

Articles

How Dykes on Bikes Got It Right: Procedural Inequities Inherent in the Trademark Office’s Review of Disparaging Trademarks

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If I must be labeled other than as a “person,” “human being,” or “woman,” I choose “Dyke.” “Dyke” is a strong word and I say it with pride. “Dyke” expresses my pride in myself, my existence, and in what I have accomplished. I am gay. I am a lesbian. I AM A DYKE!

—Soni Wolf, Secretary of the San
Francisco Women’s Motorcycle
Contingent¹

Introduction

THE SAN FRANCISCO WOMEN’S MOTORCYCLE CONTINGENT (“SFWMC”) was formed in 1976 and organizes, as one of its largest and most high profile events, the Dykes on Bikes contingent as part of the annual San Francisco Lesbian, Gay, Bisexual, Transgender Pride Parade.² While this Dykes on Bikes tradition has taken place since 1976,³ the SFWMC did not seek to register the DYKES ON BIKES trademark until 2003. The organization was spurred to seek registration after a third party, unaffiliated with the organization, attempted

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1. U.S. Trademark Application Serial No. 78/281,746, Paper Correspondence Incoming, Aug. 23, 2004 (Declaration of Soni S.H.S. Wolf).

2. *History*, DYKES ON BIKES, http://www.dykesonbikes.org/index.php?option=com_content&view=article&id=49&Itemid=63 (last visited Apr. 22, 2011).

3. *Id.*

to register the trademark for a profit-making enterprise.⁴ To protect the history associated with their unofficial name, the organization submitted a trademark application for DYKES ON BIKES to the United States Patent and Trademark Office (“USPTO”) on July 31, 2003.⁵ It took seven months before the USPTO responded and denied the trademark application declaring that the word “dyke” is disparaging to lesbians in violation of the Lanham Act’s prohibition on the federal registration of disparaging trademarks.⁶

In short, the USPTO told this group of lesbians that the name they called themselves for almost twenty-five years was too offensive to lesbians—such as themselves—to receive federal trademark protection. In response to this “slap in the face,”⁷ the SFWMC utilized the help of a trademark attorney in order to prepare a lengthy response submitted on August 23, 2004 explaining that the term dyke has been reappropriated by the lesbian community and is now an expression of pride rather than disparagement.⁸ This response included numerous statements by linguists and sociologists about the positive use of dyke in the lesbian community and by members of the SFWMC attesting to their own positive understanding and use of the term.⁹ These declarations included the statements at the start of this Article by the SFWMC’s Secretary, Soni Wolf.¹⁰ Again, on October 28, 2004, the USPTO denied their application.¹¹

The SFWMC took months to gather additional affidavits and academic support and then appealed this final rejection on April 28, 2005.¹² In this appeal, the SFWMC provided additional evidence in the form of declarations from academic and linguistic experts, evidence of the positive use of dyke in publications and websites,¹³ a list of other reappropriated slurs approved by the USPTO, and even a videotape of a Dykes on Bikes pride rally, highlighting the positive

4. *Id.*

5. U.S. Trademark Application Serial No. 78/281,746 (filed July 31, 2003).

6. U.S. Trademark Application Serial No. 78/281,746, Office Action Outgoing, Feb. 20, 2004.

7. Barbara Raab, *Rough Ride*, NAT’L SEXUALITY RES. CTR. (Apr. 20, 2006), http://nsrc.sfsu.edu/article/rough_ride.

8. U.S. Trademark Application Serial No. 78/281,746, Paper Correspondence Incoming, *supra* note 1.

9. *Id.*

10. *Id.*

11. U.S. Trademark Application Serial No. 78/281,746, Office Action Outgoing, Oct. 28, 2004.

12. U.S. Trademark Application Serial No. 78/281,746, Paper Correspondence Incoming, Apr. 26, 2005.

13. *Id.* at exhibits 1–24.

response of those in attendance.¹⁴ The trademark application was finally approved on January 4, 2006, but official registration was delayed further until October 30, 2007 because of a third party opposition.¹⁵ Thus, it took more than four years of waiting and fighting, as well as countless attorney and expert hours, before the SFWMC finally received federal trademark registration for DYKES ON BIKES—a trademark that the organization had been using publicly across much of the country since 1976.¹⁶

While this long, drawn-out process was likely frustrating and exhausting to the SFWMC, especially in light of the fact that the trademark involved was intimately tied to the SFWMC members' own senses of self, this Article argues that this tedious progression is an example of how the trademark application process for potentially disparaging trademarks should properly occur. The alternative, as discussed later in this Article, leads to inconsistency and insurmountable hurdles imposed on unsuspecting and disparaged third parties.

Part I of this Article provides an introduction to the United States trademark system, the benefits of federal trademark registration, the process by which federal registration is obtained, and how the prohibition on the registration of disparaging marks affects that process. Part II provides a comparison of the procedural and legal process undertaken in connection with the attempt to obtain federal registration for three well-known, contentious trademarks. Part III discusses the problems inherent in the USPTO's current handling of the disparagement prohibition as illustrated by the aforementioned trademarks. Finally, Part IV suggests procedural changes that could be implemented to ensure that the disparagement analysis undertaken by the USPTO is more equitable, predictable, and less burdensome to third parties.

I. Trademark Background

Trademarks are all around us. While many are easily identifiable—STARBUCKS, FORD, and GOOGLE—it is easy to accept their

14. U.S. Trademark Application Serial No. 78/281,746, Applicant's Request to Remand for Additional Evidence, Exhibit A, Sept. 15, 2005.

15. U.S. Trademark Application Serial No. 78/281,746, Registration Certificate, Oct. 30, 2007. The delay between publication and final registration of this trademark is due to the fact that an opposition proceeding was brought by a third party after the mark was published in the Official Gazette, challenging the registration of DYKES ON BIKES on the grounds that "dykes" is disparaging to men. This opposition was dismissed after the third party opposer was determined to lack standing to sue. *McDermott v. S.F. Women's Motorcycle Contingent*, 240 F. App'x. 865 (Fed. Cir. 2007).

16. See *History*, *supra* note 2.

presence without questioning their purpose. Trademarks are source identifiers used to “identify and distinguish” the goods or services offered by a person or business.¹⁷ Trademarks are useful to an entity selling a product in that a trademark: (1) identifies the seller’s product and makes it distinct from those products sold by others; (2) signifies that all of the products bearing the mark come from a single source, the seller; (3) allows consumers to rely on the assumption that all products bearing the trademark are of a consistent level of quality; and (4) serves as a focal instrument for the advertising and marketing of the seller’s products.¹⁸ *McCarthy on Trademarks and Unfair Competition*, a treatise often relied upon by trademark practitioners and courts, explains that at the heart of a trademark is a company’s “good will”:

[A] trademark is also the objective symbol of the good will that a business has built up. Without the identification function performed by trademarks, buyers would have no way of returning to buy products that they have used and liked. If this consumer satisfaction and preference is labeled “good will,” then a trademark is the symbol by which the world can identify that good will.¹⁹

Simply by using a trademark in commerce in connection with goods or services, the owner of that mark possesses certain common law rights to the mark without ever seeking any federal or state registration.²⁰ However, federal registration of a trademark confers certain exclusive benefits on the trademark owner, including constructive notice nationwide of the trademark holder’s ownership and use of the mark,²¹ the ability to bring suit for infringement of the mark in federal court regardless of the amount in controversy, and the ability to stop importation of any goods improperly bearing the registered mark.²² Additionally, once a trademark is registered with the USPTO,

17. Lanham Act § 45, 15 U.S.C. § 1127 (2006) (defining “trademark”); *see also* 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 3:1 (4th ed. 2011).

18. 1 MCCARTHY, *supra* note 17, § 3:2.

19. *Id.*

20. 2 *id.* § 16:1.

21. This creates the presumption that the trademark holder possesses exclusive use of the mark nationwide even in parts of the country where the trademark holder is not currently using the mark and may never have plans to do so. Thus, a subsequent user of the mark cannot claim ignorance of the mark or use “good faith” as a defense in a future infringement suit. JANE C. GINSBURG, JESSICA LITMAN & MARY L. KEVLIN, TRADEMARK AND UNFAIR COMPETITION LAW 221 (3d ed. 2001).

22. *Id.* at 221–22.

future trademark applications that are likely to be confused with the registered mark will be denied.²³

A. The Federal Registration Process

To obtain federal registration of a trademark, the trademark owner must submit an application for registration of the trademark to the USPTO.²⁴ This application must clearly illustrate the proposed trademark and describe the goods or services with which it is currently being used²⁵ (or is proposed to be used).²⁶ Once received by the USPTO, the trademark application is assigned to a trademark examiner who will first review the application to confirm that it complies with certain procedural requirements.²⁷ Then, the examiner will review the trademark to ascertain whether it can be accepted for registration or if it must be rejected for one of various substantive reasons.²⁸

If accepted by the examiner, the trademark application will be published in the Official Gazette.²⁹ This publication provides notice to third parties of the USPTO's intent to allow federal registration for such trademark and allows such third parties an opportunity to formally oppose the registration.³⁰ An unopposed trademark will then

23. Likelihood of confusion is a standard applied both by the USPTO in evaluating trademark applications and by the courts in analyzing claims of trademark infringement. Whether being evaluated by a court or the USPTO, "likelihood of confusion depends upon whether the purchasing public would mistakenly assume that the applicant's goods or services originate with, are sponsored by, or are in some way associated with the goods sold under a cited registration or trademark." 4 McCARTHY, *supra* note 17, § 23:78.

24. 15 U.S.C. § 1051 (2006).

25. *Id.*

26. Starting in 1988, a revision of the Lanham Act began permitting trademark applicants to file an application to register a trademark based on a bona fide intent to use the trademark in commerce. While federal registration will not be officially issued by the USPTO for an intent-to-use trademark application until proof of use is later provided, the ability to register early provides constructive notice of the applicant's use of the mark to deter potential users of confusingly similar marks. Trademark Law Revision Act of 1988, Pub. L. No. 100-667, 102 Stat. 3935 (codified at 15 U.S.C. § 1051(b)).

27. 15 U.S.C. § 1051(a).

28. JEROME GILSON & ANNE GILSON LALONDE, U.S. PATENT AND TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINATION PROCEDURE §§ 1201-17 (7th ed. 2010) [hereinafter TMEP].

29. *Id.* § 106. The Official Gazette is issued every Tuesday and is the official publication of the USPTO; *see also* 15 U.S.C. § 1062.

30. 15 U.S.C. § 1062; *see* TMEP, *supra* note 28, § 106.

receive its federal registration and will appear on the Principal Register³¹ thirty days after its publication date.³²

However, the trademark application may be rejected for a variety of substantive reasons, including if, for example, it is determined to be confusingly similar to a trademark that is currently registered.³³ Additionally, under section 2(a) of the Lanham Act, the trademark will be refused if it “[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”³⁴ Once refused, the trademark examiner issues a response (an “Office Action”) that is mailed to the applicant detailing the reasons for refusal.³⁵ The trademark applicant then has six months to respond to the Office Action with additional evidence, revisions to its initial application, or legal arguments that may permit registration.³⁶

If the trademark applicant responds to the Office Action, the trademark examiner may either accept the applicant’s arguments, evidence, or revisions, or the examiner may issue another Office Action detailing the deficiencies that remain.³⁷ A few more rounds of this back and forth between the examining attorney and the applicant may occur until the examining attorney approves the registration or issues a final rejection of the application;³⁸ however, often the applicant simply abandons the contested application rather than reply to the examining attorney. The trademark applicant may appeal a final rejection to the Trademark Trial and Appeal Board (“TTAB”),³⁹ and a

31. Marks that meet the Lanham Act’s requirements for registration are registered on the Principal Register. Section 23 of the Lanham Act created a Supplemental Register on which certain marks not capable of being registered on the Principal Register—such as those that are descriptive or geographic in nature, or which are surnames—may still be registered if such marks “are capable of distinguishing the applicant’s goods or services.” 15 U.S.C. § 1091. Registration on the Supplemental Register does not afford the trademark owner with all of the benefits associated with registration on the Principal Register, but it does allow the owner to bring suit in federal court and provides some notice to third parties of the owner’s use of the mark; *see* GINSBURG, LITMAN & KEVLIN, *supra* note 21, at 223.

32. 15 U.S.C. § 1063.

33. 4 McCARTHY, *supra* note 17, §§ 23:77–78.

34. 15 U.S.C. § 1052(a). The Lanham Act is the name commonly used for the Trademark Act of 1946, which was codified at 15 U.S.C. §§ 1051–1127.

35. TMEP, *supra* note 28, § 701.

36. 15 U.S.C. § 1062(b).

37. *Id.*

38. *Id.*

39. *Id.* § 1070.

decision of the TTAB may then be appealed to the United States Court of Appeals for the Federal Circuit.⁴⁰ An approved trademark registration may also be brought before the TTAB and appealed to the United States Court of Appeals if a third party initiates an opposition proceeding against a trademark (after it has been published in the Official Gazette, but before it has been published on the Principal Register)⁴¹ or files an action to cancel the trademark (after it has been published on the Principal Register).⁴²

B. Section 2(a)'s Prohibition on Disparaging Trademarks

As mentioned above, section 2(a) of the Lanham Act bars registration of a trademark if it “[c]onsists of or comprises . . . 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.”⁴³ The legislative history for section 2(a) does not indicate the legislature’s goals for, or reasoning behind, adding this disparagement prohibition to federal trademark registration,⁴⁴ but courts interpreting section 2(a) have stated a number of possible justifications. In discussing the prohibition on scandalous trademarks under section 2(a), the United States Court of Customs and Patent Appeals stated:

In providing that marks comprising scandalous matter not be registered, Congress expressed its will that such marks not be afforded the statutory benefits of registration. We do not see this as an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government.⁴⁵

Additionally, the Third Circuit has stated that the interests protected under such provisions of the Lanham Act are not just injuries to a

40. *Id.* § 1071.

41. *Id.* § 1063.

42. *Id.* § 1064.

43. *Id.* § 1052(a). Though outside the scope of this Article, numerous scholars have argued that section 2(a) is unconstitutional for violating the First Amendment or Due Process. *See, e.g.*, Llewellyn Joseph Gibbons, *Semiotics of the Scandalous and the Immoral and the Disparaging: Section 2(a) Trademark Law After Lawrence v. Texas*, 9 MARQ. INTELL. PROP. L. REV. 187 (2005); 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); Lilit Voskanyan, Comment, *The Trademark Principal Register as a Nonpublic Forum*, 75 U. CHI. L. REV. 1295 (2008).

44. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1737 (T.T.A.B. 1999).

45. *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981).

specific challenging individual, but rather to the “integrity of the register.”⁴⁶

An analysis of potentially disparaging trademarks is further complicated by the fact that the legislature failed to include a definition of what constitutes a “disparaging” mark under section 2(a). At first, the USPTO and the TTAB solved this problem by either conflating the treatment of disparaging marks with the jurisprudence on obscene or scandalous marks,⁴⁷ or by barring registration only when the disparagement appeared “obvious” in the eyes of the examining attorney or the TTAB. For example, a court in 1951 held that using the mark DOUGH-BOY in connection with an anti-venereal disease medication “obviously” disparaged American soldiers because “doughboy” was a nickname given to such soldiers during World War I.⁴⁸ In 1969, the TTAB similarly decided, without providing any support for its determination or any additional analysis, that “[t]here can be no question” that a mark with an “X” over a hammer and sickle disparaged the Communist Party.⁴⁹

In *In re Hines*, decided in 1994, the TTAB followed scandalousness precedent and clarified that disparagement under section 2(a) should be defined according to its plain meaning as set forth in dictionary definitions.⁵⁰ As such, a disparaging trademark was held to be one that may disparage a person, institution, belief, or national symbol when it can “depreciate,” “belittle,” or “bring reproach or discredit upon” such person or entity.⁵¹ The TTAB in *Hines* then clarified that, in analyzing whether a mark is disparaging, “the percep-

46. *Marshak v. Treadwell*, 240 F.3d 184, 194 (3d Cir. 2001) (where the plaintiff petitioned to cancel the registration of a trademark that was allegedly obtained fraudulently in violation of section 14 of the Lanham Act).

47. See, e.g., *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938) (holding that the mark MADONNA was scandalous in connection with wine because of its reference to the Virgin Mary in the Christian religion); *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. (BNA) 156, 156 (Dec. Comm’r Pat. 1938) (denying registration of QUEEN MARY for women’s underwear because of its scandalous association with the Queen of England).

48. *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227, 228 (Dec. Exam’r Pat. 1951).

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

50. See *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1688 (T.T.A.B. 1994) (relying on the use of dictionary definitions in defining “scandalous” in *In re McGinley*, 660 F.2d 481, 485–86 (C.C.P.A. 1981)).

51. *Id.* (holding that the mark BUDDA BEACHWEAR is disparaging because it trivializes Buddhists) (reversed on other grounds by *In re Hines*, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994)). This reliance on dictionary definitions was followed by the TTAB in *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1738 (T.T.A.B. 1999), where the TTAB looked to a dictionary published around the time of the enactment of section 2(a)

tions of the general public are irrelevant.”⁵² Rather, the relevant perceptions are of those persons or groups who are “referred to, identified or implicated in some recognizable manner by the involved mark”⁵³

This focus on the perceptions of the disparaged group was later incorporated into a two-part disparagement test by the TTAB in *Harjo v. Pro-Football, Inc.* (“*Harjo I*”).⁵⁴ First, 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 registrations” must be determined.⁵⁵ This determination looks at dictionary definitions as well as the elements that make up the mark in its entirety, the nature of the product or service offered in connection with such mark, and the manner in which the mark is used in the marketplace.⁵⁶

For the second part of this test, the TTAB (or court) must determine whether such meaning may disparage a substantial composite of the referenced persons, institutions, beliefs, or national symbols.⁵⁷ The TTAB clarified that “in deciding whether the matter may be disparaging, we look, not to American society as a whole . . . but to the views of the referenced group.”⁵⁸ Additionally, in an action to cancel an existing trademark registration, the court clarified that the question of whether the mark is disparaging to a substantial composite of the referenced group looks back at the group’s perceptions of the mark at the time the mark was registered and not the date of the cancellation action.⁵⁹

II. Inconsistencies and Inequities in Recent Decisions

Determining whether a trademark is disparaging is still a very subjective matter despite the two-part test clarified in *Harjo I*. An examining attorney must first use dictionary definitions and personal knowledge to determine how the general public would interpret a

to define disparagement as to “dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.”

52. *In re Hines*, 31 U.S.P.Q.2d (BNA) at 1688.

53. *Id.*

54. *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1740–48 (T.T.A.B. 1999).

55. *Id.* at 1740–41.

56. *Id.* at 1738–39.

57. *Id.* at 1740–41.

58. *Id.* at 1738–39. This is a significant distinction between the analysis of disparaging marks and that of scandalous marks where a similar two-step test is used, but such a test refers to the views of a substantial composite of the general public as the appropriate reference group for both steps.

59. *See Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828, 1832 (T.T.A.B. 1994).

trademark. Then that attorney must adopt the mindset of a member of the referenced group to determine whether a substantial composite of the group would feel disparaged. Obviously, this is not an easy task and leads to some imprecise and inconsistent results across different examining attorneys. The trademark registration process as undertaken in connection with three trademarks—DYKES ON BIKES, WASHINGTON REDSKINS, and HEEB—is detailed below. The process under which these marks obtained, or failed to obtain, federal registration highlights some of the problems that result from the USPTO’s current treatment of potentially disparaging trademarks.

A. DYKES ON BIKES

As discussed in the introduction to this Article, the San Francisco Women’s Motorcycle Contingent submitted a trademark application to the USPTO on July 31, 2003 for their popular nickname, DYKES ON BIKES.⁶⁰ On February 20, 2004, the trademark examiner who was assigned to the application issued an Office Action refusing to register the mark based on the fact that the term dyke as used in the proposed mark “may disparage or bring into contempt or disrepute to the lesbian, bisexual and transgender communities.”⁶¹ Thus, the examiner claimed that the mark was barred from registration based on section 2(a) of the Lanham Act.⁶² This refusal to register the mark is somewhat unusual in the history of section 2(a) decisions, given that the applicants are members of the group that is allegedly disparaged by the mark: lesbians who have reappropriated the mark as a symbol of pride and rebellion in connection with their motorcycle and entertainment services marketed towards fellow women.⁶³

As discussed in the introduction to this Article, in response to this rejection and the subsequent final rejection on October 28, 2004, the SFWMC provided hundreds of pages of supplemental evidence highlighting the positive, self-referential use of dyke within the lesbian

60. U.S. Trademark Application Serial No. 78/281,746, *supra* note 5.

61. U.S. Trademark Application Serial No. 78/281,746, Office Action Outgoing, *supra* note 6.

62. *See id.*

63. *See* U.S. Trademark Application Serial No. 78/281,746, *supra* note 5. The application was specifically submitted in International Class 41 for:

Education and Entertainment Services in the nature of organizing, conducting, and promoting parade contingents, community festivals, events, street fairs, forums, seminars, parties and rallies to support, organize and motivate women motorcyclists everywhere to do the same, thereby fostering pride in a wide variety of sexual orientations and identities, namely lesbian, bisexual and transgender.

Id.

community.⁶⁴ Then, the SFWMC appealed this final rejection to the TTAB on April 26, 2005 and provided even more evidence.⁶⁵ In light of this additional evidence provided on appeal, the TTAB remanded the application back to the examiner for reconsideration on November 2, 2005.⁶⁶ The examiner relented and the trademark application was finally approved for publication on January 4, 2006 and registered on October 30, 2007⁶⁷—more than four years after the initial application was submitted.

It is interesting to note that other applications for “reappropriated” lesbian slurs were reconsidered by the USPTO after the DYKES ON BIKES decision. Despite denying the initial applications for such marks, DYKES IN THE CITY was registered in August 2006, DYKE TV was registered in October 2006, and DYKEDOLLS was registered in June 2007.⁶⁸ The attorneys representing the applicants for DYKEDOLLS and DYKES IN THE CITY specifically referred to the USPTO’s approval of the DYKES ON BIKES registration and the evidence submitted in support of that application as evidence that the lesbian community does not use the term dyke in a disparaging manner.⁶⁹

As previously mentioned, the SFWMC was clearly forced to wait a long time and provide a significant amount of evidence before finally obtaining their federal trademark registration. However, providing such a large amount of evidence is not unreasonable in light of the fact that the SFWMC wanted to register a mark that was clearly disparaging in the past. Therefore, this evidence was necessary to prove to the USPTO that a substantial composite of the lesbian community had accepted the new meaning of dyke. In the end, the SFWMC was successful and obtained a registration for this reappropriated mark.⁷⁰ The SFWMC also paved the way for the registration of other dyke

64. U.S. Trademark Application Serial No. 78/281,746, Reconsideration Letter, May 25, 2005.

65. See U.S. Trademark Application Serial No. 78/281,746, Paper Correspondence Incoming, *supra* note 12; U.S. Trademark Application Serial No. 78/281,746, Applicant’s Request to Remand for Additional Evidence, Exhibit A, *supra* note 14.

66. U.S. Trademark Application Serial No. 78/281,746, Remanded to Examiner, Nov. 2, 2005.

67. See U.S. Trademark Application Serial No. 78/281,746, Registration Certificate, *supra* note 15; *McDermott v. S.F. Women’s Motorcycle Contingent*, 240 F. App’x. 865 (Fed. Cir. 2007).

68. DYKES IN THE CITY, Registration No. 3,128,444; DYKE TV, Registration No. 3,164,331; DYKE DOLLS, Registration No. 3,254,737.

69. *Id.*

70. See DYKES ON BIKES, Registration No. 3,323,803, *supra* note 15.

trademarks, which were able to register in a more efficient manner by utilizing the substantial bank of evidence submitted by the SFWMC in proving the new meaning of *Dyke*.⁷¹

B. The WASHINGTON REDSKINS

The registration history of the various trademarks associated with the Washington Redskins football team shows a much more muddled and contentious fight over disparagement. In July of 1933, George Preston Marshall changed the name of his professional football franchise from the Boston Braves to the Boston Redskins.⁷² It would later be alleged in proceedings in connection with a cancellation action brought against the team's trademarks by a group of Native Americans that Mr. Marshall changed the name of the team to honor the team's head coach, William "Lone Star" Dietz, who was a Native American.⁷³ However, it is noteworthy that at the time the football team was called the Boston Braves, the city of Boston was also home to a National League baseball team, also known as the Boston Braves, and that William Dietz's poor performance led to him being fired from the team after only a few years as head coach.⁷⁴ In 1937, the Boston Redskins franchise moved to the Washington D.C. area and became known as the Washington Redskins.⁷⁵ Despite the fact that the trademark had been in use since the 1930s, federal registration was not sought for THE REDSKINS mark (with a stylized design) until July 14, 1966.⁷⁶ This registration was followed by applications for WASHINGTON REDSKINS (without a design),⁷⁷ THE REDSKINS (with a different design from the 1966 registration),⁷⁸ and WASHINGTON REDSKINS (with a design)⁷⁹ on September 11, 1972. Additional

71. *E.g.*, DYKES IN THE CITY, Registration No. 3,128,444; DYKE TV, Registration No. 3,164,331; DYKE DOLLS, Registration No. 3,254,737.

72. BRUCE STAPLETON, REDSKINS: RACIAL SLUR OR SYMBOL OF SUCCESS? I (2001).

73. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 104 (D.D.C. 2003).

74. STAPLETON, *supra* note 72, at 1.

75. *Id.*

76. THE REDSKINS, Registration No. 836,122. The USPTO allows a trademark owner to apply for the same mark in multiple applications for different goods and services. Additionally, different applications would be required if one application only covers specific words alone and another covers the words along with a related design. For example, this registration covers the words THE REDSKINS in a stylized design for "Entertainment services—namely, football exhibitions rendered live in stadia and through the media of radio and television broadcasts." *Id.*

77. WASHINGTON REDSKINS, Registration No. 978,824 (words only).

78. THE REDSKINS, Registration No. 987,127 (words and design).

79. WASHINGTON REDSKINS Registration No. 986,668 (words and design).

applications were filed for REDSKINS⁸⁰ on November 26, 1976 and REDSKINETTES⁸¹ on October 4, 1989. The earliest of these registrations, for THE REDSKINS, was published for opposition on July 11, 1967 and approved on September 26, 1967.⁸² The final of these registrations, for REDSKINETTES, was granted on July 17, 1990.⁸³

On September 10, 1992, a group of seven Native Americans filed a cancellation action against these six REDSKINS trademark registrations, which were now owned by Pro Football, Inc.⁸⁴ The petitioners were each a member of a different federally recognized Native American tribe and alleged that the term “redskin” was disparaging to Native Americans.⁸⁵ On April 2, 1999, the TTAB canceled these six marks stating that the term “redskins” as used in Pro-Football, Inc.’s marks references Native Americans.⁸⁶ Furthermore, the TTAB noted that the petitioners clearly established that, at the time of the registration of the marks, the use of “redskins” may be seen as disparaging by a substantial composite of Native Americans.⁸⁷

In light of the TTAB’s decisive holding that “redskins” may disparage Native Americans, it is noteworthy that the TTAB never issued an Office Action in response to any of Pro-Football, Inc.’s initial applications for such trademarks that questioned whether these marks could be disparaging. Additionally, during the thirty-day window between the publication of each of the REDSKINS marks in the Official Gazette and the official registration of the marks, no third party filed an opposition against any of the marks. Despite the fact that Susan Harjo, the lead petitioner, organized protests and wrote articles condemning the marks for years, it was not until she was contacted by a trademark attorney who witnessed one such protest outside the 1992 Super Bowl in Minneapolis that she became aware of the possibility of challenging the marks on the basis of section 2(a).⁸⁸

Not surprisingly, given that the TTAB noted in its holding that the parties to this trademark dispute “have been extremely conten-

80. REDSKINS, Registration No. 1,085,092 (words only).

81. REDSKINETTES, Registration No. 1,606,810 (words only).

82. See THE REDSKINS Registration No. 836,122, *supra* note 76.

83. See REDSKINETTES, Registration No. 1,606,810 (words only), *supra* note 81.

84. Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d (BNA) 1705, 1707-09 (T.T.A.B. 1999).

85. *Id.*

86. The TTAB cited the Native American imagery present in the Washington Redskins logo as well as the use of such imagery in its marketing materials and team song as clear evidence of the team’s intent to associate its mark with Native Americans. *Id.* at 1741-43.

87. *Id.* at 1743-44.

88. STAPLETON, *supra* note 72, at 4.

tious,”⁸⁹ the decision of the TTAB was appealed by Pro Football, Inc. to the United States District Court for the District of Columbia (“*Harjo II*”).⁹⁰ On September 30, 2003, the district court overturned the TTAB’s decision on two grounds: (1) the TTAB’s finding of disparagement was not supported by substantial evidence; and (2) the consideration of the case was precluded by the doctrine of laches, an equitable defense that applies when a plaintiff’s delay in bringing a suit has unduly burdened the defendant.⁹¹

On the first ground for reversal, the court criticized the TTAB’s findings with regard to dictionary definitions of the term “redskin.”⁹² The court noted that only half of the dictionaries surveyed contained labels indicating that the term was offensive.⁹³ Additionally, without further evidence on the methodology and practices common in the industry with regard to such labels, such disparity among dictionaries could not support the TTAB’s finding that “redskin” was a patently offensive term at the time of the registration of the REDSKINS marks.⁹⁴ The court also noted the insufficiency of the petitioners’ survey evidence.⁹⁵ The survey conducted by the petitioners failed to focus on the perceptions of the term “redskins” in the 1960s and 1970s, when the first REDSKINS marks were registered, rather than the current views of the public.⁹⁶ Surveys concerning the current perceptions of the term “redskin” generally—not in connection with the football and entertainment services offered by Pro-Football, Inc.—were held to be “entirely irrelevant” and failed to justify the cancellation of Pro-Football, Inc.’s marks.⁹⁷ Furthermore, the petitioners failed to provide enough evidence to assure the court that the survey measured a representative sample of Native Americans, and thus the court held that such survey evidence could not support a finding that a substantial composite of Native Americans find the marks disparaging.⁹⁸

89. *Harjo*, 50 U.S.P.Q.2d (BNA) at 1709–10.

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

91. *Id.* at 145.

92. *Id.* at 129–30.

93. *Id.*

94. *Id.*

95. *Id.* at 132–33.

96. *Id.* at 132.

97. *Id.*

98. *Id.* at 132–33. Additionally, the court noted, based on facts supplied by Pro-Football, Inc. during a July 23, 2003 motions hearing, that there are over 2.41 million Native Americans in the United States and over 500 Native American tribes. As Native Americans are such a dispersed and segmented ethnic group, the court neglected to clarify whether a future cancellation action would need to include survey evidence from all 500 tribes in order to overcome these objections.

This trademark dispute still forged forward through the courts. The Native Americans appealed the decision in favor of Pro-Football, Inc. to the Court of Appeals for the District of Columbia Circuit.⁹⁹ On July 15, 2005, that court upheld the district court's determination that laches barred six of the Native Americans from bringing the cancellation action, but remanded the suit back to the district court to review the defense of laches against the youngest petitioner.¹⁰⁰ On June 25, 2008, the district court again held that the youngest petitioner's cancellation action was barred by laches.¹⁰¹ This holding was affirmed by the Court of Appeals for the District of Columbia Circuit.¹⁰² The Supreme Court declined to hear the case on appeal on November 16, 2009.¹⁰³ Thus, the REDSKINS trademark registrations owned by Pro-Football, Inc. remain valid for the time being.¹⁰⁴

While the process of registering DYKES ON BIKES may have been frustrating for the SFWMC, the registration of the REDSKINS marks created a much more burdensome fight for third parties who have no tangible connection to the disputed trademarks or the business they represent. In light of the refusal of the examining attorney for DYKES ON BIKES to be swayed from viewing that mark as disparaging, one might ask how the REDSKINS marks were permitted to register without such a fight in the first place. As highlighted above, there was a paucity of case law to help an examining attorney analyze whether a mark was disparaging at the time of the registration of the initial REDSKINS mark. Perhaps, the USPTO might have rejected this mark, at least initially, if an application to register the trademark was filed today; yet, it may be impossible for Native Americans to meet the evidentiary requirements necessary to have the mark canceled now. Thus, the USPTO may have permitted a disparaging mark to register

99. Pro-Football, Inc. v. Harjo, 415 F.3d 44 (D.C. Cir. 2005).

100. *Id.* The court held that the unreasonableness of a plaintiff's delay must be judged not from when any plaintiff could have brought a claim, which would have been in 1966 when the first trademark was registered, but from the time when each particular plaintiff could have brought the claim. One of the Native American plaintiffs had only reached the age of majority a few years prior to the commencement of this suit; as such, this youngest petitioner's claims were remanded so that the lower court could determine the unreasonableness of this few year delay.

101. Pro-Football, Inc. v. Harjo, 567 F. Supp. 2d 46, 62 (D.D.C. 2008).

102. Pro-Football, Inc. v. Harjo, 565 F.3d 880, 886 (D.C. Cir. 2009).

103. Harjo v. Pro-Football, Inc., 130 S. Ct. 631 (2009).

104. Another group of Native American petitioners have filed a cancellation action against these registrations. These petitioners were all near the age of majority at the time the action was brought; as such, they believe laches will not bar their cancellation action (which was on hold pending the resolution of the original REDSKINS suit). Blackhorse v. Pro-Football, Inc., Cancellation No. 92046185 (T.T.A.B. Aug. 11, 2006).

while also creating the evidentiary and laches-based burdens that will keep this error from being fixed.

C. HEEB

The contradictory treatment of the trademark HEEB also illustrates the inconsistent treatment of potentially disparaging trademarks across various examining attorneys. Heeb Media LLC obtained a federal trademark registration for HEEB for use in connection with the “publication of magazines” on June 29, 2004.¹⁰⁵ Heeb Media published a magazine under the trademarked name that was marketed to Jewish young people.¹⁰⁶ The company claimed to have chosen the name in order to transform the term “heeb” from its prior usage as a derogatory term for Jewish individuals into a term of Jewish empowerment.¹⁰⁷ As a natural expansion of the goods and services offered by Heeb Media, the company submitted a second application to register the mark HEEB on February 1, 2005 for use in connection with marketing and promotional items, such as “clothing, namely, jackets, jerseys, sweat pants, sweat shirts, track suits, t-shirts, tank tops and pants; headwear” and “entertainment, namely, conducting parties.”¹⁰⁸

Despite the fact that Heeb Media already possessed one trademark registration for HEEB, the examining attorney for this new application denied its registration on the basis that the word “heeb” “is a highly disparaging reference to Jewish people, that it retains this meaning when used in connection with applicant’s goods and services, and that a substantial composite of the referenced group finds it to be disparaging.”¹⁰⁹ As evidence of the current disparaging meaning of the term “heeb,” the examining attorney cited dictionary definitions as well as printouts of excerpts from a Nexis database, which contained reports by individuals and Jewish groups criticizing Heeb Media’s use of the disparaging term for the name of its magazine.¹¹⁰

Heeb Media submitted numerous letters from prominent members of the Jewish community and Jewish organizations supporting its

105. HEEB, Registration No. 2,858,011.

106. See *About Heeb*, HEEB MAGAZINE, <http://www.heebmagazine.com/about> (last visited Aug. 1, 2011). Heeb Media ceased production of print editions of the magazine in August 2010 but continues to produce the magazine as an online publication. Joshua Neuman, HEEB MAGAZINE, *So Much for Controlling the Media*, <http://heebmagazine.com/so-much-for-controlling-the-media/19154> (Aug. 26, 2010).

107. *In re Heeb Media LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1073 (T.T.A.B. 2008).

108. U.S. Trademark Application Serial No. 78/558,043 (filed Feb. 1, 2005).

109. *In re Heeb Media LLC*, 89 U.S.P.Q.2d (BNA) at 1072.

110. *Id.* at 1072–73.

reappropriation of the disparaging term.¹¹¹ However, the TTAB noted, “applicant’s own evidence shows that not all members of the relevant public find the term HEEB to be unobjectionable;” the letters submitted “suggest that there is a generational divide in the perception of this term.”¹¹² The TTAB held that despite Heeb Media’s good intentions the older generation of Jewish individuals who find the use of “heeb” to be disparaging constitutes a substantial composite of the referenced group.¹¹³ As such, the registration of this second HEEB trademark was denied.¹¹⁴

Because of the USPTO’s inconsistent treatment of trademarks, Heeb Media is in the awkward position of being able to enforce its federal trademark rights against a potentially infringing magazine, but may lack the rights to prevent trademark infringement in connection with its marketing materials and giveaways, such as shirts or hats. However, the rights Heeb Media has in its one registered trademark could be viewed as rights that it received too soon. In light of the TTAB’s holding in connection with the second HEEB application, it is likely that Heeb Media’s one registration was granted erroneously and should have been denied until the applicant could provide more evidence of the widespread adoption of the reappropriated meaning of “heeb” by the Jewish community.

III. Problems Inherent in Section 2(a) Treatment

The discrepancy in the treatment of the DYKES ON BIKES trademark as compared to the REDSKINS trademarks raises an obvious question: Why were the REDSKINS trademarks not initially denied on section 2(a) grounds as happened with the DYKES ON BIKES mark? The simplest explanation is that determining disparagement is an inherently subjective matter, leading examining attorneys to make apparently discrepant decisions for separate marks, such as in the case of the HEEB marks, where one was approved and a second was denied. However, the problem runs deeper: even if the examiner steadfastly applies the TTAB’s two-step analysis specified in *Hines* and *Harjo I*, a disparaging mark might still be allowed to register and may then be nearly impossible to cancel. This undesirable outcome is the result of two larger problems: (1) prohibitively difficult evidentiary burdens

111. *Id.* at 1073.

112. *Id.* at 1076.

113. *Id.* at 1077.

114. *Id.* at 1078.

faced by disparaged groups in opposition and cancellation actions; and (2) the improper application of the doctrine of laches.

In 1990, the TTAB recognized this inherent subjectivity and proposed a procedural resolution for examining attorneys:

Because the guidelines are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition proceeding can be brought and a more complete record can be established.¹¹⁵

Thus, the USPTO has developed a policy of erring on the side of publication. For this reason, the TTAB overruled itself in the case of *In re Hines* and allowed the registration of the mark BUDDA BEACHWEAR.¹¹⁶ The TTAB's decision on June 10, 1994 held that, despite the TTAB's lack of personal expertise concerning the Buddhist religion, the mark BUDDA BEACHWEAR (which included an image of Buddha wearing beach attire) undervalued and cheapened the great religious significance of Buddha to Buddhists.¹¹⁷ As such, the TTAB denied registration for this mark under section 2(a).¹¹⁸ However, the applicant filed a request for reconsideration, and, on September 23, 1994, the TTAB approved the trademark application.¹¹⁹ In doing so, the TTAB reiterated its lack of knowledge outside of personal opinions and reference materials as to how the followers of the Buddhist religion would view the mark.¹²⁰ For this reason, the TTAB allowed the mark to proceed to registration with the understanding that Buddhists could challenge the mark later if they so desired.¹²¹

The USPTO appears to be indifferent about passing on this burden to uninformed third parties and about the fact that disparaging marks may be granted federal registration based on this policy. In *In re Boulevard Entertainment, Inc.*, the court nonchalantly admitted that such errors may exist: "The fact that, whether because of administra-

115. *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990) (holding that a mark containing the word "moonies" with the "o's" replaced by an image of a buttocks did not disparage Reverend Sun Myung Moon and his Unification Church as the mark would likely be seen to refer not to Reverend Moon but rather to the act of "mooning" *viz.*, showing one's buttocks).

116. *In re Hines*, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994).

117. *In re Hines*, 31 U.S.P.Q.2d (BNA) 1685, 1691 (T.T.A.B. 1994).

118. *Id.*

119. *In re Hines*, 32 U.S.P.Q.2d (BNA) at 1376-77.

120. *Id.*

121. *Id.*

tive error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the [USPTO] must forgo applying that standard in all other cases.”¹²² This policy of allowing examining attorneys to err on the side of registration simply passes the burden of deciding whether a trademark is actually disparaging to third parties who may lack the physical numbers and societal presence to actively monitor the trademark register. Moreover, there may be cultural and socioeconomic factors that result in third parties lacking the resources to meet the higher evidentiary burdens inherent in an opposition or cancellation action. Furthermore, third parties may not understand that they have a right to challenge federally registered disparaging trademarks under the Lanham Act in the first place. Additionally, this policy leads to the erroneous registration of disparaging marks and begins the tolling of time that will be used against any future disparaged petitioners when the trademark holder claims laches in a future action. Thus, the USPTO creates a huge evidentiary and practical hurdle and then starts the race to see if a disparaged third party can surmount it in time.

A. Evidentiary Burdens

The current treatment of disparaging trademarks places an undue burden on disparaged individuals due to the increased evidentiary requirements necessary to prove disparagement after an examining attorney either approves the mark for publication or officially grants the mark federal registration. This is due, in part, to the fact that by allowing a trademark to be federally registered, the USPTO allows the trademark holder to invest time and money into building goodwill around that mark. The leading treatise on this subject observes that:

The registrant in a cancellation proceeding is entitled to the prima facie presumption that the registration and the mark are valid, that registrant is the owner and that registrant has the exclusive right to use the mark. Thus, cancellation of a valuable registration around which a valuable business good will has been built, should be

122. 334 F.3d 1336, 1339 (Fed. Cir. 2003) (cited with approval in *In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071, 1078 (T.T.A.B. 2008) where the TTAB was addressing the illogical circumstances of having one HEEB trademark registration approved and another denied as patently disparaging).

granted only with “due caution and after a most careful study of all the facts.”¹²³

Thus, a third party challenging a registered trademark under section 2(a) must provide a substantial amount of evidence to rebut this presumption of validity.

In an *ex parte* proceeding, where examining attorneys at the USPTO simply review the trademark application, they are only required to provide a minimal degree of evidence that the mark is disparaging.¹²⁴ The TTAB has explained that “[i]n evaluating the examining attorney’s evidence we must be cognizant of the USPTO’s limitations in amassing evidence and ‘we look only for . . . more than a scintilla of evidence, in support of the [USPTO]’s prima facie case.’”¹²⁵ The USPTO specifically directs examining attorneys to look to “dictionary definitions, newspaper articles, and magazine articles.”¹²⁶

In response to a refusal by an examining attorney who alleges that the mark is disparaging, applicants may persuade the examining attorney to look past such evidence to see that the proposed use of the trademark is not disparaging. In doing so, applicants may use alternative dictionaries or statements from linguistic experts,¹²⁷ affidavits from members of the disparaged group,¹²⁸ survey results,¹²⁹ and even historical accounts.¹³⁰ No specific degree or amount of such evidence is required so long as the examining attorney is persuaded to publish the mark for opposition.¹³¹ This process can be seen in the case of the DYKES ON BIKES trademark. In that instance, the examining attor-

123. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 123 (D.D.C. 2003) (citing 3 MC-CARTHY, *supra* note 17, § 20:64) (quoting *Rockwood Chocolate Co. v. Hoffman Candy Co.*, 372 F.2d 552 (C.C.P.A. 1967)).

124. See TMEP, *supra* note 28, § 1203.01 (where examining attorneys are advised that they can feel sufficiently justified in their refusal to register a trademark on the grounds that it is scandalous if they uncover dictionaries that identify the trademark as a scandalous term).

125. *In re Heeb Media LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1077 (T.T.A.B. 2008) (quoting *In re Pacer Technology*, 338 F.3d 1348, 1352 (Fed. Cir. 2003)).

126. TMEP, *supra* note 28, § 1203.01.

127. See, e.g., *Pro-Football, Inc.*, 284 F. Supp. 2d 96; see also U.S. Trademark Application Serial No. 78/281,746, Paper Correspondence Incoming, *supra* note 8.

128. See, e.g., U.S. Trademark Application Serial No. 78/281,746, Paper Correspondence Incoming, *supra* note 8.

129. See, e.g., *Pro-Football, Inc.*, 284 F. Supp. 2d at 139.

130. *Id.*

131. See, e.g., U.S. Trademark Application Serial No. 78/281,746, Paper Correspondence, Dec. 6, 2005 (where the examining attorney for the DYKES ON BIKES application states that she was persuaded to allow the trademark to proceed to publication after reviewing new information provided by the applicant).

ney may have been especially hard to persuade,¹³² but the applicant was able to provide sufficient personal, expert, and supplemental evidence to prove that the meaning of the term dyke had changed amongst the lesbian community at large.¹³³ In the case of the HEEB trademark, the applicant (for the second trademark) was not able to provide sufficient evidence that the term “heeb” had been reappropriated fully by the Jewish community.¹³⁴ Perhaps, the applicant could reapply in a few years and the reappropriated meaning would be more widespread.

However, in an *inter partes* proceeding where a third party is opposing or petitioning to cancel an allegedly disparaging trademark, the third party needs to provide “substantial evidence” that a substantial composite of the relevant group finds the mark’s use disparaging.¹³⁵ In the case of the REDSKINS marks, the Native American petitioners provided numerous expert statements as well as personal statements and expensive and time-consuming survey results. Yet none of this was substantial enough to justify cancellation of the REDSKINS marks in the eyes of the United States District Court for the District of Columbia. As the Native American petitioners were supported by sophisticated pro bono counsel with substantial resources available to assist them in obtaining this expert and survey evidence, it begs the question of how a third party challenger without such resources could ever be expected to meet this evidentiary burden. In passing off the burden of deciding whether a mark is disparaging, the USPTO may be allowing the registration of trademarks that, despite being disparaging in violation of section 2(a), no third party will ever be able to successfully cancel.¹³⁶

B. Laches as a Burden on Third Parties

Adding to the burden imposed on third parties seeking to cancel a trademark is the presumption of validity that courts afford to regis-

132. See Raab, *supra* note 7.

133. U.S. Trademark Application Serial No. 78/281,746, Paper Correspondence, *supra* note 131.

134. *In re Heeb Media LLC*, 89 U.S.P.Q.2d (BNA) 1071, 1077 (T.T.A.B. 2008).

135. *Pro-Football, Inc.*, 284 F. Supp. 2d at 144.

136. See, e.g., Joshua R. Ernst & Daniel C. Lumm, *Does Budda Beachwear Actually Fit? An Analysis of Federal Registration for Allegedly Disparaging Trademarks in the Non-Corporate Context*, 10 WAKE FOREST INTELL. PROP. L.J. 177, 183–84, 200–01 (2010) (“Given the higher evidentiary burden for cancelling a registered mark as opposed to refusing to register a mark, a mark which was registered numerous years ago could survive a cancellation proceeding, but if the same mark or a derivative of that mark were to be applied for today, it could easily be refused registration.”).

tered marks. After a trademark has been listed on the Principal Register for five years, such registration constitutes prima facie evidence of the validity of the trademark.¹³⁷ After this time, the mark can only be challenged for a limited set of specified circumstances. The Lanham Act expressly includes section 2(a) challenges based on claims that the mark “may disparage” a person or group as a grounds for cancelling a trademark registration after this five-year deadline.¹³⁸ However, the District Court for the District of Columbia held in *Harjo II* that such a cancellation action based on section 2(a) could still be barred by the passage of time.¹³⁹ In *Pro-Football, Inc.*’s appeal of the TTAB’s cancellation of its REDSKINS marks, the district court held that the defense of laches precludes the cancellation of such marks because the substantial delay by the petitioners in bringing their cancellation action¹⁴⁰ caused unfair economic prejudice to *Pro-Football, Inc.*¹⁴¹

1. Laches Background

While the defense of laches led to the dismissal of this modern REDSKINS trademark dispute, the defense is certainly not a modern development. Laches is an equitable defense that developed out of the courts of equity in England in the thirteenth and fourteenth centuries.¹⁴² Equity courts applied the defense of laches where a court of law may have applied a statute of limitations to bar a plaintiff’s claim.¹⁴³ However, unlike a statute of limitations which sets a precise time limit on when a cause of action may be brought before a court, the applicability of laches is determined based on the balancing of various equitable factors.¹⁴⁴ In evaluating these equitable factors, the court must assess whether the plaintiff’s delay in bringing suit was excusable and whether it caused undue hardship on the defendant in defending against such suit.¹⁴⁵ The defense of laches is based on the underlying principle that “equity aids the vigilant and not those who

137. See GINSBURG, LITMAN & KEVLIN, *supra* note 21, at 221.

138. 15 U.S.C. § 1064(3) (2006).

139. *Pro-Football, Inc.*, 284 F. Supp. 2d at 136.

140. The district court focused on the fact that the petitioners brought the cancellation action in 1992—twenty-five years after the team’s first “REDSKINS” registration was obtained in 1967. *Id.* at 137.

141. *Id.* at 144.

142. See Kathryn E. Fort, *The New Laches: Creating Title Where None Existed*, 16 GEO. MASON L. REV. 357, 364–70 (arguing that the courts have misapplied the long-standing rules regarding laches in the context of Native American land disputes).

143. *Id.* at 365–66.

144. *Id.*

145. *Id.* at 365.

slumber on their rights.”¹⁴⁶ The laches defense is thought to encourage plaintiffs to be vigilant about protecting their rights while promoting judicial efficiency by requiring that suits be brought when evidence is still available and when courts are in the best possible position to resolve the underlying disputes.¹⁴⁷

As U.S. courts possess both equitable and legal powers,¹⁴⁸ laches still exists as an affirmative defense in the modern legal system. In *Costello v. United States* the Supreme Court held that “[l]aches requires proof of (1) lack of diligence by the party against whom the defense is asserted, and (2) prejudice to the party asserting the defense.”¹⁴⁹ In the context of trademark disputes, laches has most often been successfully asserted against a claim of trademark infringement where a plaintiff knowingly delayed in contesting the defendant’s infringing trademark, thus unfairly permitting the defendant to invest significant time and resources into its trademark.¹⁵⁰ In such trademark disputes, courts have required a defendant asserting laches to meet “three affirmative requirements: (1) a substantial delay by a plaintiff prior to filing suit; (2) a plaintiff’s awareness that the disputed trademark was being infringed; and (3) a reliance interest resulting from the defendant’s continued development of good-will during this period of delay.”¹⁵¹ The court in *Harjo II* applied this three-part test, reasoning that this common law test could easily be modified to require Pro-Football, Inc. to show that “(1) the Native Americans delayed substantially before commencing their challenge to the ‘redskins’ trademarks; (2) the Native Americans were aware of the trademarks during

146. *NAACP v. NAACP Legal Def. & Educ. Fund, Inc.*, 753 F.2d 131, 137 (D.C. Cir. 1985).

147. *Id.*

148. Fed. R. Civ. P. 2. This section of the Federal Rules of Civil Procedure dismisses the prior distinction between actions at law and suits in equity; instead, all such actions shall be viewed as simply a civil action.

149. *Costello v. United States*, 365 U.S. 265, 282 (1961).

150. *See, e.g., E-Systems, Inc. v. Monitek, Inc.*, 720 F.2d 604, 607 (9th Cir. 1983) (emphasizing in this trademark infringement dispute “[b]ecause plaintiff and defendant advertised in the same magazines and exhibited at the same trade fairs, plaintiff had ample opportunity to discover defendant’s activities before defendant developed a substantial business”); *Tillamook Country Smoker, Inc. v. Tillamook Cnty. Creamery Ass’n*, 465 F.3d 1102, 1109 (9th Cir. 2006) (“Even though Creamery and Smoker may not have operated in the identical commercial channels at the time, the two companies were using similar marks on complementary products in the same geographical area, creating the prospect of confusion. Creamery had actual notice of Smoker’s allegedly infringing mark soon after Smoker’s inception, thereby starting the laches period.”).

151. *NAACP*, 753 F.2d at 137.

the period of delay;¹⁵² and (3) Pro-Football's ongoing development of goodwill during the period of delay engendered a reliance interest in the preservation of the trademarks."¹⁵³ In modifying this test, the district court reasoned that this three-part approach was consistent with the traditional two-part test in that the first two elements, substantial delay and notice, are necessary factors in evaluating whether there was a lack of diligence or an unreasonable delay by the petitioning party.¹⁵⁴ Also, the court reasoned that the third element is tied to the prejudice felt by the defendant.¹⁵⁵ Using this interpretation of the requirements for laches, the district court in *Harjo II* held that laches barred the cancellation of the REDSKINS trademarks and that Pro-Football, Inc. was entitled to summary judgment as a matter of law.¹⁵⁶

Aside from factual arguments as to whether the laches test, as applied, was appropriate and whether Pro-Football, Inc. met its evidentiary burden in proving the elements of laches, the application of laches to cancellation actions is further evidence of the procedural inequities inherent in the current handling of section 2(a) actions. Typical cases involving a claim of laches involve two parties that were both present for the dispute that gave rise to the cause of action. Thus, both parties are aware of the time running against them in terms of a statute of limitations or the defense of laches. Here, an unaffiliated third party that brings a cancellation action is illogically treated as if in the same position as the trademark applicant or the USPTO. This is especially unreasonable as laches should not be applicable to section 2(a) cancellation actions at all for two primary reasons: (1) the plain language of the Lanham Act makes it clear that

152. Though outside the scope of this Article, an argument could be made that a better modification of this "knowledge of infringement" requirement would be to ask whether the Native Americans were aware of their ability to challenge the REDSKINS marks. The requirement that the plaintiff be aware that the trademark was being infringed presumes that the plaintiff understands the basic legal concept that trademarks can be infringed. The court here neglected to recognize this difference between the general community understanding of trademarks as property rights that can be violated and an understanding of the intricacies of federal trademark prosecution that could allow a trademark to be canceled for being disparaging. This is especially relevant as the REDSKINS marks were used under common law from the 1930s without federal registration—and thus a third party would have no means to cancel the disparaging common law mark—until the first federal trademark registration was obtained in 1967.

153. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 136 (D.D.C. 2003) (agreeing with the TTAB's statement of the applicable law in *Pro-Football, Inc. v. Harjo*, 57 U.S.P.Q.2d (BNA) 1140, 1144 (D.D.C. 2000)).

154. *Id.* at 139.

155. *Id.*

156. *Id.* at 139–40, 145.

Congress intended to allow actions to cancel disparaging trademark registrations to be brought at any time; and (2) applying laches to prevent the cancellation of disparaging trademark registrations is contrary to the best interests of the public. Thus, allowing the application of laches to section 2(a) actions creates yet another hurdle that could prevent a third party from cancelling a disparaging trademark that was improperly permitted to register in the first place.

2. Plain Meaning Prevents Application of Laches to Section 2(a) Proceedings

The language of the Lanham Act itself, as well as the intent behind enacting section 2(a), prevents the application of laches from barring the cancellation of a mark that may be disparaging.¹⁵⁷ Section 14 of the Lanham Act provides that a mark may be canceled “at any time” if it were obtained contrary to section 2(a).¹⁵⁸ Specifically, section 14 states that a petition to cancel a trademark registration may be filed:

- (1) Within five years from the date of the registration of the mark under this chapter.
- (2) Within five years from the date of publication under section 1062(c) of this title of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.
- (3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 1054 of this title or of subsection (a), (b), or (c) of section 1052 of this title for a registration under this chapter¹⁵⁹

When viewed in light of the five-year limit on cancellation actions generally, the plain meaning of the phrase “at any time” clearly indicates that the situations contemplated by section 14(3), including cancellation actions brought against registrations issued contrary to section 2(a), are not to be time-limited.¹⁶⁰ Thus, such cancellation ac-

157. See 15 U.S.C. § 1064(3) (2006); see also *Marshak v. Treadwell*, 240 F.3d 184, 192–93 (3d Cir. 2001).

158. 15 U.S.C. § 1064(3).

159. *Id.* § 1064(1)–(3).

160. It is a generally accepted principle that statutory interpretation should begin with an analysis of the plain meaning of the relevant statutory language. See, e.g., *Robinson v. Shell Oil Co.*, 519 U.S. 337, 341 (1997) (“The plainness or ambiguity of statutory language is determined by reference to the language itself, the specific context in which that language is used, and the broader context of the statute as a whole.”); *United States v. Mo. Pac. R.R. Co.*, 278 U.S. 269, 278 (1929) (“But where the language of an enactment is clear, and construction according to its terms does not lead to absurd or impracticable conse-

tions are exempt from time-based defenses such as statutes of limitations or laches. This view was supported by the Third Circuit in *Marshak v. Treadwell* where the court concluded that “the meaning of the phrase ‘at any time’ in Section 14(3) is clear even if that particular subsection is viewed in isolation.”¹⁶¹ In *Marshak* the court held that a defendant’s claim that a trademark registration was “obtained fraudulently” could not be time-barred (whether by a statute of limitations or collateral estoppel) due to the express language of section 14(3) that such actions may be brought “at any time.”¹⁶²

The district court in *Harjo II* rejected this assertion that the plain meaning of “at any time” precludes the application of laches to actions brought under section 2(a).¹⁶³ In coming to this decision, the court pointed to 15 U.S.C. § 1069,¹⁶⁴ which states: “In all inter partes proceedings equitable principles of laches, estoppel, and acquiescence, where applicable, may be considered and applied.”¹⁶⁵ The court concluded that this provision of the Lanham Act specifically allows for the application of laches in all instances and that interpreting the “at any time” language of section 14(3) to bar laches would render this express application of equitable principles meaningless.¹⁶⁶ Unfortunately the court failed to recognize the most logical interaction between these two provisions. The court should have recognized that 15 U.S.C. § 1069 permits the application of equitable principles like laches only “where applicable.”¹⁶⁷ Because section 14(3) allows specific types of cancellation actions to be brought at “any time,” such cancellation actions would logically constitute instances where laches would not be applicable. This does not render 15 U.S.C. § 1069 meaningless since numerous other types of cancellation actions can be brought under section 14, such as those brought on the grounds of confusion, mistake, descriptiveness, functionality, or dilution.¹⁶⁸

quences, the words employed are to be taken as the final expression of the meaning intended.”).

161. *Marshak*, 240 F.3d at 192–93; *see also* *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 195 (1985) (stating that a registration “may be canceled at any time” if obtained contrary to the provisions of section 2); *Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d (BNA) 1289, 1294 (T.T.A.B. 1999) (stating that the cancellation of registrations that are void ab initio should not be precluded by equitable defenses).

162. *Marshak*, 240 F.3d at 192–93.

163. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 136 (D.D.C. 2003).

164. *Id.*

165. 15 U.S.C. § 1069 (2006).

166. *Pro-Football, Inc.*, 284 F. Supp. 2d at 136.

167. 15 U.S.C. § 1069.

168. *See id.* § 1064; *see also id.* §§ 1052(d)–(e), 1125(c).

These actions, which are not expressly permitted to be brought “at any time,” would still be susceptible to equitable defenses such as laches. In light of the interaction between the exceptions in each of these statutory provisions, the district court’s application of laches to the section 2(a) cancellation action in *Harjo II* clearly violated the express language of the Lanham Act with respect to disparaging trademarks. In plain language, laches simply does not apply to the cancellation of disparaging trademarks.

3. Laches May Not Be Applied Contrary to the Public Interest

Additionally, laches should not be used to bar cancellation actions brought under section 2(a) where such suits are clearly in the public interest. As the Third Circuit in *Marshak* noted, the kinds of claims expressly permitted to be brought “at any time,” such as those claiming disparagement under section 2(a), are unique in that they involve marks that devalue the “integrity of the register.”¹⁶⁹ As laches is an equitable defense, courts have long held that laches will not apply to block a claim brought in the public’s interest.¹⁷⁰ Furthermore, the interest of the public must be the most important consideration when balancing the equities underlying a laches allegation.¹⁷¹ The United States Court of Appeals for the Federal Circuit clarified how the public interest should be considered in light of the standard two-part test for the applicability of laches when it explained: “Laches is not *established* by undue delay and prejudice. Those factors merely lay the foundation for the trial court’s exercise of discretion. Where there is evidence of other factors which would make it inequitable to recognize the defense despite undue delay and prejudice, the defense may be denied.”¹⁷²

169. *Marshak v. Treadwell*, 240 F.3d 184, 194 (3d Cir. 2001).

170. See *Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 840 (9th Cir. 2002) (“Because laches is an equitable remedy, laches will not apply if the public has a strong interest in having the suit proceed.”); *TBC Corp. v. Grand Prix Ltd.*, 12 U.S.P.Q.2d (BNA) 1311, 1313 (T.T.A.B. 1989) (“Where the proposed ground for cancellation is abandonment, equitable defenses should be unavailable for the same reason they have been held unavailable when the ground asserted is descriptiveness or fraud. It is in the public interest to remove abandoned registrations from the register.”).

171. See *Jarrow Formulas, Inc.*, 304 F.3d at 840 (“The public’s interest is of overriding importance, and as such, should be considered apart from any presumption of laches.”); *Conopco, Inc. v. Campbell Soup Co.*, 95 F.3d 187, 193 (2d Cir. 1996) (“[T]he public good is of paramount importance when considering the equitable defense of laches.”).

172. *A.C. Aukerman Co. v. R.L. Chaides Contr. Co.*, 960 F.2d 1020, 1036 (Fed. Cir. 1992).

In light of this public interest component of a laches analysis, it is logical that laches should not apply to many, if not all, cancellation actions brought under section 2(a). Such cancellation actions do not award a victorious petitioner any monetary damages or any other personal compensation for the time and energy invested in such action.¹⁷³ Instead, the result of a successful cancellation action is that a disparaging trademark registration is canceled¹⁷⁴ so that such disparagement is no longer federally sanctioned. The federal trademark register would then be closer to the fair and equitable library of trademarks likely envisioned by Congress when section 2(a) was enacted.

Additionally, because cancellation actions under section 2(a) serve a public interest, “there is less likely to be a private party constantly reviewing the Registry and promptly filing a petition than in other trademark cases.”¹⁷⁵ Thus, it is sensible that Congress carved such actions out of the five-year limit and permitted them to be brought “at any time.” The opposite seems counter-intuitive because the USPTO has demonstrated that it is more likely to permit a potentially disparaging trademark to register if, as in the case of BUDDA BEACHWEAR, such mark references a minority population within the United States about which the examining attorney and TTAB possess little direct knowledge.¹⁷⁶ Once the mark is allowed to register, it would be up to that same small and likely historically disadvantaged population to learn about the mark’s registration in a timely manner and to understand the legal avenue available to cancel the registration. This is asking a lot of such third parties.

The court in *Harjo II* agreed that the public interest should be considered when applying laches; however, the court felt that the public interest vindicated in a section 2(a) action is less important than in

173. For this reason, cancellation actions under section 2(a) are more like a citizen suit brought by a private individual on behalf of the government rather than an action between two private citizens. As such, it could be argued that such third party petitioners should be treated as if they stand in place of the government and would thus be immune from the defense of laches. *See, e.g.*, *United States v. Beebe*, 127 U.S. 338, 344 (1888) (“The principle that the United States are not bound by any statute of limitations, nor barred by any laches of their officers, however gross, in a suit brought by them as a sovereign Government to enforce a public right, or to assert a public interest, is established past all controversy or doubt.”).

174. 15 U.S.C. § 1064 (2006).

175. *Harjo v. Pro-Football, Inc.*, 130 S. Ct. 631 (2009), *petition for cert. filed*, 2009 WL 2953014, *18 (U.S. Sept. 14, 2009) (No. 09-326).

176. *In re Hines*, 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994).

other commercial trademark disputes.¹⁷⁷ The court explained that “the public interest is somewhat more narrowly defined in [the context of section 2(a) cancellation actions] because it applies to a more narrow segment of the general population”¹⁷⁸ This reasoning, while technically accurate in terms of the small Native American population in the United States, is misguided. Preventing the disparagement of—and possibly the commercial discrimination and racism against—even a small segment of the U.S. population is a much loftier public interest than preventing consumer confusion over commonplace commercial goods.¹⁷⁹ Congress clearly believed that preventing the registration of disparaging trademarks was in the public interest when section 2(a) was enacted. As such, the interest of the public should be given substantial weight before applying laches to bar any cancellation action brought on section 2(a) grounds.

IV. Recommendations

In light of the unfairly high burdens placed on third parties seeking to cancel a disparaging trademark—in terms of both evidentiary hurdles and the misplaced application of laches by the courts—changes should be made to ensure that fewer disparaging trademarks receive registration. The burden should be shifted away from the disparaged third party and back onto the trademark applicant. After all, it is the trademark applicant who directly benefits from the federal registration and who is in the best position to fully inform the USPTO of its reasons for selection of and intended use of the trademark in question. This Article recommends the adoption of two primary procedural changes that would increase the evidentiary burden on the trademark applicant, but which could lessen the likelihood that a third party cancellation action would need to be brought by a disparaged party. First, the USPTO must hold applicants to the evidentiary burden of proof when an examining attorney has established a *prima facie* case for disparagement. The USPTO needs only require the applicant to prove their case rather than “erring on the side of publication” and subsequently passing the disparagement dispute on to third

177. *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 138 (D.D.C. 2003).

178. *Id.*

179. *See, e.g., Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 840 (9th Cir. 2002) (holding that the public interest in preventing consumer confusion concerning probiotic supplements did not prevent the application of laches to bar a false advertising claim); *Conopco, Inc. v. Campbell Soup Co.*, 95 F.3d 187, 193 (2d Cir. 1996) (holding that the public interest in preventing consumer confusion concerning the thickness of pasta sauces did not prevent the application of laches to bar a false advertising claim).

parties. Second, the Lanham Act should be amended to require a trademark applicant to affirmatively disclose whether its proposed trademark could be seen as disparaging. For marks like SEARS or GOOGLE, which are clearly not disparaging, this would not require much additional effort. However, for those applicants seeking to register a mark that makes reference to a person, group, or entity, or for applicants seeking to register a reappropriated mark, the proposed statutory change would: (1) highlight the potential for disparagement to the examining attorney so that the attorney's own personal knowledge of such disparaging terms becomes less important; and (2) permit the applicant to speed up registration by providing evidence in favor of the proposed trademark early on in the process.

A. Burden of Proof Should Be on the Applicant Rather Than a Third Party

As mentioned above, the simplest change that can be made to correct the current inconsistencies in the handling and treatment of disparaging trademarks is to do away with the current policy of resolving doubts on the issue of disparagement in favor of applicants. When an examining attorney refuses registration of a mark on the grounds of disparagement, the USPTO's own standards state that the burden is rightly shifted to the applicant to rebut that determination.¹⁸⁰ When an examining attorney, the TTAB, or a court harbors doubts after an applicant has provided evidence of their non-disparaging use of the applied for mark, the reasonable conclusion is that an applicant simply has not met its burden of proof. Erring on the side of publishing the mark for registration creates a disincentive whereby applicants need not invest their full time and energy into proving that their mark is not disparaging in the first place. Once this potentially disparaging trademark is published and eventually registered, the failure of the USPTO, TTAB, or court to hold the applicant responsible for meeting this burden of proof becomes a nearly insurmountable hurdle imposed on a third party seeking to cancel the mark at a later date.

Requiring the trademark applicant to extinguish all doubts as to whether a trademark is disparaging is still consistent with most of the USPTO's section 2(a) decisions. For example, in denying the second trademark application for HEEB, the TTAB determined that the applicant could not show that the term "heeb" had been reappropriated completely by the Jewish community: the applicant even admitted that

180. TMEP, *supra* note 28, § 1203.03(c).

the older generation of Jewish individuals still found the term disparaging.¹⁸¹ Thus, the applicant could not meet its burden of proving that the mark was not disparaging to a substantial composite of Jewish individuals. On the other hand, the applicant for DYKES ON BIKES was eventually able to meet this evidentiary burden by showing that dyke was no longer considered disparaging in the lesbian community.¹⁸² Requiring that an applicant meet its burden of proof when an examining attorney has made a prima facie case to the contrary is not unduly burdensome and does not require anything other than that the USPTO enforce the standards it has already set forth rather than simply passing on the final decision of disparagement to third parties.

B. Affirmative Duty to Disclose

This Article asserts that a more drastic change may be necessary: The creation of an affirmative duty on trademark applicants to disclose facts relevant to determine whether a new trademark application includes any words, phrases, or imagery that may disparage any persons, institutions, beliefs, or national symbols. Adding this affirmative duty would require amendment of the Lanham Act to shift the initial burden of recognizing potential disparagement from the USPTO and individual examining attorneys to trademark applicants. Two possible types of disclosure could be required: (1) a simple oath that, to the applicant's knowledge, the trademark is not disparaging; or (2) a more burdensome requirement that a trademark applicant conduct a pre-application investigation into whether the mark is disparaging and disclose any relevant facts pertaining thereto.

Section 1 of the Lanham Act already requires an applicant for registration of a trademark to execute an oath affirming that the applicant is the owner of the mark applied for and that "to the best of verifier's knowledge and belief, no other person has the right to use such mark."¹⁸³ This section, or section 2, could easily be amended to require that the applicant also submit an oath that "to the best of verifier's knowledge and belief" the trademark applied for, whether in whole or in part, could not be seen as disparaging to any persons, institutions, beliefs, or national symbols. The addition of this oath would allow a third party to allege that the trademark registration was obtained fraudulently in a future action to cancel this registration under section 2(a).

181. *In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071, 1076 (T.T.A.B. 2008).

182. *See* DYKES ON BIKES, Registration No. 3,323,803, *supra* note 15.

183. 15 U.S.C. § 1051(a)(3)(A), (D) (2006).

However, proving fraud in the USPTO would require that the third party prove that the applicant lied about their “knowledge or belief.”¹⁸⁴ With such a high burden of proof, one might ask what purpose this change could possibly serve. Clearly, this would be another evidentiary hurdle to a petitioner trying to cancel the registration under section 2(a) as the petitioner would still need to prove that the mark is disparaging to a substantial composite of the referenced group and would also need to prove that the applicant lied in stating that it lacked knowledge of such disparagement. The sole benefit of this oath by a section 2(a) petitioner is that fraud, if proven, would bar the applicant from claiming the defense of laches.

It is well settled that “[a] party with unclean hands may not assert laches.”¹⁸⁵ A defendant asserting laches must have clean hands and thus must have “acted fairly and without fraud or deceit as to the controversy in issue.”¹⁸⁶ Otherwise, such behavior “closes the doors of a court of equity to one tainted with inequity or bad faith relative to the matter in which he seeks relief.”¹⁸⁷ Thus, fraudulently claiming to lack knowledge that the trademark applied for could be seen as disparaging would preclude the defense of laches that plagued the Native Americans in the REDSKINS dispute. That case is a prime example of how this oath could be beneficial to third party petitioners since there is evidence that Native Americans met with and contacted the owner of the Boston Redskins (now the Washington Redskins) to protest the disparaging nature of the team’s name after he changed

184. See, e.g., *In re Bose Corp.*, 580 F.3d 1240, 1245 (Fed. Cir. 2009) (“Thus, we hold that a trademark is obtained fraudulently under the Lanham Act only if the applicant or registrant knowingly makes a false, material representation with the intent to deceive the PTO.”); see also Susan M. Richey, *The Second Kind of Sin: Making the Case for a Duty to Disclose Facts Related to Genericism and Functionality in the Trademark Office*, 67 WASH. & LEE L. REV. 137 (2010) (advocating for an affirmative disclosure requirement in connection with the USPTO’s prohibition on the registration of generic trademarks and functional trade dress).

185. *Jarrow Formulas, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 841 (9th Cir. 2002) (explaining that unclean hands did not bar the defense of laches in a false advertising dispute because plaintiff failed to show that defendant acted with a fraudulent intent in making the false advertising claims).

186. *Alder v. Fed. Republic of Nigeria*, 219 F.3d 869, 877 (9th Cir. 2000) (internal quotation marks omitted) (quoting *Ellenburg v. Brockway, Inc.*, 763 F.2d 1091, 1097 (9th Cir. 1985)) (holding that the relief requested by the plaintiffs was barred due to their unclean hands because the plaintiffs intentionally attempted to aid and abet the defendants’ scheme to steal from the government treasury).

187. *Precision Instrument Mfg. Co. v. Auto. Maint. Mach. Co.*, 324 U.S. 806, 814 (1945) (dismissing plaintiff’s suit for patent infringement and breach of contract because of plaintiff’s unclean hands resulting from its knowledge of perjury and failure to act so as correct such perjury).

the name of the team from the Boston Braves.¹⁸⁸ Such meetings occurred prior to the submission of many of the REDSKINS trademark applications to the USPTO, so it certainly would be possible to show that the owner of those trademarks had knowledge of their potential for disparagement.

However, this Article urges that a more drastic imposition on trademark applicants would better resolve the problems that surround section 2(a). Requiring applicants to conduct a pre-application investigation into whether the mark applied for could be seen as disparaging and to disclose any relevant facts pertaining thereto would create a more efficient and predictable system. As it currently stands, an applicant's silence and an examining attorney's lack of knowledge as to a particular group's beliefs could lead to the registration of a potentially disparaging trademark.¹⁸⁹ Then, this disparaging trademark could only be canceled by a third party if that third party had knowledge of this possibility for cancellation under section 2(a), the resources to provide "substantial evidence" of disparagement, and the time and energy to promptly devote to this cancellation action in spite of the court's automatic initial presumption that the trademark registration is valid.

Under this proposed change, the burden would be shifted to the applicant to either state that a trademark is clearly not disparaging (and has never been so) or to provide information to the USPTO concerning possible disparaging uses along with evidence to explain how the applicant's proposed use is not disparaging in spite of such information. Unlike the oath proposed above, the test for compliance with this requirement would not need to evaluate whether the applicant intended to defraud or deceive the USPTO. Rather, the TTAB or court would be asked to determine if the applicant undertook a reasonable investigation. This determination would look at whether the applicant uncovered what a reasonable applicant in a similar position could have been expected to discover and report. The USPTO could clarify this reasonable expectation further by explaining that appli-

188. STAPLETON, *supra* note 72, at 2. After a 1972 meeting between Harold Gross, director of the Indian Legal Information Development Service, and Edward Bennett Williams, then-owner of the Washington Redskins, Williams refused to change the team's name, but agreed to change some of the more offensive elements of the team's song, *Hail to the Redskins*.

189. See, e.g., *In re Hines*, 32 U.S.P.Q.2d (BNA) 1376 (T.T.A.B. 1994) (where the TTAB allowed the registration of BUDDHA BEACHWEAR because it claimed that it lacked sufficient knowledge of Buddhist beliefs to determine whether the mark would be disparaging).

cants would be expected to look to the same sorts of basic sources that an examining attorney must consult: “dictionary definitions, newspaper articles and magazine articles.”¹⁹⁰ If an applicant failed to comply with this duty of disclosure, the result would be a rejection of the trademark application. Additionally, if a third party could show in a cancellation action that the applicant failed to meet this reasonable investigation requirement, the registration would be subject to cancellation. However, in both instances the applicant would still possess any common law rights that might exist in that trademark.

This is not an unreasonable burden on applicants given that dictionaries, newspapers, and magazines are easily accessible resources, and the disclosure of which would provide a modicum of background information to the examining attorney while forcing applicants to think more closely about the mark they are choosing to represent their business. Realistically, this inquiry by a business owner into possible perceptions in the marketplace of a proposed mark is in the best interest of any applicant. Any burden on applicants caused by the investigation costs, and possibly for the cost to retain counsel, are outweighed by the benefits that would be felt by the USPTO and by third parties. The shifting of this initial burden to applicants promotes a more efficient and possibly faster review of trademark applications by the USPTO. Requiring this investigation might deter some applicants from submitting clearly disparaging applications, or from submitting applications that they realize are disparaging only after some initial research. The typical disparaging trademark timeline consists of an application that is denied maybe six months after being filed and is then promptly abandoned by the applicant. Thus, pre-application research could encourage applicants not to hastily file such controversial applications that they would not be willing to defend as non-disparaging in the future. Additionally, trademark examiners would no longer be forced to perform this initial research, but could instead review the information submitted by the applicant initially.

Though it is impossible to know for sure what would have happened if the proposed duty to disclose had been in place at the time of the submission of the DYKES ON BIKES trademark application, it is reasonable to assume that such prior disclosure could have sped up the trademark application process by skipping the initial seven month wait for the examining attorney to come back with dictionary evidence of the disparaging use of the term “dykes,” followed by six months in

190. TMEP, *supra* note 28, § 1203.01.

which the applicants were permitted to collect evidence to refute this determination. If this change were implemented, the applicant for a reappropriated trademark could come armed with its evidence of reappropriation and non-disparaging use from the outset of the application.

In the case of the REDSKINS marks, the initial preapplication research may have highlighted for Pro-Football, Inc. the potentially disparaging nature of the trademarks prior to the filing of its trademark applications. Additionally, if Pro-Football, Inc. failed to disclose the potential for disparagement to the USPTO at the time of filing those applications, Native American petitioners may have been able to seek to cancel the REDSKINS registrations by simply proving that Pro-Football, Inc. failed to comply with its duty to conduct a reasonable, preapplication investigation (especially in light of the fact that the petitioners in the Harjo dispute were able to show that several dictionaries listed the term “redskin” as disparaging).

Similarly, the applicant for the first HEEB trademark would have had the duty to disclose to the USPTO the disparaging historical use of the term “heeb.” This would have brought the question of disparagement and reappropriation before the USPTO at the time of the first application rather than the second. This may have resulted in the denial of the registration of the first HEEB trademark, thereby preventing the unusual position now faced by Heeb Media.

Conclusion

As long as section 2(a) exists as a prohibition on the registration of disparaging trademarks, the procedures and policies employed by the USPTO should work together to enforce that prohibition fully. Most scholars addressing section 2(a) concerns have analyzed this prohibition on federal trademark registration through a constitutional lens. Thus, suggestions for improvement tend to favor unrestricted speech and lessening the barriers to registration faced by applicants.¹⁹¹ However, until section 2(a) is rendered unconstitutional,¹⁹² the real focus of concern should be on making the trademark registra-

191. See, e.g., Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388 (2006) (where Anten eloquently argues for a policy of pure deference in favor of registration of reappropriated self-disparaging trademarks).

192. The court in *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) is often quoted for its view that section 2(a) does not violate the First Amendment: “[I]t is clear that the PTO’s refusal to register appellant’s mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First

tion process as fair and predictable as possible. Currently, the USPTO's policy of permitting the registration of marks where the USPTO, TTAB, or the court remains unclear about whether a referenced group would find the mark disparaging is disingenuous. A third party should not be forced to prove disparagement when a trademark applicant should have been held to that task in the first place.

The lackadaisical treatment of potentially disparaging trademarks by the USPTO and the court system unreasonably hands off responsibility for making a disparagement determination from the USPTO and the individual applicant to an unrelated, disparaged third party. In light of the huge evidentiary and practical hurdles faced by third parties seeking to cancel disparaging trademarks, this abdication of responsibility constitutes more than just a delay in undertaking this disparagement analysis. The USPTO's repeated failure to investigate and properly uphold the disparagement prohibition at the application level becomes *de facto* permission for the registration of certain kinds of disparaging marks—those that disparage the smaller, under-represented groups in American society about which many examining attorneys simply lack personal knowledge.

Requiring that an applicant meet its burden of proving that a mark is not disparaging is not unduly burdensome. The suggestions made by this Article—that the USPTO require such burden of proof be firmly placed on individual trademark applicants and that applicants be required to affirmatively disclose whether their trademark could be disparaging—are rather straightforward procedural changes that would promote greater consistency in USPTO holdings and would lessen the USPTO's reliance on third parties to police the integrity of the trademark register.

In recalling the USPTO's firm initial stance against the registration of DYKES ON BIKES, Brooke Oliver, the lead counsel for the SFWMC, said, "We chuckled a little and said, 'My, they're a little out of touch. We need to educate them a bit.'"¹⁹³ The recommendations made by this Article would require the very same: Trademark applicants should research their own trademarks and educate the USPTO "a bit" when their trademarks could potentially be disparaging.

Amendment rights would not be abridged by the refusal to register his mark." (citations omitted).

193. Raab, *supra* note 7.