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Renaming the Redskins (and the Florida State University Seminoles?): The Trademark Registration Decision and Alternative Remedies

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FLORIDA STATE UNIVERSITY LAW REVIEW



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(AND THE FLORIDA STATE UNIVERSITY SEMINOLES?):
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RENAMING THE REDSKINS (AND THE FLORIDA STATE
SEMINOLES?): THE TRADEMARK REGISTRATION
DECISION AND ALTERNATIVE REMEDIES

JACK ACHIEZER GUGGENHEIM*

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I. INTRODUCTION

On April 2, 1999, a three-judge panel of the Trademark Trial and Appeal Board (TTAB) of the Patent and Trademark Office (PTO) ordered the cancellation of federal registrations of seven trademarks of the Redskins, the National Football League’s (NFL) Washington, D.C., team.¹ The marks canceled include the team’s name and the team’s helmet logo. The TTAB’s decision was based on a finding that the name Redskins is disparaging to Native Americans. The decision relied on testimony from linguists and historians that the term “Redskin” is pejorative and on a survey finding that forty-six percent of the general public finds the term offensive.²

The TTAB’s 145-page decision does not prevent the Redskins from using the name and logos, but, arguably, it jeopardizes merchandising revenue by preventing the team from invoking federal law to prevent unauthorized goods from using the name and logos. The TTAB’s decision, however, does not take effect until the Redskins have had a chance to appeal.³ The Redskins organization has stated that it has no plans to stop using the team name, and it will likely appeal the decision to the United

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1. See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (P.T.O. 1999).

2. See *id.* at 1732-34.

3. See Brooke A. Masters, *Redskins Lose Right to Trademark Protection*, WASH. POST, Apr. 3, 1999, at A1.

States Court of Appeals for the Federal Circuit.⁴ In addition, lawyers for the team believe that even if the Federal Circuit sustains the decision, state and common law protection will prevent unauthorized merchandising.⁵ However, it is possible that the TTAB's decision will strip the Redskins' football's trademarks not only of federal protection, but also of common-law trademark protection.⁶

Part II of this Article analyzes the TTAB's decision in the historical context of trademark protection and with respect to decisions concerning "disparaging" or "scandalous" marks. It examines the evidence on both sides of the dispute and addresses the potential effect of cancellation on use of the Redskins' mark, both for the Redskins and for other potentially affected teams. For example, the Florida State University (FSU) Seminoles, named after the Native American Seminole tribe, have been the subject of recent controversy at FSU.⁷ Professor Fred Stanley, chairman of the English Department, recently called for FSU to change the name of its sport teams.⁸ The TTAB's recent cancellation decision might further escalate the debate.

Part III discusses other remedies potentially available to Native Americans to limit the misappropriation of Native American names and Native American culture, should the Federal Circuit overturn the TTAB's decision. The Native American challenge against the Redskins registration is an issue of first impression,⁹ and if it fails, Native American groups may wish to find other legal remedies to confront the issue of social mischaracterization. While such remedies may not successfully prevent use of the Redskins mark, they might succeed in stopping other teams or businesses from using Indian-related names and marks.

Regardless of whether the TTAB's decision is upheld on appeal, representatives of a wide spectrum of the Native American community initiated the challenge to the trademark's registration,¹⁰ and the resentment expressed by Native Americans may motivate the owner or future owner(s) of the Redskins to change the team's name.¹¹ Part IV of this article discusses trademark concerns in choosing a new name and recommends a new name intended to retain the goodwill vested in the Redskins mark. Trademark concerns that are present in choosing a new

4. *See id.*

5. *See id.*

6. At least one case has held that if a mark is not entitled to federal registration because it does not pass content-based registration bars, the mark cannot receive protection at common law. *See De Nobili v. Scanda*, 198 F. 341 (W.D. Pa. 1912) (indicating that public policy prevents marks which can not be registered from receiving common-law protection).

7. *See FSU in Losing Fight over Seminole Name, Prof Says*, STUART NEWS, April 16, 1999, at C3, available in LEXIS, News Library, Stunws File.

8. *See id.*

9. A registered mark has never been canceled based on 15 U.S.C. § 1052(a) (1994); however, marks have been denied registration based on 1052(a). *See George Likourezos, A Case of First Impression: American Indians Seek Cancellation of the Trademarked Term "Redskins,"* 78 J. PAT. & TRADEMARK OFF. SOC'Y 275, 276 (1996).

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

11. Similar resentment motivated the Quaker Oats Company to revise the image of "Aunt Jemima," which many considered a degrading depiction of an African-American. *See Sandra Clark & Paul Shepard, Trademark Makeovers Aim to Keep Image Hip*, CLEV. PLAIN DEALER, Mar. 7, 1993, at E1.

team name include trademark confusion caused by the name change, reverse confusion caused if the new name is too similar to one already in use, trademark infringement, and ownership of a team name no longer in use.

If the Redskins choose to change their name as a result of the pending registration action, they will have familiar precedents to consider. The Wizards, the National Basketball Association (NBA) team that, like the Redskins, plays in the Washington, D.C., area, very recently fought and won a trademark case emanating from its name change.¹² Another NFL team, the Jacksonville Jaguars, also recently confronted the trademark complications and pitfalls associated with choosing a new name.¹³ If the Redskins choose a new name, they will want to ensure preservation of the exclusive use of their old name. A third NFL team, the Indianapolis Colts, recently confronted the trademark complications of abandoning the use of the team's predecessor name—"Baltimore Colts."¹⁴

Significant developments in trademark law ensued as a result of these teams' challenges, illustrating the powerful social and economic value of prominent trademarks.¹⁵ However the current controversy is resolved, the outcome and subsequent appeal of the TTAB's decision will have significant consequences. Many professional, college, and high-school teams that use racial or ethnic names may have to re-evaluate the use of such names in light of potential decreased trademark protection.¹⁶ More

12. See *infra* Part IV.C. (discussing the debate about the likelihood of confusion between the Washington Wizards and the Harlem Wizards).

13. See *infra* Part IV.A (discussing the confusion between the Jacksonville Jaguars and Jaguar Cars, Ltd.).

14. See John R. O'Neill, *NFL Colts Blitzing CFL Colts: NFL Joins Lawsuit Charging Trademark of Name*, INDIANAPOLIS STAR, Apr. 30, 1994, at B1.

15. In 1992, analysts estimated that the NFL sold approximately \$2.1 billion in licensed merchandise. See Calvin Sims, *It's Not Just How Well You Play the Game*, N.Y. TIMES, Jan. 31, 1993, sec. 3, at 5. National Football League Properties, Inc. (NFLP) is a California corporation owned by NFL teams, which acts as the exclusive licensing agent for team trademarks. The NFLP issues manufacturing licenses for a royalty fee of six to eight percent of all wholesale revenue from licensed product sales. See Gerald Eskenazi, *Sports Logos Now Symbols of Big Profits*, N.Y. TIMES, June 19, 1989, at A1.

The significant value of a football team's trademarks is evident from the many suits brought to protect team's and the NFL's exclusive right to use certain marks. See, e.g., *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema*, 604 F.2d 200, 205 (2d Cir. 1979) (finding that the use of the team's cheerleader outfit in the movie *Debbie Does Dallas* caused confusion and violated team's trademark rights); *Nat'l Football League Properties, Inc. v. Wichita Falls Sportswear, Inc.*, 532 F. Supp. 651, 659-60 (W.D. Wash. 1982) (finding that unauthorized jerseys infringed on trademark rights by causing consumer confusion as to who produced and sponsored the goods); *Nat'l Football League Properties, Inc. v. Consumer Enter., Inc.*, 327 N.E.2d 242, 246 (Ill. Ct. App. 1975) (following *Boston Prof'l Hockey Ass'n v. Dallas Cap & Emblem Mfg.*, 510 F.2d 1004 (5th Cir. 1975), and finding that teams had property rights in team symbols as a result of acquiring goodwill and secondary meaning, which, therefore, prevented an unauthorized company from selling patches of team symbols).

16. In addition to the Washington Redskins, a small sampling of teams that use Native American Indian names include: the Atlanta Braves, the Cleveland Indians, the Kansas City Chiefs, and the Florida State University Seminoles. Some teams stopped using these names after receiving complaints that they were offensive. In 1972, Stanford University changed its name from the Indians to the Cardinals, and the University of Massachusetts changed its mascot from the Indian to the Minuteman. See David Arnold, *Minutemen Comes Under '90s-Style Fire*, BOSTON GLOBE, Oct. 14, 1993, at 1; see also Karen Goldberg, *Ethnic Team Names Draw New Attacks*, WASH. TIMES, July 10, 1993, at D1. In 1974, Dartmouth also stopped using "Indians" as a team name. See *Review & Outlook: Do You Wahoo?*, WALL ST. J., April 23, 1999,

broadly, the registration challenge and its outcome will help define the role of trademark registration as either a commercial tool, a social monitor, or an amalgamation of both.

II. THE PETITION FOR CANCELLATION

On September 10, 1992 a delegation of Native Americans (Delegation) filed a Petition for Cancellation with the PTO to cancel the federal registration of the Washington Redskins trademark, and related trademarks.¹⁷ Pro Football, Inc. (Pro Football) is the owner of the trademarks at issue. The Delegation represented a wide spectrum of the Native American community.¹⁸ The petition alleged that the term "Redskins" is a "pejorative, derogatory, degrading, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for a Native American person" and therefore violated 15 U.S.C. section 1052(a).¹⁹ The challenge reflected the Native American activists' concern that Indian-related names, logos, mascots, paraphernalia, and related fan activity perpetuate racist stereotypes of Native Americans as wild savages and preserve the image that Native Americans are relics of the past.²⁰ Native Americans have long asserted that the Redskins trademark is particularly derogatory, because, unlike some of the other names ostensibly based on Native American culture, it is an actual racial epithet.²¹

available in 1999 WL-WSJ 5449799. In 1994, St. Johns decided to change its team's name from the "Redmen" to the "Red Storm." Michael Shain, *Laundry St. Johns' Tradition "Redmen" May be Ousted*, N.Y. NEWSDAY, Nov. 4, 1993, at 172. In 1991, St. Johns removed its logo depicting an Indian brave. Despite the Indian logo, the school claimed that the name Redmen emanated from the red jerseys the team used to wear, and not from a Native American derivation. See *id.* In addition, the Boards of Education of Wisconsin and Minnesota almost banned all Indian mascots in public schools. See Keith Ervin, *Debate on Dropping School Mascots*, SEATTLE TIMES, Sept. 22, 1993, at B1.

17. See *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828, 1829 (P.T.O. 1994). Related trademarks the petition sought to cancel included: "Redskinettes," "Skins," "Redskins," "The Redskins & Design," and "The Redskins" (with stylized letters).

18. The members of the delegation included Suzan Shown Harjo, the President of the Morning Star Foundation; Vine Deloria, Jr., Esq., a citizen of the Standing Rock Sioux Tribe and Professor of History at the University of Colorado; Norbert S. Hill, Jr., Esq., a member of the Oneida Tribe of Wisconsin and Executive Director of the American Indian Science and Engineering Society; Manley A. Begay, Jr., of the Navajo Nation; Mateo Romero, member of the Cochiti Pueblo; William A. Means, a member of the Oglala Sioux Tribe; and Raymond D. Apodaca, Governor of the Ysleta del Sur Pueblo, and Area Vice President and Chairman of the Human and Religious Rights Committee of the National Congress of American Indians. See George Likourezos, *A Case of First Impression: American Indians Seek Cancellation of the Trademarked Term "Redskins"*, 78 J. PAT. & TRADEMARK OFF. SOC'Y 275, 276-77 (Apr. 1996).

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

20. See Don Pierson, *Redskins Nickname Will Be Protest Target*, CHI. TRIB., Jan. 19, 1992, at 2C.

21. Activism related to the issue of Native American mascots and names has been on going for approximately twenty-four years. See Clarence Page, *Block that Trademarked Racial Epithet*, ORLANDO SENT., Sept. 23, 1992, at A9. Prior to the recent trademark action, two of the most notable Native American protests to team names occurred: one held during the 1992 Super Bowl, featuring the Redskins; the other held during the 1991 World Series, featuring the Atlanta Braves. Protests organized by the American Indian Movement drew nearly three thousand activists to the Super Bowl. See Raad Cawthon, *Indians Receive Sympathy but No Promises from Braves*, ATLANTA CONST., Nov. 22, 1991, at H8; see also Mike Freeman, *NFL Deadline For Plan B Slips to Mar. 1, NFLPA Says Move Is Political*, WASH. POST, Jan. 25, 1992, at D7.

On March 11, 1994, the TTAB ruled on the delegation's motion to strike certain of the Redskins' affirmative defenses; two have survived. This ruling has set the stage for the full TTAB trial between the parties, and the resulting TTAB decision.

A. Trademark Protection

Common law, state registration, and federal registration can protect trademarks. Common law protection arises from the simple adoption and use of an identifying mark, even absent any form of registration, and creates an enforceable right of exclusivity in the mark's geographic area of use.²²

Trademark legislation dates back to 1791 when Thomas Jefferson proposed keeping a record of the name used on an item and making it illegal for others to put such name on their goods.²³ In 1870 Congress enacted the first federal trademark statute, which the Supreme Court found unconstitutional in 1879.²⁴ In 1881 and 1905 Congress tried again with limited trademark statutes.²⁵

In 1946 Congress passed the Lanham Act,²⁶ which provides for a federal registration system to protect trademarks used in commerce.²⁷ The term "trademark" includes any "word, name, symbol, or device, or any combination thereof" used by an individual to identify and distinguish his goods, or indicate a specific source of such goods, even if the source is unknown.²⁸ The purpose of federal trademark registration and protection is to protect the trademark owner's exclusive right to profit from the goodwill, which he has invested in his mark, and to protect the public from confusion regarding products and product sources.²⁹

The Patent and Trademark Office (PTO) governs trademark registration. The PTO's role is to promote the progress of scientific and artistic progress by securing authors and inventors the exclusive rights to their respective writings and discoveries for a limited duration of time.³⁰ The PTO is a non-commercial federal entity and one of fourteen bureaus in the Department of Commerce (DOC).³¹ The PTO's major functions are the examination and issuance of patents and the examination and registration of trademarks.³² Trademark registration assists businesses in

22. *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 416 (1916); *Avakoff v. Southern Pac. Co.*, 765 F.2d 1097, 1098 (Fed. Cir. 1985).

23. Beverly W. Pattishall, *The Constitutional Foundations of American Trademark Law*, 78 TRADEMARK REP. 456, 459 (1988).

24. *See id.* at 460; *see also* *United States v. Steffens*, 100 U.S. 82 (1879).

25. *See Pattishall, supra* note 23, at 461-62.

26. *See* Lanham Act, ch. 540, 60 Stat. 427 (1946) (current version at 15 U.S.C. §§ 1051-1127 (1994 & Supp. IV 1998)).

27. *See id.*

28. 15 U.S.C. § 1127 (1994 & Supp. II 1996).

29. *See* *Springfield Fire & Marine Ins. Co. v. Founders' Fire & Marine Ins. Co.*, 115 F. Supp. 787, 791 (N.D. Cal. 1953).

30. *See* U.S. CONST. art. I, § 8, cl. 8.

31. Title 15 U.S.C. § 1511 states that the PTO is under the jurisdiction and supervision of the Department of Commerce. *See* 15 U.S.C. § 1511 (1994).

32. Title 15 contains the provisions of the Trademark Act of 1946 that govern the administration of the trademark registration system of the PTO. *See* 15 U.S.C. §§ 1051-1127 (1994 &

protecting their investments, promoting goods and services, and safeguarding consumers against confusion and deception in the marketplace.³³

The PTO, however, does not determine rights for trademark usage.³⁴ Specifically, the PTO examines trademarks for potential registration on the Principal Register. The Principal Register provides numerous forms of protection to registrants and provides the mark's owner with significant benefits not otherwise granted by common law.³⁵ Registration on the Principal Register gives constructive notice to all later users of the trademark or of similar trademarks, which overcomes claims of good faith use.³⁶ Such constructive notice abrogates the existence of any geographical limitation on the knowledge and validity of the trademark.³⁷ The registrant obtains certain forms of trademark protection even in geographically distant areas where the registrant is not using the mark.³⁸ Registration on the Principal Register is accompanied by certain statutory rights, such as a degree of incontestability by others,³⁹ including prima facie evidence of ownership and validity of the trademark.⁴⁰ In addition, federal registration provides trademark owners with access to federal courts to litigate issues related to the mark.⁴¹

The ban on registration of "immoral" and "scandalous" marks first appeared as part of the 1905 federal trademark statute, which preceded the Lanham Act,⁴² and is now incorporated into the Lanham Act at Title 15 of the United States Code.⁴³ The major theories underlying the Lanham Act, section 1052(a), and the prohibition on inappropriate trademarks are (1) that the government should not waste its resources on protecting unseemly marks and (2) that the government should not pro-

Supp. IV 1998). Title 44 gives the PTO the authority to print patents, trademarks, and other matters relating to the business of the PTO. See 44 U.S.C. §§ 1337-38 (1994).

33. See generally *The PTO web page* (visited Feb. 7, 1996) <www.uspto.gov>.

34. See *Societe de Conditionnement en Aluminium v. Hunter Eng'g Co.*, 655 F.2d 938, 943 (9th Cir. 1981) (finding that an action for declaratory judgment that a patent is invalid or that a plaintiff is not infringing on a trademark are "case or controversy" justiciable by the courts).

35. Such protections apply to service marks and collective marks as well. See 15 U.S.C. §§ 1053-54, 1127 (1994 & Supp. II 1996).

36. See *id.* § 1072; see also *Quality Courts United, Inc. v. Quality Courts, Inc.*, 140 F. Supp. 341, 350 (M.D. Pa. 1956).

37. See 15 U.S.C. § 1072 (1994); see also *Allied Tel. Co. v. Allied Tel. Sys. Co.*, 565 F. Supp. 211, 216 (S.D. Ohio 1982).

38. See 15 U.S.C. § 1072 (1994).

39. See *id.* § 1065. Because the PTO is only concerned with registration issues, the PTO's analysis will generally only focus on issues of registration, and will generally only compare the information it has immediately before it. This analysis is different from the more extensive marketplace-oriented analysis undertaken by the courts. See Jack Achiezer Guggenheim, *KOA is A.O.K.: The Second Circuit's Recent Kosher Trademark Decision Further Illustrates that the Patent and Trademark Office Must Answer to a Higher Authority*, 22 COLUM.-VLA J.L. & ARTS 203, 211-14 (1998) (arguing that PTO decisions should not have res judicata effect because, as recent case law demonstrates, PTO determinations sometimes lack a thorough marketplace analysis).

40. See 15 U.S.C. § 1057(b) (1994 & Supp. IV 1998).

41. See *id.* § 1121.

42. See Act of Feb. 20, 1905, ch. 592, §§ 1-3, 33 Stat. 724 (1905) (previous version at 15 U.S.C. §§ 81-109) (repealed 1946).

43. See 15 U.S.C. §§ 1051-1127 (1994 & Supp. IV 1998).

vide its imprimatur to unseemly marks.⁴⁴ While section 1052(a) bars only the registration of scandalous, disparaging, or immoral marks, and not the use thereof, it does deny statutory protection and benefits resulting from registration.

B. Framing the Case and Controversy

In *Harjo v. Pro Football, Inc.*, a delegation of Native Americans filed a Petition for Cancellation of the "Redskins" trademark.⁴⁵ The Petitioners asserted as grounds for cancellation that the mark is "pejorative, derogatory, degrading, offensive, scandalous, contemptuous, disreputable, disparaging and racist."⁴⁶ Section 1052(a) states that a mark is to be refused registration if it "consists 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."⁴⁷

Pro Football, owner of the Redskins trademark, raised a number of affirmative defenses to the Delegation's cancellation action, including: 1) lack of standing; 2) equitable estoppel; 3) laches 4) secondary meaning of mark; 5) lack of damage to Petitioner; 6) that section 1052(a) of the Lanham Act is unconstitutional because it burdens free speech; 7) that section 1052(a) of the Lanham Act is unconstitutional because it is overly broad; 8) that section 1052(a) of the Lanham Act is unconstitutional because it is vague; and 9) that the Redskins mark does not disparage Petitioner because it is not reasonably understood to refer to Petitioner, or any Native American group.⁴⁸

The Delegation responded, motioning the court to strike certain of Pro Football's defenses. The Delegation brought its motion to strike in early 1994, and the TTAB ruled on the motion on March 11, 1994. The TTAB stated that in order to have standing, a petitioner must have a personal interest in the outcome of a proceeding.⁴⁹ The TTAB found that the Native American delegation had standing, because they had demonstrated a belief that the term was disparaging as applied to Native Americans.⁵⁰ Additionally, the TTAB dismissed Pro Football's laches and equitable estoppel defenses, finding that an overriding public interest trumped the failure to challenge the mark over the many years since its registration.⁵¹

The TTAB did not address the constitutional defenses raised by Pro Football, ruling instead that such defenses were outside the scope of the

44. See *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981); see also *Lee v. Superior Court*, 11 Cal. Rptr. 2d 763 (1992) (denying petition for name change to "Misteri Nigger" because it refused to sanction a racial epithet).

45. See *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828, 1829 (T.T.A.B. 1994).

46. See *id.*

47. 15 U.S.C. § 1052(a).

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

49. See *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028-29 (C.C.P.A. 1982) (holding that if a person does not plead facts sufficient to show a personal interest in the outcome of the case beyond that of the general public, the case may be dismissed for failure to state a claim).

50. See *Harjo*, 30 U.S.P.Q.2d (BNA) at 1830.

51. See *id.* at 1831.

TTAB's authority.⁵² The TTAB further concluded that since it is an administrative agency empowered by Congress, it does not have the authority to determine if Congressional enactments are constitutional.⁵³ Petitioners may, however, raise constitutional defenses on appeal.⁵⁴

52. See *id.* at 1833.

53. See *id.* For further discussion of the constitutionality of 1052(a) and limiting speech, see Richard Delgado & Jean Stefancic, *Images of the Outsider in American Law and Culture: Can Free Expression Remedy Systemic Social Ills?*, 77 CORNELL L. REV. 1258, 1262-75 (1992). See also *Texas v. Johnson*, 491 U.S. 397, 414 (1989) (noting that the bedrock principle underlying the First Amendment is that government cannot prohibit expression of an idea simply because society finds the idea offensive or disagreeable); *Hornell Brewing Co. v. Brady*, 819 F. Supp. 1227, 1245-46 (E.D.N.Y. 1993) (finding legislation prohibiting the Bureau of Alcohol, Tobacco, and Firearms from certifying a label that uses the name "Crazy Horse" on alcohol an unconstitutional prohibition on commercial speech); *Sambo's of Ohio v. City Council of City of Toledo*, 466 F. Supp. 177, 180 (N.D. Ohio 1979) (holding that restricting use of term "Sambo's" would violate First Amendment); Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPP. L. REV. 7, 43 (1994) [hereinafter, *Politically Correct*]; Jendi B. Reiter, *Redskins and Scarlet Letters: Why "Immoral" and "Scandalous" Trademarks Should be Federally Registrable*, 6 FED. CIR. B.J. 191, 196 (Fall 1996), (arguing that 1052(a) unconstitutionally encroaches on free speech). But see *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (finding that § 1052(a) is not an unconstitutional restriction on free speech because registration is not determinative of usage rights); Bruce C. Kelber, "Scalping the Redskins:" *Can Trademark Law Start Athletic Teams Bearing Native American Nicknames and Images on the Road to Racial Reform?*, 17 HAMLIN L. REV. 533, 562 (1994); and Paul E. Loving, *Native American Team Names in Athletics: It's Time to Trade These Marks*, 13 LOY. L.A. ENT. L.J. 1, 34-35 (1992) (concluding that § 1052(a) is a constitutional and effective tool to advance social goals).

Because a trademark is commercial speech, trademark legislation is subjected to relaxed Constitutional requirements. See *Friedman v. Rogers*, 440 U.S. 1, 18-19 (1979). Government regulation of commercial speech must serve a substantial purpose and not be broader than is necessary to serve such purpose. See *Central Hudson Gas & Electric Corp. v. Pub. Serv. Comm'n of N.Y.*, 447 U.S. 557, 571-72 (1980); see also Kent Greenawalt, *Insults and Epithets: Are They Protected Speech?*, 42 RUTGERS L. REV. 287, 288-91 (1990) (examining the government's role in regulating speech in a democratic society); Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 79 TRADEMARK REP. 604, 617 (1989) (discussing the need to balance free speech with trademark concerns); Caren Schmulen Sweetland, *The Demise of a Workable Commercial Speech Doctrine: Dangers of Extending First Amendment Protection to Commercial Disclosure Requirements*, 76 TEX. L. REV. 471, 483 (1997) (arguing that failure to distinguish between commercial speech and more protected political speech dilutes First Amendment protection).

Regardless of whether § 1052(a) is constitutional, it presents serious efficiency problems. What is, or is not, an offensive term is a question open to significant difference of opinion, and may force the PTO and courts to make determinations which are beyond the proper scope of trademark protection and which may not be purely objective. The value of a trademark is in the goodwill that accrues to the mark and the associations consumers make with the mark. The marketplace might be a more objective arbiter of what is and is not an offensive mark.

54. A party dissatisfied with a PTO decision has the option to appeal to the Court of Appeals for the Federal Circuit or to appeal through a civil action in federal district court. The appeal is governed by section 21 of the Lanham Act, 15 U.S.C. § 1071, and TRADEMARK MODEL RULES OF PRACTICE Rule 2.145. On appeal, a district court can provide greater relief, and give less weight to the fact-findings of the PTO, than does the Federal Circuit. See Lanham Act § 21, 15 U.S.C. § 1071 (1994); see also TRADEMARK MODEL RULES OF PRACTICE Rule 2.145. An appeal that takes the form of a civil action is commenced by the filing of a complaint with a district court, and is governed by FED. R. CIV. P. 3. See U.S. DEPT. OF COMMERCE, PATENT AND TRADE OFFICE, TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 903.04 (1995). The complaint indicates the unsuccessful party in the PTO as the plaintiff and the winning party as the defendant, and it bases federal jurisdiction on the Lanham Act § 21(b) and 15 U.S.C. § 1071. An appeal to a district court can be expanded to include a prayer for injunctive relief for trademark infringement. See, e.g., *Wells Fargo & Co. v. Stagecoach Prop., Inc.*, 685 F.2d 302 (9th Cir. 1982); *Holiday Inns, Inc. v. Holiday Inn in America*, 481 F.2d 445 (5th Cir. 1973) (holding that an appeal to the district court is a trial de novo, although the facts determined by the board are

Two of Pro Football's defenses remained after the TTAB's initial determination, including a "secondary meaning" defense. Both defenses essentially argued that the Redskins mark does not disparage Native Americans and the mark is not reasonably understood to refer to any particular Native American group.⁵⁵ Pro Football's secondary meaning defense is that through long, substantial and widespread use, the Redskins mark has acquired a secondary meaning—the term is associated with a professional football team, rather than with Native Americans.⁵⁶

The TTAB's decision slated the dispute for trial. It indicated that the case would be determined by deciding whether, at the time the registration was issued, the mark was scandalous or disparaging.⁵⁷ Because a federally registered trademark has a presumption of validity, the Delegation had the burden of proving disparagement.⁵⁸

C. "Disparaging" and "Scandalous"

1. "Disparaging" Standard and Case Law

To prevail in its action against the Redskins the Delegation had to prove that the mark "Redskins", as applied to Native Americans, was either disparaging or scandalous at the time the mark was registered.⁵⁹ In determining the standard to apply, the TTAB surprisingly rejected the application of an earlier decision.⁶⁰ The TTAB distinguished, in part, the test established in *Greyhound Corp. v. Both Worlds, Inc.* for determining whether a mark was "disparaging."⁶¹ In *Greyhound*, the Board stated that in order to be found disparaging, a mark must (1) be reasonably understood to refer to the plaintiff; and (2) be considered offensive or objectionable to a reasonable person of ordinary sensibilities.⁶² The TTAB stated that the reasonable person standard applies when the issue is disparagement of a commercial corporate entity or an individual.⁶³

In rejecting the *Greyhound* standard, the TTAB noted the distinction between commercial and non-commercial entities and between indi-

controlling). The appeal also allows for counterclaims for federal or common-law claims. *See Johnson & Johnson v. Colgate-Palmolive Co.*, 345 F. Supp. 1216 (D.N.J. 1972) (allowing the defendant to file a compulsory counterclaim pursuant to FED R. CIV. P. 13(a)). Thus, in going to a federal district court rather than to the Federal Circuit, the appellant incurs the risk of the adverse party expanding the scope of the litigation beyond the mere appeal from the TTAB's decision. *See* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARK AND UNFAIR COMPETITION § 21:20 (3d ed. 1992).

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

56. *See id.* This is different from the typical "secondary meaning" defense, which argues that the average consumer associates a trademark with a particular source for the product. *See* PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES 247 (1993).

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

58. *See id.* at 1829-30.

59. *See id.*

60. *See Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1988) (using a "substantial composite of the general public" test to find a mark which depicts a defecating dog scandalous).

61. *See Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1739-40 (P.T.O. 999).

62. *See Greyhound*, 6 U.S.P.Q.2d (BNA) at 1639.

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

viduals and groups, in cases involving alleged disparagement.⁶⁴ In cases involving non-commercial entities or groups, it found the test enunciated in *In re Hines* to be more “appropriate.”⁶⁵ In *Hines*, the TTAB noted that the determination of disparagement for a targeted, distinct religious group was “highly subjective,” and thus, the perceptions of the public were irrelevant and “only the perceptions of those referred to, identified or implicated in some recognizable manner by the involved mark are relevant to this determination.”⁶⁶ Applying this rationale to the case at hand, it determined that the standard when dealing with alleged disparagement of a religious or racial group is the view of the distinct group to whom the mark refers, identifies or implicates.⁶⁷

Therefore, the Delegation had to show that “Redskins” can be reasonably understood to refer to Native Americans and that the term “Redskins” is offensive or objectionable from a Native American’s viewpoint. To determine if the Delegation had met its burden, the TTAB examined “evidence often considered in the decisional law concerning scandalousness and disparagement,” such as dictionary definitions, history, linguistic analysis and evidence from various contemporary secondary sources.⁶⁸ Based on the “cumulative effect of the entire record” the TTAB found the “disparaging connotation of ‘redskin(s)’. . . extend[s] to the word ‘Redskin(s)’ as it appear[ed] in [the] subject marks and as used in connection with respondent’s identified services.”⁶⁹ Further, since this was an opposition proceeding and not an ex parte determination, the Redskins did not enjoy the presumptions in favor of registration discussed in *In re Mavety Media Group, Ltd.*⁷⁰ Following *Hines* and *Mavety*, the TTAB determined that “Redskins” was disparaging to Native Americans from the viewpoint of a substantial composite of Native Americans.⁷¹

Even with the guidelines of *Hines* and *Mavety*, however, the outcome of the registration challenge was highly speculative. Past decisions indicated that determinations regarding disparagement were unpredictable.⁷² The first case to refuse trademark registration on the grounds that the mark was disparaging is *Doughboy Industries, Inc. v. Reese Chemical Co.*⁷³

64. *See id.*

65. *Id.*; *see also In re Hines*, 31 U.S.P.Q.2d (BNA) 1685 (P.T.O. 1994).

66. *Hines*, 31 U.S.P.Q.2d (BNA) at 1688-89.

67. *See Harjo*, 50 U.S.P.Q.2d (BNA) at 1740.

68. *Id.* at 1744.

69. *Id.* at 1743.

70. 33 F.3d 1367, 1374 (Fed. Cir. 1994). In *Mavety*, the Federal Circuit Court dealt with an appeal of a refusal to register a mark based on the grounds that the mark was scandalous, not disparaging, but its analysis may still be helpful for implementing the “disparaging” test since similar evidence is often proffered to support both claims. *See discussion infra* Part II.C.2.; *see also Harjo*, 50 U.S.P.Q.2d (BNA) at 1743-44.

71. *See Harjo*, 50 U.S.P.Q.2d (BNA) at 1743-44.

72. *See, e.g., Doughboy Industries, Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227 (P.T.O. 1951); *In re Reemtsma Cigarettenfabriken*, 122 U.S.P.Q. 339 (T.T.A.B. 1959); *In re Waughtel*, 138 U.S.P.Q. (BNA) 594, (T.T.A.B. 1963); *In re Condas*, 188 U.S.P.Q. (BNA) 544 (T.T.A.B. 1975); *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990).

73. *See Doughboy*, 88 U.S.P.Q. (BNA) at 228; *see also Harjo*, 50 U.S.P.Q.2d (BNA) at 1738-39 (noting the authority of *Doughboy*).

In *Doughboy*, the PTO held that the use of the mark “Dough-Boy” for a prophylactic device for preventing venereal disease was disparaging to American veterans who had served in World War I, and had been referred to as doughboys. The PTO focused on the product to which the mark applied.⁷⁴ The TTAB, likewise, focused on the product to which the mark applied in *In re Reemtsma Cigarettenfabriken*.⁷⁵ In *Reemtsma*, the TTAB denied registration to the mark “Senussi” for cigarettes, because it found that application of the mark disparaged members of the Senussi faith, whose religion forbids smoking.⁷⁶ In *In re Condas*, the TTAB permitted the registration of the mark “Jap” for women’s clothing, finding that the use of the mark did not disparage Japanese.⁷⁷ In *In re In Over Our Heads, Inc.*, the Board found the mark “MOONIES” did not disparage members of the Unification Church, because it would not be associated with members of the Unification Church as applied to a novelty item, which, at the press of a button, dropped its pants and revealed its buttocks.⁷⁸

However, at least one decision might have shown which way the wind was blowing. An arguable precursor to the TTAB’s decision in *Harjo* was an August 1995 PTO decision which refused to register the mark “Crazy Horse” as applied to a malt liquor, finding it violated Section 1052(a).⁷⁹

2. “Scandalous” Standard and Case Law

The *Harjo* delegation also challenged the Redskins trademark on the grounds that it is “scandalous.” The general definition for “scandalous” is “shocking to one’s sense of decency or propriety” and “offensive to the conscience or moral feeling.”⁸⁰ To determine whether a mark is scandalous, the mark is considered as applied to the goods identified in the registration.⁸¹ In *In re McGinley*, the Court of Customs and Patent Appeals held that whether a mark is scandalous or immoral is to be ascertained from the standpoint of a substantial composite of the general public.⁸² In

74. See *Doughboy*, 88 U.S.P.Q. (BNA) at 1739.

75. See *Reemtsma*, 122 U.S.P.Q. (BNA) 339; see also *Harjo*, U.S.P.Q.2d (BNA) at 1739 (noting the authority of *Reemtsma*).

76. See *In re Waughtel*, 138 U.S.P.Q. (BNA) 594, 595 (T.T.A.B. 1963) (holding mark “Amish” for cigars did not disparage the Amish, because Amish are not prohibited from smoking).

77. See *Condas*, 188 U.S.P.Q. (BNA) 544.

78. See *In re In Over Our Heads*, 16 U.S.P.Q.2d (BNA) 1653 (T.T.A.B. 1990); *Harjo*, 50 U.S.P.Q.2d (BNA) at 1736 (noting the authority of *Over Our Heads*).

79. See Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse*, 27 CONN. L. REV. 1003, 1028-29 (1995).

80. *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938) (finding that the mark “Madonna” was scandalous as applied to wines). See also *In re P.J. Valckenberg*, 122 U.S.P.Q. (BNA) 334 (T.T.A.B. 1959) (denying mark twenty years later). But see Federal Trademark Registration Number 1,473,554 (1988) (allowing registration of “Madonna” as stage name for a pop singer).

81. See *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470 (T.T.A.B. 1988) (finding “Big Pecker” was not a scandalous mark because a substantial composite of the general public would not necessarily associate the term with a man’s genitalia instead of a bird’s beak). The TTAB noted *Hershey*’s authority in the PTO Final Decision. See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1736 (P.T.O. 1999).

82. See 660 F.2d at 481 (C.C.P.A. 1981) (holding that a photograph of a nude man and a woman kissing with the man’s genitalia exposed is scandalous and immoral from the stand-

determining whether the term Redskins was scandalous, the TTAB also looked to a decision of the United States Court of Appeals for the Federal Circuit, *In re Mavety Media Group Ltd.*,⁸³ which interpreted section 1052(a)'s prohibition on the registration of scandalous marks.⁸⁴ In *Mavety*, the court vacated and remanded a decision by the TTAB on the grounds that the TTAB did not have actual evidence that a substantial composite of the general public would find the mark "Black Tail," as applied to an adult magazine featuring African-American women, scandalous.⁸⁵

The Federal Circuit in *Mavety*, concluded that the test for scandalousness is based upon an underlying factual inquiry, which is to be determined from the viewpoint of a substantial composite of the general public and in the context of contemporary attitudes.⁸⁶ The *Mavety* court accepted dictionary definitions and editorials as authoritative but not definitive, since the court ultimately concluded that dictionaries do not necessarily represent the views of a substantial composite of the general public.⁸⁷ The court concluded that questions as to whether a mark is scandalous should be resolved in favor of the applicant, because an opposition proceeding can be brought after the mark is published by those who find the mark to be scandalous, thus establishing a greater record for determining whether the mark truly is scandalous.⁸⁸ The TTAB further noted the authority of *In re Old Glory Condom Corp.*, which held that an American flag design on condoms is not scandalous.⁸⁹

Based on this case law, to assess whether the mark Redskins is scandalous, the TTAB needed to determine whether the term "Redskins," as applied to a football team, is shocking to a substantial composite of the general public's sense of decency or propriety. Furthermore, the TTAB needed to find "Redskins" offensive to a substantial composite of the

point of a substantial composite of the general public). See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1735-36 (noting the authority of *McGinley*); see also *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, 866 (T.T.A.B. 1981) (finding that use of the mark "bullshit" for accessories was scandalous); *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443, 443-44 (T.T.A.B. 1971) (denying the mark "Bubby Trap" registration as applied to brassieres); *Ex Parte Summit Brass & Bronze Works, Inc.*, 59 U.S.P.Q. (BNA) 22, 23 (Comr. 1943) (refusing registration for mark "Agnus Dei" as applied to safes, finding that such application of an emblem sacred to the Christian faith would be offensive and scandalous); *Ex parte Martha Maid Mfg.*, 37 U.S.P.Q. (BNA) 156, 156 (1938) (denying the mark "Queen Mary" for women's underwear was denied registration because it was found to be scandalous).

83. 33 F.3d 1367 (Fed. Cir. 1994).

84. See *id.* at 1370.

85. See *id.* at 1375.

86. See *id.* at 1371.

87. See *id.* at 1373.

88. See *id.* at 1374.

89. See *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1220-21 (T.T.A.B. 1993); see also *In re In over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1655 (T.T.A.B. 1990) (finding the mark "MOONIES" not scandalous as applied to a novelty item which dropped its pants and revealed its buttocks); *In re Leo Quan, Inc.*, 200 U.S.P.Q. (BNA) 370, 371 (T.T.A.B. 1978) (finding that "Badass," standing for Benticourt Acoustically Designed Audio Sound Systems is not scandalous or immoral); *In re Thomas Labs, Inc.*, 189 U.S.P.Q. (BNA) 50, 52 (T.T.A.B. 1975) (finding a cartoon of a melancholy man examining his unseen genitalia was not shocking to society's sense of propriety); *In re Masden*, 180 U.S.P.Q. (BNA) 334, 335 (T.T.A.B. 1973) (finding that "Week-End Sex" is not a scandalous trademark for a magazine).

general public's conscience or moral feeling. The TTAB held that neither of these requirements was met.⁹⁰

D. Examining the Evidence

1. Evidence that "Redskins" Is Disparaging and Scandalous

The TTAB stated that in determining whether to cancel the Redskins registration on the grounds the mark is disparaging to Native Americans, or scandalous, it would examine the Redskins mark at the time it was registered.⁹¹ The Delegation pointed to a significant amount of data to show that, to Native Americans, the term Redskins was disparaging and possibly scandalous.⁹²

It has been suggested that the name Redskins was chosen initially when the team played in Boston, as a tribute to the American patriots who dressed up as Indians and dumped tea from English ships into the Boston Harbor as part of the "Boston Tea Party." The term Redskins has also historically been used to refer to Native Americans. Even if the mark does refer to participants of the Boston Tea Party, the mark can be disparaging to Native Americans. In fact, in 1995 the Association of American Indian Affairs called for a boycott of Snapple because it believed Snapple's use of a historic painting of the Boston Tea Party on its iced tea bottles perpetuated the image of savage Indians "upon which hundreds of years of murder and oppression have been based."⁹³

The origin of the term "Redskin" probably does not come from any characterization of Native Americans' skin color, but rather, from the European and Algonquian name for the Delaware Indians, whose men would "streak their faces and bodies with bright red ocher and blood-root, as well as white and yellow clays," and had a "fondness for vermilion makeup, concocted from fat mixed with berry juice."⁹⁴ However, at least one dictionary defines "Redskin" as a North-American Indian, "so called from the reddish or coppery color of the skin."⁹⁵

The Redskins fight song was further probative evidence that the Redskins' mark was disparaging to Native Americans at the time it was registered, since it portrays Native Americans as inarticulate barbarians.⁹⁶ The original lyrics of the Redskins' fight song were:

90. See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1748-49 (P.T.O. 1999).

91. See *Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828, 1832 (T.T.A.B. 1994); see also *Consorzio del Prosciutto di Parma v. Parma Sausage Prod., Inc.*, 23 U.S.P.Q.2d (BNA) 1894, 1898-99 (T.T.A.B. 1992) (holding that the operative date to consider in determining deceptiveness is the date of registration).

92. See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1742-45.

93. David Menzies, *Culture Jamming*, FIN. POST, Dec. 1, 1995, available in 1995 WL 4354339.

94. AMERICA'S FASCINATING INDIAN HERITAGE 118 (James A. Maxwell ed., 1978). For further analysis of the negative portrayal of Native Americans in the United States, see RAYMOND W. STEDMAN, SHADOWS OF THE INDIAN: STEREOTYPES IN AMERICAN CULTURE, (1982) and JOHN E. O'CONNOR, HOLLYWOOD: STEREOTYPES OF NATIVE AMERICANS IN FILM (1980).

95. WEBSTER'S NEW UNIVERSAL UNABRIDGED DICTIONARY (Jean L. McKechnie ed. 1983).

96. See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1746.

Hail to the Redskins, hail victory! Braves on the warpath, fight for old D.C.! Scalp 'em, wamp 'em, we will take 'em big score. Read 'em, weep 'em, touchdown, we want heap more!⁹⁷

2. Evidence that "Redskins" Is Not Disparaging or Scandalous

Arguably, the significant support that teams with Native American names have received from the Native American community itself shows that the Redskins' mark is not disparaging or scandalous but, rather, pays tribute to Native Americans and reflects bravery, courage, pride and a fighting spirit. The chief of the Cherokee tribe in North Carolina stated that the Redskins name does not bother his tribe and feels the name gives Native Americans recognition.⁹⁸ Indeed, a Cherokee princess, Pale Moon, even sang the national anthem before a 1991 Redskins game.⁹⁹ The tribe also has high regard for the Atlanta Braves, and manufactures fake tomahawks for Braves fans.¹⁰⁰

Examples of Native American support for other teams with Native American names includes the statement of James Billie, chairman of the Seminole Tribe of Florida, who asserts that Florida State University's use of the Seminole name for its team reflects a pride in Florida Seminole history and is an ego boost to his tribe.¹⁰¹ Another example is the Illinois Indians who have shown support for the University of Illinois football team and its use of Native American imagery.¹⁰² Even the Cleveland Indians, with its grinning caricature Indian-head logo, which many find highly offensive, was actually named in honor of Luis Francis Sockalexis, the first Native American major league baseball player.¹⁰³

Perhaps the strongest argument that the names are intended to be symbolic of strength and bravery is the very fact that teams have chosen to use such names. A name is chosen to encourage and serve as a rallying point, not to demean the players. This of course does not mean that it is not offensive to members of a group that do not want that group to be popularly associated with violence and savagery.

E. The TTAB's Cancellation Decision

The TTAB began the legal analysis in its dispositive cancellation decision by noting it was addressing only the trademark registration, not the use of such marks.¹⁰⁴ To determine whether the Redskins trademarks

97. *Hail to the Redskins*, WASH. POST, Jan. 20, 1984, at N7.

98. See Leonard Shapiro, *Offensive Penalty Is Called on "Redskins": Native American Tribes Protest the Name*, WASH. POST., Nov. 3, 1991, at D1.

99. See *id.*

100. See *id.*

101. See Jack Wheat, *Real Seminoles Resent the Profits FSU Makes off Their Tribal Name*, MIAMI HERALD, Feb. 11, 1993, at 7B. The article notes that Billie, however, does not enjoy the full support of all Seminoles. See *id.*

102. Jim Parsons, *Indians Say Fight over Nicknames Isn't Going Away*, MINNEAPOLIS-ST. PAUL STAR TRIB., Oct. 21, 1995, at 1A.

103. See Laurel R. Davis, *Protest Against the Use of Native American Mascots: A Challenge to Traditional American Identity*, 17 J. SPORT & SOC. ISSUES 9 (1993) (referring to the Mascot "Chief Wahoo").

104. See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705, 1740-41 (P.T.O. 1999).

were disparaging, the TTAB used a two-step process. First it examined the meaning of the challenged trademarks. Second, it examined whether such meaning was disparaging to Native Americans.¹⁰⁵ The TTAB answered these questions within the appropriate time context from 1967 to 1990, the years the marks were registered.¹⁰⁶ Based on the evidence before it, including dictionary definitions, the TTAB determined that the marks did, in fact, refer to Native Americans.¹⁰⁷ The TTAB also found that, by at least a preponderance of the evidence, it was established that, as of the dates of registration, the marks (as used in connection with the identified services) did disparage Native Americans as perceived by a substantial composite of Native Americans.¹⁰⁸

However, in reaching its determination, the TTAB rejected the view of several of the petitioner's witnesses that the use of Native-American imagery is disparaging *per se* to Native Americans.¹⁰⁹ Indeed, with respect to the images of a Native American (in profile) and a spear design, as incorporated in the marks, the TTAB found that the Delegation had not established that such images, in context, disparaged Native Americans.¹¹⁰ This element of the TTAB's decision is crucial because it bears on trademarks of other sports teams that use Native American names. Accordingly, challenges to such marks will still have to prove that they have a pejorative meaning, and are disparaging in the context of their use.

Similarly, the TTAB also relied on a two-step process to determine whether the marks were scandalous. The TTAB first assessed the likely meaning of the marks.¹¹¹ Next, the TTAB assessed whether the marks, given their meaning, were scandalous to a substantial composite of the general public.¹¹² The TTAB again found that the Redskins' marks clearly alluded to Native Americans.¹¹³ However, the TTAB then found that the Delegation had failed to establish, by a preponderance of the evidence, that the marks, in the context of their use, were scandalous. The Delegation failed to establish that the marks "would be 'shocking to the sense of truth, decency, or propriety' to, or 'giv[e] offense to the conscience or moral feelings [of,] excit[e] reprobation, [or] call out for condemnation' by, a substantial composite of the general population."¹¹⁴

F. *The Florida State University Seminoles*

The TTAB's recent decision canceling the Redskins' trademarks might further elevate the debate as to whether Florida State University (FSU) should continue to use "Seminoles" as its teams' names, but it is unlikely to result in the cancellation of any of the University's federally

105. *See id.*

106. *See id.*

107. *See id.* at 1741-42.

108. *See id.* at 1743.

109. *See id.*

110. *See id.*

111. *See id.* at 1747-48.

112. *See id.*

113. *See id.*

114. *Id.* at 1748-49 (citing *In re Mavety Media Group Ltd.*, 31 U.S.P.Q.2d (BNA) 1923, 1925 (T.T.A.B. 1994)).

registered trademarks. As noted, in reaching its determination regarding the Redskins' trademarks, the TTAB rejected the view that the use of Native American imagery in the sports context is *per se* disparaging to Native Americans.¹¹⁵ Furthermore, a challenge asserting that "Seminoles" is disparaging to Native Americans would have to show that the meaning of the challenged trademark was disparaging to Native Americans.¹¹⁶ Clearly, the name "Seminoles" refers to the Native American tribe. A challenge to an FSU Seminole trademark on the ground that it is disparaging is therefore likely to fail, because no derogatory racial implication is inherent in the name. Furthermore, it would be hard to show that Native Americans find the name disparaging, when members of the tribe itself support its use.¹¹⁷ As noted, James Billie, chairman of the Seminole Tribe of Florida, has stated that FSU's use of the Seminole name for its team reflects a pride in Florida Seminole history and is an ego boost to his tribe.¹¹⁸ Given the support of the Seminole tribe itself it is also hard to imagine that the Seminole team name "would be 'shocking to the sense of truth, decency, or propriety' to, or 'giv[e] offense to the conscience or moral feelings [of,] excit[e] reprobation, [or] call out for condemnation' by, a substantial composite of the general population."¹¹⁹

III. ALTERNATIVE REMEDIES FOR NATIVE AMERICANS

If the Federal Circuit overturns the TTAB's decision, Native American groups might look towards other legal remedies in confronting mischaracterization. In recent years the Native American community has invoked intellectual property laws more frequently to assert self-determination and to protect cultural identity, and the Native American community now has several avenues through which to address the misappropriation and improper use of Native American culture and names.¹²⁰ Although these remedies would not likely have been appropriate to stop the use of the Redskins mark, they might succeed in stopping other teams from using Indian related names and marks.

Native Americans may be able to stem the registration and use of Native American cultural icons based on another provision of section 1052(a), which prohibits registration of a mark that "[c]onsists of or comprises . . . matter which may disparage or falsely suggest a connection with persons, living or dead"¹²¹ Arguably, marks that misappro-

115. *See id.* at 1743.

116. *See id.* at 1737.

117. *See* Jack Wheat, *Real Seminoles Resent the Profits FSU Makes off Their Tribal Name*, *MIAMI HERALD*, Feb. 11, 1993, at 7B.

118. *See id.*

119. *Harjo*, 50 U.S.P.Q.2d (BNA) 1748-49.

120. Native American names currently are used on many products without any need for permission or authorization. *See* SUSAN L. STETLER, *BRANDS & THEIR COMPANIES* (11th ed. 1993); *see also* *COMPANIES AND THEIR BRANDS* (13th ed. 1995).

121. 15 U.S.C. § 1052(a) (1994 & Supp. IV 1998). *See, e.g.*, *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 703 F.2d 1372 (Fed. Cir. 1983); *University of Ala. v. BAMA-Werke Curt Baumann*, 231 U.S.P.Q. (BNA) 408 (T.T.A.B. 1986); *In re Cotter & Co.*, 228 U.S.P.Q. (BNA) 202 (T.T.A.B. 1985); *Buffett v. Chi-Chi's, Inc.*, 226 U.S.P.Q. (BNA) 428 (T.T.A.B. 1985).

priate Native American names or culture falsely suggest a connection with particular persons, namely Native Americans. These marks may be seen as signifying that the goods carrying such marks are produced by, or are in some way associated with, Native Americans. However, a recent TTAB decision indicates that such arguments will be successful only where the misappropriated term is recognized as referring uniquely to Native Americans.¹²²

Alternatively, the Native American community may be able to seek redress through tort actions, such as defamation and the right of publicity, which may be brought in tribal courts.¹²³ A recent tribal decision found that the right of publicity does exist under tribal law.¹²⁴

In *In re Tasunke Witko*, descendants of Tasunke Witko invoked the Rosebud Sioux tribal legal process to oppose the marketing of a malt liquor named "Crazy Horse."¹²⁵ The plaintiffs sought an injunction against the misappropriation and misuse of the name Crazy Horse, a written public apology, and compensation, including traditional damages of one braid of tobacco, a racehorse, and a four-point Pendleton blanket for each state and month in which the liquor was sold.¹²⁶

While *In re Tasunke Witko* was ultimately dismissed for lack of jurisdiction, the case established the tribal right to control publicity of tribal names and identities.¹²⁷ The tribal court system is an expression of federally recognized sovereign authority.¹²⁸ However, the tribal courts are not completely free from regulation by the United States government, and are subject to statutes like the Indian Civil Rights Act of 1968.¹²⁹ The Supreme Court has pushed tribal courts to conform to federal and state legal systems; however, tribal judges have also begun applying traditional

122. See *In re Indian Nation Leather Co.*, 44 U.S.P.Q.2d (BNA) 1539, 1540 (T.T.A.B. 1997) (reversing refusal of registration because it was not established that term "Indian Nation" referred uniquely to Native Americans).

123. The right of publicity protects an individual's right to choose how his name and identity will be exploited for commercial use, if at all. See, e.g., *Martin Luther King, Jr. Ctr. for Social Change, Inc. v. American Heritage Prod.*, 694 F.2d 674 (11th Cir. 1983); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979).

124. See Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse*, 27 CONN. L. REV. 1003, 1050 (1995) (citing *In re Tasunke Witko*, Civ. No. 93-204, at 11).

125. See *id.*

126. See *id.* at 1048.

127. See *id.* at 1050 (noting the court announced that tribal law does recognize the right of publicity, while at the same time it refused to address the merits of the case). For further discussion of the tribal court system and the interaction of tribal law with intellectual property rights, see Rosemary J. Coombe, *The Properties of Culture and the Politics of Possessing Identity: Native Claims in the Cultural Appropriation Controversy*, 6 CAN. J. OF L. & JURIS. 249 (1993); Vine Deloria, Jr., *Laws Founded in Justice and Humanity: Reflections on the Content and Character of Federal Indian Law*, 31 ARIZ. L. REV. 203 (1989); Sidney L. Haring, *The Incorporation of Alaskan Natives Under American Law: United States and Tlingit Sovereignty*, 31 ARIZ. L. REV. 279 (1989); Jessica R. Herrera, *Not Even His Name: Is the Denigration of Crazy Horse Custer's Final Revenge*, 29 HARV. C.R.-C.L. L. REV. 175 (1994); Chief Justice Tom Tso, *The Process of Decision Making in Tribal Courts*, 31 ARIZ. L. REV. 225 (1989); Christine Zuni, *The Southwest Intertribal Court of Appeals*, 24 N.M. L. REV. 309 (1994).

128. See Carole Goldberg-Ambrose, *Of Native Americans and Tribal Members: The Impact of Law on Indian Group Life*, 28 LAW & SOC. REV. 1123, 1145 (1994); see also Judith Resnik, *Dependent Sovereigns: Indian Tribes, States, and the Federal Courts*, 56 U. CHI. L. REV. 671, 691 (1989).

129. See 25 U.S.C. §§ 1301-1303 (1994 & Supp. IV 1998).

and customary law in adjudicating disputes.¹³⁰ One of the major challenges to bringing an action in tribal court is the jurisdictional limitation of the tribal court. However, a non-Indian defendant wishing to challenge the tribal court's jurisdiction must first bring the challenge in the tribal court, and appeal it to a tribal appellate court.¹³¹ Only after the tribal case has been completed may a challenge to jurisdiction be brought in federal court.¹³²

In addition to seeking a remedy in tribal court, the Native American community may also look to the Indian Arts and Crafts Act of 1935¹³³ (IACA) for the intellectual property protections it creates. In 1990, Congress overhauled the IACA to expand the protection of Native American arts and crafts by encouraging tribes to register their trademarks and by assisting Native American artisans in marketing their works.¹³⁴ The underlying policy of IACA is to promote the economic welfare of Native American tribes and to protect consumers through the creation and registration of trademarks of genuineness and quality.¹³⁵

Under IACA, an Indian Arts and Crafts Board is charged with developing and expanding the market for Native American products. The Indian Arts and Crafts Board has the authority to create trademarks of genuineness and quality for Native American products, to establish standards and regulations for the use of such trademarks, to register such trademarks through the PTO at no charge, to pursue or defend in court any PTO determination, and to conduct market research and technical research.¹³⁶ The IACA provides for injunctive relief, equitable relief, compensatory damages, punitive damages, and attorney's fees.¹³⁷

130. See generally Gloria Valencia-Weber, *Tribal Courts: Custom and Innovative Law*, 24 N.M. L. REV. 225, 244-56 (1994) (discussing the role of custom in the development of Indian law); Robert A. Williams, *The Algebra of Federal Indian Law: The Hard Trail of Decolonizing and Americanizing the White Man's Indian Jurisprudence*, 1986 WIS. L. REV. 219, 268-74 (1986) (discussing Supreme Court decisions designed to hamper the development of Indian tribal law as distinct from U.S. sovereignty).

131. See Kevin Gover & Robert Laurence, *Avoiding Santa Clara Pueblo v. Martinez: The Litigation in Federal Court of Civil Actions Under the Indian Civil Rights Act*, 8 HAMLIN L. REV. 497, 499-500 (1985) (discussing sovereign immunity in Native American law and the development of jurisdiction for tribal courts).

132. See Robert N. Clinton, *Tribal Courts and the Federal Union*, 26 WILLAMETTE L. REV. 841, 844-66 (1990) (exploring the relationship between tribal courts and the federal union); see also Timothy W. Joranko, *Exhaustion of Tribal Remedies in the Lower Courts After National Farmers Union and Iowa Mutual: Toward a Consistent Treatment of Tribal Courts by the Federal Judicial System*, 78 MINN. L. REV. 259, 269 (1993).

133. See Indian Arts and Crafts Act of 1935, ch. 748, 49 Stat. 891 (1935) (current version at 25 U.S.C. §§ 305-305f (1994)).

134. See Act of Nov. 29, 1990, Pub. L. No. 101-644, 104 Stat. 4662 (amending 25 U.S.C. §§ 305a, 305d, 305e (1989)).

135. See 25 U.S.C. § 305a (1994).

136. See 25 U.S.C. 305a(g)(1)-(4).

137. See 25 U.S.C. § 305e. For further discussion of the effort to protect cultural property, see generally Richard A. Guest, *Intellectual Property Rights and Native American Tribes*, 20 AM. INDIAN L. REV. 111, 134-35 (1995-96) (discussing the underlying purposes of the IACA); Suzan Shown Harjo, *Native Peoples' Cultural and Human Rights: An Unfinished Agenda*, 24 ARIZ. ST. L.J. 321, 328 (1992) (discussing the necessity for protecting Native American culture from exploitation); J.H. Merryman, *The Public Interest in Cultural Property*, 77 CAL. L. REV. 339, 355-64 (1989) (discussing the elements of an appropriate public policy regarding cultural property); Rennard Strickland & Kathy Supernaw, *Back to the Future: A Proposed Model Tribal Act to Protect Native Cultural Heritage*, 46 ARK. L. REV. 161, 163-67 (1993) (discussing

In the future, the Native American community may want to invoke the false suggestion prohibition of the Lanham Act's section 43(a), tribal court tort actions, or IACA actions, in addition to the Lanham Act's disparaging and scandalous prohibitions, to stop the misappropriation of Native American cultural names and mark.

IV. TRADEMARK ISSUES TO BE CONSIDERED IN CHOOSING A NEW NAME

In light of the TTAB's decision, Pro Football should seriously consider changing the Redskins' team name. A name change might reap the goodwill of Native Americans who were offended by the team's name and of sympathizing fans. This goodwill should be especially valuable to a team who many still remember as being the last team in the NFL to hire African-American players.¹³⁸ The main disadvantage to Pro Football in changing the name would be losing the ongoing use of the Redskins mark and the goodwill in the team name. However, drawing from the experience of other teams, it may be concluded that the team may be able to retain this vested goodwill if it chooses a proper replacement name.

If Pro Football does decide to rename the Redskins, the new team name will need to be something that has fan appeal and market presence and that can serve as a rally cry. However, the new name must not infringe on any existing marks. The Jacksonville Jaguars experience is a reminder to teams that, when selecting a new name, it is important to ensure that the new name does not infringe on an existing mark.¹³⁹ Similarly, the Washington Wizards experience in choosing their new team name provides guidance as to what issues teams should consider in avoiding reverse confusion and trademark infringement.¹⁴⁰ Finally, the Indianapolis Colts experience indicates that teams should also consider protecting their legal rights in relation to their former name.¹⁴¹

A. *Trademark Confusion and the Jacksonville Jaguars*

In 1991 the NFL Jacksonville expansion team announced that the team's new name would be the "Jaguars."¹⁴² Soon thereafter, Jaguar Cars, Ltd. filed a federal trademark infringement suit in the Southern

NAGPRA, and suggesting a model ordinance for tribes to help them fulfill their significant duties under NAGPRA); Rennard Strickland, *Implementing the National Policy of Understanding, Preserving and Safeguarding the Heritage of Indian Peoples and Native Hawaiians: Human Rights, Sacred Objects, and Cultural Patrimony*, 24 ARIZ. ST. L.J. 175, 175-76 (1992) (discussing the Native American Graves Protection and Repatriation Act (NAGPRA) and its role in a national policy to preserve Native American and Native Hawaiian heritage).

138. It was not until December 14, 1961, that Redskins owner George Preston Marshall finally ended his segregationist policies, the last NFL owner to do so. See THOMAS BOSWELL ET AL., REDSKINS: A HISTORY OF WASHINGTON'S TEAM 43 (1997).

139. See *Jaguar Cars, Ltd. v. National Football League*, 886 F. Supp. 335 (S.D.N.Y. 1995).

140. See *Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084 (D.N.J. 1997).

141. See *Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club*, 34 F.3d 410 (7th Cir. 1994).

142. See *Jaguar Cars*, 886 F. Supp. at 337.

District of New York alleging, among other things, that Jacksonville's name choice would cause a likelihood of confusion with the company's mark and therefore violated the Lanham Act.¹⁴³ In response, Jacksonville filed for a federal declaratory judgment action, in Jacksonville, arguing that the team name was the result of a fan contest and paid tribute to the fact that Jacksonville's zoo was home to the oldest living Jaguar in North America.¹⁴⁴ In 1995, the Southern District of New York decided it was the proper venue to adjudicate the dispute.¹⁴⁵ Soon thereafter, an apparent settlement was reached with Jacksonville keeping the Jaguar name but redesigning their emblem, and Ford Car Company, the parent corporation of Jaguar Cars, designated the team's official automobile.¹⁴⁶

Trademark infringement is governed by Section 43(a) of the Lanham Act, which provides that:

Any person who, on or in connection with any goods or services, . . . uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.¹⁴⁷

To prevail on a trademark infringement claim under Section 43(a) of the Lanham Act, a plaintiff must establish that: "(1) the marks are valid and legally protectable; (2) the marks are owned by the plaintiff; and (3) the defendant's use of the marks to identify goods or services is likely to create confusion concerning the origin of the goods or services."¹⁴⁸

A plaintiff demonstrates a mark's validity and its legally protectability by showing that the mark is federally registered and has become "incontestable" under the Lanham Act.¹⁴⁹ However, if the mark has not been federally registered, or if a registered mark has not achieved "incontestable" status, then the mark is still valid and legally protectable "if the

143. See Plaintiff's Complaint, *Jaguar Cars, Ltd. v. National Football League*, No. 94-CIV-3529, (S.D.N.Y. May 13, 1994). Jaguar Cars has brought a number of other suits to stop potential infringement of its mark. See, e.g., *Jaguar Cars Ltd. v. Skandrani*, 771 F. Supp. 1178 (S.D. Fla. 1991).

144. See Plaintiff's Complaint, *Jacksonville Jaguars, Ltd. v. Jaguar Cars, Ltd.*, No. 94-537-Civ-J-10 (M.D. Fla., June 2, 1994).

145. See *Jaguar Cars, Ltd. v. National Football League*, 886 F. Supp. 335, 340 (S.D.N.Y. 1995).

146. See *Jaguars Suit Settled*, *NEWSDAY*, Mar. 1, 1995, at A48.

147. 15 U.S.C. § 1125(a)(1) (1994 & Supp. II 1996).

148. *Ford Motor Co. v. Summit Motor Prod., Inc.*, 930 F.2d 277, 291 (3d Cir. 1991) (citing *Opticians Ass'n of America v. Independent Opticians of America*, 920 F.2d 187, 192 (3d Cir. 1990)).

149. See 15 U.S.C. §§ 1058 & 1065 (1994).

public recognizes it as identifying the claimant's 'goods or services and distinguishing them from those of others.'"¹⁵⁰

B. *Standard Confusion and the Polaroid Test*

In choosing a new team name, Pro Football will likely want to retain the vested goodwill that the Redskins mark enjoys as the result of the team's legacy of accomplishments. The Redskins began in 1932 as the Boston Braves, a team that played on Braves Field, in Boston, Massachusetts.¹⁵¹ The team moved in 1933 to Fenway Park and changed their name to the Boston Redskins.¹⁵² In 1937 the team moved to Washington, D.C. The Redskins won NFL Title championships in 1937 and 1942, and won the Super Bowl in 1982, 1987, and 1991.¹⁵³ The Redskins won division championships in 1936, 1937, 1940, 1942, 1943, 1945, 1972, 1982, 1983, 1984, 1987, and 1991.¹⁵⁴

The Redskins can incorporate the team's history into a new name by choosing a new name that evokes and encompasses its impressive history. At the same time, Pro Football can end the use of a name that many in the Native American community consider pejorative. One way to reference the goodwill vested in "Redskins" would be to shorten the name to the "Washington Reds." Washington Reds recalls the history, tradition, and success of the Washington Redskins. In fact, the team could use uniforms they have used in the past, which have an encircled "R" on the helmet instead of the Indian head they currently use.¹⁵⁵

This suggestion is made without the benefit of a trademark search to see if a Reds mark is currently being used or is registered to an entity providing a similar product. In choosing a new name, however, the Redskins would be wise to avoid the difficulties faced by the Jacksonville Jaguars and stay clear of any potential trademark infringement. Therefore, before the name Reds is finalized, it will be necessary to undertake a standard confusion analysis, since the team name Reds is already used by the Cincinnati Reds, a long established Major League Baseball (MLB) team. In fact, the Cincinnati Reds also arrived at their name by shortening their former name—"Redlegs."¹⁵⁶

If Pro Football's new name, Reds, causes confusion with the Cincinnati Reds mark at all, it is likely to be standard trademark confusion, because the Cincinnati Reds' mark is a long established, popularly known mark. Whether or not the name Reds, as used for an NFL team, would create a likelihood of confusion with the Cincinnati Reds' mark should be determined by employing the standard likelihood of confusion, mul-

150. *A.J. Canfield Co. v. Honickman*, 808 F.2d 291, 296 (3d Cir. 1986) (quoting 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 15.1 (2d ed. 1984)).

151. See *NFL Nicknames*, GANNETT NEWS SERVICES, Dec. 16, 1998, available in 1998 WL 5639173.

152. See *id.*

153. See BOSWELL, *supra* note 138.

154. See *id.*

155. See *id.* at 91.

156. See CNN/SI web page, *Historical Baseball Profiles*, (visited on Jan. 5, 1997) <http://cgi.cnn.com/baseball/mlb/historical_profiles/index.NL.teams.html>.

multiple variable test, first established in *Polaroid Corp. v. Polaroid Electronics Corp.*¹⁵⁷

Using the *Polaroid* test, Pro Football should consider the strength of the Cincinnati Reds' mark; the degree of similarity between a Washington Reds mark and the existing Cincinnati Reds mark; the proximity in the marketplace of a professional football team's name and a professional baseball team's name; the likelihood that the owners of the Cincinnati Reds will field a professional football team; the quality of the services and goods offered by Pro Football's football team; and the sophistication of fans of professional football and professional baseball.

Arguably, no likelihood of confusion would exist, as the teams are associated with different professional sports. The Washington Reds would use a different logo than the Cincinnati Reds and would employ the NFL mark, which is distinct from the MLB mark; Pro Football would be choosing the new name in good faith; and professional sports fans are sophisticated and can make distinctions between similar sports marks, as evidenced by the existence of a number of professional teams that share names, such as the National Hockey League (NHL) Jets and the NFL Jets, the NHL Kings and the National Basketball Association (NBA) Kings, the NFL Cardinals, and the MLB Cardinals, and the NFL Giants and the MLB Giants.

While the Reds is but one suggestion, trademark entrepreneurs may want to consider finding a way to register their best guess of what, if anything, the Redskins might choose as their new team name. Such entrepreneurs might find even greater success than the Los Angeles attorney who, in 1979, guessed the Oakland Raiders would win their antitrust suit against the NFL, and took out a state trademark on "Los Angeles Raiders." When the team moved to Los Angeles, the attorney settled the potential trademark infringement for season tickets on the 50-yard line.¹⁵⁸

C. Reverse Confusion and the Washington Wizards

In an ordinary trademark infringement case, the alleged trademark infringer takes advantage of the reputation and good will of a senior trademark owner by adopting a similar or identical mark.¹⁵⁹ In contrast,

157. 287 F.2d 492 (2d Cir. 1961). In *Polaroid*, the court adopted the test of the *Restatement of Torts*, and examined the following eight criteria in determining whether likelihood of confusion existed between two trademarks:

- (1) the strength of the senior mark;
- (2) the degree of similarity between the senior and junior mark;
- (3) the proximity of the products in the marketplace;
- (4) the likelihood that the senior user will bridge the gap, and enter the junior user's market;
- (5) actual confusion between the marks;
- (6) the junior user's good faith in adopting the mark;
- (7) the quality of the junior user's product; and
- (8) the sophistication of the relevant consumers.

Id. at 495.

158. See Lawrie Mifflin & Michael Katz, *Raiding a Name*, N.Y. TIMES, Sept. 14, 1982, at D1.

159. See *Fisons Horticulture, Inc. v. Vigoro Industries, Inc.*, 30 F.3d 466, 473-74, (3d Cir. 1994).

reverse confusion arises when a larger, more powerful entity adopts the trademark of a smaller, less powerful trademark user, thereby causing confusion as to the origin of the senior trademark user's goods or services.¹⁶⁰ Because the junior user is a larger company with greater financial ability and trademark recognition in the marketplace, it can easily overwhelm the senior user by flooding the market with promotion of its similar trademark.¹⁶¹ The strength of the junior user's promotional campaigns leads consumers to believe that the senior user's products derive from that of the junior user or that the senior user is actually the trademark infringer.¹⁶² Consequently, the senior user loses its trademark value and its ability to expand into new markets.

Alleged reverse confusion stemming from renaming a professional sports team was recently examined in *Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.*¹⁶³ Harlem Wizards Entertainment Basketball, Inc. (Harlem Wizards) is a "theatrical basketball organization that performs 'show basketball' in the tradition of the Harlem Globetrotters."¹⁶⁴ In *Harlem Wizards*, the team sought to prevent the Capital Bullets Basketball Club from using the name "Washington Wizards." On February 22, 1996, the Capital Bullets Basketball Club, commonly known as the "Washington Bullets," a member team of the NBA, "publicly announced that beginning with the 1997-1998 NBA season, the team would formally change its name to the 'Washington Wizards'."¹⁶⁵ Founded in 1961, the franchise originated in Chicago where it was first known as the Chicago Packers and later, the Chicago Zephyrs.¹⁶⁶ The team relocated to Baltimore, Maryland in 1963 and became known as the Baltimore Bullets.¹⁶⁷ In 1973, the team moved to Washington, D.C. and changed its name to the Capital Bullets.¹⁶⁸ The following year, the team adopted the name the Washington Bullets.¹⁶⁹ The Bullets changed their name to the Wizards because of concerns that the name "Bullets" had a negative and violent connotation.¹⁷⁰ Soon after the Bullets announced the name change, the Harlem Wizards filed a lawsuit against the Washing-

160. See, e.g., *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 957-61 (7th Cir. 1992) (finding that Quaker Oats Co.'s use of "Thirst Aid" for its product Gatorade infringed on the registered "Thirst-Aid" trademark owned and used by small Vermont beverage company); *Banff, Ltd. v. Federated Dep't Stores, Inc.*, 841 F.2d 486, 491-92 (2d Cir. 1988) (enjoining Bloomingdales Department stores from using mark "B-Wear" on clothing and in its stores because it infringed on the unregistered trademark "Bee-Wear" belonging to smaller women's clothing marketer).

161. See *Fisons*, 30 F.3d at 474-75.

162. See *Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1091 (D.N.J. 1997).

163. See *id.* at 1086.

164. *Id.*

165. *Id.* The NBA, which celebrates its fiftieth anniversary this year, is made up of twenty-nine member teams that play annually against each other from November until June. The league is divided into two conferences, Eastern and Western, and four divisions, Atlantic, Midwest, Central and Pacific. See *id.*

166. See *id.* at 1088.

167. See *id.*

168. See *id.*

169. See *id.*

170. Along with its name change, the Washington Bullets unveiled a new anti-violence initiative that concentrated on Washington, D.C., junior high and middle schools. See *id.*

ton Bullets, alleging that the proposed change infringed the Harlem Wizards' trademark in violation of section 43 of the Lanham Act, The New Jersey Trademark Act, and common law.¹⁷¹

The proof necessary to maintain an action for trademark infringement depends upon whether the goods or services offered by the trademark owner and alleged infringer are competitive or noncompetitive.¹⁷² If the action involves competing goods, "the court need rarely look beyond the mark itself."¹⁷³ In such cases, the court simply analyzes whether the similarity of the marks engenders confusion.¹⁷⁴ In actions where the goods are non-competing, "the similarity of the marks is only one of a number of factors the court must examine to determine the likelihood of confusion."¹⁷⁵ Likelihood of confusion exists if the consuming public assumes upon viewing a mark that the products or service represented by the mark is associated with a different product or service represented by a similar mark.¹⁷⁶ If the goods or services are noncompeting, the court must look beyond the trademark to the nature of the products themselves, and to the context in which they are marketed and sold.¹⁷⁷ The closer the relationship between the products, and the more similar their sale contexts, the greater the likelihood of confusion.¹⁷⁸

In considering a new name and the potential trademark infringement concerns accompanying such new name, the Redskins will also have to weigh the strength of any marks similar to the new name. The stronger any such other mark is, the greater the likelihood of infringement. Trademark law evaluates marks along a continuum of distinctiveness, from the nondistinctive to the inherently distinctive: Marks are (1) generic, (2) descriptive, (3) suggestive or (4) arbitrary, or fanciful.

A generic term functions as the common descriptive name of a class of products and are generally not legally protectable. An example of a generic term that cannot be used as a trademark is the word "chocolate fudge."¹⁷⁹ A descriptive mark immediately conveys a characteristic, ingredient or quality of the article or service it identifies. This type of mark acquires protected status only if the plaintiff can demonstrate that the goods or services have achieved secondary meaning. For example, the mark "Transfer Print" was found to be descriptive for surface decorating machines, related technical machines, material and related technical services to distributors and manufacturers who require designs or words

171. *See id.* at 1086.

172. *See Fisons Horticulture, Inc. v. Vigoro Industries, Inc.*, 30 F.3d 466, 472-73 (3d Cir. 1994).

173. *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 462 (3d Cir. 1983) (finding that if the mark is distinctive or has acquired sufficient secondary meaning, a comparison to the challenged mark is sufficient).

174. *See Fisons*, 30 F.3d at 472-73; *see also Country Floors, Inc. v. Partnership Composed of Gepner and Ford*, 930 F.2d 1056, 1063 (3d Cir. 1991) (applying a similar standard).

175. *Fisons*, 30 F.3d at 473.

176. 3 MCCARTHY, *supra* note 54, § 2301[1].

177. *See Fisons*, 30 F.3d at 473 (quoting *Lapp*, 721 F.2d at 462 (citations omitted)).

178. *See id.*

179. *See, e.g., Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 116 (1938); *A.J. Canfield Co. v. Honickman*, 808 F.2d 291 at 292 (3d Cir. 1986).

placed on their products; therefore, it had likely acquired a secondary meaning.¹⁸⁰

Suggestive, arbitrary and fanciful marks are afforded the highest level of trademark protection.¹⁸¹ A suggestive mark requires the consumer to use imagination, thought or perception to determine the character of the goods or service. The “Taj Mahal,” for example is thought to suggest through imagination an Indian restaurant.¹⁸² Lastly, an arbitrary mark employs terms that do not describe or suggest any attribute of goods or services sold and a fanciful mark uses unfamiliar language coined expressly for the purpose of trademark protection.¹⁸³

Generally, as noted above, likelihood of confusion is determined by the *Polaroid* test, and should be of concern to the Redskins’ decision to change its name.¹⁸⁴ Because of the significant promotion and marketing strength that the Redskins would likely employ to popularize any new name the team would adopt, however, the Redskins will need to be particularly concerned with creating reverse confusion. After concluding that the “Harlem Wizards” mark was suggestive,¹⁸⁵ the court in *Harlem Wizards* applied a modified ten-factor *Polaroid* test to determine whether reverse confusion arises when a team’s new name is confused with an existing mark.¹⁸⁶

180. See *Transfer Print Foils, Inc. v. Transfer Print America, Inc.*, 720 F. Supp. 425, 438 (D.N.J. 1989).

181. See *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979).

182. See *Taj Mahal Enterprises, Ltd. v. Trump*, 745 F. Supp. 240, 251 (D.N.J. 1990) (noting that “Taj Mahal” is suggestive of an Indian restaurant).

183. See *Sunenblick v. Harrell*, 895 F. Supp. 616, 624 (S.D.N.Y. 1995).

184. See *supra* note 157 and accompanying text (discussing the *Polaroid* test).

185. See *Harlem Wizards Entertainment Basketball, Inc. v. NBA Properties, Inc.*, 952 F. Supp. 1084, 1093 (D.N.J. 1997).

186. These factors are:

- (1) the degree of similarity between the owner’s mark and the alleged infringing mark;
- (2) the strength of owner’s mark;
- (3) the price of the goods and other factors indicative of the care and attention expected of consumers when making a purchase;
- (4) the length of time the defendant has used the mark without evidence of actual confusion arising;
- (5) the intent of the defendant in adopting the mark;
- (6) the evidence of actual confusion;
- (7) whether the goods or services, though not competing, are marketed through the same channels of trade and advertised through the same media;
- (8) the extent to which the targets of the parties sales efforts are the same;
- (9) the relationship of the goods or services in the minds of consumers because of similarity of function; and
- (10) other facts suggesting that the consuming public might expect the defendant’s market, or that he is likely to expand into that market.

Harlem Wizards, 952 F. Supp. at 1094. Under the assumption that Pro Football is, or should be, considering renaming the Redskins, the *Harlem Wizards* court’s interpretation and application of these factors bears analysis. See also *Fisons*, 30 F.3d at 473; *Dranoff-Perlstein Assoc. v. Sklar*, 967 F.2d 852, 862-863 (3d Cir. 1992); *Ford Motor Co. v. Summit Motor Prod., Inc.*, 930 F.2d 277, 293 (3d Cir. 1991); *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3d Cir. 1983); *Scott Paper Co. v. Scott’s Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978).

The court first addressed whether the services offered by the parties were similar.¹⁸⁷ In the court's view, this is the dispositive factor regarding the existence of any likelihood of confusion.¹⁸⁸ The court found that although both were "Wizard" marks used by basketball teams, the services offered by the teams show basketball, as opposed to professional basketball, were not sufficiently similar so as to cause a likelihood of confusion.¹⁸⁹ This apparently limits the Redskins concern to other NFL teams, and perhaps teams in other professional football leagues such as the Arena Football League and the Canadian Football League. This proposition is based on the logical analogy that it is hard to imagine any other services that are more similar to each other than professional show basketball is to professional basketball.

The *Harlem Wizards* court ruled that in considering the similarity between two marks, the court must compare the appearance, sound and meaning of the marks, as well as the manner in which they are used.¹⁹⁰ When making such a comparison, the relevant factor is "the overall impression created by the mark as a whole rather than simply comparing the individual features of the marks."¹⁹¹ Marks "are confusingly similar if ordinary consumers would likely conclude that . . . [the products or services] share a common source, affiliation, connection or sponsorship."¹⁹²

The court in *Harlem Wizards* found that in trademark actions involving picture or design marks, similarity of appearance is controlling.¹⁹³ However, similarity is not limited to the eye or ear. The mental impact of a similarity of meaning may be so pervasive as to outweigh any visual or phonetic differences.¹⁹⁴ If two marks create essentially the same overall impression, it is likely that courts will find the two marks confusingly similar.¹⁹⁵ Nevertheless, "similarity of the marks is merely one of the relevant factors, and it is not dispositive on the issue of likelihood of

187. See *Harlem Wizards*, 952 F. Supp. at 1094; see also *Murray v. Cable Nat'l Broadcasting Co.*, 86 F.3d 858, 860 (9th Cir. 1996) (holding that when the court determines that the goods or services are unrelated and confusion is unlikely, the complaint should be dismissed).

188. See *Harlem Wizards*, 952 F. Supp. at 1094.

189. See *id.* at 1095. See also *W.W.W. Pharmaceutical Co., Inc. v. Gillette Co.*, 984 F.2d 567, 573-74 (2d Cir. 1993) (holding that mark "Right Guard," "Sport Stick" for deodorant was found not to be in competitive proximity with mark "Sportstick" used for a lip balm, even though both generally defined as personal care products); *Lang v. Retirement Living Publishing Co., Inc.*, 949 F.2d 576, 584 (2d Cir. 1991) (holding that defendant's use of "New Choices For The Best Years" for a magazine and plaintiff's use of "New Choices Press" for a publishing house was not likely to cause reverse confusion); *Swanson v. Georgetown Collection, Inc.*, No. 94CV-1283, 1995 WL 72717 at *14 (N.D.N.Y. Feb. 14, 1995) (holding that reverse confusion was unlikely between marks "Faraway Friends" for porcelain dolls and Far Away Friends for cloth dolls).

190. See *Harlem Wizards*, 952 F. Supp. at 1096; see also *Taj Mahal Enterprises, Ltd. v. Trump*, 745 F. Supp. 240, 247 (D.N.J. 1990) (citing *Caesars World, Inc. v. Caesar's Palace*, 490 F. Supp. 818, 824 (D.N.J. 1980)).

191. *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 975 (11th Cir. 1983).

192. *Fisons Horticulture, Inc. v. Vigoro Industries, Inc.*, 30 F.3d 466, 477 (3d Cir. 1994).

193. See *Harlem Wizards*, 952 F. Supp. at 1096; see also 3 MCCARTHY, *supra* note 54, § 23.07.

194. See *Harlem Wizards*, 952 F. Supp. at 1096 (quoting 3 J. MCCARTHY, *supra* note 54, § 23.08).

195. See *Ford Motor Co. v. Summit Motor Prod., Inc.*, 930 F.2d 277, 293 (3d Cir. 1991); *Opticians Ass'n of Am. v. Independent Opticians of Am.*, 920 F.2d 187, 195 (3d Cir. 1990).

confusion.”¹⁹⁶ Furthermore, the court found that the use of a design as part of a mark minimizes any likelihood of confusion.¹⁹⁷ The court in *Harlem Wizards* found it significant that the Washington Bullets’ logo would have a unique design and color scheme and would contain the NBA’s distinctive logo.¹⁹⁸ This is also a positive precedent for Pro Football, because a new team name for the Redskins would likely be accompanied by a unique design and color scheme as well as the NFL’s logo.¹⁹⁹

The court in *Harlem Wizards* noted the widely accepted notion that consumers are less likely to be confused about the origin of specific goods or services if the goods are expensive, because the amount of care and attention consumers expend increases proportionately as the price of the desired goods or services increases.²⁰⁰ Moreover, the court found that, generally, NBA fans are sophisticated and knowledgeable; they read about their favorite teams in the sports pages or listen to sports broadcasts and commentary on television and radio. The court concluded, therefore, that it was unlikely that consumers would attend a Harlem Wizards’ game expecting to see NBA basketball or purchase NBA tickets expecting to see the Harlem Wizards perform show basketball. This is also a positive precedent for Pro Football, since NFL tickets are comparably priced to NBA tickets, and NFL fans are similarly knowledgeable of their sport.

Significantly, the *Harlem Wizards* court also noted a distinction in reverse confusion cases regarding the importance of intent in determining the likelihood of confusion. Ordinarily, the relevant intent inquiry in a trademark infringement case involves determining “whether the defendant adopted a mark with the intent of promoting confusion and appropriating the prior user’s good will.”²⁰¹ The court indicated that in reverse confusion cases the intent of a junior user in adopting a mark is less significant in determining infringement, since the junior user does not attempt to “take advantage of the senior’s good will”, but rather “seeks to overwhelm it.”²⁰² The court “identified as a more appropriate inquiry whether the defendant was careless in conducting its trademark name search and in considering the likelihood of confusion with other companies that used similar marks.”²⁰³ The court found no evidence of such carelessness by the Washington Bullets in selecting its new mark or

196. See *Harlem Wizards*, 952 F. Supp. at 1096; *Taj Mahal Enterprises, Ltd. v. Trump*, 745 F. Supp. 240, 247 (D.N.J. 1990).

197. See 3 MCCARTHY, *supra* note 54, § 23.15[5].

198. *Harlem Wizards*, 952 F. Supp. at 1096.

199. Traditionally, the strength of a trademark is dependent on its distinctiveness, or more precisely, its tendency to identify the goods sold under the mark as emanating from a particular, although possibly anonymous, source. See *Taj Mahal*, 745 F. Supp. at 248 (quoting *McGregor-Doninger, Inc. v. Drizzle, Inc.* 599 F.2d 1126, 1131 (2d Cir. 1979)). Note that a mark can be highly distinctive yet still commercially weak if it does not identify goods as emanating from a particular source. See *Harlem Wizards*, 952 F. Supp. at 1097.

200. See *Harlem Wizards*, 952 F. Supp. at 1097; see also *Taj Mahal*, 745 F. Supp. at 248-49; *Restaurant Lutece, Inc. v. Houbigant, Inc.*, 593 F. Supp. 588, 595 (D.N.J. 1984).

201. *Fisons Horticulture, Inc. v. Vigoro Industries, Inc.*, 30 F.3d 466, 479 (3d Cir. 1994) (quoting *W.W.W. Pharmaceutical Co., Inc. v. The Gillette Co.*, 808 F. Supp. 1013, 1042 (S.D.N.Y. 1992)).

202. *Harlem Wizards*, 952 F. Supp. at 1098 (citing *Fisons*, 30 F.3d at 479).

203. *Id.*

in considering the likelihood of confusion with existing marks.²⁰⁴ Therefore, it found no evidence that the Washington Bullets had adopted the name "Wizards" in bad faith.²⁰⁵

Finally, a crucial factor in cases involving non-competitive goods and services is the likelihood that the owner of a mark similar to the Redskins' new name will expand into the Redskins market. This is because one of the "chief reasons for granting a trademark owner protection in a market not his own is to protect his right someday to enter the market."²⁰⁶ In *Harlem Wizards*, the court found that since there was no likelihood that the *Harlem Wizards* planned to play professional competitive basketball, such factor weighed in favor of the Washington Wizards.²⁰⁷

Based on its multi-prong analysis, the court in *Harlem Wizards* concluded that the Washington Bullets' adoption of the Washington Wizards as its new name posed no likelihood of injury to the Harlem Wizards in the marketplace. Therefore, the court dismissed the Harlem Wizards' federal and state law claims. The Harlem Wizards decision is an important and encouraging decision for any professional sports team that might be considering changing its name. In light of this decision, if Pro Football chooses to rename the Redskins, it will need to compare any potential new team name against any existing, protected, similar marks. These comparisons must determine 1) the degree of similarity between the potential new team name and the existing mark; 2) the strength of the existing mark; 3) the care and attention of Redskins fans, and purchasers of the products bearing the existing mark; 4) the actual confusion that might be created between the new team name and an existing mark; 5) whether the goods or services sold under the new team name are marketed through the same channels of trade and advertised through the same media as the products bearing the existing mark; 6) the extent to which the targets of the new team name sales efforts are the same as that of the existing mark; 7) the potential relationship of the goods or services that might occur in the minds of consumers because of similarity of function; and 8) any other facts suggesting that the consuming public might expect the new team name to expand into the existing mark's market.²⁰⁸

D. Retaining Trademark Ownership of a Name No Longer in Use

If the Redskins change the team name, it will want to ensure that it retains the exclusive right to use the mark in the future and the right to bar others from using the mark. In *Indianapolis Colts, Inc. v. Metro-*

204. *See id.*

205. *See id.*

206. *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 464 (3d Cir. 1983).

207. *Harlem Wizards*, 952 F. Supp. at 1098.

208. *See, e.g.*, *Fisons Horticulture, Inc. v. Vigoro Industries, Inc.*, 30 F.3d 466, 473-74 (3d Cir. 1994); *Dranoff-Perlstein Assoc. v. Sklar*, 967 F.2d 852, 862-863 (3d Cir. 1992); *Ford Motor Co. v. Summit Motor Prod., Inc.*, 930 F.2d 277, 293 (3d Cir. 1991); *Lapp*, 721 F.2d at 463; *Scott Paper Co. v. Scott's Liquid Gold, Inc.*, 589 F.2d 1225, 1229 (3d Cir. 1978); *Harlem Wizards*, 952 F. Supp. at 1094.

politan Baltimore Football Club,²⁰⁹ the Seventh Circuit held that a Canadian Football League (CFL) expansion team's name, Baltimore CFL Colts, infringed on a mark owned by a National Football League team—the Indianapolis Colts. In reaching its decision, the Seventh Circuit assessed the issue of trademark abandonment within the context of professional sports teams.²¹⁰

In 1952 the NFL Dallas Texans moved to Baltimore, and changed its name to the Baltimore Colts.²¹¹ The Colts stayed in Baltimore for thirty-two years, until 1984, when the team moved to Indianapolis, causing great outrage and dismay to Baltimore fans.²¹² The Baltimore fans were so upset that the City of Baltimore even tried unsuccessfully to prevent the Colts from leaving through legal action.²¹³ In 1993, one year before the CFL gave its new team the name Baltimore CFL Colts, the NFL failed to renew the federal registration for the mark Baltimore Colts, and the new CFL team attempted to register the mark in its name with the PTO.²¹⁴ Two months later, the Indianapolis Colts filed a trademark infringement suit in an Indiana federal court.²¹⁵ The Indianapolis Colts obtained a preliminary injunction that prevented the CFL team from using the name “Colts,” “Baltimore Colts,” and “Baltimore CFL Colts.”²¹⁶ The Seventh Circuit affirmed the district court's injunction, holding that the district court had not committed error in finding that the CFL team's use of the name Baltimore CFL Colts was likely to confuse a substantial number of consumers.²¹⁷

In *Indianapolis Colts*, the Seventh Circuit found that the Lanham Act defines abandonment as non-use of a mark with intent to not resume such use.²¹⁸ The Lanham Act states:

A mark shall be deemed to be “abandoned” if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Non-use for three consecutive years shall be prima facie evidence of abandonment. “Use” of a mark means the bona fide use of such mark made

209. 34 F.3d 410, 416 (7th Cir. 1994) (affirming preliminary injunction to the Indianapolis Colts).

210. *See id.* at 412-13.

211. *See id.* at 411.

212. *See* Jon Morgan, *Hearing Ends, Ruling Due Monday in Suit over Use of CFL Colts Name*, BALTIMORE SUN, June 25, 1994, at C11.

213. The City of Baltimore unsuccessfully attempted to keep the Colts in Baltimore through its power of eminent domain. *See Indianapolis Colts v. Mayor & City Council of Baltimore*, 733 F.2d 484 (7th Cir. 1984) (staying injunction against City of Baltimore), *vacated and remanded* by *Indianapolis Colts v. Mayor & City Council of Baltimore*, 741 F.2d 954 (7th Cir. 1984), *cert. denied*, *Indianapolis Colts v. Mayor and City Council of Baltimore*, 470 U.S. 1052 (1985).

214. *See* Dave Sottile, *CFL Brings Colts Back to Baltimore: The NFL Denied the Handoff, But the Canadian League Wants to Give the People What They Want*, YORK DAILY REC., Mar. 2, 1994, at 1; *see also* Ken Murray, *Speros Calls the Play: CFL Team Sues the NFL*, BALTIMORE SUN, Mar. 3, 1994, at D8.

215. *See* John R. O'Neill, *NFL Colts Blitzing CFL Colts: NFL Joins Lawsuit Charging Trademark of Name*, INDIANAPOLIS STAR, Apr. 30, 1994, at B1.

216. *Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club*, 34 F.3d 410, 411 (7th Cir. 1994).

217. *See id.* at 416.

218. *See id.* at 414.

in the ordinary course of trade, and not merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark.²¹⁹

In *Indianapolis Colts*, the court ruled that when a trademark is abandoned it returns to the public domain and may be adopted by a new user.²²⁰ However, the court found that in the right circumstances an abandoned mark might well evoke a continuing association with the prior use and user.²²¹ In such circumstances, the court stated, it is the new user's responsibility to take reasonable precautions to prevent consumers from confusing the new mark with the old one.²²² The court found that since the previous user in these circumstances—the Indianapolis Colts—continued to market the same product—professional football—under a similar name, a significant potential for confusion was still present.²²³ The court further found that inserting “CFL” in “Baltimore CFL Colts” was not a sufficiently reasonable precaution to prevent consumers from confusing the new mark with the old one.²²⁴ The *Indianapolis Colts* decision is encouraging for Pro Football. Even if Pro Football chooses to rename the Redskins, under *Indianapolis Colts*, the continuing association with the new team name and the remaining goodwill vested in the old name will likely preclude others from claiming the mark has been abandoned and making unlicensed use of the mark.

219. 15 U.S.C. § 1127 (1994 & Supp. II 1996).

220. See *Indianapolis Colts*, 34 F.3d at 412.

221. See *id.* at 412-13.

222. See *id.*

223. See *id.* at 413.

224. See *id.* at 412.

The question of trademark abandonment in the context of a professional sports franchise was also recently addressed in *Major League Baseball Properties, Inc. v. Sed Non Olet Denarius, Ltd.*, where the Southern District of New York reached the opposite conclusion of the Seventh Circuit.²²⁵ In *Sed Non*, the court rejected the plaintiff's argument that the defendant infringed upon its mark, "Dodgers."²²⁶ The court found that the plaintiff had abandoned the mark "Brooklyn Dodgers" when the team moved to Los Angeles and changed its mark and its name from the Brooklyn Dodgers to the Los Angeles Dodgers.²²⁷ The court stated that the "Brooklyn Dodgers" was a non-transportable cultural institution separate from the plaintiff.²²⁸ Because the plaintiff had abandoned the mark "Brooklyn Dodgers," the court found that the defendant's use of the mark for the name of a restaurant was not a trademark infringement.²²⁹

Unlike other forms of intellectual property law, trademark law generally rests on the principle that the owner must "use it or lose it."²³⁰ The fact that the PTO registers a trademark does not guarantee the mark indefinite protection. For a trademark to retain protection it must be used continuously in more than a de minimis manner. Use requires a mark to be placed on goods, the packaging of goods, or displays associated with the goods or services.²³¹ Absent continuous commercial use, a trademark owner will be subject to claims of warehousing or abandoning the mark.²³² If the owner does continue to use the mark, the right of exclusive use may continue indefinitely, and rights in the mark may be transferred from one party to another. However, trademark rights end and protection terminates when the mark is abandoned or loses its distinctive nature.²³³

225. See 817 F. Supp. 1103 (S.D.N.Y. 1993).

226. See *id.* at 1128.

227. See *id.* at 1127-28.

228. See *id.* at 1128.

229. See *id.* As a result of the ruling in *Sed Non*, the trademark protection of other baseball team names which have not been used in a substantial period of time, such as the following, seems questionable: Boston Beaneaters, Boston Bees, Boston Doves, Boston Red Caps, Boston Rustlers, Brooklyn Bridegrooms, Brooklyn Robins, Brooklyn Superbas, Buffalo Bisons, Chicago Orphans, Chicago White Stockings, Cincinnati Red Stockings, Cleveland Blues, Cleveland Spiders, Detroit Wolverines, Hartford Dark Blues, Houston Colt 45's, Indianapolis Hoosiers, Louisville Colonels, Louisville Grays, Milwaukee Cream Citys, New York Mutuals, Philadelphia Quakers, Pittsburgh Alleghenys, Providence Grays, St. Louis Brown Stockings, St. Louis Maroons, St. Louis Perfectos, Syracuse Stars, Troy Trojans, Washington Statesmen, and the Worcester Ruby Legs. CNN/SI web page, *Historical Baseball Profiles*, (visited Jan. 5, 1997) <http://cgi.cnn.com/baseball/mlb/historical_profiles/index.NL.teams.html>

230. SIEGRUND KANE, *TRADEMARK LAW* 7 (2d ed. 1991).

231. See *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986). Advertisement of goods, absent sale or shipment, may not qualify as "use." See *In re Ancha Elec., Inc.*, 1 U.S.P.Q.2d (BNA) 1318, 1320 (T.T.A.B. 1986); see also *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531, 1551 (11th Cir. 1986) (noting that a trademark owner's renewal of PTO registration is insufficient to rebut presumption of abandonment); *In re Shipley Co.*, 230 U.S.P.Q. (BNA) 691, 693-94 (T.T.A.B. 1986); *In re International Paper Co.*, 153 U.S.P.Q. (BNA) 424, 424-25 (T.T.A.B. 1967).

232. See KANE, *supra* note 230, at 67.

233. See 2 MCCARTHY, *supra* note 54, § 17.05.

A primary defense to trademark infringement is that the owner of the allegedly infringed mark has abandoned use of such mark.²³⁴ Once an owner forfeits its right to a mark, the mark may be claimed and used by the general public. The burden is on the defendant to show the mark has been abandoned, and the court often requires clear and convincing evidence of abandonment.²³⁵ While non-use of a mark for three consecutive years creates a prima facie presumption of abandonment, showing intent to resume use in the reasonably foreseeable future can rebut such presumption.²³⁶ As one court stated, very appropriately for the Redskins' circumstances, it is not the law that "the slightest cessation of use causes a trade-mark [sic] to roll free, like a fumbled football, so that it may be pounced upon by an alert opponent."²³⁷ For a mark to be abandoned the non-use must manifest an explicit intent by the mark's owner to abandon it; mere suspension of use of the mark without the explicit intent to abandon the mark is insufficient.²³⁸ Furthermore, when a mark has residual goodwill, questions of abandonment should be resolved in favor of the mark's owner.²³⁹

Courts have identified uncontrolled mark licensing, the assignment of the mark absent goodwill, and the mark's transition into a generic term as manifestations of abandonment, wherein the mark no longer serves as a symbol of origin or quality.²⁴⁰

As highlighted by *Indianapolis Colts* and *Sed Non*, if Pro Football does choose to rename the Redskins, it will need to take adequate precautions to retain whatever trademark rights remain in the Redskins mark after the resolution of the appeal of the TTAB's decision. Pro Football should use the Redskins mark on goods, packaging or displays, or in some other way make evident that it has not intentionally abandoned the Redskins mark.²⁴¹ Furthermore, as indicated by the general case law regarding trademark abandonment and the *Sed Non* decision, Pro Football should also take steps to ensure that the Redskins mark is not assigned absent goodwill, and that the mark does not become generic.²⁴²

V. CONCLUSION

The TTAB's recent decision has charted new waters, and created a precedent that could affect many potentially disparaging marks. The decision also reflects how trademark law can be used as a powerful social

234. See 2 McCARTHY, *supra* note 54, § 17.01[1].

235. See 15 U.S.C. § 1127 (1994 & Supp. II 1996); see also *Saratoga Vichy Spring Co. v. Lehman*, 625 F.2d 1037, 1044 (2d Cir. 1980).

236. See 15 U.S.C. § 1127; see also KANE, *supra* note 230, at 169.

237. *Continental Distilling Corp. v. Old Charter Distillery Co.*, 188 F.2d 614, 619 (D.C. Cir. 1950) (finding that non-use over a reasonable period of time does not necessarily constitute abandonment).

238. See *Silverman v. CBS, Inc.*, 666 F. Supp. 575, 579 (S.D.N.Y. 1987) (requiring not only acts indicating a practical abandonment, but actual intent to abandon before a mark is declared abandoned); see also *Exxon v. Humble Exploration Co.*, 695 F.2d 96, 102 (5th Cir. 1983).

239. See *Silverman*, 666 F. Supp. at 579.

240. See 2 McCARTHY, *supra* note 54, § 17.02[1].

241. See, e.g., *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986).

242. See 2 McCARTHY, *supra* note 54, at § 17.02[1].

tool. Whether the Federal Circuit will affirm the decision remains to be seen. Meanwhile, if Pro Football decides to rename the Redskins, either as the result of registration cancellation or as an elective goodwill gesture, Pro Football should choose a new team name that does not create a likelihood of confusion, or reverse confusion, between the new name and an existing mark. In avoiding a likelihood of confusion, particularly of reverse confusion, the recent decision in *Harlem Wizards* is a valuable guidepost. One possible new team name that may preserve the goodwill vested in the Redskins mark, and which would likely not be offensive to Native Americans, is "Washington Reds."

If Pro Football does choose to rename the Redskins, it will want to ensure that it does not abandon whatever rights remain in the Redskins mark. Guidance on avoiding trademark abandonment may be found in trademark case law, including the decision in *Indianapolis Colts*.

The Redskins franchise is a storied team that has earned ongoing, significant fan support as a result of good play and sportsmanship. The TTAB's decision will force Pro Football to make a tough decision regarding the Redskin team name; it also raises several interesting trademark issues and provides an opportunity to add to the team's proud legacy.

