

THE REDSKINS AND TRADEMARK DISPARAGEMENT

Richard J. Hunter, Jr.

Professor of Legal Studies, Seton Hall University

John H. Shannon

Professor of Legal studies

Hector R. Lozada

Associate Professor of Marketing
Seton Hall University

ABSTRACT: *Consider this scenario: “When Chinatown dance-rock band “The Slants” wanted to trademark their name, they didn't imagine any problems. After all, they were the only band with that name. But the United States Patent and Trademark Office (USPTO) saw things differently and denied their application. The USPTO ruled that “The Slants” name “consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage.” In this case, the ruling was in reference to the term “slant” as a derogatory term for someone of Asian descent.” Does this fact pattern seem to the reader as so outlandish as to be the product of a great imagination? It might be fiction... but it is true.... (Fabio, 2011; Bonadio, 2015). This article will discuss issues relating to registration of trademarks and how they might be subject to cancellation or rejection on grounds of disparagement in light of facts developed in a series of cases involving the Washington Redskins and their famous (or now infamous) trademark.*

KEY WORDS: Redskin, Registration, Disparage, Trademark, Lanham Act, Laches, Scandalous, Cancellation

INTRODUCTION AND OVERVIEW



Redskins Primary Logo

(1972–1981, 1983–present)

For the first time in a battle that has consumed more than twenty years, a federal judge who intervened in the trademark dispute involving the Washington Redskins ordered the cancellation of the Washington Redskins trademark registration for six of its trademarks.

(The primary logo is shown above.) U.S. District Judge Gerald Bruce Lee ruled on July 5, 2015 that the team name *may* be disparaging to Native Americans. (*Pro-Football, Inc. v. Blackhorse*, 2015).

The decision of Judge Lee upheld the earlier ruling of an administrative appeals board [Trademark Trial and Appeal Board or TTAB] of the federal Patent and Trademark Office. (*Pro-Football, Inc. v. Blackhorse*, 2014). Judge Lee ordered the Patent and Trademark Office to cancel the Redskins' registration.

This article will consider the issues raised in 2014-2015, in light of earlier cases and controversies involving the Washington Redskins, providing a background from some of the major cases that had considered whether a potential or currently registered trademark had *disparaged* any party.

TRADEMARK PROTECTION AND DISPARAGEMENT CONSIDERED

Trademark Registration

A trademark is "any word, name, symbol, or device or any combination thereof used by any person to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown." (See *Two Pesos, Inc. v. Taco Cabana, Inc.*, p. 768, 1992; Haring, 2006, in *Understanding Basic Trademark Law*, p. 13, 2006). Federal law does not create trademarks—it simply registers a trademark that is entitled to registration. (See *In re Trade-Mark Cases*, p. 92, 1879). The "right to a particular mark grows out of its use, not its mere adoption...." (*United Drug Co. v. Theodore Rectanus Co.*, p. 97, 1918; *La Societe Anonyme des Parfums le Galion v. Jean Patou, Inc.*, p. 1270 n.5, 1974). The Fourth Circuit in *Emergency One, Inc. v. Am. Fire Eagle Engine Co.* (p. 267, 2003) stated: "To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services."

In addition to trademarks, Section 3 of the Lanham Act (15 U.S.C. Section 1053, 1946) recognizes service marks (which "identify and distinguish the services of one person . . . from the services of others and . . . indicate the source of the services, even if that source is unknown"); Section 4 (15 U.S.C. Section 1054, 1946) recognizes both certification marks (which "certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organizations), and collective marks (which are "used by the members of a cooperative, an association, or other collective group or organization").

The United States Patent and Trademark Office (USPTO) is charged with administering federal law governing patents and trademarks. Under the Lanham Act of 1946, the USPTO registers and regulates trademarks. The Act details the registration procedure of trademarks and sets out the causes of action and remedies available to federally registered trademark owners.

There are two main causes of action available to a trademark owner under the Lanham Act: *trademark infringement and trademark dilution*. Trademark infringement cases typically “involve one party using a mark similar to another already in use.... The other main cause of action available to a trademark owner is a dilution claim. A mark can be diluted in one of two ways: *blurring* or *tarnishing*. A mark is blurred when someone uses a famous mark on products in an entirely different market, such as the Kodak trademark on a piano. Alternatively, a mark is tarnished when someone uses the famous mark on an inferior product, thereby harming the reputation of the famous mark.” (Botnick, pp. 739-740, 2008).

Why is the legal recognition of a trademark so important?

Registration confers several statutory benefits upon the owner of a mark in addition to those available at common law. (*Hanover Star Milling Co. v. Metcalf*, 1916). These include:

- (1) constructive notice of the registrant's claim of ownership of the trademark;
- (2) prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of his exclusive right to use the mark in commerce as specified in the certificate;
- (3) the possibility that, after five years, registration will become incontestable and constitute conclusive evidence of the registrant's right to use the mark;
- (4) the right to request customs officials to bar the importation of goods bearing infringing trademarks;
- (5) the right to institute trademark actions in federal courts without regard to diversity of citizenship or the amount in controversy; and
- (6) treble damage actions (15 U.S.C. section 1117(a), 1946) against infringing trademarks and other remedies.

The owner of a trademark can apply to register the trademark with the United States Patent and Trademark Office (USPTO) under Section 1 (15 U.S.C. Section 1051, 1946). After reviewing an application, “[if] a trademark examiner believes that registration is warranted, the mark is published in the Official Gazette of the PTO” as well as the Principal Register. (*B & B Hardware, Inc. v. Hargis Indus.*, p. 1300, 2015).

Disparagement

Disparagement refers to a statutory cause of action that permits a party to petition the Trademark Trial and Appeal Board to cancel a trademark registration under Section 13 (15 U.S.C. Section 1063, 1946; Marklaw.com, 2015). Under Section 2 (15 U.S.C. Section 1052(a)), the term extends the cancellation to situations that falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute. (See **Appendix I** for *Grounds for Cancellation* of a previously registered Trademark.)

As a threshold matter, the Board has established a two-step test for determining whether a matter may be disparaging under Section 2. (15 U.S.C. Section 1052(a));

(Motolenich-Salas, 2014). Under this test, the following factors must be considered:

- (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner

in which the mark is used in the marketplace in connection with the goods or services; and

(2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.

At that point, a party seeking the cancellation of a registered trademark was required to prove two elements: (1) that the communication would be understood as referring to the plaintiff, and (2) that the communication would be considered offensive or objectionable by a reasonable person of ordinary sensibilities. (Epstein, 2013).

A Discussion of Some of the Seminal Cases in the Area of Disparagement

The following is a discussion of some of the most important cases involving an allegation of disparagement. (Generally, Anten, 2006). Unless otherwise noted, the discussions are abstracted from the original *Trademark Trial and Appeal Board Records*, accessed from the *United States Patent Quarterly*:

Order Sons of Italy in America v. The Memphis Mafia Inc. (1999)



The Order Sons of Italy in America (the Order) filed a petition to cancel Registration No. 1,891,835 of the mark **THE MEMPHIS MAFIA** for “entertainment services.” (See **Appendix II** for the *Steps in a Cancellation Proceeding*.) In the petition to cancel, petitioner alleged that the Order:

“since its founding in 1905, has been engaged in providing fraternal assistance and moral support to its Italo-American members through approximately 2700 lodges in the United States and Canada; that at many of the lodges entertainment services are provided, which may include talks relating to famous Italian Americans; that the Commission for Social Justice (CSJ) is a separate corporate entity of the Order which works to eradicate bias, bigotry and prejudice against Italo-American citizens; that the CSJ has particularly fought to eliminate the indiscriminate use of the term “Mafia”; that although “Mafia” originates from a battle cry used against the French in the invasion by Napoleon in 1799, the term now has an entirely different meaning; that the Order and the CSJ object to use of the term beyond the description of a small group of organized criminals in Italy and America; that “Mafia” is a word from an intent-to use application filed Oct. 4, 1990.”

The Order stated that the term “mafia” is detested by most law-abiding Italians and Italian Americans, and “to call an honest Italian or Italian American a member of any “Mafia” is a grave insult that disparages the character and damages the reputation of the individual by labeling him or her a criminal...” As a result, the Order petitioned the TTAB to cancel the registration of the mark **THE MEMPHIS MAFIA** because its use for the services listed disparages the members of the Order and brings the Order as an institution into contempt or disrepute. Respondent denied the allegations of the petition to cancel.

There is an interesting history attached to the opposition to the use of the word “mafia” by Italian-American groups which is outlined in the opinion:

- “Mr. Spatuzza testified that, as president of the Order, he wrote to Attorney General Griffen Bell in March 1977 regarding renewed use by the Justice Department of the terms “Mafia” and “Cosa Nostra,” after a prior ban issued by Attorney General John Mitchell in 1970;
- That a response was received from Griffen Bell affirming that “terms like ‘mafia’ and ‘cosa nostra’ have no place in the discourse of Justice Department officials” and that it “has been this Department’s policy not to use such disparaging terms when referring to organized crime. This is and will continue to be our policy.”
- Mr. Spatuzza also identified the early memorandum issued by Attorney General John Mitchell in which the Attorney General noted that it had “become increasingly clear that many good Americans of Italian descent are offended by the use of the terms Mafia and Cosa Nostra in news reports dealing with organized crime,” and that “since there is nothing to be gained by using these terms except to give gratuitous offense, I am requesting that we discontinue their use in news releases, speeches or other public statements of this Department...”

The Order’s three witnesses (deponents), testified as to their opinions that the mark **THE MEMPHIS MAFIA**, when used for the listed entertainment services, “disparages the members of the Order and brings the Order as an institution into contempt and disrepute; that the mark perpetuates the stereotype fostered on the American public of a connection between Italian-Americans and organized crime, or criminal activity in general; and that it will have a negative impact on not only members of the Order, but all Americans of Italian descent.” These witnesses also testified to the effect that, since “the Order sponsors entertainment services at its lodges and various groups advertise in its publications, and since there are many Italians in the music business, people might believe that there was a relationship between the Order and respondent’s services.”

Respondent, however, argued that the purpose of the group of men known as “The Memphis Mafia” is “solely to perpetuate the memory of Elvis Presley; that the group consists of associates and employees of Elvis Presley who now give talks about Elvis; that these persons, when traveling with Elvis, were in no way thought of as gangsters or mobsters; that the mark **THE MEMPHIS MAFIA**, as used in connection with respondent’s services, is not intended to disparage the Italian people; and that the talks are not directed to crime, ethnic groups or anything other than Elvis Presley.”

Respondent argued that the term “Mafia” as used in its mark, falls within the dictionary definition of “mafia” as “an exclusive and dominant group.” Respondent cited Webster’s Collegiate Dictionary (3d ed.) for this definition.

The Board first turned to the *likely meaning* of the term “Mafia” as used in respondent’s mark **THE MEMPHIS MAFIA**. The Board found matter which “may disparage” to include matter which may “dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison.” While the Order introduced one definition and respondent has referred to another definition, the Board took judicial notice of *additional definitions* (See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, 1983) and decided that the word “Mafia” was *not offensive or disparaging per se to any ethnic group*. Perhaps it is important to note that the Order itself had, in fact, acknowledged that the word “mafia” was “appropriately used when reference is accurately being made to the specific international criminal organization.”

The next step was to determine the meaning most likely to be attributed to the term “Mafia,” as it was being used in respondent’s mark and in connection with respondent’s services. “The mark is **THE MEMPHIS MAFIA** and the services are entertainment services in the nature of talks relating to music personalities.” While respondent has stated that “the talks are in fact restricted to one performer, Elvis Presley, we cannot construe the topic of the talks so narrowly, the Board could find no evidence of record to substantiate this representation; nor were the services, as identified, so limited.”

From the record before it, the Board found no connection whatsoever between respondent’s entertainment services and the dictionary definition of “Mafia,” as an organization dedicated to criminal activities composed of persons of Italian origin. “Instead, the only relevant meaning of the term MAFIA as used in respondent’s mark would presumably be the definition of “mafia” as an exclusive, or small and powerful, group or clique.”

The difficulty may lie in the fact that while the Order had taken the broad stand that use of the term “Mafia” in any way, other than when accurately used in reference to one specific criminal organization, *is a slur to the Italian-American ethnic group*, the record was not persuasive of this position. The Board was able to distinguish this case from *Harjo*, discussed below, where *all* usages of the term “Redskins” were found to be offensive to Native Americans.

Accordingly, the Board found that the petitioner had failed to carry its burden of proving that the term “Mafia,” as used by respondent in the mark **THE MEMPHIS MAFIA** in connection with its entertainment services, “may disparage” either the members of the Order or Italian-Americans in general. The Board decided that the petition to cancel the trademark would be denied.

In re Squaw Valley Development Company (2006)

SQUAW VALLEY

In *Squaw Valley*, the TTAB concluded that the evidence offered by the examining attorney reflected that a substantial composite (cross-section) of Native Americans would consider the term **SQUAW**, when its meaning is a Native American woman or wife, to be disparaging regardless of context, including in connection with applicant's identified goods and services in International Classes 25 and 35. (See WIPO, 2015). The evidence showed that this term, when it means a Native American woman or wife, was generally offensive to Native Americans, no matter what the goods or services with which the mark is associated.

The Board relied on its decision in *Harjo v. Pro-Football, Inc.* (1999), discussed below, in which it applied a two-part test for determining whether matter may be disparaging under Section 2(a):

“what is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services;”

“if that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group.”

Thus, after reconsidering the applicant's and the examining attorney's arguments, as well as the evidence before it, in light of the standard of proof required in an *ex parte* proceeding, the TTAB was persuaded that the examining attorney had met the USPTO's burden of establishing that a “substantial composite of Native Americans finds the use of “squaw” in connection with applicant's identified goods and services in International Classes 25 and 35 to be disparaging” and that the examining attorney has made out a prima facie case of disparagement under Section 2(a).

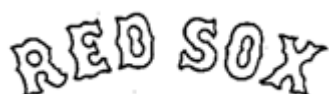
However, the TTAB also found that, when **SQUAW** was considered in connection with applicant's “skis, ski poles, ski bindings, ski tuning kits comprised of waxes and adjustment tools, ski equipment, namely, power cords,” i.e., items which are directly connected with skiing, it is the *Squaw Valley ski resort meaning* of **SQUAW**, rather than the meaning of a Native American woman or wife, that will come to the minds of consumers.

Boston Red Sox Baseball Club Ltd. Partnership v. Sherman (2008); *Incontestable*, 2008)

In *Boston Red Sox Baseball Club Ltd. Partnership v. Sherman*, Brad Francis Sherman (“Applicant”) filed an intent-to-use application to register the mark **SEX ROD** in the same stylized font as the famous **RED SOX** mark (shown below) for a wide range of clothing and apparel products.



The Boston Red Sox Baseball Club Limited Partnership (Red Sox) (“Opposer”) filed a notice of opposition, alleging prior use and registration of marks that consist of or incorporate the terms **RED SOX** (“**RED SOX Marks**”), including the stylized mark shown below in connection with baseball game services and a variety of goods, including clothing:



As grounds for the opposition, the Red Sox alleged that: (1) applicant lacked a bona fide intent to use the mark at the time of filing; (2) the mark consisted of immoral and scandalous matter; (3) the mark disparaged the Red Sox and/or brought it into contempt or disrepute; (4) there was a likelihood of confusion with **RED SOX** marks; and (5) the mark falsely suggested a connection with the Red Sox.

The Red Sox argued that **SEX ROD** comprised matter that would be considered “vulgar” to a substantial cross section (composite) of the general public when used on T-shirts and other items of apparel, including, in particular, goods intended for children and infants.

The Red Sox submitted evidence from the dictionary defining the word "rod" as "Slang... b. Vulgar, the penis." In response, the applicant conceded that **SEX ROD** was intended to possess a sexual connotation, but argued that it was only "sexually suggestive" and described his mark as a “parody” of the **RED SOX** stylized mark. (Shipley, 2010).

According to the Applicant, the mark "represents the clever yet sophomoric sense of humor that prevails in venues in which apparel bearing the **SEX ROD** Stylized mark would likely be worn, e.g., ballparks, sports bars, and university campuses." The TTAB explained that dictionary evidence alone can be sufficient to establish that a term has a vulgar meaning. Further, the TTAB found that as the mark would appear on apparel and be worn in all types of public places, the mark would convey not a sexually suggestive connotation as applicant contended, but rather a *sexually explicit* message to the viewer.

The TTAB agreed that the use of the mark on children's and infant clothing made it particularly “lurid and offensive.” Even assuming **SEX ROD** was a parody of the **RED SOX** Marks, the TTAB concluded there was nothing in the parody itself that changed or detracted from the vulgar meaning inherent in the term.

The TTAB also found that the Applicant had copied the “form, style, and structure” of the Opposer's corporate symbol, and that Applicant's mark was so visually similar to the original, such that many consumers would recognize it as referring to the Red Sox. Because the TTAB found that the mark **SEX ROD** would be perceived as a vulgar term by a substantial number of consumers, and because Applicant's mark would be understood as referring to the Opposer, the TTAB ruled that the mark would be viewed as a sexually vulgar version of the baseball club's symbol and thus constituted disparagement under Section 2(a).

The TTAB sustained the opposition on the grounds that the **SEX ROD** mark was scandalous and disparaging under Section 2(a) and that Applicant lacked a bona fide intent to use the mark in commerce. The TTAB dismissed the opposition on the ground of likelihood of confusion under Section 2(d) and on the ground that the mark falsely suggested a connection with the Opposer under Section 2(a). The TTAB stated that the fact that the Applicant's mark might “call to mind the Opposer's organization” did not compel a finding of a likelihood of confusion. In addition, the TTAB concluded that the public would *not* reasonably conclude that the Opposer, “a famous and reputable organization,” would be associated with the Applicant's mark. However, in the end, the mark would not be registered on disparagement grounds.

In re Heeb Media LLC (2008); Incontestable, 2009)

HEEB

In re Heeb Media LLC dealt with the USPTO's refusal to register the mark **HEEB** for apparel and event planning. The examining attorney refused to register the mark on the grounds that it was disparaging to a substantial cross-section (the term used in the decision is "a composite") of Jewish people, even though the applicant already owned the registered mark **HEEB** for the "publication of magazines." Interestingly, the examining attorney relied on dictionary evidence and news articles containing quotes relating to the disparaging and offensive nature of the term "heeb."

The examining attorney cited the two-step analysis for determining if a mark is disparaging:

"(1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services;" and

"(2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group." (Incontestable, 2009).

The Trade Mark Trial and Appeal Board (TTAB) clarified that a "substantial composite of the referenced group" was not necessarily a majority of the group. With respect to the first step of the analysis, neither party contested meaning of the term "heeb" or that the term referenced Jewish people.

With respect to the second step of its analysis, the TTAB considered how individuals within the referenced group perceived the **HEEB** mark when used in the context of clothing and event planning services. Relying on the *Cassel Dictionary of Slang*, the TTAB concluded the term does *not* have "a separate non-derogatory character."

Interestingly, the TTAB determined that no specific percentage or segment of the Jewish population to have found the mark disparaging—in fact, relying on the applicant's own evidence, the TTAB recognized there were in fact "disparate views within the Jewish community, generally along generational lines, as to whether the term "heeb" was disparaging"—yet, the TTAB imputed the disparate views of those entered into evidence by both the examining attorney and the applicant to the entire "post-college age Jewish population" without the necessity of any additional evidence. Essentially, by finding that *some* Jewish people determined the term "heeb" itself to be objectionable, the TTAB found the evidence sufficient to establish a *prima facie* case that the mark was disparaging and that the applicant's evidence failed to rebut the *prima facie* case established by the examining attorney. As such, the TTAB affirmed the examining attorney's refusal to register the applicant's mark on the grounds that the mark was disparaging in degradation of Section 2(a) of the Lanham Act. (15 U.S.C. Section 1052(a), 1946).

In re Lebanese Arak Corporation (2010)



Lebanese Arak Corporation is a California corporation which filed an appeal from the final refusal of the trademark examining attorney to register “**KHORAN**” in standard characters as a trademark for "alcoholic beverages, namely wines."

Registration of “**KHORAN**” was refused by the trademark examining attorney of the United States Patent and Trademark Office (USPTO) on the basis of Section 2(a) of the Trademark Act (15 U.S.C. Section 1052(a)), on the ground that applicant's mark was disparaging, that is, it involves a registration of an “immoral, deceptive, or scandalous matter.” The examining attorney's position was that the mark, **KHORAN**, was the phonetic equivalent of "Koran"; that the Koran is the sacred text of Islam; and that the Koran forbids consumption of alcoholic beverages, including wine—all of which were disparaging to the beliefs of Muslims.

The trademark examining attorney determined that the term **KHORAN** gives the commercial impression that it is the word Koran, and that the public in general, and Muslim Americans in particular, would regard the mark as referring to the holy text of Islam. What were the factors that led to this conclusion?

First, **KHORAN** can be pronounced identically to the word "Koran." Although the trademark examining attorney noted that applicant's argument that the letter "H" in its mark is not silent, but has a distinct sound in combination with the letter "K", it has long been held that there is no correct pronunciation of a trademark that is not a recognized English word. Whether or not **KHORAN** may be pronounced by an Armenian speaker as applicant asserted (the family that operates the winery, Kurkjian, is Armenian) many Americans, including Muslim Americans, would pronounce it as "Koran." This was considered as the proper context. The examining attorney further stated that this pronunciation would be particularly troubling if **KHORAN** wine were advertised on the radio, where consumers would not even be aware that applicant's mark contains an "H."

Second, because "Koran" has various accepted spellings, people are likely to regard **KHORAN** as another variant spelling, even if not an "official" one. Because the examining attorney had no doubt both that **KHORAN** would be recognized as the name of the holy text of Islam, and that the use of this term for wine would be disparaging to the religion and beliefs of Muslim Americans, the USPTO refused registration of the trade mark.

These cases provide necessary background information that will be helpful in analyzing the issues presented in the Redskins controversy.

THE INITIAL SKIRMISH FOR THE REDSKINS: PRO-FOOTBALL, INC. V. HARJO

In *Pro-Football, Inc. v. Harjo* (2005), the U.S. Court of Appeals for the District of Columbia considered the decision of the United States Patent and Trademark Office's Trademark Trial

and Appeal Board (TTAB) in which the Board had cancelled the registration of the Washington Redskins football team, based on the claim that the name was disparaging to Native Americans. However, in its decision, the Court of Appeals did not reach the merits of the TTAB's decision relating to the claim of disparagement. The Court of Appeals sent the case back to the trial court for consideration of a procedural issue.

In 1992, activist Suzan Harjo led seven Native Americans in petitioning the TTAB to cancel six trademark registrations owned by Pro-Football, Inc., the corporate entity that operates the Washington Redskins. Harjo had previously served as Congressional liaison for Indian affairs in the Carter administration and later, as president of the National Council of American Indians, a group which advocates "citizenship rights, better educational opportunities, improved health care, and cultural recognition and preservation" for American Indians.

The TTAB granted the petition, and the ownership of the Redskins appealed to the United States District Court for the District of Columbia, which overturned the cancellation of the trademarks on two separate grounds. (284 F. Supp. 2d 96, 2003). On the facts, the District Court found that the TTAB lacked substantial evidence to find disparagement. Specifically, there was little or no evidence that during the relevant time period, namely when the marks were registered, that a "substantial composite" of the Native American population found the term "Redskins" to be disparaging.

Should the Equitable Doctrine of Laches Apply?

The petitioners appealed this decision of the District Court to the Court of Appeals. The Court of Appeals would consider several questions:

1. Whether the complainants had indeed presented "substantial evidence" to the TTAB;
2. Whether a laches defense should apply at all in a disparagement case; and
3. If such a defense should apply, whether it would bar these particular complainants.

The Redskins maintained that since they had registered their marks as early as 1967, the petition was barred by the equitable doctrine of *laches*—a legal theory which prohibits a party from waiting so long to file a claim that it becomes unfair to the other party. (Wallace, 2011). As Jessica Kiser (pp. 22-23, 2011) noted in the *University of San Francisco Law Review*: "The defense of laches is based on the underlying principle that 'equity aids the vigilant and not those who slumber on their rights.' The laches defense is thought to encourage plaintiffs to be vigilant about protecting their rights while promoting judicial efficiency by requiring that suits be brought when evidence is still available and when courts are in the best possible position to resolve the underlying disputes."

As noted in the *Berkeley Technology Law Journal* (p. 739, 2005): "Laches is an available defense in an action to cancel a trademark as potentially disparaging upon satisfaction of three conditions: (1) substantial delay by plaintiff prior to filing suit; (2) plaintiffs awareness of the mark during the delay; and (3) reliance interest resulting from defendant's continued development of good-will during this period of delay."

The Native Americans argued that the doctrine of laches should not apply to a disparagement claim at all, because the statute specifies that such a claim can be brought "*at any time*." The Court of Appeals rejected this contention, noting that other language in the same statute specifically permits equitable defenses, and laches is just such a defense that may be offered by a defendant.

The Court of Appeals then considered the applicability of laches to the case that had been filed. The Court set forth a three-component test which requires answers to three questions:

- (1) Was there a "substantial delay" in bringing a suit?
- (2) Did the opposing party have knowledge of the existence of the trademarks during that delay? And
- (3) Was there continued development of goodwill in the trademarks during that delay?

Laches must be applied separately to all four of the relevant dates of registration for the six trademarks.

Because the defense of laches depends on the delay of the plaintiff in pursuing his or her rights—which in the case of a minor, can not effectively be pursued until the plaintiff has reached the age of majority—the Court of Appeals found that the defense could not be applied against the youngest plaintiff, who was only one year old when the trademarks were first registered in 1967. It vacated the District Court's application of laches to *that* plaintiff, and remanded the case to the District Court for further consideration of *that* issue only. The Court of Appeals retained jurisdiction over the rest of the case (including the question of whether the TTAB's decision had been supported by substantial evidence), pending the District Court's resolution of the laches issue.

The Court of Appeals acknowledged the assertion by the Redskins that finding a trademark disparaging a group with a constantly expanding population would leave the trademark "perpetually at risk." However, the fact that Pro-Football may never have security in its trademark registrations stems from Congress's decision not to set a statute of limitations, and instead to authorize petitions for cancellation based on disparagement "at any time".

It is important to take a more detailed look at three of the more important aspects of a laches analysis—issues which would be revived once again in the near future.

The Delay Prong

The District Court concluded that in reference to the marks registered in 1967, 1974, and 1978, the delay was "facially substantial." The delay for the 1990 trademark (i.e., the "Redskinettes" trademark) was deemed substantial "given the context of this case." Latterell (p. 1156-1158) noted that "the name "Redskinettes" has been used since 1962, and this thirty-year timeframe of use of the name, in conjunction with the existence of the other five trademarks and the lack of a challenge of the 1990 trademark until 1992, led the district court to conclude that the delay was substantial."

In support of this contention, the District Court noted that the American Indians had received clear notice of the trademarks in question when each of the six trademarks was published and again when each of the six trademarks was registered. The TTAB has made it clear that "the

clock for laches begins to run when each trademark is published. Not only did the American Indians have constructive notice, but they also had actual notice of the trademarks during the delay periods because they knew about the Washington Redskins football team.” (284 F. Supp. 2d at 140, 141). The District Court concluded that there was no reasonable excuse for the delay created by the American Indians. Thus, noted the District Court, the delay was deemed unreasonable.

The Prejudice Prong

Delay alone would not satisfy the invocation of laches; in addition to showing an inexcusable delay in bringing suit, Pro-Football (PFI) would be required to show that it suffered a “negative consequence or prejudice” due to the delay. (284 F. Supp. 2d at 141, citing *Bridgestone/Firestone Research, Inc. v. Auto. Club de L'Ouest de la France*, 2001).

The Court noted that Pro-Football (PFI) had certainly made a substantial investment and development in the Redskins "brand" throughout the period of delay, based on television contracts and the sale of merchandise and game tickets over a twenty-five year period. Thus, as to the second prong of the test, laches would likewise bar the American Indians' claim. (284 F. Supp. 2d at 144).

The Public Interest Exception

There is, however, the possibility that the doctrine of laches might have to give way if there were an overriding public interest in permitting the plaintiffs to nevertheless move forward with their claim. The District Court noted that courts have historically found in favor of tardy Section 2(d) “likelihood of confusion” claimants because the Lanham Act includes a public interest component. Due to the public interest implicated in likelihood of confusion cases, courts often apply the public interest exception to the doctrine of laches in such cases. But, the District Court concluded that in the context of Section 2(a) disparagement cases, the public interest is narrower than in Section 2(d) cases, because Section 2(a) disparagement cases have a more narrow overall application.

The District Court noted that it is inaccurate to say that laches is unavailable whenever the public interest is involved. (284 F. Supp. 2d. at 137-138). Latterell (p. 1157-1158, 2005) states that “such a rule would be too broad in application as all actions brought under § 2(a) would be outside of the reach of laches. If the rule were to be boundless in this regard, the policy purposes of trademark protection would be undermined and dilatory behavior would be rewarded.” As a result of considering the possible “public interest exception,” the District Court concluded that laches barred the disparagement claim despite the existing public interest in the claim.

Thus, in its application of the doctrine of laches, the *Harjo* court concluded that: (1) the American Indians did substantially delay in bringing suit, (2) the American Indians had notice of the marks during that delay, and (3) the interests of Pro-Football were prejudiced by that delay. (Latterell, 2005).

In July 2008, the District Court, to which the case had been remanded, also found that the doctrine of laches still applied to the supposedly minor plaintiff, since as a matter of fact he had turned 18 eight years *before* the case was filed. On November 16, 2009, the U.S. Supreme Court declined certiorari and refused to hear the Native American group's appeal of the District Court decision. (Generally, Paczkowski, 2004).

FAST FORWARD TO 2012-2015: “IF AT FIRST YOU DON’T SUCCEED...”

In 2012, yet another case was brought by Native Americans in *Blackhorse v. Pro-Football, Inc.*, with younger plaintiffs whose standing would not be barred by laches. (Ho, 2012). On June 18, 2014, the TTAB scheduled the cancellation of the registrations of the Redskins Marks under Section 2(a) of the Lanham Act. The TTAB found that at the time of their registrations the marks consisted of matter that both “may disparage” a substantial composite of Native Americans and bring them into contempt or disrepute. (*Blackhorse v. Pro-Football, Inc.*, 2014).

After the 2014 ruling by the TTAB, the Redskins sued in the federal District Court in Alexandria, Virginia, seeking to overturn the ruling. In sum, the lawyers for the Redskins argued that the name actually *honors* Native Americans. In addition, the Redskins legal team, headed by prominent attorney Robert Raskoph, maintained that the ruling of the TTAB violated the team’s free speech rights because it requires the government to make a judgment whether this particular name may be “offensive.” PFI also argued that the TTAB had erred in deciding that the defense of laches does not bar the claims of the Blackhorse.

The 2015 Decision

Interestingly, in his decision, Judge Lee cited the June 2015 decision of the United States Supreme Court which allowed the state of Texas to bar the depiction of the Confederate Battle Flag on specialty state license plates sought by a Texas group called the “Sons of Confederate Veterans.” (*Walker v. Texas Division, Sons of Confederate Veterans*, 2015; de Vogue, 2015).

Judge Lee stated that just as the state of Texas could not be forced to issue the specialty license plates depicting a flag that many groups or individuals considered offensive, the Patent and Trademark Office could not be forced to register a trademark that it deemed to be disparaging. *Walker* seemed to reject the main contentions offered by the Washington Redskins (Pro-Football, Inc.)

How did the case reach the United States District Court?

15 U.S.C. Section 1071(b)(1) “permits a party in a trademark suit to initiate a civil action in the place of an appeal of the TTAB’s determination to the Federal Circuit.” (Swatch AG v. Beehive Wholesale, LLC, p. 155, 2014). “In a § 1071(b) action, the district court reviews the record de novo and acts as the finder of fact. The District Court has authority independent of the PTO to grant or cancel registrations and to decide any related matters such as infringement and unfair competition claims.” (*Durox Co. v. Duron Paint Mfg. Co.*, 1963).

The Taxonomy of Judge Lee’s Opinion

The following is a detailed discussion abstracted from the opinion of Judge Lee. In this opinion, Judge Lee referred to the main points of the 2014 decision of the TTAB, as well as laying out the rationale for the decision of the District Court to uphold the decision of the TTAB and cancel the trademarks of Pro-Football, Inc.

The District Court alluded to the substantial history of controversies surrounding the Redskins trademarks. To say the least, the trademarks “have not evaded controversy.” (See

Walker v. Tex. Div., Sons of Confederate Veterans, Inc., p. 2262, 2015 (Alito, J., dissenting)). In 1971 and 1972, there were many newspaper articles detailing opposition to the name “Redskins” by some Native Americans. Similarly, in 1972 Leon Cook, President of the National Congress of American Indians (“NCAI”), among others, met with Edward Bennett Williams, the president of PFI, and explained that the team name was a slur. Williams reported the meeting to the NFL Commissioner the following day. Surprisingly, a 1972 official game program referenced the controversy surrounding the team’s name.

In pressing in argument before the District Court, PFI maintained that the record did not establish by a preponderance of the evidence that a “substantial composite” of Native Americans believe that the Redskins marks consisted of matter that “may disparage” them at the time of their registrations (1967, 1974, 1978, and 1990), and reiterated (2) that the defense of laches bars Blackhorse defendants’ claims.

Review of District Court’s Decision Relating to Constitutional Issues

PFI also made the following arguments, which may be considered as its *constitutional claims*: “(1) Section 2(a) of the Lanham Act violates the First Amendment by restricting protected speech, imposing burdens on trademark holders, and conditioning access to federal benefits on restrictions of trademark owners’ speech; (2) Section 2(a) of the Lanham Act is unconstitutionally vague in violation of the Fifth Amendment because it does not provide notice as to which marks “may disparage,” it authorizes arbitrary and discriminatory enforcement, and it is impermissibly vague as-applied to PFI.” (See Wright, 2005). In addition, PFI argued that the TTAB Order violates the Due Process and Takings Clauses of the Fifth Amendment because it deprives PFI of its property without due process and constitutes an unconstitutional taking of PFI’s property.

As to the constitutional challenges relating to the First Amendment, the Court held that the federal trademark registration program is *government speech* and “The Free Speech Clause” of the First Amendment clause does not regulate government speech. (*Pleasant Grove City, Utah v. Summum*, 2009). Government speech is, in fact, exempt from First Amendment scrutiny. (*Johanns v. Livestock Mktg. Assn.*, 2005; Norton, 2008). Accordingly, the Court held that PFI’s First Amendment claim had failed.

As to the issue of *vagueness*, the Court held that Section 2(a) of the Lanham Act was not void for vagueness for four reasons. “First, because PFI has not supported a facial void-for-vagueness challenge. Second, because Section 2(a) gives fair warning to the conduct under its purview. Third, because the PTO’s guidelines concerning what “may disparage” neither encourage nor authorize arbitrary and discriminatory enforcement. Fourth, because PFI has not supported an as-applied vagueness challenge.”

In relation to PFI’s *Fifth Amendment* challenge, the Court stated the following: “First, Section 2(a) of the Lanham Act is not void [for vagueness] because (1) PFI cannot show that Section 2(a) is unconstitutional in all of its applications; (2) Section 2(a) gives fair warning of what conduct is prohibited; (3) Section 2(a) does not authorize or encourage “arbitrary and discriminatory enforcement”; and (4) Section 2(a) is not impermissibly vague as applied to PFI. Second, the Takings Clause and Due Process Clause claims fail because a trademark registration is not considered property under the Fifth Amendment.” (See Marlan, 2013).

Lanham Act Challenges

The more important debate would revolve around the challenge to the Redskins' trademark on the issue of disparagement. (Behrendt, p. 407, 2000). The parties agreed that the test in this case would be as follows:

1. What is the *meaning of the matter in question*, as it appears in the marks and as those marks are used in connection with the goods and services identified in the registrations?
2. Is the meaning of the marks one that may *disparage* Native Americans? (Harjo v. Pro-Football, Inc., p. 1740-1741, 1999).

As a matter of fact, the Court found that because PFI made continuous efforts to associate its football team with Native Americans during the relevant time period by and through all six Redskin marks, and by the use of the term "Redskins," the "meaning of the matter in question" is clearly a reference to Native Americans.

"PFI admitted that "redskins" refers to Native Americans. The team has consistently associated itself with Native American imagery. First, two of the Redskins Marks contain an image of a man in profile that alludes to Native Americans, including one that also has a spear that alludes to Native Americans. Second, the team's football helmets contain an image of a Native American in profile. Third, the team's marching band wore Native American headdresses as part of their uniforms from at least 1967-1990. And, fourth, the Redskins cheerleaders, the "Redskinettes," also dressed in Native American garb and wore stereotypical black braided-hair wig." (*Pro-Football, Inc. v. Blackhorse*, WL 4096266, p. 22, 2015).

As stated by the TTAB in *Harjo* and confirmed by the D.C. District Court in *Blackhorse*:

"This is not a case where, through usage, the word "redskin(s)" has lost its meaning, in the field of professional football, as a reference to Native Americans in favor of an entirely independent meaning as the name of a professional football team. Rather, when considered in relation to the other matter comprising at least two of the subject marks and as used in connection with respondent's services, "Redskins" clearly both refers to respondent's professional football team and carries the allusion to Native Americans inherent in the original definition of that word." (*Pro-Football, Inc. v. Blackhorse*, WL 4096277, p. 23, 2015).

In answering the second question, whether the term "Redskins" "may disparage" Native Americans, courts should look to the views of Native Americans, not those of the general public. Moreover, *Blackhorse* was only required to show that the marks "may disparage" a "substantial composite" of Native Americans. As had been decided in *Harjo*, "A substantial composite is not necessarily a majority." (*In re Boulevard Ent., Inc.*, p. 1340, 2003, citing *In re McGinley*, p. 485, 1981); *In re Mavety Media Grp.*, p. 1370, 1994).

The District Court found that the meaning of the marks is one that "may disparage" a substantial composite of Native Americans in the context of the "Washington Redskins" football team. The relevant period for the disparagement inquiry is the time at which the

marks were registered—the time period between 1967 and 1990. The Court stated, perhaps wryly, “When reviewing whether a mark “may disparage,” the PTO does not, and practically cannot, conduct a poll to determine the views of the referenced group.” (*In re Loew’s Theatres, Inc.*, p. 768, 1985).

The District Court stated that three categories of evidence may be offered and given weight in order to determine whether a term “may disparage”: (1) dictionary definitions and accompanying editorial designations; (2) scholarly, literary, and media references; and (3) statements of individuals or group leaders of the referenced group regarding the term. (*Am. Freedom Def. Initiative v. Mass. Bay Transp. Auth.*, p. 585, 2015) (dictionaries); *In re Geller*, p. 1358, 2014) (dictionaries and news reports/articles); *In re Lebanese Arak Corp.*, 2010 (dictionary); *In re Heeb Media*, 2008) (dictionaries and individual and group sentiment); *In re Squaw Valley Dev. Co.*, 2006) (dictionaries, literary and media references, and individual and group statements)).

Perhaps most importantly, the District Court gave great weight to statements of individuals or group leaders. The Court noted that the record of evidence contained “statements of Native American individuals or leaders of Native American groups that weigh in favor of finding that the Redskins Marks consisted of matter that “may disparage” a substantial composite of Native Americans during the relevant time period.” The TTAB had considered statements from individuals in the referenced group and leaders of organizations within that referenced group when it makes its “may disparage” finding.

The District Court then found that the declarations from these prominent Native American individuals and leaders showed that the Redskins trademarks consisted of matter that “may disparage” a substantial composite of Native Americans during the relevant time period. The Court found that the Blackhorse defendants have shown by a preponderance of the evidence that there was no genuine issue of material fact as to the “may disparage” claim: the record evidence showed that the term “Redskin,” in the context of Native Americans and during the relevant time period, was offensive and one that “may disparage” a substantial composite of Native Americans, “no matter what the goods or services with which the mark is used.” The Court concluded that “Redskin” certainly retains this meaning when used in connection with PFI’s football team; a team that has always associated itself with Native American imagery, with nothing being more emblematic of this association than the use of a Native American profile on the helmets of each member of the football team.”

Accordingly, Judge Lee found that the Redskins marks consisted of matter that “may disparage” a substantial composite of Native Americans during the relevant time period, 1967-1990, and must be cancelled. The Court further found that the Redskins trademarks consisted of matter that brought Native Americans into “contempt or disrepute.” Thus, the Blackhorse defendants were entitled to summary judgment on their claim of entitlement to cancellation.

A Return to the Laches Argument

The final issues related once again to the question of whether the issue was foreclosed through the application of the doctrine of laches, which had resulted in the foreclosure of the complaint in *Harjo*. The laches defense, which PFI bears the burden of proving, requires evidence of “[a] lack of due diligence by the party against whom the defense is asserted, and prejudice to the party asserting the defense.” In *Nat’l R.R. Passenger Corp. v. Morgan* (pp.

121-22, 2002), the Supreme Court stated that “In a trademark case, courts may apply the doctrine of estoppel by laches to deny relief to a plaintiff who, though having knowledge of an infringement, has, to the detriment of the defendant, unreasonably delayed in seeking redress”—an argument reminiscent of that had previously been raised in *Harjo*.

In order to prevail in its laches defense, PFI was required to prove that, after turning age 18, each defendant unreasonably delayed in petitioning the TTAB to cancel the Redskins trademarks. In this case, each of the Blackhorse defendants was under the age of 18 in April 1999 when the TTAB granted the *Harjo* petition to cancel the Redskins Marks’ registrations. The *Harjo* proceedings in federal court concluded in 2009.

Because the Blackhorse defendants filed their petition with the TTAB in 2006, while the *Harjo* proceedings were pending, the Court found that they did not unreasonably or unjustifiably delay in petitioning the TTAB. The Court noted that “It was sensible for Blackhorse Defendants to see how the cancellation proceedings in the district court progressed.”

The Court also revisited the “public interest” exception and this time held that laches does not apply because of the public interest implicated in this matter. The District Court agreed with the TTAB’s finding that there “is an overriding public interest in removing from the register marks that are disparaging to a segment of the population beyond the individual petitioners.” The District Court found that the particular facts and circumstances of this case demonstrated that the application of laches should be barred because of the public’s interest in being “free from encountering registered marks that “may disparage.”” What a difference a few years (or shifting public opinion) can make! But was the issue resolved?

ON TO THE COURT OF APPEALS!

On October 30, 2015, Pro-Football, Inc. (Pro-Football/The Redskins) filed an appeal in the United States Circuit Court of Appeals for the Fourth Circuit. (No. 15-1874 (Appeal), 2015). Their main arguments may be summarized as follows:

Issues Relating to Proof

Pro-Football argued that there was no proof that a “substantial composite” of Native Americans in 1967 considered the name “Redskins” disparaging in the context of a football team. Pro-Football stated that while the conclusion that the term “Redskins” was disparaging might reflect opinions of dictionary editors, or a dictionary editor’s “best guess” about how the general public might feel about a word, “No evidence showed that any usage label reflected the views of any Native American.” (Appeal, p. 67, 2015). Further, no court has “considered dictionary labels dispositive of how any specific group might react to a term.” (Appeal, p. 68, 2015).

Pro-Football also noted that in support of its conclusion that the trademark was disparaging, the District Court had relied on a 1963 article stating that “[a]most all the students” at the Haskell Institute, a Native American vocational school, “resent being called redskins.” Pro-Football stated that “this kind of sourceless hearsay would have no probative value even if it referenced football, which it did not, and even if disputed facts could be resolved against the Redskins, which they cannot. The authors offered no explanation for their assertion.” (Appeal, p. 69, 2015).

With reference to statements of individuals or Tribal group leaders, Pro-Football noted that the District Court had relied on declarations specifically elicited for the purposes of the litigation from “four prominent Native Americans.” Pro-Football countered that “Their self-serving, present-day testimony does not reliably reflect the views of a substantial composite of Native Americans decades ago—and certainly not undisputedly so at summary judgment. Such historical recollections are invariably tainted by subsequent exposure and current views.” (Appeal, p. 70, 2015). Pro-Football asserted that the petitioners who were seeking to invalidate the trademarks presented “no evidence that [these statements] are a reasonable proxy for a substantial composite of the entire Native American population.” (Appeal, p. 70, 2015).

Pro-Football argued that the appellees had offered no “supplemental evidence” justifying a departure from the D.C. District Court’s decision in *Harjo*, which granted summary judgment to Pro-Football because, among other reasons, the evidence did not prove disparagement based on the views of a “substantial composite” of Native Americans. (Hopkins & Joraanstad, pp. 268, 277, 293, 2015).

Native Americans Have in fact Supported the Team’s Name

Pro-Football argued that the District Court had in fact *disregarded* extensive evidence that many Native Americans did *not* regard the term Redskins, in connection with sports, as disparaging in 1967 and thereafter. Most importantly, it was “undisputed” that the “six marks at issue were published and registered without opposition from Native Americans or anyone else on *twelve* different occasions.” (Appeal, p. 23, 2015, citing *Harjo*, p. 136 n.34, 2003 (District Court)). In support of their assertion, Pro-Football noted that “not a *single* Native American asked the PTO to refuse to register or cancel the marks as disparaging in 1967, 1974, 1978, or 1990 overwhelmingly shows that a ‘substantial composite’ of Native Americans did not consider them disparaging at those times.” (Appeal, p. 74, 2015).

Laches Bars the Petition

The question of the timing of the complaint was also central for Pro-Football. They argued that Appellees unreasonably delayed seeking cancellation, and that this delay had severely prejudiced the Redskins. Thus, the doctrine of laches bars their claims. (Appeal, p. 76, 2015, citing *Nat’l R.R. Passenger Corp. v. Morgan*, pp. 121-22, 2002); *Harjo*, p. 882, 2009 (Court of Appeals)). The Redskins noted that it was undisputed that (1) all petitioners (appellees) were “aware of the Redskins marks for many years before [their] eighteenth birthday,” and that (2) “nothing prevent[ed] them from filing the Petition immediately after turning eighteen.”

Pro-Football commented that the oldest petitioner had waited six years; the youngest petitioner, 11 months, 20 days. They added: “That was unreasonable.” (Appeal, p. 77, 2015, citing *Norris v. United States*, p. 80, 1921; *Tough Traveler, Ltd. v. Outbound Prods.*, p. 968, 1995).

A Return to the Serious Constitutional Issue

On a practical level, the legal counsel for the Redskins provided a list of the most *scandalous, immoral, and disparaging trademarks* that had been registered by the USPTO in the past. These included such “salacious” examples as the *SlutSeekers dating services* and *Dangerous*

Negro t-shirts, offered as part of what was described as a “calculated strategy to highlight the hypocrisy of allowing some offensive trademarks while refusing others.” (Roberts, 2015).

There was also a legal purpose involved in this strategy—besides pointing out the obvious double-standard (it may more properly be termed “political correctness” (Lee, 1997))—in arguing that Section 2(a) of the Lanham Act itself restricts speech in violation of the First Amendment, and is therefore unconstitutional. (Lee, 1997; Stout, 2015). What was the basis of this “constitutional assault”?

Section 2(a) of the Lanham Act (Trademark Act) (1946) includes a prohibition on the registration of marks that the Trademark Office deems “scandalous, immoral, or disparaging.” (Olaussen, 2014). Critics of the placing this responsibility on the USPTO have argued that the registration of a mark places an official *imprimatur* on the offensive mark or at least creates the appearance of official endorsement. In its simplest form, if an individual is a member of a group which claims to have suffered some harm by a particular term in a trademark (in this case, the words *Redskins* or *Redskinettes*), the harm is “theoretically multiplied when the mark is followed by a ®”— which provides evidence that “a government agency reviewed and approved the offensive mark and rewarded its owner with a shiny certificate.” (Roberts, 2015).

Roberts (2015), however, counters:

“The notion that all 2 million currently-registered marks are government speech is astounding,” the team claims. “No one today thinks registration reflects government approval. But if this Court holds that it does, how will the government explain registrations like MARIJUANA FOR SALE, CAPITALISM SUCKS DONKEY BALLS ... YID DISH, DIRTY WHOORE CLOTHING COMPANY and ... numerous confederate flag logos?”

In addition to providing a list of scandalous trademarks, Pro-Football cited a number of registered marks that contain clearly *disparaging terms*, including “negro,” “midget,” “retard,” “dago,” “heeb,” “dyke,” “white trash,” “fag,” “squaw,” and “injun.” Pro-Football also highlighted conflicting precedents in which some marks containing those terms were granted registration, while others were denied registration or where registration has been revoked.

From a legal standpoint, the tactics of the Redskins seemed clear: The Redskins listed the offensive marks “not for comparison, but as ammunition for its arguments about the law’s unconstitutionality.” (Roberts, 2015). By providing the Court of Appeals with clearly inconsistent applications of Section 2(a), the Redskins hoped to demonstrate that the prohibition on the use of its previously registered trademarks violates the First Amendment by discriminating based on “content and viewpoint” (Carroll, p. 868, 2006); that deregistration or cancellation of the marks would foster “arbitrary enforcement by providing only vague guidance to examining attorneys”; and such an action would provide wholly “inadequate notice to future applicants about the registrability of their own marks.” (Roberts, 2015).

The Constitutional Argument

The appellants also raised important constitutional questions in their appeal. Most importantly, they argued that Section 2(a) of the Lanham Act failed to provide the required *notice* to parties. The cited *Grayned v. City of Rockford* (pp. 108-109, 1972) in which the Supreme Court held that a statute fails to provide fair notice if they “delegate[] basic policy matters to [government officials] for resolution on an ad hoc and subjective basis,” or impose “a standard so indefinite that [lawmakers are] free to react to nothing more than their own preferences.” (*Smith v. Goguen*, p. 578, 1974). “Licensing regimes that confer “unbridled discretion” on government examiners thus are unconstitutionally vague.” (Appeal, p. 49, 2015, citing *City of Lakewood v. Plain Dealer Pub. Co.*, 1988).

The crux of Pro-Football’s argument is that the term “*may disparage*” is *subjective, indefinite, and discretionary*. Pro-Football cited the fact that the PTO itself had acknowledged this vagueness as early as 1939 when the Assistant Commissioner had informed Congress that “the 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 it is disparaging.” (Hearings on H.R. 4744 Before the Subcomm. on Trademarks of the H. Comm. on Patents, 1939). Later, in *In re In Over Our Heads* (1990), the PTO explained: “The guidelines for determining whether a mark is scandalous or disparaging are somewhat vague and the determination of whether a mark is scandalous or disparaging is necessarily a highly subjective one.” (McDavid, p. 577, 2009). Later, in *Harjo* (p. 35, 1999), the PTO noted that resolving a question whether a mark is or is not disparaging “is highly subjective and, thus, general rules are difficult to postulate.”

Appellants continued their constitutional attack and argued that Section 2(a) is vague apart from the word “disparage” because it leaves “grave uncertainty about how to estimate” the perceptions of the referenced group. (*Johnson v. United States*, p. 2557, 2015).

In addition, Pro-Football argued that Section 2(a) is *vague as applied*, because the “lengthy procedural history ... shows that the [Team] did not have fair notice of what was forbidden.” (*Bd. Of Trustees of the State of N.Y. v. Fox*, pp. 2317-2318, 1989). The PTO concluded *six times* from 1967 to 1990 that the Redskins marks were not disparaging, then abruptly reversed course. “The Redskins had no notice that the PTO would change its mind, but the PTO nonetheless applied its interpretation retroactively to revoke the registrations.” (Appeal, p. 53, 2015). The Redskins “had reason to suppose that [its trademark] would not violate the rule, yet [it] was [found in violation] nonetheless.” (Appeal, pp. 53-54, 2015).

A second argument revolved around the *arbitrary nature* of the PTO’s enforcement procedures. At its essence, the Redskins maintained that “Section 2(a) fosters arbitrary and discriminatory enforcement, driven by the subjective personal views of PTO officials.” (Appeal, p. 54, 2015). According to the PTO, prior registrations that are “similar to the applicant’s ... do[] not bind the [PTO].” (Citing *In re Heeb Media LLC*, p. 9, 2008). As a result, the Redskins argued that PTO decisions are arbitrary and unpredictable. They cited the following as examples of the arbitrary nature of the PTO’s enforcement actions: “The PTO concluded that BLACK TAIL for an adult entertainment magazine does not disparage African-American women (*Boswell v. Mavety Media Grp. Ltd.*, 1999); that JAP does not disparage Japanese Americans (*In re Condas S.A.*, 1975); and that MOONIES does not disparage the Unification Church” (*In re In Over our Heads*, 1990). PTO examiners also

registered OFF-WHITETRASH, DANGEROUS NEGRO, CELEBRETARDS, STINKYGRINGO, MIDGET-MAN, and YIDDISH, and LITTLEINDIANGIVER.

Pro-Football noted that the District Court had found that the PTO “sets forth sufficient guidelines” to defeat any claim of arbitrariness because it posted examiners’ decisions “on its website,” “published instructions” in its *Trademark Manual of Examining Procedure*, and had adopted a standard dictionary definition of “disparage.” The Redskins added, however, “But posting arbitrary and inconsistent decisions on the Internet informs the public only that the decisions are arbitrary and inconsistent.” (Appeal, p. 55, 2015).

The Redskins then made the point that the government’s delay violated its due process rights. For example, “[o]nce licenses are issued,” they “are not to be taken away without ... procedural due process.” (*Bell v. Burson*, p. 539, 1971). Where the law “engendered a clear expectation of continued enjoyment of a license,” the license-holder has “asserted a legitimate claim of entitlement ... that he may invoke at a hearing.” (*Barry v. Barchi*, p. 64 n.11, 1979).

The Redskins asserted that the massive delay between registration and cancellation deprived the Redskins of “[t]he fundamental requirement of due process”—“the opportunity to be heard ‘at a meaningful time and in a meaningful manner.’” (Appeal, p. 57, 2015, citing *Mathews v. Eldridge*, 1976).

Since the government “initially recognized and protected” the Redskins marks in 1967, it gave the Redskins a “legitimate claim of entitlement” and a “clear expectation of continued enjoyment.” Because the Lanham Act “protects” marks “indefinitely” (*McAirlaids, Inc. v. Kimberly-Clark Corp.*, p. 310, 2014), the government cannot “remove or significantly alter that protected status” (*Paul v. Davis*, pp. 710-11, 1976), without “procedural due process” (*Bell v. Burson*, p. 539, 1971).

The Redskins then raised an important *property interest*. Because the Lanham Act authorizes trademark-owners to sell or license their registered marks and to exclude others from infringing on them, trademark registration provides “the hallmarks of a protected property interest.” (Appeal, p. 57, 2015, citing *Coll. Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd.*, p. 673, 1999).

Finally, the Redskins asserted that in addition to the appellees unreasonably “sitting on their rights,” the delay between the registrations of the marks and the cancellation petition in 2006, itself *violated due process*. “That delay was 39 years for the 1967 mark, 32 years for the 1974 marks, 28 years for the 1978 marks, and 16 years for the 1990 mark.” (Appeal, p. 58, 2015). In order to determine whether an unreasonable delay violates the Fifth Amendment, courts weigh the “length of delay, the reason for the delay, the defendant’s assertion of his right, and prejudice to the defendant.” (*United States v. Eight Thousand Eight Hundred & Fifty Dollars (\$8,850) in U.S. Currency*, p. 564, 1983). The Redskins offered four arguments to bolster their contention:

First, the length of delay is “quite significant.” Second, no good reason justifies the delay. The Redskins noted that if the PTO thought the marks violated Section 2(a), it could have denied registration. Third, the Team has consistently argued that the delay violated its rights. Fourth, the delays are seriously prejudicial because they “hampered the [Team] in presenting a defense on the merits, through, for example, the loss of witnesses or other important

evidence.” For instance, the Redskins were not able to take contemporaneous surveys of Native American views in 1967, 1974, 1978, and 1990, which may have “provided the best evidence of the collective views of Native Americans, and it is impossible to overstate the significance of the lost opportunity.” (Appeal, p. 60, 2015).

In making this argument, Pro-Football was able to reel in a powerful yet unexpected ally—the American Civil Liberties Union—who came to the team’s defense. The ACLU argued that the U.S. Patent and Trademark Office (USPTO) had acted unconstitutionally when it stripped the team of the trademark protection. (Johnson, 2015).

Stated attorney Esha Bhandari (2015), who wrote on the organization’s site: “We don’t disagree with that judgment, but the government should not be able to decide what types of speech are forbidden — even when the speech in question reflects viewpoints we all agree are repellent.” The attorney added: “[V]iewpoint-based regulation of private speech is never acceptable.”

The ACLU pointed to *Texas v. Johnson* (1989), in which Justice Brennan, writing for the majority of the United States Supreme Court, stated: “the government may not prohibit the expression of an idea simply because society finds the idea itself offensive or disagreeable.”

The ACLU also cited to the Court’s decision in *United States v. Alvarez* (2012), a case concerning the constitutionality of the *Stolen Valor Act* (2005), which was a law criminalizing false claims about military-service medals. (Smolla, 2012/2013). In *Alvarez*, the Supreme Court in a 6-3 decision (with Justice Kennedy writing for a plurality of the Court) held that the *Stolen Valor Act* was unconstitutional because it was “inconsistent with the maintenance of a robust and uninhibited marketplace of ideas.” The ACLU argued that the same reasoning should apply in the case of the Washington Redskins, “especially so in the trademark context, where a literal marketplace allows members of the public to register protest through boycotts or other traditional First Amendment means.” (Cited in Volokh, 2015; Johnson, 2015).

THE SLANTS: WILL THIS CASE BE ULTIMATELY DISPOSITIVE IN THE REDSKINS CONTROVERSY?

The United States Court of Appeals for the Federal Circuit (Number 2014-1203, 2015), decided a case *en banc* on December 22, 2015 involving the refusal of the United States Patent and Trademark Office (PTO) to register a trademark **THE SLANTS** on the grounds that it was disparaging.

In order to determine if a mark was disparaging under Section 2(a) of the Lanham Act, the trademark examiner of the PTO was required to consider:

- (1) What is the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace in connection with the goods or services; and
- (2) If that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols, whether that meaning may be disparaging to a substantial composite of the referenced group. (Trademark Manual of Examination (TM Manual), 2015; *In re Geller*, p. 1358, 2014).

If the examiner “make[s] a prima facie showing that a substantial composite, although not necessarily a majority, of the referenced group would find the proposed mark, as used on or in connection with the relevant goods or services, to be disparaging in the context of contemporary attitudes,” the burden shifts to the party seeking registration for a suitable rebuttal. (TM Manual, 2015). If the applicant is unable to rebut the prima facie case of disparagement established by the trademark examiner, the examiner will refuse to register the mark. The Trademark Manual does not require an examiner who finds a mark disparaging to consult with a supervisor or take any steps to ensure that Section 2(a) is applied fairly and consistently across the PTO. Thus, a *single examiner*, with no input from a supervisor, can reject a mark by determining that registration of the trademark would or might be disparaging to a “substantial composite of the referenced group.”

Facts of This Case

Mr. Tam is the “front man” for an Asian-American dance-rock band, *The Slants*. Mr. Tam claimed that he had named his band *The Slants* to “reclaim” and “take ownership” of Asian stereotypes in order to combat these same stereotypes. Ironically, the band draws its inspiration for its lyrics from various childhood slurs and mocking nursery rhymes. Its albums include “The Yellow Album” and “Slanted Eyes, Slanted Hearts.” The band “feel[s] strongly that Asians should be proud of their cultural heritage, and not be offended by stereotypical descriptions.” With lyrics, live performances, and the name of the band itself, Mr. Tam and his band “weigh in on cultural and political discussions about race and society” which the Court of Appeals stated are “within the heartland of speech protected by the First Amendment.” (*In re Tam* (Court of Appeals), p. 11, 2015).

On November 14, 2011, Mr. Tam filed an application seeking to register the mark **THE SLANTS** for “Entertainment in the nature of live performances by a musical band,” based on his use of the mark since 2006. The examiner refused to register Tam’s mark, finding it likely disparaging to “persons of Asian descent” under Section 2(a). The examiner found that the mark likely referred to people of Asian descent in a disparaging way, stating that that the term “slants” had “a long history of being used to deride and mock a physical feature” of people of Asian descent. Even though Tam may have chosen the mark to “reappropriate the disparaging term,” the examiner nonetheless found that the *term itself* was disparaging because a composite of persons of Asian descent would find the term offensive. (This was Tam’s second application for the mark **THE SLANTS**. In 2010, Mr. Tam had filed App. No. 77/952,263 seeking to register the mark for “Entertainment, namely, live performances by a musical band.” It had been found to have been disparaging and the examiner had refused to register it. The Court noted that while Tam had initially appealed this decision to the Board, the case had been dismissed because Tam had failed to file a required brief in rebuttal.]

The Board affirmed the examiner’s refusal to register the mark. The Board wrote that “it is abundantly clear from the record not only that **THE SLANTS** . . . would have the ‘likely meaning’ of people of Asian descent but also that such meaning has been so perceived and has prompted significant responses by prospective attendees or hosts of the band’s performances.” (*In re Tam* (Court of Appeals), p. 12, 2015).

How did the Board reach this conclusion? In support of its finding that the mark likely referred to people of Asian descent, the Board pointed to dictionary definitions, the band’s website which displayed the mark next to “a depiction of an Asian woman, utilizing rising sun imagery and using a stylized dragon image” and a statement by Mr. Tam that he selected

the mark in order to “own” the stereotype it represents. (*In re Tam*, p. 5, 2013). The Board also found “that the mark is disparaging to a substantial component of people of Asian descent because “[t]he dictionary definitions, reference works and all other evidence unanimously categorize the word ‘slant,’ when meaning a person of Asian descent, as disparaging,” and because there was evidence in the record of individuals and groups in the Asian community objecting to Mr. Tam’s use of the word.” (*In re Tam* (Court of Appeals), p. 7, 2013). The Board therefore rejected the mark for registration under Section 2(a) of the Act.

Tam appealed to the United States Court of Appeals for the Federal Circuit and raised two arguments: *that the Board had erred in finding that the mark was disparaging, and that Section 2(a) itself was unconstitutional*. On appeal, a three-judge panel of the Court of Appeals (panel) affirmed the Board determination that the mark was disparaging. (*In re Tam* (Panel Op.), 2015).

Although the term “slants” has several meanings, the panel found substantial evidence to support the Board’s finding that the mark likely refers to people of Asian descent. The evidence included an article in which Tam had described the origin of the band’s name by explaining: “I was trying to think of things that people associate with

Asians. Obviously, one of the first things people say is that we have slanted eyes. . . .” (*In re Tam* (Panel Opinion), p. 570, 2015). In addition, the panel referred to the band’s *Wikipedia* page which stated that the band’s name is “derived from an ethnic slur for Asians.”

In relation to the requirement of a finding of disparagement, the panel also found that substantial evidence supported the Board’s finding that the mark is disparaging to a substantial composite of people of Asian descent. (*In re Tam* (Panel Op.), p. 571, 2015). The panel noted that the definitions in evidence had “universally characterized the word “slant” as disparaging, offensive, or an ethnic slur when used to refer to a person of Asian descent, including the dictionary definitions provided by Mr. Tam.” (*In re Tam* (Panel Op.), p. 571, 2015).

The panel also referred to a brochure published by the Japanese American Citizens League, which described the term “slant,” when used to refer to people of Asian descent, as a “derogatory term” that is “demeaning” and “cripple[s] the spirit.” Finally, the panel took note of the record which included news articles and blog posts discussing the offensive nature of the band’s name.

Having found that the mark was disparaging under Section 2(a), the panel held that binding precedent foreclosed Tam’s arguments that Section 2(a) was unconstitutional, in violation of the First Amendment. The panel explained that the refusal to register a mark under Section 2(a) does not bar the applicant from using the mark, and therefore does not implicate the First Amendment. (*In re McGinley*, p. 484, 1981). The Court had stated:

“With respect to appellant’s First Amendment rights, it is clear that the PTO’s refusal to register appellant’s mark does not affect his right to use it. No conduct is proscribed, and no tangible form of expression is suppressed. Consequently, appellant’s First Amendment rights would not be abridged by the refusal to register his mark.” (Citing *In re McGinley*, p. 484, 1981).

It should be recognized that *McGinley* had been widely criticized in a series of law review article and elsewhere. (E.g., *Richie v. Simpson*, 1999; Blankenship, 2001; Voskanyan, 2008). Recognizing that fact and prompted by the views expressed by the author of the Panel Opinion, the Circuit Court *sua sponte* ordered a rehearing *en banc* by the full Court of Appeals and asked the parties to file briefs on the following issues: *Does the bar on registration of disparaging marks in Section 2(a) of the Lanham Act violate the First Amendment to the United States Constitution?* (*In re Tam* (Court of Appeals), p. 17, 2015). Should the Court of Appeals (and any other subsequent decision by the United States Supreme Court) decide that Section 2(a) in fact violated the Constitution, this decision could have important—perhaps decisive—implications in the case of the Washington Redskins.

At the outset, the full Court would overrule *McGinley* in order to decide the constitutionality of the disparagement provision of Section 2(a) in its decision. However, it also held out the prospect that other exclusions of Section 2(a) relating to immoral or scandalous marks might also be considered in the future. (*In re Tam* (Court of Appeals), p. 8, 2015).

The *En Banc* Court of Appeal Decision

The first issue the Court discussed concerned the appropriate standard of review it would apply in the controversy. The Court affirmed that the *strict scrutiny* standard is used to review any governmental regulation that burdens private speech based on grounds of *disapproval of the message conveyed*. The Court concluded that Section 2(a) is such a regulation, and thus would be subject to strict scrutiny.

In support of this conclusion, the Court of Appeals cited several important case precedents. For example: “Content-based regulations are presumptively invalid.” (*R.A.V. v. City of St. Paul*, p. 382, 1992); “Content-based laws—those that target speech based on its communicative content—are presumptively unconstitutional and may be justified only if the government proves that they are narrowly tailored to serve compelling state interests.” (*Reed v. Town of Gilbert*, pp. 2226, 2015); “Above all else, the First Amendment means that the government has no power to restrict expression because of its message, its ideas, its subject matter, or its content.” (*Police Dep’t of Chicago v. Mosley*, p. 95, 1972).

The Court also noted that *viewpoint-based regulations*, targeting the substance of the viewpoint expressed, are even more suspect because such measures “raise the specter that the government may effectively drive certain ideas or viewpoints from the marketplace.” (*Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Bd.*, p. 116, 1991). The Court stated that “The First Amendment requires heightened scrutiny whenever the government creates ‘a regulation of speech because of disagreement with the message it conveys.’” (*Sorrell v. IMS Health, Inc.*, p. 2664, 2011).

The Court concluded that it was “beyond dispute” that Section 2(a) discriminates on the basis of content in the sense that it “applies to particular speech because of the topic discussed.” (*Reed v. Town of Gilbert*, p. 2227, 2015). Because Section 2(a) prevents the registration of disparaging marks, it cannot reasonably be argued that Section 2(a) is not a content-based restriction or that it is a content-neutral regulation of speech. The test for disparagement itself—*whether a substantial composite of the referenced group would find the mark disparaging*—makes it clear that it is the nature of the message conveyed by the speech which is being regulated. “If the mark is found disparaging by the referenced group, it is denied registration.” (*In re Tam* (Court of Appeals), p. 19, 2015). The Court cited

Forsyth Cty. v. Nationalist Movement (p. 134, 1992): “Listeners’ reaction to speech is not a content-neutral basis for regulation.”

Second, Section 2(a) is viewpoint discriminatory on its face. The PTO rejects marks under Section 2(a) when *it* finds the marks refer to a group in a *negative* way, but it permits the registration of marks that refer to a group in a *positive*, non-disparaging manner. The PTO has registered marks that refer positively to people of Asian descent such as **CELEBRASIANS**, **ASIAN EFFICIENCY**. Similarly, the PTO prohibited the registration of marks that it found had disparaged other groups—among them the cancellation of **REDSKINS**; rejection of **STOP THE ISLAMISATION OF AMERICA**; refusing to register **KHORAN** for wine; refusing to register **HEEB**; refusing to register **SQUAW VALLEY** for one class of goods, but registering it for another. The government also has registered marks that refer to particular ethnic groups or religions in *positive or neutral* ways—for example, **NAACP**, **THINK ISLAM**, **NEW MUSLIM COOL**, **MORMON SAVINGS**, **JEWISHSTAR**, and **PROUD 2 B**

CATHOLIC.

Thus, an applicant can register a mark if he or she demonstrates that the mark is perceived by the referenced group in a positive way, even if the mark contains identical or similar language that would be offensive in another context. For example, the PTO registered the mark **DYKES ON BIKES** after the applicant showed the term “Dyke” was often used with pride among the relevant population. In *Squaw Valley* (2006), the Board allowed the registration of the mark **SQUAW VALLEY** in connection with one of the applied for classes of goods (namely, skiing-related products), but not in connection with a different class of goods.

It is thus apparent that Section 2(a) does not treat identical marks in the same manner. “A mark that is viewed by a substantial composite of the referenced group as disparaging is rejected. It is thus the viewpoint of the message conveyed which causes the government to burden the speech. This form of regulation cannot reasonably be argued to be content neutral or viewpoint neutral.” (*In re Tam* (Court of Appeals), pp. 21-22, 2015). The Court of Appeals stated that the denial of registration under Section 2(a) turns on the referenced group’s *perception* of a mark.

“Speech that is offensive or hostile to a particular group conveys a distinct viewpoint from speech that carries a positive message about the group. **STOP THE ISLAMISATION OF AMERICA** and **THINK ISLAM** express two different viewpoints. Under § 2(a), one of these viewpoints garners the benefits of registration, and one does not. The government enacted § 2(a), and defends it today, because it is hostile to the messages conveyed by the refused marks. Section 2(a) is a viewpoint-discriminatory regulation of speech, created and applied in order to stifle the use of certain disfavored messages. Strict scrutiny therefore governs its First Amendment assessment—and no argument has been made that the measure survives such scrutiny.” (*In re Tam* (Court of Appeals), p. 23, 2015).

Is Trademark Registration “Government Speech,” Not Implicating the First Amendment?

It is a basic premise of constitutional law that “The Free Speech Clause [of the First Amendment] restricts government regulation of private speech; it does not regulate government speech.” (*Pleasant Grove City v. Summum*, p. 467, 2009). The Circuit Court carefully addressed whether the process of trademark registration somehow constituted “government speech,” thus exempting it from attack under the First Amendment. The Court concluded that there is no government speech at issue in the rejection of disparaging trademark registration “that would insulate § 2(a) from First Amendment review.” (*In re Tam* (Court of Appeals), pp. 38-39, 2015). The use of a mark by its owner is clearly private and not government speech. Trademarks identify the “source of a product, and are often closely associated with the actual product.” A mark’s purpose—to identify the source of goods—is actually *antithetical* to the notion that a trademark is somehow tied to the government.

Interestingly, in an effort to save Section 2(a) from invalidation under the First Amendment, the government argued that trademark registration and the incidents of the registration process—“such as the registrant’s right to attach the ® symbol to the registered mark, the mark’s placement on the Principal Register, and the issuance of a certificate of registration—amount to government speech.” (*In re Tam* (Court of Appeals), p. 39, 2015).

In rejecting this argument, the Court of Appeals stated that instead of “government speech,” trademark registration is clearly a regulatory activity. The incidents of the registration process do not convert the underlying speech to government speech.

The Court of Appeals cited the case of *Walker v. Texas Division, Sons of Confederate Veterans, Inc.* (2015) as an indication of government speech. In *Walker*, the United States Supreme Court concluded that *specialty license plates* were government speech, even though Texas state law allowed individuals, organizations, and nonprofit groups to request certain designs on their members’ license plates. The Supreme Court cited several considerations in deciding the issue.

The United States Supreme Court emphasized that “the history of license plates shows that, insofar as license plates have conveyed more than state names and vehicle identification numbers, they long have communicated messages from the States.” (*Walker v. Texas Division*, p. 2248, 2015). Why was this considered as “government speech”? “The State places the name ‘TEXAS’ in large letters at the top of every plate,” that “the State requires Texas vehicle owners to display license plates, and every Texas license plate is issued by the State,” that “Texas also owns the designs on its license plates,” and that “Texas dictates the manner in which drivers may dispose of unused plates.” (*Walker v. Texas Division*, p. 2248, 2015). As a result, the Supreme Court determined that “Texas license plate designs ‘are often closely identified in the public mind with the State.’” (*Walker v. Texas Division*, p. 2248, 2015, quoting *Summum*, p. 472, 2009). In addition, “Texas maintains direct control over the messages conveyed on its specialty plates.... Indeed, a person who displays a message on a Texas license plate likely intends to convey to the public that the State has endorsed that message.” (*Walker v. Texas Division*, p. 2249, 2015).

In sum, the Court of Appeals stated:

“When the government registers a trademark, the only message it conveys is that a mark is registered. The vast array of private trademarks are not created by the government, owned or monopolized by the government, sized and

formatted by the government, immediately understood as performing any government function (like unique, visible vehicle identification), aligned with the government, or (putting aside any specific government-secured trademarks) used as a platform for government speech. There is simply no meaningful basis for finding that consumers associate registered private trademarks with the government. Indeed, the PTO routinely registers marks that no one can say the government endorses.” (*In re Tam* (Court of Appeals), pp. 40-41, 2015).

As such, the public is unlikely to believe that the registration of a trademark on a product reflects any government endorsement. “Trademarks are understood in society to identify the source of the goods sold, and to the extent that they convey an expressive message, that message is associated with the private party that supplies the goods or services.” (*In re Tam* (Court of Appeals), p. 42, 2015).

Is Trademark Registration a Form of Government Subsidy Exempt from Strict Scrutiny?

As a final attempt to save Section 2(a) from constitutional attack, the government argued that trademark registration is a form of a *government subsidy* that the government may refuse where it *disapproves of the message a mark conveys*. “When the Government appropriates public funds to establish a program it is entitled to define the limits of that program.” (*United States v. Am. Library Ass’n*, p. 211, 2003). The government contended that “Congress has at least as much discretion to determine which terms and symbols should be registered and published by a federal agency as it would to determine which private entities should receive federal funds.” (*In re Tam* (Court of Appeals), p. 45, 2015). In addition, this includes “the authority to impose limits on the use of such funds to ensure they are used in the manner Congress intends”—even when these limitations exclude protected speech or other constitutionally protected conduct. (*Agency for Int’l Dev. v. Alliance for Open Soc’y Int’l, Inc.*, p. 2328, 2013).

Once again, the Court of Appeals rejected the government’s argument. The Court stated that trademark registration is *not* a program through which the government is seeking to “get its message out” through recipients of federal funding (direct or indirect). As a result, trademark registration does not implicate Congress’s power to spend or to control the use of government property. Simply stated, trademark registration is not a government subsidy.

TENTATIVE CONCLUSION AND COMMENTARY

Although the Court of Appeals found the disparagement provision of Section 2(a) unconstitutional, it also stated that:

“nothing we say should be viewed as an endorsement of the mark at issue. We recognize that invalidating this provision may lead to the wider registration of marks that offend vulnerable communities. Even Mr. Tam, who seeks to reappropriate the term “slants,” may offend members of his community with his use of the mark. But much the same can be (and has been) said of many decisions upholding First Amendment protection of speech that is hurtful or worse. Whatever our personal feelings about the mark at issue here, or other disparaging marks, the First Amendment forbids government regulators to

deny registration because they find the speech likely to offend others. Even when speech “inflict[s] great pain,” our Constitution protects it “to ensure that we do not stifle public debate.”” (*In re Tam* (Court of Appeals), p. 61, 2015).

The Court of Appeals held that the disparagement provision of Section 2(a) was unconstitutional because it violates the First Amendment. The Court of Appeals vacated the Board’s holding that Mr. Tam’s mark is unregistrable, and remanded the case to the Board for further proceedings.

At its core, the controlling principle enunciated by the Court of Appeals appears to be very clear: “The government cannot refuse to register disparaging marks because it disapproves of the expressive messages conveyed by the marks. It cannot refuse to register marks because it concludes that such marks will be disparaging to others.” (*In re Tam* (Court of Appeals), p. 4, 2015). In addition, the Court of Appeals found that the strict scrutiny standard of review was appropriate in holding that the disparagement proscription of Section 2(a) was unconstitutional because it amounts to viewpoint discrimination. Importantly, it also held out the prospect that other exclusions of immoral or scandalous marks may be unconstitutional as well. The Court of Appeals further determined that since the government had offered no legitimate interest justifying the disparagement proscription in Section 2(a), Section 2(a) would be unconstitutional as well under the intermediate scrutiny standard traditionally applied to government regulation of the commercial aspects of speech. (*In re Tam* (Court of Appeals), p. 4, 2015).

Would the decision by the Court of Appeals in *Tam* implicate the Board’s cancellation of the Washington Redskins Trademark? It appears that the holding in *Tam* may in fact contain an implication that will be dispositive and might compel the PTO to abandon its efforts at cancellation of the Washington Redskins’ trademark.

No matter what the decision of the Court of Appeals in *Tam*, would the matter reach the United States Supreme Court and/or would the PTO literally “see the handwriting on the wall”? The resolution of these question, and others, will no doubt result in more controversy and a renewed debate about the purposes of trademark registration in light of changing community mores and values. However, there is also the chance that the United States Supreme Court may have an entirely different view of the issue and may decide to review the decision of the Court of Appeals!

REFERENCES

- Agency for Int’l Dev. v. Alliance for Open Society Int’l, Inc., 133 S. Ct. 2321 (2013).
Am. Freedom Def. Initiative v. Mass. Bay Transp. Auth., 781 F.3d 571 (1st Cir. 2015).
Anten, Todd. (2006). “Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act.” *Columbia Law Review*, Vol. 106, pp. 388-434.
B & B Hardware, Inc. v. Hargis Indus., 135 S. Ct. 1293 (2015).
Barry v. Barchi, 443 U.S. 55 (1979).
Bd. of Trustees of the State Univ. of N.Y. v. Fox, 492 U.S. 469 (1989).

- Behrendt, Kristin E. (2000). "Cancellation of the Washington Redskins' Federal Trademark Registrations: Should Sports Team Names Mascots and Logos Contain Native American Symbolism?" *Seton Hall Journal of Sports Law*, Vol. 10, pp. 389-414.
- Bell v. Burson, 402 U.S. 535 (1971).
- Berkeley Technology Law Journal. (2005). "Pro-Football, Inc. v. Harjo." *Berkeley Technology Law Journal*, Vol. 20:1, Article 1: pp. 739 et seq., at <http://scholarship.law.berkeley.edu/btlj/vol20/iss1/70>.
- Bhandari, Esha. (2015). "The Government Doesn't Get to Play Language Police—Even When it Comes to the Washington Redskins," March 6, at <https://www.acluva.org/16845>.
- Blackhorse v. Pro-Football, Inc., 111 U.S.P.Q.2d 1080, 2014 WL 2757516 (T.T.A.B. 2014).
- Blackhorse v. United States, No. 15-1874 (4th Cir. October 30, 2015) (Appeal).
- Blankenship, Justin G. (2001). "The Cancellation of Redskins as a Disparaging Trademark: Is Federal trademark Law an Appropriate Solution for Words that Offend?" *University of Colorado Law Review*, Vol. 72, pp. 415-457.
- Bonadio, Enrico. (2015). "Brands, Morality and Public Policy: Some Reflections on the Ban on Registration of Controversial Trademarks." *Marquette Intellectual Property Law Review*, Vol. 19, pp. 39-61.
- Boston Red Sox Baseball Club Ltd. Partnership v. Sherman, 88 U.S.P.Q.2d 1581 (2008).
- Boswell v. Mavety Media Grp. Ltd., 1999 WL 1040108 (TTAB 1999).
- Botnick, Ian. (2008). "Honoring Trademarks: The Battle to Preserve Native American Imagery in the National Collegiate Athletic Association." *John Marshall Review of Intellectual Property Law*, Vol. 7, pp. 735-753.
- Bridgestone/Firestone Research, Inc. v. Auto. Club de L'Ouest de la France, 245 F.3d 1359 (Fed. Cir. 2001).
- Carroll, Michael W. (2006). "A Review of Recent Decisions of the United States Court of Appeals for the Federal Circuit: Article: One for All: The Problem of Uniformity Cost in Intellectual Property Law." *American University Law Review*, Vol. 55, pp. 845-900.
- City of Lakewood v. Plain Dealer Pub. Co., 486 U.S. 750 (1988).
- Coll. Sav. Bank v. Florida Prepaid Postsecondary Educ. Expense Bd., 527 U.S. 666 (1999).
- de Vogue, Ariane. (2015). "Supreme Court: Texas OK to reject Confederate Flag Plate." *CNN Supreme Court Reporter*, June 18, at <http://www.cnn.com/2015/18/politics/confederate-flag-license-plate-scotus>.
- Durox Co. v. Duron Paint Mfg. Co., 320 F.2d 882 (4th Cir. 1963).
- Emergency One, Inc. v. Am. Fire Eagle Engine Co., 332 F.3d 264 (4th Cir. 2003).
- Epstein, Adam. (2-13). "Maryland Sports Law." *University of Denver Sports & Entertainment Law Journal*, Vol. 15, pp. 49-72.
- Fabio, Michelle. (2011). "SCANDAL! Trademark Rejection for Disparaging, Immoral, or Scandalous Matter." *Legal Zoom*, June 11, at <https://www.legalzoom.com/articles/scandal-trademark-rejection-for-disparaging-immoral-or-scandalous-matter>
- Forsyth Cty. v. Nationalist Movement, 505 U.S. 123 (1992).
- Grayned v. City of Rockford, 408 U.S. 104 (1972).
- Hanover Star Milling Co. v. Metcalf, 240 U.S. 403 (1916).
- Harjo v. Pro-Football, Inc, 50 U.S.P.Q.2d (BNA) 1705 (1999).
- Hearings on H.R. 4744 Before the Subcommittee on Trademarks of the House Committee on Patents. (1939).

- Hiaring, Anne. (2006). "Basic Principles of Trademark Law," in *Understanding Basic Trademark Law*, 2006 (PLI Patents, Copyrights, Trademarks, & Literary Prop., Course Handbook Series No. 9024).
- Ho, Catherine. (2012). "Legal Battle over Redskins' Name Continues." *The Washington Post*, September 6, at http://www.washingtonpost.com/blogs/capital-business/post/legal-battle-over-redskins-name-continues_blog.html.
- Hopkins, Julie A. & Thomas M. Joraanstad. (2015). "Challenge Flag Thrown: The Trademark Trial and Appeal Board's Cancellation of the Redskins' Trademark and Pro-Football's Chances on Appeal." *Journal of Business and Technology Law*, Vol. 10, pp. 267-296.
- In re Boulevard Ent., Inc., 334 F.3d 1336 (Fed. Cir. 2003).
- In re Condas S.A., 1975 WL 20869 (TTAB 1975).
- In re Geller, 751 F.3d 1355 (Fed. Cir. 2014).
- In re Heeb Media LLC, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008).
- In re In Over Our Heads, 1990 WL 354546 (TTAB 1990).
- In re Lebanese Arak Corporation, 94 U.S.P.Q.2d 1215 (T.T.A.B. 2010).
- In re Loew's Theatres, Inc., 769 F.2d 764 (Fed. Cir. 1985).
- In re Mavety Media Grp., 33 F.3d 1367 (Fed. Cir. 1994).
- In re McGinley, 660 F.2d 481 (C.C.P.A. 1981).
- In re Simon Shiao Tam, Appeal from the United States Patent and Trademark Office, Trademark Trial and Appeal Board in No. 85/472,044 (Court of Appeals) (Fed. Cir. 2015).
- In re Squaw Valley Development Company, 80 U.S.P.Q.2d 1264 (T.T.A.B. 2006).
- In re Tam, 2013 WL 5498164 (Board Opinion) (T.T.A.B. 2013).
- In re Tam, 785 F.3d 567 (Panel Opinion) (Fed. Cir. 2015).
- In re Trade-Mark Cases, 100 U.S. 82 (1879).
- Incontestable. (2008). "Boston Red Sox Baseball Club Ltd. Partnership v. Sherman," October, at http://www.finnegan.com/files/upload/Incontestable_Oct08_6.html.
- Incontestable. (2009). "In re Heeb Media, LLC," January, at https://www.finnegan.com/files/upload/Incontestable_Jan07-7.html.
- Johanns v. Livestock Mktg. Assn., 544 U.S. 550 (2005).
- Johnson v. United States, 135 S. Ct. 2551 (2015).
- Kiser, Jessica M. (2011). "How Dykes on Bikes Got It Right: Procedural Inequities Inherent in the Trademark Office's Reviews of Disparaging Trademarks." *University of San Francisco Law Review*, Vol. 46, pp. 1-36.
- La Societe Anonyme des Parfums le Galion v. Jean Patou, Inc., 495 F.2d 1265 (2d Cir 1974).
- Lanham (Trademark) Act. (1946). Pub.L. 79-489, 60 Stat. 427, enacted July 5, 1946, codified at 15 U.S.C. §§ 1051-1127.
- Latterell, Steven R. (2005). "Stopping the "Savage Indian" Myth: Dealing with the Doctrine of Laches in Lanham Act Claims of Disparagement." *Indiana Law Journal*, Vol. 80, pp. 1141-1166.
- Lee, Michelle B. (1997). "Section 2(a) of the Lanham Act as a Restriction on Sports Team Names: Has Political Correctness Gone Too Far?" *Sports Law Journal*, Vol. 4, pp. 65-80.
- Marklaw.com. (2015). "Grounds for Cancellation," at http://marklaw.com/index.php?option=com_content&view=article&id=135:grounds-for-cancellation.

- Marlan, Dustin. (2013). "Trademark Takings: Trademarks as Constitutional Property Under the Fifth Amendment Takings Clause." *University of Pennsylvania Journal of Constitutional Law*, Vol. 15, pp. 1581-1629.
- Mathews v. Eldridge, 424 U.S. 319 (1976).
- McAirlaids, Inc. v. Kimberly-Clark Corp., 756 F.3d 307 (4th Cir. 2014).
- McDavid, Christopher Thomas. (2009). "I Know It When I See It: Obscenity, Copyright, and the Cautionary Tale of the Lanham Act." *University of Louisville Law Review*, Vol. 47, pp. 561-583.
- Motolenich-Salas, Ken. (2014). "The Four Quarters of the Redskins Trademark Cancellations: The Revival of the Disparagement Doctrine." *Arizona Attorney*, Vol. 51, pp. 20-24.
- Nat'l R.R. Passenger Corp. v. Morgan, 536 U.S. 101 (2002).
- Norris v. United States, 257 U.S. 77 (1921).
- Norton, Helen. (2008). "The Measure of Government Speech: Identifying Expression's Source." *Boston University Law Review*, Vol. 88, pp. 587-632.
- Olaussen, Brooke. (2014). "The Trademark Holi Wars and the Case for Protecting Religious and Cultural Symbols and Names from Commercial Exploitation." *Journal of Patent and Trademark Office Society*, Vol. 96, pp. 298-315.
- Order Sons of Italy in America v. The Memphis Mafia Inc., 52 U.S.P.Q.2d 1264 (T.T.A.B. 1999).
- Paczkowski, Lynette. (2004). "The Best Offense is a Good Defense: How the Washington Redskins Overcame Challenges to their Registered Trademarks." *Boston College Intellectual Property & Technology Forum* (60803), pp. 1-46.
- Paul v. Davis, 424 U.S. 693 (1976).
- Pleasant Grove City, Utah v. Summum, 555 U.S. 460 (2009).
- Police Dep't of Chicago v. Mosley, 408 U.S. (1972).
- Pro-Football, Inc. v. Blackhorse, 2015 U.S. Dist. LEXIS 90091 (2015).
- Pro-Football, Inc. v. Blackhorse, 2015 WL 4096277 (2015).
- Pro-Football, Inc. v. Blackhorse, 62 F. Supp.3d 498 (E.D. Va. 1014 (2014), 113 U.S.P.Q.2d (BNA) 1749.
- Pro-Football, Inc. v. Harjo, 284 F. Supp.2d 96 (District Court District of Columbia 2003).
- Pro-Football, Inc. v. Harjo, 415 F.3d 44 (D.C. Cir. 2005).
- Pro-Football, Inc. v. Harjo, 565 F.3d 880 (D.C. Cir. 2009).
- Pro-Football, Inc. v. Harjo, 567 F. Supp. 2d 46 (District Court District of Columbia 2008).
- R.A.V. v. City of St. Paul, 505 U.S. 377 (1992).
- Reed v. Town of Gilbert, 135 S. Ct. 2218 (1015).
- Ritchie v. Simpson, 170 F.3d 1092 (Fed. Cir. 1999).
- Roberts, Alexandra J. (2015). "The Redskins' Latest Legal Defense is Surprisingly Clever," *Fortune*, November 4, at <http://fortune.com/2015/11/04/redskins-latest-legal-defense-clever/>.
- Shipley, David E. (2009-2010). "A Dangerous Undertaking Indeed: Juvenile Humor, Raunchy Jokes, Obscene Materials and Bad Taste in Copyright." *Kentucky Law Journal*, Vol. 98, pp. 517-572.
- Simon & Schuster, Inc. v. Members of N.Y. State Crime Victims Board, 502 U.S. 105 (1991).
- Smith v. Goguen, 415 U.S. 566 (1974).
- Smolla, Rodney A. (2012/2013). "Categories: Tiers of Review, and the Rolling Sea of Free Speech Doctrine and Principle: A Methodological Critique of United States v. Alvarez." *Albany Law Review*, Vol. 75, pp. 499-526.

- Sorrell v. IMS Health Inc., 131 S. Ct. 2653 (2011).
- Stolen Valor Act. (2005). 18 U.S.C. § 704.
- Stout, Kristian D. (2015). "Terrifying Trademarks and a Scandalous Disregard for the First Amendment: Section 2(a)'s Unconstitutional Prohibition on Scandalous, Immoral, and Disparaging Trademarks." *Albany Law Journal of Science and Technology*, Vol. 25, pp. 213-255.
- Swatch AG v. Beehive Wholesale, LLC, 739 F.3d 150 (4th Cir. 2014).
- Texas v. Johnson, 491 U.S. 397 (1989).
- Tough Traveler, Ltd. v. Outbound Prods., 60 F.3d 964 (2d Cir. 1995).
- Trademark Manual of Examining Procedures (Trademark Manual). (Jan. 2016 ed).
- Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992).
- United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90 (1918).
- United States v. Am. Library Ass'n, 539 U.S. 194 (2003).
- United States v. Eight Thousand Eight Hundred & Fifty Dollars (\$8,850) in U.S. Currency, 461 U.S. 555 (1983).
- University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., 213 USPQ 594 (TTAB 1982), aff'd 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).
- Volokh, Eugene. (2015). "ACLU Argues that Cancellation of Redskins Trademark Violates the First Amendment." *Washington Post* (on line), March 6, at <https://www.washingtonpost.com/news/volokh-conspiracy/wp/2015/03/06>.
- Voskanyan, Lilit. (2008). "The Trademark Principal Register as a Nonpublic Forum," *University of Chicago Law Review*, Vol. 75, pp. 1295-1328.
- Walker v. Tex. Div., Sons of Confederate Veterans, Inc., 135 S. Ct. 2239 (2015) (Alito, J., dissenting).
- Wallace, John R. (2011). "Discriminatory & Disparaging Team Names, Logos, & Mascots: Workable Challenges & the Misapplication of the Doctrine of Laches." *Rutgers Race & Law Review*, Vol. 12, pp. 203-242.
- WIPO. (2015). "International Classifications," at www.wipo.int/classifications/nice/en/pdf/8_list_class_order.pdf.
- Wright, Robert H. (2005). "Today's Scandal Can be Tomorrow's Vogue: Why Section 2(a) of the Lanham Act is Unconstitutionally Void for Vagueness." *Howard Law Journal*, Vol. 48, pp. 659-684.

APPENDIX I

GROUNDS FOR CANCELLATION

- (1) Section 2(d) of the Act, 15 U.S.C. §1052(d): That defendant's mark so resembles a mark registered in the Office, or a mark or trade name previously used in the United States by another and not abandoned, as to be likely, when used on or in connection with the goods or services of the defendant, to cause confusion [likelihood of confusion], or to cause mistake, or to deceive.
- (2) The grounds specified in Section 2(e) of the Act, 15 U.S.C. §1052(e); for example, that defendant's mark, when used on or in connection with the goods or services of the defendant, is merely descriptive or deceptively misdescriptive of them, or that defendant's mark is primarily geographically descriptive or primarily geographically deceptively misdescriptive of them; and that defendant's mark is primarily merely a surname, or that defendant's mark comprises any matter that, as a whole, is de jure functional; or if not de jure functional, that the product design has not acquired distinctiveness.
- (3) The grounds specified in Section 2(a) of the Act, 15 U.S.C. §1052(a); for example, that defendant's mark is geographically deceptive, that defendant's mark disparages members of a particular group, that defendant's mark consists of or comprises scandalous matter, or that defendant's mark falsely suggests a connection with plaintiff's name or identity or that defendant's mark is a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and was first used on or in connection with wines or spirits by the applicant on or after January 1, 1996.

APPENDIX II

STEPS IN A CANCELLATION PROCEEDING

(<http://petitiontocancel.com/whathappensafterpetitiontocancel.html>)

1. Petition to Cancel is filed by Plaintiff (see Appendix III for the Suggested Format for Cancellation of a Registered Trademark)
2. Defendant (registrant) Answers within 40 days
3. Discovery Conference between parties (the parties are required to conference in person, by telephone, or by any other means on which they may agree)
4. Discovery Opens
5. Initial Disclosures Due
6. Expert Disclosures Due
7. Discovery Closes

- 8. Plaintiff's Pretrial Disclosures
- 9. Plaintiff's 30-day Trial Period-Brief on the Merits submitted
- 10. Defendant's Pretrial Disclosures
- 11. Defendant's 30-day Trial Period-Rebuttal on Brief on the Merits submitted
- 12. Plaintiff's Rebuttal Disclosures
- 13. Plaintiff's 15-day Rebuttal Period
- 14. Board's Decision

APPENDIX III

SUGGESTED FORMAT FOR PETITION TO CANCEL A REGISTERED TRADEMARK

(Found at <http://www.uspto.gov/web/forms/newform.pdf>)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of trademark registration No.....

For the mark.....

Date Registered

(Name of petitioner)

v.

(Name of registrant)

PETITION TO CANCEL

State petitioner's name, address, and entity information as follows:

(1)

(Name of individual as petitioner, and business trade name, if any;

_____Business address)_____

OR (Name of partnership as petitioner; Names of partners;

_____Business address of partnership)_____

OR (Name of corporation as petitioner; State or country of incorporation;

_____Business address of corporation)_____

The above-identified petitioner believes that it/he/she will be damaged by the above-identified registration, and hereby petitions to cancel the same.(2)

The grounds for cancellation are as follows:

[Please set forth, in separately numbered paragraphs,

the allegations of petitioner's standing and grounds for cancellation.](3)

By _____(Signature)(4)_____ Date_____

(Identification of person signing)(5)

FOOTNOTES:

(1) If petitioner is an individual, state the petitioner's name, business trade name, if any, and business address. If petitioner is a partnership, state the name of the partnership, the names of the partners, and the business address of the partnership. If petitioner is a corporation, state the name of the corporation, the state (or country, if petitioner is a foreign corporation) of incorporation, and the business address of the corporation. If petitioner is an association or other similar type of juristic entity, state the information required for a corporation, changing the term "corporation" throughout to an appropriate designation.

(2) The required fee must be submitted for each party joined as petitioner for each class opposed, and if fewer than the total number of classes in the application are opposed, the classes opposed should be specified.

(3) Set forth a short and plain statement here showing why the petitioner believes it/he/she damaged by the registration, and state the grounds for cancellation. Each

numbered paragraph should be limited, as far as practicable, to a statement of a single set of circumstances. See Rules 8(a) and 10(b) of the Federal Rules of Civil Procedure.

(4) The petition need not be verified, and may be signed by the petitioner or by the

petitioner's attorney or other authorized representative. If a petitioner signing for itself is a partnership, the signature must be made by a partner; if a petitioner signing for itself is a corporation or similar juristic entity, the signature must be made by an officer of the corporation or other juristic entity who has authority to sign for the entity and whose title is given.

(5) State the capacity in which the signing individual signs, e.g., attorney for petitioner, petitioner (if petitioner is an individual), partner of petitioner (if petitioner is a partnership), officer of petitioner identified by title (if petitioner is a corporation), etc.

REPRESENTATION INFORMATION:

If the petitioner is not domiciled in the United States, and is not represented by an attorney or other authorized representative located in the United States, a domestic representative must be designated.

If the petitioner wishes to furnish a power of attorney, it may do so, but an attorney at law is not required to furnish a power.