

PUBLIC COPY - SEALED MATERIAL DELETED
03-7162

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

SUZAN S. HARGO, *et al.*

Appellants

PRO-FOOTBALL, INC.

Appellee

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

BRIDE FOR APPELLEE PRO-FOOTBALL, INC.

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CERTIFICATE AS TO PARTIES, RULINGS, AND RELATED CASES

Pursuant to D.C. Cir. R. 28(a)(1), Appellee Pro-Football, Inc. (“Pro-Football”)

states:

A. Parties and *Amici*.

All parties and *amici* appearing before the district court (Colleen Kollar-Kotelly, J.) and in this Court are listed at Brief for Appellants (dated Oct. 31, 2008) (“Appellants’ Supp. Op. Br.”) i.

B. Rulings Under Review.

Reference to the first ruling under review appears at Brief for Appellants (dated Oct. 18, 2004) i. This ruling is reported at 284 F.Supp.2d 96 (D.D.C. 2003) (“*Harjo SJ*”), and may be found at Joint Appendix (“JA”) 487.

Reference to the second ruling under review appears at Appellants’ Supp. Op. Br. i. This ruling is reported at 567 F.Supp.2d 46 (D.D.C. 2008) (“*Harjo Post-Remand*”), and may be found at JA 727.

C. Related Cases.

As stated at Appellants’ Supp. Op. Br. ii, this case was previously before this Court as *Pro-Football, Inc. v. Harjo*, No. 03-7162. In a decision reported at 415 F.3d 44 (D.C. Cir. 2005) (“*Harjo Appeal*”), this Court retained jurisdiction but remanded for the district court to decide whether laches bars Appellant Mateo Romero’s claim.

CORPORATE DISCLOSURE STATEMENT

Pursuant to FRAP 26.1 and D.C. Cir. R. 26.1, Pro-Football states:

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

Pro-Football owns and operates the Washington Redskins football club, one of the thirty-two member clubs of the National Football League ("NFL").

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

TABLE OF CONTENTS

	<u>Page</u>
CERTIFICATE AS TO PARTIES, RULINGS, AND RELATED CASES	i
CORPORATE DISCLOSURE STATEMENT	ii
TABLE OF AUTHORITIES	v
GLOSSARY	viii
JURISDICTION.....	1
ISSUES PRESENTED.....	1
STATUTES.....	2
STATEMENT OF THE FACTS.....	3
A. Romero’s Delay.....	3
B. Events During the Romero Delay Period.....	3
1. Mr. Williams’ Death	4
2. The Loss of Documents	4
3. Pro-Football’s Investment in the Marks.....	5
C. The District Court’s Post-Remand Decision.....	6
STANDARD OF REVIEW	10
SUMMARY OF ARGUMENT	12
ARGUMENT	14
I. The District Court Acted Within Its Discretion in Finding that Romero Lacked Diligence	14
II. The District Court Acted Within Its Discretion in Finding that Pro- Football Suffered Prejudice	15
A. Pro-Football Suffered Trial Prejudice	15

1.	Mr. Williams' Death	16
2.	Survey or Other Evidence Was Not Developed	19
3.	Financial Documents Were Lost.....	20
B.	Pro-Football Suffered Economic Prejudice.....	22
III.	The District Court Acted Within Its Discretion in Declining To Exempt the "Redskinettes" Mark from Its Laches Ruling	27
	CONCLUSION	31

TABLE OF AUTHORITIES

Page(s)

CASES

<i>Ambrit, Inc. v. Kraft, Inc.</i> , 812 F.2d 1531 (11th Cir. 1986)	26
* <i>Bridgestone/Firestone Research, Inc. v. Automobile Club de l'Ouest de la France</i> , 245 F.3d 1359 (Fed. Cir. 2001)	9, 22, 23, 26
<i>Brittingham v. Jenkins</i> , 914 F.2d 447 (4th Cir. 1990)	14
<i>CarrAmerica Realty Corp. v. Kaidanow</i> , 321 F.3d 165 (D.C. Cir. 2003)	11, 14
<i>Conopco, Inc. v. Campbell Soup Co.</i> , 95 F.3d 187 (2d Cir. 1996)	25, 26
<i>Copperweld Corp. v. Astralloy-Vulcan Corp.</i> , 196 U.S.P.Q. 585 (TTAB 1977)	28
<i>Daingerfield Island Protective Society v. Lujan</i> , 920 F.2d 32 (D.C. Cir. 1990)	10, 11
<i>Goldman v. Bequai</i> , 19 F.3d 666 (D.C. Cir. 1994)	11
<i>Gull Airborne Instruments, Inc. v. Weinberger</i> , 694 F.2d 838 (D.C. Cir. 1982)	7, 15, 17, 20
<i>Harjo Appeal</i> , 415 F.3d 44 (D.C. Cir. 2005)	3, 6-9, 17, 20, 22, 30
<i>Harjo Discovery</i> , 2006 WL 2092637 (D.D.C. July 26, 2006)	9

<i>Harjo Post-Remand</i> , 567 F.Supp.2d 46 (D.D.C. 2008).....	1, 3, 6-10, 14-17, 19-22, 27, 28
<i>Harjo SJ</i> , 284 F.Supp.2d 96 (D.D.C. 2003).....	1, 9, 10, 15
<i>Harjo TTAB</i> , 50 U.S.P.Q.2d 1705 (TTAB 1999).....	1
<i>Hot Wax, Inc. v. Turtle Wax, Inc.</i> , 191 F.3d 813 (7th Cir. 1999)	11, 25, 26
<i>Hot Wax, Inc. v. Turtle Wax, Inc.</i> , 27 F.Supp.2d 1043 (N.D. Ill. 1998), aff'd, 191 F.3d 813	25
<i>Hubbard Feeds, Inc. v. Animal Feed Supplement, Inc.</i> , 182 F.3d 598 (8th Cir. 1999)	14
<i>In re Beaty</i> , 306 F.3d 914 (9th Cir. 2002)	18
<i>Klise Mfg. Co. v. Braided Accents, L.L.C.</i> , 2008 WL 2675076 (TTAB July 3, 2008)	24
<i>Landers, Frary & Clark v. Universal Cooler Corp.</i> , 85 F.2d 46 (2d Cir. 1936)	14
* <i>Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.</i> , 971 F.2d 732 (Fed. Cir. 1992)	28
<i>Merrill Lynch & Co. v. Allegheny Energy, Inc.</i> , 500 F.3d 171 (2d Cir. 2007)	11
<i>Meyers v. Asics Corp.</i> , 974 F.2d 1304 (Fed. Cir. 1992)	18
* <i>NAACP v. NAACP Legal Def. & Educ. Fund, Inc.</i> , 753 F.2d 131 (D.C. Cir. 1985).....	10, 11, 18, 24, 26, 29

<i>Nat'l R.R. Passenger Corp. v. Morgan</i> , 536 U.S. 101 (2002).....	18
<i>National Wildlife Fed'n v. Burford</i> , 835 F.2d 305 (D.C. Cir. 1987).....	10
<i>NVF Co. v. New Castle County</i> , 276 B.R. 340 (D. Del. 2002), aff'd, 61 Fed. Appx. 778 (3d Cir. 2003).....	18
<i>People's Mojahedin Org. of Iran v. Dep't of State</i> , 327 F.3d 1238 (D.C. Cir. 2003).....	11
<i>Peshlakai v. Duncan</i> , 476 F.Supp. 1247 (D.D.C. 1979).....	6, 14
<i>Rozen v. District of Columbia</i> , 702 F.2d 1202 (D.C. Cir. 1983).....	8
<i>Serdarevic v. Advanced Med. Optics, Inc.</i> , 532 F.3d 1352 (Fed. Cir. 2008).....	21

STATUTES

15 U.S.C. § 1052	23, 30
15 U.S.C. § 1972	2
Fed. R. Civ. P. 27	18
MD. CODE ANN. BUS. REG. § 1-304	21

OTHER AUTHORITIES

J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION (4th ed. 2008).....	15
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* Authorities upon which we chiefly rely are marked with an asterisk.

GLOSSARY

Appellants' Supp. Op. Br. -	Brief for Appellants dated Oct. 31, 2008
Appellee's Br. -	Brief for Appellee Pro-Football dated Oct. 18, 2004
<i>Harjo Appeal</i> -	415 F.3d 44 (D.C. Cir. 2005)
<i>Harjo Discovery</i> -	2006 WL 2092637 (D.D.C. July 26, 2006)
<i>Harjo Post-Remand</i> -	567 F.Supp.2d 46 (D.D.C. 2008)
<i>Harjo SJ</i> -	284 F.Supp.2d 96 (D.D.C. 2003)
<i>Harjo TTAB</i> --	50 U.S.P.Q.2d 1705 (TTAB 1999)
NFL -	National Football League
Pro-Football -	Appellee Pro-Football, Inc.
Romero -	Appellant Mateo Romero
Romero Delay Period -	The period beginning in 1984, when Romero reached the age of majority, and ending in 1992, when he filed his petition to cancel Pro-Football's Redskins and related trademarks
TTAB -	Trademark Trial and Appeal Board

JURISDICTION

Pro-Football agrees with Appellants' statement at Supp. Op. Br. 1.

ISSUES PRESENTED

"[A]ware of the Washington Redskins team name and the name of the cheerleaders since he watched Redskins games on television as a child" (*Harjo Post-Remand*, 567 F.Supp.2d 46, 54-55 (D.D.C. 2008)), and hence when he turned 18 in 1984, Appellant Mateo Romero nonetheless waited eight years, until 1992, to seek cancellation of the "Redskins" and related marks. During this "Romero Delay Period," (a) Edward Bennett Williams, who as the Redskins' President had met with Native Americans concerning the marks after the first was registered in 1967,¹ died; (b) it became increasingly difficult to gather information concerning Native American attitudes as of 1967; and (c) Pro-Football invested millions of dollars in the marks. Weighing these and other undisputed facts, the district court exercised its discretion to rule that laches bars Romero's claim. The following issues are presented:

1. Whether the district court acted within its discretion in finding that Romero, aware of the marks since childhood, lacked diligence in waiting eight years after reaching the age of majority to file his petition.

¹ The parties agreed, and the district court and TTAB held, that disparagement is determined as of the time of registration. *Harjo SJ*, 284 F.Supp.2d 96, 125 (D.D.C. 2003); *Harjo TTAB*, 50 U.S.P.Q.2d 1705, 1741 (TTAB 1999).

2. Whether the district court acted within its discretion in finding that Pro-Football was prejudiced by Romero's eight-year delay.
 - a. Whether the district court reasonably found that Pro-Football suffered trial prejudice given, *inter alia*, (i) the death of Mr. Williams and (ii) the increasing difficulty of ascertaining Native American attitudes as of 1967.
 - b. Whether the district court reasonably found that Pro-Football suffered economic prejudice insofar as Pro-Football invested millions of dollars in its marks during the Romero Delay Period.
3. Whether the district court acted within its discretion in declining to exempt the "Redskinettes" mark from its laches ruling, where the root of the mark (*i.e.*, "Redskin[s]") is identical to the earlier-registered marks and the mark was in use long before its registration.

STATUTES

15 U.S.C. § 1072 is set forth at Brief for Appellee Pro-Football, Inc. (dated Oct. 18, 2004) ("Appellee's Br.") 4. All other applicable statutes are contained in the Addendum to Brief for Appellants (dated Oct. 18, 2004).

STATEMENT OF THE FACTS

We respectfully refer the Court to Appellee's Br. 8-10 concerning the parties and the timing of the marks. We focus here on the facts relevant to "whether laches bars Mateo Romero's claim." *Harjo Appeal*, 415 F.3d 44, 50 (D.C. Cir. 2005).

A. Romero's Delay.

Romero turned eighteen in 1984. See *Harjo Post-Remand*, 567 F.Supp.2d at 49 n.2. Even before 1984, all of the marks were in use and all but one had been registered. "The first—'The Redskins' written in a stylized script—was registered in 1967, three more in 1974, another in 1978, and the sixth—the word 'Redskinettes'—in 1990." *Harjo Appeal*, 415 F.3d at 46. There is no dispute that Romero had watched Redskins games on television and had seen the Redskinettes cheerleaders as a child, JA 545 (¶ 61), and hence was well aware of the marks when he turned eighteen. Eight years later, Romero (and six others) petitioned the TTAB to cancel the marks. JA 16.

B. Events During the Romero Delay Period.

Several events occurred during this period. First, Mr. Williams, the Redskins' long-time President, died in 1988. Second, several documents were lost or, in the case of a survey or other measure of Native American attitudes, never obtained. Third, Pro-Football invested millions of dollars in its marks.

1. Mr. Williams' Death.

Mr. Williams served as President of the Redskins from 1965 to 1980, during which five of the six Redskins marks were originally registered. JA 536 (¶ 15).

In January 1972, Mr. Williams received a letter from Harold Gross, Director of the Indian Legal Information Development Service, complaining that the "Redskins" name is offensive to "American Indians" and asking that the name be changed. JA 138. (Mr. Gross subsequently admitted that the sentiments expressed were not based on written complaints from tribal leaders. JA 725-26.) Mr. Williams met with a group of Native Americans in March 1972, but there is no written account of what transpired. There is only a letter from Mr. Williams to then-NFL Commissioner Pete Rozelle reporting that a meeting took place and enclosing a copy of the January 1972 letter that Mr. Williams had received. JA 145.

Mr. Williams died on August 13, 1988, four years after Romero turned eighteen and four years before Romero petitioned to cancel the marks. JA 536 (¶ 15).

2. The Loss of Documents.

Lacking any notice during the Romero Delay Period of Romero's intent to file a cancellation petition, Pro-Football did not attempt to gather anecdotal or other evidence of Native American attitudes toward their marks, nor did it commission a survey of such attitudes, a survey that would have been closer (as compared to a post-1992 survey) to the dates on which the marks were registered.

Also during the Romero Delay Period, Pro-Football and/or its exclusive licensee NFL Properties LLC lost a number of key documents, including financial records from 1988 and 1991-92 and sponsor/advertiser lists from 1984-88, that might have shed further light (in addition to the extant documents discussed below) on Pro-Football's investment in the marks during the Romero Delay Period. JA 545 (¶ 65)

3. Pro-Football's Investment in the Marks.

During the Romero Delay Period, the Redskins marks were used continuously and without challenge by Pro-Football and its sponsors and licensees in connection with, *inter alia*, trading cards, posters, magazines, books, calendars, caps, wristbands, T-shirts, pajamas, jackets, socks, and baby bibs. JA 542 (¶ 44). The number of licensees grew from approximately [redacted] in 1985 (near the beginning of the period), JA 699-714, to more than [redacted] by the end of the period, JA 548 (¶ 76).

Pro-Football spent [redacted] advertising and promoting the marks in connection with licensed goods and services during the Romero Delay Period. See JA 546-47 (¶¶ 68-70).² Pro-Football's expenditures increased from [redacted] per year at the beginning of the period to [redacted] per year at the end of the period. JA 547 (¶ 70). In addition to these expenditures, Pro-Football and its exclusive licensee NFL Properties, LLC devoted significant time and money to prosecuting and

² The amounts in this paragraph and the following paragraph were calculated based on the principles at JA 546-47 (¶¶ 68-70), adapted to the Romero Delay Period.

maintaining the registrations of the marks and enforcing them against infringement and dilution. JA 547 (¶ 71).

These expenditures translated into substantial goodwill. For example, revenue from the sale of merchandise bearing the Redskins marks grew from [redacted] to [redacted] during the Romero Delay Period. JA 548-49 (¶¶ 77-80). And total team revenue increased from [redacted] in 1984 to [redacted] in 1990 (two years before the end of the period). JA 550 (¶ 81). Indeed, total team revenue likely increased even further by 1992, but the records for 1991 and 1992 are lost, as noted above.

C. The District Court's Post-Remand Decision.

The district court exercised its broad discretion to determine that laches bars Romero's claim. *Harjo Post-Remand*, 567 F.Supp.2d at 48. The court found that both prongs of laches—(1) lack of diligence by Romero and (2) prejudice to Pro-Football—were satisfied.³

1. As to lack of diligence, the district court reasoned that Romero's eight-year delay is "unusually long by any standard" and is similar to or longer than the delay in trademark and non-trademark decisions where laches has been applied. *Id.* at 54 (quoting *Peshlakai v. Duncan*, 476 F.Supp. 1247, 1256 (D.D.C. 1979)). The court found Romero's delay particularly unreasonable because he "does not contest that he

³ The district court appropriately relied on evidence that was not before the TTAB. See *Harjo Appeal*, 415 F.3d at 47.

has been aware of the Washington Redskins team name and the name of the cheerleaders since he watched Redskins games on television as a child.” *Harjo Post-Remand*, 567 F.Supp.2d at 54-55. This awareness provided Romero with actual knowledge that the trademarks were being used in the marketplace. *Id.* at 55. The court rejected Romero’s suggestion that his ignorance of his legal rights negates actual knowledge. *Ibid.*

2. Turning to prejudice, the district court recognized the interplay between the lack-of-diligence and the prejudice prongs, namely that “‘if the delay is lengthy, a lesser showing of prejudice is required.’” *Id.* at 56 (quoting *Gull Airborne Instruments, Inc. v. Weinberger*, 694 F.2d 838, 843 (D.C. Cir. 1982)). The court found Romero’s eight-year delay sufficiently “lengthy” that it reduces Pro-Football’s burden to show prejudice. See *Harjo Post-Remand*, 567 F.Supp.2d at 56.

Beginning with trial prejudice, the district court determined that “Romero’s post-majority delay resulted in a ‘loss of evidence or witnesses supporting [Pro-Football’s] position.’” *Ibid.* (quoting *Harjo Appeal*, 415 F.3d at 50 (in turn quoting *Gull Airborne*, 694 F.2d at 844)) (alteration in original). First, the court found “quite significan[t]” that Mr. Williams died during the Romero Delay Period because “[t]he 1972 meeting ... is only one example of what Mr. Williams might have been able to testify to during the TTAB proceeding if ... Romero had brought his cancellation petition ... while Mr. Williams was still alive.” *Harjo Post-Remand*, 567 F.Supp.2d at

56-57. Mr. Williams' "interactions with Native Americans" might "have provided contemporaneous evidence of their opinions of the Redskins name (as opposed to the reconstructed, after-the-fact survey evidence proffered by Defendants ...)." *Id.* at 57. Second, the court reasoned that, "by adding eight additional years to the other defendants' long delay, Romero further increased the time elapsed between the initial registrations and the date on which a survey of attitudes at the time of registration took place." *Ibid.* (internal quotation marks omitted). Third, the court found that Pro-Football's loss of financial records during the Romero Delay Period would prejudice its ability to establish economic prejudice.⁴ *Id.* at 58 n.7 (distinguishing *Rozen v. District of Columbia*, 702 F.2d 1202, 1204 (D.C. Cir. 1983), because, *inter alia*, that defendant's missing documents, unlike Pro-Football's, might have been destroyed *after* the plaintiff had filed its claim).

The district court also found that Pro-Football suffered economic prejudice. *Harjo Post-Remand*, 567 F.Supp.2d at 58. The court began by identifying the proper test of economic prejudice "where, as here, what is at stake is not the trademark owner's right to use the marks but rather the owner's right to Lanham Act protections that turn on registration." *Ibid.* (quoting *Harjo Appeal*, 415 F.3d at 50). The court held that, because the right to use the marks is not at stake, it would be inappropriate

⁴ The court did caution that this instance of prejudice warranted "less weight than the other claims of prejudice." *Harjo Post-Remand*, 567 F.Supp.2d at 58.

to require the owner of the marks to make the “all-or-nothing” showing that it would have abandoned them in favor of another name had the cancellation petition been filed earlier. Instead, “[e]conomic prejudice arises from investment in and development of the trademark, and the continued commercial use and economic promotion of a mark over a prolonged period adds weigh[t] to the evidence of prejudice.” *Harjo Post-Remand*, 567 F.Supp.2d at 59 (quoting *Harjo Discovery*, 2006 WL 2092637, at *4 (D.D.C. July 26, 2006) (in turn quoting *Bridgestone/Firestone Research, Inc. v. Automobile Club de l’Ouest de la France*, 245 F.3d 1359, 1363 (Fed. Cir. 2001))) (alterations in original). Applying this test, the court found that Pro-Football suffered economic prejudice because “[h]ad Defendant Romero commenced his cancellation proceeding when he reached the age of majority in 1984, Pro-Football could have diverted the millions of dollars it spent on promoting, advertising, and protecting its marks during the Romero Delay Period elsewhere, rather than continuing to invest money in marks that might be rendered uncertain by a successful cancellation petition.” *Harjo Post-Remand*, 567 F.Supp.2d at 61.

3. Reaffirming its previous holding, as to which this Court did not express any doubt in *Harjo Appeal*, the district court held that the “Redskinettes” mark, despite its 1990 registration, cannot be divorced from the earlier marks. *Harjo Post-Remand*, 567 F.Supp.2d at 54 n.5 (citing *Harjo SJ*, 284 F.Supp.2d at 140). First, the mark “is grounded in their claims regarding the other five marks, which were registered long

before 1990, and ... the TTAB recognized as much during the cancellation proceeding, concluding that Defendants' 'arguments and extensive evidence pertain almost entirely to the 'Redskins' portion of [Pro-Football's] marks.'" *Harjo Post-Remand*, 567 F.Supp.2d at 54 n.5 (quoting *Harjo SJ*, 284 F.Supp.2d at 140) (alteration in original). Second, because "the Washington Redskins cheerleaders have been using the term 'REDSKINETTES' since 1962 ... [,] this is not a case where the mark was introduced in 1990'" *Harjo Post-Remand*, 567 F.Supp.2d at 54 n.5 (quoting *Harjo SJ*, 284 F.Supp.2d at 140) (first alteration in original). Accordingly, Romero, who was aware of the "Redskinettes" mark since childhood, "could have filed the cancellation petition immediately upon the registration of the Redskinettes mark in 1990, instead of waiting until 1992 to do so." *Harjo Post-Remand*, 567 F.Supp.2d at 54 n.5.

STANDARD OF REVIEW

"Because laches is an equitable doctrine, courts have generally held that it 'is primarily addressed to the discretion of the trial court'" (*Daingerfield Island Protective Society v. Lujan*, 920 F.2d 32, 38 (D.C. Cir. 1990) (quoting *National Wildlife Fed'n v. Burford*, 835 F.2d 305, 318 (D.C. Cir. 1987)), and that the trial court's decision warrants "considerable deference" on appeal. *NAACP v. NAACP Legal Defense & Education Fund, Inc.*, 753 F.2d 131, 138 (D.C. Cir. 1985). *Daingerfield* and *NAACP*, like this case, involved this Court's review of a district

court's laches determination on summary judgment. *Daingerfield*, 920 F.2d at 36; *NAACP*, 753 F.2d at 136.

Appellants ignore *Daingerfield* and *NAACP* in invoking (Supp. Op. Br. 7) *de novo* review. Contrary to Appellants' assertion, the "traditional [*de novo*] standard of review in summary judgment cases must be considered in light of the notion that a district court enjoys considerable discretion in determining whether to apply the doctrine of laches to claims pending before it." *Hot Wax, Inc. v. Turtle Wax, Inc.*, 191 F.3d 813, 819 (7th Cir. 1999). And while "[a] district court's ruling on laches does not qualify for deference if the court applied the wrong legal standard" (*Daingerfield*, 920 F.2d at 38), the district court applied the proper standard here.

To be sure, a post-*Daingerfield* panel of this Court recited the standard of review as *de novo* without acknowledging *Daingerfield* or *NAACP*. See *CarrAmerica Realty Corp. v. Kaidanow*, 321 F.3d 165, 170 (D.C. Cir. 2003) (citing *Goldman v. Bequai*, 19 F.3d 666, 672 (D.C. Cir. 1994), which did not involve laches). Because *Daingerfield* and *NAACP* should have bound the *CarrAmerica* panel, see, e.g., *People's Mojahedin Org. of Iran v. Dep't of State*, 327 F.3d 1238, 1244 (D.C. Cir. 2003), we respectfully submit that *Daingerfield* and *NAACP* rather than *CarrAmerica* control here. See *Merrill Lynch & Co. v. Allegheny Energy, Inc.*, 500 F.3d 171, 187 (2d Cir. 2007) (where second panel "did not acknowledge" and departed from first

panel's holding, first panel's holding would bind third panel). But even if this Court employs *de novo* review, it should affirm because the court did not err in any respect.

SUMMARY OF ARGUMENT

The district court's ruling that Romero's claim is barred by laches is clearly correct and, at the very least, within the district court's broad discretion.

1. As to the lack-of-diligence prong, Appellants do not even challenge the district court's conclusion that Romero's eight-year delay is unreasonable. This conclusion accords with numerous cases that have found lack of diligence from similarly long periods of delay, and draws additional support from the undisputed fact that Romero was aware of each of the marks from childhood, and hence necessarily as of the age of majority.

2. The district court's analysis of the prejudice prong was equally correct, and at the very least within the realm of reasonableness. As to trial prejudice, the court found that, during the Romero Delay Period, Pro-Football suffered the loss of perhaps its single most important witness (Mr. Williams) concerning Native American attitudes toward the marks contemporaneous with their registration; a survey or other measure of such attitudes became increasingly difficult given the passage of time; and Pro-Football lost a number of potentially key financial documents. Appellants' main contention is that the exact content of Mr. Williams' testimony is un-knowable; but that is the case in every situation of a dead witness, and laches lays the uncertainty at

the foot of the party who delayed (Romero), not the party that is prejudiced (Pro-Football). In any event, Mr. Williams' testimony is hardly a matter of raw speculation, as there is no dispute that he met with Native Americans, and thus he undoubtedly could have testified regarding what they told him.

As to economic prejudice, *NAACP*, 753 F.2d at 138, among other decisions, establishes that Pro-Football needed only to show that it made substantial investments in the marks during the Romero Delay Period, not that it would have (a) changed the name or (b) used the invested funds elsewhere, had Romero timely filed his petition. Application of this test is straightforward, since there is no dispute that Pro-Football invested millions of dollars in the marks during the Romero Delay Period.

3. The district court again acted well within its discretion in declining to exempt the "Redskinettes" mark from its laches ruling. It is well-settled that, for laches purposes, a later-registered mark can be tacked to an earlier-registered mark from which it derives. Here, it is obvious that the root of "Redskinettes" is identical to the 1967-registered "Redskins." Accordingly, the district court found that Romero should have filed his petition at or shortly after the 1990 registration of "Redskinettes," rather than waiting until 1992. The district court's ruling was especially reasonable because, as Romero indisputably knew since childhood, "Redskinettes" was in use years before it was registered.

ARGUMENT

I. The District Court Acted Within Its Discretion in Finding that Romero Lacked Diligence.

Appellants conspicuously fail to contest the district court's conclusion that Romero lacked diligence in waiting eight years from turning eighteen to file his cancellation petition. See *Harjo Post-Remand*, 567 F.Supp.2d at 53-56. There is good reason for Appellants' silence, as the district court's analysis was clearly correct and certainly not an abuse of discretion.

First, as the district court observed, numerous courts have found similarly long delay periods to demonstrate that the plaintiff lacked diligence. See *id.* at 54 (citing, e.g., *CarrAmerica*, 321 F.3d at 171-72 (two years); *Peshlakai*, 476 F.Supp. at 1256 (seven years); *Hubbard Feeds, Inc. v. Animal Feed Supplement, Inc.*, 182 F.3d 598, 602 n.5 (8th Cir. 1999) ("over four years"); *Brittingham v. Jenkins*, 914 F.2d 447, 456 (4th Cir. 1990) (eight years); *Landers, Frary & Clark v. Universal Cooler Corp.*, 85 F.2d 46, 69 (2d Cir. 1936) (eight years)).

Second, the circumstances here underscore the unreasonableness of the delay. There is no dispute that Romero "has been aware of the Washington Redskins team name and the name of the cheerleaders since he watched Redskins games on television as a child" (*Harjo Post-Remand*, 567 F.Supp.2d at 54-55), and hence necessarily as of the age of majority. Nor is there any dispute that this supplied Romero with "actual knowledge of the trademarks being used in the market place."

Id. at 55 (quoting *Harjo SJ*, 284 F.Supp.2d at 141 n.35). And this Court’s “remand opinion offers no reason to reconsider that finding” *Harjo Post-Remand*, 567 F.Supp.2d at 55.

II. The District Court Acted Within Its Discretion in Finding that Pro-Football Suffered Prejudice.

When a plaintiff’s delay is lengthy, “a lesser showing of prejudice is required.” *Gull*, 694 F.2d at 843. Accord, 6 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 31:12 (4th ed. 2008) (“laches = delay x prejudice”). The district court held, and Appellants do not dispute, that Romero’s eight-year delay is sufficiently lengthy to reduce Pro-Football’s burden regarding prejudice.

Even were the burden not reduced, the district court’s conclusion that Pro-Football suffered both trial and economic prejudice is clearly correct and certainly not an abuse of discretion.

A. Pro-Football Suffered Trial Prejudice.

Pro-Football amply demonstrated trial prejudice through the undisputed facts that Mr. Williams died, survey and other evidence of Native American attitudes was not developed, and documents were lost.

1. Mr. Williams' Death.

As set forth *supra*, at 4, Mr. Williams was President of the Redskins when most of the marks were first registered, and he held an in-person meeting in 1972 with several Native Americans who voiced complaints about the marks. Through this meeting, five years after the first mark was registered, Mr. Williams was undoubtedly exposed directly to the views of Native Americans (albeit a small sample of them) and may have asked them, among other things, how representative their views were. Thus, Mr. Williams would have been perhaps Pro-Football's most important witness on the issue whether the marks were viewed by a substantial composite of Native Americans as disparaging. As the district court found:

The 1972 meeting ... is only one example of what Mr. Williams might have been able to testify to during the TTAB proceeding if Defendant Romero had brought his cancellation petition upon reaching the age of majority in 1984, i.e., while Mr. Williams was still alive. Mr. Williams may very well have had other interactions with Native Americans that would have provided contemporaneous evidence of their opinions of the Redskins name

Harjo Post-Remand, 567 F.Supp.2d at 57.⁵ The district court additionally found that

“Mr. Williams would likely have been able to shed some light on whether the

⁵ For example, Mr. Williams might have testified that he had reached an agreement with the Native Americans that they would not challenge the registrations if Pro-Football altered certain imagery associated with the team, such as the fight song, which was in fact changed during the 1970s to remove the phrase “scalp ’um.” JA (footnote continued)

Redskins might have changed their name during the Romero Delay Period if the cancellation petition had been brought earlier” *Ibid.*

Appellants’ critique of the district court’s analysis is unpersuasive. They dispute (Supp. Op. Br. 11) whether Mr. Williams would have been competent to opine on the likelihood of a name change in 1984, since his tenure as President ended in 1980. But the likelihood of a name change pertains, at most, to economic prejudice.⁶ The principal loss of testimony concerns not economic prejudice, but the merits issue of disparagement.

Turning to that issue, Appellants argue, without supporting authority, that “[t] is simply too speculative to confer on Williams an ability to opine on the perceptions of Native Americans at the time the marks were registered.” Supp. Op. Br. 11. But some speculation as to what a witness would have testified is inevitable whenever the witness has died; Appellants’ argument thus implies that trial prejudice can never be shown based on the death of a witness. Of course, this Court has held otherwise. *Harjo Appeal*, 415 F.3d at 50 (instructing district court to consider ““loss of ... witnesses supporting [Pro-Football’s] position””) (quoting *Gull*, 694 F.2d at 844)

717-23. Mr. Williams might also have testified that other Native Americans told him that they supported the team’s name as a symbol of honor for Native Americans.

⁶ As discussed at Point II.B, *infra*, it is irrelevant even to economic prejudice because a trademark holder facing a cancellation proceeding need show only that it invested in the mark during the delay period, not that it would have changed the name.

(alteration in original). See also *NVF Co. v. New Castle County*, 276 B.R. 340, 356 (D. Del. 2002) (“In the case of deceased witnesses, the testimony of those witnesses cannot possibly be known.”), *aff’d*, 61 Fed. Appx. 778 (3d Cir. 2003). And any speculation here was hardly without basis: Mr. Williams’ exposure to Native Americans on the key issue, through correspondence and in person, is undisputed.⁷

Appellants similarly lack authority for their suggestion that the onus was on Pro-Football to “preserv[e] and memorializ[e] any relevant evidence or knowledge held by Williams by having him execute an affidavit, or perpetuating his testimony.” Supp. Op. Br. 12. Laches exists to *protect* the party that is defending against a claim (here, Pro-Football), not to impose burdens on that party. This is explicit in the doctrine’s elements, which ask whether the party asserting the merits claim (here, Romero) “lack[ed] ... diligence” and whether the party defending (here, Pro-Football) suffered “prejudice.” *Nat’l R.R. Passenger Corp. v. Morgan*, 536 U.S. 101, 121-22 (2002) (internal quotation marks omitted). See also *NAACP*, 753 F.2d at 137 (“[l]aches is founded on the notion that equity aids the vigilant and not those who slumber on their rights”). Appellants’ authorities (Supp. Op. Br. 12)—Fed. R. Civ. P. 27 and a case applying that rule—not surprisingly have nothing to do with laches.

⁷ Unlike in *Meyers v. Asics Corp.*, 974 F.2d 1304, 1308 (Fed. Cir. 1992), or *In re Beaty*, 306 F.3d 914, 928 (9th Cir. 2002) (both cited at Appellants’ Supp. Op. Br. 14), Pro-Football’s assertion of prejudice from the loss of Mr. Williams’ testimony is hardly conclusory.

Rule 27 grants *rights* to take pre-litigation discovery, but does not impose *duties* to do so.⁸

2. Survey or Other Evidence Was Not Developed.

The district court also found that, “by adding eight additional years to the other defendants’ long delay, Romero further increased the time elapsed between the initial registrations and the date on which a survey of attitudes at the time of registration took place.” *Harjo Post-Remand*, 567 F.Supp.2d at 57 (internal quotation marks omitted).

Appellants’ argument is again unpersuasive. They claim that Pro-Football cannot have suffered prejudice from *Romero*’s failure—but only from Pro-Football’s failure—to develop survey evidence closer to the first registration in 1967. See Supp. Op. Br. 13 (“Trial prejudice is based upon an allegation that the party defending an action could have obtained evidence supporting his position had the plaintiff brought the case earlier.”). But even accepting that assertion, it does not aid Appellants because, had Pro-Football received earlier notice of the cancellation petition, *Pro-Football* could have commissioned its own survey or gathered anecdotal or other evidence of Native American attitudes as of 1967.

⁸ Nor, contrary to Appellants’ Supp. Op. Br. 12, could Mr. Williams’ receipt of the 1972 letter have imposed any duty on Pro-Football to perpetuate his testimony. The 1972 letter and the meeting at most gave Pro-Football notice that a few Native Americans found the marks offensive, and there is no evidence that such Native Americans advised of their intention to take legal action. More importantly, the 1972 (footnote continued)

Appellants fall back on their contention (*id.* at 13-14) that it is impossible to know whether such evidence would have supported Pro-Football's position. This argument is reminiscent of Appellants' equally unpersuasive assertion that Mr. Williams' death does not establish trial prejudice because no one knows how Mr. Williams would have testified. Were Appellants correct, a loss of documents could never establish trial prejudice because the content of those documents is inevitably a matter of speculation. They are incorrect. See *Harjo Appeal*, 415 F.3d at 50 (directing district court to consider whether Pro-Football suffered trial prejudice from "loss of evidence") (quoting *Gull*, 694 F.2d at 844).

3. Financial Documents Were Lost.

A third instance of trial prejudice involves the undisputed loss during the Romero Delay Period of documents that *did* once exist: "financial records from 1988 and 1991-92" *Harjo Post-Remand*, 567 F.Supp.2d at 58. This evidence would likely have bolstered Pro-Football's showing (discussed in Point II.B, *infra*) of economic prejudice from having invested in the marks during the Romero Delay Period.

To be sure, this evidence—unlike Mr. Williams' (lost) testimony or the absence of survey and other evidence of Native American attitudes—goes primarily to

letter and meeting were followed by some twenty years of silence before Appellants petitioned for cancellation in 1992.

economic prejudice rather than the merits issue of disparagement. But Appellants provide no authority for their assertion that trial prejudice cannot be predicated on loss of evidence that relates solely to economic prejudice. *Serdarevic v. Advanced Medical Optics, Inc.*, 532 F.3d 1352 (Fed. Cir. 2008) (cited at Appellants' Supp. Op. Br. 9), notes only that loss of evidence bearing on the merits is sufficient to constitute trial prejudice; it does not hold that loss of evidence bearing on economic prejudice is insufficient. In any event, Appellants incorrectly assume that economic prejudice is a non-merits issue; in fact, it *is* a merits issue pertaining to an affirmative defense (laches) that will be tried if not disposed of on summary judgment. The district court thus sensibly concluded that the loss of these documents, "although of less weight than the other claims of prejudice," supports Pro-Football's showing of trial prejudice. *Harjo Post-Remand*, 567 F.Supp.2d at 58.

Appellants' additional contentions (Supp. Op. Br. 8-9) likewise lack merit. First, it is irrelevant that these documents did not exist in 1984 when Romero turned eighteen—they *did* exist during the Romero Delay Period and might not have been lost had Romero not waited until 1992 to file his cancellation petition. Second, Appellants cite no authority for the proposition that Pro-Football was required to present specific evidence that the documents would not have been lost had Romero filed his petition earlier. Third, as to Pro-Football's duty under Maryland law to retain business records for three years, see MD. CODE ANN. BUS. REG. § 1-304, even

assuming *arguendo* that this duty can be invoked by a private party such as Romero, it affects only the 1991-92 records (which Pro-Football would have had to retain until 1994, after Romero's cancellation petition), not the 1988 records (which Pro-Football would have had to retain until 1991, *before* Romero's cancellation petition).

* * * * *

In short, the district court acted well within its discretion in finding these three sources of trial prejudice. Given Romero's lengthy delay and the undisputed evidence of trial prejudice, this Court need not address economic prejudice. In any event, as demonstrated below, Pro-Football clearly suffered economic prejudice as well.

B. Pro-Football Suffered Economic Prejudice.

This Court, while leaving articulation of an economic-prejudice test to the district court in the first instance, recognized that the test may take into account that "what is at stake is not the trademark owner's right to use the marks but rather the owner's right to Lanham Act protections that turn on registration." *Harjo Appeal*, 415 F.3d at 50. The district court, citing the Federal Circuit's decision in *Bridgestone/Firestone*, 245 F.3d 1359, held, see *Harjo Post-Remand*, 567 F.Supp.2d at 59, that the "stakes" identified by this Court indeed warranted a more subtle approach than the all-or-nothing inquiry proposed by Appellants, which would ask whether the trademark owner would have abandoned the mark had the cancellation

petition been filed earlier. See Supp. Op. Br. 15-17 (arguing that Pro-Football has not adduced evidence that it would have changed the name).

Bridgestone/Firestone involved a trademark cancellation proceeding filed under the same statute, 15 U.S.C. § 1052, as Appellants' petition here. *Bridgestone/Firestone*, 245 F.3d at 1360.⁹ *Bridgestone* defended against the cancellation proceeding by invoking a laches defense, which the TTAB rejected. *Id.* at 1360. On review, the Federal Circuit, in assessing economic prejudice, rejected the TTAB's "requirement of 'specific' evidence of 'reliance' on the Automobile Club's silence" *Id.* at 1363. Instead, the court held that "[e]conomic prejudice arises from investment in and development of the trademark, and the continued commercial use and economic promotion of a mark over a prolonged period adds weight to the evidence of prejudice." *Ibid.* Applying this holding, the court ruled that *Bridgestone* had demonstrated economic prejudice because "[i]t was undisputed that *Bridgestone* invested in and promoted the LEMANS brand tires over this lengthy period, during which the Automobile Club was silent." *Ibid.*

Notably, the Federal Circuit did not insist on a showing that (1) *Bridgestone* would have changed the name had the cancellation petition been filed earlier; or

⁹ Specifically, the petitioner in *Bridgestone/Firestone* sought cancellation of *Bridgestone*'s trademark LEMANS because it "falsely suggested a connection with the Automobile Club and its sponsorship of the Le Mans race" 245 F.3d at 1360. That ground is listed alongside disparagement in 15 U.S.C. § 1052(a).

(2) the funds Bridgestone invested in promoting the mark would have been used in another way had the cancellation petition been filed earlier. Accord, *Klise Mfg. Co. v. Braided Accents, L.L.C.*, 2008 WL 2675076, at *6 (TTAB July 3, 2008) (“Respondent’s reliance on petitioner’s delay in filing a petition for cancellation is not a requirement for laches.... Economic prejudice arises from investment in and development of the trademark, and the continued commercial use and economic promotion of a mark over a prolonged period adds weight to the evidence of prejudice.”) (internal quotation marks omitted).

This Court has agreed even in the all-or-nothing situation of an injunction against use of a trademark:

It is true that “mere delay” by itself does not bar injunctive relief if the defendant did not invest resources that contribute to a trademark’s future value. But injunctive relief may be appropriately barred when the defendant invested substantial labor and capital that builds the trademark’s goodwill.

NAACP, 753 F.2d at 138 (internal footnotes omitted). Thus, this Court required the defendant to show only that it “invested substantial labor and capital that builds the trademark’s goodwill” (*ibid.*), not that the defendant would have spent these resources elsewhere or changed the name had the plaintiff timely brought suit.

Numerous decisions cited by Appellants also concur that the defendant invoking a laches defense need show only that he invested in the marks during the delay period, and need not make the further showing how the funds would

alternatively have been used had the plaintiff filed suit earlier. In *Conopco, Inc. v. Campbell Soup Company*, 95 F.3d 187, 192-93 (2d Cir. 1996) (cited at Appellants' Supp. Op. Br. 19-20), a false advertising case, the Second Circuit held that the district court did not abuse its discretion in finding economic prejudice. The court focused on the fact that "Campbell committed massive resources" in support of the advertising campaign under challenge. *Id.* at 192. The court held that this alone sufficed to establish economic prejudice: "Had Conopco brought this action in a more timely manner, Campbell *might well have* chosen some alternative position" *Id.* at 193 (emphasis added).

The Second Circuit's formulation was adopted in *Hot Wax, Inc. v. Turtle Wax, Inc.*, 27 F.Supp.2d 1043, 1049 (N.D. Ill. 1998), which granted summary judgment to the defendant on its laches defense because there was no dispute that "Turtle Wax has invested substantial funds in promoting its products as waxes." *Ibid.* The Seventh Circuit affirmed, reasoning that "[h]ad Hot Wax successfully pressed its claims in a timely manner, Turtle Wax *certainly* could have invested its time and money in other areas or simply renamed its products." 191 F.3d at 824 (emphasis added) (cited at Appellants' Supp. Op. Br. 19). Again, the Seventh Circuit so held even though no specific proof had been presented on whether and how Turtle Wax would have made alternative use of the funds or changed its name had suit been filed earlier.

This approach, aside from being compelled by this Court's *NAACP* decision and supported by *Bridgestone/Firestone*, *Conopco*, and *Hot Wax*, is sound as a policy matter. Objective evidence of a defendant's investment in a trademark during the plaintiff's delay period will ordinarily have been contemporaneously created and be available as proof, whereas evidence of what the defendant *would have done* (by way of a name change or alternative investment of the funds) will likely not have existed and will have to be created through an after-the-fact affidavit.

Aside from *Conopco* and *Hot Wax* (which support Pro-Football's position), most of Appellants' case citations (Supp. Op. Br. 19-20) are inapposite because they involved patent infringement, where, unlike in the trademark cancellation context, *right to use* is at stake. And the lone trademark/trade dress case cited by Appellants, *Ambrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986), is distinguishable. There, the defendant's expenditures related primarily to "develop[ing] the product itself" and were "unrelated to the package design." *Id.* at 1546 n.82. The court appeared to recognize that "money spent to develop or promote the infringing trade dress" would support a finding of economic prejudice. *Ibid.*

Once it is recognized that the test of economic prejudice in a trademark case is whether the defendant "invested substantial labor and capital that builds the trademark's goodwill" (*NAACP*, 753 F.2d at 138), application to the facts here is straightforward. The district court found, and Appellants do not dispute, that Pro-

Football invested “millions of dollars ... on promoting, advertising, and protecting its marks during the Romero Delay Period” *Harjo Post-Remand*, 567 F.Supp.2d at 61. See also *supra*, at 5 (citing record evidence showing, among other things, that Pro-Football spent more than [redacted] advertising and promoting the marks in connection with licensed goods and services during the Romero Delay Period, plus additional amounts in prosecuting and enforcing the marks). Relatedly, if Appellants “succeeded in their cancellation petition, past investment in the mark will be jeopardized by uncertainty surrounding the brand name and an economic cost exists when a trademark is cancelled that adversely affects prior investment in the brand.” *Harjo Post-Remand*, 567 F.Supp.2d at 61 (internal quotation marks omitted).

Accordingly, the district court acted within its discretion in concluding that Pro-Football suffered economic prejudice from Romero’s unreasonable delay in petitioning for cancellation of the marks.

III. The District Court Acted Within Its Discretion in Declining To Exempt the “Redskinettes” Mark from Its Laches Ruling.

The district court again clearly acted within its discretion in declining to exempt the “Redskinettes” mark from its laches ruling. Appellants’ arguments to the contrary lack merit.

First, contrary to Appellants’ assertion (Supp. Op. Br. 23), the district court understood that Romero could not challenge the mark until it was registered in 1990; but the court held that, given the identity between the root of the mark and the earlier-

registered marks, and given the mark's long-time use, Romero's two-year delay was unreasonable for purposes of the laches doctrine. *Harjo Post-Remand*, 567 F.Supp.2d at 54 n.5 (Romero "could have filed the cancellation petition immediately upon the registration of the Redskinettes mark in 1990, instead of waiting until 1992 to do so"). Indeed, one of Appellants' own case citations supports the district court's conclusion that the "Redskinettes" mark must be considered in conjunction with the earlier-registered marks from which it derives. In *Lincoln Logs Ltd. v. Lincoln Pre-Cut Log Homes, Inc.*, 971 F.2d 732 (Fed. Cir. 1992) (cited at Appellants' Supp. Op. Br. 23), the Federal Circuit explained that "a laches ... defense in an opposition (or cancellation) proceeding may be based upon the Opposer's failure to object to an Applicant's registration of *substantially the same mark*." 971 F.2d at 734. The Federal Circuit cited as an example a TTAB decision holding that "laches applied in opposition to registration of mark ASTRALLOY-V based upon Opposer's failure to object to Applicant's registration of mark ASTRALLOY." *Ibid.* (citing *Copperweld Corp. v. Astralloy-Vulcan Corp.*, 196 U.S.P.Q. 585, 590-91 (TTAB 1977)). So too here, "Redskinettes" involves the addition of just a few letters to the 1967-registered "Redskins" and is clearly part of the same family of marks. As Appellants concede: "In considering the merits of the Redskinettes mark, this Court would necessarily have

to examine the TTAB's analysis of the disparagement associated with the term 'redskin'" Supp. Op. Br. 28.¹⁰

Second, Appellants chide (Supp. Op. Br. 24-25) the district court for failing to cite any authority in support of its alternative rationale, that the "Redskinettes" mark must be evaluated in the context of its long-time use by the team. But Appellants themselves do not cite any contrary authority, and the district court's rationale is closely related to the just-discussed doctrine of tacking a new mark to an older one from which it derives. The point is that long-time use of a subsequently registered mark—and again it warrants emphasis that Romero indisputably knew of the Redskinettes name *since childhood*, JA 545 (¶ 61)—provides a complainant with notice of the mark such that there is no plausible excuse for the complainant to delay opposing the mark during the registration process or, at the very least, seeking cancellation promptly after registration. See *NAACP*, 753 F.2d at 137 ("Laches is founded on the notion that equity aids the vigilant and not those who slumber on their rights.").

Third, Appellants' invocation (Supp. Op. Br. 25-26) of the U.S. Code's general statute of limitations and a District of Columbia statute of limitations is puzzling because this Court has already held that there is no statute of limitations for a

¹⁰ Relatedly, had Romero successfully challenged the registrations for "Redskins" earlier, Pro-Football undoubtedly would have been precluded from registering (footnote continued)

cancellation claim under 15 U.S.C. § 1052(a). See *Harjo Appeal*, 415 F.3d at 48. More importantly, it is beside the point because, as this Court also held, the relevant statute “explicitly permits consideration of laches and other equitable doctrines” *Ibid.* As explained above, the district court acted within its discretion in finding laches to bar Appellants’ challenge to the “Redskinettes” mark.

Finally, Appellants’ argument (Supp. Op. Br. 26-27) that Pro-Football did not establish prejudice between 1990 and 1992 is merely another version of Appellants’ unpersuasive attempt to divorce the “Redskinettes” mark from the earlier-registered marks for laches purposes. In any event, Appellants acknowledge that “Pro-Football has presented evidence of advertising and other expenditures during the longer 1984-1992 time period and *some of those expenditures doubtlessly occurred during the 1990-1992 time period.*” *Id.* at 26-27 (emphasis added).


“Redskinettes” in the first instance in 1992.

CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of this Court's Order dated October 3, 2008 because this brief contains 6,970 words (according to Microsoft Word's word-count function), excluding the parts of the brief exempted by Fed. R. App. P. 32(a)(7)(B)(iii).

2. This brief complies with the typeface requirements of Fed. R. App. P. 32(a)(5) and the type style requirements of Fed. R. App. P. 32(a)(6) because this brief has been prepared in a proportionally-spaced typeface using Microsoft Word in 14-point Times New Roman font.

Dated: December 23, 2008



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