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Abstract: In Harjo v. Pro-Football Inc., the Trademark Trial and Appeal Board cancelled the federally registered trademarks THE WASHINGTON REDSKINS, REDSKINS, and REDSKINETTES after finding them to be disparaging matter under section 2(a) of the Lanham Act. Pro-Football has appealed the Board’s decision to the U.S. District Court for the District of Columbia. This Note argues that Harjo’s adoption of the “substantial composite” standard for analyzing disparaging trademarks potentially ignores the majority of the implicated group members’ viewpoints and promotes section 2(a) trademark cancellations. In addition, the liberal standing requirements for opposition and cancellation proceedings combined with Harjo’s disparagement doctrine impermissibly conflict with the protections afforded commercial speech and the policies underlying federal trademark regulation. Pro-Football Inc. v. Harjo presents the Article III system with an appropriate opportunity to correct the Board’s expansive disparagement doctrine. This correction could persuade Congress to remedy the imbalance between the protections afforded intellectual property owners in Article III proceedings and those provided in section 2(a) oppositions and cancellations before the Board.

The Lanham Act gives a seller or producer the exclusive right to register a trademark, and to prevent competitors from using that trademark. As a result, the United States Patent and Trademark Office (PTO) receives thousands of trademark applications each year. The Lanham Act places few restrictions on the items that may qualify for federal registration. Courts and the PTO have authorized trademarks for particular shapes (e.g., Coca-Cola bottles), sounds (e.g., NBC’s three chimes), fragrances, and even colors. While section 2(a) of the Lanham Act carries a presumption in favor of registrability, it prohibits the PTO from approving “scandalous” or “disparaging” trademarks.

2. Id. § 1114(1); Scott Paper Co. v. Scott’s Liquid Gold, Inc., 589 F.2d 1225, 1227 (3d Cir. 1978) (“[A] good name is better than precious oil.”) (quoting Ecclesiastes 7: 1).
In *Haro v. Pro-Football Inc.*, the Trademark Trial and Appeal Board (the Board) granted a section 2(a) petition to cancel the federally registered trademarks THE WASHINGTON REDSKINS, REDSKINS, and REDSKINETTES. Although the Board found the Native American petitioner's evidence insufficient to establish the level of societal outrage necessary to cancel the trademarks on "scandalous" grounds, it concluded that Pro-Football's trademarks "may disparage" Native Americans. The Board reached this decision by limiting its analysis to a "substantial composite" of the implicated group. Harjo's expansive disparagement doctrine now permits any social group to challenge unfavorable trademarks and forces the PTO to differentiate between legitimate and non-legitimate victim groups. This subjective determination exceeds the PTO's function as a federal registrar, and presents significant threats to trademark owners' intellectual property rights due to the lack of common law and statutory protection for marks adjudged scandalous or disparaging.

This Note argues that the liberal standing requirements for opposition and cancellation proceedings, combined with Harjo's expansive disparagement doctrine, impermissibly conflict with the protections afforded commercial speech and the policies underlying federal

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8. Id. at 1749.
9. Id. at 1748.
10. Id.
11. Id. at 1739.
14. See De Nobili v. Scanda, 198 F. 341, 346 (W.D. Pa. 1912) (holding public policy denies common law protection to trademarks that violate statutory provisions); see also 3 J. Gilson et al., *Trademark Protection and Practice* § 11.08[4][h], 11–282 (2001) (noting that the trademark infringement defense of unclean hands, though often based on allegations of fraud or misrepresentation of source, "may result from any imaginable immoral or illegal conduct").
Haro v. Pro-Football Inc.

trademark regulation. Part I provides an overview of federal trademark protection and compares the standing requirements in Article III courts with those practiced in trademark opposition and cancellation proceedings before the Board. Part II examines the interaction between the Board’s section 2(a) jurisprudence and the U.S. Supreme Court’s commercial speech doctrine. Part III summarizes the Board’s decision to cancel Pro-Football’s trademarks in Harjo v. Pro-Football Inc. Part IV argues that Harjo deviated from section 2(a) precedent and created an overly expansive disparagement doctrine. Part V maintains that Congress should amend sections 13 and 14 of the Lanham Act to correct the imbalance between protections afforded intellectual property owners in Article III proceedings and those provided during section 2(a) oppositions and cancellations before the Board. This Note concludes that the U.S. District Court for the District of Columbia should declare section 2(a) unconstitutional as applied to Pro-Football’s trademarks.

I. FEDERAL TRADEMARK REGULATION: PURPOSE, CURRENT LEGISLATION, AND PREREQUISITES TO PROTECTION

Trademark law is designed to foster competition and protect consumers from false and misleading information in the marketplace. Additionally, trademark regulation provides economic incentives for product development and protects trademark owners’ investments in good will by deterring the use of unauthorized marks. These policies are reflected in current legislation such as the Lanham Act, the Federal Trademark Dilution Act, and the Anticybersquatting Consumer Protection Act, which confer substantive federal trademark rights to owners upon registration.

A. The Purpose of Federal Trademark Protection

A trademark is any combination of words, symbols, or package designs used to distinguish a good or service produced by one manufacturer from those of other manufacturers. The function of a

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19. See id. § 1127.
trademark is to allow consumers to identify the source of the article to which it is attached.\textsuperscript{20} By purchasing a product bearing a favorably regarded trademark, such as POLO, ROLLS ROYCE, or TIFFANY, consumers are assured of its value.\textsuperscript{21}

Congress established current trademark laws to support competition and protect consumers from fraud.\textsuperscript{22} To achieve this dual goal, trademark statutes aim to prevent consumer confusion about the source of a product,\textsuperscript{23} its sponsorship,\textsuperscript{24} and its quality.\textsuperscript{25} Trademark laws also safeguard trademark owners' reputation and investments in good will by prohibiting the use of confusingly similar\textsuperscript{26} and tarnishing marks.\textsuperscript{27}

\textbf{B. Current Federal Statutory Protection of Trademarks}

On July 5, 1946, Congress created substantive federal trademark rights by enacting the Lanham Act.\textsuperscript{28} Unlike previous statutes,\textsuperscript{29} registration under the Lanham Act provides a number of significant benefits. For example, obtaining federal registration entitles a trademark owner to prevent importation of confusingly similar goods,\textsuperscript{30} to constructive nationwide notice of ownership of the mark,\textsuperscript{31} to incontestable status after five years of continuous use,\textsuperscript{32} and to a prima facie presumption of validity and ownership of the mark.\textsuperscript{33} Furthermore,

\begin{itemize}
  \item \textsuperscript{20} Hanover Star Milling Co. v. Metcalf, 240 U.S. 403, 412 (1916).
  \item \textsuperscript{22} See id. at 1276.
  \item \textsuperscript{24} Ferrari S.P.A. Esercizio v. Roberts, 944 F.2d 1235, 1243–44 (6th Cir. 1991) (enjoining the sale of defendant's unauthorized Ferrari replica car kits).
  \item \textsuperscript{26} Indianapolis Colts, Inc. v. Metro. Balt. Football Club Ltd., 34 F.3d 410, 414–16 (7th Cir. 1994) (enjoining use of "Baltimore CFL Colts" because consumers might confuse the team with the Indianapolis Colts).
  \item \textsuperscript{29} Act of July 8, 1870, ch. 230, 77–84, 16 Stat. 198, 210–12 (declared unconstitutional for exceeding Congress' authority under the Commerce Clause in \textit{Trade-Mark Cases}, 100 U.S. 82, 96–97 (1879)); Act of Feb. 20, 1905, ch. 592, 33 Stat. 724 (repealed 1946) (excluding from protection descriptive marks, marks made up of geographic terms, and marks named after individuals and corporations).
  \item \textsuperscript{30} 15 U.S.C § 1124 (2000).
  \item \textsuperscript{31} Id. § 1072.
  \item \textsuperscript{32} Id. § 1065.
  \item \textsuperscript{33} Id. § 1057(b).
\end{itemize}
a mark’s owner has the right to prevent a subsequent registrant from using a similar mark if it is likely to cause consumer confusion.\textsuperscript{34}

Congress significantly expanded the Lanham Act’s scope by introducing the Trademark Law Revision Act of 1988\textsuperscript{35} and the Federal Trademark Dilution Act of 1995.\textsuperscript{36} The Dilution Act entitles owners of famous trademarks to seek recovery against others for diminishing their reputation and good will.\textsuperscript{37} In response to increased trademark infringements on the Internet,\textsuperscript{38} Congress enacted the Anticybersquatting Consumer Protection Act (ACPA).\textsuperscript{39} Under the ACPA, remedies are available to owners whose trademarks are appropriated for use as domain names.\textsuperscript{40} Together, the Lanham Act and its subsequent amendments establish a comprehensive bundle of intellectual property rights available by federal registration.\textsuperscript{41}

C. Procedural Requirements for Establishing Federal Trademark Protection

In order to obtain federal registration under the Lanham Act, an owner must apply to the PTO and show either the intention to use a mark in commerce or evidence of actual use of a mark in commerce.\textsuperscript{42} Applications for federal registration are examined by a PTO attorney for compliance with statutory formalities,\textsuperscript{43} and applications that do not contain generic, scandalous or disparaging marks are approved for

\textsuperscript{34} Id. § 1114(1)(a).
\textsuperscript{37} Id. § 1125(c)(1); see also Panavision Int'l L.P. v. Toeppen, 945 F. Supp. 1296, 1301 (C.D. Cal. 1996) ("Whereas traditional trademark law sought primarily to protect consumers, dilution laws place more emphasis on protecting the investment of the trademark owners.").
\textsuperscript{40} Id. § 1125(d)(1)(C); see also Harrods Ltd. v. Sixty Internet Domain Names, 302 F.3d 214, 231-32 (4th Cir. 2002) (holding that federal trademark registration serves as prima facie evidence of a mark’s validity and entitles the owner to proceed on an in rem basis under § 1125(d)(2)).
\textsuperscript{41} See 15 U.S.C. § 1125(e)(1)(H) (2000) (noting that federal registration is a factor in determining whether a trademark is “distinctive and famous” and entitled to federal dilution protection); see id. § 1125(d)(1)(B)(i)(I) (noting that a federally registered trademark in a domain name is a factor in determining whether a “cybersquatter” has acted with “bad faith intent” to profit from the mark).
\textsuperscript{42} 37 C.F.R. § 2.33 (2001).
\textsuperscript{43} 15 U.S.C. § 1051(a), (b) (2000).
publication in the PTO's *Official Gazette*. If the application is rejected, the applicant may appeal to the Board and then to the Federal Circuit or a federal district court in the District of Columbia.

Once a mark is published, a competitor or other potentially injured party has thirty days to initiate an opposition proceeding before the Board. After passage of the thirty-day window, the mark is registered and a third party may only challenge it by instituting a cancellation proceeding. The Board's conclusions in these proceedings may be appealed to the Federal Circuit or a federal district court in the District of Columbia.

II. ARTICLE III COURTS AND TRADEMARK OPPOSITION AND CANCELLATION PROCEEDINGS EMPLOY DIFFERENT STANDING REQUIREMENTS

Standing is a threshold issue for plaintiffs in any adjudicatory proceeding that challenges wrongful behavior or seeks the removal of federal rights. Article III tribunals are subject to constitutional and prudential standing limitations in order to reduce marginal litigation. However, administrative agencies are not subject to these restraints and are free to hear actions barred from Article III courts. Recognizing the danger that the Lanham Act's broad standing language presents to trademark owners' intellectual property rights, the Federal Circuit adopted Article III standing limitations for trademark opposition and

44. Id. § 1052(a), (c); see id. § 1062(a). To qualify for protection under the Lanham Act, a mark must be primarily understood as a source identifier. See Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 768 (1992). In this regard, generic marks such as SOAP for soap can never be protected. See Park "N Fly, Inc. v. Dollar Park & Fly, Inc., 469 U.S. 189, 194 (1985) ("A generic term is one that refers to the genus of which the particular product is a species."). Marks that are arbitrary or suggestive, such as DREAMWERKS for science fiction conventions, are inherently distinctive and entitled to protection immediately upon adoption. See Dreamwerks Prod. Group, Inc. v. SKG Studio, 142 F.3d 1127, 1130 (9th Cir. 1998). Marks that are descriptive, geographic, or surnames are not inherently distinctive and must acquire distinctiveness through proof of secondary meaning in order to qualify for protection. See Inwood Lab., Inc., v. Ives Lab., Inc., 456 U.S. 844, 851 n.11 (1982) ("secondary meaning" is acquired when "in the minds of the public, the primary significance of a product feature . . . is to identify the source of the product rather than the product itself").
46. Id. §§ 1071(a)(1), (b)(1).
47. Id. § 1063(a).
48. Id. § 1064.
49. Id. §§ 1071(a)(1), (b)(1).
52. See Ecee, Inc. v. FERC, 645 F.2d 339, 349–50 (5th Cir. 1981).
cancellation proceedings. However, in Ritchie v. Simpson, the court departed from earlier precedent and considerably weakened the requirements necessary to initiate section 2(a) challenges.

A. Proceedings in Article III Courts

Article III of the Constitution limits federal court jurisdiction to "cases" and "controversies." To satisfy this requirement, a plaintiff must show: (1) an injury in fact that is (a) concrete and particularized and (b) actual or imminent, not conjectural or hypothetical; (2) that the injury is fairly traceable to the challenged action of the defendant; and (3) that the injury is redressable. In this manner, Article III confines federal judicial power to a role consistent with a system of separated powers and to disputes capable of resolution through the judicial process.

In addition to Article III, prudential standing principles address whether a plaintiff has suffered a direct and palpable injury and is within the "zone of interests" protected by the statutory provision invoked in the suit. Prudential standing limitations exist as an integral part of judicial self-restraint and allow only proper parties to benefit from the court's remedial powers. For example, in Sierra Club v. Morton, the U.S. Supreme Court held that an environmental organization lacked standing to prevent a governmental agency from constructing a resort in a national forest. The Court noted that the policy of limiting judicial review to entities that have a direct stake in the outcome would be compromised if it construed the Administrative Procedure Act to grant standing to "organizations or individuals who seek to do no more than vindicate their..."
own value preferences through the judicial process." In this regard, the Court found that the organization failed to demonstrate a direct and palpable injury from the project's development and therefore did not fall with the "zone of interests" protected by the Administrative Procedure Act.

In the trademark arena, both the Third and Fifth Circuits have placed prudential limitations on challenges brought under section 43(a) of the Lanham Act, which prohibits false advertising, by adopting a standing test used by the U.S. Supreme Court in antitrust cases. Applying the Court's antitrust standing factors from Associated General Contractors of California, Inc. v. California State Council of Carpenters, the Third Circuit held that retailer plaintiffs do not have standing to sue manufacturers of competing products for alleged false advertising under section 43(a). The court stressed that the plaintiffs did not suffer a "competitive" harm, that their position in the distribution chain was too remote from the injurious conduct, and that any damage suffered was "if not speculative, then certainly avoidable." Finally, the Third Circuit noted that granting retailer plaintiffs standing would increase marginal litigation and undermine the Lanham Act's goals of preventing unfair competition and protecting good will.

63. Id. at 740.
64. Id. at 738–39.
65. 15 U.S.C. § 1125(a)(1) (2000) ("Any person who... uses in commerce any... false designation of origin, false or misleading description of fact... shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.").
67. 459 U.S. 519, 538–44 (1983) (stating that five factors determine prudential standing in antitrust cases: (1) the nature of the plaintiff's alleged injury; (2) the directness or indirectness of the asserted injury; (3) the proximity or remoteness of the party to the alleged injurious conduct; (4) the speculativeness of the damages claim; and (5) the risk of duplicative damages or complexity in apportioning damages).
68. Conte Bros., 165 F.3d at 236.
69. Id. at 234.
70. Id.
71. Id. at 235.
72. Id. at 236; cf. Procter & Gamble Co. v. Amway Corp., 242 F.3d 539, 563–64 (5th Cir. 2001).

Furthermore, when challenges to intellectual property rights are involved, the Federal Circuit has recognized the danger of granting standing to individuals that fail to demonstrate a judicially cognizable injury. See Animal Legal Def. Fund v. Quigg, 932 F.2d 920, 932–37 (Fed. Cir. 1991). In Quigg, the Federal Circuit affirmed a federal district court's ruling that farmers, husbandry groups, and organizations did not have standing to seek a declaration that animals are not patentable subject matter:

Here appellants assert no adverse effect on any individual's rights to benefits under the patent statute. Rather, they assert that the general public has an interest in the statutory limitations to
B. Opposition and Cancellation Proceedings

Sections 13 and 14 of the Lanham Act govern standing requirements for opposition and cancellation proceedings before the Board, and permit broad challenges by anyone suffering "damage" by registration of a trademark. After establishing standing, a party may successfully petition the Board to deny registration on the grounds that a trademark is "scandalous" or "disparaging." In an effort to prevent mere "intermeddlers" from initiating section 2(a) proceedings, the Federal Circuit, in Jewelers Vigilance Committee Inc. v. Ullenburg Corp., stressed that sections 13 and 14 are consistent with the standing requirements for Article III courts.

However, since the Jewelers Vigilance decision, the Federal Circuit's standing requirements for a direct invasion of a challenger's rights and privileges have been softened considerably. For example, in Bromberg v. Carmel Self Service, Inc., a group of female petitioners opposed registration of the mark "Only a Breast in the Mouth is Better Than a Leg in the Hand" for restaurant services. Noting that women as a class could not challenge the mark, the Board granted standing because the female petitioners fell within a "zone of real interest" in preventing registration.

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73. 15 U.S.C. § 1063(a) (2000) ("[a]ny person who believes that he would be damaged"); see id. § 1064 ("any person who believes that he is or will be damaged").
74. Id. § 1064(3) (permitting cancellations of trademarks that violate section 2(a)'s provisions).
76. 823 F.2d 490 (Fed. Cir. 1987).
77. See id. at 492 (citing Baker v. Carr, 369 U.S. 186, 204 (1962); Warth v. Seldin, 422 U.S. 490, 499 (1974)).
78. See Otto Roth & Co. v. Universal Foods Corp., 640 F.2d 1317, 1319-20 (C.C.P.A. 1981) ("The concept of damage determined in [a cancellation] proceeding by 'balancing rights and determining whose are superior'... is inextricably tied to the grounds upon which the opposer asserts damage.") (emphasis in original); United Shoe Mach. Corp. v. Compo Shoe Mach. Corp., 56 F.2d 292, 295 (C.C.P.A. 1932) ("Certainly the person seeking to cancel a registration or oppose an application for registration must have a greater interest than a member of the general public who by such registration suffers no invasion of his rights and privileges.").
80. Id. at 177.
81. Id. at 178.
82. Id. at 179.
The Federal Circuit has since explicitly extended Bromberg’s logic. In *Ritchie v. Simpson*, a divided panel reversed the Board’s refusal to permit standing and authorized a citizen to challenge registration of the marks O.J., O.J. SIMPSON, and THE JUICE because the citizen was morally outraged at O.J. Simpson’s behavior. The court rejected the Board’s requirement that a challenger demonstrate an interest beyond that of the general public, and held that Mr. Ritchie had sufficiently pled the disparagement of his family values by the registration of marks allegedly synonymous with “wife-beater” and “wife-murderer.”

In a pointed dissent, Judge Pauline Newman asserted that the majority decision would turn opposition and cancellation proceedings into a forum for attack on the morality of the registrant: “Moral indignation is not such an interest [sufficient to confer standing]; the trademark tribunals do not serve the busy-body and moral cop.” Furthermore, Judge Newman stressed that the decision discarded decades of precedent and thereby promoted challenges by self-appointed “guardian[s] of the register.” Judge Newman concluded that individuals invoking section 2(a)’s scandalous and disparaging bars to trademark registration could burden commercial speech rights in which they have no legitimate interest, in contravention of Federal Circuit and Supreme Court precedent.

III. SECTION 2(A) OF THE LANHAM ACT CREATES TWO DISTINCT BARS TO TRADEMARK REGISTRATION: “SCANDALOUS” AND “DISPARAGING”

Section 2(a) of the Lanham Act provides that no trademark shall be refused registration unless it “[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions,
beliefs, or national symbols.” Since Congress did not define “scandalous” or “disparaging” matter in the Lanham Act, the Board has struggled with section 2(a)’s subjective nature. Generally, the Board must make separate findings that a mark is scandalous or disparaging, but this distinction is often blurred. Under both analyses, the Board examines all of a mark’s elements and the goods or services on which it is used. Despite these similarities, a mark may be disparaging and not scandalous on closely related facts. Furthermore, although “scandalous” and “disparaging” prohibitions are clearly content-based, the U.S. Supreme Court did not recognize constitutional protection for commercial speech until thirty years after passage of the Lanham Act. The ambiguity that currently surrounds section 2(a) enforcement often restricts trademark owners’ ability to effectively communicate through their trademarks.

A. “Scandalous” Trademarks

Generally, trademarks consisting of profanity or vulgarity are denied registration as “scandalous,” while marks with ambiguous meanings require further analysis. For example, in In re Wilcher Corp., the Board refused registration of DICKHEADS for restaurant services due to the mark’s accompanying illustration of a human head composed of male genitalia. However, in In re Hershey, the Board permitted registration

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93. See Stephen R. Baird, Moral Intervention in the Trademark Arena: Banning the Registration of Scandalous and Immoral Trademarks, 83 TRADEMARK REP. 661, 666 n.14 (1993) (“Section 2(a) is really a hodge podge of several distinct statutory bars to federal trademark registration.”).
95. Compare Old Glory, 26 U.S.P.Q.2d at 1221 (a condom decorated with stars and stripes to suggest the American flag not scandalous), with Doughboy, 88 U.S.P.Q. at 227-28 (packaging of “prophylactic preparation for prevention of venereal diseases” disparaging to American soldiers).
99. Id. at 1934.
of the mark BIG PECKER BRAND for T-shirts because the evidence failed to demonstrate the vulgarity of the word "pecker." The Board concluded that a majority of purchasers would not be offended by the mark's reference to pictures of a large-beaked bird on the applicant's T-shirts. Additionally, in In re Old Glory Condom Corp., after emphasizing the "seriousness of purpose" surrounding the applicant's crusade against sexually transmitted diseases, the Board permitted registration of OLD GLORY CONDOM for condoms decorated with a design of the American flag.

In the 1994 case, In re Mavety Media Group Ltd., the Federal Circuit reversed the Board's refusal to register BLACK TAIL for adult entertainment magazines containing pictures of African American women. The Federal Circuit explained the Board's inconsistent application of section 2(a) as a function of the changes in social mores over time. Attempting to rationalize section 2(a) jurisprudence, the Federal Circuit announced a three-part test: (1) the mark must be shocking to the sense of truth, decency, or propriety, or call out for condemnation; (2) the mark must be considered in the context of the marketplace as applied to only the goods or services in the application for registration; and (3) the mark must be scandalous to a substantial composite of the general public, as measured from the context of contemporary attitudes.

By incorporating contemporary attitudes into its "scandalous" calculus, the Federal Circuit eliminated the difficulty of reconciling outdated societal norms with modern trademark terminology. However, problems still surround application of the "substantial composite" standard. By adopting this element, the Federal Circuit recognized the inherent difficulty of fashioning a single objective

101. Id. at 1472.
102. Id. at 1477.
104. Id. at 1221.
105. Id.
106. 33 F.3d 1367 (Fed. Cir. 1994).
107. Id. at 1370.
108. Id. at 1371.
109. Id. (citations omitted).
110. Compare id. at 1373 (highlighting the difficulty of determining whether a substantial composite of the general public considers a word scandalous based on dictionary definitions), with In re McGinley, 660 F.2d 481, 485–86 (C.C.P.A. 1981) (applying dictionary definitions contemporaneous with the passage of the Lanham Act).
measure from numerous subjective viewpoints, but felt constrained by precedent. Although somewhat vague and unpredictable, section 2(a)'s prohibition on "scandalous" trademarks has withstood due process challenges and continues to be enforced by the "substantial composite" standard.

B. "Disparaging" Trademarks

Unlike their scandalous counterparts, disparaging marks have received minimal attention under section 2(a). The Board did not define "disparagement" until 1988 in Greyhound v. Both Worlds, Inc. Noting that the legislative history of the Lanham Act indicates section 2(a) was intended to preclude registrations that conflict with another's legally protectable rights, such as privacy and publicity, the Board concluded that disparagement is essentially a violation of the right to be "let alone" from contempt or ridicule.

Drawing an analogy to tort liability, the Board adopted a two-part test: (1) whether the communication is reasonably understood to refer to the petitioner; and (2) whether the communication is considered offensive or objectionable by a reasonable person of ordinary sensibilities. Applying this test to the applicant's mark (a silhouette of a defecating dog as a logo for polo shirts), the Board found the mark to be disparaging to Greyhound's running dog trademark and thus denied registration under section 2(a).
When trademarks implicating religious beliefs or national symbols are involved, the Board has considered evidence such as affidavits,\textsuperscript{121} the applicant’s membership in the allegedly offended group,\textsuperscript{122} and documentary sources.\textsuperscript{123} For example, in \textit{In re Hines},\textsuperscript{124} an applicant sought registration of BUDDA BEACHWEAR for beach clothes.\textsuperscript{125} The PTO relied on dictionary and encyclopedia explanations of the significance of iconography in Buddhism and denied registration because “the use of Buddha’s name and likeness to hawk beachwear tends to cast doubt upon the quality of the beliefs of Buddhists,” and the mark “disparages Buddhists because it [commercializes] sacred symbols.”\textsuperscript{126} Upholding the examiner’s decision, the Board ignored perceptions of the general public and held that only perceptions of those identified in some recognizable manner by the mark are relevant.\textsuperscript{127} However, after the Federal Circuit’s \textit{Mavety Media} decision,\textsuperscript{128} the Board granted a motion for reconsideration and permitted registration of BUDDA BEACHWEAR due to a lack of opposition from Buddhists.\textsuperscript{129}

Additionally, in \textit{In re In Over Our Heads, Inc.},\textsuperscript{130} the PTO relied on dictionary definitions and denied registration to MOONIES on novelty dolls that dropped their pants, as the mark was disparaging to members of the Unification Church founded by Sun Myung Moon.\textsuperscript{131} The Board reversed, finding that consumers are more likely to perceive the mark as an allusion to “mooning” than a disparaging reference to a religious sect.\textsuperscript{132} In sum, after \textit{Hines} and \textit{In Over Our Heads}, the PTO and the Board must be armed with more than “personal opinions and dictionary sources” to successfully prohibit a mark’s registration on disparaging grounds.\textsuperscript{133}

\begin{footnotesize}
\begin{enumerate}
\item\textsuperscript{121} \textit{In re Waughtel}, 138 U.S.P.Q. 594, 595 (T.T.A.B. 1963).
\item\textsuperscript{122} \textit{In re Condas S.A.}, 188 U.S.P.Q. 544 (T.T.A.B. 1975).
\item\textsuperscript{123} \textit{In re Anti-Communist World Freedom Cong., Inc.}, 161 U.S.P.Q. 304, 305 (T.T.A.B. 1969).
\item\textsuperscript{125} \textit{Id.} at 1685–86.
\item\textsuperscript{126} \textit{Id.} at 1687–90.
\item\textsuperscript{127} \textit{Id.} at 1688.
\item\textsuperscript{128} \textit{See supra} notes 106–109.
\item\textsuperscript{129} \textit{In re Hines}, 32 U.S.P.Q.2d 1376, 1377 (T.T.A.B. 1994) (“[It is imperative that the Board be careful to avoid interposing its own judgment for that of Buddhists.”).
\item\textsuperscript{130} 16 U.S.P.Q.2d 1653 (T.T.A.B. 1990).
\item\textsuperscript{131} \textit{Id.} at 1654.
\item\textsuperscript{132} \textit{Id.}
\item\textsuperscript{133} \textit{In re Mavety Media Group Ltd.}, 33 F.3d 1367, 1370–71 (Fed. Cir. 1994).
\end{enumerate}
\end{footnotesize}
C. Section 2(a) Bars to Registration and the Commercial Speech Doctrine

The Lanham Act was enacted in 1946 before the evolution of the commercial speech doctrine, so the drafters of section 2(a) could not have predicted that they were creating content-based restrictions\(^\text{134}\) on speech.\(^\text{135}\) While current First Amendment jurisprudence offers less protection to commercial than political speech,\(^\text{136}\) the U.S. Supreme Court’s decision in *Central Hudson Gas & Electric Corp., v. Public Service Commission of New York*\(^\text{137}\) established several requirements governmental actors must satisfy before suppressing speech that proposes a commercial transaction.\(^\text{138}\) If commercial speech concerns lawful activity and is not misleading, it is entitled to First Amendment protection.\(^\text{139}\) The government cannot regulate commercial speech unless its interest is substantial,\(^\text{140}\) directly advanced by the regulation, and the regulation is no more extensive than necessary to accomplish its purpose.\(^\text{141}\) Courts applying *Central Hudson*’s framework have held that governmental actors cannot prohibit commercial speech such as solicitation of prescription drug prices,\(^\text{142}\) smokeless tobacco and cigar advertising,\(^\text{143}\) and beer labels displaying alcohol content.\(^\text{144}\)

Despite *Central Hudson*’s substantial interest and narrowly tailored requirements, several members of the U.S. Supreme Court have recently suggested that strict scrutiny is appropriate for commercial speech regulations.\(^\text{145}\) In *44 Liquormart, Inc. v. Rhode Island*,\(^\text{146}\) a plurality of the

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134. *See supra* note 96 and accompanying text.
135 *See* Valentine v. Chrestensen, 316 U.S. 52, 54 (1942) (holding that commercial speech is not protected by the First Amendment).
137. 447 U.S. 557 (1980).
138. *Id.* at 566.
139. *Id.*
145. *See, e.g.*, Lorillard, 533 U.S. at 572 (Kennedy, Scalia, J.J., concurring); *id.* at 572–73 (Thomas, J., concurring); Greater New Orleans Broad. Ass’n, Inc. v. United States, 527 U.S. 173, 197 (1999) (Thomas, J., concurring); 44 Liquormart, Inc. v. Rhode Island, 517 U.S. 484, 501, 510–14 (1996); *id.* at 517 (Scalia, J., concurring); *id.* at 518 (Thomas, J., concurring).
Court split over whether to apply strict scrutiny while striking down a state prohibition on the advertising of liquor prices. After classifying newspaper advertisements containing the word “WOW” next to liquor bottles as commercial speech, the Court found that governmental actors retain “less regulatory authority when... commercial speech restrictions strike at ‘the substance of the information communicated.” The Court concluded that Central Hudson’s review standard should apply, and held that the advertising ban did not advance Rhode Island’s interest in protecting its citizens from the vices of alcohol to a “material degree.” In separate concurring opinions, Justice Thomas and Justice Scalia voiced concerns with the Central Hudson test. While Justice Scalia concluded that the briefing was inadequate to formulate a suitable replacement, Justice Thomas concluded that governmental interests aiming “to keep legal users of a product or service ignorant in order to manipulate their choices in the marketplace” should be per se illegitimate.

Regardless of the level of scrutiny applied by the U.S. Supreme Court, trademarks that provide information about a product are considered a form of commercial speech and are entitled to protection under the First Amendment. However, the Court has not clarified whether items that only convey a product’s source, such as logos or slogans, enjoy First Amendment protection. Nonetheless, both the Second and Sixth Circuits have extended commercial speech protection into these areas.

147. Id. at 489.
148. Id. at 492–93.
149. Id. at 499 (citations omitted).
150. Id. at 504 (citing Cent. Hudson Gas & Elec. Corp. v. Pub. Serv. Comm’n of N.Y., 447 U.S. 557, 566 n.9 (1980)).
151. Id. at 505 (citing Edenfield v. Fane, 507 U.S. 761, 771 (1993)).
152. Id. at 517 (Scalia, J., concurring); see id. at 518–19 (Thomas, J., concurring).
153. Id. at 518.
154. Id.
155. Friedman v. Rogers, 440 U.S. 1, 11 (1979) (holding that the use of the trade name “Texas State Optical” is a form of commercial speech).
157. See Bad Frog Brewery, Inc. v. N.Y. State Liquor Auth., 134 F.3d 87, 91 (2d Cir. 1998) (classifying a beer label with a frog “giving the finger” and the accompanying slogan “The beer so good... it’s bad” as commercial speech); Sambo’s Rest., Inc. v. City of Ann Arbor, 663 F.2d 686,
IV. AFTER HARJO, FEDERALLY REGISTERED TRADEMARKS THAT "MAY DISPARAGE" A "SUBSTANTIAL COMPOSITE" OF AN IMPLICATED GROUP ARE SUBJECT TO CANCELLATION

The Board broke new ground in 1999 by granting a section 2(a) petition to cancel a federally registered trademark. In Harjo v. Pro-Football Inc., the Board found the Native American petitioners' evidence insufficient to establish the level of societal outrage necessary to cancel Pro-Football's trademarks on "scandalous" grounds. But, by limiting its analysis to a "substantial composite" of the implicated group, the Board concluded that Pro-Football's trademarks "may be disparaging" to Native Americans.

A. Background and Procedural History

In 1937, the Boston Braves football franchise moved to Washington, D.C. and changed its name to the Washington Redskins. In 1967, the team obtained federal registration for the mark THE REDSKINS in stylized script. The team's remaining trademarks, issued from 1974 through 1990, include: THE WASHINGTON REDSKINS, REDSKINS, and REDSKINETTES.

In September 1992, Susan Harjo, along with six other Native Americans, petitioned the Board to cancel the Washington Redskins' trademarks on the grounds that the word "redskin" is an offensive, scandalous, and disparaging designation for a Native American person. Pro-Football responded by asserting that the petitioners lacked standing to challenge the registrations, that section 2(a) unconstitutionally

694 (6th Cir. 1981) (classifying a restaurant's service mark as commercial speech because it provides consumers with valuable information about the restaurant's quality).


160. Id. at 1749.

161. Id. at 1739.

162. Id. at 1748.

163. Id. at 1727.

164. Id. at 1707 (Registration No. 836,122, issued Sept. 26, 1967).

165. Id. (Registration No. 978,824, issued Feb. 12, 1974).

166. Id. (Registration No. 1,085,092, issued Feb. 7, 1978).

167. Id. (Registration No. 1,606,810, issued July 17, 1990).

impinges on the First Amendment and that section 2(a) violates the Fifth Amendment’s guarantee of due process. In a 1994 pre-trial ruling, the Board granted petitioners standing and struck each of Pro-Football’s affirmative defenses. The Board refused to address the First and Fifth Amendment issues, noting that it lacked authority to declare section 2(a) unconstitutional.

On April 2, 1999, the Board issued cancellation orders for all of Pro-Football’s trademarks because the trademarks “may be disparaging of Native Americans to a substantial composite of this group,” and “may bring Native Americans into contempt or disrepute.” On June 1, 1999, Pro-Football sought review of the Board’s decision in a federal district court for the District of Columbia. The district court subsequently denied a motion to dismiss Pro-Football’s statutory and constitutional challenges.

B. Pro-Football’s Trademarks Are Not Scandalous

After dismissing Pro-Football’s constitutional attacks on section 2(a), the Board addressed the appropriate legal standard for analyzing scandalous marks. Condensing the guidelines established by the Federal Circuit in Mavety Media, the Board espoused a two-step process. First, the Board must determine the likely meaning of the matter in question; next, the Board must determine whether the matter is scandalous to a substantial composite of the general public.

When determining the likely meaning of the matter in question, the Board examined the relationship between the matter and all other elements of the mark, the goods or services on which the mark is used,
and the manner of use in the marketplace.\textsuperscript{181} Relying on the testimony of the seven Native American petitioners, dictionary definitions, linguistic experts, an analysis of Western genre films, and a telephone survey that resulted in thirty-six percent of the Native Americans sampled stating they were offended by "redskin(s),"\textsuperscript{182} the Board found the word "redskin(s)" to carry an allusion to Native Americans.\textsuperscript{183} Furthermore, the Board found this allusion supported by the mark's incorporation of a Native American in profile.\textsuperscript{184}

Despite the allusion to Native Americans, the Board concluded that a substantial composite of the general population would not find the trademark "shocking to the[ir] sense of truth, decency, or propriety."\textsuperscript{185} The significant amount of media coverage and fan support devoted to the Washington Redskins since the 1940's was thus inconsistent with a sense of outrage from the general population necessary to a finding of scandalousness.\textsuperscript{186} Therefore, the petitioners failed the test's second prong and the Board denied cancellation.\textsuperscript{187}

C. Pro-Football's Trademarks Are Disparaging

The language of section 2(a) makes clear that a trademark is invalid if it "consists of or comprises ... scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols..."\textsuperscript{188} Therefore, the Lanham Act requires the Board to engage in a separate, and potentially more difficult, disparagement analysis.\textsuperscript{189} First, the Board determined the "ordinary" meaning of "disparage."\textsuperscript{190} Next, it ascertained the meaning of

\begin{itemize}
  \item \textsuperscript{181} Harjo, 50 U.S.P.Q.2d at 1736.
  \item \textsuperscript{182} Id. at 1723–33. Additionally, 46.2\% of the 300 non-Native American adults surveyed stated that they were offended by the term "redskin." Id. at 1733.
  \item \textsuperscript{183} Id. at 1742.
  \item \textsuperscript{184} Id.
  \item \textsuperscript{185} Id. at 1748.
  \item \textsuperscript{186} Id. at 1749.
  \item \textsuperscript{187} Id.
  \item \textsuperscript{189} See Hearings Before the Subcomm. on Trademarks of the House Comm. on Patents on H.R. 4744, 76th Cong. 18–21 (1939) (statement of Thomas E. Robertson) ("The word 'disparage' is too comprehensive in meaning."); (statement of Assistant Commissioner Frazer) ("I am afraid that the use of that word [disparage] is going to cause a great deal of difficulty in the Patent Office, because... it is always going to be just a matter of the personal opinion of the individual parties as to whether they think [the mark] is disparaging."); Baird, supra note 93, at 667.
  \item \textsuperscript{190} Harjo, 50 U.S.P.Q.2d at 1737.
\end{itemize}
the marks in question, and, finally, decided whether their meaning was disparaging.\textsuperscript{191}

The Board began its analysis by referring to dictionary definitions and concluded that, in relation to groups, symbols, or beliefs, matter is disparaging if it may "dishonor by comparison with what is inferior... degrade... or injure by unjust comparison."\textsuperscript{192} The Board then drew two significant distinctions between "scandalous" and "disparaging" matter under section 2(a). Because of section 2(a)'s focus on identifiable objects,\textsuperscript{193} the Board concluded that the general public's viewpoints are irrelevant to whether or not matter is disparaging.\textsuperscript{194} Second, the Board found that the inclusion of the term "may" before "disparage" negated a requirement of intent.\textsuperscript{195} These two differences enabled the Board to arrive at different conclusions on the "scandalous" and "disparagement" analyses.\textsuperscript{196}

To determine the meaning of the marks in question, the Board focused on the meaning of Pro-Football's trademarks at their dates of registration.\textsuperscript{197} Based on the entire record, the Board concluded that "redskin(s)" is a denotative term for Native Americans.\textsuperscript{198} Furthermore, in connection with Pro-Football's entertainment services, the Board found "redskin(s)" to carry an allusion to Native Americans\textsuperscript{199} that continues despite the term's frequent use in popular culture and the media to identify the Washington D.C. football club.\textsuperscript{200}

Finally, the Board had to decide, given the meaning of "redskin(s)" in connection with entertainment services, if Pro-Football's marks were disparaging.\textsuperscript{201} To accomplish this task, the Board adopted a "substantial composite" of the implicated group test.\textsuperscript{202} Although the Board did not quantify what a "substantial composite" means, its new test combined the standard used by the Federal Circuit in "scandalous" cases,\textsuperscript{203} with

\textsuperscript{191}Id.
\textsuperscript{192}Id. at 1738.
\textsuperscript{194}Harjo, 50 U.S.P.Q.2d at 1739.
\textsuperscript{195}Id. at 1738.
\textsuperscript{196}Id. at 1749.
\textsuperscript{197}Id. at 1741.
\textsuperscript{198}Id. at 1742.
\textsuperscript{199}Id.
\textsuperscript{200}Id.
\textsuperscript{201}Id. at 1739.
\textsuperscript{202}See id. at 1740.
\textsuperscript{203}See supra notes 106-109 and accompanying text.
the Board’s viewpoint analysis from In re Hines. Applying its newly formulated test, the Board held that the word “redskin(s),” in connection with Pro-Football’s trademarks, retained a derogatory character and disparaged a substantial composite of Native Americans. Accordingly, the Board canceled Pro-Football’s “redskin(s)” trademarks.

V. HARJO CREATES AN OVERLY EXPANSIVE DISPARAGEMENT DOCTRINE AND PROMOTES SECTION 2(A) TRADEMARK CANCELLATIONS

The Harjo Board’s adoption of the “substantial composite” approach potentially ignores the majority of the implicated group members’ viewpoints when deciding whether a trademark is disparaging and deviates from precedent in two important aspects. First, the Board ignored Greyhound’s definition of disparagement for third party trademark opposition proceedings and second, the Board disregarded In Over Our Heads’ viewpoint analysis for disparaging trademarks that reference a particular group. Additionally, the Harjo Board erred by failing to consider Pro-Football’s marks in the context of contemporary attitudes and by affording inadequate weight to Pro-Football’s good faith intent and the respectful nature of its trademark usage. When this case comes up for appeal, the U.S. District Court for the District of Columbia should reject the Harjo Board’s expansive disparagement doctrine and apply Greyhound’s definition of disparagement.

A. The Board Erred by Adopting the "Substantial Composite" Standard for Analyzing Disparaging Trademarks

The Board’s “substantial composite” approach enables it to fix a percentage, potentially below a majority, of a group’s viewpoints that are relevant and a percentage that are not. The Board’s analysis forced it to draw an arbitrary line that excluded the sixty-four percent of Native Americans who were surveyed and not offended by Pro-Football’s

204. See supra notes 124–129 and accompanying text.
206. Id. at 1749.
207. See supra notes 116–119 and accompanying text.
208. See supra notes 130–132.
210. Id. at 1734–35.
To reach its decision, the Board relied on its analysis from *In re Hines*, but *Hines* involved a PTO examiner’s denial of registration and not a third party challenge. Furthermore, *Hines* involved an application for a potentially disparaging trademark that incorporated a religious icon’s name and likeness, and the Board never employed a substantial composite analysis. After the Federal Circuit’s *Mavety Media* decision, the *Hines* Board reconsidered its decision, and concluded that the PTO lacked sufficient evidence of disparagement to deny BUDDA BEACHWEAR registration. Thus, the *Harjo* Board’s purported reliance on *Hines* was misplaced, and its adoption of the substantial composite standard was inappropriate.

Additionally, *Harjo* ignored the Board’s analysis in *In Over Our Heads*, which involved a trademark application for a potentially derogatory group reference. After noting that dictionary definitions described “Moonie(s)” as members of the Unification Church, the Board found persuasive numerous articles incorporating the term and reasoned “[w]e doubt that such major newspapers and magazines would have repeatedly used a term derogatory of a particular religious group.” In *In Over Our Heads*, the Board did not employ a substantial composite analysis, but rather focused on the viewpoint of purchasers of goods bearing the MOONIES mark, and whether they would perceive it as ridiculing members of the Unification Church. Thus, by ignoring the perceptions of purchasers of “redskin(s)” merchandise and the media’s widespread use of the term in connection with the Washington, D.C. football club, the Board disregarded *In Over Our Heads*’ reasonable person approach and applied an incorrect viewpoint analysis.

By incorporating the substantial composite standard into its disparagement analysis, the Board has perpetuated the uncertainty and

211. See id. at 1746.
212. See supra notes 124–129 and accompanying text.
213. See supra notes 43–46.
214. See Baird, supra note 93, at 669 n.21 (“The cases dealing with religious matter . . . seem particularly well suited for application under the disparaging rubric of § 2(a).”).
216. See supra notes 106–109.
218. Id. at 1377.
219. See supra notes 130–131.
221. Id. at 1654.
Moreover, the substantial composite standard places tremendous weight on survey evidence that may not accurately depict the implicated group's viewpoints. For example, in contrast to the petitioner's survey evidence, a recent Harris Poll of three hundred and fifty-one Native Americans revealed that seventy-five percent were not offended by the name "redskins" and that sixty-nine percent feel it is acceptable for Pro-Football to continue using the name.

Thus, the district court hearing Harjo on appeal can take a substantial step toward harmonizing the divergent applications of section 2(a) by reinstating the Greyhound test and evaluating disparaging marks from the standpoint of a "reasonable person." Tort doctrines addressing an individual's privacy rights, publicity rights, and defamation have used a variation of the "reasonable person" standard effectively without employing a substantial composite analysis. These doctrines offer protection for individuals offended by the publication of damaging trademarks while still permitting the viewpoints of dissenting group members and consumers to be taken into account. Incorporating tort law into the Board's disparagement doctrine would harmonize section 2(a) with its legislative history, ensure that a trademark is harmful

223. See In re McGinley, 660 F.2d 481, 487 (C.C.P.A. 1981) (Rich, Baldwin, J., dissenting) (criticizing the substantial composite standard: "[I] am at a loss to know what [substantial composite] means or how one can have a 'composite' of a class such as 'the general public'").

224. See Marc Fisher, American Indians Among Admirers of Redskins Name, WASHINGTON POST, Jan. 26, 2002, at B1 (Walter Wetzel, former chairman of the Blackfoot tribe, said, "[i]t made us all so proud to have an Indian on a big-time team . . . [O]nly a small group of radicals [ ] oppose those names. Indians are proud of Indians."); see also Rebekah Denn, School Board to Decide Use of 'Indian' Mascots, SEATTLE POST-INTELLIGENCER, July 10, 2002, at A1 (after noting that the Duwamish Tribe did not find the West Seattle high school "Indian" mascot to be offensive, Don Hatch, a member of the Tulalip Tribal Council, said that he saw tribal names as a source of pride for Indians and that taking them away "is taking part of us away").


229. RESTATEMENT (SECOND) OF TORTS § 559 cmt. e (1977) ("Although defamation is not a question of majority opinion, neither is it a question of the existence of some individual or individuals with views sufficiently peculiar to regard as derogatory what the vast majority of persons regard as innocent.").

230. See W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 111, at 773 n.17 (5th ed. 1984) (defining defamation as "words which tend to expose one to public hatred, shame . . . contempt, ridicule . . . degradation or disgrace").

231. See supra notes 117, 189 and accompanying text.
before it is stripped of federal protection, and interject predictability and consistency into the analysis of disparaging marks.

B. The Board Erred by Disregarding Pro-Football’s Good Faith Intent

Pro-Football maintains that its intent in adopting the WASHINGTON REDSKINS name and logo was “entirely positive” and that the team name has “reflected positive attributes of the American Indian such as dedication, courage and pride.” However, the Board, focusing on the connection between “may” and “disparage” in section 2(a), found Pro-Football’s intent largely irrelevant. The Board thus ignored the substantial weight its previous decisions had afforded an applicant’s purpose in adopting a mark and seeking federal registration.

In Old Glory, the Board held that the “seriousness of purpose” surrounding a mark’s promotion and use is a significant factor in whether it is offensive. Accordingly, although potentially offensive to a large number of Americans, the Board permitted registration of a condom with a design of the American flag due to the solemn and patriotic nature of the product’s packaging and the applicant’s fight against AIDS. The Board again emphasized an applicant’s intent in Wilcher where the applicant claimed that DICKHEADS’ was an innocent double entendre used to promote Richard Heads’ Bar & Restaurant. Noting that both vulgar and non-vulgar dictionary definitions exist for the term “dickhead,” the Board found the mark’s accompanying illustration of male genitalia indicative of the applicant’s intent to project a vulgar connotation.

Pro-Football’s “seriousness of purpose” and intent to honor the positive attributes of Native Americans is demonstrated by the mark’s design elements and its use in connection with a respected organization. Although both disparaging and non-disparaging dictionary definitions of “redskin(s)” exist, unlike the mark at issue in Wilcher, Pro-Football’s marks are accompanied by a neutral design of a

233. Id. at 1738 n.100.
234. See supra notes 103–105.
236. See supra notes 98–99.
239. Id. at 1730.
Native American in profile and do not attempt to project a disparaging connotation. Furthermore, similar to the mark's packaging and promotion in *Old Glory*, Pro-Football uses its mark in a respectful manner and in connection with a professional sport that exemplifies courage and dedication. 240

C. The Board Erred by Disregarding Pro-Football's Trademarks' Secondary Meaning

In addition to dismissing Pro-Football’s “seriousness of purpose,” the Board addressed Pro-Football’s trademarks from their dates of registration rather than the date of the Native American’s petition. 241 Analyzing Pro-Football’s marks from their dates of registration permitted the Board to discount the strong “secondary meaning” 242 attached to THE REDSKINS since its inception in 1967. 243 The Board correctly noted that proof of secondary meaning is not a complete defense to claims under section 2(a); nevertheless, it afforded the mark’s nationwide use in connection with the Washington, D.C. football club minimal weight. 245 Furthermore, viewing marks at their time of registration ignores social changes from 1967 through 1999 and frustrates the Federal Circuit’s mandate to consider marks in their current context. 246

In *Mavety Media*, the Federal Circuit registered BLACK TAIL for adult entertainment magazines. 247 Dismissing challenges that the mark depicted African American women as sexual objects, the court noted that “[t]oday’s scandal can be tomorrow’s vogue,” 248 and found various dictionary definitions of “tail” unpersuasive in establishing the mark’s offensiveness. 249 The court went on to stress the importance of examining a questionable mark in view of its relevant marketplace and in the

240. *Id.* at 1721.
241. *Id.* at 1735.
242. See supra note 44 and accompanying text; see also Int'l Kennel Club of Chi., Inc. v. Mighty Star, Inc., 846 F.2d 1079, 1086–88 (7th Cir. 1988) (stating that the longer a trademark is in use, the stronger the likelihood of establishing secondary meaning).
243. Harjo v. Pro-Football Inc., 50 U.S.P.Q.2d 1705, 1708 n.12 (T.T.A.B. 1999); see *id.* at 1749 (noting the “voluminous” number of references to the Washington Redskins in news articles since the 1940s and the general acceptance of “redskin(s)” in connection with the football club).
247. *Id.* at 1370.
248. *Id.* at 1371.
249. *Id.* at 1374.
context of contemporary attitudes: "Proof abounds in nearly every quarter, with the news and entertainment media today vividly portraying degrees of violence and sexual activity that, while popular today, would have left the average audience of a generation ago aghast."  

Accordingly, the Board’s refusal to consider the secondary meaning attached to Pro-Football’s marks in their current environment contravenes Federal Circuit precedent and the Lanham Act’s purpose of protecting a trademark owner’s reputation and good will. While “redskin(s)” carried a negative connotation in Western genre films during the 1960s, today, it encompasses a different meaning in the context of a professional sports team. Furthermore, through national marketing and societal rejection of the term’s use to identify Native Americans, Pro-Football’s marks have become synonymous with the Washington, D.C. metropolitan area and the positive attributes exemplified by its football team.

D. Harjo Contravenes the Policies of Preventing Consumer Confusion and Protecting Trademark Owners’ Investments

The primary impetus behind trademark regulation is to provide the general public with accurate information about product source and quality. If cancellation is permitted after a mark has established itself as identifying a particular source of goods, consumer confusion will result when another producer sells similar goods under the same mark or

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250. Id. at 1371. See also In re Thomas Labs. Inc., 189 U.S.P.Q. 50, 52 (T.T.A.B. 1975); In re Madsen, 180 U.S.P.Q. 334, 335 (T.T.A.B. 1973) (registering WEEK-END SEX for magazines, the Board noted that “consideration must be given to the moral values and conduct fashionable at the moment, rather than that of past decades”).

251. See United States v. Hon, 904 F.2d 803, 806–07 (2d Cir. 1990); Boston Athletic Ass’n v. Sullivan, 867 F.2d 22, 32 (1st Cir. 1989); see also Chattanooga Mfg., Inc. v. Nike, Inc., 301 F.3d 789, 795–96 (7th Cir. 2002) (holding that trademark holder’s fourteen year delay in assertion of infringement claim “prejudiced” the alleged infringer for purpose of laches defense, since the alleged infringer spent millions of dollars promoting its products and had achieved position of market leader); Boston Prof’l Hockey Ass’n v. Dallas Cap & Emblem Mfg., 510 F.2d 1004, 1011 (5th Cir. 1975) (noting that trademark protection extends to the time, money, and effort needed to create a fan base).


the original goods are produced under a different mark.\textsuperscript{255} For example, the Board’s disparagement doctrine would now permit a cancellation proceeding against a mark such as FIGHTING IRISH on the grounds that it may disparage a “substantial composite” of Irish Americans.

As one of the preeminent athletic programs in the nation, consumers expect goods licensed by the University of Notre Dame and bearing the FIGHTING IRISH mark to represent quality athletic wear.\textsuperscript{256} If the mark is cancelled after establishing an association with Notre Dame, then competitors could benefit from the university’s reputation and produce “knock-offs” under the FIGHTING IRISH mark.\textsuperscript{257} Thus, cancellation of established marks breaks down the flow of information to consumers and results in confusion and wasted resources when consumers attempt to differentiate officially sanctioned goods from lower-quality imitations.\textsuperscript{258}

VI. THE BOARD’S LIBERAL STANDING REQUIREMENTS AND EXPANSIVE DISPARAGEMENT DOCTRINE IMPERMISSIBLY CONFLICT WITH THE PROTECTIONS AFFORDED COMMERCIAL SPEECH AND THE POLICIES UNDERLYING FEDERAL TRADEMARK REGULATION

The Federal Circuit has limited section 2(a) opposition and cancellation proceedings before the Board by incorporating the standing restrictions imposed upon Article III tribunals.\textsuperscript{259} However, in its 1994 pre-trial ruling, the Harjo Board authorized petitioner’s section 2(a) challenge to Pro-Football’s marks based on allegations of personal offensiveness without requiring proof of actual damage.\textsuperscript{260} Absent evidence that a trademark’s registration causes a legally cognizable injury, its cancellation under section 2(a) fails to advance the “substantial” governmental interest necessary to satisfy Central

\begin{itemize}
\item \textsuperscript{255} See Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 353 (Fed. Cir. 1992) (“Both the mark’s fame and the consumer’s trust in that symbol ... are subject to exploitation by free riders.”); William M. Landes & Richard A. Posner, \textit{The Economics of Trademark Law}, 78 \textit{TRADEMARK REP.} 267, 272 (1988).
\item \textsuperscript{256} See Univ. of Ga. Athletic Assoc. v. Laite, 756 F.2d 1535, 1540 (11th Cir. 1985); White v. Bd. of Regents of Univ. of Neb., 614 N.W.2d 330, 338-40 (Neb. 2000).
\item \textsuperscript{257} Smith v. Chanel, Inc., 402 F.2d 562, 568-69 (9th Cir. 1968).
\item \textsuperscript{258} See 1 McCarthy, supra note 15, § 2:5, at 2-8 (“[T]rademarks reduce the buyer’s cost of collecting information about products by narrowing the scope of information into brand segments rather than have the buyer start anew with each single product.”).
\item \textsuperscript{259} Jewelers Vigilance Comm. Inc. v. Ullenburg Corp., 823 F.2d 490, 492 (Fed. Cir. 1987).
\end{itemize}
Hudson's framework for commercial speech regulation.\textsuperscript{261} Thus, due to the Harjo Board's failure to require petitioners to prove actual damage from the registration of Pro-Football's marks, the district court should hold the "redskin(s)" marks' cancellation under section 2(a) unconstitutional.

A. The Standing Requirements for Opposition and Cancellation Proceedings Require Strengthening to Prevent Unconstitutional Applications of Section 2(a)

Harjo deviated substantially from Federal Circuit precedent that requires section 2(a) challengers to demonstrate a "distinct and palpable injury."\textsuperscript{262} In its 1994 ruling granting the Native American petitioners standing to challenge Pro-Football's marks,\textsuperscript{263} the Board rejected a pleading requirement of actual damage and instead held that standing exists when a challenger alleges an interest in the proceeding beyond that of the general public.\textsuperscript{264} The Board's analysis failed to address, much less resolve, whether petitioners suffered a legally cognizable injury; it merely assumed that petitioners' status as members of North American Indian tribes constituted sufficient "damage" to confer standing.\textsuperscript{265}

Five years later, in Ritchie v. Simpson, the Federal Circuit followed Harjo's lead and eroded decades of its own precedent\textsuperscript{266} by granting Mr. Ritchie standing to challenge O.J Simpson's trademarks based on his status as a "family man."\textsuperscript{267} Stripping away prior limitations on the "any person" and "damage" clauses of sections 13 and 14, the court recognized sufficient "damage" to Mr. Ritchie's moral values upon registration of marks associated with O.J. Simpson's alleged criminal conduct.\textsuperscript{268} The Federal Circuit's unprecedented decision in Ritchie

\textsuperscript{261} See supra notes 137–140 and accompanying text.


\textsuperscript{263} Harjo, 30 U.S.P.Q.2d at 1830.

\textsuperscript{264} Id. at 1832.

\textsuperscript{265} Id. at 1830.

\textsuperscript{266} See supra notes 83–90 and accompanying text; William C. Rooklidge & Matthew F. Weil, Judicial Hyperactivity: The Federal Circuit's Discomfort with its Appellate Role, 15 BERKELEY TECH L.J. 725, 729 (2000); Pauline Newman, The Federal Circuit: Judicial Stablity or Judicial Activism?, 42 AM. U. L. REV. 683, 688 (1993) ("I caution against...policy-driven activism whereby the application of the law will not be known until the Federal Circuit hears the case.... It is policy choices that lead to departure from precedent, into the judicial activism that weighs against legal stability.").

\textsuperscript{267} Ritchie v. Simpson, 170 F.3d 1092, 1097 (Fed. Cir. 1999).

\textsuperscript{268} See 3 MCCARTHY, supra note 15, § 20:7, at 20-18 ("The O.J. Simpson decision contains
allowed the Harjo Board to affirm its inadequate standing analysis, in which actual harm is not required and standing is appropriate when a challenger alleges that a mark is personally offensive.\(^{269}\)

Accordingly, Congress should strengthen the current standing requirements for opposition and cancellation proceedings in order to protect trademark registrants' commercial speech rights and eliminate use of the PTO as a forum for moral objections.\(^{270}\) Congressional amendments to sections 13 and 14 should incorporate modified versions of the pleading requirements necessary to establish causes of action for the torts of defamation\(^{271}\) and intentional infliction of emotional distress.\(^{272}\) Thus, amendments requiring a challenger to demonstrate (1) a disparaging trademark, (2) intent to cause harm or emotional distress,\(^{273}\) and (3) the existence of actual harm resulting from the trademark's registration would eliminate problems associated with defining the scope of "damage" necessary to maintain section 2(a) cancellation and opposition proceedings.\(^{274}\) This approach would restore objectivity to section 2(a) challenges and reconcile trademark law with the requisite personal injury necessary to challenge other types of federal intellectual property protection.\(^{275}\)

Applying this heightened standing test to Harjo, the petitioners would have failed prongs (2) and (3) because they had not demonstrated Pro-Football's intent to disparage or actual harm, either in the form of social aversion or financial damage, by the use of THE REDSKINS mark in
connection with a respected professional organization. However, under this standard, they would have had standing to challenge the registration of "redskin(s)" for products that do not emphasize positive attributes of Native Americans, such as weapons or alcohol. Additionally, applying this test to O.J. Simpson's marks, Mr. Ritchie would have failed prongs (2) and (3) because the alleged injury to his "family values" is too speculative and abstract. But, a member of O.J. Simpson's alleged victims' families would have standing if Mr. Simpson applied for registration of THE JUICE on leather gloves or knives, due to the foreseeable severe emotional distress it would cause to have Mr. Simpson's trademarks on products associated with the murder of Nicole Brown Simpson and Ronald Goldman.

B. The Cancellation of Pro-Football's Trademarks Under Section 2(a) is Unconstitutional

In response to commercial speech concerns, the Federal Circuit continues to maintain that cancellations under section 2(a) are constitutional because the denial of federal protection does not prohibit a mark's use. This position ignores the damaging consequences of removing a trademark owner's ability to bring infringement actions and maintain the quality and integrity of his or her marks. While the Board in Harjo lacked the authority to declare section 2(a) unconstitutional, a federal district court in the District of Columbia has the authority to address constitutional questions and will be able to review Pro-Football's claim that section 2(a) abridges its right to communicate through its trademarks.

In order for Central Hudson's protections to apply, Pro-Football's trademarks must qualify as a lawful and non-misleading form of commercial speech. The U.S. Supreme Court has stated that commercial speech is identified by the proposal of a commercial

278. See RESTATEMENT (SECOND) OF TORTS § 46, cmt. d (1965).
279. See supra note 85 and accompanying text.
281. See supra notes 14–15 and accompanying text.
284. See supra notes 137–141.
transaction, and several courts and commentators have concluded that trademarks satisfy this test due to their relationship with product advertising and sales. While this classification may not apply to trademarks registered prior to their use in commerce, trademarks that are used in commerce for some time and acquire secondary meaning communicate valuable information to consumers. The WASHINGTON REDSKINS trademark has been used in commerce for seventy years and its placement on merchandise represents official endorsement by the team. The mark enables consumers to differentiate between authorized goods and lesser quality imitations. Thus, Pro-Football’s trademark, when used in connection with officially licensed merchandise, proposes a commercial transaction and conveys information about product quality.

Because Pro-Football’s trademarks are entitled to protection as commercial speech, the U.S. District Court for the District of Columbia should apply Central Hudson’s three-part test to their cancellation under section 2(a). Stripping a famous mark such as WASHINGTON REDSKINS of federal protection would satisfy Central Hudson’s second and third prongs because of the large amount of cheap imitations that would flood the market. In this regard, Pro-Football’s inability to bring infringement actions would decrease the value of its trademarks so dramatically that it would likely abandon them, thus directly advancing the government’s interest in eliminating disparaging marks. Furthermore, since section 2(a) cancellations only apply to a limited

287. 4 McCARTHY, supra note 15, § 31:139, at 31-221 ("It would appear clear that a firm’s trademark is the most important element of commercial speech which is communicated to customers."); see Tracie Rozhon, Dropping Logos That Shout, Luxury Sellers Try Whispers, N.Y. TIMES, Sept. 15, 2002, at A1.
291. See supra notes 155-157 and accompanying text.
292. See supra notes 137-141 and accompanying text.
293. See supra note 141.
295. See id. at 2–3.
class of marks adjudged "scandalous" or "disparaging," it is not an over-extensive regulation. 296

Although section 2(a) satisfies Central Hudson's proportionality review, the cancellation of Pro-Football's trademarks is unconstitutional under Central Hudson's first prong because it does not advance a "substantial" governmental interest. 297 Courts and the PTO have recognized two governmental interests sufficient for sustaining *trademark* cancellations under sections 2(a): preventing racial unrest and eliminating PTO endorsement of disparaging marks. 298 Governmental actors thus have the power to prohibit publications that promote friction among racial and religious groups. 299 Section 2(a) cancellations arguably protect groups from exposure to "disparaging" publications; however, U.S. Supreme Court decisions have significantly weakened governmental actor's ability to proscribe offensive communications. 300 Therefore, it seems unlikely that canceling a trademark such as WASHINGTON REDSKINS will advance a "substantial" governmental interest due to the mark's failure to incite violence during its seventy-year history. 301

The second governmental justification for section 2(a) cancellations arose in *Bromberg v. Carmel Self Service, Inc.*, 302 where female petitioners alleged that federal registration of disparaging marks lowers the standards of the PTO. 303 The Board subsequently discredited this argument in *Old Glory* when it held that federal registration does not amount to governmental endorsement of the applicant's goods or approval of the applicant's mark in any way. 304 With the weakening of both of section 2(a)'s "substantial" interests, the PTO must rely solely on

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296. See supra note 141.
297. See supra note 141.
298. See supra note 140 and accompanying text.
299. See Beauharnais v. Illinois, 343 U.S. 250, 251 (1952) (upholding prohibition on publications that "expose[] the citizens of any race, color, creed or religion to contempt, derision, or obloquy or which is productive of breach of the peace or riots.").
300. See Gooding v. Wilson, 405 U.S. 518, 519, 528 (1972) (striking down Georgia statute prohibiting use of "objectionable words or abusive language, tending to cause a breach of the peace"); Brandenburg v. Ohio, 395 U.S. 444, 449 (1969) (reversing Ku Klux Klan member's conviction under a statute punishing individuals "who publish or circulate or display any book or paper containing [violent] advocacy"); see also Collin v. Smith, 578 F.2d 1197, 1204 (7th Cir. 1978) (permitting National Socialist Party to march through town of holocaust survivors).
303. Id. at 177.
the government’s ability to regulate fraudulent, obscene, and intentionally hateful commercial speech to sustain the cancellation of WASHINGTON REDSKINS. However, these prohibitions do not apply because Pro-Football’s trademarks are not obscene, were registered in good faith, and have acquired strong secondary meaning that conveys useful information to consumers about the source and quality of the goods to which they are affixed. Furthermore, the U.S. Supreme Court’s plurality decision in *Liquormart* indicates the demise of section 2(a) trademark cancellations that fail to offer compelling justifications.

VI. CONCLUSION

*Pro-Football Inc. v. Harjo* presents the Article III system with a rare opportunity to address a trademark cancellation under section 2(a) of the Lanham Act. When measured against protections available to intellectual property owners in challenges before Article III courts, the liberal standing requirements for opposition and cancellation proceedings combined with *Harjo’s* expansive disparagement doctrine present serious risks to trademark owners’ ability to obtain federal registration and exercise their commercial speech rights. Accordingly, the U.S. District Court for the District of Columbia should disregard *Harjo’s* “substantial composite” standard and analyze Pro-Football’s trademarks under *Greyhound’s* definition of disparagement. Furthermore, the district court should declare section 2(a) unconstitutional as applied to Pro-Football’s trademarks. Absent heightened standing requirements, *Harjo’s* expansive disparagement doctrine will continue to permit marginal litigation against trademarks that do not cause actual harm. In this regard, Congress should draft more objective “damage” criteria into sections 13 and 14 in order to limit section 2(a) challenges to invasions that the government has a substantial interest in proscribing. Finally, Congress should amend section 2(a)’s vague “scandalous” and “disparaging”

310. See *supra* note 44 and accompanying text.
311. See *supra* notes 145, 151–154 and accompanying text.
rubric to limit the denial of federal trademark registration to only obscene, fraudulent, misleading, and intentionally hateful trademarks.