REDSKINS Trademark Registrations Still Canceled After Appeal to Federal Court

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by Phillip Barengolts, Partner

Today, the District Court for the Eastern District of Virginia has upheld an administrative ruling that canceled federal trademark registrations for the REDSKINS nickname of the Washington football team despite the team's constitutional and other challenges. *Pro-Football, Inc. v. Blackhorse*, Case No. 14-cv-01043 (E.D. Va. July 8, 2015). [1]

Last year, on June 18, 2014, the Trademark Trial and Appeal Board of the United States Patent and Trademark Office ("TTAB") canceled six of Washington's federal registrations for the trademark REDSKINS because the name disparages Native Americans.[2] The team appealed the ruling to federal court. It argued, essentially, that Section 2(a) of the Federal Trademark Act (the "Lanham Act"), which prohibits the federal registration of potentially disparaging trademarks, is unconstitutional and that the Native American petitioners did not prove that the REDSKINS trademark is, in fact, disparaging. On cross-motions for summary judgment, the Eastern District of Virginia sided with the Native American petitioners on all counts.

The decision highlights an important aspect of trademark practice. As the Court admonished the parties, this case concerns the right of the Washington football team to *register* the REDSKINS trademark– not the team's right to use the mark. The TTAB also highlighted this point in its decision, but mass media, and even many attorneys, confused this point.

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[1] The full 70-page opinion can be found here: http://www.pattishall.com/pdf/PFI%20v%20Blackhorse%20Decision.pdf

[2] Further background and earlier coverage on the TTAB decision can be found here: http://blog.pattishall.com/2014/06/18/redskins-trademark-registrations-canceled-after-8-more-years-of-litigation/.

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The rights conferred by registration are important and valuable , but the TTAB only has the right to decide whether a trademark may be registered, it has no authority to stop the use of a trademark. Section 2(a) of the Lanham Act, at issue in this dispute, only applies to registration of trademarks. As the Court stated, "Thus, regardless of this Court's ruling, [the team] can still use the Redskins Marks in commerce."

As a practical matter, however, a trademark owner who is not permitted to register its preferred mark often *chooses* not to use that mark, but, ultimately, it is the trademark owner's choice. This point is crucial for the Court's decision and crucial for an understanding of when and why to bring an action before the TTAB.[3]

As a result of this limited application of Section 2(a) of the Lanham Act, the statute survived the constitutional challenge brought by the team. In particular, the Court found that Section 2(a) does not even implicate the First Amendment precisely because it does not prohibit the use of a trademark, and therefore, does not prohibit or impinge on any speech.

The Court also found that the federal trademark registration program is government speech under the Supreme Court's recent decision in *Walker v. Tex. Div., Sons of Confederate Veterans, Inc.*, 135 S. Ct. 2239 (2015).[4] Basically, this means that "the federal government may determine the contents and limits of programs that it creates and manages." The Court also ruled that the term "may disparage" in Section 2(a) of the Lanham Act is not impermissibly vague – generally or as applied to the team. Finally, the TTAB's ruling was not an impermissible taking because a trademark registration is not a property interest, as opposed to the underlying trademark itself, which is.

As to the team's challenges to the ruling that the term REDSKINS may disparage Native Americans, the Court found that evidence found in dictionaries, scholarly and media references, and statements from Native Americans were sufficient to uphold the TTAB's ruling.

In the previous iteration of this battle, the D.C. Circuit Court of Appeals upheld a ruling that laches barred the Native Americans' suit. *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005).[5] Here, for reasons not worth getting into, the District Court found that laches did not apply.

Undoubtedly, the team will appeal this decision to the Fourth Circuit. So, the saga of the REDSKINS trademark registration continues.

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[3] The recent decision in *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 575 U.S. __ (2015), may have changed this calculus. See http://blog.pattishall.com/2015/03/25/supreme-court-holds-that-issues-decided-by-the-ttab-may-be-preclusive-in-federal-court/. The decision can be found here: http://scholar.google.com/scholar_case?case=15316530830472719965.

[4] http://scholar.google.com/scholar_case?case=2629371590163032730.

[5] http://scholar.google.com/scholar_case?case=2204191829610278162.

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