4-7-2015

Why the Current Trademark Disparagement Analysis Needs to be Revamped

Stella Silverstein
Cardozo Arts & Entertainment Law Journal

Why the Current Trademark Disparagement Analysis Needs to be Revamped

BY STELLA SILVERSTEIN / ON APRIL 7, 2015

In June 2014, the Trademark Trial and Appeal Board (TTAB) shocked football fans everywhere when it granted a petition to cancel six Washington Redskins trademark registrations. Filed by Navajo Amanda Blackhorse and four other Native Americans, the petition sought to cancel the registrations on the grounds that they disparaged the Native American people; all six of the registrations included the term "redskin", and two included the team's logo (a Native American chief).

The TTAB granted the petition based on the results of a two-part disparagement analysis. First, the TTAB considered the likely meaning of the term as it was used in the marks, and how the marks were used in connection with entertainment services (i.e., the services for which the marks were registered). The TTAB then evaluated whether the likely meaning of the term was disparaging to a substantial composite of the Native American population. After completing both prongs of the analysis, the TTAB concluded that all six registrations disparaged Native Americans at the time of registration and therefore violated federal law. On this basis, the TTAB granted the petition.

Needless to say, Pro-Football, Inc., the owner of the registrations, wasn't too happy. Within two months, the organization appealed the cancellation by bringing a civil action in the United States District Court for the Eastern District of Virginia. In its complaint, Pro-Football attacked the TTAB'S analysis and advanced its own arguments as to why the marks could not be construed as disparaging. In its analysis, Pro-Football went well beyond the parameters of the TTAB'S two-part framework. It considered the opinions of the general public, failing to limit its analysis to those of Native Americans. It considered how the marks were used in connection with goods *not* included in the registrations, when only the applied-for goods and services were relevant. And finally, it explored contemporary sentiment surrounding the marks, when such analysis should have been limited to the times of registration (in this case, the period 1967-1990).

Clearly, Pro-Football wrote its own rules when analyzing disparagement. In doing so, it brought up several points worthy of the TTAB's consideration. Whether or not Pro-Football is successful, it may very well have given the disparagement analysis the face-lift it needs. The new framework would better account for modern-day concerns that relate to both federal protection and common law rights (such as the ability to manufacture and sell goods). As a result, both the disparaged group and trademark applicants would be better protected.

For instance, one of Pro-Football's main arguments against cancellation was that the general public accepts the marks. Pro-Football based this argument on the healthy sales of Redskins merchandise, reasoning that people would not buy goods bearing the team name and logo if they found them so offensive. Native Americans comprise only 1.2% of the American population, so it is a safe assumption that most of the customers were non-Native Americans. But the current analytical framework demands that we ignore the views of those consumers, focusing only on the viewpoints of that 1.2%. Thus, the analysis seems to be missing a big piece of the puzzle.

If we were to follow Pro-Football's lead in future disparagement analyses, however, trademark applicants would have much more information at their disposal and be better able to protect themselves and the referenced group. For instance, suppose many Americans outside the referenced group took extreme offense at a word or phrase. As an applicant, knowing that a substantial composite of the general population *and* the referenced group felt this way would provide you with a much more powerful incentive to not file the application. In addition, you might not even want to manufacture and sell the goods on which you plan to place the mark, given your certainty that few will buy them. In making such decisions, you would protect yourself from making unnecessary expenses; you would not waste money on doomed trademark applications or the production of goods no one will buy. In addition, you would protect the referenced group by decreasing the likelihood of exposure to products bearing the disparaging marks.

A similar argument can be made for expanding the framework beyond the applied-for goods, and beyond the opinions held at the time of registration. Pro-Football did both by discussing its high merchandise sales and exploring present-day sentiments surrounding the marks. By considering goods for which it is arguably likely to file trademark applications, as well as the current opinions regarding the appropriateness of the marks, Pro-Football proposed a new framework that would allow for a more thorough examination and more informed decisions. Knowing that an application for *any* goods or services would be rejected, and knowing that both the referenced group and the general public *currently* find a mark offensive, an entity would likely spare itself the costs of filing the applications and selling the goods or services. Consequently, the absence of these goods and services from the marketplace would significantly reduce the risk that the referenced group would be exposed to them.