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The Washington Redskins Case and The Doctrine of Disparagement: How Politically Correct Must a Trademark Be?

Kimberly A. Pace*

I. INTRODUCTION

'Welcome to today's game between the Baltimore Blackskins and the San Francisco Yellowmen And here come the Yellowmen onto the field, led by their famous cheerleaders, the Geisha Girls Before today's kickoff, we want to remind you that plenty of good seats still are available for next week's game against the New Jersey Fighting Jews. The Jews will be bringing their hilarious mascot, the Famous Rabbi, who will be performing during the game and at halftime' Ask yourself this question: If your skin color, race or religion were parodied in nicknames or mascots or team logos, wouldn't you be offended?

Although names such as the "New Jersey Fighting Jews" or the "New York Negroes" might seem unrealistic in contemporary society, there are ethnic groups still held out for public ridicule as team mascots. Why would it be socially repugnant to name a team the "New York Negroes" but not to name one the "Cleveland Indians?" Worse yet, could there be a team named the "New York Niggers?" Isn't that just the racial equivalent of the "Washington Redskins?"

This Article concentrates on the use of Native American images as team mascots and trademarks. It will detail the protests by Native Americans concerning the manner in which these trademarks perpetuate degrading racial stereotypes. It will also analyze the merit of the Petition to

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1. Steve Kelley, *Several Nicknames Invite Changes, Not Cheers*, SEATTLE TIMES, Feb. 21, 1992, at E1.

Cancel the "Washington Redskins" trademark under section 2(a) of the Lanham Act.

Part II of this Article addresses the use of race in trademarks. In particular, it details the opposition of Native Americans to the exploitation of their culture and imagery in a disparaging manner, which perpetuates racially demeaning stereotypes. Part III discusses the protections available for trademarks and the advantages of federal registration. It also gives a general overview of the federal registration process and the means available to a third party to contest a trademark's registration. Part IV discusses the content-based restrictions on trademark registration found in Section 2(a) of the Lanham Act and the case law interpreting this provision. It also argues that the dearth of case law discussing Section 2(a)'s prohibition against the registration of disparaging trademarks has failed to yield an appropriate test to determine when a mark is racially disparaging. While this article does propose a test for racial disparagement, it also argues that the Lanham Act's content-based restrictions that deny registration to immoral, scandalous and disparaging trademarks are an unconstitutional violation of the trademark owner's First Amendment rights. Finally, Part V details the Petition to Cancel the Redskins trademark and the legal arguments that have been raised.

II. TRADEMARKS AND RACE

A. *Use of Race in Trademarks*

In our not-too-distant past, grotesque racial caricatures and stereotypes were accepted in America as an ordinary form of humor. Advertisements and packages showed black Americans with thick, saucer lips and eyes wide with fear; or Asian Americans with long braids, swallowing live rats. The 'humorous' depictions clearly had a cutting edge, and their profusion served to reinforce white notions of racial superiority. Even less grotesque representations of blacks as servants or cooks had the same effect, driving home the concept that blacks were suited for menial jobs.²

At present, there is no registered trademark that contains the racial epithet "nigger." However, this was not true in this country's recent past; companies used trademarks such as "Nigger Head Brand" for canned vegetables³ and "Niggerhair Tobacco."⁴ While these trademarks were acceptable in the early part of the twentieth century, an era politically

2. HAL MORGAN, *SYMBOLS OF AMERICA* 52 (1986); see Appendix A for examples of federally registered trademarks that used African-American imagery.

3. See Appendix A.

4. The "Niggerhair Tobacco" trademark was accompanied by a caricature of a black woman with a bushy Afro and rings through her nose. See Nancy Kruh, *Collecting Controversy; Evolving Images: Aunt Jemima, Uncle Ben, and The Chef of Cream of Wheat*, DALLAS MORNING NEWS, Feb. 13, 1994, at 1F.

and economically dominated by white men, they are certainly not acceptable in our multi-cultural society. It is not surprising that these racially offensive trademarks are not found in contemporary society. Section 2(a) of the Lanham Act prevents the registration of a trademark with such words as "nigger," because it would ridicule African-American people and depict them in a disparaging way.⁵

Although the denial of federal registration does not prevent companies from using disparaging trademarks,⁶ many companies do not use marks that would be racially offensive to African-Americans. It would be economically unwise for a company to use a trademark that is offensive to African-Americans. A company's trademark is its commercial identity. If a company's symbol is offensive, those who are offended will not buy the company's product. For this reason companies are constantly changing their trademarks to appeal to consumers.⁷ "Few trademarks, logos and corporate symbols are constant [T]hey are fluid creatures that evolve with society."⁸

Perhaps the single best example of the evolution of a trademark is found in the "Aunt Jemima" trademark owned by the Quaker Oats Company. "Aunt Jemima has undergone several makeovers since her inception The trademark for the nation's first pancake mix has gone from a hideous caricature of slave-like servitude to a symbol of home cooking prepared with a smile."⁹ When Quaker Oats first used Aunt Jemima as a trademark for pancake mix in 1893, she appeared as caricature of a black "mammy" grinning with a handkerchief over her head.¹⁰ It wasn't until 1917 that the company replaced the caricature with a drawing of a real person, but even then, "Aunt Jemima" retained a "smiling stereotype of a household helper."¹¹ Over the years the Quaker Oats Company employed a number of different women to make public appearances as Aunt Jemima to promote the brand name and reinforce her image.¹²

5. See 15 U.S.C. § 1052(a) (1988).

6. See *infra* notes 72-88 and accompanying text.

7. Sandra Clark & Paul Shepard, *Trademark Makeovers Aim to Keep Image Hip*, PLAIN DEALER (Cleveland), Mar. 7, 1993, at E1.

8. *Id.*

9. *Id.* The "Aunt Jemima" trademark has undergone seven makeovers since its inception. Janet Key, *At Age 100, a New Aunt Jemima*, CHI. TRIB., Apr. 28, 1989, at C1; see Appendix B.

10. See MORGAN, *supra* note 2, at 55.

11. *Id.*

12. See Kruh, *supra* note 4, at 1F. The first woman employed to portray "Aunt Jemima" was Nancy Green, a black cook from Kentucky; see also MORGAN, *supra*

“Though Quaker Oats long ago stopped hiring women to pose as Aunt Jemima, the image has undergone a continued metamorphosis to reflect changing social mores.”¹³ In 1968, in response to complaints that “Aunt Jemima” was a racist trademark and that she depicted blacks in a degrading fashion, the Quaker Oats Company gave “Aunt Jemima” a face lift.¹⁴ “Aunt Jemima” lost weight, and the red knotted handkerchief she wore over her head became a more modern-looking headband (a red bandanna).¹⁵ These changes were made in an attempt to shed the black mammy image and avoid racial stereotypes.¹⁶ In 1989, “Aunt Jemima” received another makeover. This time, the Quaker Oats Company removed her red bandanna, gave her a modern hair style, added gray to her hair, white pearl earrings and a lace collared blouse.¹⁷ Quaker Oats admitted to making the changes in “Aunt Jemima”’s appearance after conducting research which showed that consumers viewed the bandanna as a “symbol of slavery.”¹⁸

The Quaker Oats Company has been diligent in assuring that their trademark conforms with contemporary societal views of acceptability.¹⁹ Quaker Oats is sensitive to societal views because they do not want to jeopardize the value of their “Aunt Jemima” trademark, which they estimate to be worth approximately three million dollars.²⁰ Since her last makeover only cost the company \$100,000, it is certainly in Quaker Oats’ economic interest to update the “Aunt Jemima” image to avoid offending or alienating consumers.²¹

note 2, at 55.

13. Kruh, *supra* note 4, at 1F.

14. *See* Clark & Shepard, *supra* note 7, at 1E.

15. *Id.*

16. *See* Carolyn Abraham, *Not-so-visible Minorities; Local Advertisers are Reluctant to Tie Their Images to Non-White Models*, OTTOWA CITIZEN, Nov. 9, 1992, at A1.

17. *See* Kruh, *supra* note 4, at 1F; Appendix B.

18. Fred Brown Jr., *Collecting African-American Images*, WASH. POST, Feb. 6, 1990, at C5. Quaker Oats is not the only company concerned with offending African-Americans. In 1993, Nabisco undertook research to determine if their Cream of Wheat Chef trademark, used for over 100 years, was offensive to blacks. After conducting a survey that targeted African-Americans, the company concluded that the trademark was not offensive. *See* Kruh, *supra* note 4, at 1F.

19. “The change in Aunt Jemima, now a century old, parallels a similar effort by advertisers and marketers to give Betty Crocker a more modern persona Betty Crocker, the 65-year-old trademark . . . has undergone six makeovers.” Key, *supra* note 9, at C1.

20. *Id.*

21. *See* Clark & Shepard, *supra* note 7, at 1E.

B. Use of Native Americans as Trademarks

During a radio talk show I was on, at the time of the Atlanta Braves brouhaha, a lady name Diane called to say she had attended a high school with a team nicknamed 'Indians.' She said she was proud to paint her face, stick feathers in her hair and make Hollywood war whoops as part of her cheerleading duties. 'I felt we were honoring the Indian people,' she said. Suppose your team was called the 'African Americans,' I asked her. Would you paint your face black, wear an afro wig and prance around the football field trying to imitate your perceptions of black people? She responded, 'Of course not! That would be insulting to blacks.' My point is made, I responded.²²

1. Use of Native American Imagery in Conjunction with Athletic Teams

Native Americans oppose the use of American Indians as team logos, trademarks and mascots.²³ They claim that the marks depict Indians in a racist and degrading fashion, and that they perpetuate demeaning stereotypes. Many professional sports teams, as well as a number of college and high school teams, use Indians as their mascots. Such marks include: the Washington Redskins; the Kansas City Chiefs; the Cleveland Indians and their mascot, "Chief Wahoo"; the Atlanta Braves and their mascot, "Chief Noc-A-Homa"; the Chicago Blackhawks; the Florida State University Seminoles; the University of Illinois Fighting Illini; the University of Miami (Ohio) Redskins; and the St. John University Redmen.²⁴

Indian groups opposing the use of these names have tried a number of legal and non-legal means to persuade teams to stop using racially offensive mascots. They have proposed boycotts on teams and universities that continue to use offensive marks, held protests and demonstrations, pressed reporters to identify these teams only by their city or school, introduced legislation that would force teams to stop using offensive names and filed lawsuits. Their efforts have been moderately successful.

22. 138 CONG. REC. E152-53 (daily ed. Jan. 30, 1992) (statement of Hon. Eni F. H. Faleomavaega of American Samoa).

23. Native American groups that have been at the forefront of the protests include: the Morning Star Institute, the National Indian Education Association, American Indian Movement (AIM) and the National Congress of American Indians (NCAI).

24. See Appendix C for the design marks that accompany a number of these word marks. As mentioned, this list is not exclusive. In Washington state alone there are approximately 31 schools that use Indian related nicknames and mascots. See Editorial, *Be Sensitive, But Don't Drop All Indian Names*, SEATTLE TIMES, Sept. 28, 1993, at B4.

Some newspapers, like *The Oregonian*, in Portland, refrain from publishing nicknames that refer to Indians.²⁵ Some high school and college teams have stopped using Native American imagery after complaints that the marks were offensive.²⁶ For example, in 1972, Stanford University changed its team mascot from the Indians to the Cardinal after protests that the name was racist.²⁷ The same year, the University of Massachusetts replaced its team mascot, an Indian, with a Minuteman.²⁸ Eastern Michigan, Syracuse and Dartmouth have also abandoned their Indian-related nicknames and mascots.²⁹ Finally, the Boards of Education of both Minnesota and Wisconsin have adopted a ban on all Indian mascots in public schools.³⁰ Unfortunately, no professional sports team has changed its name in response to the efforts of Native American groups.³¹

2. The Washington Redskins—The Worst Offender

Native American Indian groups have long been claiming that the Washington Redskins' trademark is particularly racist and degrading. They insist that the term "Redskin" is a racial epithet, and as such, it perpetuates demeaning stereotypes of Native Americans.³²

25. See Kelley, *supra* note 1, at E1.

26. Keith Ervin, *Debate on Dropping School Mascots*, SEATTLE TIMES, Sept. 22, 1993, at B1. Native Americans are not the only racial group that has successfully opposed being used as a mascot. The Shoreline Community College in Seattle changed their mascot from a Samurai to a Dolphin after protests that the Samurai was racist. *Id.*

27. David Arnold, *Minutemen Comes Under '90s-Style Fire*, BOSTON GLOBE, Oct. 14, 1993, at 1.

28. *Id.* The Minuteman, likewise, has come under attack by students as a sexist, racist, militaristic mark. However, UMass has refused to change its current mascot in response to these recent protests. *Id.* Hal Morgan, author of *SYMBOLS OF AMERICA*, suggested that "UMass adopt the tomato as a mascot. Plants are safe. They don't offend anyone. Then again, imagine being a quarterback and getting sacked for the UMass Tomatoes." *Id.* "Even symbols seemingly safer than the besieged Minuteman have come under fire. The Hurricanes of the University of Miami thought they had no issue with their football nickname until Hurricane Andrew devastated southern Florida last year. After that, the school received complaints about the team moniker." *Id.*

29. See Karen Goldberg, *Ethnic Team Names Draw New Attacks*, WASH. TIMES, July 10, 1993, at D1; Suzanne Fields, *Will Snub Patrol Scalp Braves, 'Skins, Indians?*, ATL. J. & CONST., Aug. 30, 1993, at A8.

30. See Ervin, *supra* note 26, at B1.

31. However, there has been some progress with professional sports teams. After 15 years, Chief Noc-A-Homa no longer emerges from his tepee behind the left field wall to do a war dance after every home run hit by the Atlanta Braves. See Clark & Shepard, *supra* note 7, at 1E.

32. Many commentators agree that the use of racial slurs, insults, and epithets is damaging to society as a whole, and particularly damaging to the minority group being singled out. See, e.g., Richard Delgado, *Words that Wound: A Tort Action for*

[The Washington Redskins are] the only big time professional sports team whose name is an unequivocal racial slur After all, how would we react if the team was named the Washington Negroes? Or the Washington Jews? And, what's worse, the name of Washington's team—unlike the Cleveland Indians, the Atlanta Braves, the Chicago Blackhawks (named for an actual chief) or the Kansas City Chiefs—is more than a mere racial reference. It is an actual racial epithet.³³

The team's trademark consists of the words, "Washington Redskins," along with a picture of an Indian.³⁴ The team federally registered the "Redskins" trademark in 1967,³⁵ though the team actually began using the name "Redskins" in 1933, in Boston, Massachusetts.

Initially, Native Americans attempted to persuade the Washington Redskins' owner, Jack Kent Cook, to change the team's logo through non-legal means. These efforts included protests, demonstrations, boycotts and writing personal letters stating that the name is offensive. At one protest, Native Americans handed the fans redskin potatoes as they entered a Redskins' game, suggesting that if the team won't change their name altogether, they should at least change their mascot to the potato.³⁶ Legislation was even proposed in Congress, which would force the

Racial Insults, Epithets, and Name-Calling, 17 HARV. C.R.-C.L. L. REV. 133, 135-39 (1982) (detailing the psychological, sociological, and political harms that result from racial insults); Kent Greenawalt, *Insults and Epithets: Are They Protected Speech?*, 42 RUTGERS L. REV. 287, 302 (1990) (stating that racial epithets reinforce negative stereotypes, prejudices, and feelings of inferiority); Charles R. Lawrence, *If He Hollers Let Him Go: Regulating Racist Speech on Campus*, 1990 DUKE L.J. 431, 452 ("The experience of being called 'nigger' . . . is like receiving a slap in the face."); Mari J. Matsuda, *Public Response to Racist Speech: Considering the Victim's Story*, 97 MICH. L. REV. 2320, 2336-38 (1989); Brian Owsley, *Racist Speech and "Reasonable People:" A Proposal For A Tort Remedy*, 24 COLUM. HUM. RTS. L. REV. 323, 324 (1993) ("Psychological, emotional and even physical damage is attributed to racist speech Along with the emotional harm, racists' speech can affect the victim's dignity . . . [and] facilitates the spread of racial prejudice."); Jean Stefancic & Richard Delgado, *A Shifting Balance: Freedom of Expression and Hate-Speech Restriction*, 78 IOWA L. REV. 737, 746 (1993) (pointing out that "hate speech" has a pernicious effect on the self-respect of minority groups).

33. Clarence Page, *Block that Trademarked Racial Epithet*, ORLANDO SENTINEL, Sept. 23, 1992, at A9.

34. See Appendix C.

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

36. See Roy Walter, *No Spud Missiles for Them*, COURIER J., Dec. 6, 1993, at 2D; Jack Ripley, *American Indians Protest NFL's Redskins*, ST. PETERSBURG TIMES, Dec. 6, 1993, at 3B; see also Gallery, *Keep, Name, Move the Team to Idaho*, SAN DIEGO UNION TRIB., Dec. 6, 1993, at D2. This author has found a proposed fight song for the Redskins, should they change their mascot to the Spuds, entitled, *Hail to the Redskins, French Fried or Mashed*. The lyrics to the fight song are: "Hail to the Red-

Washington Redskins to change their name if they wished to continue to play on a federally funded field.³⁷ The bill, the District of Columbia Stadium Act of 1957 Amendments of 1993, was introduced by Senator Ben Nighthorse Campbell.³⁸ It authorized the construction, maintenance and operation of a new stadium for the Redskins, with federal funds.³⁹ The Stadium Act also contained a provision which prohibited the use of the federally funded stadium by teams with nicknames and trademarks "exploiting any racial or ethnic group."⁴⁰

In addition to the congressional legislation, a majority of the District of Columbia City Council passed a resolution⁴¹ requesting the Washington Redskins to change its name.⁴² However, all attempts to persuade the

skins, Hail Victory! Potato in your Fork Bath, Fight on for Old D.C.! Bake 'em, Fry 'em, Skin 'em, Slice 'em, Mash 'em, and Smash 'em, Pound through the Line. Fight on, Fight on, for Old D.C.!!" Aslan Baghdadi, Associate, Kirkland & Ellis, in Washington D.C. (Apr. 26, 1994) (quoting Jonathan Baghdadi). This fight song is far less offensive than the original version of the Redskins' fight song, with lyrics as follows: "Hail to the Redskins, hail victory! Braves on the warpath, fight on for old D.C.! Scalp 'em, wamp 'em, we will take 'em big score. Read 'em, weep 'em, touch-down, we want heap more!" See *Hail to the Redskins*, WASH. POST, Jan. 20, 1984, at N7. Even the present version of the fight song, which was modified in 1970, uses lyrics like, "Beat 'em, Swamp 'em." *Id.*

37. See generally S. REP. NO. 1207, 103d Cong., 1st Sess. (1993). The Redskins currently play at RFK Stadium which is owned by the District of Columbia.

38. See 139 CONG. REC. S8493 (daily ed. July 1, 1993) (statement of Sen. Nighthorse Campbell). When the bill was introduced, Senator Campbell stated:

As the only American Indian serving in Congress, I am disturbed that individuals, organizations, and groups continue to use terms and slogans that are disparaging and disrespectful to racial and ethnic groups. Although Native American people represent one of the smallest population groups, the contributions they have made to this country's rich history have been significant It disturbs me that today, these insensitive terms and slogans continue to be used freely I will tell you that these practices are not only offensive to Indian people but they also perpetuate the stereotypes that society has of Indian people.

Id.

39. *Id.*

40. *Id.* at S8494.

41. A resolution does not have the force of law; in fact, it has no binding effect at all. BLACK'S LAW DICTIONARY 1310 (6th ed. 1990). It cannot force Jack Kent Cook to change the "Redskins" name, but it is an avenue for the City to express public disapproval of the name and encourage a change.

42. See LEGISLATIVE COUNCIL OF THE DISTRICT OF COLUMBIA REQUEST FOR A NAME CHANGE OF THE NATIONAL FOOTBALL LEAGUE (NFL) WASHINGTON D.C. TEAM OF 1992, PR 9-330 (1992). The resolution found in pertinent part:

(4) The name 'Redskins' is objectionable to many Native Americans and the use of the word 'Redskins' is racially insensitive in a multi-cultural society.

(5) The continued use of an objectionable name is an offense not only to Native Americans, but also is a discredit to the many men who have played

Washington Redskins' owner Jack Kent Cook to cease using the Redskins mark have failed. Cook steadfastly denies that the Redskins' name is offensive, derogatory, disparaging or demeaning to anyone.⁴³ Cook refuses to change the Redskins' name, claiming, "I admire the Redskins name. I think it stands for bravery, courage and a stalwart spirit, and I see no reason why we shouldn't continue to use it."⁴⁴ Furthermore, he contends that the word "Redskin," does not mean, necessarily, generically Indian. It means something that's much more important. It represents courage, a braveness.⁴⁵ Cook, like others, argues that the Indian names were meant to honor rather than disparage.

After all other means of persuasion failed, a group of Native Americans filed a Petition for Cancellation with the United States Patent and Trademark Office (PTO) to cancel the federal registration of the Washington Redskins trademark.⁴⁶ The petitioners claimed that the term "Redskins" was at the time of registration, and continues to be, "a pejorative, derogatory, degrading, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for a Native American person."⁴⁷ Jack Kent Cook is now forced to defend his claim—that the Redskins trademark is not disparaging to Native Americans—if he wishes to maintain its federal registration. While cancellation of the trademark's federal registration does not prevent the team from continuing to use the Redskins name, it does revoke the benefits afforded by federal registration.⁴⁸ Canceling federal registration on the basis that the trademark dis-

outstanding football for the team.

(6) Nicknames and mascots constitute an unauthentic representation of Native Americans, whether used for entertainment, commercial, or symbolic purposes, this imagery degrades Native American people and culture, and distorts Native American and non-Native American perception of self and community.

Id.

43. See, e.g., Page, *supra* note 33, at A9; Bill Pensoneau, *Letters from Readers*, STAR TRIB. (Minneapolis), Sept. 19, 1992, at 14A.

44. Leonard Shapiro, *Native American Coalition Files Action on 'Redskins'*, WASH. POST, Sept. 11, 1992, at C1 (quoting Jack Kent Cook).

45. Doug Grow, *The Way to Redskins Owner's Heart is Through His Wallet*, STAR TRIB. (Minneapolis), Sept. 11, 1992, at 3B (quoting Jack Kent Cook).

46. See Petition for Cancellation at 1, *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828, 1829 (T.T.A.B. 1994). The petitioners have also sought the cancellation of all related trademarks including: "Redskinettes," "Skins," "Redskins," "The Redskins & Design," "Washington Redskins & Design," and "The Redskins—Stylized Letters." The trademarks are owned by a corporation entitled, Pro-Football, Inc. *Id.*

47. *Id.*

48. See Shapiro, *supra* note 44, at C1.

parages Native Americans could eliminate the team's exclusive right to use the trademark.⁴⁹ This would open the doors to others who wish to profit from the Redskins' name, and Jack Kent Cook would be powerless to stop them.⁵⁰ Native Americans hope that the loss of federal government protection of the trademark will provide a sufficient economic incentive to persuade Jack Kent Cook to choose a new team name.⁵¹

3. Why Companies Don't Care if They Offend Native Americans

Perhaps Native American protests over the exploitation of Indian imagery in trademarks continue to go unheard because they do not have the political or economic clout to command an audience. The lack of political influence stems from the relatively small size of the Native American population.

[Native Americans] don't have the numbers. If those nicknames caricatured black culture, and the blacks objected, they would have been wiped off the rosters of every American athletic team from the pros to the peewees. But America and the politicians can afford to tune out the Indians. They have a couple of million people in the United States. They can't influence legislation.⁵²

In addition, because Native Americans represent a relatively small segment of the American population, they don't wield the same consumer buying power that has enabled other minorities to force companies to change trademarks which they find offensive. Trademark owners can afford to offend and alienate Native Americans because they are not dependent on them for their economic survival. "One of the basic premises of advertising is that if it is too offensive to too many people, its use will be counterproductive, for those who are offended will not only refuse to buy the product, but also, if they are sufficiently offended, they will attempt to persuade others to refuse also."⁵³ However, when a truly discrete and insular minority, such as Native Americans, is the subject of the disparaging mark, it does not have the economic power to effectuate a product boycott. For this reason, companies and team owners can ignore the Native Americans until the courts enforce existing restrictions on racially disparaging trademarks.

However, on April 29, 1994, President Clinton met with Native American tribal leaders to discuss tribal sovereignty, economic development

49. See Grow, *supra* note 45, at 3B.

50. See Page, *supra* note 33, at A9.

51. See Shapiro, *supra* note 44, at C1.

52. Jim Klobuchar, *There Can Be No Excuse for Ignoring the Pain of Parody*, STAR TRIB. (Minneapolis), Jan. 22, 1992, at 3B.

53. *Sambo's of Ohio v. City Council of Toledo*, 466 F. Supp. 177, 180 (N.D. Ohio 1979) (holding that it would violate First Amendment rights to restrict the use of the term "Sambo's" regardless of how many people are offended).

and other Indian concerns.⁵⁴ An earlier meeting between Native Americans leaders and the United States Presidency took place in 1822.⁵⁵ President James Monroe invited American Indian leaders to dinner at the White House in an effort to ease tensions after the federal government seized Indian land.⁵⁶ Indicative of the government's insensitivity to Indian customs, upon their arrival at the White House, the Indians were forced to change out of their "Indian garb" and don military uniforms.⁵⁷ President Clinton, considerably more sensitive to the concerns of Native American groups, met with 542 tribal leaders to examine the long-term problems plaguing the Indian people.⁵⁸ The President treated the Indian leaders with the same level of respect as the head of any foreign government. It is hoped this symbolic meeting between the President and the tribal leaders will result in greater awareness and sensitivity to the concerns of Native Americans, including the use of Indian imagery in trademarks.

III. TRADEMARK PROTECTION

"The protection of trade-marks is the law's recognition of the psychological function of symbols If it is true that we live by symbols, it is no less true that we purchase goods by them."⁵⁹ Trademark owners can acquire protection for their marks from three sources: federal registration,⁶⁰ state registration,⁶¹ or the common law. Unlike the state and federal protections, which are only accorded after a trademark owner files a registration, common law rights arise from adoption and use as a trade identifier; and nothing else need be done to acquire common law rights.⁶² "At common law, the exclusive right to a [trademark] grows out

54. See Linda Kanamine, *Tribal Leaders Now Feel They 'Can Be Heard,'* U.S.A. TODAY, Apr. 28, 1994, at A1.

55. See Marla Williams, *Native American Leaders Going to the White House,* SEATTLE TIMES, Apr. 26, 1994, at A1.

56. *Id.*

57. *Id.*

58. See Kanamine, *supra* note 54, at A1.

59. *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

60. The Lanham Act provides the current scheme of federal trademark registration. See 15 U.S.C. §§ 1051-1127 (1988).

61. All states have adopted their own trademark statutes and registration scheme. Most of these statutes are based upon the Model State Trademark Bill.

62. The Trademark Cases, 100 U.S. 82, 94 (1879). However, mere advertising of a mark does not constitute a sufficient use to which common law rights will attach.

of its use.⁶³ Once a trademark is adopted and used in connection with goods or services, the common law creates an enforceable right of exclusivity for the mark's owner in the geographic area in which the mark is used.⁶⁴ This means that the first to use a trademark is the mark's owner in the area of use, and has the right to exclude all others from using trademarks that would be confusingly similar.⁶⁵

Unlike patents and copyrights which are governed exclusively by federal law,⁶⁶ both Congress and state legislatures regulate trademarks.⁶⁷ This concurrent authority exists because the Constitution does not expressly address the power to regulate trademarks. All federal and state statutory trademark law originally stemmed from the state common law of unfair competition.⁶⁸ It wasn't until 1946 that Congress passed the Lanham Act, which provides the current federal registration system for protecting trademarks used in commerce.⁶⁹ The Lanham Act's expresses

See *Western Stove Co. v. Geo. D. Roper Corp.*, 82 F. Supp 206, 216 (S.D. Cal. 1949); *cf.* *Avakoff v. Southern Pac. Co.*, 765 F.2d 1097 (Fed. Cir. 1985) (mere advertising does not constitute a trademark use for purposes of federal registration.)

63. *Id.*

64. *See* *Blue Bell Inc. v. Farah Mfg. Co.*, 508 F.2d 1260 (5th Cir. 1975). Since common law rights attach upon the use of the mark, they can be limited in geographical scope to the area where the mark is used and in a natural zone of expansion. It is possible for two different people to own legitimately, and have rights enforceable at common law, for the same trademark in two different geographic areas. *See* *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918); *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403 (1916).

65. *See* *Modular Cinemas of Am., Inc. v. Mini Cinemas Corp.*, 348 F. Supp. 578 (S.D.N.Y. 1972).

66. The Constitution expressly granted Congress a right to regulate the law of patents and copyrights. *See* U.S. CONST. art. I, § 8, cl. 8. The Supreme Court has held that this grant of regulatory authority to Congress preempts any state regulation of subject matter that comes within Congress' power. States cannot protect subject matter that fails to meet the requirements for federal protection. *See* *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 155-56 (1989); *Compco Corp. v. Day-Brite Lighting Inc.*, 376 U.S. 234, 238 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225, 231 (1964).

67. The Supreme Court has held that Congress does not have exclusive authority to regulate trademarks. *The Trademark Cases*, 100 U.S. 82, 94 (1879). The Court held that Article I, § 8, clause 8, which granted the Congress the right to regulate patents and copyrights, did not extend to trademarks. *Id.* However, Congress does have the authority to regulate trademarks that are used in interstate commerce under the Commerce Clause. *See* U.S. CONST. art. I, § 8, cl. 3.

68. *See* *Two Pesos, Inc. v. Taco Cabana, Inc.*, 112 S. Ct. 2753, 2754-55 (1992).

69. "The term 'trademark' includes any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." 15 U.S.C. § 1127 (1988). The common law definition of a trademark is virtually identical to the Lanham Act's definition. *See* *Blue Bell, Inc. v. Farah Mfg. Co.*, 508 F.2d 1260, 1264-65 (5th Cir. 1975).

its dual purpose to protect both the trademark owner's exclusive right to benefit from his own goodwill and to protect the public from confusion.⁷⁰

The purpose underlying any trade-mark statute is twofold. One is to protect the public so it may be confident that, in purchasing a product bearing a particular trade-mark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its appropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trade-mark owner.⁷¹

A. *The Benefits of Federal Registration*

Federal registration of a trademark affords the mark's owner significant advantages not available at common law. The Lanham Act expands common law trademark rights by protecting service marks and collective marks as well as trademarks.⁷² Federal registration serves as nationwide constructive notice of a trademark's ownership.⁷³ Constructive notice abrogates any geographic limits on the ownership rights that exist in common law. Thus, the owner of a federally registered mark can stop infringements anywhere in the United States.⁷⁴ Federal registration also affords the trademark owner a federal forum to bring any actions in connection with the mark.⁷⁵ Furthermore, federal registration is prima facie evidence of ownership and validity of a trademark.⁷⁶ Additionally, a registration on the principle register can achieve the status of incontestabil-

70. See 15 U.S.C. § 1127 (1988); see also *Springfield Fire & Marine Ins. Co. v. Founders' Fire & Marine Ins. Co.*, 115 F. Supp 787, 791 (N.D. Cal. 1953).

71. S. REP. NO. 1333, 79th Cong., 2d Sess., reprinted in 1946 U.S.C.C.A.N. 1274.

72. 15 U.S.C. §§ 1053, 1054, 1127 (1988). The Lanham Act also permits submission of an application before the applicant even uses the trademark as long as he has a bona fide intent to use the mark. *Id.* § 1051(b). Whereas trademark rights do not attach to the mark until after it is actually used, the benefit of the "intent to use" provision is that upon registration, constructive use is presumed from the date of the application. *Id.* § 1057(c)-(d).

73. *Id.* § 1072. In addition, federal registration serves as constructive nationwide use from the date of filing for federal registration. *Id.* § 1057(c).

74. This general rule is subject to an exception. If another person used the trademark before the filing for federal registration in good faith with no actual knowledge of use by the person filing for federal registration, then the first user can continue to use the mark, but is limited to the geographic area of his use. *Id.* § 1115(c)(5).

75. *Id.* § 1121.

76. *Id.* § 1057(b).

ity after five years.⁷⁷ Incontestability is conclusive evidence of ownership and validity of a mark⁷⁸ and it limits the defenses to an action brought for trademark infringement.⁷⁹ Finally, the owner of a federally registered trademark has a right to request customs officials to bar the importation of any goods bearing an infringing trademark.⁸⁰

B. *The Federal Registration Process*

To obtain federal registration of a trademark on the principle register, the mark's owner must file an application with the Patent and Trademark Office (PTO).⁸¹ The application is reviewed by the examiner *ex parte*.⁸² If an examiner refuses to register the mark, an applicant can appeal to the Trademark Trial and Appeal Board (TTAB).⁸³ If the application passes the hurdles of *ex parte* examination, the mark is published in the Official Gazette for possible oppositions.⁸⁴ Any person who feels that he or she would be damaged by registration of the mark may file an opposition with the PTO.⁸⁵ When an opposition is filed, the TTAB conducts an *inter partes* proceeding to decide whether the opposition has merit.⁸⁶ If the opposition is unsuccessful, or if no opposition is filed, the examin-

77. *Id.* § 1065.

78. *Id.*

79. *See* Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189 (1985) (holding that an incontestable mark may not be challenged on the basis of merely being descriptive).

80. 15 U.S.C. § 1124 (1988).

81. *Id.* § 1051. If an application does not meet the requirements of registration for the principle register but is capable of meeting those requirements in the future, the applicant can seek registration on the Supplemental Register. *Id.* § 1091. For example, a descriptive mark which has not been used long enough to develop the requisite secondary meaning necessary for registration on the Principle Register may be registered on the Supplemental Register. *Id.* § 1051(a). Unlike the Principle Register, the Supplemental Register does not provide the registrant with any substantive rights. However, the Supplemental Register does give the trademark owner access to the federal courts for infringement claims and it could be a prerequisite for foreign registration since many countries require some form of registration in the applicants home country before they will protect a mark abroad. *Id.* § 1126. Hereinafter, this Article will limit its analysis to marks on the Principle Register.

82. *Id.* § 1062(a). An *ex parte* proceeding is between the applicant and the examiner. *See* BLACK'S LAW DICTIONARY 576 (6th ed. 1990).

83. 15 U.S.C. § 1070 (1988). The TTAB is composed of at least three of the following: the Commissioner, the Deputy Commissioner, the Assistant Commissioner and members appointed by the Commissioner. *Id.* § 1067.

84. *Id.* § 1062(a).

85. *See id.* § 1063(a). Oppositions must be filed within 30 days of the publication of the trademark. *Id.*

86. An *inter partes* proceeding is between an applicant or registration owner and any third party. *See* BLACK'S LAW DICTIONARY 817 (6th ed. 1990).

er will then grant the registration.⁸⁷ Once registration is granted, all of the benefits afforded federal registration attach, including the presumption that the trademark is valid.⁸⁸ Registration is granted for a period of ten years and is renewable for successive ten year periods.⁸⁹

While registration does constitute prima facie evidence that the trademark is valid, the mark's validity can still be attacked by any person who believes that she is damaged by the registration.⁹⁰ If the action is taken within five years of the mark's registration, a person who believes that she is damaged by the registration can file a Petition for Cancellation of the trademark for any of the reasons that the examiner could have refused registration.⁹¹ After five years, a Petition for Cancellation can only be filed if the registered mark becomes generic, has been abandoned, was fraudulently obtained, or should not have been granted because the mark was inconsistent with one of the content-based prohibitions in subsections 2(a), (b), or (c) of the Lanham Act.⁹² A Petition for Cancellation, like an opposition, is heard by the TTAB. Decisions of the TTAB can be appealed to either the United States Court of Appeals for the Federal Circuit⁹³ or to a United States District Court.⁹⁴

IV. SECTION 2(A)—BARS TO REGISTRATION

Although there is a presumption of registrability under the Lanham Act, federal registration and enforcement of common law rights are not available for all marks. Section 2 of the Lanham Act contains certain content-based restrictions to registration which cannot be overcome by an association with the applicant's goods.⁹⁵ The bars to registration

87. 15 U.S.C. § 1063(b) (1988).

88. *Id.* § 1057(b).

89. *Id.* §§ 1058(a), 1059(a).

90. *Id.* § 1064.

91. *Id.*

92. *Id.* § 1064(3).

93. *Id.* § 1071. The Federal Circuit was created in 1982 to be a federal court of appeals of limited jurisdiction. The Federal Circuit is empowered to hear appeals from the PTO, replacing the Court of Customs and Patent Appeals (CCPA). In its first decision, the Federal Circuit adopted all prior decisions of the CCPA. *See South Corp. v. United States*, 690 F.2d 1368, 1369 (Fed. Cir. 1982).

94. 15 U.S.C. § 1071(b) (1988). An appeal to a district court may be preferable to some parties because the case is decided de novo. *See Summa Corp. v. California ex rel. State Lands Comm'n*, 466 U.S. 198, 203 (1984).

95. 15 U.S.C. § 1052 (1988). Section 2(e) provides that a mark should be refused registration if it is merely descriptive, primarily geographically descriptive, or primari-

found in subsections 2(a), (b), and (c) are absolute.⁹⁶ According to the Lanham Act, registration is refused if a mark:

(a) Consists of or comprises immoral, deceptive, 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 dispute.⁹⁷

Congress determined that marks that fall within these categories should be prohibited from federal registration for public policy reasons in order to discourage their use.⁹⁸ The Lanham Act is not the first or the only

ly merely a surname. *See id.* § 1052(e). However, the applicant can overcome these restrictions upon a showing of secondary meaning. *Id.* § 1052(f). Secondary meaning is proof that the mark has acquired the requisite distinctiveness necessary for trademark protection. *See Park 'N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 194 (1984). A mark should also be refused registration if it is likely to be confused with another trademark. 15 U.S.C. § 1052(d) (1988). The purpose inherent in each of these restrictions is to avoid consumer confusion.

96. *Id.* § 1052(a)-(c).

97. *Id.* § 1052(a). Although this article focuses its analysis on the prohibition against trademarks that are immoral, scandalous or disparaging under Section 2(a), the Lanham Act also provides that no mark can be registered if it:

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent, or the name, signature, or portrait of a deceased President of the United States during the life of his widow.

Id. § 1052(b)-(c).

98. *Hearings on 4744 Before the Subcomm. on Trademarks of the House Comm. on Patents*, 76th Cong., 1st Sess. 18 (1939) [hereinafter *Hearings*] (statement of Rep. Thomas E. Robertson).

Mr. Robertson. Why should the Congress of the United States, for example, permit Benjamin Harrison's name . . . to be used as a trade-mark on any article, device, or merchandise, even though dead?

Mr. Marony. In other words, we would not want to have Abraham Lincoln gin.

Mr. Robertson. No, sir; we would not.

Mr. Fenning. Or George Washington coffee.

Mr. Rogers. There was a good deal of discussion last year about that very thing, and considerable difficulties seem to arise in connection with it which ever way we jump. I quite agree that Abraham Lincoln gin ought not to be used, but I would not say the use of G. Washington on coffee should not be permissible. We attempted to take care of it in subsection (a) of section 2: 'Consists of or comprises immoral, deceptive, or scandalous matter; or matter which tends to disparage persons, living or dead, institutions, beliefs, or national symbols, or to bring them into contempt.' That would take care of the abuses, but it would not prevent the perfectly legitimate uses of names.

Id.; *see also In re Bush Bros. & Co.*, 884 F.2d 569, 571 n.3 (Fed. Cir. 1989); *Thaddeus Davids Co. v. Davids*, 178 F. 801, 805 (2d Cir. 1910) (holding that immoral and scandal-

prohibition against registration for immoral, scandalous and disparaging marks. Congress had previously prohibited the federal registration of such trademarks in the Lanham Act's 1905 predecessor.⁹⁹ In addition, almost all state legislatures have prohibited registration for scandalous, immoral or disparaging trademarks.¹⁰⁰ International trademark conventions and agreements have also acknowledged that trademarks that fall into these categories have no place in any registration scheme.¹⁰¹

Like trademarks, scandalous and disparaging design patents are not entitled to the benefits and protections of patent laws. Patent examiners

ous trademarks should be refused registration for public policy reasons); 1 JEROME GILSON, *TRADEMARK PROTECTION AND PRACTICE*, § 3.04[6], at 3-112-14 n.92 (1992) ("The Lanham Act operates indirectly to protect the public morals by withholding registration from trademarks which would offend.").

99. Trade-Mark Act of 1905, 15 U.S.C. § 85(a) (1905). It is important to note that the Lanham Act actually broadened the 1905 provision to include a prohibition on marks that disparage any person or bring them into contempt or disrepute.

100. *See, e.g.*, ALA. CODE § 8-12-7(a) (1993); ALASKA STAT. § 45.50.010 (1993); ARIZ. REV. STAT. ANN. § 44-1442 (1993); ARK. CODE ANN. § 4-71-104 (Michie 1993); CAL. BUS. & PROF. CODE § 14200 (West 1994); COLO. REV. STAT. § 7-70-108 (1993); CONN. GEN. STAT. § 35-11b (1993); DEL. CODE ANN. tit 5, § 3303 (1993); FLA. STAT. ch. 495.021 (1993); GA. CODE ANN. § 10-1-441 (1993); IDAHO CODE § 48-502 (1993); ILL. REV. STAT. ch. 140, para. 9 (1992); IND. CODE ANN. § 24-2-1-3 (West 1993); IOWA CODE § 548.2 (1993); KAN. STAT. ANN. § 81-112 (1992); KY. REV. STAT. ANN. § 365.575 (Baldwin 1994); LA. REV. STAT. ANN. § 51:212 (West 1992); MD. CODE ANN. BUS. REG. § 1-404 (1993); MASS. GEN. L. ch. 110b, § 3 (1993); MICH. COMP. LAWS ANN. § 429.32 (West 1992); MINN. STAT. § 333.19 (1993); MISS. CODE ANN. § 75-25-3 (1993); MO. REV. STAT. § 417.001 (1992); MONT. CODE ANN. § 30-13-303 (1991); NEB. REV. STAT. § 87-112 (1992); NEV. REV. STAT. ANN. § 600.330 (Michie 1993); N.H. REV. STAT. ANN. § 350-A:2 (1993); N.J. STAT. ANN. § 56:3-13.2 (West 1993); N.Y. GEN. BUS. LAW § 361 (McKinney 1993); N.C. GEN. STAT. § 80-2 (1993); N.D. CENT. CODE § 47-22-02 (1993); OHIO REV. CODE ANN. § 1329.55 (Anderson 1994); OKLA. STAT. tit. 78, § 22 (1994); OR. REV. STAT. § 647.035 (1991); 54 PA. CONS. STAT. ANN. § 1111 (1992); P.R. LAWS ANN. tit. 10, § 194 (1992); R.I. GEN. LAWS § 6-2-3 (1993); S.C. CODE ANN. § 39-15-120 (Law Co-op. 1991); S.D. CODIFIED LAWS ANN. § 37-6-6 (1993); TENN. CODE ANN. § 47-25-502 (1993); TEX. BUS. & COM. CODE ANN. § 16.08 (West 1994); UTAH CODE ANN. § 70-3-2 (1993); VT. STAT. ANN. tit. 9, § 2527 (1993); VA. CODE ANN. § 59.1-79 (Michie 1993); WASH. REV. CODE ANN. § 19.77.020 (West 1993); WYO. STAT. § 40-1-102 (1993).

101. The North American Free Trade Agreement (NAFTA) has adopted the Lanham Act's prohibition against scandalous, immoral or disparaging trademarks. North American Free Trade Agreement, 1993, art. 1708, § 14, 107 Stat. 2123-24. Even as far back as 1883, countries realized that there were limits to registrability. The Paris Convention provides that a trademark should not be permitted registration if it is "contrary to morality or public order and, in particular, of such a nature as to deceive the public." Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, art. 6B3.

are instructed to reject design patents that consist of material that is scandalous or offensive to members of any race, religion, sex, ethnic group or nationality.¹⁰² However, copyright protection has been extended to material that is obscene or scandalous.¹⁰³ Courts have justified the extension of copyright protection to obscene works on the ground that society's view of what is moral and immoral continually changes; what one generation considers obscene, a later generation might consider of great literary merit.¹⁰⁴

A. Summary of Case Law Decided Under Section 2(a)

"The oft stated maxim that 'each case must be decided on its own facts' never rings so loudly as it does in Section 2(a) refusals."¹⁰⁵

This section begins by summarizing the existing case law implementing Section 2(a)'s prohibition against registering scandalous and immoral marks. It discusses the development of definitions and the factors that tribunals have considered in reaching findings of immorality or scandalousness. This section also considers the development of a separate test under Section 2(a) for trademarks that "disparage or bring [people] into contempt or disrepute."¹⁰⁶

1. Scandalous and Immoral Trademarks

The seminal case for determining whether a trademark is scandalous is *In re Riverbank Canning Co.*,¹⁰⁷ decided in 1938. In this case, the examiner found, and the Court of Customs and Patent Appeals (CCPA) agreed, that the mark "Madonna" for wines should be refused because it was scandalous.¹⁰⁸ The CCPA held that since the legislative history did not contain any definition of the term "scandalous," the court should apply the "ordinary and common meaning" of the word.¹⁰⁹ The court

102. See Patent & Trademark Office, U.S. Dep't of Commerce, MANUAL OF PATENT EXAMINING PROCEDURE § 1504, at 1500-07 (1989).

103. See *Mitchell Bros. Film Group v. Cinema Adult Theater*, 604 F.2d 852, 858 (5th Cir. 1979), *cert. denied*, 445 U.S. 917 (1980).

104. *Id.* at 857.

105. *In re Mavety Media Group Ltd.*, 1993 TTAB LEXIS 25, *15 (May 5, 1993), *vacated*, 1994 U.S. App. LEXIS 22772 (Fed. Cir. Aug. 23, 1994).

106. 15 U.S.C. § 1052(a) (1988).

107. 95 F.2d 327 (C.C.P.A. 1938). This case was actually brought under the Lanham Act's 1905 predecessors which prohibited the federal registration of marks that were scandalous or immoral. To be precise, the very first trademark denied registration as scandalous was "Queen Mary" for women's undergarments. *Ex parte Martha Maid Mfg.*, 37 U.S.P.Q. (BNA) 156 (1938).

108. *Riverbank Canning*, 95 F.2d at 329.

109. *Id.* at 328.

looked to dictionaries which defined scandalous as "shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable . . . [g]iving offense to the conscience or moral feelings."¹¹⁰ The court also turned to dictionaries to define the term "Madonna."¹¹¹ Although the court concluded that the word "Madonna" was not per se scandalous, it was scandalous in light of the goods to which it was applied—wine.¹¹² In 1959, registration was again denied (this time under the Lanham Act) for the trademark "Madonna" for wines on the grounds that the term was scandalous.¹¹³ The court held that the word "scandalous" in the Lanham Act has the same meaning as its 1905 predecessor, and, therefore, the cases should be decided under the same analysis.¹¹⁴

Due to the paucity of legislative history defining the terms "scandalous" and "immoral," courts have cited to the *Riverbank Canning* decision that held these terms be given their "ordinary and common meaning."¹¹⁵ To ascertain the framers' intent as to the definition of the terms "scandalous" and "immoral," courts have turned to the dictionary definitions of the terms extant at the time of the Lanham Act.¹¹⁶ These courts have generally adopted the definition of "scandalous" as stated in *Riverbank Canning*: "Shocking to one's sense of decency or propriety" and "offensive to the conscience or moral feelings."¹¹⁷

110. *Id.* at 329.

111. *Id.* at 328.

112. *Id.* at 329. To determine whether a mark is scandalous, the mark must be considered in the context of the market place for the goods identified in the application for registration. *Id.*; see also *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981); *Greyhound Corp. v. Both Worlds, Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988); *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1471 (T.T.A.B. 1988); *In re Thomas Labs, Inc.*, 189 U.S.P.Q. (BNA) 50, 52, (T.T.A.B. 1975); *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. (BNA) 227,229 (1951) (holding that a trademark is unregistrable if it is scandalous as applied to the goods on which it will be used; the mark itself need not be per se scandalous).

113. See *In re P.J. Valckenberg*, 122 U.S.P.Q. (BNA) 334 (T.T.A.B. 1959). For similar reasons, the TTAB denied registration for the mark "Messias" for wine and brandy back in 1968. See *In re Sociedade Agricola E. Comercial Dos Vinhos Messias*, 159 U.S.P.Q. (BNA) 275, 276 (T.T.A.B. 1968).

114. *Valckenberg*, 122 U.S.P.Q. (BNA) at 334-35.

115. See, e.g., *Greyhound*, 6 U.S.P.Q.2d (BNA) at 1638; *In re Tinsletown, Inc.*, 212 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1981); see also *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1218 (T.T.A.B. 1993).

116. See, e.g., *Greyhound*, U.S.P.Q.2d (BNA) at 1638; see also *McGinley*, 660 F.2d at 485-86; *Riverbank Canning*, 95 F.2d at 328; *Old Glory*, 26 U.S.P.Q.2d (BNA) at 1218.

117. See *Riverbank Canning*, 95 F.2d at 329.

The scandalous and immoral bars to registration have not been limited to marks that have religious significance. In 1971, the TTAB denied registration for the mark "Bubby Trap" as applied to brassieres.¹¹⁸ The tribunal held that the mark would be offensive to one's sense of propriety or morality because the term "bubby" is a vulgar reference to a woman's breast.¹¹⁹

In applying the standards of scandalousness to determine whether a trademark is registerable, the Board has held that whether a mark is "shocking to a sense of propriety" is to be determined according to contemporary standards of acceptability.¹²⁰ While a court is bound to the dictionary definitions existing at the time of the Lanham Act for interpreting the terms of the statute, it must refer to contemporary dictionaries to ascertain the definition of the term that the applicant seeks to register as a trademark.¹²¹ "[W]hat was considered scandalous as a trademark or service mark twenty, thirty or fifty years ago may no longer be considered so, given the changes in societal attitudes. Marks once thought scandalous may now be thought merely humorous (or even quaint)"¹²²

In 1975, the TTAB reversed the examiner's refusal to register a mark picturing a "cartoon-like representation of a melancholy, unclothed male figure ruefully contemplating an unseen portion of his genitalia," for a device that increases the size of a man's penis.¹²³ The Board held that whether a mark is scandalous or immoral must be determined according to contemporary standards of acceptability.¹²⁴ In this case, the Board determined that the nakedness of the cartoon mark was not shocking to

118. See *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443 (T.T.A.B. 1971).

119. *Id.* at 444.

120. See *In re Hershey*, 5 U.S.P.Q.2d (BNA) 1470, 1471 (T.T.A.B. 1988) ("[T]he trend in case law demonstrates a more contemporary attitude toward language and evidences a more liberal approach to what constitutes scandalous or vulgar language."); *In re Leo Quan Inc.*, 200 U.S.P.Q. (BNA) 370, 371 (T.T.A.B. 1978) (determining that the trademark "Badass" [acronym for "Bettncourt Acoustically Designed Audio Sound Systems"] for use on stringed musical instrument bridges is not scandalous or immoral according to the "mores of our time"); *In re Madsen*, 180 U.S.P.Q. (BNA) 334, 335 (T.T.A.B. 1973) (holding that the trademark "Week-End Sex" for a magazine is not scandalous according to "moral values and conduct fashionable at the moment, rather than that of past decades"); see also *Old Glory*, 26 U.S.P.Q.2d (BNA) at 1219.

121. See, e.g., *In re Tinsletown*, 212 U.S.P.Q. (BNA) 863, 866 (T.T.A.B. 1981) (holding that the court must look to contemporary dictionaries to determine if the term "Bullshit" should be denied registration); *Hershey*, 6 U.S.P.Q.2d (BNA) at 1471-72 (contemporary dictionaries must be consulted to ascertain the meaning of "pecker").

122. *Old Glory*, 26 U.S.P.Q.2d (BNA) at 1219 (stating that in light of contemporary attitudes, use of the mark "Old Glory Condom Corp." with an American flag design on condoms is not scandalous).

123. *In re Thomas Labs, Inc.*, 189 U.S.P.Q. (BNA) 50, 52 (T.T.A.B. 1975).

124. *Id.* at 52.

society's sense of propriety and involved no threat to present day public morals because contemporary society's attitude toward obscenity has become increasingly liberal.¹²⁵

In *In re McGinley*, the CCPA upheld the examiner's refusal to register a photograph of a nude man and woman kissing and embracing in a manner that exposes the male genitalia because it was scandalous and immoral.¹²⁶ The CCPA held that whether a mark is scandalous or immoral "is to be ascertained from the standpoint of not necessarily a majority, [but] a substantial composite of the general public."¹²⁷ Subsequent cases have applied this "substantial composite of the general public" standard with approval.¹²⁸

In a 1993 decision, the TTAB granted federal registration for the mark "Old Glory Condom Corp." which pictured a condom decorated with stars and stripes to resemble an American flag.¹²⁹ The TTAB has held that an examiner must determine whether a mark is likely to offend by considering the entire context of the mark's use.¹³⁰ In this case, the

125. *Id.*

126. *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981).

127. *Id.* at 485. The *McGinley* court claimed that this "substantial composite of the general public" test came from *Riverbank Canning*. However, this author has been unable to find such a suggestion in the *Riverbank Canning* case. *See id.* at 487 ("The majority cites *Riverbank* in apparent support of using as a basis for decision the imagined feelings of 'a substantial composite of the general public.' There is no such expression in *Riverbank*."). (Rich, J., dissenting). However, subsequent cases have cited the "substantial composite of the general public" standard with approval. *See infra* note 128.

128. *See In re Tinsletown, Inc.*, 212 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1981) (holding that the mark "Bullshit" for accessories is scandalous). The TTAB rejected applicant's argument that whether the mark is scandalous should be determined according to the views of applicant's customers, not the general public. *Id.*; *see also* *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d (BNA) 1635, 1639 (T.T.A.B. 1988) (stating that a substantial composite of the general public would find a mark which depicts a dog defecating scandalous); *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1471 (T.T.A.B. 1988) (holding that the mark "Big Pecker" was not scandalous because the TTAB found that the evidence was at best marginal that a substantial composite of the general public would believe that the mark referred to a man's penis instead of a bird's beak).

129. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216 (T.T.A.B. 1993).

130. *Id.* at 1221 (holding that the serious purpose surrounding the use of applicant's mark is a factor to be taken into account when determining if the mark is offensive or shocking); *see Hershey*, 6 U.S.P.Q.2d (BNA) at 1471 (reasoning that since the applicant's mark "Big Pecker" was used in conjunction with a picture of a bird with a big beak, it was not scandalous).

Board concluded that the mark was not scandalous because its serious purpose—to prevent the spread of AIDS—was manifest to purchasers on the package.¹³¹

2. Disparaging Trademarks

Section 2(a) prohibits the registration of any mark “which may disparage . . . persons . . . or bring them into contempt, or disrepute.”¹³² In most cases, when a mark is refused or opposed as disparaging, there is an accompanying charge that the mark is also scandalous.¹³³ This is probably due to the dearth of case law addressing the issue of disparaging trademarks.¹³⁴

Doughboy Industries, Inc. v. Reese Chemical Co. was the first case to refuse registration to a trademark on the grounds that it was disparaging.¹³⁵ The Examiner in Chief of the Patent Office held that the mark “Dough-Boy” for “a prophylactic preparation for the prevention of venereal disease,” was disparaging because American soldiers during World War I were called doughboys.¹³⁶ The examiner found that there was no doubt as to the word’s intended meaning because the package contained a picture of an American soldier.¹³⁷ The examiner also held that in determining disparagement, the examiner, should consider the particular goods to which the mark will be applied.¹³⁸

The next case to discuss disparagement was *In re Reemtsma Cigarettenfabriken*.¹³⁹ In this case, the TTAB refused registration because the mark “Senussi” for cigarettes, disparaged the religious beliefs of the Senussi sect whose religion forbids smoking.¹⁴⁰ The Board stated

131. *Old Glory*, 26 U.S.P.Q.2d (BNA) at 1221. However, the TTAB previously held that, as in the case of registration for trademarks in states or foreign countries, the applicant’s intent in using the mark is irrelevant to a determination of whether the mark is scandalous. *In re Tinsletown, Inc.*, 212 U.S.P.Q. (BNA) 863, 865-66 (T.T.A.B. 1981). The cases discussed in this Article are certainly not an exhaustive list of all cases brought under § 2(a)’s scandalous or immoral provisions.

132. 15 U.S.C. § 1502(a) (1988). It is important to note that the Lanham Act’s 1905 predecessor did not contain a prohibition against disparaging marks. *See supra* note 99 and accompanying text.

133. *See Old Glory*, 26 U.S.P.Q.2d (BNA) at 1221 n.4. However, in this case, the court held that the test for disparagement and scandalous were the same, expressly noting that these tests might not always be the same.

134. *See id.* at 1221 n.4 (“[T]here is little precedent on the meaning of ‘disparage’ in Section 2(a).”).

135. 88 U.S.P.Q. (BNA) 227 (P.T.O. 1951).

136. *Id.* at 227-28.

137. *Id.* at 228.

138. *Id.*

139. 122 U.S.P.Q. (BNA) 339 (T.T.A.B. 1959).

140. *Id.* at 339.

that "[t]he application of the name of any religious order or sect to a product whose use is forbidden to the followers or adherents of such sect or order is an affront to such persons and tends to disparage their beliefs."¹⁴¹

In the 1975 case of *In re Condas*, the TTAB determined that the trademark "Jap" for women's clothing does not disparage Japanese people.¹⁴² However, this Article argues that the case has little precedential value.¹⁴³ In *Condas*, the TTAB claimed that a New York Supreme Court case which held that the term "Jap" was not derogatory and did not subject Japanese people to "contempt, ridicule, or scandal," was persuasive authority.¹⁴⁴ However, the case relied upon by the TTAB, *Japanese American Citizen's League v. Takada*, actually held that the petitioners were not entitled to an injunction because they could not prove economic injury.¹⁴⁵ Petitioners no longer need to prove economic injury to challenge the registrability of trademark.¹⁴⁶ Furthermore, in *Condas*, the TTAB was also persuaded by the applicant's contention that he would never disparage Japanese people because he himself is Japanese.¹⁴⁷ As one commentator argued, "[t]his argument is preposterous. If accepted, it would mean an African American could trademark the word 'nigger' or an Hispanic American could trademark 'spick.'"¹⁴⁸

141. *Id.* The use of the product must be forbidden by the group before registration will be refused. See *In re Waughtel*, 138 U.S.P.Q. (BNA) 594, 594-95 (T.T.A.B. 1963) (holding that the mark "Amish" for cigars did not disparage the "Amish" people in the absence of any Amish teachings or rules referring to smoking).

142. 188 U.S.P.Q. (BNA) 544 (T.T.A.B. 1975).

143. *Id.* at 544; see *Japanese-Am. Citizen's League v. Takada*, 171 U.S.P.Q. (BNA) 109 (N.Y. Sup. Ct. 1971).

144. *Condas*, 188 U.S.P.Q. (BNA) at 544.

145. *Takada*, 171 U.S.P.Q. (BNA) at 109 ("The only injury alleged by the petitioners appears to be injury to petitioners' feelings. Petitioners do not claim that the . . . [u]se of the word or trade name deprived them of a valuable right to the word.").

146. See *infra* notes 241-45 and accompanying text.

147. *Condas*, 188 U.S.P.Q. (BNA) at 544.

148. Paul E. Loving, Comment, *Native American Team Names in Athletics: It's Time to Trade These Marks*, 13 LOY. L.A. ENT. L.J. 1, 26 (1992). Loving's article argues that professional teams should voluntarily cease using any names or images that pertain to race. "The present images are contrary to progressive social norms and practices and their use should be voluntarily discontinued." *Id.* at 43. He further contends that Native Americans should seek cancellation of disparaging trademarks under the Lanham Act. *Id.*

In 1988, the TTAB, established a test for disparagement in *Greyhound Corp. v. Both Worlds Inc.*,¹⁴⁹ which requires:

- (1) that the communication reasonably would be understood as referring to the plaintiff; and (2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities.¹⁵⁰

In *Greyhound*, the court held that the applicant's mark depicting a defecating dog disparaged the plaintiff's running dog mark and was, therefore, barred from registration.¹⁵¹ The TTAB decided that disparagement was "a violation of one's right of privacy—the right to be 'let alone' from contempt or ridicule."¹⁵² In formulating its test for disparagement, the Board adopted the definition of disparagement offered by the Second Restatement of Torts pursuant to which, "[a] statement is disparaging if it is understood to cast doubt upon the quality of another's land, chattels or intangible things"¹⁵³ The Board also relied on a case where the court adopted the Restatement definition and formulated the above test for determining whether an advertisement disparages another's products.¹⁵⁴ The inherent problem in the Board's reliance on the Restatement is that it is inconsistent with the Board's prior decisions that the terms in the Lanham Act be given their "ordinary and common meaning" at the time of their enactment by searching the terms in dictionaries extant at the time of the Act.¹⁵⁵ Congress could not have intended to adopt the Restatement's definition of disparagement because it was written thirty years after the Lanham Act was enacted. Moreover, Section 2(a) of the Lanham Act specifically includes a prohibition against trademarks that disparage "persons living or dead, institutions, beliefs, or national symbols,"¹⁵⁶ but the Restatement focuses only on the disparagement of property.¹⁵⁷ Even if the Board upheld *Greyhound's* test for disparagement, it should be limited to cases which, like *Greyhound*, consider whether one trademark disparages another. It would be inappropriate to apply this test to cases of alleged racial disparagement.¹⁵⁸

149. 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1988).

150. *Id.* at 1639 (citing RESTATEMENT (SECOND) OF TORTS § 629 (1977)).

151. *Id.* at 1640. The court also found that a substantial composite of the general public would find the mark to be scandalous because it was offensive. *Id.* at 1638.

152. *Id.* at 1639.

153. RESTATEMENT (SECOND) OF TORTS § 629 (1977).

154. *Eagle's Eye, Inc. v. Ambler Fashion Shop*, 627 F. Supp. 856, 863 (E.D. Pa. 1985).

155. *See supra* note 116 and accompanying text.

156. 15 U.S.C. § 1052(a) (1988).

157. *See supra* note 153.

158. *See infra* notes 182-84 and accompanying text.

The next case decided by the TTAB permitted the registration of the mark "Moonies," where the "oo" portion of the applicant's mark depicted a caricature of naked buttocks, in connection with dolls "which drop their pants when a collapsible bulb is squeezed, thus exposing their buttocks," despite claims that the mark disparaged members of the Unification Church founded by Sun Myung Moon.¹⁶⁰ In this case, the board agreed with the examiner's contention that the term "Moonies" alone was not per se disparaging to members of the Unification Church.¹⁶⁰ It found that "Moonies" was an accepted, non-derogatory term describing a member of the Unification Church.¹⁶¹ The examiner, however, agreed that the caricature of the naked buttocks within the second and third letters of the applicant's mark was "lacking in taste" and "an affront to an organized religious sect."¹⁶² The Board noted that although a dictionary did not define "Moonies" as members of the Unification Church, other dictionaries defined the word "moon" as the exposure of one's buttocks.¹⁶³ The Board ultimately held that the mark did not disparage members of the Unification Church because the "Moonies" mark, with its naked buttocks design, would be perceived by the public as referring to the fact that the doll "moons" people and would not be perceived as referring to members of the Unification Church.¹⁶⁴ However, the Board noted that,

[b]ecause the guidelines are somewhat vague and because the determination is so highly subjective, we are inclined to resolve doubts on the issue of whether a mark is scandalous or disparaging in favor of [the] applicant and pass the mark for publication with the knowledge that if a group does find the mark to be scandalous or disparaging, an opposition [or cancellation] proceeding can be brought and a more complete record can be established.¹⁶⁵

159. *See In re In Over Our Heads Inc.*, 16 U.S.P.Q.2d (BNA) 1653-54, 1653 (T.T.A.B. 1990).

160. *Id.* at 1654. In fact, the mark "Moonies" had already been federally registered by another applicant for use on clothing. *Id.*

161. *Id.* at 1654 n.4. The Board reached this conclusion by finding that the dictionary definitions did not state that "Moonies" is derogatory or disfavored. *Id.* at 1654. In addition, the applicant had presented numerous newspaper articles that used the term "Moonies." From these articles, the Board concluded that the term must not be derogatory because such major newspapers would never repeatedly use a term which disparages a particular religious group. *Id.* at 1654 n.4.

162. *Id.* at 1654 (citations omitted).

163. *Id.*

164. *Id.*

165. *Id.* at 1654-55.

In 1993, the TTAB decided that the mark "Black Tail" for a magazine which featured pictures of naked African-American women was scandalous because it was "degrading to women" and "offensive to one's sense of propriety."¹⁶⁶ The examiner argued, and the court agreed, that the mark should be refused because the term "Black Tail" "connotes black women as . . . sexual object[s] which would be an affront to women in general and black women specifically."¹⁶⁷ Although this case would seem to fit squarely within Section 2(a)'s prohibition against disparaging marks, the Board instead, decided it under the test for scandalousness, stating that "[a]lthough we believe that women in general and African-American women in particular would be especially offended by the mark, we think that others, including a substantial number of men, likewise would be offended."¹⁶⁸

However, the Federal Circuit later vacated and remanded this case on grounds that the Board failed to provide concrete evidence that a substantial composite of the general public would find the mark scandalous.¹⁶⁹

B. *The Test for Racial Disparagement*

This Article argues that the case law discussing Section 2(a)'s prohibition against the registration of disparaging trademarks has, thus far, failed to provide either an appropriate definition of disparagement or a workable test for determining when a mark is unregistrable because it could disparage.¹⁷⁰ Since the legislative history does not reveal Congress' intent in using the word "disparage," it should be given its ordinary and common meaning at the time of the Lanham Act's enactment. Dictionaries of that time defined "disparage" as "[t]o speak slightly of; to undervalue; to discredit,"¹⁷¹ and "to dishonor by bringing discredit or reproach upon . . . depreciate, cheapen."¹⁷² According to these defini-

166. *In re Mavety Media Group Ltd.*, 1993 TTAB LEXIS 25, *15 (May 5, 1993), vacated, 1994 U.S. App. LEXIS 22772 (Fed. Cir. Aug. 23, 1994).

167. *Id.* at *5 (quoting Examining Attorney's Brief at 4).

168. *Id.* at *12.

169. *Id.* at *14.

170. This Article contends that the test enumerated in *Greyhound* is inappropriate for cases dealing with disparagement of persons and that this test was developed to implement a definition of disparagement that Congress could never have intended. See *supra* notes 153-58 and accompanying text.

171. Reply Memorandum in Support of Petitioners' Motion to Strike Affirmative Defenses at 9, *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994) (quoting THE NEW COMPREHENSIVE STANDARD DICTIONARY OF THE ENGLISH LANGUAGE 293 (Funk & Wagnalls Co. 1938)).

172. *Id.* at 9 (quoting WEBSTER'S NEW IDEAL DICTIONARY 245 (G. & C. Merriam Co. 1931)).

tions, Section 2(a) should prohibit the registration of a trademark, which discredited or degraded any person, institution, belief, or national symbol.

It is important to note from the outset, that the statute clearly distinguishes between the test for scandalous and immoral marks, on the one hand, and disparaging marks on the other. Section 2(a) provides that registration should be refused when a mark “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which *may* disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.”¹⁷³ The statute does not prohibit “matter which disparages;” rather, it prohibits “matter which *may* disparage.” The latter is certainly a broader prohibition than the former. This Article argues that, unlike the test for scandalous matter, which is limited to an inquiry of whether the matter is scandalous at the time the applicant is seeking registration, the presence of the word “may” in the disparagement language expresses Congress’ intent that marks that could or might be disparaging, even if they are not considered so at the time of the application, should be barred from federal registration.¹⁷⁴ If the statute is interpreted in this manner, petitioners who seek to cancel a mark on the ground that it disparages would be able to include proof that the mark has, since its registration, become disparaging. Thus, if a petitioner could show that the mark has, since its registration, become disparaging, this would demonstrate the fact that the mark had the potential to be disparaging from the outset, and therefore, should never have been granted registration.¹⁷⁵

Tribunals have held that the relevant determination for whether a mark should be cancelled for disparagement is whether the mark consisted of matter that disparaged, at the time the registration was issued. In a hearing on the Petition for Cancellation of the “Redskins” trademark, the TTAB held, “the case will be determined by deciding whether, at the time

173. 15 U.S.C. § 1502(a) (1988) (emphasis added).

174. This Article is not suggesting that examiners perform the impossible task of determining whether a mark may disparage some group in the future when there is no indication of any current disparagement.

175. Evidence of disparagement after issuance of the registration should only be offered to prove that the mark may have disparaged the group when it was registered. This would prevent a group that comes into being after the registration of a mark from petitioning to cancel a mark on the basis that it now disparages them or their beliefs. To cancel a mark because it disparages, the mark has to have the potential to disparage the group at the date of its registration. If the group did not exist at the time the mark was registered, it could not have disparaged them.

these registrations issued, the various marks were scandalous and/or disparaging."¹⁷⁶ The Board recognized that its holding regarding the existence of the grounds for cancellation at the time of the registration might result in allowing deceptive or scandalous marks to maintain their federal registration.¹⁷⁷ The Board, however, concluded that this result would have to be tolerated because "it appears that the framers of the Act were attempting to strike a balance between the needs of the public and the needs of trademark owners."¹⁷⁸

The only existing test for disparagement emanated from *Greyhound Corp. v. Both Worlds Inc.*¹⁷⁹ The TTAB held that a mark is disparaging if it is shown: "(1) that the communication reasonably would be understood as referring to plaintiffs; and (2) that the communication is disparaging, that is, would be considered offensive or objectionable by a reasonable person of ordinary sensibilities."¹⁸⁰

Despite the fact that this test was developed in accordance with a definition that was limited to the disparagement of property, it provides a foundation for creating a test for racial disparagement. This Article agrees with the first prong of the *Greyhound* disparagement inquiry that the mark must reasonably be understood as referring to the plaintiff. If the public does not perceive the mark as referring to the plaintiff, there is no basis for claiming that the mark discredits or degrades the person bringing the action.¹⁸¹ This author sees no reason to treat the disparagement of people any differently.

However, the second part of the *Greyhound* inquiry, which creates a reasonable person test, is not well-suited to disparagement of persons.¹⁸² Who should be the relevant public for determining whether a trademark disparages a group or their beliefs: the trademark owner's customers, the general public, or the members of the group that the mark could disparage? Clearly, the trademark owner's customers would not be an appropriate source for determining whether the mark is disparaging to a group. If they believed that it was disparaging, presumably they would not have bought the product.¹⁸³ Besides, courts have not

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

177. *Id.*

178. *Consorzio del Prosciutto di Parma v. Parma Sausage Prods., Inc.*, 23 U.S.P.Q.2d (BNA) 1894, 1898-99 (T.T.A.B. 1992) (declining to cancel a mark even though it was geographically deceptive at the time of trial because it was not geographically deceptive when registered).

179. 6 U.S.P.Q.2d (BNA) 1635 (T.T.A.B. 1988).

180. *Id.* at 1639.

181. *Id.*

182. *See id.*

183. *Cf. In re Tinsletown, Inc.*, 212 U.S.P.Q. (BNA) 863, 865 (T.T.A.B. 1951) (rejecting the trademark owner's argument that the question of whether a mark is scandal-

limited the scandalousness inquiry to customers.¹⁸⁴ For a determination of whether a mark is scandalous or immoral, the relevant public is a substantial composite of the general public.¹⁸⁵ However, a substantial composite of the general public is not appropriate for determining disparagement of persons either because, unlike scandalousness, which is determined according to what society finds offensive, for disparagement, one must look to whether a group (as opposed to society) will be offended by a mark.¹⁸⁶ While any reasonable person would suffice for a determination of whether a mark disparages another's property (commercial disparagement), the test for whether a mark disparages persons in a group should be determined from the standpoint of a reasonable person in that group or a substantial composite of the group. This is especially true when the inquiry concerns the disparagement of a racial minority.

C. *The Constitutionality of Section 2(a)*

"I disapprove of what you say, but I will defend to death your right to say it."¹⁸⁷ The First Amendment states, "Congress shall make no law . . . abridging the freedom of speech."¹⁸⁸

1. First Amendment Protection for Trademarks

As commercial speech, a trademark is entitled to protection under the First Amendment.¹⁸⁹

ous should be determined by its "posh clientele").

184. See *supra* notes 128-29 and accompanying text.

185. See *In re McGinley*, 660 F.2d 481, 485 (C.C.P.A. 1981).

186. This is true unless the court looks to a substantial composite of the group possibly being disparaged. See *Loving*, *supra* note 148, at 38-39 (arguing that the relevant public for a determination of whether Indian team names disparage Native Americans should be a substantial composite of Native Americans, not the general public).

187. *Sambo's of Ohio, Inc. v. City Council of Toledo*, 466 F. Supp. 177, 180 (N.D. Ohio 1979) (citations omitted).

188. U.S. CONST. amend. I.

189. *Friedman v. Rogers*, 440 U.S. 1, 11 (1979) (holding that trade names are commercial speech); see also *Silverman v. CBS, Inc.*, 870 F.2d 40, 48 (2d Cir 1989); *Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686, 694 (6th Cir. 1981); *Sambo's of Ohio v. City Council of Toledo*, 466 F. Supp. 177, 179 (N.D. Ohio 1979); Harvey S. Perlman, *The Restatement of the Law of Unfair Competition: A Work in Progress*, 80 TRADEMARK REP. 461, 481 (1990) ("Trademark use fits clearly under *Virginia Pharmacy* as commercial speech . . ."); Robert N. Kravitz, *Trademarks, Speech, and the Gay Olympics Case*, 79 TRADEMARK REP. 604, 610 ("The use of a

It would appear that a company's trademark is the most important element of commercial speech which is communicated to consumers. If commercial speech is protected under the First Amendment to preserve a free market place of commercial messages and to contribute to free competition, then a trademark is at the core of the First Amendment protection All other elements of advertising commercial speech revolve around, relate to and are symbolized by the trademark.¹⁹⁰

Congress did not consider the relevance of the First Amendment when it enacted Section 2(a). This is apparent because the Lanham Act was promulgated long before First Amendment protections were extended to commercial speech.¹⁹¹

Trademark case law has, thus far, virtually ignored the possible conflict between the content-based restrictions contained in section 2(a) and the United States Constitution. Only one court has addressed the constitutionality of section 2(a), and it concluded, without any analysis, that First Amendment rights were not at issue because the trademark owner was not denied the right to use the mark, but merely denied the benefits afforded by federal registration.¹⁹² However, a determination that sec-

trademark in business is commercial speech.”). Commercial speech is defined as speech that proposes a commercial transaction. See *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumers Council, Inc.*, 425 U.S. 748, 762 (1976); *Posadas de P.R. Assoc. v. Tourism Co.*, 478 U.S. 328, 340 (1986). A trademark clearly falls within the definition of commercial speech. *Friedman*, 440 U.S. at 11. However, courts have decided that commercial speech is entitled to a more limited form of First Amendment protection. See *infra* notes 202-04 and accompanying text.

190. J. Thomas McCarthy, *Compulsory Licensing of a Trademark: Remedy or Penalty*, 67 TRADEMARK REP. 197, 234 (1977).

191. Prior to 1976, commercial speech was beyond the scope of the First Amendment. See *Pittsburgh Press Co. v. Pittsburgh Comm'n on Human Relations*, 413 U.S. 376, 388 (1973); *Breard v. Alexandria*, 341 U.S. 622, 642-43 (1951); *Valentine v. Chrestensen*, 316 U.S. 52, 54 (1942). Section 2(a) was enacted in 1946, years before first amendment protections were extended to commercial speech in 1976. See generally *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumers Council, Inc.* 425 U.S. 748 (1976).

192. *In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981). Even the attorney for the Native Americans, who filed the Petition for Cancellation of the “Redskins” trademark, concedes that the *McGinley* court's treatment of the first amendment question was without merit:

In the *McGinley* decision, the CCPA, held that a trademark applicant's “First Amendment rights would not be abridged by the [PTO] refusal to register his mark.” In reaching this conclusion, however, the court failed to articulate much support for it. Conspicuously absent from its opinion was any discussion of the unconstitutional conditions doctrine, or commercial speech balancing principles. Moreover, the court seemed to gloss over a difficult constitutional question when it suggested that First Amendment interests are not implicated by Section 2(a) because “the PTO's refusal to register [applicant's] mark does not affect his right to use it.” . . . Although in *McGinley* the CCPA purported to disperse the constitutional cloud hovering over Section

tion 2(a) does not prohibit use, does not end the First Amendment inquiry.

2. The Unconstitutional Conditions Doctrine

While it is true that a denial of registration does not prevent the trademark owner from continuing to use his trademark in conjunction with his products,¹⁹³ it does deny the trademark owner the benefits afforded by federal registration.¹⁹⁴ Denial of registration will certainly act as an economic deterrent and discourage use of the trademark. "[T]he fact that no direct restraint or punishment is imposed upon speech or assembly does not determine the free speech question. Under some circumstances, indirect 'discouragements' undoubtedly have the same coercive effects upon the exercise of the First Amendment rights as imprisonment, fines, injunctions or taxes."¹⁹⁵ In this regard, the Supreme Court has stated:

To deny . . . [a benefit] to claimants who engage in certain forms of speech is in effect to penalize them for speech. Its deterrent effect is the same as if the State were to fine them for speech . . . [denying a benefit] for engaging in certain speech necessarily will have the effect of coercing the claimants to refrain from the proscribed speech.¹⁹⁶

The Supreme Court has held that the government cannot condition access to a benefit on the waiver of a constitutionally protected right under the "unconstitutional conditions" doctrine.¹⁹⁷

2(a), it did so without a reasoned and well-articulated analysis of the difficult underlying issues.

Stephen R. Baird, *Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks*, 83 TRADEMARK REP. 661, 685-86 (1993) (citations omitted).

193. See *McGinley*, 660 F.2d at 484, 486 n.12; *Holiday Inn v. Holiday Inns, Inc.*, 534 F.2d 312, 319 n.6 (C.C.P.A. 1976).

194. *McGinley*, 660 F.2d at 486 n.12 ("[T]here is no prohibition of appellant's use of his mark . . . [w]hat is denied are the benefits provided by the Lanham Act which enhance the value of the mark."). Federal registration provides a mark's owner with benefits not available at common law or through state registration. See *supra* notes 72-81 and accompanying text.

195. *American Communications Ass'n v. Douds*, 339 U.S. 382, 402 (1950).

196. *Speiser v. Randall*, 357 U.S. 513, 518-19 (1958).

197. See, e.g., *FCC v. League of Women Voters*, 468 U.S. 364, 399-401 (1984); *Regan v. Taxation With Representation*, 461 U.S. 540, 545 (1983) ("The government may not deny a benefit to a person because he exercises a constitutional right."); *Thomas v. Review Bd. of the Ind. Employment Sec. Div.*, 450 U.S. 707, 717 (1981) (declaring that the state may not make benefits contingent on the denial of a constitutional right); *Healy v. James*, 408 U.S. 169, 181 (1972); *Shapiro v. Thompson*, 394 U.S. 618,

{T}his court has made clear that even though a person has no 'right' to a valuable government benefit and even though the government may deny him the benefit for any number of reasons, there are some reasons upon which the government may not rely. It may not deny a benefit to a person on the basis that it infringes his constitutionally protected interests—especially his interest in the freedom of speech. For if the government could deny a benefit to a person because of his constitutionally protected . . . [rights], his exercise of those freedoms would in effect be penalized and inhibited. This would allow the government to 'produce a result which [it] could not command directly.'¹⁹⁸

Since Section 2(a) contains a content-based restriction that conditions the benefits accorded by federal registration upon a finding that the trademark is not immoral, scandalous, or disparaging, it abridges the trademark owner's First Amendment rights. The government is, in effect, attempting to suppress speech through the denial of trademark registration.¹⁹⁹

3. The *Central Hudson* Analysis for Determining Whether Section 2(a) is an Unconstitutional Regulation of Commercial Speech

It is beyond dispute that the First Amendment protects commercial speech.²⁰⁰ However, there are limits to First Amendment protection when the expression at issue is commercial speech.²⁰¹ "[O]ur decisions have recognized 'the 'common-sense' distinction between speech proposing a commercial transaction, which occurs in an area traditionally subject to government regulation and other varieties of speech.' Thus, we have held that the Constitution accords less protection to commercial

627 n.6 (1969); *Sherbert v. Verner*, 374 U.S. 398, 406 (1963) (stating that denial of government benefits "effectively penalizes the free exercise of . . . constitutional liberties"); *Speiser v. Randall*, 357 U.S. 513, 518-19 (1958); see also *Blackburn v. Snow*, 771 F.2d 556, 568 (1st Cir. 1985) ("[G]overnment may not condition access to even a gratuitous benefit or privilege it bestows upon the sacrifice of a constitutional right."); *Sambo's Restaurants, Inc., v. City of Ann Arbor*, 663 F.2d 686, 694-95 (6th Cir. 1980) (holding that government cannot condition grant of building permits on applicant's agreement to refrain from using a racially offensive name in advertisements); *Sambo's of Ohio v. City Council*, 466 F. Supp. 177, 179 (N.D. Ohio 1979) ("It is clear that the defendants' actions in undertaking to prevent the plaintiffs from the use of their trade name 'Sambo's' is an unconstitutional deprivation of the First Amendment right of free speech."); Kathleen M. Sullivan, *Unconstitutional Conditions*, 102 HARV. L. REV. 1413, 1415 (1989).

198. *Perry v. Sindermann*, 408 U.S. 593, 597 (1972) (citations omitted).

199. The purpose of § 2(a) is to suppress and discourage speech which is offensive. See *supra* note 98 and accompanying text.

200. See *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council, Inc.*, 425 U.S. 748 (1976); *Metromedia, Inc. v. City of San Diego*, U.S. (1981).

201. See *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 566 (1980).

speech than to other constitutionally safeguarded forms of expression.²⁰² To determine whether government regulation of commercial speech is an unwarranted violation of the First Amendment, courts look to the four part test established by the Supreme Court in *Central Hudson Gas & Electric Corp. v. Public Service Commission*.²⁰³ The court must first decide if the speech is within the bounds of the law and not misleading.²⁰⁴ The First Amendment does not apply to commercial speech that is false, deceptive, fraudulent or misleading²⁰⁵ or commercial speech that proposes an illegal transaction.²⁰⁶ Thus, the government is free to regulate these forms of commercial speech. It is clear that the portion of Section 2(a) that applies to the prohibition of deceptive trademarks would constitute legitimate government regulation, not subject to the First Amendment balancing principles. However, immoral, scandalous or disparaging marks are neither misleading nor fraudulent, and, therefore, the restraints on these marks do not fall outside the scope of First Amendment inquiries.

The second prong of the *Central Hudson* analysis is that the asserted government interest must be substantial.²⁰⁷ Third, the regulation must directly advance the asserted government interest.²⁰⁸ Fourth, the regulation cannot be broader than necessary to meet that interest.²⁰⁹ "The last two steps of the Central Hudson analysis basically involve a consideration of the 'fit' between the legislature's ends and the means chosen to accomplish those ends."²¹⁰ Therefore, to determine whether government regulation of immoral, scandalous and disparaging trademarks is a violation of the trademark owner's First Amendment rights, a court must weigh the latter three requirements of the *Central Hudson* test.

202. *Bolger v. Young's Drug Prods. Corp.*, 463 U.S. 60, 64-65 (1983) (quoting *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 446, 455-56 (1978)) (citations omitted).

203. 447 U.S. at 556.

204. *Id.*

205. *See Posadas de P.R. Assoc. v. Tourism Co.*, 478 U.S. 328, 340 (1986); *Zauderer v. Office of Disciplinary Counsel*, 471 U.S. 626, 638 (1986); *Central Hudson*, 447 U.S. at 563; *Friedman v. Rogers*, 440 U.S. 1, 14-15 (1979); *Ohralik v. Ohio State Bar Ass'n*, 436 U.S. 447, 462 (1978).

206. *See Central Hudson*, 447 U.S. at 566; *Pittsburgh Press Co. v. Pittsburgh Comm'n on Human Relations*, 413 U.S. 376 (1973).

207. *See Central Hudson*, 447 U.S. at 566.

208. *Id.*

209. *Id.*

210. *Posadas de P.R. Assoc. v. Tourism Co.*, 478 U.S. 328, 341 (1986).

Proponents of the constitutionality of Section 2(a) could claim that there are a number of possible government interests supporting the denial of registration of scandalous, immoral or disparaging trademarks. First, the regulation may avoid the appearance that the government is giving its stamp of approval to such trademark. Second, the regulation exists to regulate morality and to prevent or discourage the dissemination of scandalous, immoral or disparaging matter to the public. This rationale may be justified as to the government's interest in protecting the health and welfare of its citizens. Third, the regulation may exist to avoid using government funds to support immoral, scandalous and disparaging trademarks. This Article addresses each substantive interest individually and the application of the third and fourth elements of the *Central Hudson* analysis to these asserted government interests.

While the government may have a legitimate interest in refusing to endorse a scandalous, immoral or disparaging trademark, the regulation at issue does not advance that interest. In a 1993 hearing, the TTAB definitively stated that issuance of a trademark registration does not amount to a government endorsement of the trademark.²¹¹

In this case, as in others where the issue has been whether a mark is scandalous, we have detected an undercurrent of concern that the issuance of a trademark registration for the applicant's mark amounts to the awarding of the U.S. Government's 'imprimatur' to the mark. Such a notion is, of course, erroneous . . . Just as the issuance of a trademark registration by the office does not amount to a government endorsement of the quality of the goods to which the mark is applied, the act of registration is not a government imprimatur or pronouncement that the mark is a 'good' one in an aesthetic, or any analogous, sense.²¹²

Since awarding registration does not amount to government endorsement of the mark, withholding registration does not serve the function of removing the government's imprimatur on scandalous, immoral or disparaging marks.

Undoubtedly, the second interest concerning the protection of the health and welfare of the citizens constitutes a substantial government interest.²¹³ However, there is no evidence that denying registration for immoral, scandalous, or disparaging trademarks will protect health and welfare. At most, these trademarks will offend. The fact that some mem-

211. *In re Old Glory Condom Corp.*, 26 U.S.P.Q.2d (BNA) 1216, 1219 (T.T.A.B. 1993). *But see In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981) (registering a trademark would be "stamping the government's imprimatur" on the mark); *In re McGinley*, 206 U.S.P.Q. (BNA) 753 (1979) (stating that federal registration conveys the government's "implied approval" of the mark).

212. *Old Glory*, 27 U.S.P.Q.2d (BNA) at 1219 n.3.

213. *See Posadas*, 478 U.S. at 341 (holding that a ban on advertising of casino gambling aimed at Puerto Rican residents is a constitutional regulation because of the legislature's substantial interest in protecting the health and welfare of its citizens).

bers of society, or even a majority of society, might be offended by the trademark is not sufficient to deny otherwise protected First Amendment rights.²¹⁴ The government's interest in discouraging offensive speech is not a substantial interest that warrants suppression of constitutional rights.²¹⁵

A related argument is that racially disparaging trademarks may frustrate the government's substantial interest in promoting racial harmony and equality. While promoting racial harmony is a substantial government interest,²¹⁶ there is no evidence that Section 2(a) accomplishes this goal. One would have to proffer, at a minimum, tangible evidence of disruption caused by the use of immoral, scandalous or disparaging marks. In *Sambo's Restaurants, Inc. v. City of Ann Arbor*,²¹⁷ where both parties stipulated that the trade name "Sambo's" was offensive to black people and "conveys to some citizens a pernicious racial stereotype of blacks as inferior," the court held that the trade name was a protected First Amendment expression that could not be regulated.²¹⁸ The court reasoned that mere stipulation that the mark affects racial harmony is insufficient evidence to surmount First Amendment scrutiny.²¹⁹

Even if it could be argued that the portion of Section 2(a) that restricts the registration of disparaging trademarks would be a legitimate means of accomplishing the governmental interest of racial harmony, Section 2(a) would still be overbroad and, therefore, unconstitutional. "The overbreadth doctrine invalidates sweeping legislation that outlaws constitu-

214. See *Virginia Pharmacy Bd.*, 425 U.S. at 765 (stating that commercial speech cannot be denied first amendment protection just because the speech may be "tasteless and excessive"); *Carey v. Population Serv. Int'l*, 431 U.S. 678, 701 (1977) ("[a]t least where obscenity is not involved, we have consistently held that the fact that protected [commercial] speech may be offensive to some does not justify its suppression."); *Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686, 694 (6th Cir. 1981) ("[w]e must also reject the proposition that otherwise protected commercial speech is stripped of that protection because of its ancillary offensiveness."); cf. *Hannegan v. Esquire, Inc.*, 327 U.S. 146, 149 (1946) (denying second class mailing privileges, a form of government subsidy, to a magazine because it is "indecent" or "morally improper" violates the first amendment).

215. *Sambo's of Ohio v. City Council*, 466 F. Supp. 177, 180 (N.D. Ohio 1979). "It would be selling our birthright for a mess of pottage to hold that because language is offensive and distasteful even to a majority of the public, a legislative body may forbid its use." *Id.*

216. See *id.* at 695.

217. 663 F.2d 686 (6th Cir. 1980).

218. *Id.* at 694-95.

219. *Id.*

tionally protected rights of free speech, press, or assembly along with allowable proscriptions."²²⁰ Furthermore, the fourth element of the *Central Hudson* analysis specifically prohibits overbroad regulations of constitutionally protected speech.²²¹ Hence, even if one could successfully argue that prohibiting the registration of disparaging trademarks would achieve the governmental objectives of racial harmony and equality, Section 2(a) is still unconstitutionally overbroad because the remaining portion of Section 2(a), which pertains to immoral or scandalous marks, would not be a legitimate restriction of constitutionally protected rights.

The third substantial interest which may be asserted for upholding the restriction on speech contained in Section 2(a) is the interest in limiting the expenditure of government funds. The Court of Customs and Patent Appeals claimed, "[w]e do not see [the denial of registration for scandalous trademarks] as an attempt to legislate morality, but, rather, a judgment by the Congress that such marks not occupy the time, services, and use of funds of the federal government."²²² However, since withholding registration no longer saves Congress time or money, Section 2(a) is not well-suited to achieve this government interest. This is because congressional funding for the Patent and Trademark Office (PTO) operations has switched from public funding to user funding, whereby public funds are not longer expended to register a mark.²²³ Thus, the PTO's operations are now supported entirely by the processing fees paid by the applicants.²²⁴ "Under these circumstances, it is the PTO's opposition to a mark, rather than its approval, that is more likely to cause the expenditure of federal funds and, for that reason, Section 2(a) is inappropriately considered a presumptively valid decision not to fund."²²⁵ It also seems obvious that more time would be expended refusing registration than it

220. Thomas H. Moore, Note, *R.A.V. v. City of St. Paul: A Curious Way to Protect Free Speech*, 71 N.C. L. REV. 1251, 1258 n.35 (1993); see also *Gooding v. Wilson*, 405 U.S. 518, 526-28 (1972) (holding that breach of the peace statute which outlawed protected speech as well as fighting words were overbroad).

221. See *Central Hudson Gas & Elec. Corp. v. Public Serv. Comm'n*, 447 U.S. 566, 566 (1980) (stating that the regulation cannot be more extensive than necessary to meet the government's interest).

222. *In re McGinley*, 660 F.2d 481, 486 (C.C.P.A. 1981). How can the CCPA claim that § 2(a) is not an attempt to legislate morality when the legislative history indicates that the purpose of § 2(a) was to discourage the use of scandalous, immoral and disparaging trademarks? See *supra* note 98 and accompanying text.

223. See 56 Fed. Reg. 65147 (1991); Omnibus Budget Reconciliation Act of 1990, Pub. L. No. 101-508, § 10101, 1990 U.S.C.A.N. (104 Stat.) 1388; Theodore H. Davis, Jr., *Registration of Scandalous and Disparaging Matter Under Section 2(a) of the Lanham Act: Can One Man's Vulgarity Be Another's Registered Trademark?*, 54 OHIO ST. L. J. 331 (1993); *UTSA Holds Annual Meeting: Trademark Review Commission Releases Report*, 34 PAT., TRADEMARK & COPYRIGHT J. 56, 58 (1988).

224. See Davis, *supra* note 223, at 367.

225. *Id.* at 368.

would in granting registration due to the applicant's right to appeal. For these reasons, the decision not to register immoral, scandalous, or disparaging marks is not a valid means of limiting the expenditure of government resources.

For the foregoing reasons, this Article argues that Section 2(a) is an unconstitutional restriction of protected First Amendment expression. One commentator has argued that Section 2(a) could still be upheld as a constitutional restriction of First Amendment speech if the courts were to limit the application of the terms "immoral" and "scandalous" to only the registration of obscene expression and the term "disparaging" to the restriction of "fighting words."²²⁶ Thus, since the first amendment protection does not apply to "fighting words"²²⁷ or obscenity,²²⁸ if courts were to interpret 2(a) in this manner, Section 2(a) would not violate any first amendment rights. However, such an interpretation would ignore a basic principle of statutory interpretation - that every word in a statute has a meaning.²²⁹ Congress did not restrict the registration of "obscene" trademarks; it restricted immoral, scandalous or disparaging trademarks. In fact, one court specifically found that the term "scandalous" does not mean "obscene."²³⁰

V. THE PETITION TO CANCEL THE "REDSKINS" TRADEMARK

A. *The Redskins Case*

On March 11, 1994, a group of Native Americans filed a Petition for Cancellation of the "Redskins" trademark.²³¹ Although this was not the

226. *Id.* at 373. At least one judge has agreed that only marks which are either obscene or profane should be refused registration as scandalous. *See In re Mavey Media Group Ltd.*, 1993 TTAB LEXIS 25, *26 (T.T.A.B. 1993) (Simms, member, dissenting), *vacated*, 1994 U.S. App. LEXIS 22772 (Fed. Cir. Aug. 23, 1994).

227. *See Chaplinksy v. New Hampshire*, 315 U.S. 568, 571 (1942) (stating that the government may prevent and punish the use of speech that is likely to incite an immediate breach of the peace).

228. *See Miller v. California*, 413 U.S. 15, 23 (1973) (declaring that the government may freely regulate obscene speech because it is not protected by the First Amendment).

229. *See United States v. American Trucking Ass'ns*, 310 U.S. 534, 543 (1940).

230. *See McGinley*, 660 F.2d at 485 ("Section 2(a) does not use the term 'obscene,' but it uses the term 'scandalous.'").

231. *See Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994). The attorney for the Native Americans, Stephen Baird, is representing the Petitioners on a pro bono basis. *Grow*, *supra* note 45, at 3B; *Shapiro*, *supra* note 44, at C1.

first cancellation proceeding brought under Section 2(a),²³² it was the first ever brought under the “disparagement” prohibition of Section 2(a).²³³ The Petition claimed that the trademark was at the time of registration, and continues to be, “a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for Native American person.”²³⁴ The trademark owner responded by asserting eleven affirmative defenses in his answer, which included: Petitioners’ lack of standing; equitable estoppel; laches; the mark’s attainment of a strong secondary meaning; lack of damage suffered by Petitioners due to the registration; the Petitioners’ claims are barred because they are based upon Section 2(a) which unconstitutionally abridges the Respondent’s freedom of speech; Petitioners’ claims are barred because Section 2(a) is unconstitutionally overbroad; Petitioners’ claims are barred because Section 2(a) is unconstitutionally void for vagueness; the “Redskins” mark cannot disparage the Petitioners because it cannot be reasonably understood as referring to them or to any group or organization to which they belong.²³⁵

This Article will summarize the major affirmative defenses and discuss their merit, as well as the TTAB’s decision to strike nine of the eleven defenses. The Board upheld the defense which claimed that the mark does not disparage the Petitioners because it does not refer to them, and the secondary meaning defense. However, the Board interpreted the secondary meaning defense as an elaboration of Respondent’s defense denying the allegations in the Petition and not as a claim that the mark can withstand Section 2(a) scrutiny because it had acquired secondary meaning.²³⁶ In fact, the Board held that secondary meaning is not a defense to claims that the mark is disparaging, stating that “a trademark or service mark may be distinctive and, at the same time, disparaging and/or scandalous.”²³⁷

1. Standing and Damages

Initially, Respondent challenged Petitioner’s standing to bring the can-

232. See Board of Trustees of the Univ. of Ala. v. BAMA-Werke Curt Baumann, 231 U.S.P.Q. (BNA) 408, 412, (T.T.A.B. 1986) (canceling a 31 year old trademark because it falsely suggested a connection with the University of Alabama).

233. *Harjo*, 30 U.S.P.Q.2d (BNA) at 1828. Petitioners also asserted that the trademark is scandalous and immoral as well, but this Article will limit its analysis to whether the mark is disparaging. In so doing, this Article shall address whether the mark brings the Native Americans into contempt and disrepute.

234. See *id.* at 1829.

235. See generally Answer to Petition for Cancellation, *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994).

236. *Harjo*, 30 U.S.P.Q.2d (BNA) at 1832 (T.T.A.B. 1994).

237. *Id.*

cancellation proceeding, and claimed that Petitioners failed to meet their burden of proving damages.²³⁸ To meet the threshold inquiry of standing, petitioners must have a "personal interest" in the outcome of the proceeding, and they cannot be "mere intermeddlers."²³⁹ The Lanham Act's cancellation provision provides that "any person who believes that he is or will be damaged by the registration of a mark" may file a petition for cancellation.²⁴⁰ "The requirements for standing in a petition to cancel based on disparagement of beliefs are not very rigorous."²⁴¹ There is no requirement that petitioners prove damage²⁴² or any other direct economic or commercial interest to establish standing.²⁴³ In a proceeding brought under Section 2(a), the TTAB held that an assertion that a party is offended by a trademark and that they believe that it is scandalous, immoral and disparaging as applied to them, is sufficient to establish standing.²⁴⁴ Consistent with these decisions, the TTAB held that the Native Americans had the requisite standing to bring a cancellation proceeding against the owners of the "Redskins" trade-

238. See Answer to Petition at 2, *Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994).

239. See *International Order of Job's Daughters v. Lindegurg & Co.*, 727 F.2d 1087, 1092 (Fed. Cir. 1984); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028-29 (C.C.P.A. 1982).

240. 15 U.S.C. § 1064 (1988). Standing requirements to bring a cancellation proceeding or to bring an opposition are identical. See *Lipton*, 670 F.2d at 1028-30; *Golden Gate Salami Co. v. Gulf States Paper Corp.*, 332 F.2d 184 (C.C.P.A. 1964).

241. *Abraham's Seed v. John One Ten*, 1 U.S.P.Q.2d (BNA) 1230, 1232-33 (T.T.A.B. 1986).

242. See *Books on Tape, Inc. v. Booktape Corp.*, 836 F.2d 519 (Fed. Cir. 1987); *Job's Daughters*, 727 F.2d at 1092; *Rosso & Mastracco, Inc. v. Giant Food, Inc.*, 720 F.2d 1263, 1265 (Fed. Cir. 1983); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 1324-25 (Fed. Cir. 1983) ("Historically, there has been much confusion in the cases between standing and damage which recent decisions and opinions have, hopefully, been straightening out. The conclusion is simple—pleading and proof of damage are not necessary to establish standing."); 1 JEROME GILSON, *TRADEMARK PROTECTION AND PRACTICE* § 3.05[3][a], at 3-158 (1978); 2 J. MCCARTHY, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, § 20.13[1], at 20-78 (3d ed. 1992) ("As in opposition proceedings, a Petitioner for cancellation need not prove actual damage."); cf. *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176, 179 (T.T.A.B. 1978) ("Section 13 [on opposition proceedings] requires only that an opposer believe that it would be damaged.");

243. *Bromberg*, 198 U.S.P.Q. (BNA) at 177.

244. *Id.* However, one commentator has argued that the standing test established by the PTO is inconsistent with constitutional standing requirements of article III. See *Davis*, *supra* note 223, at 385.

mark.²⁴⁵ The petitioners are Native Americans asserting that the trademark “Redskins” is a derogatory term that refers to Native Americans and brings them into contempt and disrepute.²⁴⁶ They have also asserted that the mark offends them as Native Americans.²⁴⁷

2. Equitable Defenses

Next, Respondents asserted the affirmative defenses of laches²⁴⁸ and equitable estoppel.²⁴⁹ Respondents claimed that Petitioners had known about the registered trademarks for years, and that cancellation of these marks, in which Respondents have invested significant time and money, would prejudice and harm respondents.²⁵⁰ Petitioners argued that the plain language of the Lanham Act—that a petition for cancellation can be filed “at any time”—precludes the laches defense in any cancellation proceeding arising under sections (a), (b) or (c).²⁵¹ “[I]t is within the public interest to have registrations which are void *ab initio* stricken from the register and that this interest or concern cannot be voided by the inaction of any single person or concern, no matter how long the delay persists.”²⁵² Contrary to the clear language of the statute, the Board has allowed the defense of laches in a cancellation proceeding brought under

245. *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828, 1830 (T.T.A.B. 1994).

246. *Id.*

247. *Id.*

248. 15 U.S.C. § 1069 (1988). The defense of laches may be invoked to bar an action when petitioners have unreasonably and inexcusably delayed in exercising their rights and where such delay would result in material prejudice to the trademark owner. *See Purex Corp. v. Maryland Paper Prods. Co.*, 287 F.2d 186, 187 (C.C.A.P. 1961).

249. 15 U.S.C. § 1069 (1988). The defense of equitable estoppel may be invoked to bar an action when the respondents relied on the petitioner’s action (or in this case inaction) to their detriment. Under this theory, if the respondents would suffer injury because the petitioners are allowed to repudiate their conduct, then the petitioners are estopped from exercising their right. *See Patton v. Bearden*, 8 F.3d 343, 346 (6th Cir. 1993).

250. *See Answer to Petition for Cancellation at 2, Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994).

251. *See Petitioner’s Motion to Strike Affirmative Defenses at 7, Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994); *see also* 15 U.S.C. § 1064(c) (1988); *National Serv. Indus. v. Turtle Wax, Inc.*, 154 U.S.P.Q. (BNA) 68, 70 (T.T.A.B. 1967) (holding that the defense of laches is inapplicable in an cancellation proceeding where the mark contrary to any of the provisions of subsections 2(a), (b) or (c)).

252. *American Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 U.S.P.Q. (BNA) 149, 153 n.5 (T.T.A.B. 1973); *see also Wandell Mach. Co. v. Altoona Fam Inc.*, 133 U.S.P.Q. (BNA) 410, 410-11 (T.T.A.B. 1962) (determining that “laches is not available as a defense in an action to remove a registration which was clearly void *ab initio*”). A trademark is void *ab initio* if it should never have been granted because it was contrary to the law or public policy.

section 2(a).²⁵³ In that case, the Board held that the defenses of laches and estoppel should be allowed unless there is an overriding public policy interest in precluding the equitable defenses. In the case at hand, the TTAB avoided the conflict between the statutory language and its prior decision by holding that the defenses of laches and estoppel are not allowed because of an overriding public policy interest in preventing disparaging marks that "hold a substantial segment of the population up to public ridicule" from receiving the benefits of federal registration.²⁵⁴

253. See *Treadwell's Drifters Inc. v. Marshak*, 18 U.S.P.Q.2d (BNA) 1318 (T.T.A.B. 1990) (allowing equitable defenses of laches and estoppel in a cancellation proceeding brought under § 2(a) which claimed that the trademark falsely suggested a connection with the opposer).

254. *Harjo*, 30 U.S.P.Q.2d (BNA) at 1831. The Board claimed, however, that it was not holding that laches and estoppel would be barred in all disparagement cases. *Id.* While it is beyond the scope of this Article, the Lanham Act seems to be internally inconsistent in the application of equitable defenses to bar cancellation proceedings brought under § 14(3). Section 14(3) clearly states that a cancellation proceeding may be brought "at any time" for the limited grounds enumerated in that section. See 15 U.S.C. § 1064 (1988) (emphasis added). However, § 19 states: "In all inter partes proceedings equitable principles of laches, estoppel and acquiescence, where applicable may be considered and applied." 15 U.S.C. § 1069 (1988) (emphasis added). Courts have responded to this inconsistency by determining whether an overriding public policy exists to preclude the application of the equitable defenses. See *Treadwell's Drifters*, U.S.P.Q.2d (BNA) at 1320-21 (stating that equitable defenses are available against the claim that respondent's mark falsely suggests a connection with petitioner because the rights asserted are personal in nature and there is no overriding public policy interest in preventing their application); *TBC Corp. v. Grand Prix Ltd.*, 12 U.S.P.Q.2d (BNA) 1311, 1313 (T.T.A.B. 1989) (holding that equitable defenses are not available in a proceeding based on descriptiveness, fraud or abandonment because of the public interest in precluding the registration of these marks); *Bausch & Lomb Inc. v. Leupold & Stevens, Inc.*, 1 U.S.P.Q.2d (BNA) 1497, 1499 (T.T.A.B. 1986) (holding that equitable defenses are inapplicable where an opposition is based on a claim that the mark is merely descriptive or, in cases of fraud, because it is within the public interest to preclude such registrations); *Southwire Co. v. Kaiser Aluminum & Chem. Corp.*, 196 U.S.P.Q. (BNA) 566, 573 (T.T.A.B. 1977) ("[I]t is settled that the equitable defenses of laches and estoppel are not available in a proceeding . . . [where the] plaintiff is asserting in essence that the mark in question is devoid of the capacity to perform a trademark function. The theory underlying this principle as expounded in these cases is that it is within the public interest to preclude registration of merely descriptive designations, to cancel registrations which are void ab initio because of this disability of the registered mark as of the time the application was filed, and to cancel those registrations where the registered marks have, since the time of registration, become terms of art or common description; and that this interest or concern cannot be waived by the inaction of any single person or concern, no matter how long the delay persists.") (citations omitted).

3. Constitutional Challenges

Respondents also raised a number of challenges to the constitutionality of section 2(a) both on its face and in its application.²⁵⁵ They claimed that Section 2(a) is unconstitutional because it abridges their freedom of speech, is unconstitutionally overbroad and is void for vagueness. However, the TTAB never reached the merit of these challenges because it determined, correctly, that such findings were beyond its authority as an administrative tribunal.²⁵⁶ Since the TTAB is an administrative agency created by Congress, it is bound by congressional enactments, and it does not have the authority to hold such enactments unconstitutional.²⁵⁷ "It goes without saying that the Trademark Trial and Appeal Board, being a creature of the Congress, is bound to apply the statute as it was enacted This limitation on our power applies even to constitutionality challenges."²⁵⁸

Although the TTAB is unable to decide issues of constitutionality, Respondents, by raising those issues, have preserved them for appeal. If this case is appealed to the United States Court for the Federal Circuit, Respondents will be able to challenge the constitutionality of section 2(a). If this opportunity does not present itself, the court must apply the *Central Hudson* balancing principles, as this Article has done above, to determine if the government's regulation of speech in section 2(a) violates the First Amendment. Blanket reliance on the CCPA decision in *McGinley* would be inappropriate since that court glossed over the difficult constitutional challenges in a cursory manner, without articulating any analysis for its decision. In addition, there have been substantial changes in the manner in which the PTO is funded following the *McGinley* decision, which makes the court's analysis inapplicable to the present situation. This Article concludes that, after applying the First Amendment balancing principles to section 2(a), section 2(a) is unconstitutional because it abridges the trademark owners' freedom of speech.²⁵⁹ This Article also finds that section 2(a) is unconstitutionally overbroad.²⁶⁰

Finally, Respondents claim, and this Article agrees, that section 2(a) is unconstitutionally void for vagueness.²⁶¹ The respondents assert that the

255. See Answer to Petition for Cancellation at 3-4, *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994).

256. See *Harjo*, 30 U.S.P.Q.2d (BNA).

257. See *Johnson v. Robison*, 415 U.S. 361, 368 (1974); *Panola Land Buyers Ass'n v. Shuman*, 762 F.2d 1550, 1557 (11th Cir. 1985).

258. *In re* ETA Sys. Inc., 2 U.S.P.Q.2d (BNA) 1367, 1370 n.4 (T.T.A.B. 1987).

259. See *supra* notes 201-26 and accompanying text.

260. See *supra* notes 220-21 and accompanying text.

261. See Respondent's Memorandum in Opposition to Petitioner's Motion to Strike

terms "scandalous" and "disparage" within section 2(a) are imprecise and fail to provide a clearly defined standard for those who must abide by them and for those who must enforce them.²⁶² The *McGinley* court's treatment of the void for vagueness question, like its treatment of the first amendment issues, provides a shallow analysis of the requisite level of precision required to withstand a due process challenge.²⁶³ The *McGinley* court, without ever reaching the standards established by the Supreme Court for determining vagueness, held that section 2(a)'s high degree of subjectiveness is not a sufficient basis for claiming that the terms are unconstitutionally void for vagueness.²⁶⁴

The void for vagueness doctrine emanates from the Fifth Amendment's requirement that persons receive due process of law. While federal statutes are entitled to a strong presumption of validity,²⁶⁵ it is also true that statutes that proscribe free speech receive the strictest scrutiny for vagueness.²⁶⁶ "The Court relaxes the requirement in first amendment cases in order to invalidate statutes that would have a chilling effect by discouraging persons from engaging in conduct that is protected by the First Amendment."²⁶⁷

Due process requires that statutes provide sufficient guidance to those who must obey the law, enforce the law and interpret the law.²⁶⁸ Section 2(a) would be void for vagueness if it fails to give the public fair guidance as to which trademarks are prohibited,²⁶⁹ fails to provide suffi-

Affirmative Defenses at 17, *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994).

262. *Id.*

263. *See In re McGinley*, 660 F.2d 481, 484 (C.C.P.A. 1981).

264. *See id.* at 484; *cf. Warner-Hudnut, Inc. v. Wander Co.*, 280 F.2d 435, 436 (C.C.P.A. 1960) (noting that the fact that determinations of the likelihood of confusion are often subjective does not affect the validity of the terms).

265. *See United States v. National Dairy Prods. Corp.*, 372 U.S. 29, 32 (1963) (pointing out the "strong presumptive validity that attaches to an act of Congress").

266. *See NAACP v. Button*, 371 U.S. 415, 432 (1963); *see also* Christopher J. Moran, Comment, *Is the "Darting" in Danger? "Void for Vagueness" - The Constitutionally of the RICO Pattern Requirement*, 36 VILL. L. REV. 1697 (1991) (holding that where a statute which is challenged as unconstitutionally vague, encroaches on first amendment rights, the defendant need not even prove that the statute is impermissibly vague as applied to his conduct).

267. Moran, *supra* note 266, at 1704 (citing *Greyned v. City of Rockford*, 408 U.S. 104, 108-09 (1972)).

268. *See Kolender v. Lawson*, 461 U.S. 352, 357-58 (1983); *see generally* Moran, *supra* note 266.

269. If a statute "either forbids or requires the doing of an act in terms so vague

cient guidance to those charged with enforcing the statute (here, the PTO),²⁷⁰ or fails to provide sufficient guidance to the judges charged with interpreting it.²⁷¹

Respondents argue, and this Article agrees, that the terms “scandalous” and “disparage” do not provide the public with adequate notice of which marks are prohibited from registration, nor do they provide the PTO with enough guidance to enforce the statute. Like the terms “scandalous” and “immoral,” neither the Lanham Act nor its legislative history define the term “disparage.” In fact, the Assistant Commissioner of Patents, Leslie Frazer, expressed the concern in the Lanham Act Hearings that the term “disparage” will be difficult to apply because a determination of disparagement is completely subjective.²⁷²

Mr. Frazer. I would like to make this suggestion with respect to the word ‘disparage.’ I am afraid that the use of the word in this connection is going to cause a great deal of difficulty in the Patent Office, because, as someone else has suggested, that is a very comprehensive word, and it is always going to be just a matter of personal opinion of the individual parties as to whether they think it is disparaging. I would like very much to see some other word substituted for that word ‘disparage.’

Mr. Lanham. That seems to me, in the light of administration, to be a very pertinent suggestion, and if you gentlemen can clarify that with verbiage you suggest it would be helpful.²⁷³

Tribunals have agreed that determining whether a mark is disparaging is highly subjective.²⁷⁴ The TTAB, which is charged with enforcing the Lanham Act, has held that the terms “scandalous” and “disparage” are “somewhat vague.”²⁷⁵ These terms render Section 2(a) void for vagueness because they fail to provide the public and the PTO with sufficient guidance as to which trademarks should be prohibited registration. These vague and highly subjective tests do not provide meaningful guidance for the PTO. As a result, the law is inconsistently and sometimes erroneous-

that men of common intelligence must necessarily guess at its meaning and differ as to its application,” then it is unconstitutionally void for vagueness. *Conally v. General Const. Co.*, 269 U.S. 385, 391 (1926) (stating that a statute which required contractors to pay workmen “current rate of per diem in the locality where the work is performed” is void for vagueness).

270. See *Kolender*, 461 U.S. at 357-58.

271. See *Greyned*, 408 U.S. at 108-09.

272. *Hearings*, *supra* note 98, at 18 (statement of Leslie Frazer).

273. *Id.*

274. See, e.g., *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d (BNA) 1653, 1654 (T.T.A.B. 1990); cf. *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1471 (T.T.A.B. 1988) (noting that the test for determining whether a mark is scandalous is highly subjective).

275. See *In Over Our Heads*, 16 U.S.P.Q.2d (BNA) at 1654 (“[T]he guidelines for determining whether a mark is scandalous or disparaging are ‘somewhat vague.’” (quoting *Hershey*, 6 U.S.P.Q.2d (BNA) at 1471)).

ly applied and, at times, the distinctions made by the PTO, between trademarks that are scandalous or disparaging and trademarks which are not, appear indefensible. However, a federal court could avoid a finding that section 2(a) is unconstitutionally vague by narrowing its interpretation of the expression to be restricted.²⁷⁶

4. "Redskins" Mark is Not Disparaging Because it Does Not Refer to Petitioners

Finally, Respondent's had two affirmative defenses that were not struck by the TTAB. Both defenses claim that the "Redskin" mark should not be cancelled because it does not refer to Petitioners or to any groups to which they belong and, thus, cannot be interpreted as either disparaging or bringing Petitioners into contempt or disrepute.²⁷⁷ Because most of the affirmative defenses were struck down, the TTAB must now decide the disparagement issue. Since a federally registered trademark has a presumption of validity, Petitioners have the burden of proving disparagement.

B. Applying the Disparagement Test to the "Redskins" Case

If Petitioners can prove that the "Redskins" trademark can reasonably be understood to refer to them as Native Americans and that reasonable Native Americans or a substantial composite of Native Americans could have found the mark disparaging in 1967 when registration was issued, then the "Redskins" trademark should be cancelled. Petitioners should be able to satisfy the first element of the test easily since the "Redskins" trademark is used in conjunction with a picture of an Indian. The second element will require proof that the term "Redskin" was a derogatory and disparaging reference to Native Americans when the trademark was registered and that the use of this term brought them into contempt and disrepute. The term "Redskin" has been defined by Webster's Ninth New Collegiate Dictionary, as "American Indian—usu[ually] taken to be offensive."²⁷⁸ The term "Redskin" was a derogatory reference to Indians as

276. For example, use of the term "obscene" is not void for vagueness because the Supreme Court limited its application to "materials depict[ing] or describ[ing] patently offensive 'hard core' sexual conduct specifically defined by the regulating state law." See *Miller v. California*, 413 U.S. 15, 27 (1973).

277. See Answer to Petition for Cancellation at 3-4, *Harjo v. Pro Football, Inc.*, 30 U.S.P.Q.2d (BNA) 1828 (T.T.A.B. 1994).

278. WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY 987 (9th ed. 1990). The term

far back as 1699 when it was declared, “[y]e firste Meeting House was solid mayde to withstande ye wicked onsaults of ye Red Skins.”²⁷⁹ As one author noted, “[t]o many Native Americans, redskin is as derogatory as ‘nigger’ is for black Americans.”²⁸⁰ Petitioners should also be permitted to offer contemporary proof that the mark is disparaging as evidence that when registered the mark had the potential to disparage.²⁸¹ Therefore, if Petitioners can prove that the “Redskin” trademark is disparaging, it will be cancelled.

VII. CONCLUSION

This Article concludes that section 2(a) should not survive the constitutional challenges because it violates the First Amendment, is overbroad, and is void for vagueness. If section 2(a) does survive these challenges, however, the “Redskins” mark should be cancelled because it disparages Native Americans. This article has proposed a test for disparagement: (1) whether the mark is reasonably understood as referring to Native Americans; and (2) whether a reasonable Indian or a substantial composite of Native Americans believe that the mark is disparaging to Indians.²⁸²

Some trademark owners may fear that cancellation of the “Redskins” mark will have a domino effect—that it will spur cancellation proceedings against any trademark that any group finds mildly offensive. Furthermore, they may be concerned that cancellation of the “Redskins” mark will encourage many to attempt to impose their notions of political correctness on society through cancellation proceedings. One commentator has noted:

Possibilities for finding offense are endless. Surely the Giants offended everyone who is pituitarily challenged. No devoted Catholic wants to watch the Saints or Angels getting knocked about on the field. How do the Swedes feel when the Native American skins stop the Vikings? Can a Southern team bear to lose to the Yankees? And who do you think picked all that cotton in the Cotton Bowl?²⁸³

The University of Miami probably thought it was free from controversy when it adopted the nickname—the “Hurricanes.” To the school’s surprise, it received complaints from people who claimed that the name is

“nigger” is defined by this same dictionary as “Negro—usu[ually] taken to be offensive.” *Id.* at 798.

279. Randy Furst, *Indian Activists Seek to Have Redskins Stripped of U.S. Trademark Protections*, STAR TRIB., Sept. 11, 1992, at 1A.

280. Loving, *supra* note 148, at 40 (quoting JAY CROAKLEY, SPORTS IN SOCIETY: ISSUES AND CONTROVERSIES 206-07 (4th ed. 1990)).

281. See *supra* notes 174-76 and accompanying text.

282. See *supra* notes 180-87 and accompanying text.

283. See Fields, *supra* note 29, at A8.

offensive because of the devastation caused by Hurricane Andrew in southern Florida.²⁸⁴

However, there is no reason for these trademark owners to be alarmed. The disparagement test does not allow anyone who is mildly offended by a particular trademark to petition for cancellation of the mark. First, the party claiming disparagement must be a member of the group to which the trademark is reasonably understood as applying and, second, a substantial composite of that group or a reasonable member of the group must find the mark disparaging.²⁸⁵ This test prevents intermeddling groups from bringing unwarranted suits in an attempt to impose their views of political correctness on society. For instance, while Native Americans do find the "Fighting Illini" disparaging, the Irish do not appear to find the "Fighting Irish" offensive, so the latter trademark would not be subject to cancellation.²⁸⁶

If the TTAB does cancel the "Redskins" mark, it will lose the benefits afforded by federal registration.²⁸⁷ This leaves open the question of whether the trademark could still receive common law protection.²⁸⁸ The first Restatement of Torts indicates that the common law will not protect a trademark which is prohibited by legislative enactment or by an otherwise defined public policy.²⁸⁹ The Restatement's definition of trademark explicitly excludes marks which are scandalous or contrary to any defined public policy.²⁹⁰ Since the Lanham Act has clearly prohibited the registration of scandalous and disparaging marks for public policy reasons, these marks would, likewise, be unprotected by the Restatement.

284. See Arnold, *supra* note 27, at 1; *supra* note 28 and accompanying text.

285. See *supra* notes 180-87 and accompanying text.

286. See Kelley, *supra* note 1, at E1.

287. See *supra* notes 73-81 and accompanying text.

288. At least one case has held that if a mark is not entitled to federal registration because it violates the content based bars to registration, public policy prevents it from receiving protection at common law. See *De Nobili v. Scanda*, 198 F. 341, 346 (W.D. Pa. 1912) ("If it could not be registered as a trademark . . . we see no reason why it should be protected as a label."). While the law may not advocate that all trademarks which are refused registration are likewise not entitled to protection at common law, there is a public interest in discouraging the use of disparaging marks which could justify denying this limited class of marks common law protection. One commentator has argued that if a federal registration is cancelled because a mark is disparaging, the common law should not protect the mark. See *Loving*, *supra* note 148, at 3.

289. RESTATEMENT (FIRST) OF TORTS § 715(d) (1938).

290. *Id.* § 726.

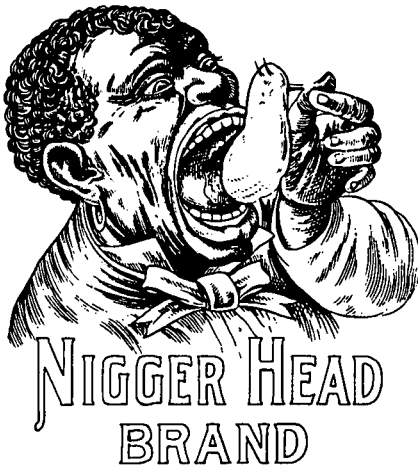
If the federal registration of the "Redskins" trademark is cancelled because the mark disparages Native Americans, and the common law denies protection to the mark despite its long use in commerce, then the trademark owner would not be able to exclude others from adopting the mark. This raises an interesting question: If canceling the federal registration of the "Redskins" mark ultimately means that others can adopt it, why are the Native Americans pursuing this course of action? A commentator has noted that, "I cannot condone the American Indian Movement's effort to cancel the exclusive trademark of the Redskins. A likely consequence would be that many high schools and colleges would 'honor' us similarly and adopt that epithet as their mascot."²⁹¹

Finally, even if the Petition for Cancellation is granted, the team can continue to use the REDSKINS mark. However, the Petitioners hope that loss of federal registration will be a sufficient economic influence to persuade Jack Kent Cook to change the team's name.²⁹²

291. See Pensoneau, *supra* note 43, at 14A.

292. In 1991, the "Redskins" trademark owner earned over \$1,000,000.00 from merchandising licenses which allow others to make sports paraphernalia with the "Redskins" mark. See Furst, *supra* note 279, at 1A. If the Native Americans win and the "Redskins" trademark is cancelled, could the Indians file a class action tort suit for defamation against the trademark owner? At least one commentator believes that they could. See Loving, *supra* note 148, at 37-38 n.273. Defamation has been defined as "words which tend to expose one to public hatred, shame . . . contempt, ridicule . . . degradation or disgrace." W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 111, at 773 n.17 (5th ed. 1984). *But see* RESTATEMENT (SECOND) OF TORTS § 546A cmt. a (1989) ("As a general rule no action lies for the publication of defamatory words concerning a large group or class of persons.").

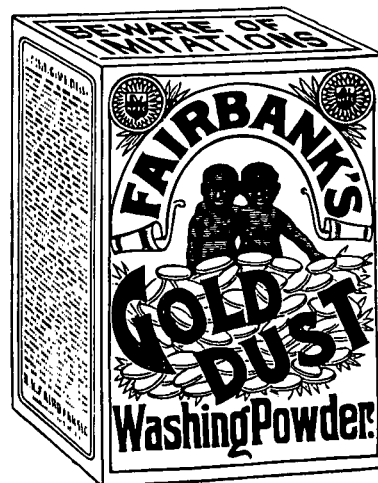
Appendix A



NIGGER HEAD BRAND
was granted federal registration
for use on canned fruits and vegetables



NICKELINE
was granted federal registration
for use on stove polish



GOLD DUST
was granted federal registration
for use on washing powder

The idea for use of the black twins came from a cartoon which showed the twins washing each other in a tub and the caption read, "Warranted to wash clean and not fade."

See HAL MORGAN, *SYMBOLS OF AMERICA* 52 (1986) for these, and other trademarks which used racial images.

Appendix B



1890



**AUNT
JEMIMA**

1902

1905



1917



Appendix C

WASHINGTON



REDSKINS

WASHINGTON REDSKINS



ATLANTA BRAVES



CHICAGO BLACKHAWKS



CLEVELAND INDIANS
CHIEF WAHOO

