

Panel 2
Intellectual Property and Sports Law
Perspectives on Native Mascots

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***Cancelling Trademark Registrations
That Disparage Native Americans:
Successes and Challenges***

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Trademark Generally

- Symbol for product offered for sale
 - A **symbol** associated with specific goods or services
 - Must be **used** (in commerce)
 - Must be **source identifying**
- Can establish rights under the common law or Federal or State registration system (with use), all of which *generally* have similar requirements and limitations/prohibitions

Why Have Trademarks?

- Original purpose is to prevent consumer fraud by providing information as to source, affiliation, or sponsorship and product information
- Because it is not to incentivize inventions (patent) or creative works (copyright), the Federal trademark act (Lanham Act) is authorized under the Commerce Clause

Reasons to Prohibit or Limit Trademark Rights

Most relate to the unfair competition/anti-fraud purpose, such as

- Name of a Living Person (without written consent)
- Deceptive marks
- Generic marks
- Marks likely to cause confusion with existing marks

No secondary meaning and

- Descriptive marks
- Geographic marks
- Marks that are primarily surnames

– 15 USC § 1052

But the Lanham Act has two prohibitions that do not appear to fit the unfair competition/anti-fraud paradigm

Scandalous or Immoral Trademark Prohibition

(added in 1905)

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it –

(a) consists of or comprises immoral ... or scandalous matter; ...

– 15 USC § 1052

Justifications for Scandalous Registration Prohibition

- Avoid the appearance of government imprimatur
- Avoid wasting government time, services, and use of funds

Scandalous Prohibition Test

(no later than 1981)

Defined as “shocking to the sense of propriety or call out condemnation”

1. Determine the **likely meaning** of the mark in the context of the associated goods or services in the application, other elements in the mark, and the marketplace; and
2. Evaluate if a **substantial composite of the *general public*** would find it **scandalous** based upon attitudes **contemporaneous to the application timeframe**

Types of Marks Typically Found Scandalous

1. Political Imagery
 2. Religious Terms and Icons
-
4. Identity Issues involving race, gender, and sexual orientation
 5. Sexual Matter (vulgar)
 6. Profanity (vulgar)
 7. Illegality

1914 – Use on Religious Org. Names

- [Quaker Oats Representative] I am trying to speak of this matter generally, and the answer is that there is no necessity for it. There is no need for it. There is no **offense** being committed. There being no offense there should not be any such drastic punishment that would tie up not only our business, but a great deal of the business of our country, destroy trade-marks used throughout the civilized world, **cause a loss in the American industries** at the present time, just because of the **supersensitiveness** – and I say it with all respect – the supersensitive conscience of some very high-minded men
- [Representative for Society of Friends] I want to call attention to the fact that we . . . feel that it is not for other people to sit in judgment upon our possible supersensitiveness, because we believe we are here representing the conscience of our domination [sic] in the question

Disparaging Trademark Prohibition

(added in 1946)

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it –

(a) consists of or comprises ... matter which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.

– 15 USC § 1052

Statutory Distinctions between Scandalous and Disparaging

For both, the statutory language suggests two different prohibitions but treated as one. Yet:

1. Matter that *may* disparage
2. Limited to persons (living or dead), institutions, beliefs, or national symbols

Justification for Disparaging Registration Prohibition

Legislative History


- Focus on individuals –
 - Examples of prior “offensive” applications, such as KNUTE ROCKNE for whisky and alcoholic beverage and the Duchess of Windsor’s name for brassieres and underwear
- Would GEORGE WASHINGTON for coffee be offensive?
- And I would ask if DUCHESS OF WINDSOR constitutes a person or an institution?

Definition of Disparage

- Not defined in cases
- General definition from Dictionary.com
 - To speak of or treat slightly; depreciate; belittle
 - To bring reproach or discredit upon; lower the estimation of

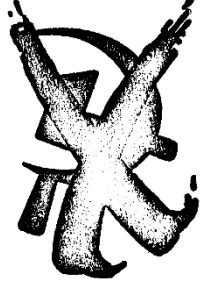
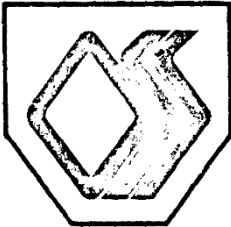
Initial Disparaging Claims

(yes or no)

1. Associating existing trademark and its owner with undesirable goods
 - 1951 – DOUGHBOY for venereal diseases treatment (*sua sponte*) - yes
 - 1960 –  for clubs, including in penal and mental institutions - yes
 - 1976 – K2 for cigarettes - no

Initial Disparaging Claims (yes or no)

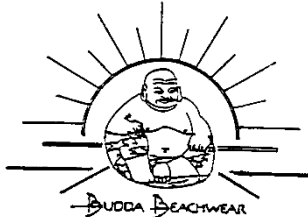
2. Political(?)/National Symbols –

- 1969 -  for educational services related to U.S. laws concerning Communist Party activities - yes
- 1975 -  (OSS) for business security systems – no
- 1977 – MOHAWK for airplanes - no

Initial Disparaging Claims (yes or no)

3. Religious Claims

- 1959 – SENUSSI for cigarettes - yes
- 1990 -  for dolls - no

- 1994 –  for clothing - no

4. Identity Claims

- 1975 – JAP for clothing - no

Initial Disparaging Claims (yes or no)

5. Use of Another Entity's Mark Disparages

– 1988 –



for polo shirts and
T-shirts (brought
by Greyhound) -
yes

Disparaging Prohibition Test (no earlier than 1994)

- (1) Determine the **likely meaning** of the mark, in context of products, other elements in the mark, and marketplace;
- (2) Evaluate if a **substantial composite of the *targeted group*** would find it **scandalous** based upon attitudes **contemporaneous to the application timeframe**

Note – different test for individual or corporate disparagement

Harjo (and then Blackhorse) *v. Pro-Football (1994 to present)*

- Disparaging claim based on race
- Petition to Cancel tm registrations – registration dates range from 1967-1990
- R__s__s
- R__s__ettes
- Washington R__s__s

The Redskins

WASHINGTON



REDSKINS

The Redskins



In re Tam (2013 to present)

- Disparaging Claim based on race
- THE SLANTS for a musical band



Band's Wikipedia entry: "The band name, The Slants, is derived from an ethnic slur for Asians."

"We want to take on these stereotypes that people have about us, like the slanted eyes, and own them. We're very proud of being Asian -- we're not going to hide that fact. The reaction from the Asian community has been positive."

In re Geller and Spencer (2013 – 2015)

- Disparaging claim based on religion
- STOP THE ISLAMISATION OF AMERICA for providing information regarding understanding and preventing terrorism
- The Southern Poverty Center defined as a hate group
- Geller: opposed mosque near Ground Zero, created bus ads under The American Freedom Defense Initiative, and ran the contest to draw Mohammed

Other Reported Disparagement Disputes Related to Native Americans

In re Squaw Valley Develop. Co. – June 2006

- Owner has registrations for SQUAW VALLEY and SQUAW VALLEY USA for its resort
- Application: SQUAW and SQUAW ONE for clothing; ski equipment; retail store services
- History: application refused, the Board originally reversed the refusal
- Refusal for 2 out of 3 because, that 1 (ski equipment), triggers geography, Squaw Valley Ski Resort in California

Other Reported Disparagement Disputes Related to Native Americans

The Crazy Horse Memorial Foundation v. Spence – Feb. 2014

- Application: CRAZY HORSE for online adult entertainment
- The Foundation raised an opposition to stop the registration process
- Disparagement was improperly introduced too late; was never substantively decided
- Other claims failed - Registered

Where We Are - *Blackhorse*

- June 2014 – TTAB cancelled the registrations as disparaging
- July 2015 – E.D. Va. *De novo* review also cancelled the registrations
- August 2015 – Pro-Football appealed to the 4th Circuit - pending

Where We Are – *In re Tam*

- Jan. 2012 to Sept. 2013 – various decisions at the USPTO (administrative level) to refuse registration based on disparagement
- Apr. 20, 2015 – Fed. Cir. affirmed the refusal with extensive additional views by Judge Moore
- Apr. 27, 2015 – *sua sponte per curium* opinion vacating prior decision for *en banc* review, adding in constitutionality question
- Dec. 22, 2015 – *en banc* decision holds Sec. 2(a) unconstitutional

Initial Thoughts

There are harms caused by conflating scandalousness and disparaging

- Congressional Intent:
 - Original language: “tends to bring into disrepute” → “may disparage”
 - Doubt in application of prohibition is resolved in favor of the applicant
- Undermines potential policy distinctions
 - Offense to sense of propriety vs. harm caused by stereotyping

Perhaps could flip current standard that holds that, when in doubt, allow registration

First Amendment Arguments Raised

- *In re Tam* – the prohibition conditions a benefit – trademark registration – on the relinquishment of speech
-
- *Pro-Football* – the prohibition is an impermissible regulation on commercial speech and would amount to viewpoint discrimination
 - *Geller v. USPTO* petition for cert – the disparaging prohibition constitutes viewpoint discrimination for political speech

First Amendment at the TTAB

Traditional position— *In re Geller*.

“The refusal to register applicants’ marks does not impede their right to use the mark. As such, it imposes no restraint or limit on their ability to communicate ideas or express points of view, and does not suppress any tangible form of expression. Therefore, applicants’ rights are not abridged by the refusal to register their mark.”

Additionally – *Harjo (and Blackhorse) v. Pro-Football*

Argument that Section 2(a) is unconstitutional is beyond the TTAB’s authority

Some First Amendment Arguments

1. Trademark vs. Trademark Registration
2. Government Speech - *Walker v. Texas Division, Sons of Confederate Veterans, Inc.*
3. Trademark as Commercial Speech
4. Ubiquity of Trademark Access - *FCC v. Pacifica* and George Carlin's Filthy Words

Another Argument With Success – Falsely Suggesting a Connection

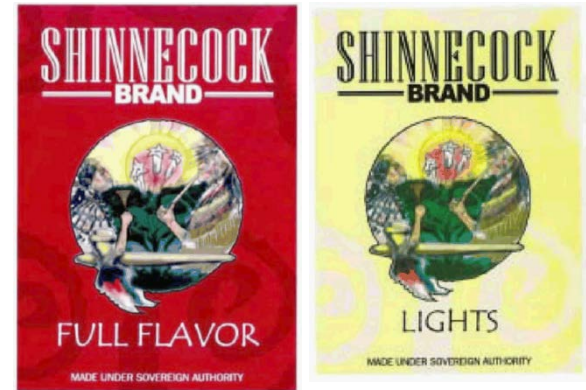
1. That the defendant's mark is the same or a close approximation of plaintiff's previously used name or identity;
2. That the mark would be recognized as such;
3. That the plaintiff is not connected with the activities performed by the defendant under the mark; and
4. That the plaintiff's name or identity is of sufficient fame or reputation that when the defendant's mark is used on the goods or services, a connection with the plaintiff would be presumed.

Falsely Suggesting a Connection - Example

In re Shinnecock Smoke

– Sept. 2008

- Application: cigarettes
- Applicant: on-reservation member of Shinnecock Indian Nation
- Affirmed refusal to register
- Among 4 elements, a key issue: applicant membership or nation's awareness of business is not enough – must be a specific commercial connection between the Applicant and the Nation



Falsely Suggesting a Connection – Examples of Success

- *In re (Julie) White*
 - APACHE for cigarettes (Sept. 2004);
 - MOHAWK for cigarettes (July 2006)
- *In re G&R Brands, LLC*–
 - MOJAVE for various tobacco related goods (Nov. 2008)
- *In re Kent Pedersen* –
 - LAKOTA for medicinal herbal remedies (Dec. 2013)

Falsefully Suggesting a Connection – Not Always Successful

- *In re Indian National Leather Co.*



– for distributor and mail-order services for various equestrian equipment (June 1997)

- *In re WM Distribution Inc.*

– SANDIA for cigarettes (Oct. 2005)

*Thanks for your kind attention,
and I'd welcome any
comments or questions.*

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