Washington Redskins Have Time On Their Side In TM Dispute

Law360, New York (June 19, 2013, 12:19 PM ET) -- The federal Lanham Act prohibits anyone from registering a trademark that disparages particular groups or cultures. So why have efforts to cancel the NFL Redskins franchise’s trademark registrations been ineffective? The short answer is that time is on the Redskins’ side.

A federally registered trademark may only be canceled as disparaging if the trademark would have been considered offensive at the time it was registered. Modern sentiment is not taken into consideration, and establishing that American Indians would have found the team’s trademarks offensive in the 1960s has been an uphill battle. However, the recently introduced Non-Disparagement of American Indians in Trademark Registrations Act of 2013 (“H.R. 1278”) seeks to overcome that hurdle by preventing registration of trademarks that contain the term “redskin” and requiring cancellation of any registered trademarks that currently use the term.

In 1992, in Harjo v. Pro Football Inc., a group of seven American Indians sought to cancel the Redskins’ trademarks before an administrative court by alleging that several trademarks owned by the Redskins’ corporate entity, Pro-Football Inc., disparaged American Indians. While the lower court agreed and canceled the trademark registrations, an appellate court ultimately reversed, holding that petitioners’ eight year delay in filing suit was unreasonable.

In 2006, in Blackhorse v. Pro-Football Inc., a group of five American Indians ages 18 to 24 filed a nearly identical action with the hopes of avoiding the delay issue. At a March 2013 hearing, petitioners emphasized that evidence of disparagement aside, the case itself “makes an important statement about the disparaging nature of the team’s name.” In support, Suzan Shown Harjo, president of the Morning Star Institute advocacy group and a party to the original Harjo litigation, added that the word “redskin” is “the worst thing we can be called in the English language.” Counsel for Pro-Football, however, has maintained that the team’s name is neither insulting nor offensive, but instead honors American Indians.
Whether you’re buying it or not, remember that under trademark law, what you believe doesn’t really matter. The trademarks at issue were registered between 1967 and 1990, and petitioners must prove that American Indians would have found the “redskins” term disparaging then, not now. While the U.S. Patent and Trademark Office has rejected applications for at least three new “redskins”-related trademarks as disparaging since 1996, sentiment regarding the term before the 1990s is unclear. Proving disparagement in a bygone era will not be easy, and thus, no definitive ruling on the team’s name is likely any time soon.

Perhaps with that delay in mind, just two weeks after the Blackhorse hearing, Rep. Eni Faleomavaega, D-Am. Samoa, introduced H.R. 1278 into the House of Representatives. The bill would amend the Lanham Act to prohibit registration of new trademarks containing the term “redskin” and require cancellation of all such existing trademark registrations.

While the Blackhorse cancellation and H.R. 1278 have garnered significant media attention, it is important to note that their immediate effects are likely limited. Petitioners filed the Blackhorse cancellation almost seven years ago, and a final decision in the case is not expected any time soon. Similarly, H.R. 1278 has gained little traction in the House and remains without a companion bill in the Senate.

Ultimately, even if owners of disparaging trademarks were to lose their federal trademark registrations, the victory would be largely symbolic. While owners of unregistered trademarks no longer benefit from many of the advantages of federal registration, they still retain substantial trademark rights. Federal protection for unregistered trademarks is available under the Lanham Act, and owners may protect their trademarks under unfair competition laws or specialized state statutes.

Finally, trademark officials do not have the authority to prohibit the sale of goods bearing disparaging trademarks, nor can they order the owners of such trademarks to pay damages to anyone offended by the trademarks. Cancellation, therefore, while certainly a moral victory for petitioners, would likely have very little practical effect. Negative publicity may ultimately prove to be the more realistic concern for the team’s owners.

--By Perry Viscounty, Jennifer Barry and Parker Tresemer, Latham & Watkins LLP

Perry Viscounty is a partner in Latham’s Orange County, Calif., office. Jennifer Barry is a partner in the firm’s San Diego office. Parker Tresemer is an associate in the firm’s Orange County office. They practice in the firm’s intellectual property litigation practice group.

The opinions expressed are those of the authors and do not necessarily reflect the views of the United States or Portfolio Media Inc. or any of its respective affiliates. This article is for general information purposes and is not intended to be and should not be taken as legal advice.

All Content © 2003-2013, Portfolio Media, Inc.