

Brandmarking

THOUGHTS ON THE CREATION,
PROTECTION, AND ENFORCEMENT OF
BRAND IDENTITY

THE REDSKINS DECISION: MUCH ADO ABOUT (PROBABLY) NOT MUCH

I've been having fun listening to commentators – most of whom appear to know little or nothing about trademark law – expound on last week's decision by the Trademark Trial and Appeal Board to cancel six trademark registrations for variations of the word REDSKINS as the name of Washington, D.C.'s pro football team. One observer described it as a "landmark" decision, and several have prophesied that it marks "the beginning of the end" of the team's controversial nickname.

The decision may turn out to have significant impact on the team politically and in terms of public relations. But legally...not so much.

Into the Time Machine

Many of the "beginning of the end" analyses treat the TTAB decision as a referendum on current public opinion about the Redskins name issue. A spokesman for the National Congress of American Indians, which supported the plaintiffs, said, "I don't know how the team doesn't recognize at this point that it's not just a small group of Indians anymore. It's more than that. People and fans and the country itself are saying, 'Let's just change the name.'"

Maybe they are – but the TTAB decision has nothing to do with that. As the dissenting judge (it was a 2-1 decision) wrote, "To be clear, this case is *not* about the controversy, currently playing out in the media, over whether the term "redskins," as the name of Washington's professional football team, is disparaging to Native Americans *today*." The task before the TTAB was not to render a judgment on the propriety of naming a football team the Redskins. Rather, the task before the TTAB was to conduct a kind of time-machine research project: to determine, as a matter of empirical historical fact, whether the term Redskins was considered offensive by a "substantial composite" (not necessarily a majority) of the Native American population *at the time when the first of the REDSKINS registrations was granted* – in 1967.

In performing this task, the Board was limited to the evidence placed in the record by the parties. It didn't do any independent research or fact-finding of its own, and it was not allowed to take "judicial notice" of any information that may have come its way by other means. This procedural limitation is crucial to understanding why the decision may be vulnerable to being overturned on appeal.



June 25, 2014 • Volume 3, Number 2

THIS MONTH:

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ABOUT "BRANDMARKING"

The word is a combination of "branding" and "trademark." It reflects a conviction that marketing and legal professionals share a common goal, and that they need to learn to speak each other's language in order to reach it. That goal is simple: to develop powerful, durable brand identities and capture them in names, slogans, and designs that customers will associate with their products -- and with no one else's.

If you like what you find here, feel free to pass it along to others.

ABOUT THE AUTHOR



Attorney John Blattner helps businesses develop and protect brand identities. He does trademark counseling, clearance, prosecution, enforcement, and litigation, in the fashion, health and beauty, financial services, technology, retailing, publishing and media, automotive, sporting goods, and other industries. John also teaches Trademarks and Unfair Competition at Michigan State University College of Law.

CONTACT

John Blattner
350 S. Main Street, Suite 300
Ann Arbor, MI 48104
(734) 623-1698 (direct)
jblattner@dickinsonwright.com

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“Déjà Vu All Over Again”

It is important to bear in mind that we have passed this way before. In 1999, in a case called *Harjo v. Pro Football Inc.*, the TTAB canceled the very same six trademark registrations for the very same reason: that the word “redskin” was considered disparaging by Native Americans at the time the registrations were granted. Pro Football appealed to the U.S. District Court for the District of Columbia, and won: the court overruled the Board’s decision, holding – bear with me, this is the important part – that the evidence concerning the disparaging nature of the term “redskins” in 1967 was insufficient. The petitioners then appealed to D.C. Circuit Court of Appeals, which affirmed the district court – without disturbing the ruling on insufficient evidence. The six registrations – which had remained intact throughout the appeal process – were thus definitively preserved.

Flash forward. The case decided last week, *Blackhorse v. Pro Football, Inc.*, was essentially a re-run of *Harjo*, with different plaintiffs but with essentially the same evidence. The parties stipulated that all the testimony, expert reports, affidavits, and other documents from *Harjo* would be received into evidence in *Blackhorse* as well, and the new petitioners made a strategic decision not to add any substantial new evidence.

Same Evidence, Same Result?

This appears to have worked well in the TTAB: the same tribunal, asked to decide the same issue by examining the same evidence, came to the same conclusion.

But the same strategic decision may backfire in the appellate courts. Note what happened in *Blackhorse*: the petitioners went into court armed solely with a body of evidence that a higher court had already ruled was insufficient. As the dissent in *Blackhorse* wrote, “The consequence of petitioners’ decision to rely on the same evidence [that was] previously found insufficient to support cancellation[,] without substantial augmentation[,] is that the evidence before the Board in this case remains insufficient as well.”

Will the appellate courts agree, and overturn the Board’s decision a second time? The picture is clouded by the fact that, owing to an intervening restructuring of the federal court system, the initial appeal might be heard this time by the U.S. District Court for the District of Eastern Virginia, rather than the District of Columbia. Will the new court agree with the old? Only time will tell. But the petitioners may have a hard time persuading any court that a body of evidence already deemed insufficient had somehow grown in stature merely as the result of growing 15 years older.

The initial aftermath of *Blackhorse*, however, will be much the same as that of *Harjo*. The TTAB has already stayed execution of the *Blackhorse* decision on the assumption that Pro Football will appeal. So the six REDSKINS registrations will remain in full force and effect throughout the appeal process, which could take several years (as it did last time).

What Impact?

Let’s suppose that Pro Football’s appeal ultimately fails, and that the six registrations are, finally and definitively, canceled. What then? The fact is that the impact of such an outcome on the Washington Redskins team would likely be far less than many observers have suggested.

For starters, the team would not need to change its name. The TTAB decision does not cancel the REDSKINS trademarks, only the federal registrations for those marks. To be sure, federal registration provides important benefits. But as my trademark law students could tell you, under U.S. trademark law rights ultimately come from use of a mark in commerce, and even unregistered marks can become quite strong by virtue of long-standing and widespread use, substantial investment in advertising and promotion, and strong “name recognition” among the public. By any of those measures, REDSKINS is a very strong mark indeed, and Pro Football would not find it difficult to enforce its common-law trademark rights against infringers.

Purely as a matter of legal and economic reality, the post-cancellation world of the Washington Redskins might not look much different than the current one.

IP Rights and Censorship

All this, of course, addresses only what may happen as a result of what is done in courts of law. The court of public opinion is a different matter. *Blackhorse* appears to have triggered significantly stronger public reaction than *Harjo*, which may help bring other forces to bear on the situation.

One thing that has not changed is my conviction that deciding issues of this nature is not a job for the Trademark Office. The judges who decide cases in the TTAB are experts on trademark law. They shouldn’t be expected to be experts on the kinds of social and political issues that drive cases like this one, or even on the kind of historical research questions such cases present. Nor do they have the opportunity to submit fact issues to a jury, which might be better positioned to render a verdict about what is or is not “immoral” or “scandalous.”

The Lanham Act is the only intellectual property statute that includes a censorship provision. Why do we feel it is improper to place a government “stamp of approval” (the ® symbol) on a trademark that is “immoral” or “scandalous,” when we have no qualms about placing another such symbol (the © symbol) on copyrighted pornography or hate speech, which we do all the time?

The Redskins case raises many interesting, and important, issues. But none of them are really trademark issues. That’s why their ultimate resolution will likely have little to do with what happened in the Trademark Office last week.

Dickinson Wright Offices

Detroit

500 Woodward Ave.
Suite 4000
Detroit, MI 48226
Phone: 313.223.3500

Ann Arbor

350 S. Main St.
Suite 300
Ann Arbor, MI 48104
Phone: 734.623.7075

Columbus

150 E. Gay St.
Suite 2400
Columbus, OH 43215
Phone: 614.744.2570

Grand Rapids

200 Ottawa Ave., NW
Suite 1000
Grand Rapids, MI 49503
Phone: 616.458.1300

Las Vegas

8965 South Eastern Avenue
Suite 280
Las Vegas, NV 89123
Phone: 702.382.4002

Lansing

215 S. Washington Square
Suite 200
Lansing, MI 48933
Phone: 517.371.1730

Nashville

424 Church St.
Suite 1401
Nashville, TN 37219
Phone: 615.244.6538

Saginaw

4800 Fashion Square Blvd.
Suite 300
Saginaw, MI 48604
Phone: 989.791.4646

Phoenix

1850 North Central Avenue
Suite 1400
Phoenix, AZ 85004
Phone: 602.285.5000

Troy

2600 W. Big Beaver Rd.
Suite 300
Troy, MI 48084
Phone: 248.433.7200

Toronto

199 Bay St., Suite 2200
Commerce Court West
Toronto ON M5L 1G4
Phone: 416.777.0101

Washington, D.C.

1875 Eye St., NW
Suite 1200
Washington, DC 20006
Phone: 202.457.0160