



9-1-1992

Native American Team Names in Athletes: It's Time to Trade These Marks

Paul E. Loving

Follow this and additional works at: <https://digitalcommons.lmu.edu/elr>



Part of the [Law Commons](#)

Recommended Citation

Paul E. Loving, *Native American Team Names in Athletes: It's Time to Trade These Marks*, 13 Loy. L.A. Ent. L. Rev. 1 (1992).

Available at: <https://digitalcommons.lmu.edu/elr/vol13/iss1/1>

This Article is brought to you for free and open access by the Law Reviews at Digital Commons @ Loyola Marymount University and Loyola Law School. It has been accepted for inclusion in Loyola of Los Angeles Entertainment Law Review by an authorized administrator of Digital Commons@Loyola Marymount University and Loyola Law School. For more information, please contact digitalcommons@lmu.edu.

ARTICLES

NATIVE AMERICAN TEAM NAMES IN ATHLETICS: IT'S TIME TO TRADE THESE MARKS

Paul E. Loving*

The field is almost limitless from which to select words for use as trade-marks, and one who uses debatable marks does so at the peril that his mark may not be entitled to registration.

—Judge Lenroot¹

I. INTRODUCTION

During 1991-92, teams with Native American names² experienced remarkable on-field success. The Atlanta Braves played in the 1991 and 1992 World Series, the Washington Redskins won Super Bowl XXVI, and the Florida State University Seminoles spent most of the season ranked first in both the Associated Press and United Press International college football polls.

These on-field accomplishments, however, occurred during a barrage of protests by Native American individuals and groups. Many Native Americans are outraged by the way they are portrayed in athletics. They perceive stereotypical portrayals such as the University of Illinois' mascot

* B.S., 1990, University of California at Los Angeles; J.D. candidate, 1993, University of Oregon School of Law, Associate Editor, *Oregon Law Review*. Upon graduation, the author will serve as a Judicial Clerk to the Honorable Edwin J. Peterson, Justice of the Oregon Supreme Court.

This Article was written for Professor Dom Vetri's Spring 1992 Intellectual Property Course. The author wishes to thank his wife Kim who initially recognized the problem with Native American team names. Sandy Robb, a close friend and colleague, and those individuals and groups across the country who provided me with research materials, also deserve special recognition. Copyright Paul E. Loving 1992.

1. *In re Riverbank Canning*, 95 F.2d 327, 329 (C.C.P.A. 1938).

2. The phrases "Native American team name" and "Native American name" are used somewhat loosely in this Article. These phrases also encompass slang, stereotypical, and offensive references to Native Americans such as "Redskins." In addition, "team names" should be read to include "team logos."

Chief Illiniwek,³ the tomahawk chop,⁴ the Florida State University mascot,⁵ the Washington Redskins' fight song,⁶ and the sacrilegious treatment of Native American religious symbols and practices at sporting events⁷ as demeaning and humiliating. The most insulting treatment concerns the use of Native American names for athletic teams.

This Article contends a legal remedy is available to opponents of Native American team names under the Federal Trademark Act ("Lanham Act").⁸ Those opponents could initiate a trademark cancellation proceeding to deprive an athletic team of the protections and benefits its team name receives under the Lanham Act. By eliminating a team's ability to enforce its trademarks in an infringement action, cancellation would decrease the value of the trademarks so dramatically a team would likely abandon them voluntarily. Further, if federal registration is canceled, common law

3. The "Chief" wears facial paint and a headdress and performs dances at University of Illinois games. The University Of Illinois' Director of Academic Affirmative Action described Chief Illiniwek as "an affront to the dignity of all Indians," and Senator Paul Simon signed a student petition to abolish Chief Illiniwek. See Franz Lindz, *Not A Very Sporting Symbol: Indians Have Ceased to be Appropriate Team Mascots*, SPORTS ILL., Sept. 17, 1990, at 8.

4. The "chop" originated at Florida State University during the 1970's and gained national attention during the Braves' 1991 season. The "chop" involves moving one's hand in an up and down chopping motion. Some fans hold foam tomahawks in their hand, others act as if they are holding a tomahawk.

The "chop" phenomena caught on in Kansas City at Chiefs' games, in Washington at Redskins' games, and at high school games across the country. After the conclusion of the 1991 World Series, Ted Turner, owner of the Braves, stated he "wouldn't mind getting rid of the tomahawk chop." However, during the Series he and his wife-to-be, Jane Fonda, participated in the "chop." Dan Burkhart, *Turner Won't Change Braves' Name, But Wouldn't Mind Stopping the Chop*, ATLANTA J., Dec. 3, 1991, at F8.

5. The Seminoles' mascot rides on horseback "onto the football field in a headdress and plant[s] a flaming spear into the ground." Rick Reily, *Let's Bust Those Chops*, SPORTS ILL., Oct. 28, 1991, at 110.

6. The lyrics to the 1938 version of the song are: "Hail to the Redskins, hail victory! Braves on the warpath, fight for old D.C.! Scalp 'em, swamp 'em, we will take 'em big score. Read 'em, weep 'em, touchdown, we want heap more!" Lyrics adopted in the 1970's, in response to Native American protests, are: "Hail to the Redskins! Hail victory! Braves on the Warpath, fight for old D.C.! Run or pass and score—we want a lot more! Beat 'em Swamp 'em Touchdown—let the points soar! Fight on, Fight on—Till you have won, Sons of Washington!!" See *Hail to the Redskins*, WASH. POST, Jan. 20, 1984, at N7.

7. See *infra* notes 288-90 and accompanying text.

8. 15 U.S.C. §§ 1051-1127 (1988). The Lanham Act is applicable because professional and collegiate team names are federally registered trademarks. For comprehensive and excellent treatments of the history of United States trademark law, see 1 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION §§ 5.1-5.4 (2d ed. 1984); FRANK I. SCHECTER, THE HISTORICAL FOUNDATIONS OF THE LAW RELATING TO TRADE-MARKS (1925); and Sidney A. Diamond, *The Historical Development of Trademarks*, 65 TRADEMARK REP. 265 (1975).

trademark will not provide any protection to a Native American team name. Although this Article focuses on professional athletics, its theories are equally applicable to any Native American team name which is a registered trademark.⁹

II. NATIVE AMERICAN TEAM NAMES

Native American team names are common in professional, collegiate, and high school athletics.¹⁰ Professional teams include: Atlanta Braves (baseball), Chicago Blackhawks (hockey), Cleveland Indians (baseball), Kansas City Chiefs (football), and Washington Redskins (football). Collegiate teams include: Florida State University Seminoles, St. Johns University Redmen, and Miami of Ohio University Redskins.¹¹ Discussing collegiate sports, one author notes:

In reality, if all names associated with the American Indian were grouped together, that category would be the unquestionable winner [of the most often used nickname]. In addition to Indians, such labels as Redmen, Warriors, Savages, Braves & Chiefs show up frequently as athletic mascots. These names still remain popular despite the efforts of minority groups around the country to separate any reference to the American Indian from college

9. The portion of this Article discussing common law trademark would also apply to those trademarks never registered, as well as trademarks whose registration was canceled.

Although this Article focuses on four professional teams, they certainly do not comprise an exhaustive list of racially offensive trademarks. One may wonder how broadly this theory could be applied. In particular, could people of Nordic ancestry challenge the trademark of professional football's Minnesota Vikings or people of Irish ancestry challenge professional basketball's Boston Celtic trademark? What about a sexist team name? See John R. Fuller & Elisabeth Anne Manning, *Violence and Sexism in College Mascots and Symbols: A Typology*, 15 FREE INQUIRY IN CREATIVE SOCIOLOGY 61 (1987) (examples of women's team names: Mercer University Teddy Bears and University of Arkansas at Monticello Cotton Blossoms); D. Stanley Eitzen & Maxine Baca Zinn, *The De-athletization of Women: The Naming and Gender Marking of Collegiate Sport Teams*, 6 SOCIOLOGY OF SPORT J. 362 (1989).

Without expressing an opinion on any of these particular trademarks, the author believes any petitioner who can demonstrate that a trademark meets one of the prohibitions of 15 U.S.C. § 1052(a) should prevail in an action to cancel a federally registered trademark. See *infra* note 100 and accompanying text.

10. This author's high school team has a Native American team name, "Warriors," and had a Native American mascot until 1989 when the mascot was banned at the recommendation of the Michigan Civil Rights Commission. See Letter from Brother Rice High School to John Roy Castillo, Director Dept. of Civil Rights (Feb. 3, 1989) (on file with author).

11. See generally THE BLUE BOOK OF SR. COLLEGE, UNIVERSITY AND JUNIOR & COMMUNITY COLLEGE ATHLETICS (Ansel W. Tinker ed., 1991).

sports.¹²

Apologists rely on several rationales to support retaining the current Native American names:¹³ (1) “[t]he [locale] has a tradition of involve-

12. RAY FRANKS, WHAT’S IN A NICKNAME? EXPLORING THE JUNGLE OF COLLEGE ATHLETIC MASCOTS 10 (1982).

13. MICHIGAN DEPARTMENT OF CIVIL RIGHTS, MICHIGAN CIVIL RIGHTS COMMISSION REPORT ON USE OF NICKNAME, LOGOS, AND MASCOTS DEPICTING NATIVE AMERICAN PEOPLE IN MICHIGAN EDUCATION INSTITUTIONS 19 (1988) [hereinafter MICHIGAN COMMISSION]. Contrary to this claim, several groups and individuals have complained. See *infra* notes 30-67 and accompanying text. It is true, however, that Native American team names and symbols have been used for a many years. For example, the Cleveland Indians will celebrate their 125th anniversary in 1994. CLEVELAND INDIANS PRESS GUIDE (1992).

Throughout its history, the team has changed its name several times: 1869 (Forest City), 1889 (Spiders), 1900 (Blues), 1902 (Broncos), 1903 (Naps), 1915 (Indians). When the team decided to change its name in 1903, a local newspaper sponsored a contest to choose the new team name. Cleveland residents chose the name Naps in honor of one of the team’s premiere players, Napoleon Lajoie. In 1914, Lajoie was released and a new name was needed. *Id.*

Once again, through a contest sponsored by a local newspaper, the franchise chose its new name based on fan balloting. One fan suggested the name Indians to honor a Native American who had played for the franchise when it was known as the Spiders. The player, Louis Sockalexis, was the first Native American professional baseball player. Sockalexis lived from 1871 to 1913 and was a Penobscot Indian. He attended college at Holy Cross College where he played intercollegiate baseball. In 1887, he joined the Cleveland organization. Sockalexis only played three seasons of professional baseball. *Id.*

The team has been named the Cleveland Indians for 77 years. And is often referred to as the “Tribe” and its players as the “Tribesmen.” The team’s present logo is a comical picture of a Native American who wears a headband with one feather, and who displays a large grin. The logo was designed by Bob Fishel in the late 1940’s. MICHIGAN COMMISSION at 5. At that time, Fishel was the secretary of the American Baseball League. Of the logo, Fishel stated, “[i]t was just supposed to be a happy Indian. I don’t believe in running down any group or nationality.” *Id.*

One writer, though, has compared the Cleveland Indians logo, a “grinning-injun,” to the stereotypical black character “Stepin Fetchit.” See Rick Reily, *Let’s Bust Those Chops*, SPORTS ILL., Oct. 28, 1991, at 110. In addition, the Michigan Civil Rights Commission noted, “[e]ven though a school administration [or in this case a franchise] may make a strong effort to present a dignified logo, it cannot control the misuse of the image which arises from fans.” MICHIGAN COMMISSION at 21 (for example, “posters, cheers or insults hurled at opposing teams”). Further, whether the Indians have made a “strong effort” is questionable.

The Washington Redskins also have a long history. The Redskins originally played in Boston, Massachusetts and were known as the Boston Braves. WASHINGTON REDSKINS PRESS GUIDE 230 (1991). The team’s original owner was George Preston Marshall. During the time the team played in Boston, the city was also home to the National League baseball franchise Boston Braves. On July 8, 1933, after a poor season by baseball’s Boston Braves, Marshall changed the name of his football team to the Redskins. Marshall supposedly chose the Redskins name because “he had always been an admirer of the American Indian and . . . one of the team’s coaches was an American Indian.” MICHIGAN COMMISSION at 6 (relying on statements by Marshall’s granddaughter, Jordan Price). This argument, though, ignores the teams’ old name which already was a Native American team name. In reality, what Marshall did was expand the

ment with Indian people;" (2) "[t]he original idea was to honor or pay tribute to the Indian community;" (3) "Indian people symbolize positive character[istics] which include courage, steadfastness and strength, which an athletic team should emulate;"¹⁴ and (4) "the name and symbol ha[ve] been used for a long time and no one has complained."¹⁵

In addition, many teams assert changing their team name will destroy the market for their trademarked goods.¹⁶ This argument is specious because it conveniently disregards the continued economic vitality of teams which have dropped their Native American team names. Although no professional team has abandoned its Native American team name, several universities have.¹⁷

offensiveness of his team name by choosing a more offensive term for Native Americans. In no way does this show admiration for Native Americans.

On February 13, 1937, the franchise moved to Washington and retained its name. WASHINGTON REDSKINS PRESS GUIDE 230 (1991). The current Redskins' logo is described as "an Indian head in profile, dressed in war paint and feathers." Richard Justice, *REDSKINS NOTEBOOK, Washington Entrenched On Nickname*, WASH. POST, Oct. 24, 1991, at B6.

14. The present ownership of the Redskins does not believe the team name is derogatory, rather, the name symbolizes the honorable characteristics of Native American culture. John Cooke, the team's executive vice president and son of Redskins owner Jack Kent Cooke, stated: "[The Redskins name] [o]ver the years, [has] come to represent the best of the culture—bravery, organization [of the Native Americans], the whole works. The name Redskins means football in Washington. We honor Native Americans. We believe that . . . [the Redskins name] represents the finest things in the Indian culture." Leonard Shapiro, *Offensive Penalty is Called on "Redskins": Native Americans Protest the Name*, WASH. POST, Nov. 3, 1991, at D1.

15. MICHIGAN COMMISSION, *supra* note 13, at 19.

16. See Raad Cawthorn, *Baseball Indians Receive Sympathy But No Promises*, ATLANTA CONST., Nov. 22, 1991, at H8 (the president of the Atlanta Braves stated the name change would be detrimental to the Braves' organization because of "business considerations"). See also MICHIGAN COMMISSION, *supra* note 13, at 19 (When faced with the possibility of changing their team names, "[s]everal administrators [of Michigan schools] raised questions about the cost of changing names and symbols."); Chuck Haga, *Torn Over A Nickname; Some Grand Forks Residents Fighting School Board's Ban on 'Redskins'*, STAR TRIB., Jan. 20, 1992, at B1 ("\$25,000 to change uniforms and equipment, and remove the Indian head logo painted on the basketball court floor.").

17. In addition to Stanford University and Dartmouth College, the University of North Dakota has also changed its Native American team name. See Julia Kazaks, *North Dakota Alters Indian Mascot*, STANFORD DAILY, Oct. 27, 1987, at 6.

A. Stanford Indians

In 1970, twenty-seven Native Americans enrolled at Stanford University.¹⁸ These students recognized the offensive nature of the school's team name and brought it to the attention of the University administration.¹⁹ The students met with various University officials to discuss the racist nature of the name and to encourage them to abandon its use.²⁰

In 1972, the students presented a petition to the Stanford Ombudsman urging the University to eliminate its Native American team name, the mascot "Prince Lightfoot," the offensive dress of the cheerleaders known as the dollies, the use of the name "Indians" in advertising, and to give aid to the Stanford Native American program.²¹ Later that year, "[a]fter a vote in the student senate and two student referendums," the University officially dropped the name "Indians."²² Unfortunately, there were efforts to revive it.²³

B. Dartmouth Indians

Dartmouth College was established in 1769 "for the education and instruction of Youth of the Indian Tribes in the land in reading, writing & all parts of Learning which shall appear necessary and expedient for

18. See STANFORD AMERICAN INDIAN ORGANIZATION STATEMENT ON "STANFORD INDIAN" SYMBOL—AUTUMN, 1975. The students, twenty-two undergraduate and five graduate, were the first Native Americans to enroll at Stanford.

19. *Id.*

20. *Id.* (Including its use and derivative use by the "[u]niversity administration, athletic department, bookstore, bike shop, band, dollies [the school's cheerleaders who dressed in Native American attire] and other groups.").

21. 1972 NATIVE AMERICAN PETITION.

22. Kazaks, *supra* note 17, at 6.

23. In addition to an unofficial campaign to bring back the Indian name, Prince Lightfoot has periodically shown up at Stanford athletic events. See, e.g., *Keep 'Chief' Off the Field*, STANFORD DAILY, Oct. 10, 1979, at 4 ("Shortly before the end of the halftime performance [at the Stanford/U.C.L.A. football game], [Timm] Williams and several large menacing body guards wearing 'Bring Back Chief Lightfoot' T-Shirts were admitted to the playing field and pompously paraded around the track to the cheers of many students, alumni and fans."). In an exemplary stance, the University has re-affirmed its 1972 position stating: "[U]nequivocally . . . the Indian is unacceptable as a mascot and will not be used again." *Let There Be No Mistake*, STANFORD DAILY, Oct. 10, 1980, at 7.

civilizing & Christianizing Children of Pagans”²⁴ Its athletic teams were not called the Indians until the mid-1920’s, when “such terminology simply slipped into newspaper sports page usage with increasing frequency.”²⁵ The name first appeared on athletic uniforms during the 1928-29 season, but did not appear on football jerseys until 1965.²⁶

In 1972, a Native American student group appeared before the Dartmouth Alumni Council (“Council”) and asked it to abolish the Indians name and symbol. The Council quickly appointed the “Indian Symbol Study Committee” to investigate this request.²⁷ After six months of research, chairman Robert D. Klimarx presented the study to the Council. He emphasized that “the committee was *not* simply giving in to another minority demand. There has been no demand on the part of [the College’s] Native Americans. . . . The Indian symbol may have made sense for Dartmouth at one time; it does not now. It is an idea whose time has gone by.”²⁸

In 1974, the Trustees of Dartmouth College affirmed the Council’s decision stating, “[t]he board considers use of the symbol in any form to be inconsistent with the present institutional and academic objectives of the College in advancing Native American education.”²⁹ While neither the committee nor the trustees would act to officially abolish the name “Indians,” their stance against the name resulted in student and alumni

24. REPORT AND RECOMMENDATION OF THE DARTMOUTH ALUMNI COUNCIL INDIAN SYMBOL STUDY COMMITTEE 2 (1972) [hereinafter DARTMOUTH REPORT]. Admittedly, though, Dartmouth was slow to enroll and educate Native Americans. *Id.* at 3.

25. DARTMOUTH COLLEGE OFFICE OF INFORMATION SERVICES PRESS RELEASE 2 (June 6, 1972) [hereinafter PRESS RELEASE].

26. *Id.*

27. DARTMOUTH REPORT, *supra* note 24, at 1.

28. PRESS RELEASE, *supra* note 25, at 2. However, the committee determined: “Since at no time in the college’s history has the Indian Symbol been adopted by a college governing body, the committee finds there is nothing to ‘repeal’ today.” *Id.* Therefore, the committee believed it would be improper to abandon a symbol never officially adopted. *Id.* The committee did note several on- and off-campus groups had voluntarily “curtail[ed] or eliminat[ed] . . . the use [or] mention of the Indian as a symbol,” and expressed their personal pleasure at these efforts. *Id.* at 3. The committee also distinguished Dartmouth’s situation from Stanford’s, who two months earlier had abolished its Indian name, because the Stanford student senate had officially established the Indian as the school’s symbol. *Id.* at 3; *see also* notes 18-23 and accompanying text.

29. DARTMOUTH COLLEGE NEWS SERVICE PRESS RELEASE 1 (Oct. 30, 1974). The Trustees, though, also agreed “no official action be taken to either affirm or eliminate the [Indian] symbol.” *Id.* at 8.

protests in favor of retaining the name.³⁰

III. RECENT PROTESTS OVER NATIVE AMERICAN TEAM NAMES

One individual dedicated to eliminating Native American team names is Tim Giago, editor and publisher of the *Lakota Times*.³¹ Giago, a member of the Oglala Lakota (Sioux) tribe, has written several editorials criticizing Native American team names.³² Giago also has written a commentary that appeared in *Newsweek* magazine,³³ urging individuals watching the 1992 Super Bowl to substitute "Blackskins," "Whiteskins," or "Yellowskins" for "Redskins" any time the team's name was used during the telecast.³⁴ Giago believed this would demonstrate how "demeaning, degrading and insulting" the name "Redskins" is to Native Americans.³⁵ Giago's commentary drew both strong support and criticism.³⁶

30. For example, the *Dartmouth Review* is campaigning to bring back the team's Indian name. See Franz Lindz, *Not A Very Sporting Symbol: Indians Have Ceased to be Appropriate Team Mascots*, SPORTS ILL., Sept. 17, 1990, at 8. While students may protest name changes, a school's decision to change its team name does not intrude on its students' First Amendment rights. See *Crosby v. Crosby*, 852 F.2d 801 (4th Cir. 1988) (upholding a high school principal's decision to ban the schools' "Johnny Reb" symbol "based on complaints that it offended black students and [at the] suggestion [of] the school's Minority Achievement Task Force" because school officials may "disassociate [their] school from controversial speech even if [the decision] may limit student expression").

31. The *Lakota Times* is published in Rapid City, South Dakota.

32. See, e.g., Tim Giago, *Pigskin Mascots: A Seasonal Insult*, LAKOTA TIMES, Sept. 25, 1991, at B5 ("The two teams most notorious for exploiting the skin color of Native Americans are the Washington Redskins and the St. John's Redmen."); Tim Giago, *Talk Radio: Ignorance Adds Insult to Injury*, LAKOTA TIMES, Oct. 30, 1991, at B6 ("A common question was, 'Why are Indians jumping on this issue all of the sudden when they haven't said anything all of these years?' The fact of the matter is, we have been saying something all of these years but no one was listening, and what is more, we never had a national forum from which to air our grievances."); Tim Giago, *In 1992, Let's Send Mascots Sailing Over the Ocean Blue*, LAKOTA TIMES, Dec. 30, 1991, at B5 ("We now believe it is time for all elected tribal leaders to stand up and help us bring this disgusting and disgraceful practice to an end.").

33. Tim Giago, *I Hope the Redskins Lose*, NEWSWEEK, Jan. 27, 1991, at 8.

34. *Id.*

35. *Id.* George Shankle, a "nickname" historian, notes that "the American Indians were nicknamed *The Red-Skins* by those persons who settled in the western part of the United States, because the skin of the Indian is a reddish copper color." GEORGE EARLIE SHANKLE, AMERICAN NICKNAMES: THEIR ORIGIN AND SIGNIFICANCE 373 (1937).

36. Sen. Paul Simon of Illinois found the commentary an "excellent article." See Sen. Paul Simon, *Article 'Excellent'*, LAKOTA TIMES, Feb. 12, 1992, at B4. Robert C. Hunter, President of PepsiCo. Food Systems in Dallas, Texas wrote: "Continue to educate the ignorant from your

Several Native American groups also have protested Native American team names. One group, Native American Students for Progress, protested several Redskins' regular season games.³⁷ Another group, the National Congress of American Indians, addressed offensive team names at their Annual Convention in San Francisco, California.³⁸ The Congress of American Indians issued a resolution which created a new office to, *inter alia*, identify and challenge racial stereotypes.³⁹ A third group, Concerned American Indian Parents, created an enlightening poster which depicts four pennants hanging on a wall.⁴⁰ The first pennant reads, "Pittsburgh

perspective. There are many Americans that still do not realize how demeaning and degrading these names can be . . . just because they've been a part of our past certainly does not make it right. Every person has a right to be treated with dignity." Robert C. Hunter, *Continue to Educate the Ignorant*, LAKOTA TIMES, Feb. 12, 1992, at B4. Loret Rueth of New Haven, Kentucky wrote: "To many, taking offense at team names and mascot's names may seem like 'nit-picking.' However, as you eloquently pointed out, the use of these names is clearly indicative of crass insensitivity." Loret Rueth, *Still Learning About Prejudice*, LAKOTA TIMES, Feb. 12, 1992, at B5.

Other letters were not so flattering. John Parker of Weatherford, Texas wrote, "U No Likem Washington Redskins? Your 'My Turn' in Newsweek sounded wimpy and juvenile." John Parker, *Who Cares if They are Called the Washington Redskins?*, LAKOTA TIMES, Feb. 12, 1992, at B5. Miriam H. Hemphill of Columbia, Missouri wrote: "I am sorry you feel that having a team named the Redskins is demeaning to Indians. To me it seems complimentary. . . . I honestly don't think anyone means to insult Indians by naming a team for them." Miriam H. Hemphill, *Please Take No Offense*, LAKOTA TIMES, Feb. 12, 1992, at B4. Merle E. Lofgren added: "Tim [Giago] must talk to different Indians than I do. I found none on the Standing Rock Reservation who agree with him. Maybe I talk to different Indians. I talk to ones on the street and sometimes in cafes and bars and even outside my church. He probably talks to ones in college think tanks and in protest groups." Merle E. Lofgren, *Many Indians Do Not Agree*, LAKOTA TIMES, Feb. 12, 1992, at B5.

37. Leonard Shapiro, *Indian Group to Protest at Sunday's Game*, WASH. POST, Oct. 31, 1991, at B3.

38. The National Congress of American Indians was established in 1944. It is the oldest national organization which represents Native American concerns. The Congress' goal is to "promote the common interests and welfare of [the] American Indian and Alaskan Native peoples." These interests include "speak[ing] out against racism and promot[ing] a greater understanding [of the indigenous peoples of North America]." *Resolution for National Congress of American Indians to Take Action on Anti-Defamation*, 48TH NATIONAL CONFERENCE OF AMERICAN INDIANS (1991).

39. *Id.*

40. The poster was created with the help of Martin-Williams Advertising, Inc., a Minneapolis, Minnesota advertising agency and is distributed by the Minnesota-Dakotas office of the National Conference of Christians and Jews.

Phil St. John, a Sioux, founded Concerned American Indian Parents after taking his two sons to a Minneapolis secondary school basketball game. One of the teams playing was named the "Indians." During the game, the team's mascot engaged in stereotypical portrayals of Native Americans. This incident led St. John to found the organization and work to eliminate Native

Negroes;" the second "Kansas City Jews;" the third "San Diego Caucasians;" and the fourth "Cleveland Indians." The caption at the bottom of the poster reads, "Maybe Now You Know How Native Americans Feel."

Native American groups also protested at the 1991 Major League Baseball World Series games in Minneapolis, Minnesota and Atlanta, Georgia. In Minneapolis, efforts led by the American Indian Movement ("AIM") attracted as many as 1,000 participants.⁴¹ At the conclusion of the World Series, AIM officials met with Atlanta Braves management to persuade them to change their team name.⁴² At a subsequent joint press conference, Braves management did not rule out changing the name, but stated there were no present plans to make such a change.⁴³

The pinnacle of the protest efforts came when the Washington Redskins qualified for Super Bowl XXVI.⁴⁴ Protesters seized this opportunity to gain national media coverage for their cause. Between 2,000 and 3,000 people, including members of AIM, the National Association for the Advancement of Colored People, the Urban Coalition, and the National Organization for Women, protested use of the name Redskins outside Super

American team names in Minneapolis public schools. See Craig Neff, *A Sign of Change*, SPORTS ILL., Feb. 1, 1988, at 10. His efforts were successful. See *infra* note 49 and accompanying text.

Concerned American Indian Parents also successfully convinced CBS to drop references to Indians as "savages" in the CBS special "This is America, Charlie Brown!" See Tony Kennedy, *Savage Editing Peanuts Show Revised After Indian Objections*, LANSING STATE J., Oct. 13, 1988, at C7.

41. Leonard Shapiro, *Protestors Want Super Bowl Platform: Native American Group Dislikes Name, But Hopes Redskins in Game*, WASH. POST, Dec. 17, 1991, at E6. The American Indian Movement (AIM) was founded in 1968 and is headquartered in Minneapolis. Clyde and Vernon Bellecourt, father and son respectively, direct the efforts of AIM.

42. See Cawthorn, *supra* note 16, at H8.

43. *Id.*

44. While this event was the high-water mark of protest efforts, protests over Native American team names are not unique to 1991 and 1992. Just prior to the kickoff of the 1988 Super Bowl, Fans Against Indian Racism (FAIR) flew a protest banner over Jack Murphy Stadium, located in San Diego, California, where the Redskins played in Super Bowl XXII. Tom Friend, *Onlookers Keep Moving at Practice*, WASH. POST, Jan. 29, 1988, at D5. FAIR also offered to sponsor a contest to change the Redskins' name. MICHIGAN COMMISSION, *supra* note 13, at 5. Also in 1988, there were efforts in Indiana to change Native American team names. See, e.g., Lawrence Hayes, *Indian Names Must Go*, J.-GAZETTE, May 1, 1988, at C6 (Fort Wayne, Indiana); Lawrence Hayes, *More About Indians*, J.-GAZETTE, May 27, 1988, at A8. In the early 1970's, there were student protests at Dartmouth and Stanford University concerning the schools' Native American team names. See *supra* notes 18-30 and accompanying text. In 1971, Native American students at Marquette were able to persuade school officials to abolish the school's Native American mascot "Willie Wampum." See MICHIGAN COMMISSION, *supra* note 13, at 4.

Bowl XXVI in Minneapolis, Minnesota.⁴⁵ Protesters held banners and shouted slogans as they marched around the stadium and denounced the use of Native American team names and mascots.⁴⁶

These protests have fallen on deaf ears. Two days prior to Super Bowl XXVI, in his state-of-the-National Football League speech, NFL Commissioner Paul Tagliabue discussed complaints concerning the names Redskins and Chiefs.⁴⁷ Tagliabue stated the NFL is "sensitive" to Native Americans' concerns about the team names, but added the names are not "demeaning."⁴⁸

Although protest efforts have had no effect in changing professional team names and only some effect in changing college names, these efforts have influenced other levels of organized athletics. In the Minneapolis area, Concerned American Indian Parents convinced several local public schools to change their Native American team names, and persuaded the school board to adopt a policy encouraging the abandonment of racially stereotypical team names.⁴⁹

In addition to Native Americans, others have voiced their disapproval of Native American team names. Notably, government agencies, legislators, and the media have begun to address the offensive nature of Native American team names. In 1988, the Michigan State Civil Rights Commission ("Commission") prepared a detailed report on Native American team names used in the state.⁵⁰ The Commission found Native Americans are the only racial group used as a team mascot or name in Michigan.⁵¹ The Commission, referring to team names, logos, and mascots, concluded that "[the] use of Indian images is stereotypic[al], racist and discriminatory," and recommended "the use of Indian names, logos and mascots . . . be discontinued [by Michigan schools] because racial stereotyping of Native Americans is prevalent and destructive."⁵² Acting on the Commission's recommendation, Eastern Michigan University dropped its Native American

45. Compare Ken Denlinger, *Protest of "Redskins" Draws 2,000 at Stadium*, WASH. POST., Jan. 27, 1992, at C18 (claiming the number was 2,000) with Eric Haase, *3,000 Rally Against Racist Mascots*, LAKOTA TIMES, Jan. 28, 1992, at B1 (claiming the number was nearly 3,000).

46. Denlinger, *supra* note 45, at C18.

47. See Mike Freeman, *NFL Deadline For Plan B Slips to Mar. 1, NFPLA Says Move Is Political*, WASH. POST., Jan. 25, 1992, at D7.

48. *Id.*

49. See Dan Fields, *Notes On A Scorecard*, SPORTS ILL., Feb. 1, 1988, at 10.

50. See *supra* note 13.

51. MICHIGAN COMMISSION, *supra* note 13, at 14. Four of 52 colleges, 62 of 711 high schools, and 33 of 605 junior high/middle schools had Native American team names or logos. *Id.* at 23.

52. *Id.* at 26, 29.

team name.⁵³

Legislators are also beginning to act. In Missouri, proposed, but ultimately unsuccessful, legislation would have prohibited funding⁵⁴ to the stadium where the Kansas City Chiefs play if the team were to "discriminate against Native Americans or mock sacred Native American symbols."⁵⁵ In Washington, D.C., a resolution has been passed by the District of Columbia Council which urges Washington Redskins owner Jack Kent Cooke "to change [the team's name] to a name that is not offensive to Native Americans or any other minority group."⁵⁶

One major newspaper, the *Oregonian*,⁵⁷ has courageously discontinued printing any racial, religious, or ethnic team names which may be considered offensive.⁵⁸ This decision, like Giago's commentary in *Newsweek*,⁵⁹ prompted a flood of letters to the editor.⁶⁰ While no other

53. In 1991, the team changed its name from the Hurons. The school's president William Shelton stated: "[We] never intended disrespect . . . toward Native Americans." Michael Jaffe, *For The Record*, SPORTS ILL., Feb. 11, 1991, at 208.

54. Current legislation provides for up to two million dollars to be allocated to the sports complex where the Kansas City Chiefs play their home games. See MO. REV. STAT. § 67.641 (Supp. 1991).

55. H.R. 1560, 86th Gen. Assem., 2d Reg. Sess. (1992) would have repealed MO. REV. STAT. § 67.641 (Supp. 1991) and added new language. The bill was tabled in committee.

56. See Council of the District of Columbia Request for a Name Change of the National Football League (NFL) Washington, D.C. Team, PR-330 (1992). Although the resolution was unanimously passed, it does not have a binding legal effect on the Redskins organization. See Rene Sanchez, *Tougher Bail Law Activated In D.C.: Council Puts Vote Measure Into Effects Now*, WASH. POST, Mar. 4, 1992, at D5.

57. The *Oregonian* is a daily newspaper published in Portland, Oregon.

58. See William A. Hilliard, *To Our Readers*, OREGONIAN, Feb. 16, 1992, at D1 ("I have directed this action with the belief that these names tend to perpetuate stereotypes that damage the dignity and self-respect of many people in our society and that this harm far transcends any innocent entertainment or promotional value these names may have."). The *Oregonian's* decision curbs the temptation to use catchy headlines in reporting teams with Native American names. For example, a sports section headline in the *Indianapolis Star* read: "Mitchell, Redskins scalp Vikings 24-7." INDIANAPOLIS STAR, Jan. 3, 1993, at B1.

59. See *supra* note 33.

60. Some were extremely supportive and others were highly critical. Compare Ross Daily, *As Well as Overdue, Sensitive, Moral*, OREGONIAN, Feb. 23, 1992, at F2 ("It's an overdue move, and one which should be followed immediately by all media."); Phillip Park, *Names Impact On People*, OREGONIAN, Feb. 23, 1992, at F2 ("Rather than being criticized, The *Oregonian* is to be congratulated for its courageous stance in changing its editorial policy."); Rosemary Domkus, *Decision Reflects Understanding*, OREGONIAN, Feb. 23 1992, at F2 ("Anyone who canceled his or her newspaper subscription in protest of your new policy would benefit from a refresher course in humanity.") with Randy Steck, *Well-Intentioned But Ill-Conceived*, OREGONIAN, Feb. 23, 1992, at F2 ("You have overstepped your bounds. I urge you to re-consider this decision and opt for accurate reporting of the facts."); Dick Hoskins, *Names Reflect Winners*, OREGONIAN, Feb. 23,

major newspaper has followed the *Oregonian's* example,⁶¹ radio station WTOP in Washington, D.C. stopped using the names "Redskins," "Braves" and "Fighting Irish" for a brief period.⁶²

However, not everyone agrees that Native American team names are disrespectful to Native Americans.⁶³ In response to media coverage of the issue, letters sent to the editors of several newspapers have supported the team names.⁶⁴ In addition, a national public opinion poll by the *Washington Post* found eighty-nine percent of their sample believe the name "Redskins" is not intended to be offensive and should not be changed.⁶⁵ In fact, even some Native Americans do not support the protests.⁶⁶ For

1992, at F2 ("[T]he names of sports teams [are] intend[ed] to reflect winners . . . [therefore they] contribute to, rather than damage, the self-respect of those peoples."); John Kindseth Lodi, *Animal Nicknames Next to Go?*, OREGONIAN, Feb. 23, 1992, at F2 ("[P]olitics is shortsided, silly, panders to politically correct whiners and an affront to academicians everywhere.").

61. The *Sporting News*, though, may also change its publication policy. Telephone interview with John Rawlings, Sports Editor of The *Sporting News* (April 15, 1992).

62. See Leonard Shapiro, *WTOP Won't Say 'Redskins': Radio Station Heeds Native Americans' Distaste*, WASH. POST, March 15, 1992, at D1 ("It's the minority group that determines what's offensive, regardless of what the majority wants."). The station, however, had second thoughts about its decision, and eventually a new station owner reversed the policy. See Leonard Shapiro, *SPORTS WAVES—Ban on 'Redskins' Still News at WTOP*, WASH. POST, Apr. 3, 1992, at F2. See also Jeffery Yorke, *On the Dial—Skins, Namely, Back at WTOP*, WASH. POST, Nov. 10, 1992, at C7.

63. In an uncharacteristic statement, given his past human rights contributions, Former President Jimmy Carter declared: "With the Braves on top, we have a brave, courageous and successful team, and I think we can look on the American Indian as brave, successful and attractive. So I don't look on [the name Braves] as an insult." Charles Walston, *WORLD SERIES '91 Miller, Carter Disagree with Indian Protesters*, ATLANTA CONST., Oct. 24, 1991, at D7.

64. Concerning the selection of team names, one individual noted that "Native Americans should be proud that they were deemed worthy of such recognition." Charles W. Herdman, *Braves & Tomahawks*, SPORTS ILL., Nov. 25, 1991, at 6. See also Joe Welch, *Name Game*, SPORTING NEWS, Dec. 30, 1991, at 6 (editorial letter praising Ted Turner for retaining the name "Braves" rather than bowing to pressure applied by special interest groups).

65. See Richard Morin, *"America's Team" Has a New Home: Washington*, WASH. POST, Jan. 17, 1992, at G1.

66. See Mike Brosenne, *Native American Protests—Overdone*, WASH. POST, Nov. 4, 1991, at A20 (letter to the editor by member of the Eastern Shawnee Tribe of Oklahoma encouraging Native Americans to end trivial protests and focus their energy on more constructive solutions to Native American problems). See also Terence Moore, *Tomahawk Chop Getting Old Anyway*, ATLANTA CONST., Nov. 23, 1991, at D2 (In a letter to Florida State Officials, Chief James E. Billie of the Florida Seminole Tribe wrote: "I've often thought that a lot of people would like to be considered an Indian or a Native American. If they are not by birth, then they choose to use an American tribe as a namesake that is indicative of their toughness.").

Giago, who had been a long time critic of AIM, stated: "We are allowed to have our differences, but on an issue of national importance, we as Indian people, no matter what tribe we're from, we must unite." Haase, *supra* note 45, at B2.

example, the Chief of the Cherokee tribe in North Carolina finds nothing wrong with the names "Redskins" or "Braves."⁶⁷

Despite the disagreement as to the propriety of the team names, there is growing dissatisfaction among Native Americans and many others. The obvious choice for athletic teams interested in countering this growing dissatisfaction, would be to voluntarily change their offensive names. Obstinate, the Braves,⁶⁸ Chiefs, Indians, and Redskins⁶⁹ appear determined to retain their current Native American names.

IV. ECONOMIC IMPORTANCE OF TEAM TRADEMARKS

Professional teams register their names, and often several logos, as trademarks.⁷⁰ These trademarks are an important source of team and league revenues. The merchandising of team trademarks on clothing, athletic equipment, and novelty gifts produces considerable revenues each year.⁷¹ In 1990, analysts estimated professional athletic licensing pro-

67. See Leonard Shapiro, *Offensive Penalty is Called on "Redskins": Native Americans Protest the Name*, WASH. POST, Nov. 3, 1991, at D1; *World Series '91 Cherokee Tribe Supports Chop, May Adopt Braves*, ATLANTA CONST., Oct. 24, 1991, at D7. The Chief, however, may be biased. The Cherokee tribe in North Carolina manufactures most of the foam tomahawks used in Atlanta and provides Native American souvenirs sold at RFK stadium where the Redskins play their home games. These operations provide approximately 300 jobs to members of the Cherokee tribe. *Id.*

Asked about Native Americans who are fans of the Redskins, Clyde Bellecourt, executive director of AIM stated: "You'll always find scouts willing to ride with the cavalry." Rachel Shuster, *Indian Group Targets Redskins Name Next*, USA TODAY, Jan. 17, 1992, at C1. See also THOMAS W. DUNLAY, *INDIAN SCOUTS AND AUXILIARIES WITH THE U.S. ARMY IN THE TRANSMISSISSIPPI WEST, 1860-1890* (1980).

68. Ted Turner, owner of the Atlanta Braves believes: "There is nothing wrong with [the name] Braves. It's a compliment. Braves are warriors No, I don't plan on changing the name." Dan Burkhart, *Turner Won't Change Braves' Name, But Wouldn't Mind Stopping the Chop*, ATLANTA J., Dec. 3, 1991, at F8.

69. After winning Super Bowl XXVI, Redskins owner Jack Kent Cooke stated that "[t]here is nothing in the world wrong with the name Redskins." Denlinger, *supra* note 45, at C18.

70. The Braves, Chiefs, Indians, and Redskins hold numerous trademarks that are registered world wide. Whether team names are registered as "service marks" or "trademarks," they are entitled to identical protection and must meet the same registration requirements. See 15 U.S.C. § 1053 (1988) ("Subject to the provisions relating to the registration of trade-marks . . . service marks shall be registrable, in the same manner and with the same effect as are trade-marks, and when registered they shall be entitled to the [same] protection provided herein in the case of trade-marks.").

71. See generally Glenn M. Wong, *Recent Trademark Law Cases Involving Professional and Intercollegiate Sports*, 1 DET. C.L. REV. 87 (1986); David M. Kelly, Comment, *Trademarks: Protection of Merchandising Properties in Professional Sports*, 21 DUQ. L. REV. 927 (1983).

duced over \$3.8 billion in sales.⁷² This figure is more than \$2.4 billion greater than the revenues produced in 1985.⁷³

Collegiate licensing is also lucrative. This appears to be the result of network telecasts of collegiate events, begun in the 1970's. In 1989, the University of Notre Dame led the nation in collegiate trademark licensing revenue, earning one million dollars.⁷⁴ The sixth largest licensing revenue belonged to the University of Iowa at a respectable half million dollars.⁷⁵ In 1989, total collegiate licensing reached one billion dollars, twice that of 1986.⁷⁶

Professional team trademarks are licensed on a variety of items including such traditional ones as jackets, baseball hats, and t-shirts, as well as such obscure items as bird feeders, underwear, and hubcaps.⁷⁷ College trademarks also appear on a variety of items ranging from golf visors to vanity license plates.⁷⁸ One can even purchase toilet paper with Chief Illiniwek's picture imprinted on the sheets.⁷⁹

Professional leagues have been so successful in merchandising their teams' trademarks that several have established exclusive licensing agents. In 1963, NFL Properties was created to license the trademarks of what are now twenty-eight teams.⁸⁰ In addition, Major League Baseball Properties, NBA Properties, and the Licensing Company of America (for the National Hockey League), have been created to license their respective league's team trademarks.

The Washington Redskins have been very effective in licensing their team trademarks. The Redskins ranked sixth in NFL licensing in 1987 and second in 1988.⁸¹ In addition, because the Redskins have played in several recent Super Bowls, they have enjoyed a boost in sales the years

72. See Chuck Stogel, *Teams Logos Turning Into Gold*, SPORTING NEWS, Nov. 12, 1990, at 48.

73. *Id.*

74. Gerald Eskenazi, *Sports Logos Now Symbols of Big Profits*, N.Y. TIMES, June 19, 1989, at A1.

75. *Id.*

76. *Id.*

77. See Stogel, *supra* note 72, at 48.

78. Gerald Eskenazi, *Sports Logos Now Symbols of Big Profits*, N.Y. TIMES, June 19, 1989, at A1.

79. See Haase, *supra* note 45, at B1.

80. See Elizabeth Comte, *NFL Properties' Values Booming*, SPORTING NEWS, Oct. 30, 1989, at 64.

81. Richard Rosenblatt, *Bears Are NFL'S Best Sellers*, SPORTING NEWS, May 22, 1989, at 49 (1987 revenue was 32.5 million dollars and 1988 revenue was 50.6 million dollars).

following their victories.⁸² Individual successes such as this are misleading, however, as all NFL teams share equally in the total NFL Properties' revenues.⁸³

V. TRADEMARK LAW

A. *Basic Principles*

The Lanham Act currently governs federal trademark law.⁸⁴ The act defines a trademark as any "word, name, symbol or device" used by a manufacturer or merchant to identify its goods and distinguish them from those of another manufacturer or merchant.⁸⁵ While the Lanham Act is a comprehensive statute, it leaves undisturbed the principles of common law trademark. Common law protection arises when the mark is first used in connection with the sale of the good or service.⁸⁶ Accordingly, a trademark owner has common law rights in addition to rights under the Lanham Act.

B. *The Federal Registration Process*

The Lanham Act provides for the federal registration of marks⁸⁷ on two Registers: the Principal⁸⁸ and the Supplemental.⁸⁹ Marks eligible

82. *Id.*

83. This income sharing arrangement tends to belie the economic harm argument used to support preservation of Native American team names. See *supra* note 16 and accompanying text.

84. See 15 U.S.C. §§ 1051-1127 (1988). The Act is named after Representative Fritz G. Lanham who introduced the bill. The Lanham Act replaced the Trademark Act of 1905. For a comparison of the two Acts, see DAPHNE ROBERT, *THE NEW TRADE-MARK MANUAL* (1947). Two helpful examinations of the Lanham Act are Bartholomew Diggins, *The Lanham Trade-Mark Act*, 35 GEO. L.J. 147 (1947) and Elwin A. Andrus & Merle E. Sceales, *The New Trade-Mark Act*, 1947 WIS. L. REV. 618 (1947).

85. 15 U.S.C. § 1127.

86. See *infra* notes 258-263 and accompanying text.

87. A mark is defined as "any trade-mark, service mark, collective mark, or certification mark" that is entitled to registration under the Lanham Act. 15 U.S.C. § 1127.

88. 15 U.S.C. §§ 1051-72.

89. 15 U.S.C. §§ 1091-96. The Supplemental Register enables the owner of a mark to register it domestically as a basis for foreign protection. See 15 U.S.C. § 1091. In addition, when the mark does not qualify for registration on the Principal Register but has acquired secondary meaning, it may be registered on the Supplemental Register. *Id.* After this footnote, any reference to "federal registration" refers exclusively to registration of the Principal Register.

for registration on the Principal Register are trademarks,⁹⁰ service marks,⁹¹ collective marks,⁹² and certification marks.⁹³ A trademark may be granted registration subject not only to the specific requirements of these two Registers but also the Lanham Act as a whole.

To obtain registration on the Principal Register, the trademark applicant is required to complete an application form and tender a fee to the United States Patent and Trademark Office.⁹⁴ Once this is done, the trademark examiner makes an "*ex parte*" determination of whether the trademark is subject to federal protection.⁹⁵

Two threshold requirements that must be met are whether the trademark has been "used in commerce,"⁹⁶ and whether the mark has been affixed to the goods sold or transported in commerce.⁹⁷ Additionally, and most importantly for this Article's discussion, the examiner must decide whether the trademark violates 15 U.S.C. § 1052.⁹⁸ This section prescribes prohibitions to federal registration:

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, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs or national symbols, or bring them into contempt, or disrepute.⁹⁹

If a trademark is "found not entitled to registration," an applicant can submit an amended application within six months.¹⁰⁰ Upon a final denial

90. 15 U.S.C. § 1127.

91. 15 U.S.C. § 1053 (service marks are afforded the same protection given to trademarks). A "service mark" is a mark used in the sale or advertising of services. See 15 U.S.C. § 1127.

92. 15 U.S.C. §§ 1054, 1127.

93. 15 U.S.C. §§ 1054, 1127.

94. 15 U.S.C. § 1113. False or fraudulent statements contained in the application subject the applicant to civil penalties. 15 U.S.C. § 1120.

95. 15 U.S.C. § 1062.

96. 15 U.S.C. § 1051. The phrase "used in commerce" refers to use in United States interstate commerce or in United States commerce with foreign countries. 15 U.S.C. § 1127.

97. 15 U.S.C. § 1127.

98. 15 U.S.C. § 1052.

99. *Id.* In contrast to the Lanham Act, the Copyright Act does not deny copyright registration to works of authorship which may be deemed immoral or obscene. See 17 U.S.C. § 102 (1988). See also *Mitchell Brothers Film Group v. Cinema Adult Theatres*, 604 F.2d 852, 858 (5th Cir. 1979), *cert. denied*, 445 U.S. 917 (1980) ("1909 copyright statute [contains] no explicit or implicit bar to the copyrighting of obscene materials and [provides] for the copyright of all creative works.").

100. 15 U.S.C. § 1062(b).

of registration, the applicant may appeal the examiner's decision.¹⁰¹ If the examiner determines the mark is entitled to registration, the mark will be published in the *Official Gazette of the Patent and Trademark Office*.¹⁰² Within thirty days following the mark's first publication, "any person who believes that he would be damaged by the registration of [the] mark . . . may file an opposition."¹⁰³

If an opposition is filed, an opposition proceeding is initiated. An opposition proceeding is an adversarial hearing before the Trademark Trial and Appeal Board ("Trademark Board").¹⁰⁴ To prevail, the opposer must plead and prove standing,¹⁰⁵ and state why the mark in question should not be granted registration.¹⁰⁶ Equitable defenses are available to the owner of the trademark.¹⁰⁷

A decision by the Trademark Board may be appealed to either the Court of Appeals for the Federal Circuit¹⁰⁸ or to one of the United States District Courts.¹⁰⁹ If opposition to the trademark fails, a certificate of registration is issued.¹¹⁰ A certificate of registration remains in effect for ten years¹¹¹ and can be renewed for subsequent ten year periods.¹¹²

Once the Patent and Trademark Office grants a trademark federal registration, its owner is entitled to several rights and protections.¹¹³

101. 15 U.S.C. § 1070.

102. 15 U.S.C. § 1062(a).

103. 15 U.S.C. § 1063.

104. 15 U.S.C. § 1067. The proceeding must "be heard by at least three members of the [Trademark] Board." *Id.*

105. 15 U.S.C. § 1063.

106. For example, this may mean the applicant has failed to use the mark "in commerce." See *Community of Roquefort v. Santo*, 443 F.2d 1196 (C.C.P.A. 1971); *Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024 (C.C.P.A. 1982). It may also mean that registration is prohibited by 15 U.S.C. § 1052. See *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176 (1978).

107. 15 U.S.C. § 1069 (e.g., laches, estoppel, and acquiescence).

108. 15 U.S.C. § 1071(a); 28 U.S.C. § 1295(a) (1988). Once a final decision is reached by the United States Court of Appeals for the Federal Circuit, the case may be appealed to the United States Supreme Court. 28 U.S.C. § 1256 (1988). Whether to pursue an action in district court or with the Court of Appeals for the Federal Circuit is up to the appealing party.

109. 15 U.S.C. § 1071(b); 15 U.S.C. § 1121. Once a final decision is reached by the district court, the case may be appealed to the United States Court of Appeals, 28 U.S.C. § 1291 (1988); 15 U.S.C. § 1121, and then to the United States Supreme Court. 28 U.S.C. § 1254 (1988).

110. 15 U.S.C. § 1063(b).

111. 15 U.S.C. § 1058(a) (subject to filing an affidavit of use by the trademark's owner that the trademark is still used in commerce or its lack of use meets one of the sections' exceptions).

112. 15 U.S.C. § 1059.

113. See generally Note, *Trademarks and Unfair Competition*, 68 HARV. L. REV. 814, 827-31 (1955).

First, a certificate of registration is "prima facie evidence of the validity of the registration," and the registrant's ownership and exclusive right to use the mark.¹¹⁴ For purposes of enforcement, federal registration implies the existence of a federal question. Thus, a party may have access to the federal court system without meeting the amount in controversy or diversity requirements.¹¹⁵ In a civil infringement action, the registered owner of a trademark may recover damages, defendant's profits, and costs of the suit.¹¹⁶ Additionally, the registered owner may destroy any infringing articles.¹¹⁷ In "exceptional cases," reasonable attorney fees may also be awarded to the prevailing party.¹¹⁸

Further, a federally registered trademark is incontestable unless it is subject to cancellation under 15 U.S.C. § 1064(3) or (5).¹¹⁹ Federal registration also provides "constructive notice of the registrant's claim" thereby eliminating any possibility of a good faith defense by an infringer.¹²⁰ Lastly, federal registration affords the trademark owner rights and remedies against imported goods infringing the trademark.¹²¹

C. Interpretation of 15 U.S.C. Section 1052(a)

When interpreting section 1052(a), it is important to remember the drafters of the Lanham Act significantly expanded prohibitions on trademark registrability. Under the 1905 Trademark Act, only marks which "[c]onsist[ed] of or comprise[d] immoral or scandalous matter" were prohibited,¹²² whereas under the Lanham Act, such concepts as disparagement, contempt, and ridicule have been added to the prohibited material. The policy considerations behind the drafters' expansion of the prohibitions should not be ignored when considering how to construe these bars to registration. Had the drafters intended to broaden the scope of trademark subject matter to encompass more questionable marks, they would not have

114. 15 U.S.C. § 1057(b); 15 U.S.C. 1115(a). See also *May Dep't. Stores Co. v. Schloss Bros. & Co.*, 234 F.2d 879 (C.C.P.A. 1956); *Iowa Farmers Union v. Farmers' Educ. & Co-op Union*, 247 F.2d 809 (8th Cir. 1957).

115. 15 U.S.C. § 1121.

116. 15 U.S.C. § 1117.

117. 15 U.S.C. § 1118.

118. 15 U.S.C. § 1117.

119. 15 U.S.C. § 1065; 15 U.S.C. § 1115(b). Title 15, § 1064(3) is discussed at length *infra* notes 218-50 and accompanying text.

120. 15 U.S.C. § 1072.

121. 15 U.S.C. § 1124.

122. 15 U.S.C. § 85(a) (1905).

added several new prohibitions.

Neither the text nor the legislative history of the Lanham Act defines the prohibitions found in section 1052(a). Accordingly, to construe the language of section 1052(a), one must consider federal court and Trademark Board decisions interpreting the Lanham Act, as well as dictionary definitions. In addition, most states have enacted trademark statutes which are similar if not identical to the Lanham Act.¹²³ Despite federal and state legislation, there is a "dearth" of case law interpreting prohibited matter.¹²⁴

1. Cases Decided Under the 1905 Act

In 1938 *Ex parte Martha Maid Manufacturing*¹²⁵ was the first case to interpret the language of the 1905 Act. The case involved a denial of registration because the mark was prohibited by section 5(a).¹²⁶ The mark in question, "Queen Mary," was used in connection with "women's undergarments, including slips, dance sets, etc."¹²⁷ The examiner refused registration because the mark was scandalous.¹²⁸ In a brief opinion, the Commissioner of Patents ("Commissioner") affirmed the refusal.¹²⁹

A few months later, the Court of Customs and Patent Appeals ("Court of Customs") decided *In re Riverbank Canning Co.*¹³⁰ The applicant appealed the examiner's refusal to register "MADONNA" as a mark for wines on the grounds it was scandalous within the meaning of section 5(a) of the 1905 Act.¹³¹ The Commissioner affirmed,¹³² and an appeal was granted by the Court of Customs.¹³³

The Court of Customs held scandalous must be given "its ordinary and

123. See, e.g., GA. CODE ANN. § 10-1-441 (1991).

124. *In re McGinley*, 660 F.2d 481, 485 n.6 (C.C.P.A. 1981) (specifically referring to interpretations of "immoral").

125. 37 U.S.P.Q. (BNA) 156 (1938).

126. Section 5 was the 1905 Act's version of 15 U.S.C. § 1052(a).

127. 37 U.S.P.Q. (BNA) at 156.

128. *Id.*

129. *Id.*

130. 95 F.2d 327 (C.C.P.A. 1938). This decision attracted limited scholarly comment. See Austin Dunn, Note, *Trademarks and Tradenames—Scandalous Matter*, 18 OR. L. REV. 58 (1938). Although Dunn incorrectly states *Riverbank Canning* was the first case in this area, certainly this decision is a much more insightful examination of section 5(a) than is *Martha Maid*.

131. 95 F.2d at 327.

132. 30 U.S.P.Q. (BNA) 374 (1936).

133. 95 F.2d at 327.

common meaning."¹³⁴ This meaning was defined as:

1. Causing or tending to cause scandal; . . . shocking to the sense of truth, decency, or propriety; disgraceful; offensive; disreputable;
2. Giving offense to the conscience or moral feelings; exciting reprobation; calling out condemnation;¹³⁵

Applying this guideline, the Court of Customs found "MADONNA" was not "per se scandalous."¹³⁶ However, "consideration ordinarily must be given to the goods upon which the mark is used."¹³⁷ Applying this criteria, the Court of Customs upheld the refusal to register.¹³⁸

134. *Id.* at 328.

135. *Id.* (citations omitted).

136. *Id.*

137. *Id.*

138. 95 F.2d at 327 (Mark's "use upon wine for beverage purposes would be shocking to the sense of propriety of nearly all who do not use wine as a beverage, and also to many who do so use it.').

However, there was a dissent. *Id.* at 329-31 (Jackson, J., dissenting). The logic of the dissent, though, is far from infallible. First, Judge Jackson argued: "If the use of the trade mark 'Madonna,' as applied to the goods and articles mentioned, gave offense or scandal, it seems to me it would be noised about and probably these articles would have but scanty sale." *Id.* at 330. Tying societal opinions to sales is a fallacious argument. For example, many people believe pornography is offensive, yet its sales are brisk. The people who purchase pornography cannot reasonably be understood to speak for those who oppose pornography.

Second, the dissent argued the mark was registered on other items, including food. *Id.* Therefore, used in connection with food, the mark was just as scandalous as when used in connection with alcohol. The dissent stated: "The excessive use of good food results in evil. Surely a glutton gives scandal comparable to the scandal caused by one who drinks alcoholic beverages to excess." *Id.* The majority opinion had dismissed the relevance of these prior registrations: "Whether such registrations were properly issued is not before us, and their issuance constitutes no reason why the registration of appellant's mark here involved should be allowed if it is in fact scandalous." *Id.* at 328. Further, comparing a gourmand to an alcoholic, at best, lacks any rational explanation. Aside from the fact both glorify excess, not only are the characteristics and causes of each unique, but society views the two quite differently.

After the *Riverbank Canning* decision, the Trademark Board heard its share of cases dealing with religious trademarks. See *Ex parte Summit Brass and Bronze Works, Inc.*, 59 U.S.P.Q. (BNA) 22 (1943) (pictorial representation of the Agnus Dei, an image or representation of a lamb as an emblem of Christ, used in connection with tabernacle safes was held "offensive to most individuals of the Christian faith") (citing *In re Riverbank Canning*, 95 F.2d 327 (C.C.P.A. 1938)); *In re Sociedade Agricola E. Comercial Dos Vinhos Messias, S.A.R.L.*, 159 U.S.P.Q. (BNA) 275 (1968) (use of the word "Messias" in connection with wine and brandy was considered scandalous).

2. Cases Decided Under the Lanham Act

The first case interpreting section 1052(a) was decided in 1951. *Doughboy Industries, Inc. v. Reese Chemical Co.*,¹³⁹ involved the mark "Dough-boy" used in connection with prophylactics.¹⁴⁰ The appeal concerned the examiner's dismissal of an opposition to the mark.¹⁴¹ While the Trademark Board reversed the examiner's dismissal, it also made an *ex parte* review of the appropriateness of the subject matter of the mark.¹⁴²

The Trademark Board determined the mark was a name "given to the American soldier in the first World War."¹⁴³ Therefore, when used in connection with prophylactics, the mark violated section 1052(a).¹⁴⁴ In its opinion, the Trademark Board noted the prohibitions in the 1905 Act were narrower than those of the 1946 Act,¹⁴⁵ but stated that an interpretation of the new Act's provisions, including the newly added prohibitions, should be identical to one under the 1905 Act.¹⁴⁶ The Trademark Board stated that the analysis under the 1905 Act was established in *Riverbank Canning*.¹⁴⁷

A decision interpreting the meaning of "immoral" came in 1952. In *Ex parte Parfum L'Orle, Inc.*,¹⁴⁸ registration was refused by the examiner on the ground "Libido," used in connection with perfumes, "refers to sexual desire."¹⁴⁹ While the Patent Office Examiner in Chief, ("Examiner in Chief"), noted there were prior cases cited by the examiner and applicant which interpreted section 1052(a), he stated those cases dealt with different problems than those at issue.¹⁵⁰ The Examiner in Chief observed that the

139. 88 U.S.P.Q. (BNA) 227 (1951).

140. *Id.*

141. *Id.*

142. *Id.* at 227-28.

143. *Id.* at 228.

144. 88 U.S.P.Q. (BNA) at 228 (A mark which "[c]onsists of or comprises . . . matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute" is unregistrable.)

145. *Id.* (the 1905 Act "merely barred . . . immoral or scandalous matter").

146. *Id.*

147. *Id.*

148. 93 U.S.P.Q. (BNA) 481 (1952).

149. *Id.*

150. *Id.* The Examiner in Chief found *Ex parte* Martha Maid Mfg. Co., 37 U.S.P.Q. (BNA) 156 (1938), involved "the name of a famous personage"; *In re* Riverbank Canning Co., 95 F.2d 327 (C.C.P.A. 1938), and *Ex parte* Summit Brass & Bronze Works, 59 U.S.P.Q. (BNA) 22 (1943), involved "names and words of religious significance"; and *Doughboy Indus., Inc. v. The*

case "appears to be the first instance in which the question of refusal of a registration on the ground of the immoral or scandalous nature of the mark itself" had been decided.¹⁵¹ The Examiner in Chief determined the mark "has more general meanings than the particular one mentioned . . . and is probably not a word in every day use."¹⁵² Relying on an English decision,¹⁵³ she held section 1052(a) did not prohibit the mark from being registered.¹⁵⁴

On July 24, 1959, the Trademark Board issued two opinions interpreting section 1052(a). One of these cases¹⁵⁵ addressed the appeal of a refusal to register the word "Senussi" as the name of a cigarette in *In re Reemtsma Cigarettenfabriken*.¹⁵⁶ The "Senussi" trademark held a valid German registration issued in 1919.¹⁵⁷ Evidence presented before the Trademark Board showed the word "Senussi" referred to a sect of Muslims which forbade the use of cigarettes.¹⁵⁸

Because the trademark was the name of a religious order or sect whose followers were not allowed to use the product, the Trademark Board determined the "Senussi" trademark was an "affront to such persons and tend[ed] to disparage their beliefs."¹⁵⁹ The Trademark Board held that use of the sect's name on cigarettes would be "scandalous" and therefore

Reese Chem. Co., 88 U.S.P.Q. (BNA) 227 (1951), involved "the name of a group of persons the use of which on the particular goods involved was considered disparaging."

151. 93 U.S.P.Q. (BNA) 481 (1952).

152. *Id.* at 482.

153. *Id.* at 481 n.1. See *In re La Marquise Footwear's Application*, 64 R.P.D. & T.M. 27 (1946) ("[I]n American slang this strange word 'Oomph' has a significance, I think, of sex appeal, I do not think that, if all the circumstances of this case are taken into account, including the circle of people in which such words are likely to be current, it is just to reject on that ground an application for registration.").

154. The Examiner in Chief similarly stated: "I do not think that, when used in ordinary writing or speech, particularly among the class of persons who would be apt to use such a word, it would be considered shocking, or offensive, or obscene, and I do not believe that the Office can refuse registration in this particular case on the ground raised." *Id.* at 482.

155. The second opinion was *In re P.J. Valckenberg, GmbH*, 122 U.S.P.Q. (BNA) 334 (1959). In this decision, the Trademark Board dispelled any doubt that scandalous under the 1946 Act should not be interpreted differently than under the 1905 Act. The mark seeking registration was "MADONNA" which was used in connection with wine. *Id.* Relying on *In re Riverbank Canning*, the Trademark Board found the meaning of scandalous had not been changed in the Lanham Act and affirmed the refusal of registration. *Id.* at 334-35.

156. *In re Reemtsma Cigarettenfabriken*, 122 U.S.P.Q. (BNA) 339 (1959).

157. See German Trademark Reg. No. 235,739 (dated Sept. 27, 1919).

158. While there may be a "death" of case law in this area, the Board's reliance on secondary sources for definitions is widespread. Here, the Board relied on the *Encyclopaedia Britannica*. 122 U.S.P.Q. (BNA) at 339.

159. *Id.*

registration was properly refused.¹⁶⁰

Four years later, in *In re Waughtel*,¹⁶¹ the Trademark Board addressed a dispute concerning a trademark comprised of the Amish name above a cameo dressed in Amish fashion.¹⁶² The examiner had denied registration to the trademark finding it "scandalous" when used in connection with cigars.¹⁶³ In making this determination, the examiner relied on the standard announced in *In re Reemtsma Cigarettenfabriken*.¹⁶⁴

On appeal, the applicant argued it had presented affidavits which conclusively supported registration. The affidavits were of two Amish men who stated they were well versed in Amish ways, there were no Amish teachings against the use of cigars, numerous members of the Amish sect smoked cigars, and some even raised tobacco.¹⁶⁵ No contrary evidence was presented by the petitioner, and thus the Trademark Board concluded the registration was improperly denied.¹⁶⁶

In 1975,¹⁶⁷ the Trademark Board decided *In re Thomas Laboratories, Inc.*¹⁶⁸ This appeal involved a mark "for a corrective implement for increasing the size of the human penis."¹⁶⁹ The applicant described its mark as "a simple caricature of an unclothed man sitting and looking down

160. *Id.*

161. 138 U.S.P.Q. (BNA) 594 (1963).

162. *Id.* at 594-95.

163. *Id.*

164. *Id.* at 595 (quoting *In re Reemtsma Cigarettenfabriken*, 122 U.S.P.Q. (BNA) 339, 339 (1959)).

165. *Id.*

166. 138 U.S.P.Q. (BNA) at 595.

167. Between 1963 and 1975, the Trademark Board decided three cases involving section 1052(a). See *In re Runsdorf*, 171 U.S.P.Q. (BNA) 443, 443 (1971) ("BUBBY TRAP" used for brassieres held scandalous because it would be offensive to a "segment of the public sense of propriety . . ."). The Trademark Board relied on a dictionary definition which defined "bubby as Breast, now often considered vulgar."); *In re Hepperle*, 175 U.S.P.Q. (BNA) 512, 512 (1972) (The mark "ACAPULCO GOLD" used in connection with suntan lotion was refused registration on the grounds the mark was "a commonly understood term meaning marijuana." The Trademark Board held "to the average purchaser of suntan lotion in the normal marketing milieu . . . 'ACAPULCO GOLD' would suggest the resort city of Acapulco noted for its sunshine and other climatic attributes rather than marijuana."); *In re Madsen*, 180 U.S.P.Q. (BNA) 334, 335 (1973) (Application to register "WEEK-END SEX" as the title of a magazine would admittedly "bring to mind a magazine dealing with sexual relationships," but was not prohibited from registration based on the "moral values and conduct fashionable at the moment, rather than that of past decades.").

168. 189 U.S.P.Q. (BNA) 50 (1975).

169. *Id.* at 51. The goods already held a valid United States registration under the designation "LEGEND LENGTHENER." Registration No. 998,772, issued Nov. 19, 1974.

in a side view."¹⁷⁰ The Trademark Board, however, described the mark as "a cartoon-like representation of a melancholy, unclothed male figure ruefully contemplating an unseen portion of his genitalia."¹⁷¹ The examiner refused registration in light of "the entire pose of the figure" and because "the mark, in the marketplace, is not viewed in a vacuum, but is viewed in connection with the goods."¹⁷²

The Trademark Board noted both the goods used in connection with the mark and the "moral values and conduct which contemporary society has deemed to be appropriate and acceptable" should be considered to determine whether the mark was immoral or scandalous.¹⁷³ Relying on an obscenity decision, the Trademark Board also noted the difficulty of determining the "moral values and conduct [of] contemporary society."¹⁷⁴ In reversing the examiner's refusal, the Trademark Board relied on the above two criteria and a second obscenity case.¹⁷⁵ The Board held "the mark as applied to the specific goods [here] involved to be innocuous in character and, thereby, to involve no threat to present-day public morals or sense of propriety."¹⁷⁶

An athletic team whose trademark is challenged may attempt to rely on the Trademark Board's 1975 decision, *In re Condas S.A.*¹⁷⁷ *In re Condas S.A.* was the appeal of a refusal to register the trademark "JAP" because the examiner found the trademark "may disparage or falsely suggest a connection with the Japanese."¹⁷⁸ The Trademark Board

170. 189 U.S.P.Q. (BNA) at 51.

171. *Id.* at 52 (graphic material reproduced).

172. *Id.* at 51.

173. *Id.* at 52 (citing *In re Madsen*, 180 U.S.P.Q. (BNA) 334 (1973)). The Trademark Board noted nudity alone is not a ground to refuse registration, rather the "mien or posture" of the subject of the mark "must necessarily involve an element of immorality or lewdness." *Id.* at 51. In this instance, the Trademark Board broadened the definition of "immoral" to include "lewdness."

174. The Trademark Board stated: "Probably the fundamental reason why the word obscene is not susceptible of exact definition is that such intangible moral concepts as it purports to connote, vary in meaning from one period to another." *In re Thomas Lab.*, 189 U.S.P.Q. (BNA) 50, 52 (quoting *Parmelee v. United States*, 113 F.2d 729, 731 (D.C. Cir. 1940)).

175. 189 U.S.P.Q. (BNA) at 52 (citing *Roth v. United States*, 354 U.S. 476, 487 n.20 (1957)) ("A thing is obscene if, considered as a whole, its predominant appeal is to prurient interest, i.e., a shameful or morbid interest in nudity, sex or excretion, and if it goes substantially beyond customary limits of candor in description or representation of such matters.").

176. *Id.* This language may also be read as another expansion of the scope of 15 U.S.C. § 1052(a). Previously the Trademark Board talked of "offending" the public morals. Here, the Board is now talking about "threats" to these morals.

177. 188 U.S.P.Q. (BNA) 544 (1975).

178. *Id.*

reversed the refusal of registration,¹⁷⁹ basing its decision on *Japanese American Citizens League v. Takada*,¹⁸⁰ and the fact that a Japanese individual owned the corporation seeking the registration, claiming it would be absurd for him to disparage himself.¹⁸¹ Registration was allowed despite evidence the Japanese American Citizens League, public figures, and newspapers "[had] been highly critical" of the proposed trademark.¹⁸²

A challenger could distinguish *In re Condas S.A.* on two grounds. First, one could argue the Trademark Board relied on a proposition in *Takada* which is no longer good law. *Takada* held that "injury to feelings" did not constitute standing.¹⁸³ Since *Takada* was decided, the Trademark Board has determined that standing may be established by "injury to feelings."¹⁸⁴ Second, the Trademark Board was persuaded by appellants' argument that because *Takada* was Japanese, he would not use a trademark which disparaged Japanese people.¹⁸⁵ This argument is preposterous.¹⁸⁶ If accepted, it would mean an African American could trademark the word "nigger"¹⁸⁷ or an Hispanic American could trademark "spick." Because of the poor reasoning underlying *In re Condas S.A.*, a challenger could argue the case should carry no precedential value, otherwise, the policy underlying the disparaging mark prohibition would be negated and the statute's language would be superfluous.

The 1981 decision, *In re McGinley*,¹⁸⁸ was the first appeal of a Trademark Board decision involving section 1052(a) since *In re Riverbank Canning* and provided three levels of administrative and judicial review of the validity of the mark in question.¹⁸⁹ The mark "comprise[d] a photo-

179. *Id.*

180. 171 U.S.P.Q. (BNA) 109 (1971).

181. 188 U.S.P.Q. (BNA) at 544.

182. *Id.*

183. 171 U.S.P.Q. (BNA) at 109 ("[P]etitioners have merely assumed the role of champions of the community and are not the proper parties and have not shown any injury as a result of the use of ['JAP'].").

184. See *infra* notes 250-52 and accompanying text.

185. 188 U.S.P.Q. (BNA) at 544.

186. Professor Richard Delgado stated that "[m]ost people today know that certain words are offensive and only calculated to wound. No other use remains for such words as 'nigger,' 'wop,' 'spick,' or 'kike.'" Richard Delgado, *Words that Wound: A Tort Action for Racial Insults, Epithets, and Name-calling*, 17 HARV. C.R.-C.L. L. REV. 133, 145 (1982) (footnote omitted).

187. Cf. *Lee v. Superior Court*, 9 Cal. App. 4th 510, 11 Cal. Rptr. 2d 763 (1992) (upholding the denial of a request by an African American applicant to officially change his name to include a form of racial epithet "nigger").

188. 660 F.2d 481 (Fed. Cir. 1981).

189. *Id.* The registrability of the mark was reviewed by the examiner, the Trademark Board, and the Federal Circuit.

graph of a nude man and woman kissing and embracing in a manner appearing to expose the male genitalia"¹⁹⁰ and was used in connection with a "Newsletter Devoted to Social and Interpersonal Relationship Topics' and 'Social Club Services.'"¹⁹¹ The examiner denied registration to the mark¹⁹² and his decision was affirmed on appeal by the Trademark Board.¹⁹³

On appeal to the Federal Circuit, the appellant contested the denial on several grounds, all of which failed. First, appellant claimed section 1052(a) was "constitutionally 'void for vagueness.'"¹⁹⁴ The Federal Circuit dismissed this argument and stated "'scandalous' is sufficiently precise to satisfy due process requirements."¹⁹⁵

The appellant also contended the mark should be considered without reference to the goods or services with which it was associated.¹⁹⁶ The court noted, in determining the nature of the mark, "the mark must be considered in the context of the marketplace as applied to only the goods or services described in the application for registration."¹⁹⁷ The court added that "inquiry into the specific goods or services not shown in the application" is irrelevant.¹⁹⁸ Thus, the argument was rejected, but the scope of the examination was not broadened.

Next, appellant argued the mark at issue was not immoral or scandal-

190. *Id.* at 482.

191. *Id.* The court further stated that "the newsletter has to do with discussions of sexual topics such as bisexuality, homosexuality, masturbation, and fornication; that the services include sponsoring and arranging parties for 'swinging,' which appears to be a form of group sex." *Id.*

192. The examiner stated: "[A]ppellant's services involve various 'mini-affairs' between two unmarried people; sometimes two or more unmarried people. . . . 'Such activities are considered deviations from the sexual norm of husband and wife relations. Such activities are immoral and scandalous.'" 660 F.2d 481, 482 (Fed. Cir. 1981) (emphasis added by Court of Appeals for the Federal Circuit).

193. The Trademark Board's decision is found at 206 U.S.P.Q. (BNA) 753 (1979). The Trademark Board identified a broad class of people who the newsletter "could appeal to, be offered to, and be read [by]." *Id.* The Trademark Board concluded, "[First,] the overwhelming majority of the people who are potential readers of applicant's newsletter as described . . . would be affronted by the use of [the] mark [Second,] by any standard, including the most contemporaneous mores of what has been repeatedly described as a permissive, but not licentious, society, applicant's photograph, when used as a mark for any goods or services, is offensive to propriety and morality, outrages a sense of decency, and is shocking to the moral sense of members of the community, whose sensibilities are protected by the statute." *Id.* at 756.

194. *In re McGinley*, 660 F.2d at 483.

195. *Id.* at 485.

196. *Id.* at 483-84.

197. *Id.* at 485.

198. *Id.* (applauding the Trademark Board's approach in *In re Madsen*, 180 U.S.P.Q. at 335).

ous.¹⁹⁹ The court stated: "Whether or not the mark, including innuendo, is scandalous is to be ascertained from the standpoint of not necessarily a majority, but a substantial composite of the general public."²⁰⁰ While the dissent in *McGinley* questions the reasoning behind this standard,²⁰¹ the standard has been cited with approval by the Trademark Board.²⁰²

The first of two cases decided in 1988 was *In re Hershey*.²⁰³ Applicant appealed the examiner's refusal to register its mark "BIG PECKER BRAND" imprinted on T-shirts.²⁰⁴ The examiner refused registration, deeming the mark scandalous because "'pecker' is a slang or vulgar expression for 'penis'" and "'big' contribute[d] to the vulgarity of the mark."²⁰⁵

After restating the standards established in *In re McGinley*²⁰⁶ and its definition of scandalous, the Trademark Board reversed the refusal.²⁰⁷ First, the Trademark Board found the slang dictionary definitions the examiner relied on were "relevant," but "did not carry great weight in

199. *In re McGinley*, 660 F.2d at 483.

200. *Id.* at 485 (citing *In re Riverbank Canning Co.*, 95 F.2d at 329 n.7) (*Riverbank Canning* held the use of "MADONNA" on wine "would be shocking to the sense of propriety of nearly all who do not use wine as a beverage, and also to many who do so use it.") (emphasis added).

The express application of the standard in *McGinley* is implicitly applicable to the other prohibitions in 15 U.S.C. § 1052(a). Section 1052(a) should be read as a whole, not as a string of disjointed clauses. Therefore, the standard announced for one prohibition should be equally applicable to another.

201. *In re McGinley*, 660 F.2d at 487 (Rich, J., dissenting with whom Baldwin, J., joined).

202. See *In re Tinseltown, Inc.*, 212 U.S.P.Q. (BNA) 863, 865 (1981) ("Bullshit" used on "hand-bags, purses, belts, and wallets" gives "offense to the conscience [and] is shocking to the sense of decency or propriety of a substantial composite of the general public of the United States.").

203. 6 U.S.P.Q.2d (BNA) 1470 (1988).

204. *Id.* The mark comprised the name "BIG PECKER BRAND" and a picture of a bird with a large bill. *Id.* at 1472 (graphic material reproduced).

205. *Id.* (The examiner relied on slang, conventional dictionary definitions, and articles retrieved from the NEXIS research database.).

206. *Id.* The concurrence, though, does not use the "substantial composite" language found in *McGinley*; rather, Boardmember Cissel uses a "significant number of potential purchasers" and a "significant portion of the readers [of the *Hershey* opinion]" standard. In addition, Cissel misinterprets the evidentiary value of brisk sales. Cissel states:

Applicant apparently enjoys a reasonable business in selling its goods under this mark. If the double entendre were in fact objectionable, why is it that business has developed to the point where the mark is worth the effort and expense of protecting it with registration? If it were actually so offensive, people simply would not purchase products bearing it.

Id. at 1472. A mere fifty years after the *Riverbank Canning* decision, this argument seems even less plausible. See *supra* note 135-39 and accompanying text.

207. 6 U.S.P.Q.2d (BNA) at 1471.

determining whether a substantial number of the general public even recognize[d] the term 'pecker' as a slang word for penis."²⁰⁸ As to evidence retrieved from the NEXIS database,²⁰⁹ the Trademark Board stated, "this evidence, standing alone, is at best marginal to demonstrate that the mark is a vulgar, slang reference to male genitalia and would be recognized as such a reference by a substantial composite of the general public."²¹⁰ In addition, the applicant was able to establish that the word pecker has an "innocuous" primary meaning to the public, one of a bird's bill.²¹¹

In re In Over Our Heads Inc. is the most recent pronouncement on section 1052(a).²¹² At issue was a mark which was comprised of the word "MOONIES" and a design incorporating the word in connection with "dolls" which "drop their pants when a collapsible bulb is squeezed, thus exposing their buttocks."²¹³ The "OO" portion of the "MOONIES" design appeared "in buttocks caricature."²¹⁴ The mark was refused registration on the ground "it comprise[d] scandalous matter which disparage[d] The Unification Church founded by Reverend Sun Myung Moon."²¹⁵

The examiner contended the mark was "lacking in taste and is an affront to [an] organized religious sect."²¹⁶ The Trademark Board, however, noted Moonie(s) may refer either to a member of the Unification Church or may be used in the context of "exposing one's buttocks."²¹⁷ Accordingly, when used in connection with a doll, the Trademark Board

208. *Id.* (The Trademark Board found one dictionary was printed in 1947 and another dictionary indicated "pecker" was quickly becoming archaic.)

209. Six articles, from *Playboy*, *Medical Economics*, *Financial Times*, and *Newsweek*, which used pecker synonymously with penis.

210. 6 U.S.P.Q.2d (BNA) at 1471.

211. *Id.* at 1471-72. This was supported by the applicant's use of a bird with a large bill in its mark. *Id.* at 1472. See also *In re Leo Quan Inc.*, 200 U.S.P.Q. (BNA) 370, 371 (1978) ("We are unwilling to assign base motives to an applicant who propounds a plausible explanation for a trademark which is susceptible to a wholly innocent pronunciation."). A team with a Native American name would be precluded from prevailing on the argument that their name refers to something other than Native Americans; a simple visual examination of the team's trademark would demonstrate this.

212. 16 U.S.P.Q.2d (BNA) 1653 (1990). Currently the Trademark Board is reviewing a case involving a red, white, and blue condom. See *Application of Old Glory Condom*, appeal pending, No. 74-004,391.

213. 16 U.S.P.Q.2d (BNA) at 1653-54.

214. *Id.* at 1653 n.1 (citing Application Serial No. 755,278 filed Oct. 3, 1988).

215. *Id.* at 1653.

216. *Id.* at 1654.

217. 16 U.S.P.Q.2d (BNA) 1653, 1654.

believed the second definition would be applicable and not invoke a reference to members of the Unification Church.²¹⁸

In reversing the examiner's denial of registration, the Trademark Board noted "this is a close case," but reiterated the "guidelines for determining whether a mark is scandalous or disparaging are 'somewhat vague' and the 'determination [of whether] a mark is scandalous [or disparaging] is necessarily a highly subjective one.'" ²¹⁹ Therefore, at the initial registration stage only, the Trademark Board is "inclined to resolve doubts on the issue whether a mark is scandalous or disparaging in favor of [the] applicant and pass the mark for publication," knowing an opposition proceeding may be brought later.²²⁰

D. Trademark Cancellation

Cancellation of a federally registered trademark is expressly recognized in the Lanham Act.²²¹ Professor McCarthy refers to the cancellation process as the "second backstop" to the initial decision by the examiner.²²² Accordingly, if a trademark is improperly registered by the examiner and no opposition occurs, a cancellation proceeding provides the appropriate vehicle to rectify the examiner's error.

The Lanham Act states that an individual who "believes that he is or will be damaged by the registration [of a trademark]" may bring an action to cancel a trademark registered on the Principal or Supplemental Register.²²³ The individual must file a petition stating the reasons upon which

218. *Id.*

219. *Id.* (quoting *In re Hershey*, 6 U.S.P.Q.2d (BNA) 1470, 1471 (1988)). See also *Greyhound Corp. v. Both Worlds, Inc.* 6 U.S.P.Q. 2d (BNA) 1635 (1988) (mark comprised of defecating dog contained scandalous matter and disparaged Greyhound's running dog mark).

220. 16 U.S.P.Q.2d (BNA) 1653, 1654 (1990). This is a problematic policy because it shifts the burden of protecting the public interests away from the Patent and Trademark Office onto the general public. Professor McCarthy strongly stated:

A company can only oppose if it can afford the luxury of hiring someone to continually peruse the Official Gazette for published marks ready for registration on the principal register. The law should not impose on every company the expense of this searching. A small company may not be able to afford this searching and thus be unaware of impending registrations which it may wish to oppose.

1 MCCARTHY, *supra* note 8, § 20:20(E) at 1075.

221. 15 U.S.C. § 1064 (1988).

222. See 1 MCCARTHY, *supra* note 8, § 20:12 at 1048.

223. Title 15, § 1064 governs cancellation of trademarks registered on the Principal Register. Title 15, § 1092 governs cancellation of trademarks registered on the Supplemental Register. With the global expansion of American sports (e.g., the World League of American Football), the

she relies to cancel the trademark, and pay a prescribed fee.²²⁴ The content of the petition is governed by the Trademark Rules of Practice of the United States Patent and Trademark Office.²²⁵ A petition to cancel a trademark must be filed within five years of the date of registration;²²⁶ or within five years of the date of publication under 15 U.S.C. § 1062(c);²²⁷ or at any time if the source of the goods or services is being misrepresented;²²⁸ or, most importantly for this Article, at any time if the mark becomes generic, was obtained fraudulently, or is contrary to 15 U.S.C. § 1054 or 15 U.S.C. § 1052(a), (b), or (c).²²⁹

All cancellation proceedings are initially heard by the Trademark Board.²³⁰ Although the Lanham Act provides for cancellation "in whole or in part," the Trademark Board may not partially cancel a trademark's registration.²³¹ Trademark Board cancellation decisions may be appealed to either the Court of Appeals for the Federal Circuit, or to one of the United States District Courts.²³² These federal courts have the authority to cancel federal trademark registrations "in whole or in part" in actions "involving a registered trademark."²³³ The standard of proof in a cancel-

Supplemental Register may become important. However, this discussion focuses on the cancellation of marks registered on the Principal Register.

In addition, the Federal Trade Commission (FTC) may bring an action to cancel a registered mark on the grounds it violates 15 U.S.C. § 1064(c) or (e). Title 15, § 1064 provides that "the Federal Trade Commission may apply to cancel on the grounds specified in subsections (c) and (e) of this section any mark registered on the principal register established by this chapter, and the prescribed fee shall not be required." 15 U.S.C. § 1064. *See, e.g.,* Bart Schwartz Int'l Textiles, Ltd. v. FTC, 129 U.S.P.Q. (BNA) 258 (1961). The proviso of 15 U.S.C. § 1064 which grants the FTC the authority to represent the public interest would seem to empower the FTC to bring an action to cancel a mark which was improperly registered under 15 U.S.C. § 1052(a).

224. 15 U.S.C. § 1064.

225. PTO Rules of Practice, 37 C.F.R. § 2.112 (1992).

226. 15 U.S.C. § 1064(a).

227. 15 U.S.C. § 1064(2).

228. 15 U.S.C. § 1064(3).

229. 15 U.S.C. § 1064. Registration may also be canceled under two other conditions. First, the registration may be canceled if the mark has been registered and not published under 15 U.S.C. § 1062(c). 15 U.S.C. § 1064(4). Second, registration may be canceled at any time in the case of a certification mark. 15 U.S.C. § 1064(5).

230. 15 U.S.C. § 1067.

231. Title 15, § 1119 provides, in part, that "in any action involving a registered mark the court may determine the right to registration, order the cancellation of registration, in whole or in part . . ." *Selfway, Inc. v. Travelers Petroleum, Inc.*, 198 U.S.P.Q. (BNA) 271, *aff'd*, 579 F.2d 75 (C.C.P.A. 1978).

232. *See supra* notes 107-08.

233. 15 U.S.C. § 1119. *See Massa v. Jiffy Prod. Co.*, 240 F.2d 702 (9th Cir. 1956), *cert. denied*, 353 U.S. 947 (1957).

lation proceeding is a preponderance of the evidence.²³⁴ Last, in a cancellation proceeding, the applicant may assert any of several equitable defenses.²³⁵ Several cases²³⁶ and the leading commentators²³⁷ note the standing requirements of a cancellation proceeding are identical to those of an opposition proceeding. As the requirements for standing in opposition proceedings become more liberalized, so do those for cancellation proceedings.²³⁸ The standing requirement is designed to distinguish between mere intermeddlers and those with a personal interest in the outcome beyond that of the general public.²³⁹ The petitioner must show a "real interest" in the proceedings.²⁴⁰

A recent Trademark Board opinion, *Bromberg v. Carmel Self Service, Inc.*,²⁴¹ is relevant to the issue of standing in connection with canceling

234. See, e.g., *Massey Junior College, Inc. v. Fashion Inst. of Technology*, 492 F.2d 1339 (C.C.P.A. 1974). The burden used to be higher in a cancellation proceeding than in an opposition proceeding. See, e.g., *W.D. Byron & Sons, v. Stein Bros Mfg.*, 377 F.2d 1001 (C.C.P.A. 1967), *overruled by Massey Junior College, Inc. v. Fashion Inst. of Technology*, 492 F.2d 1339 (C.C.P.A. 1974).

235. 15 U.S.C. § 1069 (laches, estoppel, and acquiescence). A laches defense would be easily defeated because 15 U.S.C. § 1063 expressly authorizes a cancellation proceeding "at any time." See *National Serv. Indus. v. Turtle Wax, Inc.*, 154 U.S.P.Q. (BNA) 68 (1966). The estoppel doctrine would not be applicable. The acquiescence defense also would fail for the same reason as the laches defense. In addition, in the case of Native American team names, any equities weigh heavily in favor of Native Americans because they would be seeking to redress historical discrimination.

236. See, e.g., *Golden Gate Salami Co. v. Gulf States Paper Corp.*, 332 F.2d 184 (C.C.P.A. 1964); *In re Application of Meyers*, 201 F.2d 379 (C.C.P.A. 1953).

237. Professor McCarthy states that "standing to cancel is placed on the same basis and criteria as standing to oppose." 1 MCCARTHY, *supra* note 8, § 20:13 at 1051; accord 1 J. GILSON, *TRADEMARK PROTECTION & PRACTICE* § 3.05[3][a], at 3-158 (1992).

238. See 1 MCCARTHY, *supra* note 8, § 20:13 at 1051.

239. See *Lipton Indus. v. Ralston Purina Co.*, 670 F.2d 1024 (C.C.P.A. 1982). See also *International Order of Job's Daughter v. Lindeburg & Co.*, 727 F.2d 1087 (Fed. Cir. 1984); *Selva & Sons, Inc. v. Nina Footwear, Inc.*, 705 F.2d 1316 (Fed. Cir. 1983); *Golden Gate Salami Co. v. Gulf States Paper Corp.*, 332 F.2d 184 (C.C.P.A. 1964).

240. See 727 F.2d at 1092.

241. 198 U.S.P.Q. (BNA) 176 (1978). There is a student piece on *Bromberg*. Kerry L. Kester, Note, *Standing to Oppose Scandalous or Immoral Trademarks*, 58 NEB. L. REV. 249 (1979). The Note, though, is poorly reasoned. While the author proposed to narrow the class of petitioners who meet the standing requirement, this conclusion is in direct contradiction to the leading cases and commentators in this area, as well as this author's opinion. One of the most recent pronouncements of the standing requirement by the Trademark Board demonstrates the Trademark Board is broadening, not narrowing as Kester proposed, the standing requirement. See *Estate of Biro v. Bic Corp.*, 18 U.S.P.Q.2d (BNA) 1382, 1385 (1991) ("[T]here is a low threshold for a plaintiff to go from being a mere intermeddler to one with an interest in the proceeding."). Further, on the facts of *Bromberg*, the Trademark Board's holding is well reasoned. Kester's

a Native American team trademark. In *Bromberg*, registration of the mark "ONLY A BREAST IN THE MOUTH IS BETTER THAN A LEG IN THE HAND" was opposed by two women who asserted the mark was prohibited registration by section 1052(a).²⁴² Registration of the mark was sought in connection with restaurant services.²⁴³

In connection with their opposition petition, the two women filed several affidavits from women's organizations which supported the petition's "claim as to the nature of the mark."²⁴⁴ Carmel Self Service moved to dismiss the opposers' petition on the ground that the two women did not have standing to bring the action.²⁴⁵ The trademark owner argued the women were not involved in "any type of commercial activity, including the restaurant business"; the affidavits were irrelevant and merely were an attempt to establish standing; and the pleadings failed to "show how opposers would be damaged by the registration" of the mark.²⁴⁶ The petitioner urged, *inter alia*, that the applicant failed to distinguish between the standing requirements under section 1052(d), which require commercial activity, and the standing requirements under section 1052(a), which do not.²⁴⁷

Initially, the Trademark Board made a critical distinction concerning who may bring an opposition action. The Trademark Board noted 15 U.S.C. § 1063 reads "*any person*" may file an opposition.²⁴⁸ This language, the Trademark Board went on to state, expressly forecloses the

inference that the "disgust" of the women in *Bromberg* fails to meet the standing requirement trivializes the damage sexism causes.

242. 198 U.S.P.Q. (BNA) at 177. The two women asserted the mark

comprises immoral and scandalous matter, is disparaging to all people of a specific class, and in particular, women, in that it has false connotations and brings individuals, especially women, into contempt and disrepute; that the obvious double entendre of the mark indicates that it is lewd, lascivious, indecent, obscene, worthless, depraved, chauvinistic, degrading, and has no commercial value, and that the granting of a registration therefor unnecessarily lowers the standards of the United States Government, in particular, the United States Patent Office [sic].

Id. The applicant's mark was successfully opposed on other grounds. See *Golden Skillet Corp. v. Carmel Self Serv., Inc.*, 201 U.S.P.Q. (BNA) 790 (1979).

243. 198 U.S.P.Q. (BNA) at 177.

244. *Id.* Affidavits expressing support were made by Chicagoland Women's Federal Credit Union, the executive and managing editors of *She Publications, Ltd.*, and *Women in Management*. See Notice of Opposition at 2, *Bromberg v. Carmel Self Serv., Inc.*, 198 U.S.P.Q. (BNA) 176 (1978) (Opp. No. 59,979).

245. 198 U.S.P.Q. (BNA) at 177-78.

246. *Id.*

247. *Id.* at 178.

248. 15 U.S.C. § 1063 (emphasis added).

possibility of a class action suit.²⁴⁹ Therefore, until an individual “pays a filing fee and [is] identified as an opposer,” she is not entitled to standing.²⁵⁰

The Trademark Board then concluded section 1052(a) does not require “commercial damage” to satisfy the standing requirement:

[N]ormally an opposition to the registration of a trademark is filed by a commercial enterprise seeking to preserve and protect an economic interest. The Trademark Act, however, makes it clear that one need not be a commercial enterprise, nor is it necessary that a commercial interest be at stake for one to object to a trademark registration.

Thus the fact that opposers have not based their claim of damage on their involvement in a commercial activity is not fatal to the question of standing. Rather, as indicated by the Court of Customs and Patent Appeals . . . “a party has standing to oppose within the meaning of Section 13 if that party can demonstrate a real interest in the proceeding.”²⁵¹

In finding the two women did have standing, the Trademark Board held, “the instant opposers who are persons within the meaning of section 13²⁵² and members of a group who may believe the mark to be scandalous have the requisite standing to be heard on the question before us.”²⁵³

E. The Effect of Cancellation and the Principles of Common Law Trademark

Federal legislation which permits canceling the registration of an immoral, scandalous, or disparaging trademark would appear to raise serious First Amendment questions.²⁵⁴ The owner of a challenged trademark might accuse opponents of blatant censorship. However, this argument would fail to distinguish between a person’s First Amendment

249. 198 U.S.P.Q. (BNA) at 178.

250. *Id.*

251. *Id.* (citation omitted) (quoting *Federated Foods, Inc. v. Fort Howard Paper Co.*, 192 U.S.P.Q. (BNA) 24 (1976)). See also *Universal Oil Prod. Co. v. Rexall Drug and Chem. Co.*, 174 U.S.P.Q. (BNA) 458 (1972).

252. Section 13 is synonymous with 15 U.S.C. § 1063.

253. 198 U.S.P.Q. (BNA) at 179.

254. The First Amendment states: “Congress shall make no law . . . abridging the freedom of speech” U.S. CONST. amend. I.

rights to use the mark²⁵⁵ and the rights inherent in trademark registration.²⁵⁶ Cancellation of a trademark's federal registration does not deprive the trademark holder of the use of the trademark, it merely deprives the holder of the benefits of federal registration.²⁵⁷ Therefore, an athletic team with a Native American name could continue to use its name but would retain no rights to enforce the name under federal law.²⁵⁸

Although a trademark may not meet the requirements of federal protection, through sustained use a trademark may achieve common law protection.²⁵⁹ Common law trademark rights can arise prior to federal registration,²⁶⁰ and can exist after federal registration has expired²⁶¹ or after federal registration has been canceled.²⁶² A team whose trademark has been canceled because the mark was found to violate section 1052(a) may try to rely on common law trademark to protect its mark. Despite the loss of federal protection, a common law trademark holder would not be deprived of any protections which would be available under a common law theory.²⁶³ These protections include the right to enforce the validity of the

255. In two instances involving the "Sambo's" trademark, efforts to prohibit use of the mark violated the owner's First Amendment rights. See *Sambo's Restaurants, Inc. v. City of Ann Arbor*, 663 F.2d 686, 695 (6th Cir. 1981) (held "Sambo's" is protected commercial free speech); *Sambo's of Ohio v. City Council of Toledo*, 466 F. Supp. 177, 180 (N.D. Ohio 1979) (held action by City Council violated Sambo's First Amendment rights and "the exclusive remedy for preventing the use of such trade names is under the provisions of [15 U.S.C.] § 1064, which provides a method for canceling a registration which has been made 'contrary to law'").

256. See *supra* notes 113-21 and accompanying text.

257. See *Volkswagenwerk Aktiengesellschaft v. Wheeler*, 814 F.2d 812 (1st Cir. 1987); *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981); *Hammernill Paper Co. v. Gulf States Paper Corp.*, 337 F.2d 662 (C.C.P.A. 1964).

258. The economic reality is that lack of protection is synonymous with lack of use due to a loss of revenue. Indeed, cancellation would appear a motivational factor for teams to rapidly market their new marks to dry up the black market which may emerge for their the old names.

259. See *United States v. Steffens*, 100 U.S. 82, 92 (1879); *La Societe Anonyme des Parfums Le Galion v. Jean Patou, Inc.*, 495 F.2d 1265, 1271 (2d Cir. 1974).

260. See *Maternally Yours, Inc. v. Your Maternity Shop, Inc.*, 234 F.2d 538, 541 (2d Cir. 1956).

261. See *United States Jaycees v. San Francisco Junior Chamber of Commerce*, 354 F. Supp. 61 (N.D. Cal. 1972); *Phoenix Mfg. Co. v. Plymouth Mfg. Co.*, 286 F. Supp. 324, 328 (D. Mass. 1968).

262. See *Armstrong Paint and Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315 (1938); *National Trailways Bus Sys. v. Trailway Van Lines, Inc.*, 269 F. Supp. 352, 357 (E.D.N.Y. 1965).

263. See RESTATEMENT (FIRST) OF TORTS § 715 cmt. f (1938) ("[R]egistration is not required and trade-marks may be protected though they are not registered.").

trademark through an action for infringement.²⁶⁴

However, common law trademark does not protect matter which is prohibited by section 1052(a). While there are no cases on point, the *American Law Institute Restatement (First) of Torts* ("Restatement") is a useful tool in determining what the common law will protect. The *Restatement* contains sections applicable to trademarks²⁶⁵ and provides the common law definition of trademark:

A trademark is any mark, word, letter, number, design, picture or combination thereof in any form of arrangement, which
 (a) is adopted and used by a person to denominate goods which he markets, and

....

(d) the use of which for the purpose stated in Clause (a) is prohibited neither by *legislative enactment nor by an otherwise defined public policy*.²⁶⁶

The *Restatement* provides, "A designation cannot be a trade-mark or trade name if it is scandalous or indecent, or otherwise violates a defined public policy."²⁶⁷ The comments to this *Restatement* section provide that matter which "violates accepted standards of decency or a defined public policy" is not a trademark or tradename.²⁶⁸

Perhaps there is nothing more indecent than racism and certainly, under any administration, it is a defined public policy to redress discrimination. Prior federal registration cannot be twisted into a pronouncement of an unbridled right of common law protection. Common law protection will only exist if the matter in question meets the common law requirements necessary to establish a trademark.

264. See, e.g., *Sterling Drug Inc. v. Lincoln Lab., Inc.*, 322 F.2d 968 (7th Cir. 1963). Recall that this protection is important to teams because it enables them to prevent unlicensed use of their marks.

265. *RESTATEMENT (FIRST) OF TORTS* §§ 715-40, 744-56 (1938).

266. *Id.* § 715 (emphasis added). Comment c discusses three categories of inappropriate trade-mark subject matter:

The third category of designations which are inappropriate for use as trademarks comprises those which may not be so used because of the prohibitions of a legislative enactment or of an otherwise defined public policy. Thus legislation prohibits the use as a trade-mark of the Red Cross in a white background, or of the American Flag.

267. *Id.* § 726.

268. *Id.* § 726 cmt. a. For example, a picture of a man shooting at the back of a police officer with the words "Kill the Tyrants" imprinted above the picture would not be recognized as a trademark or tradename under this section. *Id.*

VI. APPLICATION OF 15 U.S.C. SECTIONS 1064 AND 1052(A) TO NATIVE AMERICAN TEAM NAMES

A. *Standing to Cancel Under 15 U.S.C. Section 1064*

One issue the Trademark Board or a court will have to determine is whether a Native American has standing to challenge the mark in question. Applying the requirements established in *Bromberg*, it appears a Native American would have standing under section 1064 to cancel a Native American team trademark.²⁶⁹ Because Native American team names are an affront to a Native American's dignity, a Native American would not be a "mere intermeddler,"²⁷⁰ but would be able to establish a "real interest"²⁷¹ in the proceedings. Just as two women had standing to oppose a sexist mark,²⁷² a Native American would have standing to cancel a racist mark. The mark's de-humanizing effect, aside from any "economic damage," is sufficient to grant standing to a Native American petitioner. Further, applying the guidelines established in the *Restatement*, once federal registration is canceled, a Native American team name is also not entitled to common law protection.²⁷³

269. In *Bromberg*, the Trademark Board provided important pearls of wisdom to heed in choosing the "perfect plaintiff." First, a "corporation or other commercial enterprise" is less likely to have the "emotional characteristics requisite to being or feeling offended by that which may be considered scandalous." *Bromberg*, 198 U.S.P.Q. (BNA) at 178-79. This appears applicable to any argument raising the other prohibitions of 15 U.S.C. § 1052(a). Second, the Trademark Board notes "one or several" members of a "certain segment of the public," who can demonstrate a real interest, may obtain standing. *Id.* (emphasis added). While safety is in numbers, litigation costs may limit the number of cancellation proceedings brought. Third, "an examiner cannot be expected to be aware of the significance of all marks before him as to all individuals, groups, organizations, orders, etc." *Id.* Therefore, one needs to bring the offensive nature of a mark to the examiner's attention before anything can be done about it. Last, to overcome the standing requirement, a petitioner need not prove damages. *Id.* However, once the petitioner demonstrated standing, she should be prepared to present a compelling case.

A final thought, when choosing the "perfect plaintiff" one should pay close attention to which court will have appellate jurisdiction. The plaintiff need not live in the same city as the team whose trademark is in question because a sports team's name is prominent outside the city where the team plays. This gives a resourceful attorney the option of choosing a plaintiff who lives in a jurisdiction with precedents which might favor a Native American plaintiff.

270. See *supra* note 239 and accompanying text.

271. See *supra* note 240 and accompanying text.

272. See *supra* note 253 and accompanying text.

273. If a Native American trademark is canceled because it is prohibited by 15 U.S.C. § 1052(a), an additional theory to research is whether a Trademark Board or court decision would have a collateral estoppel effect in a suit for defamation against the owner of the trademark. This theory may be a way for Native Americans to not only foreclose future use of the trademark, but

B. Prohibited Subject Matter Under 15 U.S.C. Section 1052(a)

Once standing has been established, the focus of the Trademark Board or a court will be whether the trademark in question violates one or more of the prohibitions of the Lanham Act. Applying Trademark Board and judicial interpretations of section 1052(a), Native American team names are prohibited from retaining federal registration because they: (1) are immoral; (2) are scandalous; (3) disparage Native Americans; (4) disparage Native American beliefs; (5) bring Native Americans into contempt; and (6) bring Native Americans into disrepute.²⁷⁴

1. Substantial Composite of the General Public

In its examination of the challenged trademark, the Trademark Board or a court will determine whether the *McGinley* court's "substantial composite of the general public"²⁷⁵ standard has been satisfied. Application of this standard is more pragmatic than a literal interpretation would suggest. Accordingly, a "substantial composite" of Native Americans would appear to satisfy the standard.

When the *McGinley* court stated the "substantial composite" standard, it relied on an earlier standard announced in *Riverbank Canning*. Cases subsequent to *Riverbank Canning*, yet prior to *McGinley*, should be understood as applying the same standard which *McGinley* restates. For example, in *Reemtsma Cigarettenfabriken* the Trademark Board denied registration to a mark because it was disparaging and scandalous to an obscure sect of Muslims.²⁷⁶ The *Encyclopaedia Britannica*, relied on by the Trademark Board in that case, states the sect had only a few members at the time the mark was denied.²⁷⁷ Because the Trademark Board was

also recover monetary damages for approximately a century of injury. It appears, even under what the leading treatise on tort law refers to as "too narrow" a definition of defamation, Native American team names are defamatory. See W. PAGE KEETON ET AL., PROSSER AND KEETON ON THE LAW OF TORTS § 111, at 773 n.17 (5th ed. 1984) ("words which tend to expose one to public hatred, shame, obloquy, contumely, odium, contempt, ridicule, aversion, ostracism, degradation or disgrace"). See also RESTATEMENT (SECOND) OF TORTS § 559 (1977). Cf. Delgado, *supra* note 186, at 133 (proposing a new tort action).

274. 15 U.S.C. § 1052(a). Most of the arguments in this section of the Article are applicable to more than one prohibition. Once again, the most effective combination of arguments in a given case is for the individual attorney to determine.

275. See *supra* note 200 and accompanying text.

276. See *supra* notes 159-60 and accompanying text.

277. Cf. 20 ENCYCLOPAEDIA BRITANNICA 333 (1952).

applying the same standard the *McGinley* court applied, it appears that even members of a small group could satisfy the "substantial composite" standard.

The owner of a challenged trademark might contend that the "substantial composite" standard represents a combination of *two* distinct standards found in *Riverbank Canning*. Arguably, if there were two distinct standards, the *Riverbank Canning* decision would require the Trademark Board or a court to determine whether the challenged trademark was, for example: (1) disparaging to "nearly all" Native Americans *and*; (2) disparaging to "many" Americans.²⁷⁸

This interpretation not only would be erroneous, it also would completely disregard the *Reemtsma Cigarettenfabriken*, *Societe Agricola*, and *Runsdorf* decisions. The *Bromberg* court expressly recognized the implications of these past decisions, "[These cases and *Riverbank Canning* represent decisions where] marks have been refused registration by the examiner on the ground that they were offensive to a *certain segment of the public*."²⁷⁹ It is Native Americans alone, not American society as a whole, who should comprise the relevant "public" and determine whether Native American team names are offensive. If this were not true, our society would revisit an era where racial inequality flourished.²⁸⁰

2. Immoral

Native American team names are immoral because they deprive Native Americans of their opportunity for self-determination. While Native Americans have not asked to be defined, athletic teams have done just that by labelling and depicting Native Americans in a virulent manner. Because race is an immutable characteristic, Native Americans are constrained by these stereotypical portrayals. Until these team names are abolished, Native Americans will continue to be associated with images and representations which malign them.

278. *In re Riverbank Canning*, 95 F.2d 327, 329 (C.C.P.A. 1938).

279. 198 U.S.P.Q. (BNA) at 179 (emphasis added).

280. *Cf. Plessy v. Ferguson*, 163 U.S. 537, 551 (1896) ("We consider the underlying fallacy of the plaintiff's argument to consist in the assumption that the enforced separation of the two races stamps the colored race with a badge of inferiority. *If this be so, it is not by reason of anything found in the act, but solely because the colored race chooses to put that construction upon it.*") (emphasis added).

3. Scandalous

Native American team names also satisfy the definition of scandalous established in *Riverbank Canning*.²⁸¹ The *Concise Oxford Dictionary* defines "redskin" as "*colloq. offens.* an American Indian."²⁸² In addition, "Indian" encompasses references to Native Americans as heathens or savages.²⁸³ Native American team names are disgraceful, are offensive to one's conscience, and shock an enlightened society's sense of truth, decency, and propriety.

4. Disparagement, Contempt, and Disrepute

Native American team names are also disparaging and bring Native Americans into contempt and disrepute. The *Random House Dictionary* defines "redskin" as "*slang (often disparaging and offensive)* A Native American Indian."²⁸⁴ Professor Coakley of the Center for the Study of Sport and Leisure at the University of Colorado, Colorado Springs adds:

To many Native Americans, redskin is as derogatory as 'nigger' is for black Americans. It is symbolic of such racism that the capitol city of the government that once put bounties on the lives of native peoples has a football team named the Redskins. It symbolizes a continuing lack of understanding of the complex and diverse cultures and the heritage of native peoples and is offensive to anyone aware of the history of native peoples in North America.²⁸⁵

Regardless of the setting in which a Native American team name

281. See *supra* note 134 and accompanying text.

282. THE CONCISE OXFORD DICTIONARY OF CURRENT ENGLISH 1006 (8th ed. 1990). "Redskin" is also found in dictionaries devoted to slang. See, e.g., RICHARD A. SPEARS, SLANG & EUPHEMISM: A DICTIONARY OF OATHS, CURSES, INSULTS, SEXUAL SLANG AND METAPHOR, RACIAL SLURS, DRUG TALK, HOMOSEXUAL LINGO AND RELATED MATTERS 327 (1981) ("A North American Indian. Sometimes derogatory. [colloquial since the late 1600's] Synonyms: BOW AND ARROW, BREED, BUCK, INJUN, UNCLE TOMMYHAWK, VANISHING AMERICAN").

283. A "heathen" is "one who adheres to the religion of a tribe or nation that does not acknowledge the God of Judaism, Christianity, or Islam." AMERICAN HERITAGE DICTIONARY OF THE ENGLISH LANGUAGE 600 (1979). See generally ROY HARVEY PEARCE, SAVAGISM AND CIVILIZATION: A STUDY OF THE INDIAN AND THE AMERICAN MIND (1988).

284. RANDOM HOUSE DICTIONARY OF THE ENGLISH LANGUAGE 1618 (2d ed. unabridged 1987).

285. See JAY J. COAKLEY, SPORT IN SOCIETY: ISSUES AND CONTROVERSIES 206-07 (4th ed. 1990).

appears or whether the name is directed at an individual or a group, it is disparaging and promotes racial insensitivity. Because of the popularity of sports in our society and the large number of Native American team names in use, Native American team names appear frequently in both public and private settings. As a result, Americans are constantly being exposed to racist portrayals of Native Americans.²⁸⁶ This exposure has a pervasive effect on societal attitudes concerning Native Americans.

When considering the offensive nature of Native American team names, one must consider the historically appalling treatment of Native Americans in the United States.²⁸⁷ The dramatic difference in the treatment of Native Americans when Native American team names were first adopted and today illustrates another reason to change these names.²⁸⁸ Too often, depictions associate Native Americans with images formulated during frontier settlement. Two authors explain, "The use of the Indian symbol as a team mascot is offensive to American Indians because only the qualities of the warrior role are emphasized. The stereotypical image projected by the mascot serves to perpetuate a negative aspect of the American Indian"²⁸⁹

Stereotypical representations have a pernicious effect and erode the foundations of equality. This is due, in large part, to their effect of undermining Native American self-esteem. The devastating effect is apparent. Citing the low level of Native American participation in sports, Professor Coakley asserts:

For the young [N]ative American attending schools or watching games between schools with team names like Indians,

286. Disturbingly, as American sports becomes more widely disseminated throughout the world, we spread these racist portrayals and attitudes to other countries and peoples.

287. See generally VINE DELORIA AND CLIFFORD M. LYTLE, *AMERICAN INDIANS, AMERICAN JUSTICE* (1990). In addition, the two leading commentaries on Native American law are FELIX S. COHEN, *HANDBOOK OF FEDERAL INDIAN LAW* (1986) and CHARLES F. WILKINSON, *AMERICAN INDIANS, TIME, AND THE LAW* (1987).

288. The Michigan Commission noted, "Unfortunately, there are many images of Native American people which are based on Indian people of several hundred years ago or upon popular misunderstanding of diverse Indian culture; language and the history of Indian people. As a society, we accept images of Indian people which are of a single warlike group frozen in time." MICHIGAN COMMISSION, *supra* note 13, at 1. See, e.g., JOHN CLARK RIDPATH, *A POPULAR HISTORY OF THE UNITED STATES OF AMERICA FROM ABORIGINAL TIMES TO THE PRESENT DAY* 41-50 (1882) (One of the "propensities of the Red men was the passion for war. . . . Fighting was limited to surprise, the ambushade, the massacre; and military strategy consisted of cunning and treachery."). *Id* at 44-45.

289. John R. Fuller & Elisabeth Anne Manning, *Violence and Sexism in College Mascots and Symbols: A Typology*, 15 *FREE INQUIRY IN CREATIVE SOCIETY* 61 (1987).

Redskins, and Savages, and with mascots who run around and mimic white stereotypes of 'Indian' behavior, playing sports involves giving up much more than half their soul.²⁹⁰ When they see a distorted or historically inappropriate caricature of a [N]ative American on a gym wall of a school that doesn't even try to increase student awareness of the cultures of local native peoples, it means swallowing cultural pride, repressing anger against insensitive, historically ignorant whites, and giving up hope of being understood in terms of their own feelings and cultural heritage.²⁹¹

Further, these names are viewed by our children who are formulating not only their values, but also their prejudices.²⁹² By discriminating in athletics, teams are contributing to societal discrimination against Native Americans as well as fostering latent racism in future generations.

5. Disparagement of Religious Beliefs

Native American team names disparage Native American beliefs. The Michigan Commission concluded:

The most commonly used symbol of Indians which is found in logos and mascot dress is the eagle feather. In Michigan Indian culture, the eagle feather [is] sacred and a great honor to receive. In the same way, the Sioux headdress is only worn in ceremonies by persons who have earned the honor of doing so.

Current use of the feather trivializes and degrades the significance placed on the feather by Indian people.²⁹³

Tim Giago elaborated in an editorial:

The sham rituals, such as the wearing of feathers, smoking of so-called peace pipes, beating of tom-toms, fake dances, horrendous attempts at singing Indian songs, so-called war whoops, and the painted faces, address more than the issue of

290. Coakley earlier quoted runner Billy Mills, an Olympic gold medal winner, who stated in regard to his training: "[T]o become part of white society you give up half your soul."

291. See COAKLEY, *supra* note 285, at 205. Cf. *Brown v. Board of Educ.*, 347 U.S. 483, 494 (1954) ("To separate [Negro children] from others of similar age and qualifications solely because of their race generates a feeling of inferiority as to their status in the community that may affect their hearts and minds in a way unlikely ever to be undone.").

292. See ARLENE B. HIRSCHENFELDER, *AMERICAN INDIAN STEREOTYPES IN THE WORLD OF CHILDREN: A READER AND BIBLIOGRAPHY* (1982); Jesus Garcia, *Native Americans in U.S. History Textbooks: From Bloody Savages to Heroic Chiefs*, 17 J. AM. INDIAN EDUC. 15 (1978).

293. MICHIGAN COMMISSION, *supra* note 13, at 26-27.

racism. They are direct attacks upon the spirituality (religion) of the Indian people.²⁹⁴

Just as the Trademark Board held the use of the Senussi name in connection with cigarettes disparaged Senussi beliefs,²⁹⁵ they should also find Native American team names disparage Native American beliefs.

Because discriminatory practices are clandestine, they are often difficult to observe and eliminate. Once identified, though, these practices can be confronted and changed. In the case of Native American team names, their discriminatory nature is apparent and unmistakable. Teams are not trying to conceal their discriminatory practices, rather they are openly exploiting their disregard of Native Americans. There is no excuse for overlooking discrimination which is so conspicuous. By allowing the continued registration of Native American team names, the federal government is enabling a trademark owner to profit at the detrimental expense of its citizens.

VII. CONCLUSION

Regrettably, Native American team names were granted federal trademark protection. Athletic team names should not comprise images and names which pertain to race. Race-neutral names are easily fancied and are afforded federal trademark protection.

The present images are contrary to progressive social norms and practices and their use should be voluntarily discontinued. This is not a plea to conform to notions of "political correctness," but rather a request to respond to societal maturation. A team's refusal to change its Native American name is a somber reminder that blatant racism and prejudice still exist.

This Article confidently places the ball in the Native Americans' court. Albeit a step in the appropriate direction, the current efforts to eliminate Native American team names are inadequate to properly address this problem. Today, Native Americans need to focus their resentment and obtain a judicial resolution of this issue under the Lanham Act.²⁹⁶ By

294. Tim Giago, *Mascots, Spirituality and Insensitivity*, LAKOTA TIMES, Oct. 23, 1991, at B7.

295. See *supra* note 158 and accompanying text.

296. Since this Article was written, Native Americans have done just this, filing a cancellation proceeding with the Trademark Board. See Leonard Shapiro, *Native American Coalition Files Action on Redskins*, WASH. POST, Sept. 11, 1992, at C1. The case was taken on a pro bono arrangement by the Minneapolis based law firm of Dorsey & Whitney. The lead attorney on the case is Stephen Baird.

depriving team owners of the financial return a team's trademarks provide, Native Americans will compel owners to acknowledge the reality of their racist team names.