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INITIAL BRIEF

ORAL ARGUMENT SCHEDULED FOR DECEMBER 10, 2004

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

NO. 03-7162

SUZAN S. HARJO, ET AL.,
Appellants

v.

PRO-FOOTBALL, INC.,
Appellee

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

REPLY BRIEF FOR APPELLANTS

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SUMMARY OF ARGUMENT

Pro-Football, Inc. (“Pro-Football”) apparently agrees with the Appellants 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”) that this Court should apply the substantial evidence test in determining whether the decision of the Trademark Trial and Appeal Board (“TTAB”) should be upheld and the case should be remanded to the United States District Court for the District of Columbia (“District Court”). Because the substantial evidence test is deferential to agency decision-making and because the Native American Parties submitted voluminous evidence before the TTAB, Pro-Football, like the District Court, is reduced to arguing that almost all of the evidence is “irrelevant” because it is not “direct” evidence and that, therefore, the TTAB decision is not based upon substantial evidence. This argument is implicitly based upon a standard of “relevance” completely at odds with the well-established practice of using circumstantial evidence articulated in decisions of the TTAB and courts in previous trademark cases. Pro-Football endorses the District Court’s position that there was no “direct” evidence without defining exactly what evidence it would accept as “direct” and without describing how the evidence in this case is less “direct” than evidence used in other disparagement cases and in trademark cases in general. Nothing in Pro-Football’s brief refutes the Native

American Parties' argument that the evidence in this case easily satisfies the substantial evidence standard.

The Native American Parties are not barred by judicial estoppel from arguing that the views of the general public are relevant to a determination of whether the "redskins" marks are disparaging because they are not taking a position that is inconsistent with one they successfully asserted before the TTAB or the District Court.

The Native American Parties' Opening Brief demonstrated that laches should not be applied in this case. Further, the Native American Parties showed that, even if laches is applicable, there must be an assessment and balancing of interests which inherently requires fact finding and, therefore, laches should not be resolved on summary judgment. Pro-Football's brief fails to identify any precedent for the application of laches in a case involving the disparagement of an entire group of people, registrations challenged pursuant to Section 14(3) and void *ab initio* registrations. Even were laches held to be applicable, Pro-Football's brief fails to explain why the case should not have been remanded to the TTAB and why there is not, at a minimum, a triable issue of fact as to the Native American Parties' delay and harm to Pro-Football given the explicit representation by the current ownership in the purchase agreement that the TTAB decision was not a "Seller Material Adverse Effect." In addition, Pro-Football's brief ignores the public

interest in avoiding the disparagement of an entire ethnic group and the need to balance that public interest against whatever harm Pro-Football can actually demonstrate in an evidentiary hearing.

ARGUMENT

I. THIS COURT SHOULD REJECT PRO-FOOTBALL'S ARGUMENT THAT THE TTAB DECISION IS REVERSIBLE BECAUSE IT IS NOT BASED UPON DIRECT EVIDENCE

A. *Direct Evidence Is Not Required*

Pro-Football endorses the District Court's view that, because there was "no direct evidence" of disparagement, the TTAB's decision was not based upon substantial evidence. (Appellee's Br. at 19); *Pro-Football, Inc. v. Harjo*, 284 F. Supp.2d 96, 127 (D.D.C. 2003) (emphasis in original). Pro-Football also belatedly suggests that some unidentified portion of the evidence was inadmissible (Appellee's Br. at 28 n. 19), and criticizes the TTAB for the inferences the TTAB drew from the evidence despite the well-established body of law that the TTAB has broad discretion to make just such inferences. (Appellant's Br. at 20-22). Neither Pro-Football nor the District Court explain why the TTAB's reliance on appropriately drawn inferences from circumstantial evidence, as opposed to "direct" evidence, is not appropriate in this case, nor, indeed does either define what would constitute "direct" evidence.¹

¹ It is unclear what evidence Pro-Football would concede to be "direct." Apart from the production of hundreds of thousands of notarized affidavits executed by Native Americans on the precise dates the trademarks were registered and attesting that the individual finds the marks disparaging, virtually any type of evidence would have to be accompanied by some level of inference in order to show disparagement.

In insisting upon “direct” evidence, Pro-Football repeatedly misstates the Native American Parties’ position and misleadingly accuses the Native American Parties of “shifting strategy” (Appellee’s Br. at 23) or changing their position. The Native American Parties have not “shifted strategy” or changed their position. The Native American Parties agree now and have always agreed that the ultimate issue is whether the “redskins” marks as used disparaged Native Americans at the time they were registered. But the Native American Parties also take the position now and have always taken the position that evidence of the general public’s understanding of the term “redskins,” evidence that the term “redskins” is generally disparaging or offensive, evidence that the “redskins” marks as used by Pro-Football have carried reference to Native Americans rather than to, for example, redskin potatoes, and protests by Native American individuals and groups of the use of the “redskins” marks are all relevant to that ultimate issue. For example, evidence that the term “redskins” is and has been generally viewed as a derogatory epithet for Native Americans as a group is clearly relevant to the issue of whether trademarks containing that very word as well as a profile of a Native American with a spear disparage Native Americans.² Pro-Football obfuscates the

² In this regard, the Native American Parties’ Opening Brief submitted that “no trademark applicant has ever succeeded in successfully persuading the TTAB or a court that a derogatory epithet or name for a group can be included in a trademark without rendering the trademark disparaging.” (Appellant’s Br. at 27-28). It is revealing that the Appellee’s Brief provided no examples to the contrary.

issue by misstating the Native American Parties' position on the ultimate issue and has not answered the Native American Parties' argument that such evidence is relevant.

Pro-Football has no good answer to the Native American Parties' argument that the above evidence is relevant. There is no rule of law that "direct" evidence is required or that circumstantial evidence cannot be considered in trademark cases, nor has Pro-Football cited a trademark case where a party was not allowed to support its case with circumstantial evidence. In fact, the disposition of trademark cases has long turned on the TTAB's and federal courts' reliance on circumstantial evidence to determine issues such as dilution, acquired distinctiveness and likelihood of confusion. *See, e.g., Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 434 (2003) ("It may well be, however, that direct evidence of dilution such as consumer surveys will not be necessary if actual dilution can reliably be proven through circumstantial evidence."); *Bose Corp. v. QSC Audio Prods., Inc.*, 293 F.3d 1367, 1371 (Fed. Cir. 2002) ("Direct evidence of fame, for example from widespread consumer polls, rarely appears in contests over likelihood of confusion . . . [i]nstead, our cases teach that the fame of a mark may be measured indirectly."); *Beacon Mutual Ins. Co. v. Onebeacon Ins. Group*, 376 F.3d 8, 17 (1st Cir. 2004) ("In the Title VII context, the Supreme Court has expressly rejected a direct evidence requirement, instead applying the conventional

rule that a plaintiff may amass a preponderance of the evidence through direct or circumstantial evidence. . . . We see no reason for applying a different rule in the trademark context.”). *See also Heartland Bank v. Heartland HomeFinance, Inc.*, 335 F.3d 810, 822 (8th Cir. 2003) (finding the district court’s insistence on direct evidence improper -- “[t]here is no specific event or action to be proved by direct evidence; the likelihood that purchasers will be confused must ultimately rest on the inference to be drawn from circumstantial evidence”) (Smith, J. concurring); *J. Thomas McCarthy, 2 McCarthy on Trademarks and Unfair Competition* § 15:30 at 15-47 (4th ed. 2004) (“[S]urvey data is not a requirement and secondary meaning can, and most often is, proven by circumstantial evidence.”).

Further, in previous TTAB decisions finding disparagement or scandalousness, the TTAB clearly relied on circumstantial evidence. *See, e.g., Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1639-40 (T.T.A.B. 1988) (relying on evidence of many years of use submitted by opposer); *Doughboy Indus., Inc. v. Reese Chem. Co.*, 88 U.S.P.Q. 227, 228 (PTO 1951) (looking at applicant’s specimen of use); *In re Reemtsma Cigarettenfabriken GmbH*, 122 U.S.P.Q. 339 (T.T.A.B. 1959) (relying on *Encyclopedia Britannica* entry); *see also In re Riverbank Canning Co.*, 95 F.2d 327, 328-29 (C.C.P.A. 1938) (finding “scandalousness” in reliance upon dictionary definitions and “common knowledge”).

In apparent contradiction of this long line of cases, Pro-Football attacks the TTAB for reaching a decision in favor of the Native American Parties without the benefit of any “direct” evidence on the question of disparagement. This is clearly not what trademark law requires; Pro-Football cannot turn years of trademark jurisprudence on its head by now asserting, without citing any authority, that circumstantial evidence cannot be considered in assessing the issue of whether a trademark is disparaging under 15 U.S.C. § 1052(a) (2004) (“Section 2(a)”).

The weakness of Pro-Football’s argument that the evidence the TTAB considered was irrelevant is revealed by Pro-Football’s own conclusion that “there was almost no proof of disparagement at the TTAB” (Appellant’s Br. at 39) (emphasis supplied), implicitly conceding that this case involves the balancing of relevant, but conflicting evidence.³ The decision of how to weigh and balance such conflicting evidence is clearly within the discretion of the TTAB.

B. Consideration of the Views of the General Public Are Not Barred By Judicial Estoppel

Pro-Football asserts that “Appellants are barred by judicial estoppel” from arguing that the views of the general public are relevant to a determination of whether the “redskins” marks are disparaging because they have assumed a “contrary position” to a position taken below. (Appellee’s Br. at 24). But Pro-

³ See also Appellee’s Br. at 28-29 complaining of “a dearth of evidence, certainly not substantial” that the trademarks were disparaging in the relevant time frame.

Football cites no evidence that the Native American Parties have ever advanced the opposite position before the TTAB or the court below. Once again, Pro-Football seeks to confuse matters by equating the Native American Parties' consistent agreement that the ultimate issue is the perception of Native Americans with Pro-Football's assertion that the perception of the general public is completely irrelevant. The Native American Parties have never taken the position that the perception of the general public is irrelevant; judicial estoppel is clearly inapplicable.⁴

Pro-Football's further assertion that the general public's views that a term used in a trademark is disparaging should be rejected as irrelevant by the TTAB under *In re Hines*, 31 U.S.P.Q.2d 1685 (T.T.A.B. 1994) is untenable. The facts surrounding the views of the general public in *In re Hines* (reliance on general public's views to show a mark was not disparaging where views of the allegedly disparaged group were not of record) are clearly distinguishable from the facts in the instant case (consideration of the general public's views to show a mark was disparaging where views of the allegedly disparaged group were also of record).

⁴ Even if the Native American Parties had changed their position, judicial estoppel would likely be inapplicable here. *See, e.g., United Mine Workers of Am. 1974 Pension v. Pittston Co.*, 984 F.2d 469, 477-78 n.12 (D.C. Cir. 1993) (declining to apply the doctrine of judicial estoppel in favor of a determination on the facts as ultimately presented); *Am. Methyl Corp. v. EPA*, 749 F.2d 826, 833 n.44 (D.C. Cir. 1984) (stating that the Court is wary of the doctrine of judicial estoppel because it does not conform with the judicial process and the rules of pleading).

Thus, isolated statements made by the TTAB in *In re Hines* cannot be applied out of context. Pro-Football also ignores the very relevant explanation provided by the TTAB in its decision below, applying its own precedent in *In re Hines* to the facts of the instant case, that “if allegedly disparaging matter provokes a widespread *negative* societal reaction, it is reasonable to infer that the relevant group will, similarly, perceive the matter to be disparaging.” *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1739 n.99 (T.T.A.B. 1999) (the “*TTAB Decision*”).⁵ This finding does not contradict the TTAB’s conclusions in any other case or context, including the cases cited in Pro-Football’s brief. *See Order of Sons of Italy in Am. v. Memphis Mafia, Inc.*, 52 U.S.P.Q.2d 1364, 1369 (T.T.A.B. 1999) (noting that evidence had not been submitted that the word “Mafia” was offensive or disparaging *per se* to any ethnic group, thus distinguishing its decision in *Harjo*, and articulating the only reason for its rejection of a public opinion survey as “no mention was made of the term ‘Mafia’”); *In re In Over Our Heads, Inc.*, 16 U.S.P.Q.2d 1653, 1654 (T.T.A.B. 1990) (finding applicant’s use of term “Moonies” non-disparaging because the mark at issue would not be perceived by the public to reference members of an allegedly disparaged group).

⁵ Further, it is contradictory for Pro-Football to argue that the perceptions of the general public are irrelevant to a determination of whether a mark is disparaging and then to cite as “best record evidence” of its position on the registrability of the term “redskins” the views of the United States Patent and Trademark Office’s Trademark Examining Attorneys. The Examining Attorneys in this instance are members of the very public whose views Pro-Football asserts to be “irrelevant.”

C. *Pro-Football's Argument that the TTAB's Findings Can be Disregarded Because Some of Them are not Labeled "Findings of Fact" is Without Legal Support*

As the Native American's Opening Brief demonstrated, the TTAB's opinion contains numerous findings and a reasonable explanation of how it reached the conclusion that the trademarks were disparaging based on the evidence before it.

These findings include, for example, the following:

- We find these [survey] results supportive of the other evidence in the record indicating the derogatory nature of the word "redskin(s)" for the entire period from, at least, the mid-1960's to the present, to substantial composites of both the general population *and the* Native American population. *TTAB Decision* at 1746 (emphasis added).
- Thus, from the fact that usage labels appear in approximately half of the dictionaries of record at any point in the time period covered, we can conclude that a not insignificant number of Americans [including Native Americans] have understood "redskin(s)" to be an offensive reference to Native Americans since at least 1966. *Id.* at 1744.⁶
- At the same time, we find that, in determining the meaning of the term "redskin(s)" as it appears in respondent's registered marks, it would be both factually incomplete and disingenuous to ignore the substantial evidence of Native American imagery used by respondent. *Id.* at 1746.
- Thus, we conclude that the 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 respondent's marks in connection with the

⁶ Pro-Football's remark that the term "offensive" in usage labels has no bearing on whether the term is disparaging is disingenuous in its implication that language used by lexicographers must parallel language in the Lanham Act to be relevant.

identified services, such that respondent's marks may be disparaging of Native Americans to a substantial composite of this group of people. *Id.* at 1748.

Pro-Football argues that all findings not labeled "findings of fact" must be disregarded and cites *Motor Vehicle Mfgs. Ass'n of the United State v. State Farm Mutual Auto. Ins. Co.*, 463 U.S. 29, 43 (1983) and *Lozowski v. Mineta*, 292 F.3d 840, 845 (D.C. Cir. 2002). But *Motor Vehicle* applied the "arbitrary and capricious" standard and merely held that an agency must "articulate a satisfactory explanation for its action." *Id.* at 42- 43. The Supreme Court found that the agency failed to supply "the requisite reasoned analysis." *Id.* at 57 (internal quotations omitted). Notably, the Supreme Court remanded the case to the Circuit Court with directions to remand the matter to the agency for further consideration. *See id.* At no point did the Supreme Court suggest that agency findings should be disregarded merely because they are not labeled "findings of fact." The Court's opinion also indicates that, in the event an agency explanation of its reasoning process is unclear,⁷ the remedy is a remand to the agency. *Lozowski* is a decision of this Court reversing a decision of Judge Kollar-Kotelly which reversed a decision of the Department of Transportation. It is unclear why Pro-Football asserts that this decision supports its position, as the D.C. Circuit decision affirms

⁷ *See* Pro-Football's implication that the TTAB's lack of clarity requires parties and courts to be "clairvoyants." (Appellee's Br. at 20, n. 13).

an agency ruling and does not, in any way, suggest that agency findings have to be labeled “findings of fact.” The TTAB’s decision meets the standard for “reasoned analysis” set forth in *Motor Vehicle*. Even if this Court concludes that it does not meet this standard, the appropriate remedy would be a remand to the district court with instructions to remand to the TTAB.

II. LACHES IS INAPPLICABLE TO SECTION 2(A) DISPARAGEMENT CASES

A. *Bridgestone* is Distinguishable from This Case

1. This is a Disparagement Case Involving a Public Interest Whereas *Bridgestone* was a False Suggestion Case Involving a Private Interest

Pro-Football relies on *Bridgestone/Firestone Research, Inc. v. Auto. Club de L'Ouest de la France*, 245 F.3d 1359 (Fed. Cir. 2001) to support its assertion that laches is available as a defense to the Native American Parties’ cancellation petition. But, as recognized by Pro-Football, *Bridgestone* is a false suggestion case involving a private interest. There is no precedent for applying *Bridgestone* to a disparagement case dealing with public interests. Indeed, the *Bridgestone* court recognized this distinction, pointing out that the application of laches to a false suggestion case is appropriate *because* a public interest is *not* involved. *See id.* at 1363. In contrast, this case involves substantial public interests, namely protecting the Native Americans from public ridicule and shielding the general public from disparaging matter (*see* Appellant’s Br. at 35-38). While it is conceivable that a

disparagement suit could involve a private right, as in the case of a trademark that disparages an individual person or entity, that is clearly not the case here.

2. The Parties in *Bridgestone* were Individual Entities, but in this Case, the Native American Parties Represent a Continually Expanding Group of People

Bridgestone is further distinguishable because the Native American Parties are members of a constantly expanding group of potential plaintiffs. Indeed, each case following *Bridgestone* (other than the *Opinion Below*) involves only individual parties. But this case involves the disparagement of a large group of people, Native Americans. The group is constantly expanding with the birth and coming of age of additional Native Americans, all of whom are disparaged by Pro-Football's marks. Thus, for example, plaintiff Mateo Romero was only a year old when Pro-Football's first registration issued.

In cases such as this where the number of injured parties increases daily, the courts have rejected laches or applied it sparingly. For example, in the environmental arena the courts have held that "laches must be invoked sparingly . . . because ordinarily the plaintiff will not be the only victim of alleged environmental damage." See *Daingerfield Island Protective Society v. Lujan*, 920 F.2d 32, 37 (D.C. Cir. 1990) (quoting *Preservation Coalition, Inc. v. Pierce*, 667

F.2d 851, 854 (9th Cir. 1982)) (internal quotations and citation omitted).⁸ Further, there is a long-standing principle in tort and property law that “the statute of limitations and laches do not run against the public right.” *Restatement (Second) of Torts* §821C, Comment (e) (1979).⁹

B. Pro-Football Fails to Address the Precedent Holding that Laches is Not Applicable to Registrations Challenged Pursuant to Section 14(3) and Void Ab Initio Registrations.

Pro-Football criticizes the Native American Parties’ discussion of *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1985), arguing that the case does not involve Section 2(a), but deals with a petition to cancel a mark on mere descriptiveness grounds. But *Park ‘N Fly* recognizes that incontestable registrations can be cancelled “at any time” under the grounds enumerated in Section 14(3). *See id.* at 194-95. One of the grounds enumerated in Section 14(3) is that an incontestable registration can be challenged if obtained contrary to

⁸ To date, at least 10 of 13 federal courts of appeal have embraced this approach. *See, e.g., Ocean Advocates v. U.S. Army Corps of Eng’rs.*, 361 F.3d 1108, 1121-22 (9th Cir. 2004); *Park County Resource Council v. USDA*, 817 F.2d 609, 617 (10th Cir. 1987).

⁹ This rule has been recognized in both federal and state courts. It is an old principle of state law and at least 19 state supreme courts have explicitly adopted this rule. *See, e.g., Norfolk and W. Ry Co. v. Waselchalk*, 421 S.E.2d 424, 425 (Va. 1992) (holding that “no prescriptive right can be acquired in property affected with a public interest or dedicated to a public use”) (citation and internal quotations omitted); *Strong v. Sullivan*, 181 P.2d 59, 60 (Cal. 1919) (concluding that “[n]o lapse of time can legalize a public nuisance”); *City of Deadwood v. Hursh*, 138 N.W. 1122, 1123 (S.D. 1912) (same); *see also NRDC, Inc. v. Fox*, 909 F. Supp. 153, 160 (S.D.N.Y. 1995) (finding that “laches is no defense in a suit to enforce a public right or to protect the public interest”).

Section 2(a). See 15 U.S.C. § 1064(3) (2004). Indeed, *Park 'N Fly* expressly acknowledges 2(a) as an available ground for challenging an incontestable registration. See *Park 'N Fly*, 469 at 195. Thus, it is clear that the instant case – in which the “redskins” marks are challenged because they were obtained contrary to Section 2(a)¹⁰ – comes within the grounds enumerated in Section 14(3).

Pro-Football fails to address the cases cited by the Native American Parties interpreting this “at any time” language to preclude the application of laches to Section 14(3) cases. In one of the most recent cases finding laches inapplicable to 14(3) cases,¹¹ the Third Circuit held: “[T]he language of subsection (3) means what it says: a petition falling within subsection (3) . . . is not subject to any time limit but may be filed ‘at any time.’” *Marshak v. Treadwell Drifters, Inc.*, 240 F.3d 184, 193 (3rd Cir. 2001). There is substantial support for this interpretation. See *id.* at 193 n.4. The “at any time” language “derives from Section 13 of the Trademark Act of 1905, 15 U.S.C. § 93” which stated “whenever any person shall deem himself injured by the registration of a trade-mark in the Patent Office he

¹⁰ Section 2(a) explicitly forbids the registration of disparaging trademarks. 15 U.S.C. § 1052.

¹¹ See also *Emmpresa Cubana Del Tabaco v. Culbro Corp.*, 2002 U.S. Dist. LEXIS 21731 *14 (S.D.N.Y. 2002) (noting that “the PTO has consistently held that the phrase ‘at any time’ precludes a laches defense”); *Int’l Ass’n of Fire Chiefs, Inc. v. H. Marvin Ginn Corp.*, 225 U.S.P.Q. 940, 947 (T.T.A.B. 1985) (applying laches to bar claims brought pursuant to 14(3) would “frustrate the clear purpose of the Trademark Act, expressed in Section [14(3)] that a registered mark may be cancelled at any time”) *rev’d on other grounds*, 782 F.2d 987 (Fed. Cir. 1986).

may at any time apply to the Commissioner of Patents to cancel the registration.” *Id.* (internal quotations omitted). Courts read the “at any time” language of the 1905 Act to “exclude[] the defense of laches in a cancellation proceeding.” *Id.*¹² Underlying these decisions is the policy that “the interest vindicated by Section 14 is not just the injury to the challenging party, but the integrity of the register.” *Id.* at 194.

Similarly, Pro-Football does not refute the Native American Parties’ argument that a void *ab initio* registration can be cancelled at any time and laches cannot bar the challenge. “The rationale behind this [proposition] is that it is within the public interest to have registrations which are void *ab initio* stricken from the register and that this interest or concern cannot be voided by the inaction of any single person or concern, no matter how long the delay persists.” *Am. Velcro, Inc. v. Charles Mayer Studios, Inc.*, 177 U.S.P.Q. 149, 156 n. 5 (T.T.A.B. 1973).¹³ Even if a mark is associated with a commercially successful business, as

¹² See also *Dwinell-Wright Co. v. National Fruit Prod. Co.*, 129 F.2d 848, 853 (1st Cir. 1942) (concluding that under the 1905 Act, laches could not be asserted as a defense in a cancellation proceeding); *White House Milk Prods. Co. v. Dwinell-Wright Co.*, 27 C.C.P.A. 1194, 1197 (C.C.P.A. 1940) (noting that despite the appellee’s delay, the defense of laches was unavailable because the statute provided that a cancellation petition could be filed “at any time”); *Cluett, Peabody & Co. v. Hartogensis*, 41 F.2d 94, 17 C.C.P.A. 1166, 1170-71 (C.C.P.A. 1930) (relying on Supreme Court precedent affirming injunctive relief despite a finding of laches to support the conclusion that the “at any time” language precluded an application of laches).

¹³ See also *Wandel Mach. Co. v. Altoona Fam, Inc.*, 133 U.S.P.Q. 410, 410-411 (T.T.A.B. 1962) (determining that a laches defense is not available where a plaintiff seeks to cancel a registration that is void *ab initio*); *W.D. Byron & Sons, Inc. v. Stein Bros. Mfg. Co.*, 146 U.S.P.Q. 313, 316 (continued...)

is the case with Pro-Football's business, this cannot validate the registration of mark that is void *ab initio*. See *Schnur & Cohan, Inc. v. Academy of Motion Picture Arts and Sciences*, 223 F.2d 478, 480 (C.C.P.A. 1955).

C. The Public Interests Asserted by Pro-Football Do Not Support the Applicability of Laches

Pro-Football argues for the maintenance of its registrations on the ground that there is a strong public policy in maintaining the registration of "technically good" marks that are still in use. But Pro-Football cites no cases in support of the continued registration of disparaging marks on this basis. Pro-Football adopted the "redskins" marks and proceeded with registration despite the statutory provision that disparaging marks are unregistrable. In other words, Pro-Football acted at its own peril in adopting the "redskins" marks. See *In re McGinley*, 660 F.2d 481, 485 n. 7 (C.C.P.A. 1981) ("The field of [available marks] is almost limitless from which to select words . . . for use as trade-marks, and one who uses debatable marks does so at the peril that his mark may not be entitled to registration.") (citing *In re Riverbank*, 95 F.2d at 329). The Native American Parties should not be penalized for Pro-Football's decision.

(..continued)

(T.T.A.B. 1965) (noting "it is well established that the equitable defense of estoppel and laches is not available to a defendant in a proceeding wherein, as here, the adverse party is claiming in essence that the mark in question inherently cannot function as a trademark under the trademark statute") *aff'd*, 377 F.2d 1001 (C.C.P.A. 1967).

Further, Pro-Football asserts that the cancellation of its registrations would involve the government penalizing free speech. To support its position, Pro-Football cites a case in which an employee sued her employer for asserting that she was fired because of her testimony before the Council of the District of Columbia contradicting her employer's position on proposed tort reform and because she testified on behalf of plaintiffs in medical malpractice cases. *See Carl v. Children's Hosp.*, 702 A.2d 159, 160 (D.C. App. 1997). The employee alleged that the public policy exception to the employee-at-will doctrine "should be expanded to include the rights of employees to speak out publicly." *Id.* at 159. *Children's Hospital* not only fails to support Pro-Football's contention, but it is hardly even relevant. The Federal Circuit has expressly rejected Pro-Football's argument: The refusal to allow the registration of a mark "does not affect [the owner's] right to use it. No conduct is proscribed, and no tangible form of expression is suppressed." *McGinley*, 660 F.2d at 484 (citation omitted).

Finally, Pro-Football asserts that the Native American Parties' are attempting to "revive" a claim under the Indian Trust Doctrine. Contrary to this assertion, the Native American Parties merely discuss the Indian Trust Doctrine as an example of the broad scope of protection that the U.S. government affords to the public interests of Native Americans.

III. EVEN IF THE DISTRICT COURT PROPERLY DECIDED THAT LACHES IS APPLICABLE TO THIS CASE, IT WAS REQUIRED TO REMAND THE CASE TO THE TTAB

Pro-Football cites no authority (other than the *Opinion Below*) for the proposition that it was proper for the District Court to determine the laches issue. In their appellate brief, the Native American Parties clearly explain that the District Court had two proper options for disposing of the laches claim: 1) conduct a full trial on the merits or 2) remand the case to the TTAB for factual findings. The Native American Parties supported this position by citing extensive precedent establishing that courts disfavor a resolution of laches on summary judgment because of the issue's intensely factual nature. (See Appellants' Br. at 39, n. 20). Moreover, there is ample authority supporting the assertion that when a court is reviewing an administrative agency decision and determines that the agency made an error of law such as not considering an applicable defense, it is proper, even required, that the reviewing court remand the case. This court has confirmed that "[w]hether it is a court of appeals or a district court, 'under settled principles of administrative law, when a court reviewing agency action determines that an agency made an error of law, the court's inquiry is at an end: the case must be remanded to the agency for further action consistent with the corrected legal standards.'" *County of Los Angeles v. Shalala*, 192 F.3d 1005, 1011 (D.C. Cir.

1999) (citations omitted).¹⁴ The Federal Circuit – a court that routinely hears appeals from the TTAB -- has also confirmed this principle¹⁵ and, in fact, frequently remands under such circumstances.¹⁶ The District Court should have followed this precedent and remanded the case to the TTAB to consider whether Pro-Football had established the elements of a laches defense.

IV. THE DISTRICT COURT IMPROPERLY GRANTED SUMMARY JUDGMENT BECAUSE GENUINE ISSUES OF MATERIAL FACT RELATED TO LACHES ARE STILL IN DISPUTE

A. Substantial Delay

1. REDSKINETTES

Pro-Football argues that for purposes of a laches determination, the REDSKINETTES mark is substantially similar to REDSKINS. In support of this

¹⁴ See also *I.N.S. v. Ventura*, 537 U.S. 12, 17 (2002) (recognizing that “when Congress has exclusively entrusted [an issue] to an administrative agency . . . ‘the proper course, except in rare circumstances, is to remand to the agency for additional investigation or explanation’”) (citations omitted); *NLRB v. Enters. Ass’n of Steam, Hot Water, Hydraulic Sprinkler, Pneumatic Tube, Ice Mach. & Gen. Pipefitters of N.Y. and Vicinity*, 429 U.S. 507, 522 n.9 (1977) (“When an administrative agency has made an error of law, the duty of the Court is to ‘correct the error committed by that body, and after doing so to remand the case to the [agency] so as to afford it the opportunity of examining the evidence and finding the facts as required by law’”) (quoting *ICC v. Clyde S.S. Co.*, 181 U.S. 29, 32-33 (1901)).

¹⁵ See *Int’l Light Metals v. United States*, 279 F.3d 999, 1003 (Fed. Cir. 2002).

¹⁶ See, e.g., *In re Cal. Innovations, Inc.*, 329 F.3d 1334, 1335 (Fed. Cir. 2003) (remanding because the TTAB “applied an outdated standard in its analysis under § 1052(e)(3)”; *Amalgamated Bank of N.Y. v. Amalgamated Trust & Sav. Bank*, 842 F.2d 1270, 1275 (Fed. Cir. 1988) (remanding because “the TTAB erred in applying the proper legal standard to the concurrent use registrability” of the mark at issue); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316, 1324 (Fed. Cir. 1983) (remanding to the TTAB for consideration of appellee’s estoppel defense because the TTAB had incorrectly refused to consider it).

position, Pro-Football cites *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 U.S.P.Q. 585 (T.T.A.B. 1977). The *Copperweld* case is, however, distinguishable in that the marks at issue differed by only one letter (ASTRALLOY v. ASTRALLOY-V) and the goods identified by the marks were identical. *See id.* at 588, 592. Here, the differences between the marks are more pronounced; the addition of the suffix “ette” creates a mark visually and aurally distinguishable from REDSKINS. The “ette” suffix also connotes something feminine – a connotation that does not extend to the REDSKINS mark. Further the services covered by the REDSKINS and REDSKINETTES marks are different. (*See* Appellant’s Br. at 44). In view of these significant differences, the REDSKINETTES mark can hardly be considered substantially similar to REDSKINS.

In addition, Pro-Football reiterates its argument that the Native American Parties delayed in petitioning to cancel the REDSKINETTES mark because the mark was in use since 1962. But the law is clear that use of a mark is irrelevant when considering laches in the context of a cancellation proceeding. *See Nat’l Cable Television Ass’n, Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1581 (Fed. Cir. 1991). Pro-Football did not cite any cases (other than the *Opinion Below*) to the contrary.

2. Mateo Romero

As discussed in Section II.A.2 above, imputing a substantial delay to Mateo Romero unfairly ignores the interests of a plaintiff who cannot justly be held responsible for a delay because he was only a year old when the first registration issued. Pro-Football argues that if Appellant Romero is not “imputed with the substantial delay of his fellow petitioners” then “trademark owners would never have certainty, since a disparagement claim could be brought by an as yet unborn claimant for an unlimited time after a mark is registered.” (Appellee’s Br. at 48).

Pro-Football’s argument is untenable because the organization adopted the “redskins” marks with knowledge that the Lanham Act expressly precludes the registration of disparaging terms. At a minimum, Mateo Romero’s equities must be balanced against Pro-Football’s.

B. Harm

1. Trial Prejudice

Pro-Football asserts that “the District Court correctly linked Appellants’ failure to provide substantial evidence regarding the disparaging nature of the “redskins” marks to Appellants’ quarter-century delay in bringing their case.” (Appellee’s Br. at 44). But the TTAB drew reasonable inferences from the evidence submitted, including the survey, dictionary definitions, newspaper excerpts and film clips, to support its conclusion that the term “redskins” was

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disparaging at the relevant time period. In view of the substantial evidence submitted, trial prejudice can hardly be claimed.

2. Economic Prejudice

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3. Negating Factors

Before a laches determination is made, this Court requires that negating factors be considered, i.e. factors that, if present, would preclude an application of laches even if the elements of the defense have been met. *See NAACP v. NAACP Legal Def. & Educ. Fund, Inc.*, 753 F.2d 131, 139 (D.C. Cir. 1985). Public policy is a negating factor to be considered. *See Coach House Rest., Inc. v. Coach and Six Rests., Inc.*, 934 F.2d 1551, 1564 (11th Cir. 1991) (“Although petitioner has acquiesced in use of their logo by the registrant, the public interest in preventing confusion around the marketplace is paramount to any inequity caused the registrant.”).¹⁷ Summary judgment is inappropriate because balancing such

¹⁷ *See Chun King Corp. v. Genii Plant Line, Inc.*, 403 F.2d 274, 276 (C.C.P.A. 1968) (recognizing that “laches, even if established, [would] not avoid a judgment in favor of the prior user” because of the important public policy in protecting the public from inevitable confusion); *Turner v. Hops Grill & Bar, Inc.*, 52 U.S.P.Q.2d 1310, 1313 (T.T.A.B. 1999) (recognizing that even if laches is proven, it will not bar a petition to cancel if confusion is inevitable “because any injury to respondent caused by petitioner’s delay is outweighed by the public’s interest in preventing confusion in the marketplace”).

negating factors against the elements of the laches test is an inherently factual matter.

V. THIS COURT SHOULD REVERSE THE DISTRICT COURT'S DECISION UNDER EITHER THE *DE NOVO* OR THE ABUSE OF DISCRETION STANDARD OF REVIEW

It is well settled that “the grant or denial of summary judgment is a determination of law” subject to a *de novo* standard of review. *Liberty Lobby, Inc. v. Rees*, 852 F.2d 595, 598 (D.C. Cir. 1988). Indeed, the cases cited by Pro-Football clearly provide that a district court’s determination as to whether there are genuine issues of material fact in dispute on the laches issue shall be reviewed *de novo*. See *Exxon Corp. v. Oxxford Clothes, Inc.*, 109 F.3d 1070, 1082 n. 16 (5th Cir. 1997); see, cf. *FTC v. H. J. Heinz Co.*, 246 F.3d 708, 713 (D.C. Cir. 2001) (recognizing a “*de novo* review to the district court’s conclusions of law”).

Upon a *de novo* review of a decision that laches is applicable and there are no genuine issues of material fact in dispute, some circuits apply an abuse of discretion standard to whether the district court properly determined that the undisputed facts warrant an application of laches. See *Hot Wax, Inc. v. Turtle Wax, Inc.*, 191 F.3d 813, 819 (7th Cir. 1999); *Exxon*, 109 F.3d at 1082 n. 16. This bifurcated approach is not, however, universally accepted. The Tenth Circuit applies the *de novo* standard to whether there are any issues of material fact and whether the undisputed facts favor an application of laches. See *Jacobsen v.*

Deseret Book Co., 287 F.3d 936, 948 (10th Cir. 2002) (applying an abuse of discretion standard only if the district court decides the laches question after a bench trial). This Court need not consider which approach to adopt because there are issues of material fact in dispute; *see, supra*, Section IV.

Even if this Court were to find that there are no genuine issues of fact in material dispute, it should reverse the District Court's decision that the facts warrant the application of laches under either the *de novo* standard of review or the abuse of discretion standard. This Court should find that the District Court abused its discretion in granting summary judgment to Pro-Football because:

- Mateo Romero did not substantially delay in petitioning to cancel the "redskins" registrations;
- There was no substantial delay in petitioning to cancel the registration for REDSKINETTES; and
- The District Court failed to consider negating factors that might militate against an application of laches.

CERTIFICATE OF SERVICE

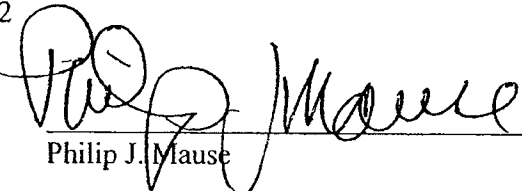
I, Philip J. Mause, counsel for Appellants Suzan S. Harjo, et al., hereby certify that copies of the Reply Brief for Appellant were served by U.S. mail, postage prepaid, this 27th day of September, 2004, on the following:

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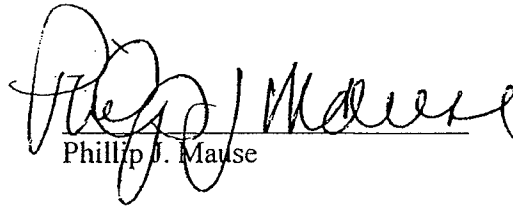

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CERTIFICATE OF COMPLIANCE

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 6,742 words.

2. This brief has been prepared in proportionally spaced typeface using Microsoft Word 2002 in Times New Roman 14 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

September 27, 2004