THE CANCELLATION OF REDSKINS AS A DISPARAGING TRADEMARK: IS FEDERAL TRADEMARK LAW AN APPROPRIATE SOLUTION FOR WORDS THAT OFFEND?

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INTRODUCTION

Imagine flipping the remote control to your cable sports channel and hearing that the "San Antonio Latinos" were leading the "New York Fighting Jews" fourteen to seven at halftime.[1] Offended? How about attending a "Chicago Blacks" game and watching a halftime show where Caucasians paint their faces black and dance to rap or hip-hop music? What about a "San Francisco Orientals" team that calls its cheerleaders the "Geisha Girls"? Or better yet, what if the mascot's name took on religious significance? How about watching the antics of a mascot for the "Louisiana Lutherans," who chases the opposing team's mascot and tries to nail it to a cross? Offended now? If you are, you may have some inkling of understanding as to why many American Indians[2] are outraged to see symbols of their culture and religion appropriated as mascots and relegated to sideshow entertainment for sports fans.

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1. These fictitious names were printed on pennants and photographed for a poster released by the Minnesota-based National Conference for Community Justice. A photograph of the poster is available at Suzan Shown Harjo, *Chief Offenders*, *at* http://www.nativepeoples.com/np_features/np_articles/1999_summer_article/su99-mascots.html (last visited Oct. 30, 2000). Similar names were also used in the following articles: Ethan G. Zlotchew, *"Scandalous" or "Disparaging"? It* Should *Make a Difference in Opposition and Cancellations Actions: Views on the Lanham Act's Section 2(a) Prohibitions Using the Example of Native American Symbolism in Athletics*, 22 COLUM.-VLA J.L. & ARTS 217 (1998) (citing Richard Cohen, *Redskin Reservations*, WASH. POST MAGAZINE, Apr. 17, 1988, at W7 for inspiration); Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement: How Politically Correct Must a Trademark Be?*, 22 PEPP. L. REV. 7, (1994).

2. The author uses this term throughout the paper to refer to all Native American indigenous peoples with the understanding that it is the preferred term adopted by this group.

Ultimately, these examples still cannot convey what some American Indians feel about a team name like the "Washington Redskins." A team name like the "Louisiana Lutherans" lacks the stigmatic sting of a derogatory term for a minority group.[3] Perhaps one could imagine being a Christian in a Moslem dominated society, or vice-versa, and seeing symbols of his culture and religion, maybe even the crucifixion, appropriated by the majority for entertainment purposes. Imagining this scenario may bring us closer to understanding the outrage felt by many American Indians. But without a lifetime of perspective as a minority, it is difficult, if not impossible, to understand the damage that is done when cultural heritage is misappropriated for the entertainment of the majority.

Those offended by the moniker "Redskins" have tried for years to pressure team ownership to change the name. Protesters drew the most attention to this issue in 1992, when the Redskins played in Superbowl XXVI. The game attracted between two and four thousand protesters who decried the use of the word "redskin(s)" as a team name.[4] This movement carried over after the Superbowl,[5] and protests over the name still occur,[6] but with much less attention from mainstream America. Hardly a week goes by during football season without a sports page editorial in some city denouncing the use of American Indian imagery for team names or sports mascots.[7] Despite all of this criticism, team ownership has consistently refused to con-

3. "What would not be considered disparaging when applied to one group, such as the St. Louis 'Christians,' is much more likely to be noxious to a minority group." Zlotchew, *supra* note 1, at 218.

4. *See* Michael Freeman, *Indians Protesting Use of Redskins*, WASH. POST, Jan. 21, 1992, at D5; *Activists Use the Big Game to Air Views*, LOS ANGELES DAILY NEWS, Jan. 27, 1992, at S8.

5. *See Pre-Game Indian Protest is Kansas City Standoff*, THE BALTIMORE EVENING SUN, Nov. 16, 1992, at 9C (describing a four hour demonstration outside of a Chiefs-Redskins game during the 1992 season).

6. *See* Susan Aschoff, *Protecting Their History and Sharing Their Pain*, ST. PETERSBURG TIMES, Feb. 6, 2000, at 1F (describing a protest that occurred at the January 15, 2000 playoff game between the Tampa Bay Buccaneers and the Washington Redskins).

7. *See, e.g.*, Lawrence R. Baca, *Drop the R-Word*, WASH. POST, Jan. 15, 2000, at A23; Leonard Pitts, Jr., *Derogatory Team Names Foul Native Americans' Dignity*, THE INDIANAPOLIS STAR, Sept. 19, 1999, at J4; Tim Giago (Nanwica Kciji), *Case Against Redskins is Case for Pride*, SEATTLE TIMES, Nov. 24, 1994, at B11.

sider changing the name,[8] and the protests seemed to fall on deaf ears, at least until a creative legal strategy was devised and tested by the legal system in 1999.

In the early 1970s, Suzan Shown Harjo, a member of the Cheyenne tribe, moved with her husband to the District of Columbia where they anxiously attended their first professional football game at R.F.K. stadium.[9] The Harjos were shocked when they saw how American Indians were belittled by the Washington Redskins franchise. While attempting to leave, they unfortunately found themselves the victims of hair-pulling, pointing, and poking from fans who discovered that they were actual American Indians.[10] Since that day, Suzan Harjo has become an outspoken critic of American Indian mascots, eventually receiving the attention of attorney Stephen R. Baird, who convinced her to be the named plaintiff in a novel legal challenge.[11]

In 1992,[12] Harjo and six other American Indian petitioners representing various tribes[13] filed a complaint with the Trademark Trial and Appeals Board[14] seeking to cancel federal registration of the trademark REDSKINS, and all other permutations of the word, under section 2(a) of the Lanham Act. Section 2(a) provides that:

> No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it (a) Consists of or comprises immoral, deceptive, or

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8. *See* Richard Leiby, *Bury My Heart at RFK: How the Redskins Got Their Name, and Why Just Maybe It Should Be Changed*, WASH. POST, Nov. 6, 1994, at F1.

9. *See* Adrienne T. Washington, *Indian Activist Tackles Football*, WASH. TIMES, Apr. 26, 1999, at C4.

10. *See id.* Harjo added, "This is the home team I'd like to root for and hope to in the not-too-distant future under another name." *Id.*

11. *See* Erik Brady, *Indian Nicknames Have Some Seeing Red*, SEATTLE TIMES, May 16, 1999, at E3.

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

13. *See* Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1708–09 (T.T.A.B. 1999). The other petitioners were Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr. *See id.* at 1707.

14. The Trademark Trial and Appeals Board will be referred to as "the Board" throughout the rest of this casenote. In footnote citations, this entity is abbreviated "T.T.A.B."

> scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute . . . .[15]

This complaint became the case of *Harjo v. Pro-Football, Inc.*,[16] the subject of this casenote. The Board announced its decision on April 2, 1999,[17] holding that the marks REDSKINS and REDSKINETTES[18] were disparaging to American Indians within the meaning of section 2(a), and that the marks were no longer entitled to the benefits of federal registration on the Principal Register.[19] The petitioners hoped that this ruling would encourage bootleggers to create unofficial merchandise and that the subsequent loss of revenue for the Washington football team would pressure them to change their name. Thus far, this has not been the case, and the Washington Redskins have appealed to the Court of Appeals for the Federal Circuit where the case is still pending as of this article's publication date.[20]

This casenote argues that the decision of the Board was correct, both in terms of precedent and policy, and that the federal court should uphold the decision. In Part I, this casenote discusses the importance of federal trademark registration and the benefits it provides. Part II examines the history of the word "redskin" and argues that the use of American Indian mascots and team names causes real and immediate damage to American Indian individuals and communities. Part III examines the *Harjo* case in detail, specifically focusing on the substantive doctrine surrounding section 2(a). This section also analyzes the case history applying section 2(a) and argues that the Board decided this case in accordance with previously established doctrine. Part IV.A addresses constitutional issues

15. 15 U.S.C. § 1052(a) (1994).

16. 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999). As mentioned earlier, Harjo refers to Suzan Harjo, the named petitioner of the group of American Indian activists challenging the trademark. "Pro-Football, Inc." is the corporate name of the Washington Redskins professional football franchise.

17. *See id.*

18. The nickname for the Washington football team's cheerleaders. *See id.* at 1707.

19. *See id.*

20. *See* Keri Christ, *When Marks Offend . . . From the Redskins on Back, Decisions Not to Register Marks Mirror the Mores of the Times*, NAT'L L.J., May 31, 1999, at C1.

likely to be considered by the Federal Circuit on appeal, arguing that these constitutional challenges should fail. Part IV.B examines the important policy question of whether it is appropriate for a handful of people to challenge a trademark on behalf of a society that does not seem to share their abhorrence with the mark, arguing that it is an appropriate function of government to protect minorities from disparaging trademarks in this context. Finally, Part V examines how this decision is likely to affect the Washington Redskins, and other sports teams, if it is upheld.

I. THE IMPORTANCE OF FEDERAL REGISTRATION OF A TRADEMARK UNDER THE LANHAM ACT

A trademark is defined in the Lanham Act as "any word, name, symbol, or device, or any combination thereof—(1) used by a person . . . to identify his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods . . . ."[21] In general, a trademark performs four functions for the owner:[22]

> (1) to identify one seller's goods and distinguish them from goods sold by others; (2) to signify that all goods bearing the trademark come from a single . . . source; (3) to signify that all goods bearing the trademark are of an equal level of quality; and (4) as a prime instrument in advertising and selling the goods.[23]

A trademark exists under state common law independently of the Federal Lanham Act,[24] but federal registration on the Principal Register[25] provides several advantages.[26] These ad-

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21. 15 U.S.C. § 1127 (1994).

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

23. J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 3:1B, at 104–05 (2d ed. 1984).

24. *See id.* § 19:4, at 881. The Lanham Act is a federal codification of common law principles that provides some additional benefits to trademark holders. State common law was unaffected by the Act, so there is an independent basis of protection for trademarks under previously existing state law.

25. The other form of registration is in the Supplemental Register, which does not provide the protections of prima facie evidence of exclusive right to use the mark, constructive notice against potential infringers, a status of incontest-

vantages are not otherwise available under state common law.[27] For example, section 22 of the Lanham Act[28] contains a nationwide constructive notice element, which provides that others will be held to have had knowledge of the mark in infringement cases, despite a lack of intentional wrongdoing.[29] Other unique protections provided by registration on the Principal Register include: a provision that makes the trademark incontestable after five years on the Principal Register;[30] a provision that establishes prima facie evidence of ownership and validity of the trademark in case of potential challenges;[31] a provision that guarantees the owner of the mark access to a federal forum for enforcement;[32] and a provision that gives the owner of the mark the right to curb the importation of any goods bearing the mark.[33]

To register a trademark and obtain federal protection under the Lanham Act, the applicant simply files an application with the United States Patent and Trademark Office,[34] where it is reviewed by an examining attorney.[35] To obtain registration on the Principal Register, a trademark examiner must determine that two threshold requirements are met: (1) the mark must be "used in commerce"[36] and affixed to goods sold or transported in commerce;[37] and (2) the mark must not violate

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ability after five years, or a basis to stop importations of infringing goods in the United States. *See id.* § 19:8A, at 887.

26. *See id.* § 19:5, at 883.

27. *See id.* § 19:5, at 883–84.

28. 15 U.S.C. § 1072 (1994).

29. The owner of the mark does not have to prove culpability on the part of the infringing party, only that the mark is sufficiently similar to the owner's and that the owner's was registered first. *See* Zlotchew, *supra* note 1, at 221.

30. *See* 15 U.S.C. § 1065 (1994). However, incontestable status does not make the mark immune to challenges under section 2(a) of the Lanham Act. *See id.* § 1052(a). Cancellation can be initiated at any time if the source of the goods or services is being misrepresented under 15 U.S.C. § 1064(3), or if the mark becomes generic, was obtained fraudulently, or does not comply with 15 U.S.C. §§ 1054 or 1052(a), (b), or (c).

31. *See id.* § 1057(b).

32. *See id.* § 1121.

33. *See id.* § 1124.

34. *See id.* § 1051(a)(1).

35. *See id.* § 1062(a) (1994).

36. *Id.* § 1051.

37. *See id.* § 1127. For a discussion of the necessary qualifications for registration on the Principal Register, see MCCARTHY, *supra* note 23, § 19:6, at 884–85.

the provisions of section 2 of the Lanham Act.[38] If the trademark application is rejected, the applicant may reply or amend her application,[39] or she may appeal to a federal administrative body known as the Trademark Trial and Appeal Board.[40] At this point, an applicant still denied registration can appeal this determination to the U.S. Court of Appeals for the Federal Circuit or have her case heard *de novo* by a federal district court.[41] If registration is granted, however, all the benefits of federal registration are immediately available for a period of ten years, with an option for successive ten-year renewal periods.[42]

The Lanham Act allows any person who "believes that he is or will be damaged by the registration" to petition for cancellation of a mark registered on the Principal Register.[43] The cancellation procedure allows a party to remove the mark from the Principal Register after it has been registered, even though the Trademark Examiner was satisfied with the application and no party opposed the trademark at the time of registration.[44] The petition for cancellation is heard by the Trademark Trial and Appeal Board.[45]

If a cancellation action is commenced within five years of registration, one who opposes the mark may cancel it if she believes she is damaged for any of the reasons available to the initial examiner.[46] After the five-year period has passed, canceling a trademark becomes more difficult. At this time, cancellation proceedings may only be initiated if a mark has become generic, has been abandoned, was obtained through

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38. *See* 15 U.S.C. § 1052. Section 2(a) of the Lanham Act is what the word "redskin" was held to have violated in this case.

39. *See id.* § 1062(b).

40. *See id.* § 1070.

41. *See id.* § 1071(a)–(b).

42. *See id.* §§ 1058(a) & 1059(a).

43. *Id.* § 1064.

44. *See* MCCARTHY, *supra* note 23, § 20:12, at 1048. As this leading treatise on trademark describes it:

> [t]o successfully prosecute a petition for cancellation, petitioner must plead and prove two basic elements: (1) that it has standing to petition to cancel in that it is likely to be damaged by the registration; and (2) that there are valid grounds why the registration should not continue to be registered.

Id. The petition need only contain a "short and plain statement" showing how the petitioner will be damaged, "stating the grounds for cancellation," and naming the responding party. *Id.* § 20.12, at 1049.

45. *See id.* § 20:12(A), at 1048.

46. *See* 15 U.S.C. § 1064.

fraud, or should never have been granted because of the Lanham Act's content-based prohibitions contained in sections 2(a)–(c).[47]

Under section 2(a), the content-based prohibition used by the petitioners in this case, a trademark will be refused registration if it "[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute."[48] If there is some question that the mark could be considered "scandalous" or "disparaging" under section 2(a), the Patent and Trademark Office will usually permit the mark to pass for publication and allow "interested members of a composite of the general public who consider the mark to be scandalous to bring opposition proceedings."[49]

Because there is no provision for class actions in the Lanham Act, marks can only be canceled under section 2(a) by a petition of individual offended parties willing to name themselves as plaintiffs.[50] Suzan Shown Harjo became the named petitioner for this case in an effort to cancel registration of the trademark REDSKINS and other permutations of the word. The petitioners argued that REDSKINS was both "scandalous" and "disparaging" within the meaning of section 2(a) and, therefore, did not meet the requirements for registration on the Principal Register.[51]

II. WHAT'S IN A NAME?

Those unfamiliar with the cause of Suzan Harjo often fail to understand what it is about the word "redskin" that outrages her. One newspaper writer described attending a pep rally and watching Ms. Harjo almost weep when an American Indian team mascot "skipped through the crowd," waving to the fans with a cheerful "Howdy, howdy, howdy," before stopping in

47. *See id.* § 1064(3).

48. *Id.* § 1052(a). Cancellation is referred to as the "second backstop" to the examiner's initial decision. *See* MCCARTHY, *supra* note 23, § 20:12, at 1048.

49. Ritchie v. Simpson, 170 F.3d 1092, 1094 (Fed. Cir. 1999) (citing *In re* Mavety Media Group Ltd., 33 F.3d 1367, 1371 (Fed. Cir. 1994)).

50. *See* Bromberg v. Carmel Self Serv., Inc., 198 U.S.P.Q. 176, 179 (T.T.A.B. 1978).

51. *See* Harjo v. Pro-Football Inc., 50 U.S.P.Q.2d 1705, 1708 (T.T.A.B. 1999).

front of her to ask her if she was having a good time.[52] Only upon witnessing the effect of the team name on Ms. Harjo did the reporter understand how damaging it could be to a minority to see her culture and religion turned into a spectacle.[53] This section describes why the word "redskin" is so offensive to American Indians and examines the damaging effects of using American Indian mascots.

A. The Appropriation of American Indians in Trademarks

As of the date this article was published there were 154 federally registered trademarks that use the word "Cherokee," 59 that use the word "Navajo," and 481 that refer to the "Sioux," "Dakota," or "Lakota."[54] Because of the historically unique minority status of American Indians in the United States, the appropriation of these names as trademarks for entertainment purposes hardly seems appropriate. Since the inception of the United States of America, American Indians have been treated differently than any other group in history. They are acknowledged as sovereign nations within our borders for some purposes, yet they are simultaneously subjected to segregation and discrimination similar to other minority groups. Their status is unique under the United States Constitution,[55] where no other group was given similar treatment "via the treaty-making power."[56] Their unique place in American culture was furthered by the Indian Reorganization Act of 1934,[57] which allowed for self-governance on reservations with

52. Courtland Milloy, *Suddenly Perceiving the 'R-Word' in a Whole New Light*, PORTLAND OREGONIAN, Jan. 15, 2000, at C9, *available in* 2000 WL 5368199.

53. *See id.* at C9.

54. *See* USPTO, *Official Gazette of the United States Patent & Trademark Office*, http://www.uspto.gov (last modified Feb. 22, 2001). In 1998, there were 94 registered trademarks that used the word "Cherokee," 35 that used the word "Navajo," and 208 that referred to the "Sioux," "Dakota," or "Lakota." *See* Terence Dougherty, *Group Rights to Cultural Survival: Intellectual Property Rights in Native American Cultural Symbols*, 29 COLUM. HUM. RTS. L. REV. 355, 376 (1998) (citing Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse*, 27 CONN. L. REV. 1003, 1008 n.19 (1995)).

55. U.S. CONST. art. I, § 2, cl. 3. This section was replaced by the Fourteenth Amendment, which retains the exception for "Indians not taxed" in calculating representation in the House. U.S. CONST. amend. XIV, § 2.

56. Dougherty, *supra* note 54, at 365.

57. 48 STAT. 935 (1934) (codified as amended at 25 U.S.C. § 465 (1994)).

their own courts and legal system.[58] This unusual legal status also led to a relative social isolation from mainstream American society, rather than the inclusion and absorption that most other groups eventually experience.[59] This isolation has made American Indians an easy group from which to appropriate names and symbols, and an easy group to misunderstand or misrepresent by using these names and symbols inappropriately. Commentators have argued that "[t]his misuse, when considered in conjunction with the particular problems that Native American communities face, links claims of cultural appropriation to group cultural survival."[60]

Many activists argue that misappropriation of these symbols results in significant harm to American Indian communities, essentially alienating individuals from their own culture by blurring the line between cultural reality and commercialism.[61] Consistently representing a minority group as an outdated, objectified symbol, such as a mascot, can have detrimental effects on societies that are still very much alive and often struggling to survive. The sorts of images that render "native people as inhuman, timeless, and essentialized . . . help promote the myth of the vanishing Indian and in so doing, deprive Indians not just of their history but of their present reality."[62]

Appropriating American Indian dress, dance, and tradition and using them for purely entertainment purposes has a particularly deleterious effect because it trivializes the very basis of many cultural and religious beliefs.[63] Billy Mills, a Lakota motivational speaker and former Olympic gold medal winner, has compared the appropriation of American Indian ceremony,

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58. *See* Dougherty, *supra* note 54, at 365.

59. This point is valid for comparative purposes only. The author in no way intends to minimize the struggles of other minority groups or the importance of individual ethnic cultures in the United States today.

60. Dougherty, *supra* note 54, at 376.

61. *See generally* Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse*, 27 CONN. L. REV. 1003 (1995); Dougherty, *supra* note 54. "Invisible to a certain extent as political actors, Native American people are in effect disenfranchised by this use of their cultural symbols." Dougherty, *supra* note 54, at 377.

62. Newton, *supra* note 61, at 1010–11.

63. "Long before names and mascots defined the debate, Native Americans used sports not merely as games, but as worship and to prepare for hunting and for war." *The Native American Sports Experience* (ESPN television broadcast, Nov. 16, 1999) [hereinafter *ESPN*].

spirituality, and religion to prostitution.[64] Thus, American Indian team names and mascots create a unique harm that is not at all analogous to the effects of appropriating other cultural groups for sports teams. Names like the "Cowboys," "Vikings," or "Fighting Irish" do not have comparable effects because the history of each of these groups is one of inclusion and survival, rather than exclusion and potential cultural extinction.

As correlative proof of these dehumanizing effects, the petitioners in the *Harjo* case presented evidence to the Trademark Trial and Appeals Board that depression among American Indians "is reflected in the suicide rate among Native American adults and adolescents, which is three times greater than among the general population; and that, among Native American children, the suicide rate is five times greater than among children in the general population."[65] Although it is difficult to trace a direct link between suicide rates and sports mascots, this statistic indicates that native societies in the present day are particularly vulnerable and often have difficulty reconciling their culture with the modern world. In addition, the use of such names and mascots leads to a de facto exclusion of American Indians from many sports events, simply because they may wish to avoid exposure to a misuse of their culture or religion.[66] These damaging effects have led many activists to attack the use of American Indian names and symbols in ways that misrepresent their culture, particularly sports names and mascots that many find offensive.

64. "I think when they address the face painting, or they do their drumming, or they do their chants, the painting was ceremonial, tied in with the spirituality, with the religion of the people. And to do that in fun is prostituting it." *Id.*

65. Harjo v. Pro-Football Inc., 50 U.S.P.Q.2d 1705, 1727 (T.T.A.B. 1999).

66. *See* Note, *A Public Accommodations Challenge to the Use of Indian Team Names and Mascots in Professional Sports*, 112 HARV. L. REV. 904, 910 (1999) (stating that "[a]lthough Indians are not physically barred or denied service, the manner in which they are served is nonetheless discriminatory because team names and mascots cause harm and lead to exclusion by maintaining an intimidating environment").

B. American Indian Team Names and Mascots in Sports

Of the many sports teams, on both the professional and amateur levels, to adopt American Indian mascots,[67] none has been considered as offensive as the Washington Redskins. This team has consistently been at the forefront of the most bitter attacks by American Indian activists[68] because of the particularly derogatory origin of the name. As the petitioners in the *Harjo* case alleged, the word originates from a time when bounty hunters roamed the land, collecting rewards for killing native men, women, and children.[69] Rather than requiring a head, those who placed the bounty would accept a scalp; rather than requiring a body, they would accept a "redskin." There is, however, some debate as to whether this origin of the word is accurate.[70] Whether or not it is true, it is difficult to argue that the word "redskin" itself is not pejorative in nature. Dictionary definitions of the word "redskin" are usually accompanied with the same warning that accompanies the word "nigger."[71] As studies of popular culture have concluded, "in popular films and literature, the word 'redskin' had been preceded by such adjectives as 'savage,' 'bloodthirsty,' 'heathen,' 'thieving,' 'dirty,' 'drunken,' etc."[72]

The oft-cited counter-argument to the American Indian mascot controversy is that the team names and logos were chosen out of respect for native cultures, not as derogatory terms.[73] The Redskins franchise has consistently argued that the name

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67. "Five professional sports teams currently have American Indian names and mascots: the Atlanta Braves, Chicago Blackhawks, Cleveland Indians, Kansas City Chiefs, and Washington Redskins." *Id.* at 904.

68. *See, e.g.*, Freeman, *supra* note 4; Baca, *supra* note 7; Pitts, *supra* note 7; Milloy, *supra* note 52.

69. *See* Leiby, *supra* note 8, at F1.

70. *See id.* at F4. "Most white historians do not believe, as Suzan Harjo, Sen. Campbell and many other Indians do, that 'redskins' originated in the bounty hunter trade." *Id.*

71. *See, e.g.*, THE AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 1514 (3d ed. 1992). "*n. Offensive Slang.* Used as a disparaging term for a Native American." *Id.* The same dictionary also defines the word "nigger" as "*n. Offensive Slang* . . . Used as a disparaging term for a Black person." *Id.* at 1222.

72. Leiby, *supra* note 8, at F1.

73. For example, Blair Atcheynum, a right wing for the "Chicago Blackhawks" and the only American Indian to currently play for a major league team with an American Indian logo, takes pride in the "Blackhawk" name and logo, seeing it as a sign of respect for his people. *See* ESPN, *supra* note 63.

was not adopted as a pejorative word, but as a term of respect.[74] According to the granddaughter of George Preston Marshall—the former owner of the franchise who adopted the name "Redskins"—the name was chosen to honor the coach of the team, William "Lone Star" Dietz, a half-German Sioux.[75] Many point out that it simply "makes no sense to say that a team would intentionally give itself a name that it considered derogatory."[76] This argument, however, ignores the fact that the word "redskin" has never had the effect of honoring American Indians. Our society does not normally excuse racially offensive comments simply because of "good intentions," nor do we tolerate repetition of the offense. Even if the majority fails to understand the harm of the word "redskin," the perspective of the minority group maligned by the team name should be given more weight than the impressions of the majority.[77]

Although the Redskins are aware that a significant minority finds their use of the names "Redskins," "Skins," and "Redskinettes" offensive, both the old and new owners have refused to change the team name.[78] The Redskins, however, have made efforts to avoid using the team name and logo in a manner that could be considered pejorative. In the *Harjo* case, Jack Kent Cooke, another former owner of the Redskins, testified that a set of parameters adopted during a joint advertising campaign

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74. *See* Leiby, *supra* note 8, at F1. Ms. Harjo responds to this argument: "'They keep trying to mesmerize me into being honored,' she said. 'It's like they want to grab us by the throat and say, Are you honored yet? Why are you not honored?'" Brady, *supra* note 11, at E3 (internal quotation marks omitted).

75. *See* Leiby, *supra* note 8, at F4. It should also be noted that commentators have considered Marshall "a stone-cold racist, refusing to employ blacks until forced to do so by the federal government in 1961. But Indians, they weren't a problem." *Id.*

76. Jendi B. Reiter, *Redskins and Scarlet Letters: Why "Immoral" and "Scandalous" Trademarks Should Be Federally Registrable*, 6 FED. CIR. B.J. 191, 206 (1996).

77. For an example of a minority perspective, consider what one newspaper staff writer wrote about a collection of memorabilia with misappropriated Indian imagery owned by Suzan Harjo, the named petitioner in this case: "On display are cheap rubber tomahawks, cardboard headdresses given to whiny kids in restaurants, and pictures of cartoonish sports team mascots, including Chief Illiniwek of the University of Illinois. His image also appears on toilet paper, 'which I think is a real honor,' Harjo says acidly." Leiby, *supra* note 8, at F4.

78. Ironically, new owner Daniel Snyder was more than happy to change the name of the stadium's location from Raljon (which was an amalgam of the names of the former owner's sons, Ralph and Jon) to Landover, because a few hundred Landover residents were offended that their community had been renamed. *Jockbeat*, VILLAGE VOICE, Sept. 28, 1999, at 181.

with the McDonald's fast-food chain remain the standard today.[79] These parameters require that all "use of 'the Redskins name, logo and image'" be "Reserved and Tasteful," not involve use of caricatures, not involve use of "Indian Costumes or Headdresses," not use war chants or other "Derogatory Indian Language," use film and photography that is "Beneficial to the Redskins' Image," and not employ "Insulting" or "Smart-Elect (sic) Language or Humor."[80] Despite these guidelines, the very use of the words "Redskins," "Skins," and "Redskinettes" is so insulting to certain people that they have done everything in their power to convince the Washington football team to abandon its logo.[81]

III. *HARJO V. PRO-FOOTBALL INC.*: IS THE TRADEMARK "REDSKINS" DISPARAGING TO AMERICAN INDIANS?

For years, American Indian activists have attempted, with limited success, to convince the public that the word "redskin" is a derogatory and offensive term that has no place as a team name for a professional sports franchise.[82] In addition to these attempts, American Indian logos have faced several legal challenges over the years.[83] These challenges have been made under Title VI of the Civil Rights Act,[84] under state pupil anti-

79. *See* Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1709 (T.T.A.B. 1999).

80. *Id.* at 1728.

81. There are countless newspaper articles available describing protests and editorials condemning the use of American Indian logos and mascots. *See, e.g.*, Milloy, *supra* note 52, at C9; Aschoff, *supra* note 6, at 1F.

82. *See generally* Laurel R. Davis, *Protest Against the Use of Native American Mascots: A Challenge to Traditional American Identity*, 17 J. SPORT & SOCIAL ISSUES (no. 1) 9, 11–12 (1993) (describing the protest that occurred outside of the 1992 Superbowl in Minneapolis in which the Redskins participated); *Pre-Game Indian Protest*, *supra* note 5 (describing a 1992 protest at a Chiefs-Redskins game); Aschoff, *supra* note 6 (describing a January 5, 2000 protest at a Redskins playoff game, the most recent protest as of the writing of this casenote). While only a few activists actively campaign against American Indian team names and mascots, these opinions are representative of opinions shared by much larger groups. In the *Harjo* opinion, the court ultimately recognized that "redskins(s)" was considered a derogatory term by a significant portion of the population, as demonstrated through survey evidence. *See Harjo*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999).

83. *See supra* note 82; *infra* note 84.

84. *See* Danile J. Trainor, *Native American Mascots, Schools, and Title VI Hostile Environment Analysis*, 1995 U. ILL. L. REV. 971 (discussing a discrimination attack on federally funded programs).

discrimination law,[85] and through legislative attempts to deny stadium funding.[86] Some have argued that Title II of the Civil Rights Act of 1964, which provides for "full and equal enjoyment"[87] of all places of public accommodation, may provide a means of restricting team logos, although this theory has yet to be tested.[88] However, the only legal attack to meet with legitimate success has been to seek cancellation of a trademark as "scandalous" or "disparaging" under section 2(a) of the Lanham Act.[89]

Originally, the only marks canceled in section 2(a) opposition proceedings were "predominantly risqué or vulgar depictions of bodily functions."[90] Recently, the scope of section 2(a) has expanded with cases like *Bromberg v. Carmel Self Service, Inc.*,[91] which allowed for the cancellation of a restaurant's slogan, "Only a Breast in the Mouth is Better Than a Leg in the Hand,"[92] based on the petition of a few women who purported to speak for their entire gender. Since that case, section 2(a) has been available as a tool for a small minority[93] to challenge federal registration of a trademark when they find it offensive.

In the *Harjo* case, the petitioners, each an active member of a different federally recognized Indian tribe,[94] asserted "that the word 'redskin(s)' 'was and is a pejorative, derogatory, deni-

85. *See* Munson v. State Superintendent of Pub. Instruction, 577 N.W.2d 387 (Wis. Ct. App. 1998).

86. *See generally* 139 CONG. REC. 15,214–16 (1993) (statement of Sen. Campbell); Cathy L. Claussen, *Ethnic Team Names and Logos—Is There a Legal Solution?*, 6 MARQ. SPORTS L.J. 409, 414 (1996).

87. 42 U.S.C. § 2000(a) (1994).

88. *See* Note, *supra* note 66. This theory has not yet been tested in a court of law. *See id.*

89. 15 U.S.C. § 1052(a) (1994). As stated in the introduction, this is the approach that the petitioners took in *Harjo v. Pro-Football, Inc.*, hoping that cancellation of its trademarks would create enough financial pressure for the team to change its mascot, name, and logo. *See, e.g.*, Victoria Slind-Flor, *Redskins Ruling Could Hurt Others*, NAT'L L.J., Apr. 19, 1999, at B1; Washington, *supra* note 9, at C4.

90. Reiter, *supra* note 76, at 192.

91. 198 U.S.P.Q. 176 (T.T.A.B. 1978).

92. *Id.* at 177.

93. Courts, however, seem to treat the issue differently if the registrant is actually a member of the group that is purported to be offended. In *In re Condas S.A.*, the Patent and Trademark Office allowed the registration of the word "Jap" because the potential owner of the mark was actually Japanese. *See* 188 U.S.P.Q. 544 (T.T.A.B. 1975).

94. *See* Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1709 (T.T.A.B. 1999).

grating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for a Native American person.'"[95] The petitioners presented evidence relating to both the etymology of the word "redskin" and the public perception of the word. As part of the etymological evidence, the petitioners demonstrated that the word rarely appeared in formal writings, even those that regularly employed the terms "uncivilized" and "savages" when describing American Indian peoples.[96] In addition, a linguistics expert testified that lexicographers have considered the word disparaging from the 1960s onward, and that "redskin" is rarely used in the press "because it is 'a loaded pejorative term.'"[97] The petitioners also offered the testimony of a history expert who described the word "redskin" as "'an artifact of an earlier period during which the public at large was taught to believe that American Indians were a backward and uncivilized people.'"[98] In terms of popular culture, the petitioners presented evidence that when the word "redskin" was used in Western films, it was "often coupled with negative adjectives such as 'dirty,' or 'lying'; or that the word is used in the context of violence, savagery, or dishonesty."[99]

In addition, the Board considered survey evidence indicating that the word "redskin" was considered offensive by 46.2% of the general public, more than any American Indian term besides "injun" (49.5%).[100] The petitioners also offered personal testimony of incidents when the word "redskin" was used in their presence in a derogatory manner,[101] a resolution by the National Congress of American Indians condemning the word "redskin,"[102] and similar statements from other minority groups.[103]

95. *Id.* at 1708 (quoting from the petitioner's complaint).

96. *See id.* at 1720.

97. *Id.*

98. *Id.* at 1726.

99. *Id.* at 1732.

100. *See id.* at 1733. Other high ranking words included "squaw" (36.2%) and "buck" (36.5%). *See id.* Although the word "squaw" is often used as a synonym for woman, it actually means "vagina" in Algonquian and Iroquoian. *See* Leiby, *supra* note 8, at F1. The word "buck" came to refer to American Indian men during the bounty hunting days as well, when a "redskin" "was worth roughly the same as a deer's pelt, or buckskin." *Id.*

101. *See Harjo*, 50 U.S.P.Q.2d at 1723.

102. *See id.* at 1725.

103. *See id.* at 1724–25.

In making its decision, the Board divided the section 2(a) analysis into separate determinations of whether the marks were scandalous[104] or disparaging.[105] Part A of this section examines the case law regarding whether a trademark is "scandalous" within the meaning of section 2(a), confirming that the Board was correct in determining that REDSKINS is not scandalous. Although this determination did not ultimately affect the Board's decision to cancel the mark, analysis of the case law regarding scandalous marks is important because these doctrines often overlap with the question of disparagement. Part B examines the doctrine of disparagement and argues that the Board's decision that REDSKINS is "disparaging" to American Indians is also consistent with prior case law.

A. *Scandalousness*

The first substantive issue considered by the Board was whether the mark "comprise[d] immoral, deceptive, or scandalous matter."[106] Academics have divided cases considering the scandalous issue into two separate approaches taken by reviewing bodies:[107] (1) the "Rule of Association"[108] approach; and (2) the "Anti-Contextual Approach," or the "Per Se Rule."[109]

The first approach, the "Rule of Association," acknowledges that a mark is not scandalous on its face, but it may become scandalous when placed in a certain context. For example, the mark MADONNA is perfectly legitimate as a registration for a pop music star.[110] But when placed on a bottle of wine, the mark is considered scandalous because of the potential relig-

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104. *See id.* at 1748.

105. *See id.* at 1740. The case also contains a brief discussion of a third element, whether "the challenged registrations consist of or comprise matter . . . which may bring Native Americans into contempt or disrepute." *Id.* at 1748. The court merely incorporates its discussion of disparagement to determine that the word "Redskin" may result in bringing Native Americans into contempt or disrepute. *See id.* Therefore, the discussion of this element is omitted from this casenote.

106. 15 U.S.C. § 1052(a) (1994).

107. A trademark decision may be made by an administrative body or a federal court.

108. *See* Zlotchew, *supra* note 1, at 226.

109. *See id.* at 228.

110. *See* U.S. Trademark Reg. No. 1,473,554 (1988).

ious significance.[111] In making this determination, the court[112] deciding this case noted in its decision that "consideration ordinarily must be given to the goods upon which the mark is used."[113]

The Board has followed this associative approach in other cases, such as in *In re Reemtsma Cigarettenfabriken*,[114] where it refused to register the mark SENUSSI. Registration was not refused because the mark was scandalous on its face, but instead because it was placed on a brand of cigarettes. "Senussi" is the name of a Moslem sect that forbids its members from using tobacco.[115] *Cigarettenfabriken* is often contrasted with *In re Waughtel*,[116] where the Board allowed registration for cigars with an AMISH mark because most Amish men actually smoked and there was no religious prohibition against the habit. The distinction to be drawn between the two cases is that where the association between the mark and the goods is offensive, registration will be refused; where the resulting association is innocent, registration is allowed.

A somewhat controversial use of this approach occurred more recently in *In re Old Glory Condom Corp.*,[117] in which the Board held that a condom designed to look like the stars and stripes did not result in a scandalous association. Instead, the Board held that practicing safe sex could legitimately be portrayed as a patriotic duty.[118] Although the association between the product and the mark was a bit unconventional, it was not scandalous within the meaning of section 2(a). This case is also indicative of the fine, and often unpredictable, distinctions drawn by adjudicative bodies answering the inherently subjective question of whether or not a mark is scandalous. In cases adopting the "Rule of Association" approach, an otherwise in-

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111. *See In re* Riverbank Canning Co., 95 F.2d 327, 328 (C.C.P.A. 1938). This case was not actually decided under the Lanham Act, but rather the 1905 Trademark Act. However, it still used the "scandalous" language, and the analysis used here has been employed by courts interpreting the Lanham Act.

112. This case was decided by the United States Court of Customs and Patent Appeals (C.C.P.A.), a predecessor court to the Court of Appeals for the Federal Circuit.

113. *Riverbank*, 95 F.2d at 328.

114. 122 U.S.P.Q. 339 (T.T.A.B. 1959).

115. *See id.*

116. 138 U.S.P.Q. 594 (T.T.A.B. 1963).

117. 26 U.S.P.Q.2d 1216 (T.T.A.B. 1993).

118. *See id.* at 1221.

nocent term may be considered scandalous because of its context, or an otherwise offensive mark may be registered because of its innocent context.[119]

The second approach adopted by reviewing bodies is the "Per Se Rule."[120] Under this approach, a reviewing body need not look at the context of the mark; the only question is whether the mark is scandalous on its face. This approach is evidenced by the case of *In re Tinseltown*,[121] where the Board held that the mark BULLSHIT was scandalous per se. As one could imagine, the fact that the mark appeared on fashion accessories did not influence the court one way or the other.[122] The association between the mark and the goods did not make the mark any more or less scandalous. This approach was also used in the case of *In re McGinley*,[123] in which the court held that a photograph of a nude man and woman in an embrace was scandalous because the posing of the figures slightly exposed the man's genitalia. By contrast, in *In re Thomas Laboratories*,[124] the Trademark Board found that the cartoon of a predominantly naked man looking down at his genitalia was not scandalous per se. The case can be distinguished from *McGinley* by the fact that this was a cartoon, rather than an actual photograph, and that a viewer could not actually see the genitalia in the cartoon.[125] Again, the determination was made looking solely at the mark itself and had nothing to do with the fact that the mark was attached to a penis-enlargement device.

119. Similarly, in *Ex parte Martha Maid Mfg. Co.*, 37 U.S.P.Q. 156 (Comm'r Patents 1938), the court held that the mark "Queen Mary," while innocent enough on its face, took on a scandalous meaning when associated with women's undergarments. Likewise, the court in *In re Runsdorf*, 171 U.S.P.Q. 443 (T.T.A.B. 1971) held that the mark "Bubby Trap" was considered scandalous when associated with bras, because it offended enough of the public in this context. While these cases may be a bit dated when it comes to public sensibilities, they still illustrate the associative approach. A more modern example can be found in *In re Hepperle*, 175 U.S.P.Q. 512 (T.T.A.B. 1972), where the Board allowed the registration of the mark "Acapulco Gold" for suntan lotion. The issue with the term was that it was often used as slang for marijuana, but the Board held that, in the context of suntan lotions, it was more likely to inspire thoughts of warm beaches than of illegal substances.

120. *See* Zlotchew, *supra* note 1, at 228.

121. 212 U.S.P.Q. 863 (T.T.A.B. 1981).

122. *See id.* at 865.

123. 660 F.2d 481 (C.C.P.A. 1981).

124. 189 U.S.P.Q. 50 (T.T.A.B. 1975).

125. *See id.* at 52.

Under this line of reasoning,[126] which is more appropriate when looking at a mark such as REDSKINS,[127] the question of whether or not a mark is scandalous is answered by looking at the mark on its face and ignoring the context. As the results of these cases suggest, decisions under this approach are even more subjective and unpredictable than the "Rule of Association" approach. Without the association between the mark and the goods to ground its reasoning, an adjudicative body is essentially asked to make a purely subjective determination of whether a mark is offensive. The distinctions drawn in these cases are subtle, if not outright conflicting, with considerable discretion resting on the shoulders of the factfinder.

In *Harjo*, the Board adopted the "per se" approach of *McGinley*.[128] Thus, whether or not the mark was scandalous was determined by looking at the mark in isolation; the fact that REDSKINS is attached to a football team is irrelevant. The "per se" test looks at whether the mark gives "offense to the conscience or moral feelings; exciting reprobation, [or] calling out condemnation."[129] This substantive test followed by many adjudicative bodies was based solely on a dictionary definition of the word "scandalous."[130] As a point of reference, the Board looked at whether the mark was scandalous "from the standpoint of not necessarily a majority, but a substantial composite of the general public."[131] In this case, the Board's in-

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126. Another example of this line of reasoning can be found in *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d 1635 (T.T.A.B. 1988). The Board looked at the mark on its face to determine that a picture of a defecating dog and its fresh feces was scandalous. *See id.*

127. *See* Zlotchew, *supra* note 1, at 230. The fact that "Redskins" refers to a professional football franchise does not make it any more or less disparaging. *See id.*

128. *See* Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1735 (T.T.A.B. 1999).

129. *In re* McGinley, 660 F.2d 481, 486 (C.C.P.A. 1981) (quoting WEBSTER'S NEW INTERNATIONAL DICTIONARY (2d ed. 1942)). The court does not purport to be choosing between an "association" approach or a "per se" rule in making this decision, however. This distinction has been used by academics but not explicitly in case law. Nevertheless, the distinction will be useful when analyzing how this ruling may affect other sports franchises. *See id.*

130. Which dictionary to use is not an issue that has been litigated, but the Board has chosen to use dictionary definitions contemporary to 1946, when the Lanham Act was adopted. *See id.* at 486, n.11.

131. *Id.* at 485. In terms of the level of proof required, "the threshold for objectionable matter is lower for what can be described as 'scandalous' under Section 2(a) than for 'obscene' . . . ." *Id.* at 485 n.9. Thus, marks that are protected

quiry into whether REDSKINS was scandalous followed a two-step analysis. First, it looked at "the likely meaning of the matter in question," and second, whether "the matter is scandalous to a substantial composite of the general public."[132]

In applying the first part of the test, which requires determining the likely meaning of the word REDSKINS, the Board concluded that the respondent's marks "clearly carrie[d] the allusion to Native Americans."[133] However, when looking at the second prong of the test, the Board determined that the petitioners did not establish, by a preponderance of the evidence, that:

> the word "redskin(s)," in the marks herein and in connection with the identified services, 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."[134]

In essence, the Board looked at the dictionary definition of "scandalous" and determined that REDSKINS was not offensive to a substantial composite of the general public under this definition. The Board found that the mark REDSKINS had taken on a strong secondary meaning that the general population associated with the professional football franchise, rather than considering it a scandalous or pejorative term.[135] Even if a mark is not scandalous, however, it may still be canceled under section 2(a) of the Lanham Act if it is found to be disparaging to a specific group, as it was in this case.

B. Disparagement

Although the case law surrounding scandalousness is hardly clear, it is even more difficult to divine a clear doctrine for disparagement due to a dearth of case law discussing the

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by the First Amendment may still be deemed unregisterable. *See* Reiter, *supra* note 76, at 191.

132. *Harjo*, 50 U.S.P.Q.2d at 1748.

133. *Id.*

134. *Id.* at 1748–49 (quoting *In re Mavety Media Group Ltd.*, 31 U.S.P.Q.2d 1923, 1925 (1994)) (alterations in original).

135. *See Harjo*, 50 U.S.P.Q.2d at 1749.

subject.[136] In addition, courts have often blurred or ignored the distinctions between scandalous and disparaging,[137] making the law of scandalousness relevant in this context as well. The predominant difference between the two analyses is that disparagement depends upon the mark's relation to a certain subject,[138] which under the Lanham Act may be "persons, living or dead, institutions, beliefs or national symbols."[139] For example, in *Doughboy Industries, Inc. v. The Reese Chemical Co.*,[140] the court held that an anti-venereal medication with the mark DOUGHBOY and a picture of a soldier was disparaging to World War I soldiers because that name was often used to refer to soldiers.[141]

Because the focus of the harm has been narrowed to a certain group of people, the relevant audience to whom the mark must be considered offensive is also more narrow than in the scandalousness determination. Rather than being constrained by the perceptions of a substantial composite of the general public, as is the case when considering whether a mark is scandalous, the Board in *Harjo* pointed out that:

> [i]n determining whether or not a mark is disparaging, the perceptions of the general public are irrelevant. Rather, because the portion of Section 2(a) proscribing disparaging marks targets certain persons, institutions or beliefs, only the perceptions of those referred to, identified or implicated

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136. *See* Zlotchew, *supra* note 1, at 230; *see also Harjo*, 50 U.S.P.Q.2d at 1737.

137. *See* Zlotchew, *supra* note 1, at 230.

138. *See id.* at 231; *see also In re* Anti-Communist World Freedom Congress, Inc., 161 U.S.P.Q. 304, 305 (T.T.A.B. 1969) (holding that a logo of a hammer and sickle with a large "X" over it disparaged the national symbol of the Soviet Union); *In re* Waughtel, 138 U.S.P.Q. 594, 595 (T.T.A.B. 1963) (holding that the mark "Amish" on a cigar and the picture of an Amish man smoking a cigar did not disparage Amish beliefs because they did not prohibit smoking); *In re* Reemtsma Cigarettenfabriken, 122 U.S.P.Q. 339 (T.T.A.B. 1959) (holding that the mark "Senussi" as a cigarette does disparage the beliefs of a Moslem sect that forbids smoking).

139. 15 U.S.C. § 1052(a) (1994). If a mark is scandalous, it is scandalous regardless of whether or not it relates to a person, institution, belief, or national symbol. Disparagement depends upon this relationship.

140. 88 U.S.P.Q. 227 (T.T.A.B. 1951).

141. *See id.* at 228.

> in some recognizable manner by the involved mark are relevant to this determination.[142]

With this perspective in mind, the Board once again focused on "'ordinary and common' meaning"[143] by using the word "disparage" according to the dictionary definition, and described the applicable test as whether "such matter may dishonor by comparison with what is inferior, or may slight, deprecate, degrade, or affect or injure by unjust comparison."[144]

Once again, the Board framed its analysis as a two-step inquiry. First, it asked, "[w]hat is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the services identified in the registrations?"[145] In answering this question, the Board quickly determined that although the mark REDSKINS had acquired a strong secondary meaning as the name of a professional football organization, it was obvious that the word still referred to American Indians.[146] The second, and more substantial, inquiry is whether the meaning is "one that may disparage Native Americans?"[147]

With regard to this question, the Board initially noted that there was not enough evidence to conclude that the two logos used by the respondents, a spear design and a profile portrait of an American Indian, were disparaging toward American Indians.[148] However, the Board did conclude that "the word 'redskin,' as it appears in respondent's marks in those registrations and as used in connection with the identified services, may disparage Native Americans, as perceived by a substantial composite of Native Americans."[149] The Board reached this conclusion based "on the cumulative effect of the entire record,"[150] including the results of a survey that indicated how the public

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142. Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1739 (T.T.A.B. 1999) (quoting *In re* Hines, 31 U.S.P.Q.2d 1685, 1688 (T.T.A.B. 1994), *vacated on other grounds*, 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994) (finding the mark "Budda [sic] Beachwear" to be disparaging based on its depictions of Buddha)).

143. *Id.* at 1737.

144. *Id.* at 1738.

145. *Id.* at 1740–41.

146. *See id.* at 1742.

147. *Id.* at 1741.

148. *See id.* at 1743.

149. *Id.*

150. *Id.*

perceived the word, dictionary evidence regarding the connotation of the word "redskin," and the linguistics evidence about the pejorative meaning of the word "redskin" throughout history and as used in the media.[151]

IV. "UPON FURTHER REVIEW": WAS THIS THE RIGHT CALL?

This section of the casenote considers two important questions about the use of section 2(a) of the Lanham Act for this particular purpose. Part A considers whether section 2(a) represents an unconstitutional infringement on free speech by imposing an unconstitutional condition on federal registration of a trademark, arguing both that section 2(a) does not represent an unconstitutional condition and that the doctrine of unconstitutional conditions is inappropriate in this context. Part B considers whether allowing a small minority to speak for society as a whole in determining which trademarks are "scandalous" or "disparaging" is good public policy, and argues that it is appropriate for the government to protect minorities from disparaging trademarks in cases like *Harjo*.

A. *Is Section 2(a) of the Lanham Act Constitutional?*

Whenever the government takes an action against a specific party based on the content of some form of speech, First Amendment[152] issues are naturally implicated. It is unclear, however, whether these concerns are justified when it comes to the cancellation of a federally registered trademark under the Lanham Act. By allowing cancellation of the mark REDSKINS through use of the Lanham Act, some fear that Congress is essentially preventing sports teams from using American Indian logos.[153] The common response to such fears is that the federal government has not actually prevented the party whose mark was canceled from using the mark; the government is simply choosing not to grant the mark the additional protections pro-

151. *See id.* at 1743–47; discussion *supra* Part III.

152. *See* U.S. CONST. amend. I.

153. *See* Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?*, 4 SPORTS L.J. 65, 68 (1997).

vided by federal registration.[154] Thus, section 2(a) is clearly not a direct restraint on speech, but merely a condition imposed on applicants seeking to attain the benefits of federal registration. However, the cancellation of a mark has significant consequences and the imposition of such conditions on registration may still implicate constitutional issues.

Canceling registration of a trademark leads to the removal of federal benefits and advantages that make the intellectual property more valuable to the owner.[155] Although section 2(a) only prevents access to the benefits of federal registration, rather than taking away a right to use the mark,[156] it may still be subject to the doctrine of "unconstitutional conditions."[157] Under this doctrine, "Congress is restrained from achieving indirectly what it cannot constitutionally achieve directly."[158] Because Congress could not act directly in requiring the Washington Redskins to abandon their logo, the argument is that they are likewise forbidden from doing so through indirect action, such as canceling their trademark.

The response to this argument, in terms of constitutional law, is that trademarks are entitled to less protection under the First Amendment because they are considered a form of commercial speech.[159] In fact, until 1975, commercial speech was not entitled to any First Amendment protection.[160] Usually, First Amendment doctrine requires that the restriction on speech be categorized as content-neutral, content-based, or viewpoint-based for purposes of determining what level of scru-

154. *See, e.g.*, Reiter, *supra* note 76, at 200; Dougherty, *supra* note 54, at 381.

155. *See* Lee, *supra* note 153, at 69; discussion *supra* Part I.

156. *See* discussion *supra* Part I.

157. *See* Lee, *supra* note 153, at 68.

158. Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 693 (1993). This author, of Dorsey & Whitney, Minneapolis, Minn., is also the principal attorney for the petitioners in *Harjo*.

159. *See* Lee, *supra* note 153, at 70. The Supreme Court has found that commercial speech is afforded less protection than other constitutionally protected speech. *See* Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n of New York, 447 U.S. 557 (1980) *reh'g denied*, 439 U.S. 883 (1978).

160. *Compare* Valentine v. Chrestensen, 316 U.S. 52 (1942) (holding that the First Amendment did not prevent the government from placing restraints on commercial advertising), *with* Bigelow v. Virginia, 421 U.S. 809 (1975) (holding that a commercial advertisement for abortion services could not be found criminal because the commercial was entitled to some First Amendment Protection).

tiny to apply to the government's restrictions.[161] However, the analytical framework changes when the restriction is placed on commercial speech. Where commercial speech is involved, intermediate scrutiny is always applied[162] and content-based regulations that are usually impermissible for other forms of speech may be allowed.[163] Beginning in *Central Hudson Gas & Elec. Corp. v. Pub. Serv. Comm'n of New York*,[164] the United States Supreme Court has applied a three-prong test for determining whether restrictions on commercial speech are constitutional. First, however, a court will have to determine that the commercial expression is not false, deceptive, or misleading, and does not propose an illegal transaction in order to qualify for any First Amendment protection.[165] Once this initial inquiry is satisfied, the court will look at whether the restriction satisfies each prong of the test: (1) the governmental interest must be substantial; (2) the regulation on speech must further that interest directly; and (3) the regulation must not be any more broad than is necessary to serve that interest.[166]

As an initial matter, it must be determined that trademarks are indeed a form of commercial speech. Commercial speech is defined as that which proposes a commercial transaction.[167] In 1979, in the case of *Friedman v. Rogers*,[168] the Supreme Court recognized that a trade name is a form of commercial speech, and that it is entitled to less protection under the First Amendment. That case held that with trade names comes the risk that an unscrupulous businessperson could use the name to deceive consumers as to the nature and quality of services.[169] Because of this risk, the Court found that the State has a substantial interest in protecting the public from commercial harms, and that this interest outweighs the First

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161. *See* Jeffrey Lefstin, *Does the First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665 (2000).

162. *See* Central Hudson Gas & Elec., 447 U.S. at 564.

163. *See id* at 564 n.6.

164. 447 U.S. 557 (1980).

165. *See id.* at 566. The REDSKINS mark is clearly not false or misleading, and it does not propose any sort of illegal transaction. Therefore, the analysis in the text will simply look at the three main prongs of the *Hudson* test, ignoring this initial inquiry.

166. *See id.* at 563–66.

167. *See* Virginia State Bd. of Pharmacy v. Virginia Citizens Consumers Council, Inc., 425 U.S. 748, 762 (1976).

168. 440 U.S. 1 (1979).

169. *See id.* at 12–13.

ity of section 2(a) on its face because the Supreme Court has held that the overbreadth doctrine does not apply as strongly to commercial speech as it does to regular speech.[176] Instead, the relevant inquiry is whether section 2(a) was constitutionally applied when the Board canceled the mark REDSKINS.[177] In the *Harjo* case, the government has a far more compelling interest for restricting speech: preventing racial unrest. The Sixth Circuit recognized this as a substantial governmental interest in *Sambo's Restaurants, Inc. v. City of Ann Arbor*.[178] The many protests sparked every year by the name "Redskins," such as the demonstration that occurred outside of the 1992 Superbowl in Minneapolis,[179] provide evidence of continuing racial unrest. The most recent of such protests to receive national media attention was the January 15, 2000 protest at the Washington playoff game in Tampa Bay.[180]

Another substantial governmental interest that may be asserted is the interest in ensuring cultural survival. Critics have argued that the appropriation of American Indian symbols for team names and mascots have helped to depict this as a culture of the past, inflicting serious and immediate harm on a minority group.[181] One could argue that the federal registration of disparaging trademarks makes the government an accomplice to the unwanted commercialization of a culture, and that the government has a substantial interest in disassociating itself from such activities. This argument should suffice to satisfy the first prong of the *Hudson* test.

Once it is determined that the government has a substantial interest in imposing the section 2(a) prohibitions to registration, then the last two prongs of the *Hudson* test are easily satisfied by this case. The cancellation of the REDSKINS

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176. *See* Bates v. State Bar, 433 U.S. 350, 380–81 (1977); *see also* Village of Schaumburg v. Citizens for a Better Env't, 444 U.S. 620, 632 n.7 (1980) (citation omitted) ("For the purposes of applying the overbreadth doctrine, however, it remains relevant to distinguish between commercial and noncommercial speech.").

177. *See* Peel v. Attorney Registration and Disciplinary Comm'n, 496 U.S. 91, 119 (1990) (White, J., dissenting) (stating that when the overbreadth doctrine is inapplicable, a showing of unconstitutional application is required).

178. 663 F.2d 686, 695 (6th Cir. 1981) (holding that preventing racial unrest may be a substantial governmental interest, but speculation as to the name "Sambo's" effect was not enough to satisfy the burden of proof here).

179. *See* Davis, *supra* note 82, at 14–15.

180. *See* Aschoff, *supra* note 6.

181. *See* discussion, *supra* Part II.A.

Amendment right to use a trade name.[170] The same analysis applies to trademarks. With trademarks, there is a similar risk that a mark could be used to deceive consumers as to the nature and quality of goods, and there is a similar State interest in protecting the public from such commercial harms. Therefore, it is appropriate to consider trademarks as a form of commercial speech for constitutional purposes.

The most difficult prong of the *Hudson* test to satisfy is the first prong, finding a substantial governmental interest in the restriction on speech. Some have argued that section 2(a) of the Lanham Act is not a legitimate restriction on speech because the government lacks a substantial interest to refuse federal protection to scandalous or disparaging marks.[171] The State interest most commonly asserted to justify the restriction is that the government does not want to place a stamp of approval on a mark that is considered scandalous or disparaging.[172] Unfortunately, courts have made it particularly easy to attack this justification by explicitly stating that granting registration of a trademark is not the government's award of its imprimatur on the mark.[173] Likewise, the governmental interest in saving money does not suffice because registration is not funded by the government, but rather paid for by the registration fees of the trademark holders.[174] To further complicate matters, there is constitutional precedent holding that speech that is merely offensive cannot be prohibited, even if it is only commercial speech.[175]

In applying the *Hudson* test to determine the constitutionality of section 2(a), one should not focus on the constitutional-

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170. *See id.* at 15.

171. *See generally* Lee, *supra* note 153; Lefstin, *supra* note 161; Reiter, *supra* note 76.

172. *See* Baird, *supra* note 158, at 674.

173. *See In re* Old Glory, 26 U.S.P.Q.2d 1216, 1220 n.3 (T.T.A.B. 1993). This claim is bolstered by the fact that obscene works are still eligible for copyright protection. *See* Reiter, *supra* note 76, at 200; *see also* Mitchell Brothers Film Group v. Cinema Adult Theater, 604 F.2d 852 (5th Cir. 1979). In addition, obscenity cannot be asserted as a defense to infringement. *See* Jartech, Inc. v. Clancy, 666 F.2d 403, 406–08 (9th Cir. 1982).

174. *See* Lee, *supra* note 153, at 72.

175. *See* Carey v. Population Serv. Int'l, 431 U.S. 678, 695 n.18 (1980) (holding that it is unconstitutional to prohibit the advertising of contraceptives merely because some parties are offended); Bolger v. Young Drug Products, 463 U.S. 60, 71–72 (1983) (holding that it is unconstitutional to prohibit the mailing of constitutional products).

trademark directly furthers the government's interest in preventing racial unrest and in disassociating itself from an activity harmful to minorities, satisfying the second prong of the test. Section 2(a) only allows for the cancellation of certain marks that are specifically found to be offensive, making it difficult to argue that the application of the Lanham Act has been overbroad, satisfying the third part of the *Hudson* test. Of course, this analysis applies only to the prohibition of REDSKINS as a disparaging mark. There is still some question as to whether the government has a substantial interest in preventing the registration of scandalous marks in general, or the registration of disparaging marks in other, less compelling contexts.[182]

However, these attacks on section 2(a) all depend upon whether a court would find that the doctrine of unconstitutional conditions applied in the first place. The Supreme Court has recently held that the doctrine of unconstitutional conditions involves situations where the "Government has placed a condition on the *recipient* of the subsidy rather than on the particular program or service, thus effectively prohibiting the recipient from engaging in the protected conduct outside of the scope of the federally funded program."[183] Thus, because the applicant can still use the name "Redskins" without the program of federal trademark registration, there is a strong argument that the doctrine of unconstitutional conditions simply does not apply in this situation.[184] Even though courts have stated that federal registration of a trademark is not equivalent to the government's "imprimatur" on the mark,[185] this does not change the basic nature of federal registration. The federal government is conferring a benefit on the registrant for the convenience of enforcing the mark; refusing to register the mark does not preclude the owner from using the mark or impede the use of the mark in the same manner as other cases that have been cited by critics of section 2(a).

The only time the constitutionality of section 2(a) has been significantly litigated was in the case of *In re McGinley*,[186] in

182. *See, e.g.*, Ritchie v. Simpson, 170 F.3d 1092, 1098 (Fed. Cir. 1999); Bromberg v. Carmel Self Serv., Inc., 198 U.S.P.Q. 176 (T.T.A.B. 1978).

183. Rust v. Sullivan, 500 U.S. 173, 197 (1991).

184. *See* Baird, *supra* note 158, at 696.

185. *See In re* Old Glory, 26 U.S.P.Q.2d 1216, 1220 n.3 (T.T.A.B. 1993).

186. 660 F.2d 481 (C.C.P.A. 1981).

which the court[187] upheld the constitutionality of section 2(a) for the very reasons argued above: denial of registration does not prevent an applicant from using a trademark. However, many critics argue that this case dealt with the First Amendment issue in an insufficient and superficial manner.[188] The decision never dealt with the critical First Amendment principle that speech does not have to be proscribed, only abridged or sufficiently chilled, for a violation to exist.[189] While persuasive, the *McGinley* decision ultimately leaves too many questions unanswered to provide any definitive conclusions.

The holders of the Washington REDSKINS trademark tried to raise constitutionality as an issue at several points in the proceedings, though always unsuccessfully.[190] In a preliminary decision, the Board heard the registrant's arguments that petitioners' claims should be barred because section 2(a) is overbroad, and that it should be considered void for vagueness.[191] Although these arguments were intended as affirmative defenses, the Board recognized them as attacks on the constitutionality of section 2(a) and refused to consider them because the issue was beyond the Board's authority: "An administrative tribunal such as the Trademark Trial and Appeal Board has no authority to declare provisions of the Lanham Act unconstitutional."[192] The constitutional rule is that administrative agencies and non-Article III tribunals do not have the power to declare a statute unconstitutional.[193] If it had decided

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187. This case was decided by the Court of Customs and Patent Appeals, which is one of the predecessor courts of the Federal Circuit. *See* Lefstin, *supra* note 161 at 676.

188. *See generally*, Pace, *supra* note 1, at 48; Theodore H. Davis, Jr., *Registration of Scandalous, Immoral, and Disparaging Matter Under §2(a) of the Lanham Act: Can One Man's Vulgarity be Another's Registered Trademark?*, 83 TRADEMARK REP. 801, 832–33 (1993); Baird, *supra* note 158, at 685–86.

189. *See* American Communications Ass'n v. Douds, 339 U.S. 382, 402 (1950), *reh'g denied*, 339 U.S. 990 (1950).

190. *See* Harjo v. Pro-Football, Inc., 30 U.S.P.Q.2d 1828, 1832–33 (T.T.A.B. 1994); Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1710 (T.T.A.B. 1999).

191. *See Harjo*, 30 U.S.P.Q.2d at 1832–33; *see also* Baird, *supra* note 158, at 678 (arguing that because "scandalous," "immoral," and "disparaging" are not defined in section 2(a), they should be considered "void for vagueness" because they constitute a denial of due process).

192. *Harjo*, 30 U.S.P.Q.2d at 1833. The T.T.A.B. cannot decide constitutional issues because it is an administrative creation, not an Article III court. *See In re* ETA Systems Inc., 2 U.S.P.Q.2d 1367, 1370 n. 4 (T.T.A.B. 1987).

193. *See* U.S. CONST. art. III, §§ 1–2; *In re* ETA Systems Inc., 2 U.S.P.Q.2d at 1370 n. 4.

the issue, it seems unlikely that a court would find section 2(a) void for vagueness, even though the definitions of "scandalous," "immoral," and "disparaging" are less than clear. As defined in *Grayned v. City of Rockford*,[194] the "void for vagueness" doctrine is most applicable in situations where statutes prohibit conduct and subject offenders to prosecution.[195] Under the Lanham Act, conduct is only subject to administrative and civil penalties.

At another point in the proceedings, the holder of the mark argued that the Board was not proceeding from a viewpoint-neutral perspective as mandated by the First Amendment[196] because it considered whether the mark was disparaging from the perspective of American Indians. If the Board had agreed with the registrant, it essentially would have ruled counter to nearly every decision regarding disparaging matter under section 2(a), since a determination of disparagement depends upon the perspective of a maligned party.[197] In addition, the evidence in *Harjo* indicated that 46.2% of the general population polled—not just American Indians—answered that the word "redskin" was offensive to them.[198]

If the constitutional issue is fully argued in the Federal Circuit, the court should hold that this application of section 2(a) is constitutional for either of the two main reasons argued above. First, trademarks are only commercial speech, entitled to limited protection, and this application of section 2(a) fur-

194. 408 U.S. 104 (1972).

195. *See id.* at 108–09; *see also* Baird, *supra* note 158, at 682.

196. *See* Sons of Confederate Veterans, Inc. v. Glendening, 954 F. Supp. 1099 (D. Md. 1997) (holding that the state inappropriately took the view of those who were offended by the possible racial connotations of the confederate flag when the Motor Vehicles Administration revoked license plates with that image).

197. *See* discussion *supra* Part III.C. The Redskins also argued that the petitioners should be required to prove their case through "clear and convincing" evidence because of the implicated constitutional issues, which the Board likewise rejected because of its inability to consider a constitutional issue. *See Harjo*, 50 U.S.P.Q.2d at 1735 n.90. At least one critic has argued that section 2(a) may constitute an unconstitutional taking under the Fifth Amendment. *See* Lee, *supra* note 153, at 77 (pointing out that there may be a taking of intellectual property under *Ruckelhaus v. Monsanto Co.*, 467 U.S. 986, 1002–05 (1984), but acknowledging that this is a much more tenuous argument than other constitutional issues). However, this seems highly unlikely since refusing to grant federal registration can hardly be considered a denial of all economically viable use of the property under the Supreme Court's holding in *Lucas v. South Carolina Coastal Council*, 505 U.S. 1003 (1992). In any event, it does not appear that this issue was even argued by the registrants in this case.

198. *See Harjo*, 50 U.S.P.Q.2d at 1733.

thers a substantial governmental interest. Second, the doctrine of unconstitutional conditions should not apply to this situation at all because a trademark does not involve the receipt of a subsidy, but the application of a service.

B. Does This Application of Section 2(a) Make for Appropriate or Desirable Public Policy?

Although the application of section 2(a) to *Harjo* is constitutional and the law surrounding "scandalous" and "disparaging" marks was applied correctly, there remains the important question of whether this type of government prohibition on the content of trademarks is appropriate or desirable as a matter of public policy. In this particular case, the petitioners are attempting to apply financial pressure to the registrants by making it impractical to maintain the name "Redskins." There is nothing unusual about attempting to induce change by applying financial pressure to a large organization, but this is usually accomplished through public protests and boycotts. Section 2(a) essentially allows a minority group[199] to apply that same financial pressure with the assistance of government action, without the burden of having to convince a majority of society that the trademark is inappropriate or offensive. The minority group need not allege a particular harm, but only that they have a "real interest" in the outcome of whether the registration should be granted.[200] This simple standing requirement has been notoriously easy to satisfy.[201] In *Harjo*, the Board found that the petitioners had unquestionably satisfied the requirement in a hearing several years earlier.[202] The lenient

199. There is no class action provision in the Lanham Act, so marks canceled under section 2(a) are done so through the petition of individual offended parties. *See* Bromberg v. Carmel Self Serv., Inc., 198 U.S.P.Q. 176, 179 (T.T.A.B. 1978).

200. *See* Universal Oil Prod. Co. v. Rexall Drug & Chem. Co., 463 F.2d 1122, 1123 (C.C.P.A. 1972).

201. *See, e.g.,* Ritchie v. Simpson, 170 F.3d 1092, 1098 (Fed. Cir. 1999) (holding that the petitioner had standing to challenge the marks "O.J. Simpson," "O.J.," and "The Juice" because they "possess a connotation such that the marks are offensive to him as a Christian, family man" and for himself, and others who have signed his petitions, the marks "are scandalous, denigrate their values, encourage spousal abuse and minimize the problem of domestic violence"); *Bromberg*, 198 U.S.P.Q. 176 (allowing a small group of women to challenge a restaurant slogan that they believed was offensive to all women).

202. *See Harjo*, 30 U.S.P.Q.2d at 1830.

standing requirements of section 2(a) challenges have led some to argue that "a handful of courts and the [Patent and Trademark Office] should not presume to impose a hypothetical national standard of offensiveness where no cultural consensus exists."[203]

But is section 2(a) really an effort by the government to legislate morality? The two rationales that are most often offered to support the policy of section 2(a) are the "waste of government resources" theory and the "implied imprimatur" theory.[204] As stated earlier, courts have rejected the "implied imprimatur" theory,[205] making it difficult to rely on it for support. However, even if granting federal registration does not amount to a stamp of approval on the trademark, it does not necessarily follow that the government should be required to register a trademark that a substantial portion of the public may find objectionable. The "waste of government resources" theory has similarly lost some of its persuasive force because the registration process is now funded by the applicant's fees.[206] Thus, the traditional justifications for section 2(a) appear unpersuasive.

There is also a significant policy concern that the application of section 2(a) has been inconsistent in the past. Unfortunately, inconsistency is difficult, if not impossible, to avoid because the determination of whether a mark is scandalous or disparaging is inherently subjective in nature.[207] As Stephen Baird, the attorney for Suzan Harjo argues, "[s]ubjectivity breeds unpredictability, and the absence of predictability in this area of the law is easily illustrated by a comparison of those marks denied federal registration under section 2(a) with those marks published . . . ."[208] For example, in *In re Runsdorf*,[209] the Board held that the mark BUBBY TRAP was scandalous when used in connection with women's underwear because one dictionary defined the word "bubby" as a vulgar way

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203. Reiter, *supra* note 76, at 204.

204. *See id.* at 193.

205. *See In re* Old Glory Condom Corp., 26 U.S.P.Q.2d 1216, 1220 n.3 (T.T.A.B. 1993); *see* discussion *supra* Part IV.A.

206. *See* Lee, *supra* note 155, at 72.

207. *See In re* Hershey, 6 U.S.P.Q.2d 1470, 1471 (T.T.A.B. 1988) (acknowledging "that a determination that a mark is scandalous is necessarily a highly subjective one").

208. Baird, *supra* note 158, at 669.

209. 171 U.S.P.Q. 443 (T.T.A.B. 1971).

of referring to a woman's breast.[210] However, the Board has approved registration of the marks "Hooters"[211] and "Hooter Patrol"[212] for clothing designs. Critics have pointed out that:

> the pattern of cases decided under the "immoral" and "scandalous" clause of Section 2(a) shows that whether a mark is registrable will depend on an unpredictable mix of factors, including judges' opinions of the product, their reaction to sexual, racial, and religious innuendo, and the feelings of individuals who have no standing to represent the general public.[213]

The use of section 2(a), while still inconsistent in application, has expanded from simply prohibiting registration of indecent images[214] to protecting the interests of minority groups who are particularly sensitive to certain issues. This expansion has led some to argue that because "some are viewing it as an opening for government management of our political dialogue, section 2(a)'s constitutional validity and political desirability are even more questionable."[215]

Admittedly, the application of section 2(a) has been inconsistent and unpredictable to say the least. But this admission does not lead to the inevitable conclusion that it should be jettisoned from the Lanham Act. As with all subjective judgments in the law, early doctrine is more abstract and unpredictable before focusing into a more narrow set of workable

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210. *See id.* at 443–44.

211. *See* U.S. Trademark Reg. No. 1,590,973.

212. *See* U.S. Trademark Reg. No. 1,544,529. The Board also granted the registration of "Big Pecker Brand" T-Shirts, concluding that the public could find the mark to be an innocuous reference to a bird design. *See In re* Hershey, 6 U.S.P.Q.2d at 1471–72. In the religious context, in *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653 (T.T.A.B. 1990), the Board overturned an Examiner's denial of a registration for "Moonies" as attached to a doll that dropped its pants, even though it was extremely offensive to the Unification Church. However, "Senussi" was denied registration as a brand of cigarette because it was offensive to a Moslem sect that forbids smoking. *See In re* Reemtsma Cigarettenfabriken, 122 U.S.P.Q. 339 (T.T.A.B. 1959). "Madonna" was also denied registration as the name for a wine because it was offensive to Christians. *See In re* Riverbank Canning Co., 95 F.2d 327, 328 (C.C.P.A. 1938). However, as mentioned earlier, the mark "Madonna" was registered in connection with the pop star. *See* U.S. Trademark Reg. No. 1,473,554 (1988).

213. Reiter, *supra* note 76, at 195.

214. "Even when it dealt mainly with merely gross or naughty images, section 2(a) was applied in a vague and unpredictable manner." *Id.* at 192.

215. *Id.*

standards. After years of precedent, abstract principles become solid doctrine. The doctrine surrounding section 2(a) is still undergoing this process. Because section 2(a) cases arise fairly infrequently, and because societal norms have changed significantly over time, so have the judgments surrounding what is "scandalous" or "disparaging." It may be that we no longer need the government to refuse registration to indecent materials because those who would be offended can avoid those materials easily enough. It may be that the "immoral" and "scandalous" categories of section 2(a) have outlived their usefulness. However, one application of section 2(a) that still seems appropriate is protecting the sensitivities of minorities who may often have no other recourse to prevent the damage caused by disparaging marks.[216]

In this sense, the *Harjo* case may be the most appropriate application of section 2(a) to date. As discussed earlier, the damage done to American Indian individuals and cultures by the adoption of offensive and stereotypical mascots and logos is both real and immediate.[217] Unlike most scandalous material, which can simply be avoided by not frequenting a forum where such products or services are available, a trademark that is disparaging to a minority group may appear harmless to the majority of society and become so pervasive that the minority cannot avoid the harm that may come from exposure. The name of a professional football team is just such a mark, and American Indians that have any desire to pay attention to sports or inhabit the regions where these names are used cannot help but be exposed to these marks on a regular basis. "Redskin" is a racial epithet that is essentially equivalent to "nigger,"[218] and yet it has permeated American culture through various forms of expression, including television, radio, newspapers, clothing, sports memorabilia, and everyday speech. Although those who utter the word do not intend the harm of a racial epithet, this does not make the harm any less real for

216. This policy justification leaves a case like *Bromberg v. Carmel Self Service, Inc.*, 198 U.S.P.Q. 176 (T.T.A.B. 1978), on more tenuous grounds. Since women are not considered a minority group, intervention by the government is less justified than in the *Harjo* case. One could certainly argue that the petitioners in *Bromberg* should have been relegated to using economic or political persuasion to make their point that the restaurant's slogan was offensive to women.

217. *See* discussion *supra* Part II.B.

218. *See* Pace, *supra* note 1, at 7.

those who know its meaning, and are harmed by the appropriation of their culture and religion as a tool for the entertainment of the masses. Unfortunately, the majority has confused the issue to the point where many believe that to "paint [their] face, stick feathers in [their] hair and make Hollywood war whoops" is "honoring the Indian people," while it is blatantly obvious that they should not "paint [their] face black, wear an afro wig and prance around the football field."[219]

When a minority is so harmed by the actions of an uninformed majority, it is not only permissible, but it is the duty of the government and the law to intervene on behalf of that group.[220] Public policy should demand it, not prohibit it. Section 2(a) functions as an appropriate tool in this respect, allowing the minority to apply financial pressure similar to that of a boycott or protest. Section 2(a) merely refuses to grant the benefit of federal protection to a trademark, but stops far short of actually mandating that the offending party abandon the mark. This strikes an appropriate compromise between acknowledging the speech rights of the offending party, and protecting the harmed minority.

V. THE EFFECT OF THE DECISION: WHERE DOES THIS LEAVE THE WASHINGTON REDSKINS AND ITS TRADEMARK?

The purpose of Suzan Harjo's lawsuit was to secure the cancellation of the trademark REDSKINS in the hopes that without the advantages of federal registration and enforcement, it would no longer be economically feasible for the owner to keep the "Redskins" moniker. As stated throughout this casenote, the failure to secure, or the revocation of a federal registration of a mark, does not preclude the owner from using the mark. All that is lost is the promise of federal protection and the exclusive right to use the mark.[221] Although holders of unregistered marks are still entitled to the protection of state statutes, the common law,[222] and section 43(a) of the Lanham

219. *Id.* at 11 (referring to a conversation between the author, Kimberly Pace, and a caller on a radio talk show).

220. "The lack of political influence stems from the relatively small size of the Native American population." *Id.* at 16.

221. *See* Dougherty, *supra* note 54, at 381.

222. *See* Baird, *supra* note 158, at 788–89.

Act,[223] none of these can provide the sort of benefits that are unique to federal registration.[224]

There is some question as to what extent the owner of a mark can rely on common law and state protection without federal registration. Common law rights arise whenever the trademark is used in connection with the sale of goods or services, and the common law principles of trademark are undisturbed by the Lanham Act.[225] Trademark rights under the common law can arise prior to registration[226] and remain in effect after federal registration has expired[227] or has been canceled.[228] However, the protection of common law trademark principles depends upon its own limitations, one of which is that a "designation cannot be a trade-mark or trade name if it is scandalous or indecent, or otherwise violates a defined public policy."[229] Thus, any mark that is canceled under section 2(a) of the Lanham Act for being scandalous or disparaging is unlikely to find much protection under common law principles either, although this will ultimately be determined by state courts applying their own common law principles.

In addition to the common law, all fifty states have passed their own trademark statutes with corresponding provisions for registration, almost all of which have been influenced by the Model State Trademark Bill.[230] However, state statutes carry restrictions similar to those of the Lanham Act, most of which

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223. 15 U.S.C. § 1125(a) (1994). This section only provides protection through a civil action if another party deceives the public causing them to confuse her own product with that of another. It appears from the language of the statute that if the infringing party is honest about the product's origins, there will be no remedy under this section.

224. *See* discussion *supra* Part I (describing the federal benefits obtained by registration on the Principal Register).

225. *See* Paul E. Loving, *Native American Team Names in Athletics: It's Time to Trade These Marks*, 13 LOY. L.A. ENT. L.J. 1, 16 (1992).

226. *See* Maternally Yours, Inc. v. Your Maternity Shop, Inc., 234 F.2d 538, 541 (2d Cir. 1956).

227. *See* United States Jaycees v. San Francisco Junior Chamber of Commerce, 354 F. Supp. 61 (N.D. Cal. 1972); Phoenix Mfg. Co. v. Plymouth Mfg. Co., 286 F. Supp. 324, 328 (D. Mass. 1968).

228. *See* Armstrong Paint & Varnish Works v. Nu-Enamel Corp., 305 U.S. 315 (1938); National Trailways Bus Sys. v. Trailway Van Lines, Inc., 269 F. Supp. 352, 357 (E.D.N.Y. 1965); *see also* Loving, *supra* note 225, at 35.

229. RESTATEMENT (FIRST) OF TORTS § 726 (1938).

230. *See* Zlotchew, *supra* note 1, at 220.

deny registration to offensive or disparaging marks.[231] Only three states fail to prohibit scandalous, immoral, or disparaging matter in trademarks.[232] Therefore, without the benefits of federal registration, enforcement against trademark infringements becomes much more difficult. In addition to facing the hurdle of proceeding in various jurisdictions with the potential for varied and unsatisfying outcomes, it is very possible that a plaintiff's state registration of a trademark could be canceled on the same grounds.

If cancellation of federal registration results in the loss of the aforementioned benefits, why did the same old Washington Redskins take the field every weekend during the 2000 season? One reason is that the Redskins have appealed the decision to the Court of Appeals for the Federal Circuit,[233] and will likely

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231. Nearly every state has prohibited the registration of trademarks that are scandalous or immoral. *See* ALA. CODE § 8-12-7(a)(1) (2000); ALASKA STAT. § 45.50.010(a)(1) (Michie 2000); ARIZ. REV. STAT. ANN. § 44-1442.1 (West 2000); ARK. CODE ANN. § 4-71-104(1) (Michie 1999); CAL. BUS. & PROF. CODE § 14220(a) (West 2000); COLO. REV. STAT. § 7-70-108(1)(a) (2000); CONN. GEN. STAT. § 35-11b(1) (2000); DEL. CODE ANN. tit. 6, § 3303(1) (1999); FLA. STAT. ANN. § 495.021(1)(a) (West 2001); GA. CODE ANN. § 10-1-441(1) (2000); IDAHO CODE § 48-502(2)(a) (Michie 2000); 765 ILL. COMP. STAT. 1036/10(a) (2000); IND. CODE ANN. § 24-2-1-3(a) (Michie 2000); IOWA CODE ANN. § 548.1.a (West 2000); KAN. STAT. ANN. § 81-203(a) (1999); KY. REV. STAT. ANN. § 365.567(1) (Michie 2000); LA. REV. STAT. ANN. § 51:212(1) (West 2000); MD. CODE ANN., BUS. REG. § 1-404(b)(1) (2000); MASS. GEN. LAWS ch. 110B, § 3(a) (2000); MICH. COMP. LAWS ANN. § 429.32.2(a) (West 2000); MINN. STAT. ANN. § 333.19(1)(1) (West 2000); MISS. CODE ANN. § 75-25-3(a) (2000); MO. REV. STAT. § 417.011(1) (2000); MONT. CODE ANN. § 30-13-303(a) (1999); 2000 Neb. Laws L.B. 626 (2d Session) § 4(1) (to be codified at NEB. REV. STAT. § 25-2130); NEV. REV. STAT. ANN. § 600.330(1) (Michie 2001); N.H. REV. STAT. ANN. § 350-A:2.I (2000); N.J. REV. STAT. § 56:3-13.2(a) (2000); N.M. STAT. ANN. § 57-3B-4(1) (Michie 2000); N.Y. GEN. BUS. LAW § 360-a (McKinney 2000); N.C. GEN. STAT. § 80-2(1) (2000); N.D. CENT. CODE § 47-22-02.1 (1999); OHIO REV. CODE ANN. § 1329.55(A) (Anderson 2000); OKLA. STAT. ANN. tit. 78, § 22(a) (West 2000); OR. REV. STAT. § 647.035(1) (1999); 54 PA. CONS. STAT. § 1111(1) (2000); R.I. GEN. LAWS § 6-2-3(1) (1999); S.C. CODE ANN. § 39-15-1110(1) (Law. Co-op. 2000); S.D. CODIFIED LAWS § 37-6-6 (Michie 2000); TENN. CODE ANN. § 47-25-502(1) (2000); TEX. BUS. & COM. CODE ANN. § 16.08(a)(1) (Vernon 2000); UTAH CODE ANN. § 70-3-2(1)(a) (2000); VT. STAT. ANN. tit. 9, § 2527(a) (2000); VA. CODE ANN. § 59.1-92.3(1) (Michie 2000); WASH. REV. CODE ANN. § 19.77.020(1) (West 2001); W. VA. CODE ANN. § 47-2-2(1) (Michie 2000); WYO. STAT. ANN. § 40-1-102(a)(i) (Michie 2000).

232. *See* Hawaii, HAW. REV. STAT. § 482-3 (1999); Maine, ME. REV. STAT. ANN., tit. 10, § 1522(1) (West 2000); and Wisconsin, WIS. STAT. ANN. § 132.01 (West 2000).

233. *See* Christ, supra note 20. Federal Registration implies the existence of a federal question, so diversity and amount in controversy requirements do not need to be satisfied. *See* 15 U.S.C. §1121 (1994); Loving, *supra* note 225, at 19.

wait until the case is reviewed before making a decision about the team name. The Board's decision to cancel the mark will not actually take effect until the appeal has been resolved.[234] Another reason may simply be the stubborn attitudes of team ownership. Former owner, Jack Kent Cooke, often made it clear that the Redskins were his property and that he could call them whatever he wished.[235] This attitude seems to have carried over to the new "hands-on" owner, Daniel Snyder, who seems equally reluctant to change the name anytime in the near future.[236]

Yet another reason the Redskins have retained their name is the unique nature of the National Football League, which provides that team merchandise is licensed by the league as a collective, and proceeds are shared equally by each of the teams.[237] Therefore, the Washington franchise is unlikely to take a significant financial hit from the loss of federal trademark registration. In addition, it is still too soon to see what entrepreneurs hoping to profit from an opening in the team merchandising market may do, and whether they will have the stomach for the litigation that will likely follow.[238] Only marks protecting names such as REDSKINS, SKINS, and REDSKINNETTES were canceled, but neither of the team logos—the spear and the profile of the American Indian warrior—were canceled.[239] Consumers may not be attracted to many bootleg products that only include the name "Redskin" without any of the distinctive artwork.

If it turns out that league revenues take a substantial loss from unlicensed sales, however unlikely this possibility appears, then it is quite possible that other owners would pressure Mr. Snyder into finally changing the name. It is difficult, however, to speculate as to what such an eclectic group of

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234. *See* Masters, *supra* note 12.

235. *See* Leiby, *supra* note 8.

236. *See* ESPN, *supra* note 63.

237. *See* PAUL C. WEILER & GARY R. ROBERTS, SPORTS AND THE LAW 459 (2d ed. 1998). This allows the league to conveniently sell merchandising rights as a collective, while splitting the total revenues equally between the franchises. *See id.*

238. The Washington Football Club would likely try to prosecute trademark infringements under state law, although these claims are unlikely to succeed. *See supra* text accompanying note 155.

239. *See* Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1743 (T.T.A.B. 1999).

wealthy multi-millionaires will choose to do. For the time being at least, new owner Daniel Snyder has indicated that he will not change the team name despite the cancellation of the trademark and increased pressure from the public to change the name.[240] Changing the name carries with it a fear of displeasing fans who may then be less likely to purchase licensed products featuring a new name and logo. The team name is unlikely to change unless it becomes less profitable for the team to live without federal registration of REDSKINS than it would be for them to simply change to a more modern, and less offensive name. As it stands now, *Harjo* represents a moral or political victory more than anything else.

VI. NEW AMMUNITION FOR AMERICAN INDIAN ACTIVISTS: HOW IS THIS DECISION LIKELY TO AFFECT OTHER TEAMS WITH AMERICAN INDIAN MASCOTS AND LOGOS?

No other team name or mascot is considered as offensive to a minority group as "Redskins" because no others carry with it the stigma of a racial epithet.[241] However, names like the "Cleveland Indians" or the "Atlanta Braves" are not much more appropriate. As discussed earlier, these sorts of team names cause damage that names such as the "Minnesota Vikings" and the "Notre Dame Fighting Irish" cannot. As stated in a recent E.S.P.N. special, "Native Americans say these groups have different histories, that they were absorbed into American culture, rather than forcibly excluded."[242] Although the words "Indians," "Braves," "Chiefs," or "Blackhawks" are not racial epithets like the word "redskin," there is still the harm to the minority of watching their culture and religion appropriated and taken out of context for mass entertainment.[243] They "are still undeniably references to one's ancestry, religion, and culture" that many would feel uncomfortable having attached to a sports team.[244]

Although it is too soon to tell what effect this decision will have on other sports teams, it seems unlikely that many institutions will be subject to the same sort of legal action that the

240. *See* ESPN, *supra* note 63.
241. *See* discussion, *supra* Part II.B.
242. ESPN, *supra* note 63.
243. *See* discussion, *supra* Part II.A.
244. Zlotchew, *supra* note 1, at 217.

Redskins have been, simply because there are few names and logos that are as offensive as REDSKINS. The decision itself was limited to the mark REDSKINS in its various forms. The graphical logos of the team remain unaffected because the petitioners could not prove that these logos disparaged American Indians.[245] Based on this part of the holding, it appears that most team names are safe under the law, except those sports teams (professional or collegiate) that use "Redskin" or perhaps some form of "Redman."[246] But more importantly, this case may serve to educate the public as to the meanings of these terms and sway public opinion against team names and logos that not only disparage American Indians, but also result in a mockery of their culture and religion.

At one time, 2600 institutions across the country used American Indian terms and imagery in some form.[247] Six hundred schools have dropped these images over the last three decades, beginning with the University of Oklahoma in 1970.[248] In another prominent move, Stanford dropped the "Indians" name in 1972 after pressure from American Indian students. Likewise, the Dartmouth Alumni Council and Trustees took a stance against the use of "Indians" in 1974.[249] More recently, the Marquette University Warriors changed their name from the "Warriors" to the "Golden Eagles."[250]

Pressure against the use of American Indian team names and mascots has also mounted in the press and the political arena. At least four major newspapers[251] have decided not to print racial, religious, or ethnic team names that might be considered offensive in their sports pages.[252] These changes were

245. *See* Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1743 (T.T.A.B. 1999).

246. However, the Patent and Trademark Office will face this same issue as a challenge to the Atlanta Braves trademark by the Native American Resource Academy. *See* Slind-Flor, *supra* note 89.

247. *See* ESPN, *supra* note 63.

248. *See id.*

249. *See* Loving, *supra* note 225, at 6–7.

250. *See* Leiby, *supra* note 8; *see also* John B. Rhode, *The Mascot Name Change Controversy: A Lesson in Hypersensitivity*, 5 MARQ. SPORTS L.J. 141, 155 (1994).

251. The four newspapers are the Seattle Times, the Salt Lake Tribune, the Star Tribune, and the Portland Oregonian. *See* ESPN, *supra* note 63.

252. *See* William A. Hilliard, *To Our Readers*, PORTLAND OREGONIAN, Feb. 16, 1992, at D1 (announcing the newspaper's decision to discontinue printing potentially offensive team names).

largely brought about by headlines referring to certain teams "scalping" their opponents, or "going on the warpath." Colorado Senator Ben Nighthorse Campbell sponsored legislation in 1993 authorizing construction of a new stadium for the Redskins on federal land and with federal funds, but prohibiting the use of the stadium by any teams "exploiting any racial or ethnic group."[253] To this date, no professional team has voluntarily abandoned an Indian symbol or name.[254]

CONCLUSION

Although the *Harjo* decision has not resulted in a change of heart by the Redskins franchise, it has pushed the issue to the forefront of American culture. The petitioners hope that the decision will be affirmed on appeal, and that the effect will place enough financial pressure on the National Football League that it will urge the Redskins to change its name and logo. Although several challenges have been made to section 2(a) of the Lanham Act, this casenote suggests that those challenges will fail because of the basic nature of section 2(a): it refuses to grant a benefit to applicants upon certain conditions, but it does not deny them the right to use their mark.

As for the argument that a vocal minority should not be deciding what is appropriate for society, this casenote argues that it is the proper place of government and the courts to assist a persecuted minority in certain circumstances. The use of trademarks that disparage American Indian cultures and religions results in real harms to both the individuals and their cultures, in terms of perpetuating stereotypes, misappropriating important symbols and rituals, and excluding individuals from participating in certain activities and attending certain events because of offensive displays. When the majority prefers to remain ignorant as to the harm it has caused, it is a legitimate function of government to give credence to the voice of the minority. As Paul Loving argues in his own article against American Indian mascots, "[t]his is not a plea to conform to notions of 'political correctness,' but rather a request to respond to societal maturation. A team's refusal to change its Native

253. 139 CONG. REC. 15,214 (1993) (statement of Sen. Benjamin Nighthorse Campbell).

254. *See* Zlotchew, *supra* note 1, at 219.

American name is a somber reminder that blatant racism and prejudice still exist."[255]

255. Loving, *supra* note 225, at 43.