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### BY DAVID R. ELLIS, ATTORNEY AT LAW, LARGO, FLORIDA

Both before and during the current football season, we have seen increasing controversy over the propriety of professional and college sports teams using Native

American names and symbols for their team nicknames and mascots. Recently, in one of the ongoing disputes that has reached the legal arena, a federal appeals court in Washington, D.C. ruled against the Washington Redskins in a case seeking to cancel the team's federal trademark registrations as disparaging to Native Americans. Pro-Football, Inc. v. Harjo, No. 03-7162 (D.C. Cir. July 15, 2005).

The Court of Appeals for the D.C. Circuit reversed and remanded a decision of the district court in a case brought by seven Native Americans attempting to cancel seven of the Redskins' federal trademark registrations. The district court had held that the team trademarks of the Redskins were improperly cancelled by the Trademark Trial and Appeal Board (TTAB) of the U.S. Patent and Trademark Office (PTO), and had granted summary judgment to the Redskins. The court's ruling was based on two alternative grounds - that there was no substantial evidence to support the conclusion that the term was disparaging to Native Americans, and that the cancellation petition was barred by laches based on the substantial delay of twenty-five years in bringing the petition, resulting in prejudice to the Redskins.

The Redskins began their existence as a National Football League franchise in 1932 as the Boston Braves, taking their name from the major league baseball team with whom they shared a stadium. After their first season, the football team changed its name to the Redskins, and in 1937, they moved to Washington, where they won a championship. The baseball Braves eventually moved to Milwaukee and later Atlanta where they play today.

The Redskins registered their team name and logos with the United States Patent and Trademark Office (PTO) over a period from 1967 to 1990. They have maintained their politically incorrect name throughout, even in the face of criticism from many, including Native Americans. These critics have been successful over the past several years in persuading many colleges to change their ethnic nicknames to less offensive ones, and have convinced the National Collegiate Athletic Association (NCAA) to issue rulings against the use of names with Native American names and imagery.

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After years of trying to convince the Redskins to change their name, seven Native Americans petitioned the TTAB in 1992 to cancel the Redskins' registrations on the grounds that the use of the word "redskins" is "scandalous," "may . . . disparage" Native Americans, and may cast Native Americans into "contempt, or disrepute" in violation of §2(a) of the U.S. Trademark (Lanham) Act. In 1999, the TTAB agreed and cancelled the registrations. The team's owner, Pro-Football, Inc., then sued the petitioners in federal district court for review of the TTAB's order.

The U.S. Trademark (Lanham) Act provides a number of grounds for cancellation of a trademark and permits persons to file a petition with the TTAB to cancel a registration. Under §14 of the Act, a petitioner must allege that he or she will be damaged by continuing registration of a mark, including that the mark "consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute ...."

The district court reversed the TTAB on two alternate grounds. One was that the TTAB's cancellation decision was incorrect because there was no substantial evidence to support the conclusion that the team nickname was disparaging to Native Americans. The other was that the TTAB should have found the Native Americans' petition barred by laches because they had delayed for twenty-five years in bringing their cancellation petition, and the team would be prejudiced by the delay. 284 F. Supp. 2d 96 (D.D.C. 2003). (For more on the district court opinion, see my article, Seeing Red: Native Americans Try - But Fail - To Cancel The Washington Redskins' Trademark Registrations, http://easl.info/modules/Static\_Docs/data/20040101%20David%20Ellis%20Redskins%20Article.htm.)

On appeal, the court of appeals agreed with the Native Americans that the district court mistakenly applied the doctrine of laches to one of the petitioners, Mateo Romero, who was only one-year old in 1967 when the district court started the clock for laches. The court explained that laches is an equitable doctrine "founded on the notion that equity aids the vigilant and not those who slumber on their rights." It ruled that, as to Romero, the district court's approach ran afoul of the "well-established principle of equity that laches runs only from the time a party has reached his majority."

The appeals court acknowledged the Redskins' argument that in theory, trademark owners could never have certainty about the continuing validity of their trademarks, since a disparagement claim could be brought by an as yet unborn claimant for an unlimited time after a mark is registered. However, the court said, even if registrations of some marks would remain perpetually at risk, that would not change the fact that one of equity's fundamental principles is that laches attaches only to parties who have unjustifiably delayed in bringing suit. Since Romero brought his own claim, there was no reason why the laches of the other petitioners should be imputed to him. Thus, the district court should have measured both his delay and the resulting prejudice to the Redskins based on the period between his attainment of majority and the filing of the cancellation petition in 1992.

The court remanded the case to the district court to assess the possible prejudice to the Redskins, both trial and economic prejudice. As to trial prejudice, the district court was directed to consider the extent to which Romero's post-majority delay resulted in a "loss of evidence or witnesses supporting the Redskins' position.

As to economic prejudice, the court noted that what was at stake is not the right of the trademark owner (the Redskins) to use its trademarks but rather its right to Lanham Act protections that turn on federal registration. The court said: "We encourage the district court to take briefing on whether economic prejudice should be measured based on the owner's investment in the marks during the relevant years, on whether the owner would have taken a different course of action — e.g., abandoned the marks — had the petitioner acted more diligently in seeking cancellation, or on some other measure"

The case will thus continue in overtime before the district court.

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