

ORAL ARGUMENT SCHEDULED FOR NOVEMBER 5, 2004

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IN THE UNITED STATES COURT OF APPEALS FOR THE  
DISTRICT OF COLUMBIA CIRCUIT

UNITED STATES COURT OF APPEALS FOR DISTRICT OF COLUMBIA CIRCUIT	
JUL 27 2004	NO. 03-7162
RECEIVED	

SUZAN S. HARJO, ET AL.,  
Appellants

v.

PRO FOOTBALL, INC.,  
Appellee

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ON APPEAL FROM  
THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF COLUMBIA

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BRIEF FOR APPELLANTS

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July 27, 2004

CERTIFICATE AS TO PARTIES, RULINGS AND RELATED CASES

Pursuant to Circuit Rule 28(a)(1), Appellants, Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr., hereby certify:

A. Parties and Amici before the District Court and this Court. Parties currently before this Court and previously before the District Court are Defendants-Appellants Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr. and Plaintiff-Appellee Pro-Football, Inc. Amici InterFaith Conference of Metropolitan Washington, National Congress of American Indians, National Indian Education Association, National Indian Youth Council and Tulsa Indian Coalition Against Racism were granted leave to participate by this Court's Order on April 7, 2004.

B. Rulings Under Review. The final judgment under review is *Pro-Football, Inc. v. Harjo*, 284 F. Supp.2d 96, 100 (D.D.C. 2003) (per Kollar-Kotelly, D.J.), granting summary judgment to Plaintiff-Appellee and denying the same to Defendant-Appellant. The District Court's judgment reversed an April 2, 1999 decision of the TTAB. This opinion is also available at 68 U.S.P.Q.2d 1225.

C. Related Cases. Prior to review before the District Court, this case was before the TTAB as Cancellation No. 21,069, *Suzan Shown Harjo, et al. v. Pro-Football, Inc.* This opinion is available at 50 U.S.P.Q.2d 1705 (TTAB 1999) and 1999 WL 375907 (TTAB 1999).

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## GLOSSARY

**APA:** Administrative Procedure Act

**Native American Parties:** Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr.

**NCAI:** National Congress of American Indians

**Pro-Football:** Pro-Football, Inc.

**TTAB:** Trademark Trial and Appeal Board

## STATEMENT OF JURISDICTION

Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means and Manley A. Begay, Jr. (the “Native American Parties” or “Appellants”) initiated this proceeding before the Trademark Trial and Appeal Board (the “TTAB” or the “Board”) pursuant to 15 U.S.C. §1052(a) by filing a petition to cancel six federal trademark registrations containing the word “redskins” (the “redskins” marks) owned by Pro-Football, Inc. (“Pro-Football” or “Appellee”). 15 U.S.C. §1052(a) (2004). By Order dated April 2, 1999, the TTAB scheduled the cancellation of the “redskins” marks.

Thereafter, pursuant to 15 U.S.C. §§1071(b)(1) and (4), Pro-Football sought reversal of the TTAB’s decision in the United States District Court for the District of Columbia. 15 U.S.C. §1071 (2004). On September 30, 2003, the District Court reversed the TTAB’s decision. The Native Americans timely filed a Notice of Appeal on October 29, 2003.

This Court has jurisdiction over this appeal pursuant to 28 U.S.C. §1291. 28 U.S.C. §1291 (2004).

### STATEMENT OF ISSUES PRESENTED

1. Whether the District Court was wrong to conclude that the decision of the TTAB to cancel the “redskins” marks was not supported by substantial evidence.

2. Whether the District Court erred in holding that the TTAB’s conclusion that the “redskins” marks may disparage Native Americans was not supported by substantial evidence.

3. Whether the District Court erred in concluding that the TTAB was wrong to consider the perceptions of the general public in determining if the “redskins” marks are disparaging to Native Americans.

4. Whether the District Court erred in granting Pro-Football’s Motion for Summary Judgment instead of remanding the case to the TTAB for further fact-finding on the ground that the TTAB failed to make sufficient findings and prevented the District Court from engaging in “meaningful review” of the TTAB decision.

5. Whether the District Court erred in concluding that laches is an available and valid defense against claims brought under Section 2(a) of the Lanham Act, 15 U.S.C. §1052(a).

6. Whether the District Court erred in concluding that “the delay in bringing the cancellation proceeding was so substantial [that] a presumption is created that Pro-Football was entitled to rely on the security of the trademarks at issue” and, therefore, that cancellation of the “redskins” marks was precluded by the laches defense.

### STATUTES AND REGULATIONS

The relevant statutes and regulations appear in the Addendum to this brief.

## STATEMENT OF THE CASE

On April 2, 1999, the TTAB issued an order scheduling the cancellation of Pro-Football's "redskins" marks. The TTAB's decision was based on its finding that:

[T]he evidence of record establishes that, within the relevant time periods, the derogatory connotation of the word "redskin(s)" in connection with Native Americans extends to the term "Redskins," as used in [Pro-Football's] marks in connection with the identified services, such that [Pro-Football's Redskins] marks may be disparaging of Native Americans to a substantial composite of [Native Americans].

*Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1748 (T.T.A.B. 1999) (the "*TTAB Decision*"), (interpreting Section 2(a) of the Lanham Act).

On June 1, 1999, Pro-Football filed a civil action in the District Court seeking review of the *TTAB Decision*.<sup>1</sup> Pro-Football's Complaint challenged the *TTAB Decision* in five (5) separate causes of action, asking the District Court to find:

- (1) that the "redskins" marks do not disparage Native Americans [Count I];
- (2) that the "redskins" marks do not bring Native Americans into contempt or disrepute [Count II];
- (3) that Section 2(a) of the Lanham Act violates the First Amendment because it is a vague, overbroad, content-based restriction on speech [Count III];
- (4) that Section 2(a) of the Lanham Act violates the Fifth Amendment because it is unduly vague [Count IV];
- (5) that the cancellation petition filed by our clients was barred by the doctrine of laches [Count V].

*See Pro-Football, Inc. v. Harjo*, 284 F. Supp.2d 96, 100 (D.D.C. 2003) (the "*Opinion Below*").

Both sides filed summary judgment motions. Pro-Football sought summary judgment on the First, Second, and Fifth counts of its Complaint. *See id.* at 102. The Native American Parties asked the District Court (1) to affirm the *TTAB Decision*; (2) to dismiss Pro-Football's

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<sup>1</sup> The Lanham Act permits parties aggrieved by a registration/cancellation decision of the TTAB to choose between (1) appealing the TTAB's decision to the Federal Circuit; or (2)

(continued...)

laches claim; and (3) to reconsider, if necessary, their previously-filed motion to dismiss Counts III and IV of Pro-Football's Complaint (*i.e.*, the constitutional claims). *See id.*

Pro-Football's motion for summary judgment made "two main arguments." *Id.* at 102. First, Pro-Football challenged the TTAB's finding that the "redskins" marks "may disparage" Native Americans within the meaning of the Lanham Act, arguing that "the dispositive evidence before the TTAB was irrelevant." *Id.* Second, Pro-Football argued that the Native American Parties' petition for cancellation was barred by the doctrine of laches. *See id.* Ultimately, the District Court agreed with Pro-Football on both points.

In an opinion dated September 30, 2003, the District Court granted summary judgment for Pro-Football on Counts I and II, concluding that the TTAB's finding of disparagement was "not supported by substantial evidence." *Id.* at 145. The court also held that "the doctrine of laches precludes consideration of the case." *Id.* The Native American Parties have appealed to this Court.

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(..continued)  
seeking review of the TTAB's decision by filing a civil action in District Court. *See* 15 U.S.C. §§ 1071(a)(4), 1071(b)(1).

## STATEMENT OF FACTS

Appellants Suzan Shown Harjo (Cheyenne & Arapaho Tribes of Oklahoma), Raymond D. Apodaca (Pueblo of Ysleta del Sur), Vine Deloria, Jr. (Standing Rock Sioux Tribe), Norbert S. Hill, Jr. (Oneida Tribe of Wisconsin), Mateo Romero (Cochiti Pueblo), Manley A. Begay, Jr. (Navajo Nation) and William A. Means (Oglala Sioux Tribe of Pine Ridge) are all Native American persons, and each is a member of a different federally recognized Indian tribe. (NR1 Ex. 2.) Each has a lengthy history of public service to the Native American community and all have held and currently hold positions of responsibility within or for their respective tribes, as well as for a variety of other American Indian institutions and organizations. (SH Ex. 69, VD Ex. 32, NH Ex. 40, MR Ex. 103, MB Ex. 83, and WM Ex. 88.) Throughout their lifetimes, all have been the target of insult, degradation and humiliation resulting from use of the derogatory term “redskins.”

Pro-Football is the Washington, D.C. professional football organization that has chosen this racial epithet as its team name. The Native American Parties seek cancellation of Pro-Football’s six federally-registered service marks that incorporate the term “redskins” or derivations of this word. The six challenged marks were registered by Pro-Football between 1967 and 1990. Four of the marks (THE REDSKINS (1967) in stylized script, THE WASHINGTON REDSKINS (1974), REDSKINS (1978) and REDSKINETTES (1990)) consist solely of text. Two others, both registered in 1974, also include Native American imagery. Each of the challenged “redskins” registrations purports to cover “entertainment services” relating to the presentation of professional football games and exhibitions, the performance of dance routines by cheerleaders at such games and exhibitions, and other personal appearances. Each of the challenged marks consists of or comprises the word “redskins.” Two of Pro-Football’s



marks also include additional graphic material making it abundantly clear that they (and the team) refer to, identify, or otherwise implicate Native Americans.

The Native American Parties contend that the “redskins” marks challenged at the TTAB should have never been registered in the first place and that the registrations were therefore void *ab initio*, justifying immediate cancellation. Section 14(3) of the Lanham Act provides for cancellation of a registration “at any time,” if the subject mark was registered “contrary to the provisions” of Section 2(a) of the Lanham Act. 15 U.S.C. § 1064(3) (2004). Pursuant to Section 2(a), no mark shall be registered if it consists of or comprises “matter which may disparage... persons, living or dead,... or bring them into contempt, or disrepute...” 15 U.S.C. § 1052(a). Matter *may* “disparage” when it *may* “slight,” or “dishonor,” or “discredit” persons,<sup>2</sup> or when it *may* be considered “derogatory” toward persons.<sup>3</sup> The Native American Parties demonstrated before the TTAB that the “redskins” marks contain matter that not only “*may* disparage,” but that **does**, in fact, “disparage” Native Americans.

Evidence showing use of the word “redskins” clearly demonstrated the word’s long history as a term of disparagement. Examples from nineteenth- and twentieth-century American newspapers (particularly in their accounts of life in the American West) and popular literature reveal vivid examples of the offensive and disparaging use of “redskins” as a term associated with violence, savagery, racial inferiority and other negative ethnic stereotypes. (See NR1 Exs. 22.001, 22.003, 22.005, 22.007, 22.008, 22.011, 22.013, 22.017, 22.024, 22.029, 22.033, 22.063, 22.064; GN2 at 288; NR1 Ex. 125.) In terms of modern usage, the Native American

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<sup>2</sup> See *In re Hines*, 31 U.S.P.Q.2d 1685, 1688 n.5 (TTAB 1994) [hereinafter *Hines I*], *rev’d on other grounds*, 32 U.S.P.Q.2d 1376 (TTAB 1994).

<sup>3</sup> See *In re In Over Our Heads Inc.*, 16 USPQ2d 1653, 1654 n.4 (TTAB 1990).

Parties established that the term “redskins” had fallen largely into disuse in the context of articles about Native Americans because “redskins” is *not* a neutral, purely denotative term but is, instead, a pejorative and offensive term. (GN2 at 312-13.)

In addition, the Native American Parties submitted the results of a study examining the use of the word “redskins” in film and assembled a video montage containing relevant excerpts from nine films. The films selected were reasonably representative of the film genre known as the “Western,” with some comedies and comedic Westerns also included. (SC at 46.) They were also representative of the manner in which Native Americans are treated in American films. (SC at 52.) In particular, “redskins” was often coupled with negative adjectives like “dirty” and “lying” and was used in a context of violence, savagery and killing. (SC at 87-88.)

The Native American Parties presented the expert testimony of Geoffrey Nunberg, Ph.D, a linguist who analyzed evidence from dictionaries and other secondary sources. (*See, generally*, GN and GN1.) The year before and of Pro-Football’s first registration saw the publication of two editions of a dictionary specifically acknowledging the offensive character of “redskin(s).” In 1966 and 1967 the *Random House Dictionary of the English Language* defined “redskin(s)” as “*Often offensive. A North American Indian.*” (NR1 Exs. 1.003; 1.004) (italics in original). Three years later, but at least four years prior to the issuance of six of Pro-Football’s six challenged registrations, the *Random House Dictionary of the English Language (School Edition)* defined “redskin(s)” as “a North American Indian. (Often considered an offensive term.)” (NR1 Ex. 1.006) (parenthetical in original). In 1974, the *Thorndike-Barnhart Intermediate Dictionary* published a nearly identical definition: “a North American Indian (a term often considered offensive).” (DB Ex. 3 at 11) (parenthetical in original). The linguist demonstrated that the *presence* of a label shows that the editors *did* consciously think

about the word and made a judgment about its connotation but that the absence of a usage label (like “offensive” or “usually disparaging”) in a dictionary was not necessarily determinative of a term’s connotation.<sup>4</sup> (GN2 at 330-31, 333.)

Moreover, the Native American Parties established through expert testimony that the names of team mascots are often chosen because they sound “fierce, ferocious, savage, inhuman, implacable, so as, in a symbolic way, to strike fear into the hearts of opponents” and that the name “redskins” falls into this category of names. (GN2 at 360, 362-63.) The Native American Parties submitted evidence in the form of sports-page headlines concerning Pro-Football, including the following: “Redskins Start Bloodletting Today,” “Skins Scalp Giants, 23-7,” “More Cuts Likely to Follow Full-Scale Redskin Warfare” and “Redskins Back on the Warpath.” (GN2 at 364-65; NR1 Ex. 11.) These headlines showed the degree to which the association of the team name and the use of the word to refer to Native Americans remains vivid and salient in the minds of sports writers and the general public and suggested a very vivid connection that, in fact, is linguistically exploited by headline writers. Thus, it is simply not the case that “redskins” has acquired a meaning that somehow is divorced from or independent of its use in referring to Native Americans. The word that disparages Native Americans when it is applied to them directly remains just as disparaging when it is applied to them metaphorically.

The Native American Parties submitted detailed personal testimonials regarding use of the term “redskins,” and each of them testified about the pain that this term has caused them. Their negative experiences with “redskins” did not decrease with time, nor did encounters with the term become less damaging. Indeed, all told of continued negative experiences with

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<sup>4</sup> According to Pro-Football’s linguist David Barnhart, usage labels normally reflect the opinion of the dictionary editor-in-chief who may be generous or conservative in including them or may be constrained by space limitations.

“redskins” throughout their adult lives. To them, the word is far from neutral and is not, and never has been, simply an informal synonym for “Indian(s)” or “Native American(s).” Perhaps most important to these proceedings, however, the Native American Parties have found Pro-Football’s use of the “redskins” marks no less disparaging or hurtful than any other use of the term “redskins.” (SH3 at 260, 261; RA1 at 16; VD3 at 199-200; SH3 at 268; NH3 at 286-87; VD1 at 144-45.) By contrast, despite admitting that the views of Native Americans were highly relevant to the TTAB proceeding, Pro-Football did not call a single Native American to testify.

The Native American Parties established that their experiences with the term “redskins” were in no way unique among Native Americans. Indeed, the record shows that Native Americans protested the “redskins” marks more than a quarter-century ago. The National Congress of American Indians (“NCAI”), which is “the oldest and largest intertribal organization” and is a “nationwide representative of and advocate for national, regional, and local tribal concerns” representing over 185 tribes and 800,000 American Indians as well as other Native American institutions, has long opposed the “redskins” marks. In March 1972, only four years after issuance of Pro-Football’s earliest “redskins” registration, the President of NCAI and members of other prominent organizations representing Native Americans met with Pro-Football’s then owner, Edward Bennett Williams, to formally object to the “redskins” team name. (See HG at 18-19; NR1 Exs. 32.005, 32.006, 32.012; *see also* NR1 Exs. 18, 25.001 and 32.) The effort was organized by Mr. Harold M. Gross (Executive Director, Indian Legal Information Development Service), whose letter requesting the meeting explained that the term “redskins” was “[b]orn at a time in our history when the national policy was to seize Indian land

and resources, and hunt down Indian people who stood in the way....”<sup>5</sup> This letter concluded that this term is most often “coupled with other derogatory adjectives, as ‘dirty Redskin’ or ‘pesky Redskin’ which is used interchangeably with the word ‘savage’ to portray a misleading and denigrating image of the Native American.” (HG at 14; NR1 Ex. 32.007.) NCAI later adopted two resolutions, one in 1993 and one in 1997, condemning Pro-Football’s use of “redskins” and finding the term “has always been and continues to be” offensive, scandalous and disparaging. (NR1 Ex. 3; RA Exs. 102 and 144.) Thus, NCAI has spoken out formally and informally since the early 1970s against Pro-Football’s marks.

The various forms of evidence that the Native American Parties presented of their own experiences and from academic fields (*e.g.*, linguistics, history, social sciences) were clearly sufficient to demonstrate the disparaging nature of “redskins.” Nonetheless, as it is traditional in trademark cases to offer survey evidence, the Native American Parties included this additional type of evidence of the disparaging nature of “redskins.” (IR Ex. 3.) Through the work of their expert Dr. Ivan Ross,<sup>6</sup> the Native American Parties demonstrated that “redskins” is widely perceived as offensive, both among Native Americans and in the population as a whole. According to Dr. Ross’s survey, 46.2% of the general population were themselves offended by “redskin,” 55.8% believed that others would be offended, and 71.1% believed “redskin” was

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<sup>5</sup> See HG at 18-19; NR1 Exs. 32.005, 32.006, 32.012; *see also* NR1 Exs. 18, 25.001 and 32. In his letter requesting this meeting, Mr. Gross had suggested that Mr. Williams “imagine a hypothetical National Football League, in which the other teams are known as the New York Kikes, the Chicago Polocks, the San Francisco Dagoes, the Detroit Niggers, the Los Angeles Spics, etc. \* \* \* Such a league would shortly be out of business, since the number of people properly outraged by such ethnic slurs would be sizeable enough to force its closing. Yet the term ‘Redskin’ is no less stereo-type provoking and no less insulting to American Indians than [these terms]....” (HG at 11-12; NR1 Ex. 32.007.)

<sup>6</sup> Ivan Ross, Ph.D., is President of Ross Research and a former Professor of Marketing and Adjunct Professor of Psychology with the Carlson School of Management of the University of Minnesota with over thirty years of experience designing and conducting attitude surveys. (IR Ex. 3 at Tab A.)

offensive to either themselves *or* others. In the Native American sample, the analogous figures were 36.6%, 52.5%, and 60.3%. (IR2 at 66; IR Ex. 3 at Tab B; IR Ex. 159.) Although Pro-Football alleged that Dr. Ross's 1995 survey was irrelevant to public opinion in 1967, the Native American Parties established that "there would very likely be a positive correlation between the answers that they would have given then and the answers that they would give now." (IR1 17.)

In sum, the Native American Parties successfully demonstrated before the TTAB that Native Americans have understood and still understand "redskins" to be a derogatory, offensive, discrediting, slighting, dishonoring and disparaging racial epithet that brings them into contempt, ridicule and disrepute. Their testimony concerning their own life experiences of the word was particularly striking, both in general and specifically with reference to Pro-Football's use of the word. They also demonstrated (through survey evidence and through the formal actions and conduct of various Native American social institutions) that other Native American persons, tribes and institutions share their views on this subject. Linguistic and historical evidence confirmed that these perceptions exist and are eminently reasonable. In other words, the Native American Parties went well beyond the required proof to facilitate the Board's ultimate conclusion that "redskins" *may* "disparage" Native American persons and that Pro-Football's use of the "redskins" marks, in fact, *does* so.

## SUMMARY OF ARGUMENT

Under the procedure set forth under 15 U.S.C. §§1071(b)(1) and (4), a party may challenge a decision of the TTAB before a federal District Court for the purpose of introducing new evidence. In this case, however, Pro-Football filed a motion for summary judgment on the issue of disparagement without introducing any new evidence on this issue, putting the District Court in the role usually assigned to this Court of reviewing whether an agency's decision was supported by substantial evidence. Because this case comes before this Court on a grant of summary judgment, the Court reviews the District Court's decision *de novo*. Therefore, this Court should examine *de novo* whether the TTAB's decision was supported by substantial evidence and, if it determines that the TTAB's decision was supported by substantial evidence, should reverse the District Court's decision.

The District Court correctly concluded that the TTAB's fact-finding was subject to the "substantial evidence" standard of review set forth in Section 706(2)(E) of the Administrative Procedures Act ("APA"). *Opinion Below* at 114. Having articulated the correct standard of review, however, the District Court's analysis of the facts at issue then failed to afford any deference to the fact-based conclusions drawn by the TTAB. Instead, the District Court granted summary judgment in favor of Pro-Football, thereby reversing the TTAB's ultimate finding that that the term "redskin(s)" may disparage.

The District Court also erred in granting summary judgment in favor of Pro-Football on the issue of laches. Because §15 U.S.C. 1064(3) allows a challenge to a trademark under §15 U.S.C. 1052(a) to be brought "at any time" and there are important public interest considerations implicated by this case, the application of laches is inappropriate here.

This Court has explained that it is inappropriate for a District Court to find disputed facts in the context of a motion for summary judgment. See *Formula v. Heckler*, 779 F.2d 743, 745 n.2 (D.C. Cir. 1985) (citing *Rodway v. United States Dep't of Agric.*, 482 F.2d 722, 727 (D.C. Cir. 1973)); see also *Toney v. Bergland*, 645 F.2d 1063, 1070 (D.C. Cir. 1981) (reversing and remanding in light of genuine issues of material fact). The numerous material facts at issue in this case – including those discussed below – should have prevented summary judgment on Counts I and II (disparagement) and Count V (laches) of Pro-Football's Complaint.



## ARGUMENT

### **I. If This Court Finds That The TTAB Decision Was Sustainable Under A Substantial Evidence Standard, It Should Reverse The District Court's Decision**

This case was filed under 15 U.S.C. §§1071(b)(1) and (4), creating an unusual procedure. In most cases filed under 15 U.S.C. §§1071(b)(1) and (4), the plaintiff challenges a TTAB decision by introducing new evidence. The District Court then conducts a trial on the record. In this case, however, Pro-Football filed a motion for summary judgment, seeking to reverse the TTAB's decision on the issue of disparagement without introducing any new evidence on this issue. This procedure had the practical effect of putting the District Court in the role normally assumed by this Court in reviewing an administrative agency decision to determine whether, on the record before the agency, the decision was supported by substantial evidence. This District Court granted Pro-Football's motion for summary judgment. On appeal, this Court should apply a *de novo* standard of review to the District Court's decision. Thus, this Court should independently review the decision of the TTAB to determine whether it was based upon substantial evidence.

#### ***A. The TTAB's Decisions Are Reviewed Under the Deferential "Substantial Evidence" Standard***

In *Dickinson v. Zurko*, 527 U.S. 150, 165 (1999), the U.S. Supreme Court held that decisions of the United States Patent and Trademark Office ("PTO") are subject to the deferential standard of review prescribed by the Administrative Procedures Act ("APA"), which requires reviewing courts to "hold unlawful and set aside agency action, findings and conclusions" found to be "unsupported by substantial evidence." 5 U.S.C. §706(2)(E) (2004). The United States Court of Appeals for the Federal Circuit has confirmed that *Zurko's* conclusion extends to both patent and trademark decisions, stating that the TTAB's findings of

fact are subject to the “substantial evidence” standard of review provided for in 5 U.S.C. 706(2)(E). *See Mazzari v. Rogan*, 323 F.3d 1000, 1005 (Fed. Cir. 2003) (“[A] reviewing court, whether this court or the District Court, applies the ‘substantial evidence’ standard of review to findings of fact made by the board.”). Other courts concur. *See, e.g., CAE, Inc. v. Clean Air Eng’g, Inc.*, 267 F.3d 660, 675 (7<sup>th</sup> Cir. 2001).

“Substantial evidence is more than a mere scintilla. It means such relevant evidence as a reasonable mind might accept as adequate to support a conclusion.” *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938); *see also In re Gartside*, 203 F.3d 1305, 1312 (Fed. Cir. 2000); *CAE*, 267 F.3d at 675. “Mere uncorroborated hearsay or rumor does not constitute substantial evidence.” *Consolidated Edison*, 305 U.S. at 230. On the other hand, “the possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency’s finding from being supported by substantial evidence.” *Consolo v. Federal Maritime Comm’n*, 383 U.S. 607, 620 (1966).<sup>7</sup>

In its opinion below, the District Court agreed that the substantial evidence standard of review applied in this case and purported to review the TTAB’s “ultimate conclusion” under this standard. It also agreed that the issue “[w]hether the six trademarks disparage Native Americans [within the meaning of the Lanham Act] is ultimately a fact-bound conclusion.” *Opinion Below* at 117. And the District Court then correctly recognized, following the Supreme Court’s

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<sup>7</sup> The substantial evidence standard is considered to be less deferential than the “arbitrary and capricious” standard of review. *See On-Line Careline, Inc. v. America Online, Inc.*, 229 F.3d 1080, 1085 (Fed. Cir. 2000); *Gartside*, 203 F.3d at 1312. It is slightly *more deferential*, however, than the “clearly erroneous” standard of review that many reviewing courts, including the Federal Circuit, applied to the TTAB’s findings of fact prior to *Zurko*. *See CAE*, 267 F.3d at 675; *see also Zurko*, 527 U.S. at 162 (comparing “more strict” (*i.e.*, less deferential) “court/court” standard of review with the APA’s “court/agency” standard).

reasoning in *Zurko*, that its review of the fact-based disparagement issue was thus “circumscribed by the agency record.” *CAE*, 267 F.3d at 675.

To prove disparagement before the TTAB, a petitioner must meet a “preponderance of the evidence,” rather than a “clear and convincing evidence,” burden of proof. *See West Florida Seafood, Inc. v. Jet Restaurants, Inc.*, 31 F.3d 1122, 1128 (Fed. Cir. 1994) (“petitioner *always* bears the burden of proof by a *preponderance of the evidence* in a cancellation proceeding, whether the argument for cancellation is based on abandonment, likelihood of confusion, *or any other ground*”) (emphasis added). If the “preponderance of the evidence” standard is correctly applied in an administrative proceeding, the fact-finder need only be satisfied that “on the whole, . . . *greater weight* of the evidence supports the plaintiff’s account.” *See Secretary of Labor v. Keystone Coal Mining Corp.*, 151 F.3d 1096, 1103 (D.C. Cir. 1998) (emphasis added); *see also Stone v. Commissioner*, 865 F.2d 342, 347 (D.C. Cir. 1989) (describing a “preponderance” as “half plus a little bit”). The District Court agreed that the TTAB had correctly articulated the preponderance of the evidence standard.

The ultimate issue before the District Court was, therefore, whether, based upon the record before the TTAB, a reasonable decision maker could have found that the Native American Parties had demonstrated that the trademarks disparage Native Americans by a preponderance of the evidence.

***B. This Court Reviews the District Court’s Decision De Novo***

Because “the grant or denial of summary judgment is a determination of law<sup>8</sup> rather than one of fact,” reviewing courts apply a *de novo* standard of review. *See Liberty Lobby, Inc. v.*

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<sup>8</sup> As the District Court recognized, it was not “permitted under the Federal Rules of Civil Procedure to make findings of fact” at the summary judgment stage in the proceedings. *Opinion Below* at 102, n.2.

*Rees*, 852 F.2d 595, 598 (D.C. Cir. 1988). Thus, this Court reviews the District Court's decision to grant summary judgment in favor of Pro-Football *de novo*. See *Mazzari*, 323 F.3d at 1005; *Lederman v. United States*, 291 F.3d 36, 41 (D.C. Cir. 2002); *Fort Sumter Tours, Inc. v. Babbitt*, 202 F.3d 349, 354 (D.C. Cir. 2000); *IMS, P.C. v. Alvarez*, 129 F.3d 618, 619 n.1 (D.C. Cir. 1997) ("Our standard of review of a grant of summary judgment under Federal Rule of Civil Procedure 56 is *de novo*."); *Tao v. Freeh*, 27 F.3d 635, 638 (D.C. Cir. 1994) ("Our review of the grant of summary judgment is *de novo*, applying the same standards as the District Court.").

In the context of this case, *de novo* review involves a review of the TTAB decision to determine whether it was based upon substantial evidence. If this Court concludes that the TTAB's decision passes the substantial evidence test, it should reverse the District Court's decision.

## **II. The TTAB Was Correct In Concluding That The Term "Redskins" Disparages Native Americans**

### ***A. The TTAB Conclusion That The Term "Redskins" Disparages Native Americans Was Supported By Substantial Evidence***

The TTAB correctly concluded that the term "redskins" disparages Native Americans when used in the context of Pro-Football's products and services. This conclusion was reached after the TTAB had spent considerable time reviewing the evidence presented by both sides. In addition to extensive evidence presented in the form of news articles and literature, film clips, testimony of academic experts, dictionary definitions, surveys, resolutions of representative organizations, complaints by Native Americans about the use of the word "redskins" and the Native American Parties' own personal experiences, the TTAB considered:

- A resolution passed in 1994 by Unity 94, a coalition of four minority journalists associations, calling upon news and media organizations to "officially discontinue the

use of Native American and other culturally offensive nicknames, logos and mascots related to professional, college, high school and amateur sports teams.”

- The fact that the use of the term “redskins” to refer to Native Americans was prevalent during the first half of the 20<sup>th</sup> Century and the unanimous view of both sides’ experts that “until at least the middle of [the last] century, spoken and written language often referred to Native Americans in a derogatory, or at least condescending, manner and that references to Native Americans were often accompanied by derogatory adjectives and/or in contexts indicating savagery and/or violence.”
- Evidence establishing that, during the relevant time periods, the disparaging connotation of “redskins” as a term of reference for Native Americans extends to the word “redskins” as it appears in the “redskins” marks and as used in connection with [Pro-Football’s] identified services.
- A substantial number of news articles, from various time periods, reporting Native American objections, and activities in relation thereto, to the word “redskins” in respondent’s team’s name.”
- Various articles and publications about language that include “the assumption or conclusion that the word ‘redskins’ as a term of reference for Native Americans is, and always has been, a pejorative term.”

The TTAB drew reasonable conclusions from this evidence. In particular, as befits its role as an expert agency judicial body, it carefully weighed the evidence before it and made conclusions as to the credibility, quality and quantity of evidence presented on each side, the appropriate inferences to be drawn from the evidence, and the relevance of the evidence to the ultimate question of disparagement.

For instance, in looking at the writings evidencing the use of the word “redskin(s),” the TTAB considered the conflicting evidence offered by the Native American Parties’ and Pro-Football’s linguistic experts on whether historical references to “redskin(s)” were negative or neutral. After reviewing that evidence, the TTAB then disagreed with Pro-Football’s expert that the references were “neutral, if not positive” and found that:

[T]he specified references to Native Americans [are], in fact, negative. However, even if we agreed with [Pro-Football’s expert]’s conclusions about these specified statements, we find these few references to be inconsequential in comparison to the substantial number of undisputedly negative historical references to Native Americans as “redskin(s)” in newspapers and other writings in the record.

*TTAB Decision* at 1745, n. 116.

In other cases, the TTAB has found a term to be disparaging on the basis of much less evidence as to the views of the relevant public or the allegedly disparaged group. *See, e.g., Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635 (TTAB 1988) (relying on evidence of many years of use submitted by opposer); *Doughboy Indust., Inc. v. The Reese Chem. Co.*, 88 U.S.P.Q. 227 (PTO 1951) (looking only at applicant’s specimen of use); *In re Reemtsma Cigarettenfabriken GmbH*, 122 U.S.P.Q. 339 (TTAB 1959) (relying on *Encyclopedia Britannica* entry); *see also In re Riverbank Canning Co.*, 95 F. 2d 327 (C.C.P.A. 1938) (finding “scandalousness” in reliance upon dictionary definitions and “common knowledge”). In the instant case, the TTAB considered “numerous discovery and testimony depositions on behalf of [the Native American Parties] and [Pro-Football], all with accompanying exhibits’ and numerous exhibits made of record by [the Native American Parties] and [Pro-Football].” *TTAB Decision* at 1709. Based on its consideration and weighing of all of this evidence, TTAB properly concluded that the evidence before the TTAB in this case proved by a preponderance of the evidence that

1122, 1125-26 (Fed. Cir. 1994) (“[W]hether a particular piece of evidence by itself establishes prior use is not necessarily dispositive as to whether a party has established use by a preponderance . . . ; one should look at the evidence as a whole, as if each piece of evidence were part of a puzzle which, when fitted together, establishes prior use”).

What the District Court failed to recognize in its analysis is that the TTAB is permitted and entitled to draw reasonable inferences with respect to the record before it. *See Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 1024 (Fed. Cir. 1989) (finding that TTAB properly drew inferences from facts in the record in support of its finding of abandonment); *EZ Loader Boat Trailers, Inc. v. Cox Trailers, Inc.*, 706 F.2d 1213, 1215 (Fed. Cir. 1983) (upholding a conclusion of the TTAB that was based on an “evaluation of the evidence and the inferences it drew from that evidence”). The substantial evidence standard applicable to the TTAB’s findings of fact applies with equal force to the inferences reasonably drawn by the TTAB. *See Crowley v. Commissioner*, 962 F.2d 1077, 1080 (1<sup>st</sup> Cir. 1992) (stating that “the inferences drawn from undisputed facts are entitled to the same deferential standard of review” as the factual findings themselves) (citing *Commissioner v. Duberstein*, 363 U.S. 278, 291 (1960))<sup>9</sup>; *see also Opinion Below* at 128 (stating that “the Court defers to the TTAB’s inferences under the rubric of a substantial evidence standard”).

In reviewing the TTAB’s inferences, the District Court purported to be applying the “substantial evidence” test, specifically acknowledging that it was not permitted to “substitute its judgment for that of the TTAB.” *Opinion Below* at 128. But the District Court then went on to do just that. For example, the court explained that the surveys proffered by the Native American

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<sup>9</sup> In *Duberstein* and *Crowley*, the courts were discussing the “clearly erroneous” standard of review, which is even less deferential than the “substantial evidence” standard applicable to the TTAB’s findings of fact.

Parties did not tend either “to prove or disprove that the marks at issue ‘may disparage’ Native Americans during the relevant time frame” because the surveys “did not measure the attitudes of the survey participants as they were held during the relevant time periods.” Yet the District Court did not give credence to or even acknowledge the TTAB’s reasonable inference that “evidence concerning the significance of the word ‘redskins(s)’ before and after the relevant time periods may shed light on its significance during those time periods.” *TTAB Decision* at 1715.

In sum, the District Court erred in stating that the TTAB was not entitled to draw inferences, and then compounded this error by ignoring inferences properly drawn that allowed the TTAB to reach its conclusion that the term “redskins “ is disparaging to Native Americans.

2. The District Court Misinterpreted Cases And Thus Incorrectly Rejected A Number Of The TTAB’s Valid And Articulated Findings Of Fact

The District Court not only incorrectly rejected certain evidence as irrelevant to the TTAB’s task at hand, it also failed to recognize certain findings of fact that were clearly articulated in the TTAB’s decision.

i. *District Court Failed Even To Recognize A Number Of The TTAB’s Findings Of Fact*

In the court’s view, the TTAB made “specific findings of fact” in only two areas: (1) linguists’ testimony; and (2) survey evidence. *Opinion Below* at 119. While it is true that the TTAB only *labeled* as “findings of fact” its discussion about the linguists’ testimony and survey evidence, it is also clear from the TTAB’s decision that many other findings of fact influenced its ultimate conclusion that the term “redskin(s)” may disparage.

The TTAB’s decision frequently prefaces statements with phrases such as “we find,” “we look at evidence establishing that” and “we have considered.” The TTAB identifies at several points in its decision other materials that it relied upon to reach its conclusion, including “a



substantial number of writings, including, inter alia, excerpts from newspapers and other publications, encyclopedias, and dictionaries . . . clearly portray[ing] Native Americans in a derogatory or otherwise negative manner” and “voluminous excerpts from newspapers, including cartoons, headlines, editorials and articles, from the 1940’s to the present, that refer to [Pro-Football’s] football team in the context of stories and writings about the game of football . . . [and] portray[] Native Americans as either aggressive savages or buffoons.” *TTAB Decision at 1747*. The District Court’s mistake in glossing over these explanations by the TTAB ultimately contributed to the court’s error holding that the TTAB’s finding of disparagement was not supported by substantial evidence.

ii. *The District Court Improperly Rejected Certain Findings of Fact Based On A Misreading Of Two Relevant Cases*

The District Court overturned the TTAB’s “ultimate conclusion” that “the marks at issue ‘may disparage’ Native Americans.” To reach this result, the court found that the TTAB’s conclusion that the term “redskin(s)” may disparage Native Americans was unsupported by substantial evidence and was logically flawed. *See Opinion Below at 127*. The District Court’s decision is largely founded upon its conclusion that much of the evidence considered by the TTAB was “irrelevant,” and it reached this conclusion based on an incorrect application of two prior cases dealing with the disparagement issue: *Hines I* and *Doughboy*. *Hines I*, 31 U.S.P.Q.2d at 1685; *Doughboy*, 88 U.S.P.Q. at 227. A misunderstanding of these cases appears to have tainted the District Court’s views on how the TTAB weighed evidence, which ultimately led to the District Court’s disagreement with, and overturning of, the TTAB’s ultimate conclusion that the “redskins” marks may disparage.

As an initial matter, the court found that the TTAB's finding that the "derogatory connotation of the word 'redskin(s)' extends to the term 'Redskins' as used in connection with [the Washington Redskins football team]" was not supported by substantial evidence:

To reach the conclusion that the trademarks may disparage Native Americans, the TTAB essentially determined that because the word "redskin(s)" may be viewed by Native Americans as derogatory when used as a reference for Native Americans, the trademarks are disparaging because they use that word. The result of this analysis is that there is very little discussion of the use of the mark in connection with Pro-Football's products or services.

*Opinion Below* at 133 (emphasis in original). The court's criticism of the TTAB on this issue was unfounded. In particular, the court was incorrect about the absence of evidence in the record concerning use of the mark in connection with professional football. For example, as the court itself acknowledged, the TTAB found (concerning the "meaning of the matter in question") that *as used in connection with Pro-Football's services*, "'Redskins' clearly both refers to [Pro-Football's] professional football team and carries the allusion to Native Americans inherent in the original definition of the word." *Id.* at 126 (emphasis added).<sup>10</sup>

In addition, the TTAB carefully detailed how and why it was considering the marks in the context of Pro-Football's goods and services with the following statement:

Both parties have submitted voluminous excerpts from newspapers... from the 1940's to the present, that refer to respondent's football team in the [football] context ... [and demonstrate that] the media has used Native American imagery in connection with respondent's team, throughout this entire time period, in a manner that often portrays Native Americans as either aggressive savages or buffoons. For example, many

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<sup>10</sup> As the District Court expressly recognized, the TTAB also found (1) that the Redskins use Native American imagery throughout their logos and team imagery; and (2) that two of the marks at issue "include a portrait of the profile of a Native American and what is presumably a Native American spear." *Id.* at 126-127 (citing *TTAB Decision* at 1742) ("We believe these two elements reinforce the allusion to Native Americans that is present in the word 'Redskins' in both marks.")

[excerpts] refer to the "Redskins" team, players or managers "scalping" opponents... holding "pow wows"... [and using] pidgin English, such as "Big Chief Choo - He Ponder" [or show] respondent's team's fans dressed in costumes and engaging in antics that clearly poke fun at Native American culture and portrays Native Americans as savages and buffoons... [W]e agree with respondent that it is not responsible for the actions of the media or fans; however, the actions of the media and fans are probative of the general public's perception of the word "redskin(s)" as it appears in respondent's marks herein. As such, this evidence reinforces our conclusion that the word "redskin(s)" retains its derogatory character as part of the subject marks *and* as used in connection with respondent's football team.

*TTAB Decision* at 1747 (emphasis added).

The District Court relies on *Hines I* for the proposition that the perceptions of the general public are "irrelevant" to a determination of the views of Native Americans on the issue of whether the term "redskins" may disparage. This is a misreading of the case. In *Hines I*, the TTAB made the statement that "the perceptions of the general public are irrelevant" in determining whether or not a mark is disparaging in response to a defense argument that no one, apart from the disparaged group, would deem the mark at issue disparaging. In other words, the TTAB's statement was made in the context of a record "devoid of evidence that anyone in the public would be shocked" by defendant's mark. *Hines I*, 31 U.S.P.Q.2d at 1686. Applying that statement to a case with very different facts turns it on its head, particularly where the TTAB had already made it clear in its opinion that "if allegedly disparaging matter provokes a widespread negative social relation, it is reasonable to infer that the relevant group will, similarly, perceive the matter as disparaging," thus distinguishing the statement taken from *Hines I*. *TTAB Decision* at 1739, n. 99.

The District Court took the statement that "the perceptions of the general public are irrelevant" from *Hines I* and, without considering the context of that case, concluded that the

public's perceptions regarding the derogatory nature of the term "redskins" were completely irrelevant to this case,<sup>11</sup> stating that:

the fact that a 'not insignificant number of Americans have understood "redskin(s)" to be an offensive reference to Native Americans' *has nothing to do* with whether Native Americans themselves consider the term 'offensive.'

*Opinion Below* at 130 (emphasis added).

The District Court reiterated this view several times, further noting that "[t]he perceptions of the general public *are irrelevant* to determining if the marks are disparaging to Native Americans," and that "evidence relating to media and fans *has no bearing on...*" the case (emphasis added). *Id.* at 134. The court's conclusion that the perceptions and understandings of the general public and evidence relating to media and fans are "irrelevant" leads the court to ignore a great deal of the evidence of record.

Finally, relying on the *Doughboy* decision, the District Court determined that disparagement could be assessed only in the context of the goods or services identified by the mark. In *Doughboy*, the TTAB found that the mark DOUGH-BOY was disparaging when used in connection with "prophylactic preparations" even though the term "doughboy" was innocuous in and of itself. *Doughboy*, 88 U.S.P.Q. at 227. The TTAB held in *Doughboy* that the analysis of disparagement should be controlled by the "same interpretation" of the law used in the case *In re Riverbank Canning Co.* in determining whether a trademark is "scandalous":

it was not necessary that a word be scandalous per se to be unregistrable as a trade mark, but . . . a trademark was unregistrable if it was scandalous by reason of the particular goods in connection with which it was used.

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<sup>11</sup> Of course, the Court's position as to the irrelevance of the general public's perceptions would raise intractable problems in establishing that a trademark is disparaging to a dead person or persons, as the statute clearly contemplates.

*Doughboy*, 88 U.S.P.Q. at 228 (citing *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938) (finding that “Madonna,” although not scandalous in itself, was scandalous when used to identify wine)).

The TTAB in *Doughboy* found that a *non-derogatory term* or epithet can be used in connection with a particular product to produce a *disparaging trademark*. The District Court apparently relied on the authority set forth in *Doughboy* to support the dubious proposition that a *derogatory term* or epithet can be used with a product to produce a *non-disparaging trademark*. In this way, the District Court criticized the TTAB for reaching the conclusion that “the derogatory connotations of the term ‘redskins(s)’” extends required independent evidence that the specific use of a derogatory term in the trademark itself is disparaging. Although the Native American Parties introduced substantial evidence of record to satisfy even the District Court’s skewed reading of the law, this fundamentally flawed legal analysis rendered much of the most readily available evidence “irrelevant” in the court’s view.<sup>12</sup> As a result, in the District Court’s view, dictionary definitions of words, words used common parlance as typified in newspaper articles and other types of evidence as to what words are generally understood to mean, become completely irrelevant to a determination whether trademarks containing such words are disparaging.

The TTAB was correct in finding that evidence that the term “redskins” was generally viewed as a derogatory epithet is highly relevant to this case. No trademark applicant has ever

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<sup>12</sup> The District Court justified its rejection of other evidence considered by the TTAB of Native Americans’ objections to the use of the word “redskins” by Pro-Football with the confusing explanation that the evidence was “irrelevant” because it “does not add exponentially to the requirement that the marks, when used in connection with Pro-Football’s services, are considered disparaging by a substantial composite of Native Americans.” *Opinion Below* at 135. (continued...)

succeeded in successfully persuading the TTAB or a court that a derogatory epithet or name for group can be included in a trademark without rendering the trademark disparaging. It was also perfectly reasonable for the TTAB to consider the generally accepted meaning of terms in deciding whether trademarks using those very terms are disparaging. It was also reasonable to assume that if the general public views the term “redskins” to be an offensive reference to Native Americans, then the very use of that term by non-Native Americans will be understood by Native Americans to be offensive. These approaches were not contradicted by the *Hines I* or *Doughboy* decisions, or by any other authority.

The District Court’s erroneous reading of the law would, if accepted, invite the use of any number of derogatory epithets in trademarks. Challenges to such trademarks would then be unreasonably restrained by the wholesale exclusion of evidence of public perception as “irrelevant.” This Court should make it clear that the District Court was mistaken. The TTAB was correct to decide that evidence of the general public’s understanding of the term “redskins” as a derogatory term for Native Americans is relevant to the outcome of this case.

3. The District Court Re-Balanced Evidence To Support Its Conclusion That The TTAB’s Decision Was Not Supported By Substantial Evidence

Repeatedly and throughout its opinion, the District Court interpreted facts in the record to mean the exact opposite of what the TTAB interpreted them to mean without citing any additional authorities or support for its conclusions. The examples provided below demonstrate how the District Court impermissibly substituted its own judgment for that of the TTAB.

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(..continued)

The District Court cited no authority for the proposition that evidence must “add exponentially” to that requirement for it to be considered relevant.

i. *Survey Evidence*

With respect to survey data presented at trial, the District Court criticized the TTAB for erroneously “focusing on the general public and inferring that the Native Americans would simply agree with those views.” *Opinion Below* at 129. The court found that the TTAB had incorrectly “equated” the views of the general public with the views of Native Americans. *Id.* at 128. Contrary to these assertions, the TTAB had clearly found that the survey “adequately represents the view of the *two populations* sampled.” *TTAB Decision* at 1734. In other words, the TTAB did not only focus on the views of the general public and infer that the Native Americans would simply agree with those views; the TTAB looked at the views of both groups.

In addition, although the District Court agreed with the TTAB’s finding that the Ross Survey was “a survey of current attitudes towards the word ‘redskin(s)’ as a reference to Native Americans,” the court ultimately concluded that the survey did not support the TTAB’s conclusion that “the word ‘redskins’ was viewed by a substantial composite of Native Americans to be a derogatory term of reference for Native Americans from the mid-1960’s to 1990.” The court then concluded that the survey was “entirely irrelevant” to the question before the Board. *Opinion Below* at 132.

The TTAB found that the survey, although imperfect, should be received into evidence and that it was entitled to some evidentiary weight. In so doing, the TTAB implicitly found that the “flaws” in the survey were “not so severe as to deprive the survey of any relevance.” *TTAB Decision* at 1734 (citing *Lon Tai Shing Co. Ltd. v. Koch & Lowy*, 19 U.S.P.Q.2d 1081 (S.D.N.Y. 1990), *Selchow & Righter Co. v. Decipher, Inc.*, 598 F. Supp. 1489 (E.D. Va. 1984)). Thus, contrary to the District Court’s assertions, the TTAB simply found that, in the context of the entire record (including the critique offered Pro-Football’s expert, Dr. Jacoby), the Ross survey

“adequately” represented the views of not only the general population; but also the Native American population, with respect to “the word ‘redskin(s)’ as a reference to Native Americans.” *Id.*<sup>13</sup>

ii. *Linguists’ and Dictionary Evidence*

The District Court criticized the TTAB’s interpretation of the testimony provided by the parties’ respective linguists regarding the significance of dictionary evidence. In particular, the District Court found it problematic that the TTAB allegedly “declined to make specific findings of fact with regard to the experts’ different views on the usage labels contained in the dictionary definitions.” *Opinion Below* at 109. In concluding that the TTAB “simply considered the dictionary definitions, themselves, in the context of its legal analysis, without relying on the experts’ opinions,” however, the District Court ignored the fact that the TTAB did find the testimony of Pro-Football’s linguist to be probative of at least one issue: the lack of any positive associations with the term “redskin(s).” *TTAB Decision* at 1732 (noting that the contention of Pro-Football’s linguistics experts that the word “redskin(s)” is merely an informal term does not address the issue of whether the connotation of “redskin(s)” in any given context is negative, neutral or positive).

The TTAB thus used the linguists’ testimony to support its reasonable determination that a term that is perceived as “negative” in some contexts and “neutral” in others will have the net effect of being perceived as negative. Again, this conclusion was supported by the TTAB’s

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<sup>13</sup> The District Court’s quarrel with the TTAB’s conclusion was primarily based on TTAB’s failure to provide a point-by-point refutation of Dr. Jacoby’s criticisms. In other words, the court did not conclude that the survey was invalid or that Dr. Jacoby’s criticisms were correct. Instead, it concluded that the TTAB’s failure to respond to Dr. Jacoby’s criticisms rendered the TTAB’s ultimate conclusion suspect. However, absent a finding by the District Court that Dr. Jacoby was actually correct and that his criticisms establish the complete irrelevance of the survey results, the mere failure of the TTAB to answer these criticisms point-by-point should not vitiate the evidentiary weight of the survey itself.



finding that the few positive references in the record to Native Americans as “redskin(s)” are “inconsequential in comparison to the substantial number of *undisputedly negative* historical references to Native Americans as ‘redskin(s)’ in newspapers and other writings in the record.” *Id.* at 1745, n. 116 (emphasis added). The District Court not only ignored this finding, but also reached the opposite conclusion based on faulty reasoning, as is evidenced in its statement that if “dictionary evidence only states that the term ‘redskin(s)’ is ‘often offensive,’ . . . [this] means that in certain contexts, the term ‘redskin(s)’ was not considered offensive.” *Opinion Below* at 130. The District Court clearly did not recognize the difference between a term that conveys no association, good or bad, and one that is affirmatively deemed “not offensive.”

iii. *Historical Evidence*

With respect to the “historical evidence,” the court also challenged the TTAB’s finding that “the word ‘redskins’ has virtually disappeared from spoken and written language because it is perceived by the general population as a pejorative term for Native Americans,” finding that there was no substantial evidence in the record from which the Court could have reasonably reached this conclusion. *See id.* at 131-132. In the court’s view, there was no “*concrete evidence*” to support the TTAB’s conclusion. *Id.* at 131 (“The TTAB merely assumed that because the term “redskins” dropped out of use as a term for Native Americans it must have been because the term was derogatory.”). In reaching this conclusion, the court did not identify any evidence offered by Pro-Football to support a different explanation for the virtual disappearance of the word “redskins” from spoken and written language as a reference to Native Americans.

iv. *The Testimony Of The Native American Parties*

The District Court also discounted the abundance of evidence presented that Native Americans find the term “redskins” derogatory. The District Court did not credit “the testimony

of the seven Native Americans who brought suit” on the grounds that they do not constitute a “substantial composite” of Native Americans. *Id.* at 129. Although the court suggested that the testimony of the Native American Parties was irrelevant, the court did not explain why it did not consider the testimony of the Native American Parties to be probative evidence of the views of Native Americans concerning whether the “redskins” marks may disparage Native Americans, particularly in the absence of testimony from any Native Americans to the contrary.

The District Court was able to conclude that the TTAB’s determination was flawed concerning “the views of Native Americans” only by misstating the latter. In the court’s view, the TTAB had improperly shifted the burden of proof by crediting the evidence in the record largely due to the “absence of evidence to the contrary.” *Id.* In the District Court’s view, “[t]his [was] not a case of the TTAB simply crediting un rebutted evidence ... the Ross survey and other evidence *clearly demonstrates that the views of Native Americans do not necessarily correlate with the views of the general population.*” *Id.* at 129 (emphasis added). It is evident from this statement that the District Court twisted the TTAB’s finding of fact to facilitate its conclusion. The TTAB did not find that the views of Native Americans “correlate” with the views of the general population; it found that the survey results were relevant to the question whether a substantial composite of Native Americans shared that view. In other words, the TTAB merely concluded that, in the absence of direct evidence to the contrary (*i.e.*, direct evidence that Native Americans *do not* consider the term “redskin(s)” to be offensive), the Native American Parties had met their burden of proving, by a preponderance of the evidence, that Native Americans find the term offensive.

The significance of the District Court’s error in this regard is two-fold. First, the District Court was clearly not applying a deferential standard of review but was instead reviewing the

evidence *de novo*. For example, the District Court completely discredited and disregarded, without any adequate explanation for doing so, the testimony of the actual Native Americans who brought suit. Second, and more importantly, the District Court's analysis demonstrates that the court – rather than the TTAB – improperly shifted the burden of proof by not only failing to accord deference to the TTAB's findings (including its inferences) concerning the views of Native Americans, but also by failing to recognize that, as the party seeking summary judgment on the question of disparagement, Pro-Football bore the burden of proving that there were no genuine issues of material fact and that it was entitled to judgment as a matter of law on the question of disparagement. The District Court's granting of summary judgment on this claim in Pro-Football's favor without requiring Pro-Football to present any evidence of its own rebutting the evidence in the record concerning the views of *actual* Native Americans is plain error.

In sum, the District Court did not accord the TTAB's conclusion that the "redskins" marks *may disparage* Native Americans the deference required under the "substantial evidence" test. As noted above, "the possibility of drawing two inconsistent conclusions from the evidence does not prevent an administrative agency's finding from being supported by substantial evidence." *Consolo*, 383 U.S. at 620. Instead, the court misconstrued the law by ignoring relevant evidence in the record, improperly finding important evidence to be "irrelevant," assigning improper weight to other evidence in the record and generally failing to accord deference to the TTAB's findings. Otherwise stated, the District Court generally substituted its own judgment for that of the TTAB.

### **III. The District Court Erred in Granting Summary Judgment to Pro-Football on the Defense of Laches**

The District Court should not have granted summary judgment on the defense of laches for three reasons. First, Section 14 of the Lanham Act provides that a registered mark can be

cancelled at “any time” if it was “obtained contrary to the provisions” of Section 2(a). Second, this case involves significant public interest considerations that render laches inapplicable.

Third, even if laches were held to be applicable, Pro-Football failed to establish that it was entitled to summary judgment here because a laches determination depends upon the balancing of facts that can be accomplished only after a trial on the merits.

*A. Applying Laches Contravenes Section 14 of the Lanham Act.*

Section 14 of the Lanham Act provides that a mark may be cancelled at “any time” if it was obtained contrary to Section 2(a). 15 U.S.C. §1064(3); *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 195 (1985) (recognizing that a registration “may be cancelled at any time” if obtained contrary to the provisions of Section 2). The plain meaning of the phrase “any time” dictates that laches is inapplicable to situations contemplated by Section 14(3), including registrations issued contrary to Section 2(a).<sup>14</sup> Moreover, the TTAB has repeatedly held that laches cannot be asserted to prevent the cancellation of registrations that are void *ab initio*. See *The Ohio State Univ. v. Ohio Univ.*, 51 U.S.P.Q.2d 1289, 1294 (T.T.A.B. 1999) (recognizing that

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<sup>14</sup> See also *Marshak v. Treadwell Drifters, Inc.*, 240 F.3d 184, 192-193 (3<sup>rd</sup> Cir. 2001) (stating that “the meaning of the phrase ‘any time’ in Section 14(3) is clear” and concluding that a “cancellation based on fraud, is not subject to any time limit but may be filed at ‘any time’”); *Emmpressa Cubana Del Tabaco v. Culbro Corp.*, 2002 U.S. Dist. LEXIS 21731, \*14 (following the decisions of the Trademark Trial and Appeal Board finding that the “any time” language in Section 14 “precludes a laches defense”); *The International Assoc. of Fire Chiefs, Inc. v. The H. Marvin Ginn Corp.*, 225 U.S.P.Q. 940, 947 (TTAB 1985) (noting that “the section [of the Lanham Act] which provides that [equitable] defenses may be considered and applied ‘in all inter partes proceedings . . . where [they are] applicable’ must be reconciled with other relevant statutory provisions, including the provision in Section 14(c)”) (internal citation omitted) *rev’d on other grounds* by 782 F.2d 987 (Fed. Cir. 1986); *Schenley Indus., Inc. v. Sterling Brewers, Inc.*, 157 U.S.P.Q. 593, 595 (TTAB 1968) (determining that “the equitable defenses set forth in Section 19 of the [Lanham Act] are for obvious reasons inapplicable in a proceeding involving abandonment and/or any of the other grounds for cancellation enumerated in Section 14(c)”) *rev’d on other grounds* by 441 F.2d 675 (C.C.P.A. 1971); *National Srvs. Indus., Inc. v. Turtle Wax, Inc.*, 154 U.S.P.Q. 68, 70 (TTAB 1967) (finding that laches is not applicable to “situations envisioned” by Section 14(3) of the Lanham Act).

equitable defenses should not preclude cancellation of registrations that are void *ab initio*).<sup>15</sup> In view of these well-settled principles, laches should not be applied to bar a petition to cancel based on Section 2(a) of the Lanham Act.

**B. *The Public Interests Involved in this Case Transcend the Defense of Laches.***

Laches is an equitable – not a legal – defense. It is well settled that laches will not be relied upon where there are persuasive public policy reasons that can render it inapplicable. In this case, there is a strong public interest in protecting Native Americans and the general public from racially disparaging matter.

This Court and other Courts of Appeals have held that the public interest is the most important consideration in assessing the availability of equitable remedies such as laches. *See Maryland-National Capital Park and Planting Comm'n v. U.S. Postal Srvc.*, 487 F.2d 1029, 1042 (D.C. Cir. 1973) (holding that “[e]quitable remedies depend not only on a determination of legal rights and wrongs, but on such matters as laches, good (or bad) faith, and most important an appraisal of the public interest”).<sup>16</sup>

The District Court failed to consider the public interests in this case and concluded that the public interest involved in a disparagement claim under Section 2(a) of the Lanham Act “applies to a more narrow segment of the general population than in the likelihood of confusion

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<sup>15</sup> *See also Consolidated Foods Corp. v. Big Red, Inc.*, 226 U.S.P.Q. 829, 833-34 (TTAB 1985); *Care Corp. v. Nursecare Int'l, Inc.*, 216 U.S.P.Q. 993, 995-96 (TTAB 1982).

<sup>16</sup> *See also Jarrow Formula, Inc. v. Nutrition Now, Inc.*, 304 F.3d 829, 840 (9<sup>th</sup> Cir. 2002) (citing *Maryland-National* to find that “because laches is an equitable remedy, laches will not apply if the public has a strong interest in having the suit proceed”); *Conopco, Inc. v. Campbell Soup Co.*, 95 F.3d 187, 193 (2d Cir. 1996) (requiring that public interests be considered in a laches analysis); *SunAmerica Corp. v. Sun Life Assurance Co. of Canada*, 77 F.3d 1325, 1337 (11<sup>th</sup> Cir. 1996) (rejecting the equitable defense of acquiescence because “[s]omeone must suffer the remedy, and law demands it not be the public”); *Gasser Chair Co., Inc. v. Infanti Chari Manuf. Corp.*, 60 F.3d 770, 773 (Fed. Cir. 1995) (recognizing that even where undue delay has been established, laches will not apply if it would result in inequity).

cases.” *Opinion Below* at 138. The Native American Parties acknowledge that not all Section 2(a) Lanham Act disparagement cases involve a public interest. For example, a mark that disparages an individual may not involve a public interest. In the present case, however, two significant public interests are involved, namely: (1) shielding a significant segment of the population – Native Americans – from public ridicule; and (2) the protection of the general public from racially disparaging matter.

1. The Public Policy in Protecting Racial Minorities, Particularly Native Americans, from Discrimination and Disparagement is Sufficiently Strong to Trump the Application of Laches

The public policy in favor of protecting minorities from discrimination or disparagement is manifest in the Supreme Court’s interpretation of the Equal Protection Clause as requiring the strictest form of judicial scrutiny when reviewing laws affecting “discrete and insular minorities.” *United States v. Carolene Prods. Co.*, 304 U.S. 144, 153 (1938). Strict scrutiny is applied to cases involving racial minorities because such groups have been “saddled with ... disabilities, or subjected to such a history of purposeful unequal treatment, or relegated to such a position of political powerlessness as to command extraordinary protection from the majoritarian political process.” *San Antonio Indep. School Dist. v. Rodriguez*, 411 U.S. 1, 28 (1973).<sup>17</sup>

Barring the laches defense in this case is particularly compelling because Pro-Football’s marks disparage *Native Americans*. Native American people have historically been

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<sup>17</sup> See also *Washington v. Seattle School District No. 1*, 458 U.S. 457, 486 (1982) (noting “the judiciary’s special role in safeguarding the interests of those groups that are ‘relegated to such a position of political powerlessness as to command extraordinary protection from the majoritarian political process’”) (citations omitted); *Sugarman v. Dougall*, 413 U.S. 634, 642 (1973) (identifying alienage as a suspect classification requiring strict judicial scrutiny because aliens are a “discrete and insular minority”); *Graham v. Richardson*, 403 U.S. 365, 372 (1971) (recognizing that “classifications based on alienage, like those based on nationality or race, are inherently suspect and subject to close judicial scrutiny”) (citations omitted); See, e.g., *Padula v. Webster*, 822 F.2d 97, 102 (D.C. Cir. 1987); *United States v. Cohen*, 733 F.2d 128, 135 (D.C. Cir. 1984).

geographically and culturally isolated from other populations and, therefore, extremely disadvantaged in terms of seeking to use majoritarian political or economic processes to protect themselves from societal abuse. The federal government has long recognized the unique status of Native Americans and the need to afford special protections to this racial minority. Chief Justice Marshall characterized this relationship as “resembl[ing] that of a ward to his guardian” and stated that Native Americans “look to our government for protection [and] rely upon its kindness and its power.” *Cherokee Nation v. Georgia*, 30 U.S. 1, 17 (1831); *see also Worcester v. Georgia*, 31 U.S. 515, 555 (1832) (stating that “the Cherokee Nation is under the protection of the United States of America”).<sup>18</sup>

To protect Native Americans, the courts have developed canons of legal interpretation dictating that “[d]oubtful expressions are to be resolved in favor of the weak and defenseless people who are wards of the nation, dependent upon its protection and good faith.” *Carpenter v. Shaw*, 280 U.S. 363, 367 (1930). *See also Tulee v. Washington*, 315 U.S. 681, 684-685 (1942) (concluding that “[i]t is our responsibility to see that the terms of the treaty are carried out... in a spirit which generously recognizes the full obligation of this nation to protect the interests of a dependent people”) (citations omitted); *United States, as Guardian of the Hualpai Indians of Arizona v. Santa Fe Pacific Railroad Co.*, 314 U.S. 339, 354 (1941) (announcing that “the rule of construction recognized without exception for over a century has been that ‘doubtful expressions

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<sup>18</sup> *Elk v. Wilkins*, 112 U.S. 94, 99 (1884) (noting that “[t]he members of [the Indian] tribes ... were in a dependent condition, a state of pupilage, resembling that of a ward to his guardian”); *United States v. Rickert*, 188 U.S. 432, 437 (1903) (concluding that “[t]hese Indians are yet wards of the Nation, in a condition of pupilage or dependency, and have not been discharged from that condition”); *Morton v. Mancari*, 417 U.S. 535, 551 (1974) (recognizing “the unique legal status of Indian tribes under federal law and upon the plenary power of Congress, based on a history of treaties and the assumption of ‘guardian-ward’ status, to legislate on behalf of federally recognized Indian tribes”); *Morton v. Ruiz*, 415 U.S. 199, 236 (1974) (noting that “[t]he overriding duty of our Federal Government to deal fairly with Indians wherever located has been recognized by this Court on many occasions”).

are to be resolved in favor of the weak and defenseless people who are wards of the nation, and dependent wholly upon its protection and good faith”). In this case, where the fairness of applying the equitable doctrine of laches is indeed very “doubtful,” the responsibility of the federal courts to protect Native Americans presents a strong public interest for disallowing a laches defense.

2. Protecting the General Public From Racially Disparaging Matter is a Significant Public Interest that Should Bar Pro-Football’s Laches Defense

Permitting a laches defense in this case would also conflict with the interest of the general public to live in a society free of racial prejudice. The United States has long acknowledged the detrimental effects of racial prejudice upon those who are not the targets of prejudice, and has worked diligently to eliminate such prejudice to better society as a whole. *See Bob Jones Univ. v. United States*, 461 U.S. 574, 592 (1983) (announcing that “there can be no doubt that the activity involved [racially discriminatory admissions practices by a private institution of higher education] is contrary to a fundamental public policy... against racial discrimination”); *Linmark Assoc. v. Township of Willingboro*, 431 U.S. 85, 94 (1977) (acknowledging that “[t]his Court has expressly recognized that substantial benefits flow to both whites and blacks from interracial association and that Congress has made a strong national commitment to promote integrated housing”) (citations omitted); *Hirabayashi v. United States*, 320 U.S. 81, 99 (1943) (emphasizing that “[d]istinctions between citizens solely because of their ancestry are by their very nature odious to a free people whose institutions are founded upon the doctrine of equality”).<sup>19</sup>

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<sup>19</sup> *See also Sambo’s Rests., Inc. v. City of Ann Arbor*, 663 F.2d 686, 695 (6<sup>th</sup> Cir. 1981) (recognizing that “racial harmony and equality is a substantial state interest”); *Higgins v. Grand Rapids Bd. of Education*, 508 F.2d 779, 795 (6<sup>th</sup> Cir. 1974); *Hart v. Cmty. School Bd. of Brooklyn*, 383 F. Supp. 699, 732 (E.D.N.Y. 1974) (quoting *Oliver et al. v. Kalamazoo Bd. of*

(continued...)



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3. It Was Unreasonable For Pro-Football To Rely On Native Americans' Delay In Bringing The Petition To Cancel

To prevail on a laches defense, a defendant must establish that its reliance on the plaintiff's inaction was reasonable. *See N.A.A.C.P.*, 753 F.2d at 138-139. Pro-Football cannot argue that it has “reasonably” relied on the silence of the Native American Parties because the Native American Parties have not, in fact, been silent.

The District Court also erred in considering the length of the use of the REDSKINETTES mark. It is well-settled that use of a mark is irrelevant to whether a plaintiff delayed in bringing a cancellation proceeding. *See Lincoln Logs*, 971 F.2d at 734 (stating that equitable defenses “[a]s applied in trademark opposition or cancellation proceedings . . . must be tied to a party’s registration of a mark, not to a party’s use of the mark”); *National Cable Television Assoc., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1581 (Fed. Cir. 1991) (holding that in assessing the issue of laches, delay is not to be measured from the date of knowledge of use but from “knowledge of the application for registration”). In a cancellation proceeding, a delay for the purpose of laches is measured from the date the mark was published in the *Official Gazette* for opposition. *See National Cable Television Assoc.*, 19 U.S.P.Q.2d at 1432.

The PTO published Reg. No. 1,606,810 – REDSKINETTES on March 24, 1990 and issued a certificate of registration on July 17, 1990. The Native American Parties petitioned to cancel this registration on October 5, 1992 – less than two years after it was published. A delay of less than two years before filing a petition to cancel can hardly constitute a “substantial delay.”

CONCLUSION

For the foregoing reasons, this Court should reverse the District Court's grant of summary judgment to Pro-Football.

Respectfully submitted,

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July 27, 2004

CERTIFICATE OF SERVICE

I, Philip J. Mause, counsel for Appellants Suzan S. Harjo, et al., hereby certify that copies of the Brief for Appellant were served by U.S. mail, postage prepaid, this 27<sup>th</sup> day of July, 2004, on the following:

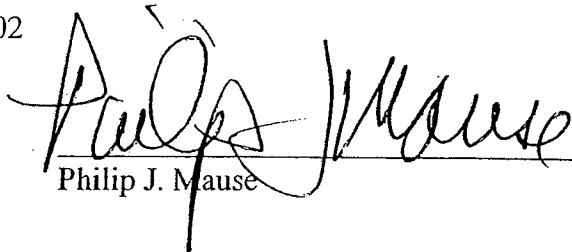
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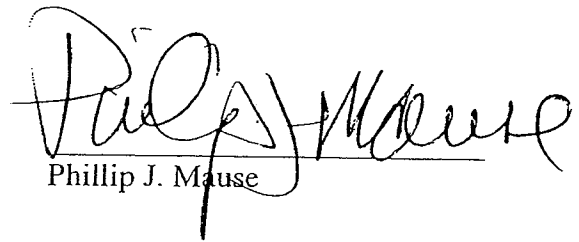
  
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CERTIFICATE OF COMPLIANCE

Pursuant to Federal Rule of Appellate Procedure 32(a)(7), the undersigned certifies that this brief complies with the type-volume limitations of Federal Rules of Appellate Procedure 32(a)(7)(B)(i) and Circuit Rule of Appellate Procedure 32(a)(1)-(2):

1. Exclusive of the exempted portions of the brief, as provided in Federal Rule of Appellate Procedure 32(a)(7)(B)(iii) and Circuit Rule of Appellate Procedure 32(a)(2), the appellant's brief includes 13,962 words.

2. This brief has been prepared in proportionally spaced typeface using Microsoft Word 2002 in Times New Roman 12 point font. As permitted by Federal Rule of Appellate Procedure 32(a)(7)(C), the undersigned has relied upon the word count of this word-processing system in preparation of this certificate.

  
Phillip J. Mause

July 27, 2004

## **ADDENDUM – STATUTES & REGULATIONS**

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UNITED STATES CODE SERVICE  
TITLE 5. GOVERNMENT ORGANIZATION AND EMPLOYEES  
PART I. THE AGENCIES GENERALLY  
CHAPTER 7. JUDICIAL REVIEW

5 USCS § 706 (2004)

§ 706. Scope of review

To the extent necessary to decision and when presented, the reviewing court shall decide all relevant questions of law, interpret constitutional and statutory provisions, and determine the meaning or applicability of the terms of an agency action. The reviewing court shall—

- (1) compel agency action unlawfully withheld or unreasonably delayed; and
- (2) hold unlawful and set aside agency action, findings, and conclusions found to be—
  - (A) arbitrary, capricious, an abuse of discretion, or otherwise not in accordance with law;
  - (B) contrary to constitutional right, power, privilege, or immunity;
  - (C) in excess of statutory jurisdiction, authority, or limitations, or short of statutory right;
  - (D) without observance of procedure required by law;
  - (E) unsupported by substantial evidence in a case subject to sections 556 and 557 of this title or otherwise reviewed on the record of an agency hearing provided by statute; or
  - (F) unwarranted by the facts to the extent that the facts are subject to trial de novo by the reviewing court.

In making the foregoing determinations, the court shall review the whole record or those parts of it cited by a party, and due account shall be taken of the rule of prejudicial error.



UNITED STATES CODE SERVICE  
TITLE 15. COMMERCE AND TRADE  
CHAPTER 22. TRADEMARKS  
THE PRINCIPAL REGISTER

15 USCS § 1052 (2004)

§ 1052. Trademarks registrable on the principal register; concurrent registration  
No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--

(a) 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; or 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 is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO Agreement (as defined in section 2(9) of the Uruguay Round Agreements Act [19 USCS § 3501(9)]) enters into force with respect to the United States.

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

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

(d) Consists of or comprises a mark which so resembles a mark registered in the Patent and Trademark 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 of the applicant, to cause confusion, or to cause mistake, or to deceive: Provided, That if the Director determines that confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce prior to (1) the earliest of the filing dates of the applications pending or of any registration issued under this Act; (2) July 5, 1947, in the case of registrations previously issued under the Act of March 3, 1881, or February 20, 1905, and continuing in full force and effect on that date; or (3) July 5, 1947; in the case of applications filed under the Act of February 20, 1905, and registered after July 5, 1947. Use prior to the filing date of any pending application or a registration shall not be required when the owner of such application or registration consents to the grant of a concurrent registration to the applicant. Concurrent registrations may also be issued by the Director when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce. In issuing concurrent registrations, the Director shall prescribe conditions

and limitations as to the mode or place of use of the mark or the goods on or in connection with which such mark is registered to the respective persons.

(e) Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them, (2) when used on or in connection with the goods of the applicant is primarily geographically descriptive of them, except as indications of regional origin may be registrable under section 4 [15 USCS § 1054], (3) when used on or in connection with the goods of the applicant is primarily geographically deceptively misdescriptive of them, (4) is primarily merely a surname, or (5) comprises any matter that, as a whole, is functional.

(f) Except as expressly excluded in subsections (a), (b), (c), (d), (e)(3), and (e)(5) of this section, nothing herein shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made. Nothing in this section shall prevent the registration of a mark which, when used on or in connection with the goods of the applicant, is primarily geographically deceptively misdescriptive of them, and which became distinctive of the applicant's goods in commerce before the date of the enactment of the North American Free Trade Agreement Implementation Act [enacted Dec. 8, 1993].

A mark which when used would cause dilution under section 43(c) [15 USCS § 1125(c)] may be refused registration only pursuant to a proceeding brought under section 13 [15 USCS § 1063]. A registration for a mark which when used would cause dilution under section 43(c) [15 USCS § 1125(c)] may be canceled pursuant to a proceeding brought under either section 14 [15 USCS § 1064] or section 24 [15 USCS § 1092].

UNITED STATES CODE SERVICE  
TITLE 15. COMMERCE AND TRADE  
CHAPTER 22. TRADEMARKS  
THE PRINCIPAL REGISTER

15 USCS § 1064 (2004)

§ 1064. Cancellation of registration

A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged, including as a result of dilution under section 43(c) [15 USCS § 1125(c)], by the registration of a mark on the principal register established by this Act, or under the Act of March 3, 1881, or the Act of February 20, 1905:

(1) Within five years from the date of the registration of the mark under this Act.

(2) Within five years from the date of publication under section 12(c) hereof [15 USCS § 1062(c)] of a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905.

(3) At any time if the registered mark becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or is functional, or has been abandoned, or its registration was obtained fraudulently or contrary to the provisions of section 4 [15 USCS § 1054] or of subsection (a), (b), or (c) of section 2 [15 USCS § 1052] for a registration under this Act, or contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used. If the registered mark becomes the generic name for less than all of the goods or services for which it is registered, a petition to cancel the registration for only those goods or services may be filed. A registered mark shall not be deemed to be the generic name of goods or services solely because such mark is also used as a name of or to identify a unique product or service. The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.

(4) At any time if the mark is registered under the Act of March 3, 1881, or the Act of February 20, 1905, and has not been published under the provisions of subsection (c) of section 12 of this Act [15 USCS § 1062].

(5) At any time in the case of a certification mark on the ground that the registrant (A) does not control, or is not able legitimately to exercise control over, the use of such mark, or (B) engages in the production or marketing of any goods or services to which the certification mark is applied, or (C) permits the use of the certification mark for purposes other than to certify, or (D) discriminately refuses to certify or to continue to certify the goods or services of any person who maintains the standards or conditions which such mark certifies:

Provided, That the Federal Trade Commission may apply to cancel on the grounds specified in paragraphs (3) and (5) of this section any mark registered on the principal register established by this Act, and the prescribed fee shall not be required. Nothing in paragraph (5) shall be deemed to prohibit the registrant from using its certification mark in advertising or promoting recognition of the certification program or of the goods or services meeting the certification standards of the registrant. Such uses of the certification mark shall not be grounds for cancellation under paragraph (5), so long as the registrant does not itself produce, manufacture, or sell any of the certified goods or services to which its identical certification mark is applied.

UNITED STATES CODE SERVICE  
TITLE 15. COMMERCE AND TRADE  
CHAPTER 22. TRADEMARKS  
THE PRINCIPAL REGISTER

15 USCS § 1071 (2004)

§ 1071. Appeal to courts

(a) Persons entitled to appeal; United States Court of Appeals for the Federal Circuit; waiver of civil action; election of civil action by adverse party; procedure.

(1) An applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancellation proceeding, a registrant who has filed an affidavit as provided in section 8 [15 USCS § 1058], or an applicant for renewal, who is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, may appeal to the United States Court of Appeals for the Federal Circuit thereby waiving his right to proceed under subsection (b) of this section: Provided, That such appeal shall be dismissed if any adverse party to the proceeding, other than the Director, shall, within twenty days after the appellant has filed notice of appeal according to paragraph (2) of this subsection, files notice with the Director that he elects to have all further proceedings conducted as provided in subsection (b) of this section. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under subsection (b) of this section, in default of which the decision appealed from shall govern the further proceedings in the case.

(2) When an appeal is taken to the United States Court of Appeals for the Federal Circuit, the appellant shall file in the Patent and Trademark Office a written notice of appeal directed to the Director, within such time after the date of the decision from which the appeal is taken as the Director prescribes, but in no case less than 60 days after that date.

(3) The Director shall transmit to the United States Court of Appeals for the Federal Circuit a certified list of the documents comprising the record in the Patent and Trademark Office. The court may request that the Director forward the original or certified copies of such documents during pendency of the appeal. In an ex parte case, the Director shall submit to that court a brief explaining the grounds for the decision of the Patent and Trademark Office, addressing all the issues involved in the appeal. The court shall, before hearing an appeal, give notice of the time and place of the hearing to the Director and the parties in the appeal.

(4) The United States Court of Appeals for the Federal Circuit shall review the decision from which the appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue its mandate and opinion to the Director, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case. However, no final judgment shall be entered in favor of an applicant under section 1(b) [15 USCS § 1051(b)] before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c) [15 USCS § 1057(c)].

(b) Civil action; persons entitled to; jurisdiction of court; status of Director; procedure.

(1) Whenever a person authorized by subsection (a) of this section to appeal to the United States Court of Appeals for the Federal Circuit is dissatisfied with the decision of the Director or Trademark Trial and Appeal Board, said person may, unless appeal has been taken to said United States Court of Appeals for the Federal Circuit, have remedy by a civil action if commenced within such time after such decision, not less than sixty days, as the Director appoints or as provided in subsection (a) of this section. The court may adjudge that an applicant is entitled to a registration upon the application involved, that a registration involved should be canceled, or such other matter as the issues in the proceeding require, as the facts in the case may appear. Such adjudication shall authorize the Director to take any necessary action, upon compliance with the requirements of law. However, no final judgment shall be entered in favor of an applicant under section 1(b) [15 USCS § 1051(b)] before the mark is registered, if such applicant cannot prevail without establishing constructive use pursuant to section 7(c) [15 USCS § 1057(c)].

(2) The Director shall not be made a party to an inter partes proceeding under this subsection, but he shall be notified of the filing of the complaint by the clerk of the court in which it is filed and shall have the right to intervene in the action.

(3) In any case where there is no adverse party, a copy of the complaint shall be served on the Director, and, unless the court finds the expenses to be unreasonable, all the expenses of the proceeding shall be paid by the party bringing the case, whether the final decision is in favor of such party or not. In suits brought hereunder, the record in the Patent and Trademark Office shall be admitted on motion of any party, upon such terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of any party to take further testimony. The testimony and exhibits of the record in the Patent and Trademark Office, when admitted, shall have the same effect as if originally taken and produced in the suit.

(4) Where there is an adverse party, such suit may be instituted against the party in interest as shown by the records of the Patent and Trademark Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same State, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs.

UNITED STATES CODE SERVICE  
TITLE 28. JUDICIARY AND JUDICIAL PROCEDURE  
PART IV. JURISDICTION AND VENUE  
CHAPTER 83. COURTS OF APPEALS

28 USCS § 1291 (2004)

§ 1291. Final decisions of district courts

The courts of appeals (other than the United States Court of Appeals for the Federal Circuit) shall have jurisdiction of appeals from all final decisions of the district courts of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, except where a direct review may be had in the Supreme Court. The jurisdiction of the United States Court of Appeals for the Federal Circuit shall be limited to the jurisdiction described in sections 1292(c) and (d) and 1295 of this title.