sup> As a consequence of the Blackhorse Petitioners' failure to offer any evidence besides what was deemed insufficient to support the same claim in the *Harjo* matter, the evidence before in this case remains insufficient as well.

This conclusion would already hold true if the court was tasked with finding a mere "substantial composite" of the evidence, as the district court in *Harjo* was. However, because of a new governing statute, the court must be able to support the new cancellation petition by a preponderance of the evidence. As such, the *Blackhorse* Board applies inconceivable logic

Thus, it is illogical for the *Blackhorse* Board to assume that an account of the evidence that so plainly failed the less strict burden of substantial evidence review could satisfy the stricter burden of proof required preponderance of the evidence standard.

#### **D. Err in Favor of Registration**

Lastly, the Blackhorse TTAB recognized that any cancellation of a registration should be granted only with “due caution” and “after a most careful study of all the facts.”<sup>150</sup> In the case at bar, there isn’t just a doubt but a ruling on the same evidence and the same claim from another district. Surely, a potential circuit split gives rise to a “doubt”. In accordance with this need for “due caution” the court should not affirm the finding of the Blackhorse Board until, unlike that reviewing agency, the court has provided all of the evidence on the record the review it deserves.

#### **VI. Conclusion**

Proving disparagement as it pertains to Section 2(a) of the Lanham Act is no easy task. Recent legislations, such as the America Invents Act, has only made it harder for petitioners to prevail on such claims by placing a higher evidentiary burden on those parties to show disparagement.

In relation to the Blackhorse matter, it is very likely that Pro-Football will succeed in obtaining a reversal of the TTAB’s cancellation order because the record of evidence is insufficient made available by the *Blackhorse* Petitioners to support a finding under the strict burden of proof applied under the recently passed America Invents Act (AIA).

This is not to say that another group of petitioners could not win a similar claim in the future. Although this hypothetical challenger would be faced with more challenges, such as the passing of even more time, it seems clear from the controversy that has already transpired that they would be best off providing a review board, or a court, with a new record of evidence.

---

<sup>1</sup> 15 U.S.C. §1127; Microstrategy, Inc. v. Motorola, Inc., 245 F.3d 335, 341 (4th Cir.2011).  
<sup>2</sup> Id.  
<sup>3</sup> J. McCarthy, McCarthy on Trademarks and Unfair Competition §3.1(4<sup>th</sup> ed. 2013).  
<sup>4</sup> See 15 U.S.C. §1062(b).  
<sup>5</sup> See 15 U.S.C. §1052.  
<sup>6</sup> 15 U.S.C. §1078(b)  
<sup>7</sup> 37 C.F.R. §§ 2.129(a) & 2.142(e)(1).  
<sup>8</sup> 15 U.S.C. § 1067(a)  
<sup>9</sup> See Yale Elec. Corp. v. Robertson, 26 F.2d 972, 973-974 (2d Cir. 1928).  
<sup>10</sup> See New Kids on the Block v. News America Pub., Inc.; 971 F.2d 302, 305 (9th Cir. 1992).  
<sup>11</sup> J. McCarthy, McCarthy on Trademarks and Unfair Competition §3.2(4<sup>th</sup> ed. 2013).  
<sup>12</sup> 15 U.S.C. §1052(a).  
<sup>13</sup> See Pro-Football, Inc. v. Harjo, 50 U.S.P.Q.2d 1705 (T.T.A.B 1999).  
<sup>14</sup> entitled “Braves Pro Gridmen to Be Called Redskins”  
<sup>15</sup> See Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1709 (T.T.A.B. 1999).  
<sup>16</sup> See Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999); See also 15 U.S.C. §1064.  
<sup>17</sup> Id. at 1708.  
<sup>18</sup> Id. at 1749.  
<sup>19</sup> Id.  
<sup>20</sup> Id.. 1833.  
<sup>21</sup> Id. at 1794.  
<sup>22</sup> Id. at 1705.  
<sup>23</sup> Id. at 1707.  
<sup>24</sup> Id. at 1749.  
<sup>25</sup> Id.  
<sup>26</sup> Id.  
<sup>27</sup> Id. at 1736.  
<sup>28</sup> Id. at 1749.  
<sup>29</sup> Id.  
<sup>30</sup> Id..  
<sup>31</sup> Id. at 1714-17.  
<sup>32</sup> Id. at 1749.  
<sup>33</sup> Id.  
<sup>34</sup> Id.  
<sup>35</sup> Id.  
<sup>36</sup> Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96, 107 (D.D.C. 2003).  
<sup>37</sup> Id. at 109.  
<sup>38</sup> Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1709 (T.T.A.B. 1999). (An “adult” was any man or woman who had reached a minimum age of sixteen years).  
<sup>39</sup> See Pro-Football, Inc.v. Harjo, 284 F.Supp.2d 96, 109(D.C. 2003).  
<sup>40</sup> Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1749 (T.T.A.B. 1999).  
<sup>41</sup> Id.  
<sup>42</sup> Id.  
<sup>43</sup> Id.  
<sup>44</sup> Id.  
<sup>45</sup> Id.  
<sup>46</sup> See Id.  
<sup>47</sup> See Pro-Football, Inc.v. Harjo, 284 F.Supp.2d 96, 112(D.C. 2003).  
<sup>48</sup> Id. ; see also Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1749 (T.T.A.B. 1999).  
<sup>49</sup> Id.  
<sup>50</sup> Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1749 (T.T.A.B. 1999).  
<sup>51</sup> See Pro-Football, Inc.v. Harjo, 284 F.Supp.2d 96, 108 (D.D.C. 2003).  
<sup>52</sup> Id. at 109.  
<sup>53</sup> Id.  
<sup>54</sup> Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1747 (T.T.A.B. 1999).

---

55 Id.  
56 Id.  
57 Pro-Football, Inc. v. Harjo, 286 F.Supp.2d 96, 99 (D.C. 2003).  
58 Id. at 100; see also 15 U.S.C. §1071(b).  
59 Id.  
60 Id.  
61 Id. at 1145.  
62 See id at 1145-46.  
63 Pro-Football, Inc. v. Harjo, 286 F.Supp.2d 96, 99 (D.C. 2003).  
64 HARJO PAGE 5 CITE 19  
65 Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96 (D.D.C. 2003).  
66 See id at 114-116  
67 See id at 145.  
68 HARJO 104; see also HARJO 22  
69 See Pro-Football, Inc.v. Harjo, 284 F.Supp.2d 96, 108 (D.C. 2003).  
70 See id. at 109.  
71 Id.  
72 Id.  
73 HARJO 200  
74 Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96, 144 (D.D.C. 2003).  
75 HARJO 203  
76 Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96, 145 (D.D.C. 2003).  
77 Id.  
78 See Pro-Football, Inc. v. Harjo, 415 F.3d 44, 47 (D.C. Cir.2005).  
79 See Id.  
80 Id. at 51.  
81 Id. at 49-50; See also Pro-Football, Inc. v. Harjo, 415 F.3d 44, 47 (D.C. Cir. 2005).  
82 Id.  
83 See Pro-Football, Inc. v. Harjo, 567 F.Supp.2d 46, 48 (D.C. 2008).  
84 See Pro-Football v. Harjo, 565 F.3d 880, 889 (D.C. Cir. 2009).  
85 Id.  
86 Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1749 (T.T.A.B. 1999).  
87 Id. at 51.; See also 15 U.S.C. 1052(a).  
88 Pro-Football, Inc. v. Blackhorse, 2014 U.S. Dist. LEXIS 166889, 8-9 (E.D. Va. Nov. 25, 2014).  
89 Id. at 4.  
90 Id. at 5.  
91 Id. at 18.  
92 Id. at 4.  
93 Id.  
94 Id. at 5.  
95 Id.1.  
96 Blackhorse v. Pro-Football, Inc., 13, 111 U.S.P.Q.2D (BNA) 1080, 1094 (T.T.A.B. 2014).  
97 Pro-Football, Inc. v. Blackhorse, 2014 U.S. Dist. LEXIS 166889, 4-5 (E.D. Va. Nov. 25, 2014).  
98 Id.  
99 Id. at4  
100 Id.  
101 Id. at 5; See also Id. at 1.  
102 Id. at 2.  
103 Id.  
104 Blackhorse v. Pro-Football, Inc., 13, 111 U.S.P.Q.2D (BNA) 1080, 1095-96 (T.T.A.B. 2014).  
105 Id. at 109  
106 Id.  
107 Pro-Football, Inc. v. Blackhorse, 2014 U.S. Dist. LEXIS 166889, 1 (E.D. Va. Nov. 25, 2014)  
108 Harjo v. Pro-Football, Inc., 50 USPQ2d at 1742, rev'd on other grounds, Pro-Football, Inc. v. Harjo, 68 USPQ2d at 1249.

- 
- 109 Id.
- 110 Blackhorse v. Pro-Football, Inc., 13, 111 U.S.P.Q.2D (BNA) 1080, 1085 (T.T.A.B. 2014) (citing Heeb Media, 89 USPQ2d at 1075).
- 111 Id. at 2.
- 112 Id. at 2.
- 113 Id. at 1090.
- 114 Id.
- 115 Id.
- 116 Id. at 1124.
- 117 Id. at 1090.
- 118 Id. at 1149; See Random House Unabridged (1st ed. 1966).
- 119 Id. at 1112.
- 120 Id.
- 121 Id.
- 122 Id. at 1171.
- 123 Id. at 1168.
- 124 Id. at 1102.
- 125 Id. at 1101.
- 126 Id. at 1099.
- 127 Id. at 1020.
- 128 Id. at 1022.
- 129 Id. at 1034.
- 130 Id.
- 131 Id. at 1119.
- 132 1995 Federal Register
- 133 Blackhorse v. Pro-Football, Inc., 13, 111 U.S.P.Q.2D (BNA) 1080, 1235 (T.T.A.B. 2014).
- 134 Id.
- 135 Id.
- 136 Id.
- 137 Id. at 1238.
- 138 Id. at 1241.
- 139 Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96, 116 (D.D.C. 2003).
- 140 Blackhorse v. Pro-Football, Inc., 13, 111 U.S.P.Q.2D (BNA) 1080, 1200 (T.T.A.B. 2014).
- 141 In re Squaw Valley Development Co., 80 U.S.P.Q.2D (BNA) 1264, 1283-83 (T.T.A.B. 2008).
- 142 In re Heeb Media, LLC., 89 USPQ2d 1071, 1073 (T.T.A.B. 2008).
- 143 Blackhorse v. Pro-Football, Inc., 13, 111 U.S.P.Q.2D (BNA) 1080, 1201 (T.T.A.B. 2014). (citing In re Heeb Media, LLC., 89 USPQ2d 1071, 1077(T.T.A.B. 2008)).
- 144 In re Squaw Valley Development Co., 80 U.S.P.Q.2D (BNA) 1264, 1277(T.T.A.B. 2008).
- 145 Pro-Football, Inc. v. Blackhorse, 2014 U.S. Dist. LEXIS 166889, 12 (E.D. Va. Nov. 25, 2014)
- 146 In re Squaw Valley Development Co., 80 U.S.P.Q.2D (BNA) 1264, 1278 (T.T.A.B. 2008).
- 147 In re Heeb Media, LLC., 89 USPQ2d 1071, 1088 (T.T.A.B. 2008).
- 148 Blackhorse v. Pro-Football, Inc., 160, 111 U.S.P.Q.2D (BNA) 1080, 1121 (T.T.A.B. 2014).
- 149 Id. at 1090.
- 150 Rockwood Chocolate Co. v. Hoffman Candy Co., 372 F.2d 552, 152 USPQ 599, 601 (CCPA 1967) (internal citations omitted).