

1/18/04

ORAL ARGUMENT SCHEDULED FOR FEBRUARY 7, 2005

NO. 03-7162

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

SUZAN SHOWN HARTO, RAYMOND D. APODACA, VINCE DELOREA,
JR., NORBERT S. HILL, JR., MARIO ROMERO, WILLIAM A. MEANS,
and MANLEY A. BEGAY, JR.

Appellants

PRO FOOTBALL, INC.

Appellee

On Appeal from the United States District Court
for the District of Columbia

BRIEF FOR APPELLEE PRO FOOTBALL, INC.

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**CERTIFICATE OF COUNSEL AS TO PARTIES, RULINGS
AND RELATED CASES**

Pursuant to Rule 28(a)(1) of the Circuit Rules of the United States Court of Appeals for the District of Columbia Circuit, Appellee Pro-Football, Inc., by its attorneys White & Case LLP, respectfully submits this Certificate of Counsel as to Parties, Rulings and Related Cases.

A. Parties and Amici Before the District Court and Before this Court

1. Appellee

Name: Pro-Football, Inc.

Address: 21300 Redskin Park Drive, Ashburn, Virginia 20147

2. Appellants

Upon information and belief, Appellants are as follows:

Name: Suzan Shown Harjo

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Name: Raymond D. Apodaca

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3. Amici on Behalf of Appellants

By Order of this Court dated April 7, 2004, amici The Interfaith Conference of Metropolitan Washington (hereinafter, "Amici IFC"), National Congress of American Indians ("NCAI"), National Indian Education Association, National Indian Youth Council and the Tulsa Indian Coalition Against Racism (hereinafter, collectively, "Amici NCAI") were granted leave to participate in the appeal before this Court on behalf of Appellants.

B. Ruling Under Review

The United States District Court for the District of Columbia opinion under review is Pro-Football, Inc. v. Harjo, et.al., Civil Action No. 99-1385 (D.D.C. Sept. 30, 2003) (per Kollar-Kotelly, D.J.), available at 284 F. Supp. 2d 96 (D.D.C. 2003), granting summary judgment to Appellee on its First, Second and Fifth

causes of action and denying summary judgment to Appellants-Defendants on these causes of action. The opinion is also available as 68 U.S.P.Q.2d 1225.

C. Related Cases

Prior to the District Court's opinion, the same parties also appeared in an earlier trademark cancellation proceeding before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office as Suzan Shown Harjo, et.al. v. Pro-Football, Inc., Cancellation No. 21,069 (cancellation proceeding instituted on September 10, 1992), available at 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999).

APPELLEE PRO-FOOTBALL, INC.'S
CORPORATE DISCLOSURE STATEMENT

Pursuant to Federal Rule of Appellate Procedure 26.1 and Rule 26.1 of the Circuit Rules of the United States Court of Appeals for the District of Columbia Circuit, Appellee Pro-Football, Inc., by its attorneys White & Case LLP, respectfully submits this Corporate Disclosure Statement and hereby discloses the following:

Pro-Football, Inc. is a wholly-owned subsidiary of WFI Group and no publicly-held company owns a 10% or greater ownership interest in Pro-Football, Inc.

Pro-Football, Inc. owns and operates the Washington Redskins football club, one of the thirty-two member clubs of the National Football League, whose teams play professional football games.

Pro-Football, Inc. is a Maryland corporation with its principal place of business at 21300 Redskin Park Drive, Ashburn, Virginia 20147.

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GLOSSARY

- Amici IFC - Amici for Appellants, The Interfaith Conference of Metropolitan Washington
- Amici NCAI- Collectively, Amici for Appellants National Congress of American Indians, National Indian Education Association, National Indian Youth Council and the Tulsa Indian Coalition Against Racism
- APA - Administrative Procedure Act, codified at 5 U.S.C. § 706
- Appellants - The seven Native American Petitioners: Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr.
- Harjo I - Harjo, et al. v. Pro-Football, Inc., 30 U.S.P.Q.2d 1828 (T.T.A.B. 1994)
- Harjo II - Harjo, et al. v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999)
- Harjo III - Pro-Football, Inc. v. Harjo, et al., 57 U.S.P.Q.2d 1140 (D.D.C. 2000)
- NCAI - National Congress of American Indians
- NFL - National Football League
- Opinion Below- Pro-Football, Inc. v. Harjo, et al., 284 F. Supp. 2d 96 (D.D.C. 2003)
- Redskins Club- Appellee Pro-Football, Inc., corporate owner of the Washington Redskins professional football team (also, “Redskins”)
- TTAB - Trademark Trial and Appeal Board (also, “Board”)
- USPTO - United States Patent and Trademark Office

JURISDICTIONAL STATEMENT

Appellee Pro-Football, Inc. does not contest Appellants' Statement of Jurisdiction.

STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

- 1) In a de novo appeal from an administrative agency decision, was the reviewing trial court correct in finding that Appellants failed to sustain their burden of proving that certain registered trademarks of the Washington Redskins professional football team disparaged a substantial composite of Native Americans at the time the registrations issued, where the agency record lacked substantial evidence of disparagement and Appellants failed to submit any additional evidence of disparagement to the reviewing trial court?

- 2) Did the District Court abuse its discretion in finding that laches barred Appellants' petition to cancel the Redskins' trademark registrations, where:
 - (A) The Redskins Marks had been used in connection with the Washington Redskins professional football team for over six decades and registered on the Principal Register for twenty-five years before Appellants' challenge;
 - (B) During the twenty-five year delay, Appellants admitted they had actual notice of the contested trademarks and twelve separate instances of constructive notice of the marks when each was published and registered;

- (C) Appellants offer no reasonable excuse for their delay in bringing their petition;
- (D) Appellants' lengthy delay economically prejudiced the Washington Redskins, as the Redskins invested heavily in the contested marks in reliance upon Appellants' failure to legally challenge the registrations; and
- (E) The Washington Redskins suffered trial prejudice in the form of missing witnesses and evidence that would have been available to defend against Appellants' claim had it been brought in a timely manner?

STATUTES AND REGULATIONS

15 U.S.C. § 1072

Registration as constructive notice of claim of ownership

Registration of a mark on the principal register provided by this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, shall be constructive notice of the registrant's claim of ownership thereof.

Pursuant to Local Circuit Rule 28(a)(5), Appellee Pro-Football, Inc. hereby affirms that, aside from the statute cited above, all applicable statutes are contained in the Brief for Appellants.

STATEMENT OF THE CASE

Pro-Football, Inc., the corporate owner of the Washington Redskins professional football team (hereinafter, the “Redskins Club” or “Redskins”), instituted a de novo proceeding in the United States District Court for the District of Columbia based upon an unprecedented April 1999 decision of the Trademark Trial and Appeal Board (“TTAB” or “Board”) of the United States Patent and Trademark Office (“USPTO”) to cancel incontestable trademarks that had been in use for as long as six decades, and validly registered without challenge for a quarter of a century, based on the disparagement, contempt or disrepute provisions of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a). The TTAB had also rejected claims by Appellants here that the six Redskins Club trademark registrations under review (the “Redskins Marks”) were scandalous, and that imagery used in the Redskins Marks disparaged Native Americans or was scandalous. Still, the Board specifically found that the Redskins Marks “may be disparaging of Native Americans to a substantial composite of this group of people,” and “may bring Native Americans into contempt or disrepute.”¹

Appellants, the seven Native American individual petitioners, have not appealed from either of the two TTAB rulings that were adverse to them, nor did

¹ Harjo, et al. v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1748 (T.T.A.B. 1999) (“Harjo II”).

they appeal from Board rulings setting forth the proper legal standards in this matter, namely, the relevant time period (the times at which each of the Redskins Marks were registered), context (how the Redskins Club has used the Redskins Marks in the football context), and population (a substantial composite of Native Americans) to be used in the determination of the disparagement claim.

On June 1, 1999, the Redskins Club timely appealed the TTAB's disparagement finding to the District Court for the District of Columbia pursuant to 15 U.S.C. §§ 1071(b) (1),(4).² The Redskins Club's Complaint asserted five causes of action: (a) requesting a finding that the Redskins Marks do not disparage Native Americans or bring them into contempt or disrepute, (JA 438-39 [¶¶ 108-11]); (b) alleging that Section 2(a) of the Lanham Act is unconstitutional under the First and Fifth Amendments, respectively, (JA 439 [¶¶ 112-18]); and (c) a claim that the petition should be barred by laches because Appellants waited twenty-five years to file it. (JA 439-40 [¶¶ 119-20]). Laches was pleaded by the Redskins Club in the TTAB, but the Board struck it even before a record could be developed on the issue.³

² Under 15 U.S.C. § 1071(b), a party "dissatisfied with the decision of the [TTAB] . . . may . . . have remedy by a civil action." In such an appeal, "[t]he court may adjudge that an applicant is entitled to a registration . . . or such other matter as the issues in the proceeding require as the facts in the case may appear." 15 U.S.C. § 1071(b)(1).

³ Harjo, et al. v. Pro-Football, Inc., 30 U.S.P.Q.2d 1828, 1833 (T.T.A.B. 1994) ("Harjo I").

The parties cross-moved for summary judgment in July 2002. The Redskins Club moved for summary judgment on all but its constitutional claims (as directed by the District Court under the doctrine of constitutional avoidance).⁴ Appellants sought summary affirmance of the TTAB's disparagement finding and a judgment that laches was unavailable. The District Court heard oral argument in July 2003.

On September 30, 2003, the District Court reversed the Board's rulings on disparagement and laches, determining that the TTAB's disparagement finding "was not supported by substantial evidence"⁵ and that petitioners' "undue delay" and the attendant "economic prejudice" to the Redskins Club constituted laches.⁶

⁴ Pro-Football, Inc. v. Harjo, et al., 57 U.S.P.Q.2d 1140, 1142-43 (D.D.C. 2000) ("Harjo III").

⁵ Pro-Football, Inc. v. Harjo, et al., 284 F. Supp. 2d 96, 136 (D.D.C. 2003) ("Opinion Below").

⁶ Id. at 144.

STATEMENT OF FACTS

A. The Parties

The Redskins Club, one of the thirty-two member clubs of the National Football League (“NFL”), is one of the most fabled franchises in the history of professional sports. The team has developed its national reputation by competing under the name “Redskins” for over seventy years, attracting “millions of impassioned fans who root fervently for their Redskins every Sunday in the fall.”⁷ Given such “continuous renown in the sport of football,”⁸ the Redskins Club is the owner of trademarks that are among the most famous in this country. Signs of the team’s on-field success are plentiful: in 1950, the Redskins were the first team to have all its games televised; the Redskins have sold out every home game since 1966; the team has played in five Super Bowl championship games and won three. (JA 536-38, 541-42 [¶¶ 12, 22, 27, 38, 41, 43]; JA 527-28 [¶¶ 9, 11, 13-15, 17-18].) In the words of the TTAB itself, the Redskins Club’s use of the word “Redskins” in connection with its professional football team and entertainment

⁷ Harjo III at 1141.

⁸ Harjo II at 1749.

services, has been “clear[ly] accept[ed]” by a substantial composite of the general population.⁹

On September 11, 1992, the seven Native American Petitioners (“Appellants”), Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr., filed a petition for cancellation claiming that the Redskins Club’s use of the word “redskin(s)” is “scandalous,” “may . . . disparage” Native Americans, and may cast Native Americans into “contempt, or disrepute” in violation of Section 2(a) of the Lanham Act.¹⁰

B. The Redskins Marks

In 1933, the Redskins began to use the mark



in commerce. (JA 421 [¶ 20]; 452 [¶ 20 (admit)].) After filing an application for trademark registration in 1966, the PTO issued registration number 836,122 for this mark on September 26, 1967, for use in connection with “entertainment services-namely, football exhibitions rendered live in stadia and through the media of radio and television broadcasts” in International Class 041. (JA 150-51; 474-77; 538-39 [¶ 24].)

⁹ Id. at 1749.

¹⁰ Id. at 1708 (citing 15 U.S.C. § 1052(a)); Opinion Below at 99.

Registrations for the following three marks: WASHINGTON REDSKINS,

WASHINGTON



REDSKINS, and



, followed in 1974 under

Registration Numbers 978,824; 986,668; and 987,127, respectively. These three marks had been in use as early as 1937, and were also registered in Class 41. (JA 152-54; 470-73; 535-36; 538; 539-40 [¶¶ 10, 11, 26, 28-34].)

On February 7, 1978, the PTO issued registration number 1,085,092 for the word mark REDSKINS in Class 41, a mark that had also been in use since 1933. (JA 155; 421 [¶ 20]; 452 [¶ 20 (admit)]; 540-41.)

Finally, in or about 1962, the Redskins' cheerleaders started using the word mark REDSKINETTES. Registration number 1,606,810 in Class 41 issued on July 17, 1990. (JA 156; 536 [¶ 13]; 541 [¶ 42].)¹¹

¹¹ The original petition for cancellation had included a seventh mark, SKINS, but the TTAB had not instituted the proceeding as to this mark because it was moot at the time of filing. See Harjo II at 1706 n.1.

SUMMARY OF ARGUMENT

This appeal presents for review a textbook example of a trial judge fulfilling her role as a gatekeeper against legal claims that cannot be supported. The district court, comprehending the difference between a politically-charged case and a legally-sufficient one and refusing to be distracted by the attempt to substitute invective for proof, ruled in essence that claims lacking sufficient evidentiary support would not go forward.

The TTAB, the District Court, and the parties on appeal have agreed that the sole legal question facing the Board in determining whether Appellants had proved a claim of disparagement under Section 2(a) of the Lanham Act was “whether, at the times [the Redskins Club] was issued each of its challenged registrations, the [Redskins Marks, used in the context of professional football] consisted of or comprised . . . matter which may disparage [a substantial composite of] Native American persons, or matter which may bring Native American persons into contempt or disrepute.” Harjo II at 1735. The District Court properly focused on the evidentiary record before the TTAB (as supplemented by the parties in the District Court), and carefully reviewed the TTAB’s legal conclusions and the evidence on which it based its factual and legal findings. The District Court observed that while the TTAB pronounced the correct legal standard, it failed to

correctly apply that standard to the facts by considering non-probative evidence and attempting to tie such evidence back to the legal standard through speculation and unsupported inference. In the end, the District Court found the TTAB's findings on the agency record to be deficient and substantially flawed. Appellants did not introduce any substantial evidence at the summary judgment stage of the trial proceeding to shore up the record before the Board.

Similarly, the Court's grant of summary judgment on the issue of laches was anything but an abuse of discretion. The ruling was properly made on the undisputed material facts in evidence. If ever a case deserved summary judgment on laches it was here, where "[t]he Court, like the TTAB, [was] handicapped in resolving this case because of the [Appellants'] delay," and where the marks had been in use for over sixty years and properly registered for twenty-five, before being challenged. Opinion Below at 136. And, of course, the dual grounds for reversal reinforce each other, because, as the Court stated, "laches correlate[d]" with the insufficient record on disparagement. Id.

Appellants simply put forth no valid evidence of disparagement during the relevant time period. For example, Appellants' "survey" of Native American attitudes was more than twenty-five years too late, and did not even purport to survey the Redskins Marks as used by the team. The Redskins Club was greatly prejudiced by this delay, both economically (by building up its investment in the

Redskins Marks over the lengthy period of delay, the registrations for which were belatedly subject to a cancellation determination) and through trial prejudice (lost records, deceased material witnesses, and lack of contemporaneous evidence). As such, the Court did not abuse its discretion by entering summary judgment in favor of the Redskins on laches.

ARGUMENT

I. STANDARDS OF REVIEW

A. THE DISTRICT COURT PROPERLY APPLIED THE “SUBSTANTIAL EVIDENCE” STANDARD OF REVIEW TO THE MINIMAL FINDINGS OF FACT OF THE TTAB

The Redskins Club sought review of the TTAB decision by way of a civil action filed in a federal district court. Lanham Act § 21(b)(1), 15 U.S.C. § 1071(b)(1). A district court review of a TTAB decision requires two separate steps: First, pursuant to the Administrative Procedure Act (“APA”), 5 U.S.C. § 706, and Supreme Court precedent, the Court reviews the TTAB’s factual findings and conclusions under a “substantial evidence” test. Dickinson v. Zurko, 527 U.S. 150, 165 (1999) (quoting APA that reviewing court may “set aside agency action, findings, and conclusions found to be . . . unsupported by substantial evidence”); see also Mazzari v. Rogan, 323 F.3d 1000, 1005 (Fed. Cir. 2003) (affirming grant of summary judgment for lack of substantial evidence); Sikora v. Brenner, 379 F.2d 134, 136 (D.C. Cir. 1967) (holding that APA provisions govern review of USPTO decision). A review for substantial evidence “involves examination of the record as a whole, taking into account evidence that both justifies and detracts from an agency’s decision.” In re Gartside, 203 F.3d 1305, 1312 (Fed. Cir. 2000) (citing Universal Camera Corp. v. NLRB, 340 U.S. 474, 487-88 (1951)). Second, as the parties are permitted to offer new evidence in the District Court, the Court

may make new findings of fact based on any newly-submitted evidence. See Material Supply Int'l, Inc. v. Sunmatch Indus. Co., Ltd., 146 F.3d 983, 989 (D.C. Cir. 1998).

B. AS TO DISPARAGEMENT, THIS COURT REVIEWS THE DISTRICT COURT'S GRANT OF SUMMARY JUDGMENT DE NOVO

Although the standard of review in this Circuit for a grant or denial of summary judgment is de novo, see Liberty Lobby, Inc. v. Rees, 852 F.2d 595, 598 (D.C. Cir. 1988), one of the principal purposes of the summary judgment rule is “to isolate and dispose of factually unsupported claims.” Celotex Corp. v. Catrett, 477 U.S. 317, 323-24, 327 (1986) (summary judgment not “a disfavored procedural shortcut, but . . . an integral part” of FRCP); see also Palestine Info. Ofc. v. Schultz, 853 F.2d 932, 944 (D.C. Cir. 1988) (in deciding summary judgment, court may “penetrate the allegations of fact in the pleadings and look at any evidential source”) (citation omitted).

Because Appellants bore the burden of proving their disparagement claim, the Redskins can establish entitlement to judgment as a matter of law “by ‘showing’ . . . that there is an absence of evidence to support [Appellants’] case.” Celotex, 477 U.S. at 325 (emphasis added). Having shown an absence of evidence, the burden shifts to Appellants to produce “specific evidence” that a genuine issue of material fact exists. Id. at 324. Appellants are required to make “a sufficient showing” to establish the elements of its case. Id. at 322-23.

Moreover, “the mere existence of [a] factual dispute,” by itself, is not enough to bar summary judgment. Anderson v. Liberty Lobby, Inc., 477 U.S. 242, 248 (1986); see also Greene v. Dalton, 164 F.3d 671, 674 (D.C. Cir. 1999). To be material, the factual assertion must be capable of affecting the substantive outcome of the litigation; to be genuine, the issue must be supported by sufficiently admissible evidence such that a reasonable trier-of-fact could find for the nonmoving party. Id.; see also Laningham v. United States Navy, 813 F.2d 1236, 1242-43 (D.C. Cir. 1987). In short, the adverse party must do more than simply “show that there is some metaphysical doubt as to the material facts.” Matsushita Elec. Indus. Co. v. Zenith Radio Corp., 475 U.S. 574, 586 (1986).

C. AS TO LACHES, THE DISTRICT COURT’S GRANT OF SUMMARY JUDGMENT SHOULD BE REVIEWED FOR ABUSE OF DISCRETION

This Court reviews a District Court’s grant or denial of an equitable remedy under an abuse of discretion standard, and will set aside the court’s factual findings only if they are “clearly erroneous.” See FTC v. H.J. Heinz Co., 246 F.3d 708 (D.C. Cir. 2001) (reversing denial of preliminary injunction); Ambach v. Bell, 686 F.2d 974, 979 (D.C. Cir. 1982) (per curiam). A District Court has wide discretion in determining whether to apply the doctrine of laches to claims pending before it. See NAACP v. NAACP Legal Def. and Educ. Fund, Inc., 753 F.2d 131, 138 (D.C. Cir. 1985) (noting “considerable deference is given to the trial judge’s discretion” on determination of laches); Hot Wax, Inc. v. Turtle Wax, Inc., 191 F.3d 813, 819

(7th Cir.1999) (setting forth abuse of discretion standard for review of laches determination). When the district court correctly applies the summary judgment standard in granting a dismissal based upon laches, and the material facts relevant to laches are not in genuine dispute, the district court's "determination of whether the undisputed facts warrant an application of laches is reviewed for abuse of discretion." Nat'l Ass'n of Gov't Employees v. City Pub. Serv. Bd., 40 F.3d 698, 707-08 (5th Cir. 1994); accord In re Beaty, 306 F.3d 914, 921 (9th Cir. 2002); Brown-Mitchell v. Kansas City Power & Light Co., 267 F.3d 825, 827 (8th Cir. 2001); City of Wyandotte v. Consol. Rail Corp., 262 F.3d 581, 589 (6th Cir. 2001); Sanders v. Dooly County, 245 F.3d 1289, 1291 (11th Cir. 2001); Holmes v. Pension Plan of Bethlehem Steel Corp., 213 F.3d 124, 134 (3d Cir. 2000); see also Hot Wax, 191 F.3d at 819; Wanlass v. General Elec. Co., 148 F.3d 1334, 1337 (Fed. Cir. 1998).

II. THE DISTRICT COURT PROPERLY FOUND THAT THE TTAB'S FINDING OF DISPARAGEMENT WAS NOT SUPPORTED BY SUBSTANTIAL EVIDENCE

Using the APA "substantial evidence" standard, see supra Part I.A, the District Court's opinion properly focused on the sufficiency or insufficiency of the evidence before the TTAB regarding whether the Redskins Marks "may disparage" Native Americans. See generally Opinion Below at 114-15, 119-25. The Court

undertook its careful examination using the standard for disparagement articulated by the TTAB; that is, “whether, at the times [the Redskins Club] was issued each of its challenged registrations,” the Redskins Marks “as those marks are used in connection with the services identified in the registrations” were disparaging.

Opinion Below at 127 (quoting Harjo II at 1743).¹² In so doing, it found that the TTAB’s few findings of fact, and the conclusions based upon those findings, were “unsupported by substantial evidence,” “logically flawed,” and “fail[ed] to apply the correct legal standard to its own findings of fact.” Opinion Below at 125-26; see also Hayman v. Nat’l Acad. of Sci., 23 F.3d 535, 539 (D.C. Cir. 1994) (“[n]one of the individual pieces of evidence that Appellant[s] proffered creates a reasonable inference . . . and their whole is no greater than the sum of their parts”).

A. THE DISTRICT COURT CONDUCTED A PROPER ADMINISTRATIVE REVIEW IN REVERSING THE TTAB’S FINDING OF DISPARAGEMENT

A reviewing court is “not obliged to stand aside and rubber-stamp” an administrative decision that it deems unsupported by substantial evidence. NLRB v. Brown, 380 U.S. 278, 291-92 (1965); see also FTC v. Texaco, 555 F.2d 862, 903 (D.C. Cir. 1977). Here, the District Court, properly adhering to the administrative review standard enunciated in Section 706 of the APA, see BFI Waste Sys. v. FAA, 293 F.3d 527, 534 (D.C. Cir. 2002) (agreeing that agency’s

¹² This legal standard was uncontested and the District Court adopted it as well. Opinion Below at 125.

factual conclusions were “as flawed as the procedures it used to reach them”), correctly found that the vast majority of Appellants’ evidence failed to bear upon the TTAB’s stated disparagement test.

In reaching its decision, the TTAB had stated that “we consider the broad range of evidence in this record as relevant to th[e] question either directly or by inference.” Harjo II at 1743. The District Court discussed the “transparent” difficulty of such a “problematic” statement, finding that “even a cursory review” of the TTAB’s findings of fact reveal “no *direct* evidence in the findings that answers the legal question posed by the TTAB.” Opinion Below at 127 (emphasis in original). Instead, the TTAB had “simply catalogued” the “voluminous” record, choosing to make only minimal findings of fact on the disputed evidence while “focusing almost exclusively on the undisputed portion of the record,” and had substituted “inferential fact-based judgments” for substantiated “concrete evidentiary proof.” Id. at 102 n.4. As the District Court properly recognized, the submission of reams of irrelevant evidence will not cumulatively add up to “substantial evidence;” it is the quality, not the quantity, of evidence that counts. See id. at 128.

The TTAB made findings of fact in only two very specific areas - - linguistic evidence and Appellants’ survey evidence - - and many of these findings of fact simply summarized undisputed testimony. Opinion Below at 127-28. Even

Appellants admit this.¹³ (Appellants' Br. at 22.) As to the linguistic testimony, the TTAB essentially made five findings of fact.¹⁴ Opinion Below at 107-08. As to Appellants' survey, it made an additional three findings of fact.¹⁵ Id. at 111-12. This "paucity of actual findings of fact made by the TTAB" is especially notable given that the TTAB opinion "spent fourteen pages cataloguing the evidence in the case." Opinion Below at 119 (emphasis added). As the TTAB merely catalogued the evidence, rather than make factual findings, no deference was due. See Motor

¹³ Appellants' attempts to semantically redeem the TTAB's approach to fact-finding are unavailing: "[w]hile 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 . . . that many other findings of fact influenced its ultimate conclusion . . ." (Appellants' Br. at 22 (emphasis in original).) Parties to a proceeding and reviewing courts should not have to be clairvoyants. Agency fact-finding is subject to the Federal Rules of Evidence and should be clearly identified as findings of fact, as the TTAB obviously was able to do. See Motor Vehicle Mfrs. Ass'n v. State Farm Mut. Auto. Ins. Co., 463 U.S. 29, 43 (1983) (focusing on whether agency "articulate[d] a satisfactory explanation for its action" reflecting a "rational connection between the facts found and the choice made"); see also Lozowski v. Mineta, 292 F.3d 840, 845 (D.C. Cir. 2002) (same).

¹⁴ These findings were: 1) there was no dispute among the linguists that "redskin(s)" has been used historically to refer to Native Americans; 2) "redskin(s)" has, since the mid-1960s, dropped from most written and spoken language as a reference to Native Americans; 3) in the same time period, the words "Native American," "Indian," and "American Indian" have been used to refer to Native Americans; 4) in the same time period, the word "redskin(s)" often appears only as a reference to the Redskins Club; and, 5) the experts agree that, until the mid-20th century, spoken and written language often derogatorily referred to Native Americans. See Harjo II at 1731-32.

¹⁵ These findings were: 1) that there was ample support for the survey methodology used, including the sampling plan and the principal questions asked; 2) that there was no error in including respondents who were not alive at the time that several of the Redskins Marks registered, as the survey was only represented as a survey of current attitudes as of the time that the survey was conducted; and, 3) that the survey was relevant and adequately represented the views of the two populations sampled, though it was far from dispositive of the question before the Board. See Harjo II at 1734.

Vehicle Mfrs., 463 U.S. at 43 (stating that deference to agency decision-making does not require court to accept agency's failure to consider relevant factors).

Appellants now attempt to breathe new life into the same "catalogue" of evidence, without addressing its underlying probity. For example, as to their 1996 survey, Appellants still claim - - with no supporting evidence of record - - that they have "established that 'there would very likely be a positive correlation'" between responses given in 1996 and responses that would have been given had a survey been conducted nearly thirty years earlier, in 1967. (Appellants' Br. at 11.) As the District Court recognized, even crediting the unsupported conclusion that there would "very likely" be a correlation between responses in 1967 and responses in 1996 fails to satisfy the requirement that expert testimony be relevant and reliable. See Meister v. Med. Eng'g Corp., 267 F.3d 1123, 1126-27 (D.C. Cir. 2001) (finding no abuse of discretion in excising plaintiff's expert testimony and affirming grant of judgment as matter of law in light of insufficient remaining evidence).¹⁶

¹⁶ Amici NCAI go even further. Obviously recognizing the paucity of the evidence on disparagement before the TTAB, they improperly attempt to add new evidence to this closed record, including articles, studies and videos which were not part of the record below. (See generally Amici NCAI Br. at 5-7, 16-19, 24, 26-28.) Amici NCAI have even attempted to introduce a survey mentioned in an article from Sports Illustrated magazine, (Amici NCAI Br. at 24), with an utter lack of foundation. (Id. at 24-25.) As set forth fully in the Motion of Appellee to Strike the Brief and Addendum of Amici NCAI, this blatant attempt to "beef up" Appellants' sparse evidence on disparagement should be stricken. Amici cannot save Appellants' lack of

(continued)

**B. THE DISTRICT COURT CORRECTLY APPLIED THE TEST FOR
DISPARAGEMENT ARTICULATED BY THE TTAB**

The TTAB, the District Court, and the parties on appeal have agreed that the sole legal question facing the Board in determining whether Appellants had proved a claim of disparagement under Section 2(a) of the Lanham Act was “whether, at the times respondent was issued each of its challenged registrations, the respondent’s registered marks consisted of or comprised . . . matter which may disparage Native American persons, or matter which may bring Native American persons into contempt or disrepute.” Harjo II at 1735; see also Opinion Below at 125; see also Defs’ Mot. for Summ. J. at 2, 27; Defs’ Opp’n to Pl.’s Mot. for Summ. J. at 10-15; JA 670-71 [¶¶ 222-24]. This analysis, the TTAB further explained, must follow a two-step process:

[F]irst: What is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the services identified in the registrations? Second . . . Is this meaning one that may disparage Native Americans? As previously stated, both questions are to be answered as of the dates of registration of the marks herein.

Harjo II at 1740-41 (emphasis added).

In the face of the District Court’s reversal of the TTAB, Appellants and amici, having found no fault with the established disparagement standard when

(continued)

substantial evidence by the belated addition of baseless and improper “evidence” to a closed record.

they were benefiting from it, now appear to find fault with it, arguing that: 1) the views of the general public may be extrapolated to determine the views of Native Americans as to the nature of the Redskins Club's use of the Redskins Marks, and are therefore probative (Appellants' Br. at 25-26; Amici IFC Br. at 7-8); and, 2) the question of disparagement need not be considered within the context of the Redskins Club's use of the Marks in connection with their professional football services (Appellants' Br. at 26-28; Amici IFC Br. at 4-6). Each of these arguments is unsupported by relevant caselaw and at odds with the law of this case, as will be shown infra.

It is clear that Appellants' shifting strategy is a belated effort to avoid the District Court's careful evidentiary review and subsequent holding (unfavorable to Appellants on these points). However, Appellants cannot be permitted to raise as an issue on appeal the TTAB's interpretation of caselaw - - first articulated a decade ago in Harjo I - - that they supported both in the TTAB and in the District Court. "It is a hard and fast rule of administrative law, rooted in simple fairness, that issues not raised before an agency are waived and will not be considered by a court on review." Nuclear Energy Institute, Inc. v. EPA, 373 F.3d 1251, 1297-98 (D.C. Cir. July 9, 2004) (collecting cases); see also Nat'l Wildlife Fed'n v. EPA, 286 F.3d 554, 562 (D.C. Cir. 2002) (citing a "near absolute bar against raising new issues - factual or legal - on appeal in the administrative context").

Moreover, Appellants are barred by judicial estoppel. Under that doctrine, “[w]here a party assumes a certain position in a legal proceeding, and succeeds in maintaining that position, he may not thereafter, simply because his interests have changed, assume a contrary position, especially if it be to the prejudice of the party who has acquiesced in the position formerly taken by him.” New Hampshire v. Maine, 532 U.S. 742, 749 (2001) (citing Davis v. Wakelee, 156 U.S. 680, 689 (1895)); Pyramid Sec. Ltd. v. IB Resolution, Inc., 924 F.2d 1114, 1123-24 (D.C. Cir. 1991) (Williams, J.) (estopping party’s “expedient” attempt to create issue of material fact by “jettison[ing]” its earlier testimony and agreeing that “parties’ opportunism should not readily imperil summary judgment”). Judicial estoppel “protect[s] the integrity of the judicial process by prohibiting parties from deliberately changing positions according to the exigencies of the moment.” New Hampshire, 532 U.S. at 749; see also Pegram v. Herdrich, 530 U.S. 211, 227 n.8 (2000) (doctrine “prevents a party from prevailing in one phase of a case on an argument and then relying on a contradictory argument to prevail in another phase”); Mitchell v. Washingtonville Cent. Sch. Dist., 190 F.3d 1, 6 (2d Cir. 1999) (change of position before appellate court from position adopted before administrative tribunal).

1. **Appellants’ Evidence Failed to Address the Relevant Time Period**

The District Court properly found that the TTAB’s disparagement

conclusion was not supported by substantial evidence, in part, because Appellants failed to present any evidence that the Redskins Marks were disparaging at the time the registrations issued. See Opinion Below at 136. Indeed, as discussed infra Part III, the Court found a direct relationship between Appellants' substantial delay in bringing their case and the paucity of the record evidence supporting Appellants' claims of disparagement. See id. at 136. The Court found evidence that only:

chips away at the sides of th[e] legal question but never helps answer it directly. This is undoubtedly a "test case" that seeks to use federal trademark litigation to obtain social goals. The problem, however, with this case is evidentiary. The Lanham Act has been on the books for many years and was in effect in 1967 when the trademarks were registered. By waiting so long to exercise their rights, Defendants make it difficult for any fact-finder to affirmatively state that in 1967 the trademarks were disparaging.

Id. at 145 (emphasis added). The Court correctly ruled that this delay should be held against Appellants.¹⁷ See id.; see also Massey Junior Coll., Inc. v. Fashion Inst. of Tech., 492 F.2d 1399, 1402 (C.C.P.A. 1974) ("[T]he longer a party waits . . . to commence a cancellation proceeding, the greater may be the number of facts . . . to be considered in determining the quantum of proof required").

¹⁷ The TTAB, on the other hand, had denied the Redskins Club even the opportunity to develop a record on laches. See Harjo I at 1831.

Appellants' survey expert, Dr. Ivan Ross, admitted there was no empirical data that would support the conclusion that the term "Redskins" was considered disparaging during the relevant time period because he conducted his survey in March 1996.¹⁸ (JA 210-13; 215-17.) In reviewing the TTAB's findings of fact regarding the Ross Survey, the District Court agreed only that there was substantial evidence for the narrow conclusion that the survey represents nothing more "than a survey of current attitudes at the time the survey was conducted." Opinion Below at 119-20. However, "current attitudes" of respondents in 1996 are simply irrelevant to the controlling issue here: the attitudes of Native Americans at the time the registrations issued. Id. at 132 ("the survey tells us nothing about the relevant time frame"); see also Dick's Sporting Goods, Inc. v. Dick's Clothing and Sporting Goods, 188 F.3d 501, No. 98-1653, 1999 WL 639165 (4th Cir. Aug. 20, 1999) (finding survey defective because it failed to address relevant time period). Indeed, the TTAB recognized that "a survey of attitudes as of the dates of registration of the challenged registrations would have been extremely relevant in

¹⁸ The TTAB acknowledged the deficiencies of the Ross survey in this respect, stating that Dr. Ross "does not represent this survey as anything other than a survey of current attitudes as of the time the survey was conducted." Harjo II at 1734. Nevertheless, the TTAB relied on this deficient survey. Even Appellants now seem to admit the limitations of their own "imperfect" survey, intimating that the Ross Survey was conducted only because "it is traditional in trademark cases to offer survey evidence." (Appellants' Br. at 10, 29.) But this belated excuse for offering the survey is flimsy, given that survey evidence is not regularly found in Section 2(a) cases, though they are often found in trademark confusion cases.

this case,” Harjo II at 1734 (emphasis added), but nevertheless failed to recognize the lack of relevance of a survey performed decades later.

Appellants’ linguistic expert, Dr. Geoffrey Nunberg, also went far outside the relevant time period, attempting to base his opinion on: (1) a review of historical citations of the word “redskin” in the press and books from the late 1800s through the first half of this century; (2) the use of the word in movies beginning in 1920; and, (3) dictionary entries beginning as early as 1910. (JA 263-64; 294-98; 332-46.) Appellants’ other “experts” relied on similar, and irrelevant, historical reviews: history expert Frederick Hoxie based his opinion on the historical literature of the 17th, 18th and 19th centuries; and social sciences expert Arlene Hirschfelder based her testimony on American history textbooks, which discussed Native Americans in the same periods. (JA 299-306; 348-57.) All of these submissions were plainly irrelevant, as the time period that all parties agree was relevant was the time the registrations issued, not in the 17th, 18th, 19th and early 20th century or in 1996. See FRE 402.

Similarly irrelevant are the several resolutions submitted by Appellants to the TTAB (from organizations purportedly supporting Appellants’ position), as each was adopted outside the relevant time period. Opinion Below at 135. Though the TTAB relied on this evidence as within the “broad range of evidence”

submitted,¹⁹ it made no findings of fact about the strength of this evidence. Id. All but one of the subject registrations issued between 1967 and 1978, fourteen to twenty-five years before the first of these resolutions; the last of the Redskins Marks registered in 1990 — still two years before the first of these resolutions. See Harjo II at 1724-25. Notably, Amici NCAI expressly decided against a resolution during the relevant time period. When Appellant Deloria was one of its only two employees in 1967, the NCAI declined a policy opposing the Redskins' initial registration, even though Deloria had wanted to, because Deloria "had about forty [Native American] elders to answer to." (JA 366-67.) The District Court therefore properly ruled that "[a]ll of these resolutions were made after the relevant time frame, with no explanation by the TTAB as to how they 'shed light' on the relevant time period, and thus, are irrelevant to the calculus." Opinion Below at 135. There simply was a dearth of evidence, certainly not substantial, that the Redskins Marks were disparaging to Native Americans during the relevant time frame.

2. **Appellants' Evidence Failed to Consider The Redskins Marks As They Are Used In The Marketplace**

Until Appellants shifted gears during this appeal, the TTAB's holding that

¹⁹ The phrase "broad range of evidence" is in truth a misnomer, for while there was indeed a broad range of "submissions" by Appellants before the TTAB, few of these submissions would be admissible under the Federal Rules of Evidence, the very rules the Board has adopted for itself.

“the question of disparagement must be considered in relation to the goods or services identified by the mark in the context of the marketplace” had been undisputed. Harjo II at 1738-39; accord Boswell v. Mavety Media, 52 U.S.P.Q.2d 1600, 1606 (T.T.A.B. 1999); In re Old Glory Condom Corp., 26 U.S.P.Q.2d 1216, 1221 (T.T.A.B. 1993); In re In Over Our Heads, 16 U.S.P.Q.2d 1653 (T.T.A.B. 1990); In re Hershey, 6 U.S.P.Q.2d 1470 (T.T.A.B. 1988); Doughboy Indus. v. Reese Chem. Co., 88 U.S.P.Q. 227 (Comm’r 1951). Thus, the Redskins Marks were supposed to be examined in the context of their use in connection with the Washington Redskins professional football team. The District Court found no error in this “[m]ost important[]” determination, Opinion Below at 125, and neither side contested this aspect of the test for disparagement below. Id.; Defs’ Opp’n to Pl’s Mot. for Summ. J. at 10-11.

The District Court found that the TTAB had “decoupled” its discussion of the term “redskin(s)” from the Redskins Club’s entertainment services. Opinion Below at 129. The TTAB simply found that as the word “redskin(s)” may be used pejoratively when used as a reference for Native Americans, that the Redskins Marks were, therefore, disparaging. See id. at 133. This superficial and flawed analysis yielded very little discussion of the use of the mark in connection with the Redskins Club’s football services, and, therefore, “very little analysis of how the use of [the Redskins Marks] in connection with Pro-Football’s services disparages

Native Americans.” Id. (emphasis in original). Even the TTAB acknowledged that “the evidence herein shows [an increasingly respectful] portrayal of Native Americans” by the Redskins Club “through the 1960s to the present.” Harjo II at 1746. The Court noted that “despite this stunning observation - - that during the relevant time frame Pro-Football used Native American imagery in a respectful manner as connected to its entertainment services - - the Board still concluded that the use of the term ‘redskin(s)’ was disparaging when used in the context of Pro-Football’s professional football club.” Opinion Below at 134. The District Court thus correctly found that that conclusion was not based on substantial evidence.

The TTAB erroneously found “the actions of the media and [Redskins Club’s] fans . . . probative of the general public’s perception of the word ‘redskin(s)’ as it appears in respondent’s marks herein.”²⁰ Harjo II at 1747. From the actions of others, it concluded that the term “redskin(s)” “retains its derogatory character” even when connected to football services. Id. But as the District Court pointed out, under this “logically flawed” finding, no professional sports team that uses Native American imagery would ever be permitted to keep its trademark registrations if the team’s fans or the media took any action or made any remark

²⁰ Again following its pattern of stating one test, then mis-applying that test to reach the result it apparently desired, the TTAB had stated just two lines earlier its belief that “we agree with [the Redskins Club] that it is not responsible for the actions of the media or fans.” Harjo II at 1747.

that could be construed as insulting to Native Americans. See Opinion Below at 134. Such an “expansive doctrine” is unacceptable, especially “when premised on a finding that is not supported by any substantial evidence.” Id.

Appellants and amici IFC now challenge the critical “context” aspect of the test for disparagement (for the first time). (Appellants’ Br. at 24, 26-28; Amici IFC Br. at 4-6.) Even if they could overcome waiver and judicial estoppel, their challenge is utterly flawed. Appellants thoroughly misread the Doughboy case in misstating the District Court’s holding as one that finds that a “derogatory” term can be used in connection with goods or services to “produce a non-disparaging trademark.” (Appellants’ Br. at 27.) Similarly, Amici IFC, inventing from whole cloth a per se approach to disparagement, reach the same flawed conclusion regarding ownership of an “inherently offensive” mark. (Amici IFC Br. at 6.)

Each assertion fails for at least two reasons. First, “disparag[ing],” not “offensive” or “derogatory” is the operative statutory term.²¹ 15 U.S.C. § 1052(a); see also Harjo II at 1738, 1740; Boswell, 52 U.S.P.Q.2d at 1607. Second, as numerous other Section 2(a) cases have held, examinations of challenged marks

²¹ Even Appellants’ linguistics expert Dr. Nunberg agrees, testifying below that “[d]isparaging and offensive are two different words and mean two different things.” (JA 220-22.) Dr. Nunberg further testified that the term “‘disparaging’ focuses more sharply” on the intent of the speaker to injure or harm, whereas “offensive” focuses on the reaction that the word would likely elicit from the person to whom it is directed or applied. (JA 223.) Thus, the speaker’s context is critical to the determination.

must take place within the context of the mark's use, because context is everything in the field of trademarks, where goods and services are linked to a specific indicator of source. See, e.g., In re Old Glory Condom Corp., 26 U.S.P.Q.2d at 1221 (allowing mark to use the American flag on condoms in light of the context of use); In re Hershey, 6 U.S.P.Q.2d at 1470 (allowing BIG PECKER mark on t-shirts bearing both the mark and a bird design); In re Leo Quan, 200 U.S.P.Q. 370 (T.T.A.B. 1978) (allowing BADASS bridges for musical instruments). In the trademark realm, "Apple" means one thing in connection to fruit, and has entirely another association in connection with computers; similarly, "Delta" can be faucets or an airline. Seen in their proper context, the Redskins Marks refer to the professional football team from Washington, as all parties, the TTAB and the District Court agree.²² Harjo II at 1741; Opinion Below at 126. The fact that virtually every media outlet in the nation uses the Redskins Marks without the slightest hint of a blush or pause, is powerful evidence of the Marks' meaning in their proper context.²³ See In re In Over Our Heads, 16 U.S.P.Q.2d at 1654

²² In fact, Appellants and their experts admitted — as they must — that, when applied to professional football, the term "Redskins" "denotes the Washington Redskins football team," and that this sports usage is "distinctive of [the] usage of the word . . . when applied to individuals." (JA 361-62.)

²³ As the TTAB noted when it rejected Appellants' claim that the Redskins Marks were "scandalous" under Section 2(a) (which finding Appellants did not appeal): "Such continuous renown in the sport of football and acceptance of the word 'Redskin(s)' in connection with respondent's football team is inconsistent with the sense of outrage by a substantial composite of

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(raising doubt that “major newspapers and magazines would have repeatedly used a term” if its meaning in context was disparaging).

None of Appellants’ submissions follow the “in context” rule. The Ross Survey is a classic, but hardly the only, example. Ross asked absolutely no questions concerning the use of the Redskins Marks in connection with football. See Harjo II at 1734. Rather, he asked whether respondents would be “offended” if the term “redskin” were used to refer to “an American Indian person;” Ross admitted that he had no opinion that a “particular person would think that the use of the word Redskins as a name of a football team is offensive.”²⁴ (JA 214; 218-19; 316; 330-31.) Thus, there was no survey evidence before the TTAB measuring the Redskins Marks as employed. Harjo II at 1734.

Appellants’ submissions actually suggest the conclusion that the Redskins Marks are not disparaging in context. For instance, Appellants’ linguistic expert Dr. Nunberg acknowledged that when the term “Redskin” is used as a trademark to

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the general population that would be necessary to find this word scandalous in the context of the subject marks and the identified services.” Harjo II at 1749.

²⁴ The District Court criticized the TTAB for ignoring the Ross Survey criticisms offered by the Redskins Club’s survey expert Dr. Jacob Jacoby that “there is absolutely nothing in [Dr. Ross’s] survey that would enable . . . an honest researcher [to] make an extrapolation that the use of the word Redskins as applied to a football team was offensive to Native American persons.” (JA 200-01.) The Court found that the TTAB “simply cast aside” Dr. Jacoby’s “highly detailed criticism,” an omission it deemed improper. Opinion Below at 120; see also Starter Corp. v. Converse, Inc., 170 F.3d 286, 296-97 (2d Cir. 1999) (finding survey defective due to failure to ask directly pertinent question).

identify a motorcycle, “the word . . . is not applied to Indians” and was not necessarily disparaging. (JA 358-360.) In 1977, the dictionary for which Dr. Nunberg now serves as Usage Editor and Usage Panel Chair defined the word “Redskins” as “The National Football League team from Washington.” (JA 198-99; 288-93.) Perhaps most tellingly, in his research of sixty newspapers from 1982 to 1996 to determine the number of instances in which the term “redskin” or “Redskin” appeared in those newspapers, Dr. Nunberg found more than 135,000 citations to the term, 134,690 of which referred to “Redskins” in the context of either the Washington Redskins or football. (JA 267-69.) The TTAB simply ignored this powerfully relevant evidence. Accordingly, the District Court properly reversed the Board’s conclusion of disparagement.

3. **Appellants’ Evidence Does Not Represent the Views of a Substantial Composite of Native Americans**

The TTAB held that “it is only logical that, in deciding whether the matter may be disparaging, we look, not to American society as a whole, . . . but to the views of the referenced group.” Harjo II at 1739. To determine the referenced group, the TTAB adopted the test from In re Hines, which looks to “the perceptions of ‘those referred to, identified or implicated in some recognizable manner by the involved mark.’” Harjo II at 1739-40 (citing In re Hines, 31 U.S.P.Q.2d 1685, 1688 (T.T.A.B.), vacated on other grounds 32 U.S.P.Q.2d 1376 (T.T.A.B. 1994)). The views of the referenced group, the Board concluded, are

“reasonably determined by the views of a substantial composite thereof.” Harjo II at 1739 (citing Hines, 31 U.S.P.Q.2d at 1688).

Despite having correctly stated this portion of the test for disparagement as limited to the views of Native Americans, the TTAB - - not five pages in the opinion later - - again failed to abide by its own articulated test:

we have found that the evidence supports the conclusion that a substantial composite of the general public finds the word ‘redskin(s)’ to be a derogatory term of reference for Native Americans. Thus, in the absence of evidence to the contrary, it is reasonable to infer that a substantial composite of Native Americans would similarly perceive the word.

Harjo II at 1743-44 (emphasis added). The TTAB, therefore, failed to consider the fact that there was no evidence to support the conclusion that the perceptions of Native Americans are the same as the perceptions of the general public, but instead improperly cited the lack of evidence to the contrary. The District Court properly rejected this approach: “[b]y concluding that the views of the general public were probative, the TTAB erred” and “[b]y focusing on the general public and inferring that the Native Americans would simply agree with those views, the TTAB made a decision unsupported by substantial evidence.” Opinion Below at 129.

Additionally, the TTAB “impermissibly shifted the burden” of proof to the Redskins Club by reaching its conclusion only because of an “absence of evidence to the contrary.” Id. The Redskins Club, however, was not required to disprove Appellants’ disparagement claim. Rather, Appellants bore the burden of proving

disparagement in the TTAB. This would be so even if the Redskins Club adduced no contrary evidence whatsoever, though such evidence was provided in abundance.

Appellants and amici IFC again, for the first time, raise objections to this portion of the test for disparagement.²⁵ (Appellants' Br. at 25-26, 32; Amici IFC Br. at 7-8.) Appellants now claim that the views of the general public are somehow relevant to this disparagement determination, and, thus, that the District Court must have "misread" the Hines case. (Appellants' Br. at 25.) This claim conveniently neglects the fact that, if the District Court misread Hines, so, too, must have the TTAB in its earlier determination in favor of Appellants and in other determinations, and so must have all trademark commentators on the matter. See Harjo II at 1739; Order Sons of Italy in America v. Memphis Mafia, Inc., 52 U.S.P.Q.2d 1364 (T.T.A.B. 1999); In re In Over Our Heads, 16 U.S.P.Q.2d at 1654; 3 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition §

²⁵ Notably, there is consistent inconsistency within Appellants' and Amici IFC's briefs. On the one hand, Appellants make reference to the quantum of evidence in this case "as to the views of the relevant public or the allegedly disparaged group," (Appellants' Br. at 19), yet just six pages later, they claim that the views of the general public are relevant to the determination of disparagement. (Id. at 25.) Not to be outpaced, Amici IFC change positions far more quickly: in one sentence they cite the "proper test" for disparagement as one that takes into account whether the matter disparages "a substantial composite of the subject group," and, incredibly, in the very next sentence, state without support that "[t]he holding in In re Hines that the views of the general public are 'irrelevant' for disparagement purposes is untenable." (Amici IFC Br. at 7.)

19:77.1 (4th ed. 2004); 1 J. Gilson, Trademark Protection and Practice §

3.04(6)(a)(i)(B)(I) (2004).

Appellants' and amici IFC's assertions regarding the relevancy of the general public's views in a determination of disparagement were, however, considered at length by the TTAB in Hines and were plainly rejected under any reading of that case:

“[i]n determining whether or not a mark is disparaging, the perceptions of the general public are irrelevant. Rather, because the portion of Section 2(a) proscribing disparaging marks targets certain persons, institutions or beliefs, only the perceptions of those referred to, identified or implicated in some recognizable manner by the involved mark are relevant to this determination.”

Hines, 31 U.S.P.Q.2d at 1688 (emphasis added) (citations omitted).

Appellants' desperately late reversal reflects one thing: now, as always, they completely lack proof of the views of any substantial composite of Native Americans, as they virtually admitted below. (See Defs' Opp'n to Pl's Summ. J. at 14-15.) Appellants proffered no evidence of polls or surveys or of a tribal-wide position of any of the more than 500 official Native American tribes in the United States during the relevant time frame or otherwise. (JA 555 [¶ 109].) Instead, they

chose to rely on the 1996 Ross telephone survey of Native Americans,²⁶ and on their own testimony.

Both the TTAB and the District Court noted the limitations of these submissions in attempting to assist the trier of fact in determining the views of a substantial composite of Native Americans. See Harjo II at 1743 n.113 (“The views of petitioners, alone, do not inform us of the views of a substantial composite of Native Americans.”); Opinion Below at 135 (Appellants’ testimony is a “reflection of their individual viewpoints and there is no evidence that [their] views are a reasonable proxy for a substantial composite of the entire Native American population”). The resolutions Appellants attempted to rely upon were equally lacking in probative value, as they were either adopted out of the relevant time frame, or were passed by groups having few or no Native American members,

²⁶ As noted supra, both the TTAB and the District Court noted many flaws in the Ross survey’s methodology (including that it took place nearly thirty years after the relevant time period; that it offered respondents located in only twelve out of the fifty states in the U.S.; that it did not even bother to limit its universe to those respondents who were alive in 1967; that it did not seek the views of respondents towards the Redskins Marks in their proper context, etc.) The District Court thus noted that the Ross Survey failed to support the TTAB’s disparagement finding with substantial evidence. See Opinion Below at 132-33 (noting that the survey results did not demonstrate that a “substantial composite” of Native Americans found the term “offensive,” much less disparaging); accord Gencom, Inc. v. FCC, 832 F.2d 171, 186 (D.C. Cir. 1987) (affirming that trial court properly excluded survey because of defects in survey universe).

or both. Id. at 135. In the case of the NCAI resolutions, raised again in amici NCAI's brief, they were both adopted out of the relevant time frame.²⁷

At base, there was almost no proof of disparagement in the TTAB, certainly not enough to constitute substantial evidence. Opinion Below at 135-36.

C. SUBSTANTIAL EVIDENCE EXISTS THAT THE REDSKINS MARKS WERE NOT DISPARAGING

Appellants attempt to shift the burden of proof on the issue of disparagement to the Redskins Club. (Appellants' Br. at 33 (claiming "plain error" in not requiring the Redskins to "present any evidence of its own rebutting the evidence in the record.") This misguided argument not only fails legally, see supra Part II.B.3, it also fails factually since there was substantial evidence before the TTAB to show that the Redskins Marks were not disparaging under the TTAB's test. Thus, once the irrelevant evidence proffered by Appellants was excluded, the remaining evidence only supported a finding of non-disparagement.

²⁷ At best, this resolution, and the others, constitute a self-serving attempt to buttress Appellants' claims after they filed the cancellation proceeding. See, e.g., Order Sons of Italy, 52 U.S.P.Q.2d at 1369. As the TTAB recognized, Appellants have significant ties to amici NCAI. See Harjo, et al. v. Pro-Football, Inc., 45 U.S.P.Q.2d 1789, 1998 WL 90884, at *4 (T.T.A.B. 1998). Some of the Appellants have held leadership positions in the NCAI and counsel for Appellants has represented NCAI. Id. And, unlike the bulk of the third party witnesses providing testimony and documents, NCAI engaged in a discovery dispute with Appellee on matters relating to this proceeding. Id.

1. **At the Relevant Times, When the Six Redskins Marks Were Registered, Each Reviewing USPTO Examiner Concluded that the Redskins Marks Did Not Disparage Native Americans**

The best record evidence of the non-disparaging nature of the Redskins Marks during the relevant time period and in the relevant context is contained within the contemporaneous file histories of each of the six subject trademark registrations, since each mark was examined by trademark examining attorneys for deficiencies including, inter alia, possible violations of Section 2(a). The Trademark Manual of Examining Procedure (“TMEP”), the USPTO’s handbook for its federal trademark examining attorneys, sets forth the scrutiny with which trademark examiners must examine each application, including an examination for unregistrable matter in connection with Section 2(a) of the Lanham Act. See TMEP at §§ 1203; 1203.03. Many of the Section 2(a) cases relied upon by Appellants, the Redskins and amici were initiated by an examining attorney’s refusal to register a trademark due to Section 2(a) concerns. See, e.g., Hines, 31 U.S.P.Q.2d at 1688; In re Old Glory Condom, 26 U.S.P.Q.2d at 1221; In re In Over Our Heads, 16 U.S.P.Q.2d 1653; In re Hershey, 6 U.S.P.Q.2d 1470.

This uniform agency approval of the Redskins Marks’ applications over several decades is not mere testimony of an interested party, but rather part of the undisputed history of the applications themselves. Again, no USPTO examiner, applying then-contemporary standards, ever refused registration of the Redskins

Club's marks based on Section 2(a). Yet this remarkably relevant evidence was totally ignored by the TTAB. If that is not in itself sufficiently telling, neither Appellants nor any other entity once objected to the registrability of the Redskins Marks until the petition for cancellation was filed some twenty-five years after the first of the registrations issued. Opinion Below at 106-07. The publications and subsequent registrations of the Redskins marks provided twelve separate notifications to Defendants beginning as early as 1967. Id. at 136 n.34.

Thus, the evidence is clear that, by 1967, with three decades and more of use behind it, the team trademark REDSKINS had taken on its own meaning, which is why no objective trademark examiner saw fit to object at a time when it counted.

2. **Evidence From Dictionaries During the Relevant Time Period Reflects that the Term "Redskins" Was Not Disparaging**

The District Court noted that, as to linguistic evidence from dictionaries, the TTAB "simply catalogued the evidence without making any specific findings of fact." Opinion Below at 108. Notably, virtually every one of the more than one hundred dictionaries in the record define "redskin" as, simply, "a North American Indian;" one 1977 dictionary even defined "Redskins" as "The National Football League Team from Washington." (See JA 157-70; 179-81; 198-99; 484-86; 683 [¶¶ 266-67].)

Similarly, the Board declined to make findings of fact regarding the use or lack thereof of usage labels, those indicators inserted into word entries by a dictionary's editorial board, because of the "contradictory opinions" of each side's experts, and only indicated that this material was considered "in the context of the entire record." Opinion Below at 109 (citing Harjo II at 1732). Dictionaries in existence in 1967 and 1974, when the Redskins' earlier registrations issued, typically did not contain any usage label for the word "redskin."²⁸ See, e.g., In re In Over Our Heads, Inc., 16 U.S.P.Q.2d at 1654 n.4 (citing absence of negative labels for "Moonies" in finding mark not disparaging). Though the TTAB observed that half of the dictionaries in the record contained a usage label, those that did were typically usage labels indicating, for example, that the word "redskin(s)" is "often offensive," "informal," or "offensive slang." Opinion Below at 130 (citing Harjo II at 1744). As noted supra, disparage, not "offensive" is the operative statutory term. See 15 U.S.C. § 1052(a).

Still, despite the fact that half of the dictionaries had no usage labels, the TTAB drew a conclusion that "redskin(s)" has been understood to be an "offensive reference to Native Americans since at least 1966." Opinion Below at 130 (citing Harjo II at 1744). The District Court properly noted that the TTAB made no

²⁸ See JA 683 [¶ 266].

findings of fact to support its conclusion, id., then went on to state, logically, that a conclusion that states that the term “redskin(s)” is “often offensive,” means that in certain contexts the term “redskin(s)” was not considered offensive. Id. (citing Pl.’s Mot. for Summ. J. at 27). Because the TTAB had earlier concluded that the term “redskin(s)” means both a Native American and the Washington-area professional football team, the fact that it is “often” offensive may mean the term is only offensive in one of these contexts. Id.

III. THE DISTRICT COURT PROPERLY EXERCISED ITS DISCRETION AND APPLIED THE DOCTRINE OF LACHES

The District Court properly granted the Redskins Club’s motion for summary judgment on the defense of laches. Opinion Below at 136. Appellants should not be permitted to challenge the validity of the Redskins’ federal trademark registrations after staying silent for more than twenty-five years as to those registrations. See NAACP v. NAACP Legal Def. and Educ. Fund, Inc., 753 F.2d 131, 137-38 (D.C. Cir. 1985). The TTAB improperly concluded that laches was unavailable to the Redskins Club. Harjo I at 1831. The result of that ruling was that laches was before the District Court for the first time in the decade-long history of the litigation.

As an initial matter, 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. See Opinion Below at 136. Noting that "[t]he best time to resolve this case was 1967 or shortly thereafter," the Court stated that Appellants' delay directly led to the lack of any "direct or circumstantial evidence in the record that, at the times the trademarks were registered, the trademarks at issue were disparaging." Id. (citing NAACP, 753 F.2d at 137, for the proposition that "[p]laintiffs are encouraged to file suits when courts are in the best position to resolve disputes"). Thus, the Court found itself "handicapped in resolving this case because of the Defendants' delay. Therefore, the problem of laches correlates, to some degree, with the Court's finding that the TTAB's decision is not supported by substantial evidence." Opinion Below at 136.

The District Court correctly stated this Circuit's laches test, modified to fit the instant case, as follows: to succeed on laches, the Redskins Club need only prove that "(1) the Native Americans delayed substantially before commencing their challenge to the 'Redskins' trademarks; (2) the Native Americans were aware of the trademarks during the period of delay; and (3) Pro-Football's ongoing development of goodwill during the period of delay engendered a reliance interest in the preservation of the trademarks."²⁹ Harjo III at 1144 (citing NAACP, 753

²⁹ The Court also noted that it would apply the laches test separately to each of the Redskins Marks, in considering the various periods of substantial delay, ranging from a two year delay for

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F.2d at 137). The Redskins Club satisfied all three of these elements. The District Court, accordingly, properly granted summary judgment. See, e.g., NAACP, 753 F.2d at 138.

A. LACHES IS AVAILABLE IN A SECTION 2(A) PROCEEDING

The District Court found that, on the basis of the specific facts and circumstances of this case, laches was an available defense to the Redskins Club. Opinion Below at 137. The Federal Circuit agreed when it held that “equitable defenses of laches and estoppel are not barred in § 2(a) false suggestion cases, absent misrepresentation or deceit.” Bridgestone/Firestone Research, Inc. v. Auto. Club de L’Ouest de la France, 245 F.3d 1359, 1363 (Fed. Cir. 2001). Notably, though both parties relied heavily on the Bridgestone case below, Appellants now fail even to mention it.³⁰ Laches is not only available as a defense under cancellation petitions brought under Section 2(a), but summary judgment is well-recognized as a proper means of adjudicating a laches defense. See cases collected supra Part I.C.

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the 1990 mark to a twenty-five year delay for the 1967 mark. Opinion Below at 137. Appellants concede that this is the “correct” approach. (Appellants’ Br. at 43.)

³⁰ Appellants instead attempt to rely on Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189 (1985), though this reliance is misplaced since Park ‘N Fly was not a Section 2(a) case. (Appellants’ Br. at 34.) Park ‘N Fly concerned a counterclaim for cancellation of an incontestable trademark registration on the grounds that the registered mark was merely descriptive. Park ‘N Fly, 469 U.S. at 191. The Court in Park ‘N Fly specifically stated that “[w]e note . . . that we need not address in this case whether traditional equitable defenses such as estoppel or laches are available in an action to enforce an incontestable mark.” Id. at 203 n.7.

Even more unusual is Appellants' contention that the District Court "should have . . . remanded the issue [of laches] to the TTAB for findings of fact."

(Appellants' Br. at 39-40.) Appellants cite no authority for this proposition, and never describe why they believe this proposed action to be the correct path. (*Id.*) The District Court's discussion and findings as to laches were not an appeal or an agency review; rather, the District Court considered the laches claim as a trial court. During the nearly three years that this case was pending at the District Court, the parties conducted discovery as to laches, including taking depositions and producing myriad documents. A full evidentiary record was developed, and both parties cross-moved for summary judgment, itself establishing there were no material disputed facts. Thus, there was no justification (not to mention no authority) for the District Court to remand the issue of laches to the TTAB.

B. APPELLANTS DELAYED SUBSTANTIALLY BEFORE COMMENCING THEIR CHALLENGE TO THE REDSKINS MARKS

The Court found that Appellants substantially delayed in bringing a challenge to the Redskins marks as a matter of law. Opinion Below at 139. The delay here was twenty-five years from the registration of the first Redskins mark (and sixty years after its first use in commerce). *Id.* Indeed, Appellants "do not dispute that they have long known about and objected to the name of the Washington football franchise." *Id.* at 140 (citing Defs' Opp'n to Pl's Mot. for Summ. J. at 23). In their instant appeal, Appellants appear to admit that there was

substantial delay as to all Appellants except Appellant Romero, and to all the Redskins Marks' registrations except the final one in 1990 (for the cheerleaders mark, REDSKINETTES). (Appellants' Br. at 40.)

The District Court found that for all six trademarks (and for all seven Appellants) the delay was substantial. Opinion Below at 139-40. In the case of the five Redskins Marks registered in 1967, 1974, and 1978, the delay "was substantial on its face." Id. at 140; accord NAACP, 753 F.2d at 138 (finding a thirteen-year delay barred claim due to laches).³¹ Appellants now argue that there was no substantial delay in their petition to cancel the REDSKINETTES cheerleaders mark, and claim that the District Court "did not perform a separate analysis" for each registration. (Appellants' Br. at 43.) Both of these claims are specious. The Court spent nearly half a page of its opinion discussing the REDSKINETTES registration. Opinion Below at 140. The Court found that, though the mark was only registered in 1990, it had been in use since 1962 (nearly thirty years before Petitioners brought their cancellation proceeding). Id. ("this is not a case where the mark was introduced in 1990"). Moreover, "the delay does

³¹ Defendants' delay was also substantially greater than other cases in which courts in this Circuit have applied the laches doctrine in other contexts. See, e.g., Jeanblanc v. Oliver Carr Co., 62 F.3d 424, No. 94-7118, 1995 WL 418667 at *4 (D.C. Cir. June 21, 1995) (finding delay of nearly eight years unreasonable and finding claim barred by laches); Nat'l Parks and Conservation Ass'n v. Hodel, 679 F. Supp. 49, 53-54 (D.D.C. 1987) (three years); Peshlakai v. Duncan, 476 F. Supp. 1247, 1256 (D.D.C. 1979) (seven years); Gerstendorfer Bros. v. United Supply Co., 26 F.2d 564 (D.C. Cir. 1928) (fifteen years).

not exist in a vacuum,” as all six of the challenged marks contain the term “Redskins.” Id. Appellants admit that laches can be held applicable to marks that are substantially similar, (Appellants’ Br. at 44), as they unquestionably are here. See Copperweld Corp. v. Astralloy-Vulcan Corp., 196 U.S.P.Q. 585, 590-91 (T.T.A.B. 1977) (laches applied to opposition to registration of mark ASTRALLOY-V, based upon opposer’s failure to object to applicant’s earlier registration of ASTRALLOY mark).

Appellants also claim that Appellant Romero should not be imputed with the substantial delay of his fellow petitioners. But, as the District Court noted, this argument only lends credence to the lack of evidence during the earlier, relevant time period, that Native Americans did not find the Marks disparaging. See Opinion Below at 141 n.36. Such an argument would logically mean that trademark owners could 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. Id. The exception would inevitably swallow the rule. The lengthy inaction by Appellants before 1992 has “engendered a presumption that Pro-Football reasonably relied on such inaction.”³²

³² Id. at 140 (citing NAACP, 753 F.2d at 139 (“The passing of almost thirteen years without any clear reservation of rights by the Association creates a presumption of reasonable reliance.”)).

C. APPELLANTS ADMITTEDLY HAD ACTUAL AND CONSTRUCTIVE NOTICE OF THE REDSKINS MARKS DURING THE PERIOD OF DELAY

As mentioned supra Part II.C.1, Appellants had twelve separate occasions of constructive notice when the six marks were each published and registered at the PTO. Opinion Below at 140 (citing National Cable Television Ass'n, Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 1581 (Fed. Cir. 1991)); see also 15 U.S.C. § 1072 (registration on the Principal Register shall be constructive notice of the claim of ownership). Moreover, each Appellant testified that he or she had actually known about the Washington Redskins football franchise for many years during the lengthy delay. (JA 536-37; 542-45 [¶¶ 16-20, 45-61].) Appellants also stated in their pleadings below that they “do not dispute that they have long known about and objected to the name of the Washington football franchise.” Opinion Below at 141 (citing Defs’ Opp’n to Pl’s Mot. for Summ. J. at 23).

Most notably, appellant Deloria, an attorney, admitted during deposition that he had wanted to take action against companies that used Native American symbols as marks in the mid 1960s, but could not convince his tribal elders to “take on the trademarks.” (JA 366-67.) Accordingly, the District Court properly found that Petitioners were aware of the Redskins Marks during the period of delay under a theory of actual or constructive notice.

D. THE REDSKINS' ONGOING DEVELOPMENT OF GOODWILL DURING THE PERIOD OF DELAY ENGENDERED A RELIANCE INTEREST IN THE PRESERVATION OF THE REDSKINS MARKS

As to the third prong of this Court's laches test, the District Court found that Appellants' substantial and unexplained delay in bringing its petition for cancellation worked to prejudice the Redskins Club. Opinion Below at 142.

Noting that there must be some "detriment due to the delay," id. (citing Bridgestone, 245 F.3d at 1362), the District Court correctly stated that the test for economic prejudice in a trademark case is that "prejudice is equated with investment in the trademark that theoretically could have been diverted elsewhere had the suit been brought sooner." Opinion Below at 143 (citing Hot Wax, Inc. v. Turtle Wax, Inc., 191 F.3d 813, 824 (7th Cir. 1999) (the longer the use and the lengthier the period of delay, the lighter the burden of showing economic prejudice in support of the defense of laches)). Therefore, given the specific facts and circumstances of this case, the Court found there was:

no dispute that in this case Pro-Football has invested heavily in the marketing and development of its brand during the period of delay. . . . In the instant case, because the delay in bringing the cancellation proceeding was so substantial, a presumption is created that Pro-Football was entitled to rely on the security of the trademarks at issue. In 1967, the NFL was still a nascent industry. Had this suit been brought at that point, Pro-Football may have acquiesced and changed the name. The twenty-five year delay, where Pro-Football has invested so heavily in the marks, has clearly resulted in economic prejudice.

Opinion Below at 143 (emphasis added) (citing Defs' Opp'n to Pl's Mot. for Summ. J. at 31, for the admission that Appellants "acknowledge . . . Pro-Football's and NFLP's advertising expenditures since 1967, the revenue earned from merchandise bearing the Marks, and the considerable revenue from tickets and TV contracts").

Appellants' arguments to the contrary are unsupportable. (Appellants' Br. at 41-43.) First, Appellants again question whether the Redskins Club will be prejudiced by the cancellation of the Redskins marks. (Id. at 41.) But "common sense dictates that Pro-Football will suffer some economic hardship. Otherwise, there would be no point to this litigation being used as a vehicle to force Pro-Football to change the name of the team." Opinion Below at 144; accord Bridgestone, 245 F.3d at 1363; Hot Wax, 191 F.3d at 821, 824; Conopco, Inc. v. Campbell Soup Co., 95 F.3d 187, 192-93 (2d Cir. 1996) (showing prejudice from delay to party who might have chosen alternative position).

Next, Appellants claim that they "do not seek to cancel Pro-Football's registrations because they want to impose economic harm upon Pro-Football" (Appellants' Br. at 42.) Appellants' assertion is belied, however, by the many comments on the record by Appellants and their counsel throughout the more than decade-long history of this litigation. Appellant Harjo, for example, has repeatedly called this a "pocketbook-incentive lawsuit," (see e.g., JA 464-69), while

Appellants' counsel noted that the TTAB's 1999 decision would "take away the economic incentive for [the Redskins] to continue using the mark" thereby "killing a key source of team revenue." (JA 463.) Appellants clearly intend to cause economic harm to the Redskins Club. Yet, even if their rather incredible claim that they intend no harm is to be taken at face value in spite of the foregoing, their intentions are irrelevant as harm has indeed occurred, intentional or not.

Finally, without citation to authority, both Appellants and amici NCAI offer an internally inconsistent argument: on one hand, they argue that the Redskins were wrong to rely on Appellants' inaction because they say they protested vigorously throughout the relevant time (Appellants' Br. at 43; Amici NCAI Br. at 17, 20); yet, on the other hand, they contend they were too busy protesting to litigate, and thus could not have brought this proceeding earlier. (Amici NCAI Br. at 30-33.) Though the Redskins Club may have been aware of protests by some groups to the team name, such awareness of a threat of litigation does not mitigate the reliance upon a party's inaction over time. Indeed, it only makes that reliance more reasonable, given the failure to follow through on these threats. See, e.g., NAACP, 753 F.2d at 139 (reasoning that threats of litigation which are not followed through create a reasonable reliance based both upon plaintiff's passivity and its affirmative acts); Ancient Egyptian Arabic Order of Nobles of the Mystic Shrine v. Michaux, 279 U.S. 737 (1929); Creswill v. Grand Lodge Knights of

Pythias of Georgia, 225 U.S. 246 (1912). Having made a conscious choice not to petition for over twenty-five years, even though - - admittedly - - Appellant Deloria wanted to “take on the trademarks” in the early 1970s, and a major Native American activist filed a libel suit against the Cleveland Indians professional baseball team in 1972, (Amici NCAI Br. at 17), Appellants must now live by the legal consequences of their inaction.

E. THE REDSKINS CLUB SUFFERED TRIAL PREJUDICE DURING THE PERIOD OF DELAY

As noted supra, the District Court found that Appellants’ lack of substantial evidence on the issue of disparagement “correlates” to Appellants’ substantial delay in bringing their case. Opinion Below at 136. This is especially notable in assessing the issue of trial prejudice, which Appellants notably ignore.³³ The Redskins Club pleaded both economic and trial prejudice below, and noted the numerous missing financial and team records and witnesses from the intervening years of Appellants’ delay. Because the Court found economic prejudice due to the Redskins reliance on Appellants’ delay, it did not specifically reach the issue of trial prejudice, but did point out that “defending this lawsuit against evidence that,

³³ Prejudice, in a laches context, may take the form of economic prejudice (as loss of time or money or foregone opportunity) or trial prejudice (as loss of evidence or memory/availability of witnesses). See Opinion Below at 142-43; Bridgestone, 245 F.3d at 1362.

due to the twenty-five year delay, does not directly address the legal question at issue, would represent a hardship to Pro-Football.” Id. at 143 n.37.

Appellants’ delay has resulted in a loss of documentary evidence and witnesses that were likely to support the Redskins’ position. In the intervening twenty-five years between the registration of the Redskins Marks and filing of the cancellation proceeding, a crucial evidentiary trail has gone cold with respect to one of the central issues to be determined in this case: “whether, at the times respondent was issued each of its challenged registrations, the respondent’s registered marks consisted of or comprised . . . matter which may disparage Native American persons, or matter which may bring Native American persons into contempt or disrepute.” Harjo II at 1735 (emphasis added). Given Appellants’ unreasonable twenty-five year delay, conducting an appropriate survey to determine the public perception of the meaning of the Redskins Marks as of the relevant time frame is impossible, several important witnesses are deceased, and documents can no longer be located or no longer exist. (See JA 481 [¶ 20]; 526-30 [¶¶ 7, 19, 25-26]; 535; 545; 551; 577 [¶¶ 8, 62-63, 65, 86, 254]); see also Bridgestone, 245 F.3d at 1362; NAACP, 753 F.2d at 137 (delay means that “claims become increasingly stale [and] pertinent evidence lost”). As a result, Appellants have “gain[ed] the unfair advantage of hindsight,” while the Redskins Club

“suffer[ed] the disadvantage of an uncertain future outcome.” NAACP, 753 F.2d at 137.

F. THE PUBLIC INTERESTS INVOLVED FAVOR THE REDSKINS CLUB

Having found that laches was applicable under the undisputed facts, the District Court considered the competing private and public interests at issue here. Appellants had attempted to argue below that, where a “public interest” is involved, laches is unavailable. However, as mentioned supra, they relied on the Bridgestone case for this proposition - - a Section 2(a) case that actually found that laches was available. Opinion Below at 137 (citing Bridgestone, 245 F.3d at 1361). Additionally, the Court noted that “[t]he problem with Defendants’ argument is that it has no limit. Any public interest that seeks vindication under section 2(a) would not be subject to a laches defense.” Id. at 138. Clearly, if long-registered marks could be subject to attack at any point in time, the entire policy of seeking federal trademark protection in the first place would be seriously undermined. Id. at 139. That is “particularly true given the fact that the Defendants claim that the marks have been disparaging during this entire time frame and readily admit that they have been aware of the trademarks during this entire time frame.” Id.

As the District Court noted, significant public policy concerns weigh heavily in favor of the Redskins Club here. The Redskins Club, as a brand owner with

long-held, famous trademarks, has an undisputed substantial interest in being able to rely on federal trademark registrations it has held for many years, and in being able to continue to develop, without fear of interference, the goodwill that has come to be symbolized by such federally-registered marks as a result of its substantial investment.³⁴ Similarly, “[i]t is in the public interest to maintain registrations of technically good trademarks on the register so long as they are still in use.” Morehouse Mfg. Corp. v. J. Strickland & Co., 407 F.2d 881, 888 (C.C.P.A. 1969). The public also has an interest in freedom of speech that would be jeopardized by Appellants’ petition that asks the government to penalize constitutionally-protected expression. See Carl v. Children’s Hosp., 702 A.2d 159, 185 (D.C. App. 1997) (per curiam) (Schwelb, J., concurring) (“We add the obvious: the public also has an interest in the free expression of ideas on public and other issues.”). These public and private interests outweigh any purported interest asserted by Appellants. Though Appellants cite their “public” interests, Appellants admittedly only act in their individual capacities in filing their petition for cancellation; they do not represent any tribes or groups. (See JA 16-19.)

³⁴ Amici NCAI’s statement that “laches generally does not bar injunctive relief against ongoing infringement,” (Amici NCAI Br. at 32), misses the point. Leaving aside the fact that trademark infringement is not at issue here, the Bridgestone court made clear, “the notion of a ‘continuing wrong’ is a strong justification for application of the doctrine of laches, for a party aggrieved by a trademark use could delay filing suit indefinitely, while prejudice to the trademark user increases.” Bridgestone, 245 F.3d at 1364 (citing Hot Wax, 191 F.3d at 821) (emphasis added).

Appellants also herein attempt to revive their argument, dismissed at the TTAB five years ago, that “the unique status of native Americans” should shield them as “wards of the nation” under the Indian Trust Doctrine. (Appellants’ Br. at 37.) As an initial matter, the TTAB found “no basis for extending the Indian trust doctrine to the Trademark Act in the case before us,” a determination which Appellants did not contest below, and thereby failed to preserve for appeal. Harjo II at 1713. Anyway, the fiduciary duty so described arises only when there exists an agreement between the federal government and a Native American tribe in an arena where the tribe has a specific economic interest. See United States v. Mitchell, 463 U.S. 206 (1983). The TTAB further stated that it “found no decisional law addressing the Indian trust doctrine in the context of a patent, trademark or copyright case.” Harjo II at 1712. Neither did the Board find any “specific item of Native American intellectual property” at issue to even consider warranting the imposition of the Indian trust doctrine. Id. at 1713. Thus, the Board found, the trust doctrine cannot apply in the absence of an “identifiable trust corpus.” Id.

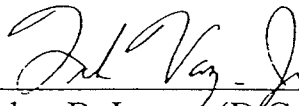
Appellants’ petition implicated no “public” interest. Therefore, the private interests of the Redskins coupled with the public interest in not canceling the Redskins Marks outweigh Appellants’ individual personal interests in this case.

CONCLUSION

For all of the foregoing reasons, Appellee Pro-Football, Inc. respectfully requests that this Court affirm the decision of the District Court in its entirety.

Dated: October 18, 2004

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

Pursuant to Local Circuit Rule 32(a)(3)(C), the undersigned certifies that this brief complies with the type-volume limitations of Federal Rule of Appellate Procedure 32(a)(7)(C).

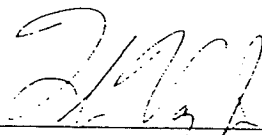
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ADDENDUM - - UNPUBLISHED OPINIONS

- 1) Dick's Sporting Goods, Inc. v. Dick's Clothing and Sporting Goods, 188 F.3d 501, No. 98-1653, 1999 WL 639165 (4th Cir. Aug. 20, 1999)
- 2) Jeanblanc v. Oliver Carr Co., 62 F.3d 424, No. 94-7118, 1995 WL 418667 (D.C. Cir. June 21, 1995)

▽

Briefs and Other Related Documents

NOTICE: THIS IS AN UNPUBLISHED OPINION.

(The Court's decision is referenced in a "Table of Decisions Without Reported Opinions" appearing in the Federal Reporter. Use FI CTA4 Rule 36 for rules regarding the citation of unpublished opinions.)

United States Court of Appeals, Fourth Circuit.

DICK'S SPORTING GOODS, INCORPORATED,
Plaintiff-Appellant,
and

Gary Shank, d/b/a Dick's Sporting Goods, Incorporated,
Plaintiff,

v.

DICK'S CLOTHING AND SPORTING GOODS,
INCORPORATED; Richard's Clothing And
Sporting Goods, Incorporated, d/b/a Dick's Clothing and
Sporting Goods,
Incorporated, Defendants-Appellees.

No. 98-1653.

Argued March 3, 1999.
Decided Aug. 20, 1999.

Appeal from the United States District Court for the District of Maryland, at Baltimore, No. CA-96-320-L; Benson E. Legg, District Judge.

Richard Michael McMahon, Sr., Scally, Scally & McMahon, P.C., Upperco, Maryland, for Appellant.

Steven Keith Fedder, Rudnick & Wolfe, Washington, D.C., for Appellees.

ON BRIEF: Caroline E. Petro, Rudnick & Wolfe, Washington, D.C., for Appellees.

Before TRAXLER, Circuit Judge, VOORHEES, United States District Judge for the Western District of North Carolina, sitting by designation, and FABER, United States District Judge for the Southern District of West Virginia, sitting by designation.

OPINION

VOORHEES.

**1 Plaintiff-Appellant, Dick's Sporting Goods, Inc. sued

Defendant-Appellee Dick's Clothing & Sporting Goods, Inc. alleging trade name infringement and unfair competition. [FN1] Dick's Clothing & Sporting Goods, Inc. filed a counterclaim against Dick's Sporting Goods, Inc. alleging infringement of its federally licensed trade name, "Dick's Clothing & Sporting Goods, Inc." See 15 U.S.C. § 1051, et seq. The district court granted Dick's Clothing & Sporting Goods, Inc.'s motion for summary judgment on the complaint and on its counterclaim. We affirm.

[FN1] Appellant also alleged intentional infliction of emotional distress and conversion. Upon motion of Appellee, the district court dismissed those claims. Appellant has not appealed those dismissals.

I. FACTS

Dick's Sporting Goods, Inc. ("Sporting") is a small retail sporting goods business founded in 1971 by Richard Shank. At all times, Sporting operated out of a single location on Stemmers Run Road in Essex, Maryland. The store sold hunting and fishing gear including clothing, hunting and fishing licenses, bait, archery equipment, guns, and ammunition. In May 1998, Sporting closed its store.

In January 1948, Richard Stack founded Dick's Clothing & Sporting Goods, Inc. ("Clothing") and opened its first store in Binghamton, New York. As of 1995, Clothing operated approximately 51 stores across several states including New York, Connecticut, Pennsylvania, Massachusetts, Illinois, Ohio, Kentucky, New Jersey, Michigan, and Maryland. Clothing's stores sell general sports apparel, sporting goods, and children's apparel.

On May 9, 1988, Clothing applied to the United States Patent and Trademark Office seeking registration for the trade name "Dick's Clothing & Sporting Goods, Inc." On June 27, 1989, Clothing's proposed trade name was published in the federal register. On September 19, 1989, the United States Patent and Trademark Office issued registration number 1557325 for "Dick's Clothing & Sporting Goods." In 1994, the trade name "Dick's Clothing & Sporting Goods" became incontestible under the Lanham Act. At no time has Sporting contested the trademark sought by Clothing or obtained a federally registered trademark of its own.

On October 6, 1995, Clothing opened retail stores in the State of Maryland. Upon seeking to register as a foreign corporation with the state, Clothing learned that Sporting had filed articles of incorporation with the Maryland State Department of Assessment and Taxation in July 1995,

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gaining incorporation as "Dick's Clothing & Sporting Goods, Inc." Sporting sought and gained incorporation in the name of "Dick's Clothing & Sporting Goods, Inc." although the record contains no evidence that Sporting had ever conducted business in that name. Thereafter, Clothing registered with the state as "Richard's Sporting & Goods, Inc. a/k/a Dick's Clothing and Sporting Goods, Inc." Although Sporting concedes that it incorporated a shell entity, it denies infringing upon Clothing's federally registered trade name and contends that it registered the shell corporation preemptively merely to avoid confusion of its business name with that of Clothing.

**2 To promote the opening of its Maryland stores, Clothing organized an advertising campaign in which it employed the names "Dick's" and "Dick's Sporting Goods." Sporting claims that it was barraged with over 7,500 misdirected telephone calls and a plethora of misdirected mail as a result of Clothing's advertising campaign. In addition, Sporting asserts that several customers visited its store believing they were visiting Clothing's store.

We review *de novo* the holding of the district court that Sporting failed to demonstrate that its trade name, "Dick's" or "Dick's Sporting Goods" had acquired secondary meaning in the minds of a substantial portion of the consuming public as of 1989, the year in which Clothing registered its trademark.

II. STANDARD OF REVIEW

We review a district court's grant of summary judgment *de novo* and apply the same standards employed by the district court. See *Felty v. Graves-Humphreys Co.*, 818 F.2d 1126, 1127-28 (4th Cir.1987). Summary judgment is appropriate only where there is "no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law." Fed.R.Civ.P. 56(c). In other words, to grant summary judgment the court must determine that no reasonable jury could find for the nonmoving party on the evidence before it. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248, 106 S.Ct. 2505, 91 L.Ed.2d 202 (1986). "In passing on a summary judgment motion, the court must view the record and draw inferences most favorably to the opposing party." *Pignons S.A. de Mecanique v. Polaroid Corp.*, 657 F.2d 482, 486 (1st Cir.1981).

III. TRADEMARK PROTECTION AND CLASSIFICATION

Section 43(a) of the Lanham Act, prohibiting the use of false descriptions, representations, or designations of origin, has been construed to protect against trademark, service mark, and trade name infringement even though the mark or

name has not been federally registered. 15 U.S.C. § 1125(a); *Lois Sportswear, U.S.A., Inc. v. Levi Strauss & Co.*, 799 F.2d 867, 871 (2d Cir.1986). In order to prevail in an action for trademark infringement and unfair competition under sections 32(1) and 43(a) of the Lanham Act, respectively, "a complainant must demonstrate: (1) that it has a valid, protectable trademark; and (2) that the defendant's use of a colorable imitation of the trademark is likely to cause confusion among consumers." *Lone Star Steakhouse & Saloon, Inc. v. Alpha of Va., Inc.*, 43 F.3d 922, 930 (4th Cir.1995); see also 15 U.S.C. § 1114(1).

In the instant appeal, Sporting merges the above requirements in its arguments to the Court despite the fact that the district court did not hinge its ruling on a finding of likelihood of confusion. Rather, the district court found that Sporting did not own common law rights to the trade name, "Dick's" or "Dick's Sporting Goods" in that Sporting had failed to demonstrate that the trade name had acquired secondary meaning in the minds of the consuming public by 1989, the year Clothing registered its trademark. For this reason, the district court was not required to examine the issue of likelihood of confusion. See *Spartan Food Systems, Inc. v. HFS Corp.*, 813 F.2d 1279, 1284 (4th Cir.1987); *Thompson Medical Co. v. Pfizer*, 753 F.2d 208, 216 (2d Cir.1985). Such an inquiry would have been superfluous because a determination that a mark is ineligible for protection establishes that consumers do not associate that mark with a particular source.

**3 The Lanham Act affords nationwide trademark protection to registered users, regardless of the area in which the registrant actually uses the mark. 15 U.S.C. § 1072; *Armand Subway, Inc. v. Doctor's Associates, Inc.*, 604 F.2d 849, 849 (4th Cir.1979). However, the protection is only potential in areas where the registrant does not do business. A competing user could use the mark in those areas until the registrant extended its business to the area in question. Thereupon, the registrant would be entitled to exclusive use of the mark in that area unless the prior user could show that it acquired a local, common law right to the mark before the date of the mark's registration. 15 U.S.C. § 1065; see also *Armand Subway*, 604 F.2d at 849-50; *First Bank v. First Bank System, Inc.*, 84 F.3d 1040, 1044 (8th Cir.1996). Accordingly, Clothing may prevent Sporting from using the trade name "Dick's" or "Dick's Sporting Goods" in the Baltimore, Maryland area unless Sporting can show that it acquired a local, common law right in the trade name by 1989.

The protection accorded trademarks is directly related to the mark's distinctiveness. In *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir.1976), the Court

classified the word "marks" into four categories: (1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful. *Id.* at 9. If a term is generic (the common descriptive name for a thing), then it is ineligible for trademark protection as the public has an inherent right to call a product by its generic name. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 119, 59 S.Ct. 109, 83 L.Ed. 73 (1938). If terms are suggestive (words partially descriptive and partially fanciful), arbitrary (common words applied in unfamiliar ways), or fanciful (words invented solely for their use as trademarks), then the association between the mark and its source is presumed and the mark is eligible for trademark protection. *Abercrombie & Fitch*, 537 F.2d at 9-11.

However, if a mark is merely descriptive, then proof of secondary meaning in the marketplace is required for the mark to be eligible for protection. *Thompson Medical*, 753 F.2d at 212-13 & n. 9. Both surnames and first names are regarded as descriptive terms and, therefore, one who claims federal trademark rights in a name must prove that the name has acquired a secondary meaning. *Tonawanda Street Corp. v. Fay's Drug Co.*, 842 F.2d 643, 648-49 (2d Cir.1988). "Secondary meaning" is defined as "the consuming public's understanding that the mark, when used in context, refers not to what the descriptive word ordinarily describes, but to the particular business that the mark is meant to identify." *Perini Corp. v. Perini Constr., Inc.*, 915 F.2d 121, 125 (4th Cir.1990). In the case of a trade name, secondary meaning is "[t]he power of a name ... to symbolize a particular business." *Ideal Toy Corp. v. Kenner Products Div'n of General Mills Fun Group, Inc.*, 443 F.Supp. 291, 305 n. 14 (S.D.N.Y.1977). If a trade name has not acquired secondary meaning, the purchaser will not make an association with a particular producer and thus will not be misled by an identical or similar mark.

A. Secondary Meaning

**4 Proof of secondary meaning entails a rigorous evidentiary standard. "The burden of proving secondary meaning is on the party asserting it, whether he is the plaintiff in an infringement action or the applicant for federal trademark registration." *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 1578-79 (Fed.Cir.1988); accord *815 Tonawanda Street Corp. v. Fay's Drug Co., Inc.*, 842 F.2d 643, 647-48 (2d Cir.1988) (noting that the burden of proving secondary meaning is on the party seeking to obtain legal protection for its mark). Moreover, a certificate of registration constitutes prima facie evidence of the validity of the registered mark and relieves the holder of the burden of proving secondary meaning. 15 U.S.C. § 1057(b) (1997); *Qualitex Co. v. Jacobson Products Co., Inc.*, 13 F.3d 1297, 1301 (9th

Cir.1994), *rev'd on other grounds*, 514 U.S. 159, 115 S.Ct. 1300, 131 L.Ed.2d 248 (1995). The burden of proof, therefore, is on Sporting to prove that it is entitled to common law trademark protection.

The Second Circuit has promulgated six factors adopted by this Court as relevant to, though not dispositive of, secondary meaning: (1) advertising expenditures; (2) consumer studies linking the mark to a source; (3) sales success; (4) unsolicited media coverage; (5) attempts to plagiarize the mark; and (6) the length and exclusivity of the mark's use. *Thompson Medical*, 753 F.2d at 217; *Perini*, 915 F.2d at 125. "In assessing the existence of secondary meaning, no single factor is determinative ... and every element need not be proved. Each case, therefore, must be resolved by reference to the relevant factual calculus." *Thompson Medical*, 753 F.2d at 217.

B. Evaluation of the Evidence

Sporting concedes that the district court properly relied upon *Perini* as the relevant law. In support of its claim, Sporting proffered the following evidence to the district court: (1) a trade name survey conducted by Robert L. Mead ("Mead Report"); (2) the expert witness opinion of Gary D. Krugman ("Krugman Opinion"); (3) its gross sales and advertising figures for the years 1984 through 1989; (4) fifteen customer affidavits; (5) sixty five customer checks made payable to "Dick's"; (6) details regarding a waterfowl calling seminar organized in 1982; and (7) a 1982 newspaper article mentioning its store in reporting on the increasing use of decoys by Maryland hunters. For the reasons explained below, we affirm the district court's grant of summary judgment to Clothing on the complaint and on Clothing's counterclaim.

Evaluating Sporting's evidence separately, the Court will first address the Mead Report. The Mead Report is a telephone survey conducted by the staff of Robert L. Mead on November 26 and 27, 1996. Mead's staff interviewed 200 men over the age of 25 who had lived in the Baltimore area for more than three years and who expressed an interest in hunting or fishing. Mead submits that 48 of these men were licensed hunters and 22 of them associated the name "Dick's" with Sporting's store. In addition, Mead reports that 32% of 126 men who bought hunting and/or fishing licenses (i.e., 40 individuals) associated the name "Dick's" with Sporting's store. Finally, Mead claims that 56% of 18 gun permit buyers (i.e., 10 individuals) associated the name "Dick's" with Plaintiff's store.

**5 In the proceedings below, Clothing moved to exclude the Mead Report from evidence. In a Memorandum dated

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March 31, 1998, the district court found that the Mead Report fell short of establishing secondary meaning for the following reasons: (1) it failed to address the relevant time period (1989); (2) it focused unjustifiably on license and gun permit buyers; and (3) it excluded substantial portions of the relevant population. Mem. at 9. Consequently, the district court discounted Mead's findings, but did not rule on the report's admissibility.

Survey evidence is admissible as an exception to the hearsay rule only if the survey is "material, more probative on the issue than other evidence and if it has guarantees of trustworthiness." Harold's Stores, Inc., et al. v. Dillard Dept. Stores, Inc., 82 F.3d 1533, 1544 (10th Cir.1996) (citing Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513, 522 (10th Cir.1987)); accord 5 Jack B. Weinstein & Margaret A. Berger, Weinstein's Evidence ¶ 901(b)(9)[03] at 901-140 (1995) ("The admissibility of survey or sampling results depends upon two factors: necessity and trustworthiness."). "A survey is trustworthy if it is shown to have been conducted according to generally accepted survey principles." Brunswick Corp., 832 F.2d at 522. "The survey should sample an adequate or proper universe of respondents." Harold's Stores, 82 F.3d at 1544 (citing Exxon Corp. v. Texas Motor Exchange of Houston, Inc., 628 F.2d 500, 507 (5th Cir.1980)). "[T]hat is, the persons interviewed must adequately represent the opinions which are relevant to the litigation." Amstar Corp. v. Domino's Pizza, Inc., 615 F.2d 252, 264 (5th Cir.), cert. denied, 449 U.S. 899, 101 S.Ct. 268, 66 L.Ed.2d 129 (1980). The district court should exclude the survey "when the sample is clearly not representative of the universe it is intended to reflect." Harold Stores, 82 F.3d at 1544 (citing Bank of Utah v. Commercial Sec. Bank, 369 F.2d 19, 27 (10th Cir.1966), cert. denied, 386 U.S. 1018, 87 S.Ct. 1374, 18 L.Ed.2d 456 (1967)).

After careful review of the Mead Report, this Court finds that the district court would have abused its discretion had it admitted the report into evidence. See Eisenstadt v. Centel Corp., 113 F.3d 738, 742 (7th Cir.1997) (noting that hearsay is inadmissible in summary judgment proceedings save affidavits and depositions). An analysis of the Mead Report reveals that its findings are unreliable for purposes of establishing secondary meaning. For example, only 126 of the 200 men surveyed were aware of a store named "Dick's" in the Baltimore area, and only 19 of the original 200 men surveyed identified goods sold by "Dick's" as hunting or fishing equipment. Mead Report at 10. In addition, only 21 individuals overall (i.e., 10.5% of the original 200) identified Essex, Maryland as the location of a "Dick's" store in the Baltimore area. *Id.*

**6 In addition, the fact that the Mead Report excluded men under the age of 25 and all women regardless of age from its sample of 200 individuals contributes to its unreliability. The report's unreliability is corroborated by the findings of Marshall G. Greenberg, Ph.D., who found that nearly 38% of all prospective buyers of hunting and fishing gear and guns were female and 9% of all prospective buyers were males between the ages of 18 and 24. Greenberg Op. at 3. Dr. Greenberg's survey also revealed that awareness of Sporting's store was extremely low. In 1997, fewer than 2% of 414 potential customers in the Baltimore area were aware of Sporting's store on an unaided basis, and only 9.9% of potential customers indicated awareness of the store after its location was disclosed. J.A. at 489.

Dr. Greenberg also discovered that only 1.7% of Sporting's potential customers indicated an awareness of Sporting's store prior to February 1995. *Id.* Based upon this evidence, the district court reasoned that the only reasonable inference was that there was low awareness of Sporting's store among potential consumers in 1989. This Court agrees. For the foregoing reasons, we find the Mead Report to be inadmissible hearsay and note that the record fails to contain any other consumer study linking Sporting's trade name to its Essex, Maryland store.

The opinion of trademark attorney Gary D. Krugman also fails to bolster Sporting's claim that its trade name had acquired secondary meaning by 1989. On October 3, 1996, Krugman opined in an expert witness report that the mark "Dick's Sporting Goods" had acquired secondary meaning and was entitled to protection from an infringing mark or name likely to cause confusion. Krugman Report at 8. Krugman based his opinion upon the fact that Sporting had been selling and advertising sporting goods for "some 25 years" and upon the "substantial sales volume" enjoyed by Sporting "for at least the last six years...." *Id.* This Court is unpersuaded by Krugman's opinion and finds that it lacks the foundation necessary to render it probative of secondary meaning for the following reasons.

First, Krugman concedes in his deposition that he failed to familiarize himself with the sporting goods market prior to rendering his opinion. Second, he admits that he failed to consider any consumer studies or other pertinent information relevant to the sporting goods industry, the sporting goods market, or Sporting's prospective buyers. Third, he admits that he did not attempt to ascertain the amount of money expended by Sporting on advertising, the frequency of Sporting's advertising, or the effectiveness of Sporting's advertising. Fourth, he concedes that he did not consider media coverage of any kind. Finally, Krugman admits that in evaluating Sporting's "substantial sales

volume," he obtained no information regarding the total sales volume of sporting goods in the Baltimore area or elsewhere, but simply believed that annual gross profits of \$100,000 must be "substantial." Krugman Dep. at 97-100. In short, Krugman failed adequately to evaluate the factors articulated by this Court in *Perini* as relevant to secondary meaning. As a result, his opinion that the trade name "Dick's Sporting Goods" had acquired secondary meaning must be rejected. Even if this Court were to accept Krugman's opinion, he has presented no evidence that Sporting's trade name acquired secondary meaning as of the year in question, 1989.

**7 Likewise, Sporting's advertising expenditures fail to establish that its trade name had acquired secondary meaning in the minds of a substantial portion of the consuming public by 1989. In accordance with *Perini*, the district court properly held that "substantial advertising expenditures may establish a retailer's name in the market and, under appropriate circumstances, support an inference that such advertising had been successful at creating name recognition among a significant portion of the consuming public." Mem. at 12. In the instant case, however, Sporting spent only \$14,206.00 on advertising from 1984 to 1989. Of that amount, Sporting spent less than one thousand dollars annually from 1987 to 1989. Based upon this evidence, the district court held that Sporting may have been a "healthy local retail store" but that its advertising expenditures did not suggest "the kind of campaign that would create secondary meaning in a trade name." Mem. at 13-14.

On appeal, Sporting argues that the district court failed to consider its advertisements featured in the Yellow Pages and on the cover of a retail sporting goods catalog. However, it is clear that the district court not only considered Sporting's Yellow Pages advertisements, but also Sporting's advertisements featured in local brochures. Finding that Sporting has presented no evidence that its advertising expenditures exceeded a total of \$14,206.00 for the years 1984 through 1989, inclusive of costs for advertising in the Yellow Pages or otherwise, this Court concludes that Sporting's advertising expenditures were *de minimis*.

Even if this Court were to conclude that Sporting's advertising expenditures were significant, Sporting has failed to show that its expenditures were effective in causing consumers in the Baltimore, Maryland geographic area to associate the trade name "Dick's" or "Dick's Sporting Goods" with Sporting's business. See *FM 103.1, Inc. v. Universal Broadcasting of New York, Inc., et al.*, 929 F.Supp. 187, 196 (D.N.J.1996) ("Large advertising or promotional expenditures do not contribute to establish a

secondary meaning unless the moving party explains how its efforts were effective in causing the relevant group of consumers to associate the mark with itself."). "While evidence of advertising may be relevant, the mere expenditure of money is not, in itself, determinative of the actual result in buyers' minds." 2 J. Thomas McCarthy, *MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION*, § 15:51 (4th ed.1997).

A third factor cited by *Perini* as relevant to the establishment of secondary meaning is sales success. The record in this case shows that Sporting failed to achieve a level of sales from which secondary meaning may be inferred. For example, a national survey submitted by Sporting shows that Marylanders spent approximately \$111 million on fishing equipment and \$78 million on hunting equipment in any given year. [FN2] By contrast, Sporting's tax returns reflect gross sales of \$641,976 in 1984, \$658,782 in 1985, \$684,765 in 1986, \$609,664 in 1987, \$557,358 in 1988, and \$558,177 in 1989. The district court held that these figures revealed that Sporting's sales "were a small portion of total sales of hunting and fishing equipment in Maryland," and, therefore, "did not suggest the kind of market penetration which would reasonably support an inference of secondary meaning." Mem. at 13- 14. For the following reasons, this Court concurs with the finding of the district court.

FN2. 1991 National Survey of Fishing, Hunting and Wildlife Associated Recreation (J.A. at 754). Although 1991 is the only year for which the parties have submitted information of this kind, the Court finds that it is reasonable to assume that annual fluctuations, if any, have not been significant.

**8 Sporting argues that it enjoyed substantial sales for over 18 years in the retail sporting goods industry prior to Clothing's registration of its trade name. While one may concede that Sporting maintained a thriving local business during the years in question, its sales simply do not constitute a significant portion of the \$111 million and \$78 million Marylanders spent on fishing and hunting equipment, respectively. Indeed, the record reflects that Sporting's sales decreased from \$684,765 in 1986 to \$558,177 in 1989, nearly twenty percent. Moreover, Sporting's gross sales decreased from \$509,206 in 1990 to \$367,562 in 1994. In other words, from its high water mark in 1986, Sporting's sales diminished by nearly half without any competition from Clothing. Based upon this evidence, this Court cannot find that Sporting's gross sales support a reasonable inference that the trade name "Dick's" or "Dick's Sporting Goods" had acquired secondary meaning in the

minds of actual or prospective consumers by 1989.

As evidence of unsolicited media coverage, Sporting asserts that it received frequent, unsolicited media attention on the radio and in various Baltimore newspapers prior to 1990. Specifically, Sporting argues that its business was featured in the *Sun Paper*, *News American*, *Bill Burton's Reports*, and in *Fishing in Maryland*. Clothing argues that this Court should exclude Sporting's allegations of unsolicited media attention because Sporting failed to disclose any publicity, other than paid advertising, in its response to interrogatories. Clothing also asserts that Sporting never supplemented or corrected its response. Because Clothing's arguments are persuasive, we find that evidence of Sporting's alleged incidents of unsolicited media coverage is not properly before this Court. Moreover, we note that the district court's order of November 24, 1997, did not grant Sporting leave to supplement the record with evidence of unsolicited media coverage.

Therefore, the only evidence concerning unsolicited media coverage properly before this Court is public attendance at a waterfowl calling seminar organized by Sporting in 1982 and a newspaper article mentioning the Sporting's store on January 17, 1982. After careful consideration, the Court concludes that neither event is probative of secondary meaning. First, both events occurred well before 1989. Second, the record is devoid of evidence indicating that Sporting organized any other seminar or was featured in any other newspaper articles after 1982. Accordingly, the only reasonable inference is the one reached by the district court: that these events were isolated incidents. Had Sporting's trade name acquired secondary meaning by 1989, one would have expected similar events to have occurred after 1989. The fact that future events did not occur undermines Sporting's claim of secondary meaning and tends to indicate that Sporting did not enjoy widespread recognition in the minds of the consuming public, as alleged.

****9** As additional evidence of secondary meaning, Sporting asserts that Clothing attempted to plagiarize its mark, a fifth factor relevant to secondary meaning under *Perini*. From this proposition, Sporting also argues that the district court erred in refusing to shift the burden of proof to Clothing to show a lack of secondary meaning. For the following reasons, we conclude that these arguments must fail.

In trademark infringement cases, "the courts have held that evidence of deliberate copying establishes a prima facie case of secondary meaning, subject to rebuttal by the defendant, with the defendant bearing the ultimate burden of proof once deliberate copying is proven." *M. Kramer Mfg. Co. v. Andrews*, 783 F.2d 421, 449 (4th Cir.1986); *Audio*

Fidelity, Inc. v. High Fidelity Recording, Inc., 283 F.2d 551, 558 (9th Cir.1960) (quoting *My-T Fine Corp. v. Samuels*, 69 F.2d 76, 77 (2d Cir.1934) (L.Hand, Jr.)), cert. denied, 371 U.S. 934 (1962). "The rationale for this presumption is that when a defendant copies the trademark of a competitor, it is likely that he intended to appropriate some commercial advantage or benefit that his competitor derived from the use of the mark." *M. Kramer Mfg.*, 783 F.2d at 449; *Chevron Chemical Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 704 (5th Cir.1981) (quoting *American Chicle Co. v. Topps Chewing Gum, Inc.*, 208 F.2d 560, 563 (2d Cir.1953) (L.Hand, J.)), cert. denied, 457 U.S. 1126 (1982).

A review of the record evidence compels the conclusion that Clothing did not deliberately copy Sporting's alleged common law trade name. Generally, intentional copying must involve more than simply using the same name. For example, in *Polo Fashions, Inc. v. Extra Special Productions, Inc.*, 451 F.Supp. 555 (S.D.N.Y.1978), the district court held that while the defendant could not be enjoined from using the descriptive name "Polo" on its clothing products, it had engaged in intentional copying by labeling its clothing "POLO by Marco Polo" and utilizing the image of a polo player in a manner strikingly similar to that used in the plaintiff's "POLO BY RALPH LAUREN" clothing line. Therefore, the fact that Clothing utilizes the trade name "Dick's" to promote its sporting goods merchandise does not, standing alone, support a finding of intentional copying.

Moreover, the record reveals no evidence that Clothing intended to palm off the reputation or goodwill of Sporting by employing the trade name "Dick's" or "Dick's Sporting Goods." The fact that Clothing has been in business for over 40 years and operates in excess of 50 retail stores nationwide renders Sporting's argument weak from the outset. Because no evidence exists that Clothing intentionally copied Sporting's trade name, the district court properly refused to shift the burden to Clothing to show a lack of secondary meaning.

****10** As to the final *Perini* factor, length and exclusivity of the mark's use, the district court found that Sporting had been "neither specific nor consistent in identifying the area for which it claims to have acquired common law rights to its trade name." Mem. at 7. Sporting does not contest this finding but attempts to minimize its failure to do so:

The Sporting accepts this point as to the lack of consistent identification up to the point in time of Sporting's Cross Motion for Summary Judgment filed June 24, 1997. The market area claimed by the Sporting was well defined by specific by (sic) zip code in that document.

Sporting's Br. at 32.

Contrary to this argument Sporting did not assert in its Cross Motion for Summary Judgment that its use of the trade name "Dick's" or "Dick's Sporting Goods" had been *exclusive* in any geographic region. Rather, Sporting argued in that document only that its use of the trade name had been *continuous*. It was not until Sporting filed its Supplemental Memorandum in Support of its Motion for Summary Judgment on January 16, 1998, that it argued that its use had been both continuous and exclusive in the Baltimore, Maryland area. Sporting also argued that Clothing had an affirmative duty to rebut Sporting's claim of exclusivity. Supplemental Mem. in Supp. of Plaintiff's Motion for Summary Judgment at 11. Sporting's argument is unpersuasive for the following reasons.

In *Celotex Corp. v. Catrett*, 477 U.S. 317, 106 S.Ct. 2548, 91 L.Ed.2d 265 (1986), the district court had entered summary judgment for the defendant. The D.C. Circuit Court reversed because the defendant had failed to support its motion for summary judgment with evidence tending to negate the plaintiff's claim. The Supreme Court reversed, upholding the district court's entry of summary judgment. As a leading treatise on federal procedure explains, under *Celotex*, "the moving party on a summary judgment motion need not produce evidence, but simply can argue that there is an absence of evidence by which the nonmovant can prove his case." 10A Charles Alan Wright, Arthur R. Miller & Mary Kay Kane, FEDERAL PRACTICE AND PROCEDURE § 2720, at 10 (2d ed. Supp.1994); see *Celotex*, 477 U.S. at 325 ("[T]he burden on the moving party may be discharged by 'showing'—that is, pointing out to the district court-- that there is an absence of evidence to support the nonmoving party's case."); accord *Cray Communications, Inc. v. Novatel Cmpt. Systems, Inc.*, 33 F.3d 390 (4th Cir.1994). In sum, it is clear under *Celotex* and *Cray* that Clothing bears no burden of production. Instead, Clothing may simply assert, as it has done, that Sporting has presented insufficient evidence to establish secondary meaning.

**11 Moreover, this Court notes that the district court's order of November 24, 1997, did not grant Sporting leave to present evidence regarding exclusivity. That order granted Sporting limited leave to supplement the summary judgment record with evidence of the following only:

1. Copies of newspaper advertisements from 1989;
2. Copies of Plaintiff's tax returns for the years 1985 to 1989;
3. An affidavit from an attendee to a waterfowl conference; and
4. Supplemental affidavits from 18 affiants already

contained in the record.
J.A. at 572.

Notwithstanding the district court's order, Sporting argued in its Supplemental Memorandum that its use of the trade name "Dick's" or "Dick's Sporting Goods" had been exclusive. Specifically, Sporting paints the picture that it guarded its trade name by compelling a competing business, Dick's Sports Center, Inc., to cease using the trade name "Dick's." As a result, Sporting contends, the competitor went out of business. Supp. Mem. at 8-9. In other words, Sporting would have this Court believe that but for a short interval of time, it alone utilized the trade name "Dick's" in the Baltimore, Maryland geographic region. To the contrary, records from the Maryland Department of Assessments and Taxation reveal that Dick's Sports Center, Inc. conducted business in the State of Maryland for 11 years and was dissolved for failure of its owner to file a personal property tax return. J.A. at 798. Because Dick's Sports Center, Inc. utilized the trade name "Dick's" simultaneously with Sporting from 1985 to 1996, Sporting's claim of exclusivity must fail. Although Sporting utilized the trade name "Dick's" for many years, length of use and exclusivity are not synonymous.

Sporting also argues on appeal that the district court "abused its discretion by refusing to allow [it] discovery of supplemental proof of name recognition offered to show secondary meaning as of 1989...." Sporting's Br. at 33. A review of the record shows that Sporting argued in its original Motion for Summary Judgment that its trade name had acquired secondary meaning as of 1995—the year Clothing opened its first store in Maryland. Clothing argued in response that Sporting's proof of secondary meaning was inadequate in that it had failed to proffer evidence of secondary meaning as of the relevant year, 1989. Following a telephone conference with the parties, the district court entered the order of November 24, 1997, granting Sporting limited leave to supplement the summary judgment record with the specific items noted heretofore. Sporting now asserts that the district court erred in refusing to allow it to supplement the record with the following additional evidence: (1) consumer studies; (2) expert witness reports; (3) the market area claimed by Sporting; and (4) "a review of any additional factors." Sporting's Br. at 33.

This Court finds that the district court acted within its discretion in refusing to allow Sporting to start over from square one. "District courts enjoy nearly unfettered discretion to control the timing and scope of discovery...." *Hinkle v. City of Clarksburg*, 81 F.3d 416, 426 (4th Cir.1996). In fact, had the district court allowed Sporting to supplement the summary judgment record more extensively,

it may have abused its discretion. In Cray Communications, Inc. v. Novatel Cmpt. Systems, Inc., 33 F.3d 390 (4th Cir.1994), this Court affirmed the exercise of the district court's discretion in refusing to consider new evidentiary matters and reasoned:

**12 Novatel contends, in essence, that dismissal of its fraud claim because of its counsel's mistake imposes an unjust penalty on the client. As Justice Harlan once explained, such contentions are "wholly inconsistent with our system of representative litigation, in which each party is deemed bound by the acts of [its lawyer]...." Keeping this suit alive merely because plaintiff should not be penalized for the omissions of his own attorney would be visiting the sins of plaintiff's lawyer upon the defendant.

Id. at 395 (emphasis in original).

Similarly, in the instant case, it appears that Sporting's failure to submit cogent evidence in its original motion for summary judgment may have been attributable to oversight. It is well settled law and undisputed by Sporting that the appropriate date for proof of secondary meaning in this case is 1989, the date Clothing obtained federal registration of its trademark. See Armand's Subway, Inc. v. Doctor's Assocs., 604 F.2d 849, 849-50 (4th Cir.1979) (noting that registration constitutes constructive notice to competing users). Accordingly, the district court granted Sporting only limited leave to supplement the summary judgment record and did not abuse its discretion in refusing to allow Sporting to reopen the entire record.

Because Sporting has failed to satisfy any of the factors relevant to secondary meaning under *Perini*, we find that Sporting's trade name is ineligible for trademark protection. Sporting's evidence of 65 customer checks made payable to "Dick's" and 15 customer affidavits does not change our conclusion. No reasonable juror could find that 65 checks and 15 affidavits connote that a substantial portion of the consuming public associated the trade name "Dick's" or "Dick's Sporting Goods" with Sporting's business as of 1989. We note that none of the checks proffered by Sporting were written before the year 1996, and only some of the affiants claim to have patronized Sporting's store on or before 1989. For these reasons, Sporting's checks and affidavits are insufficient to establish secondary meaning. Indeed, none of Sporting's admissible evidence, considered separately or in the aggregate, suffices to establish secondary meaning under *Perini*.

Finally, we address Sporting's argument that the doctrine of reverse confusion is applicable to lower or shift Sporting's burden of proving secondary meaning. "Reverse confusion occurs when a larger, more powerful company uses the

trademark of a smaller, less powerful senior owner and thereby causes likely confusion as to the source of the senior user's goods or services." Fisons Horticulture, Inc. v. Vigoro Industries, Inc., 30 F.3d 466, 474 (3d Cir.1994). To date, this Court has not adopted the doctrine of reverse confusion. However, even if we were to adopt the doctrine, it would not apply to the instant case because Sporting is not a "trademark holder." In DeCosta v. Viacom International, Inc., 981 F.2d 602 (1st Cir.1992), the United States Court of Appeals for the First Circuit discussed the leading case on reverse confusion, Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co., 561 F.2d 1365 (10th Cir.1977), cert. dismissed, 434 U.S. 1052, 98 S.Ct. 905, 54 L.Ed.2d 805 (1978), and noted that only a "trademark holder could base a claim on ... 'reverse confusion.'" DeCosta, 981 F.2d at 608 (emphasis added). In other words, the doctrine of reverse confusion is a damages theory, expanding the relief available to a plaintiff who has already established exclusive right to its trade name. Because Sporting has failed to establish that its trade name acquired secondary meaning in the minds of a substantial portion of the consuming public as of 1989, Sporting is not a "trademark holder" and cannot avail itself of the doctrine of reverse confusion.

**13 Because Sporting has failed to establish that its trade name acquired secondary meaning in the minds of the consuming public by 1989, we affirm the district court's denial of summary judgment to Sporting on the Complaint and grant of summary judgment to Clothing on the Complaint and on Clothing's counterclaim.

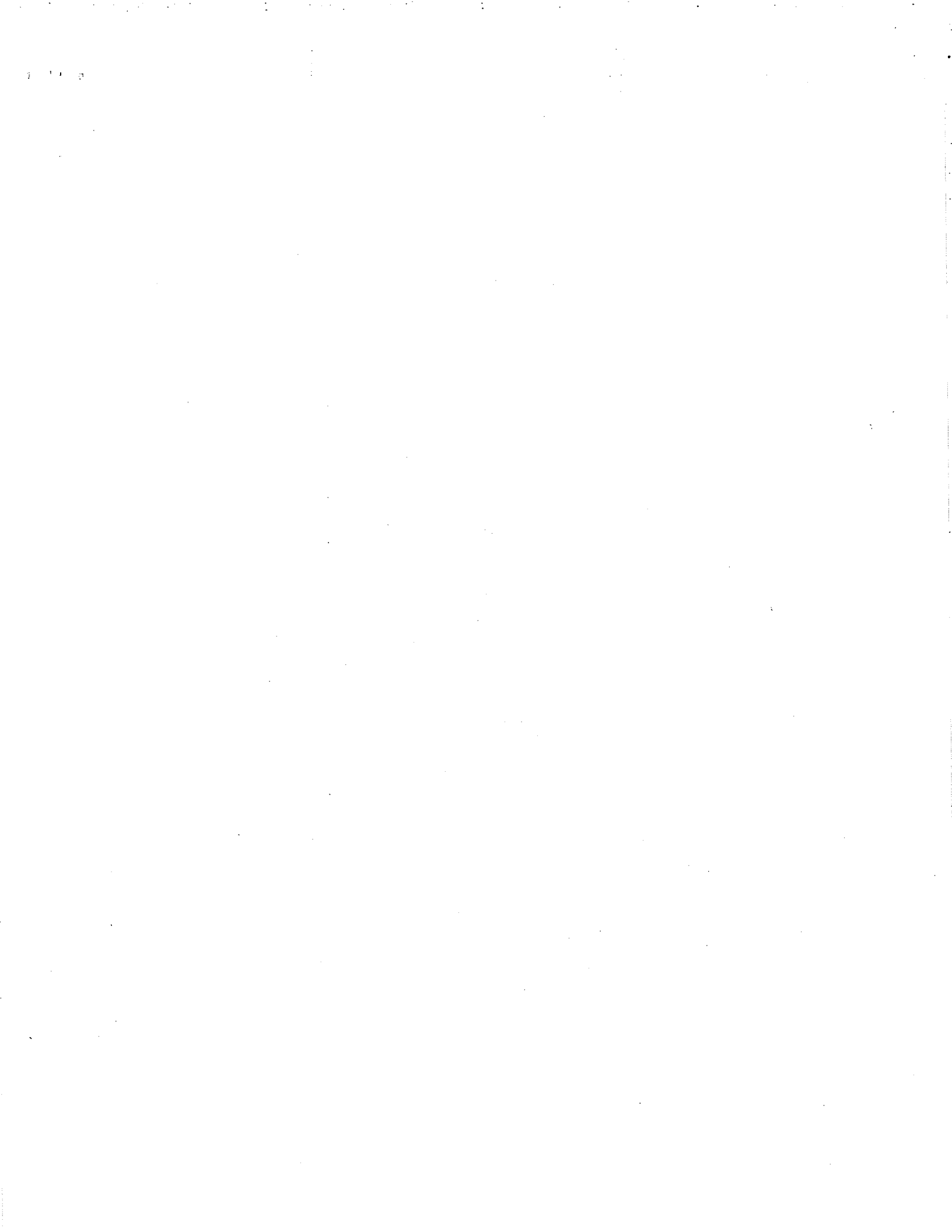
AFFIRMED

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Unpublished Disposition

(Cite as: 62 F.3d 424, 1995 WL 418667 (D.C.Cir.), 314 U.S.App.D.C. 101)

H

NOTICE: THIS IS AN UNPUBLISHED OPINION.

(The Court's decision is referenced in a "Table of Decisions Without Reported Opinions" appearing in the Federal Reporter. Use FI CTADC Rule 28 and FI CTADC Rule 36 for rules regarding the publication and citation of unpublished opinions.)

United States Court of Appeals, District of Columbia Circuit.

James K. JEANBLANC, Appellant,

v.

The OLIVER CARR COMPANY, Appellee.

No. 94-7118.

June 21, 1995.

Rehearing and Suggestion for Rehearing En Banc Denied Aug. 8, 1995.

Appeal from the United States District Court for the District of Columbia (No. 91cv00128), Joyce Hens Green, District Judge.

D.D.C., 1992 WL 189434.

AFFIRMED.

Before: Wald, SILBERMAN AND SENTELE, Circuit Judges.

JUDGMENT

PER CURIAM.

**1 This appeal was considered on the record from the United States District Court for the District of Columbia, on the briefs filed by the parties, and on oral arguments presented May 12, 1995. The issues were accorded full consideration by the Court and occasion no need for a published opinion. See D.C. Cir. Rule 36(b). For the reasons stated in the accompanying memorandum, it is

ORDERED AND ADJUDGED that the judgment of the District Court be affirmed on all counts in accordance with the accompanying memorandum.

The Clerk is directed to withhold issuance of the mandate herein until seven days after disposition of any timely petition for rehearing. See D.C. Cir. Rule 41.

ATTACHMENT
MEMORANDUM

Appellant James Jeanblanc appeals the entry of summary judgment against him in his action against Oliver Carr Co. ("Carr") in this action arising out of a real estate partnership as well as the dismissal of that part of his claim relating to his father's interest in the partnership as a sanction for destruction of documents. We have considered Jeanblanc's arguments in full, but address here only those arguments which we believe merit separate consideration. We affirm the judgment of the district court on all counts.

I. BACKGROUND

Appellant James K. Jeanblanc and his father Lindsey Jeanblanc were limited partners in the Square 224 Partnership ("Square 224"), a limited partnership in which appellee Oliver Carr Company ("Carr") was the lone general partner. In 1979, the Jeanblancs each invested \$125,000 in the partnership, which was formed to acquire and hold the property located in Square 224 of the District of Columbia, and then later contribute the property to a development venture which had yet to be formed. To compensate Carr Co. for its efforts in assembling the Development Property, the agreement provided Carr Co. with a credit to its "capital account in the development venture" (the "Carr Land Credit") equal to the difference between Carr's acquisition cost of the development property and \$20/sq.ft. It also provided Carr a fee for the services it would perform for the development venture, stating that 80% of this fee could be reinvested as an additional contribution to Carr's capital account in the development venture (the "Carr Development Fee"). The agreement contemplated that such reinvestments would result in the "appropriate adjustment" of all partners' partnership interests.

Finally, the agreement provided that any partner receiving an offer to buy its interest must inform the other partners of the offer. The other partners would then have a right of first refusal, with Carr getting priority to purchase. Excepted from this provision were transfers to a subsidiary of a partner and transfers "without consideration."

At a May 1980 meeting of the partners, Oliver Carr described a transaction to develop the property being negotiated with the Equitable Life Assurance Society ("Equitable"), in which Equitable would purchase a 25% interest in the new Development Venture for \$6 million and Square 224 would own the remaining 75% (in exchange for the property held by the partnership). The property would be developed in two phases. At the meeting, Carr distributed a detailed handout explaining the terms of the Equitable deal, stating that: (1) Carr would recognize its Land Credit and

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Development Fee in Square 224, rather than in the Development Venture; (2) the Carr Land Credit would be recognized before recognition of a "general land credit" to be credited to all partners; (3) a closed alley that bordered the development property ("the alley") was treated as part of the land acquired by Carr Co. for purposes of calculating the Carr Land Credit; and (4) no land acquisition costs would be recognized for the alley. The handout indicated that, as a result of Carr Co.'s recognition of the credits, the Jeanblancs' individual shares would decrease from 2.49% to 1.81%.

**2 In December 1980, Jeanblanc, his father and the other limited partners gave Carr Co. written authority to form the Development Venture with Equitable on the terms discussed at the May meeting. In February 1981, the day after executing the agreement with Equitable, Carr Co. provided the limited partners with a letter and enclosure further detailing the Venture's terms. The letter confirmed the effects of the Carr Land Credit, the Carr Development Fee, and the General Land Credit.

In 1984, Phase Two of the Development Venture began with Equitable providing a second level of financing and the partnership contributing the Phase II lots to the venture. Carr informed Jeanblanc that a second portion of the Land Credit and Development Fee would be applied in Phase II, and Jeanblanc complained that he thought that the "percentage would be the same." Although no Phase II credits were taken until 1986, Carr told Jeanblanc in 1985 that his interest would be diminished by the Phase II credits. In February 1986, Carr mailed Jeanblanc a spreadsheet that illustrated that his interest would decrease from 1.58% to 1.405% as a result of recognition of the Carr Land Credit and Development Fee. Again, in November, 1987, Carr Co. provided Jeanblanc with an elaborate step-by-step breakdown of the calculations.

On January 29, 1990, Carr Co. informed the limited partners that LaSalle Advisors Limited ("LaSalle") had offered to purchase Equitable's 25% interest in the Development Venture, and the interests of any individual partners in Square 224. Both Jeanblancs informed Carr that they wished to cash out. Each received \$1.11 million for the sale of their respective 1.405% interests.

On December 17, 1990, Jeanblanc brought suit in the Eastern District of Virginia on his own behalf and derivatively for the other limited partners. The court dismissed Jeanblanc's derivative claims and transferred the remaining counts to D.C. District Court. On January 28, 1991, Lindsey Jeanblanc assigned his claim against Carr to his son, James. Shortly thereafter, Lindsey Jeanblanc

destroyed all of his documents pertaining to Square 224.

On February 5, 1991, Jeanblanc filed a three-count amended complaint against Carr in district court, alleging that Carr Co. breached the partnership agreement and its fiduciary duties. Jeanblanc contended that he should have had 2.4907% of Square 224 when his interest was sold in 1990. In Count One, he alleged that Carr Co. defrauded him (and his father) in at least four ways: (1) by recognizing the Land Credit and Development Fee in the partnership and not in the development venture; (2) by recognizing the Land Credit before recognizing the General Land Credit; (3) by including the alley as part of the development property; and (4) by recognizing zero acquisition costs associated with the alley. Jeanblanc prayed for damages and an accounting. Additionally, he challenged various assignments of interests from Carr Co. to Carr Co. employees. Counts Two repeated the allegations and charged that Carr Co. breached its fiduciary duties in failing to sell all of Jeanblanc's interest. Count Three charged that Carr Co. failed to account for and distribute all of the proceeds of the May 1990 sale.

**3 On March 3, 1992, Carr moved to dismiss the entire case as a sanction for destruction of documents. The district court granted Carr's motion in part, finding that Lindsey Jeanblanc destroyed every document in his control pertaining to the transactions at a time when he knew that a lawsuit was pending. As a sanction, the court dismissed the portion of the case arising from Lindsey Jeanblanc's interest.

On September 14, 1992, the parties filed cross motions for summary judgment. The court partially granted Carr's motion and denied Jeanblanc's motion. Although it had previously held in response to a 12(b) motion that counts one and two were equitable in nature and thus subject to laches rather than the statute of limitations, the Court revisited the issue on summary judgment. It concluded that the "overwhelming evidence of Jeanblanc's knowledge and his failure to act promptly, persuades the court that justice would not be served by denial of the defendant's statute of limitations defense." Stating that "both the discovery of additional and substantial evidence and the prevention of manifest injustice require reexamination of the Court's earlier rulings," the court found that a three-year statute of limitations applied. The court thus held that counts one and two of the complaint were time-barred. Alternatively, the court held that the assignments to Carr Co. employees were not "personal assignments" barred by the agreement, but rather were assignments to joint ventures that were "subsidiaries" of Carr, and thus allowable.

After settlement of the remaining claim and subsequent entry of judgment, Jeanblanc appealed.

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II. ANALYSIS

I. Laches and the Statute of Limitations.

In its disposition of the case below, the district court held that Jeanblanc's claims were barred by the three-year statute of limitations applicable to contract actions in the District of Columbia. See D.C. Code Ann. § 12-301(7) (1994). Appellant claims that the district court erroneously applied the three-year statute instead of a twelve-year statute of limitations accorded documents under seal. See id. § 12-301(6). Relying upon the proposition that, under District of Columbia law, a party who signs an instrument to which another has affixed his seal is presumed to adopt the seal, see McNulty v. Medical Service of D.C., Inc., 176 A.2d 783, 784 (D.C. 1962), appellant contends that the twelve-year statute applies here because the partnership agreement governing Square 224 was signed under seal by all of the limited partners.

Assuming *arguendo* the correctness of appellant's proposition that the twelve-year statute of limitations applies, we nonetheless conclude that appellant's claim is barred under the doctrine of laches. Although appellant's claims may be within the twelve-year period authorized by statute, the statute of limitations provides only the "outside limit beyond which [the legislature] has determined claims are simply too stale to be litigated." Detweiler v. Pena, 38 F.3d 591, 595 (D.C. Cir. 1994) (quoting, with approval, Deering v. United States, 620 F.2d 242, 245 (Ct. Cl. 1980)). Even where the twelve-year statute mandated for documents under seal applies, a claim may be otherwise barred as untimely by the equitable doctrine of laches. See Amidon v. Amidon, 280 A.2d 82, 84 (D.C. 1971) (applying laches in case involving separation agreement where only seven of the twelve years allowed by statute had passed).

**4 In order to apply laches to bar a claim as untimely, a defendant must show that the plaintiff has unreasonably delayed in asserting a claim and that there was "undue prejudice" to the defendant as a result of the delay. American Univ. Park Citizens Ass'n v. Burka, 400 A.2d 737, 740 (D.C. 1979).

We believe that Jeanblanc's delay until 1990 in filing suit was unreasonable and inexcusable. The record reflects that Carr provided sufficient information regarding the disputed transactions at a May 1980 meeting of the partners to put Jeanblanc on notice of all relevant facts. Again, after executing the agreement with Equitable Life Assurance Society, in February 1981, Carr provided detailed handouts indicating how Jeanblanc's shares would decrease in percentage terms. Additionally, Carr informed Jeanblanc of the challenged transfers to James Clark in 1982. Our review

of the record reveals that appellants had sufficient information at that time to challenge Carr's calculation of ownership interests. Jeanblanc's rationale for not challenging these transactions earlier -- that appellees had misled them into believing that the transactions conformed to the partnership agreement -- is unavailing because Jeanblanc had a copy of that agreement to refute that claim. Thus, with respect to count one and the claim that Carr improperly transferred an interest to James Clark, we conclude that Jeanblanc's delay of nearly eight years in filing suit was unreasonable.

Next, we agree with Carr that Jeanblanc's delay in filing suit unduly prejudiced Carr. In the normal course of its business, Carr had destroyed certain business documents -- including invoices, bank statements, cancelled checks, etc. -- with which it could have been able to defend itself had the claim been brought in a timely manner. Among the inequities that the doctrine of laches protects against is the loss of pertinent evidence. See NAACP v. NAACP Legal Defense & Educ. Fund, Inc., 753 F.2d 131, 137 (D.C. Cir.), cert. denied, 472 U.S. 1021 (1985). Appellant claims that undue prejudice cannot arise from the destruction of one's own documents. Although we agree that under certain circumstances -- such as a potential defendant having knowledge of pending claims -- destruction of evidence will clearly not support a finding of prejudice, see EEOC v. Massey-Ferguson, Inc., 622 F.2d 271, 280 (7th Cir. 1980); Bernard v. Gulf Oil Co., 596 F.2d 1249, 1257 (5th Cir. 1979), we find that the circumstances here present a compelling case of undue prejudice. Appellee's destruction of documents was not willful; rather, the documents were destroyed in the ordinary course of business. Because the documents themselves were not documents under seal, it was reasonable for appellee to destroy them after the lapse of the normal three-year period of limitations. See D.C. Code Ann. § 12-301(7).

**5 We thus conclude that appellee has met its burden of demonstrating unreasonable delay and undue prejudice and hold that both count one and appellant's claim regarding transfers of interests to James Clark are thus barred by the equitable doctrine of laches.

B. Other Claims.

We agree with the district court that appellant's separate claims regarding sales of interests to employees and the amount paid per percentage point of interest in the partnership are meritless.

The partnership agreement excepted from the right of first refusal any transfers without consideration and any

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assignments to subsidiaries. The challenged transfers meet both criteria. The assignments to Carr employees were in recognition of past services, as indicated by the language in the assignment documents, "[I]n recognition of [the employee's] efforts, ability and diligence exhibited in the course of his employment, the Carr Company has assigned to him a portion of said participatory interest." As we have noted, "past consideration is no consideration." Murray v. Lichtman, 339 F.2d 749, 752 n. 5 (D.C. Cir. 1964). Thus, these assignments are excepted from the agreement as transfers without consideration. Additionally, because the transaction regarding each employee is, at least in form, a transfer to a subsidiary, the employee transfers are excepted. The district court thus correctly dismissed these claims.

Finally, the district court correctly noted that the documents submitted by both parties indicated that each partner cashing out of the partnership would receive \$789,000 from the sale of each percentage point in the transaction. Appellant's claim here is utterly baseless and thus properly rejected.

C. Sanctions.

The record demonstrates that Lindsey Jeanblanc's destruction of documents was knowing and willful, unlike that of the appellee which was done in the normal course of business. In cases involving the "willful, systematic, and extensive destruction ... of documents," we have clearly stated that a district court may dismiss an entire case as a sanction. See Synanon Church v. United States, 820 F.2d 421, 427 (D.C. Cir. 1987). Dismissal is an option at the disposal of a district court in exercising its "inherent power ... to levy sanctions in response to abusive litigation practices." Roadway Express, Inc. v. Piper, 447 U.S. 752, 765 (1980). The sanction was particularly appropriate here, where the documents were destroyed willfully and the opponent is in no position to present evidence of their content. See Synanon Church, 820 F.2d at 428 ("The occurrence of a cover-up raises a presumption that disclosure of the materials would be damaging.").

Accordingly, the decision of the district court is affirmed.

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