

# Sports Litigation Alert

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## The Team's Name, the Government's Speech: "Redskins" Trademark Registrations Remain Cancelled

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On August 4, 2015, the Washington Redskins filed notice of their intent to appeal a district court decision from earlier this summer upholding the Trademark Trial and Appeal Board's (TTAB) decision to revoke the federal trademark registrations for the team's name. While briefing on the appeal is set to conclude by the end of this year, the team's President Bruce Allen recently announced the franchise would not cave to outside pressures to change the name including the Federal Government's indication that it would not consider leasing land to the team for a proposed new stadium in DC until the name was dropped. It remains to be seen whether the Redskins will succeed in this upcoming season on or off the field.

In the July decision, Judge Gerald Bruce Lee of the Eastern District of Virginia, ruled against the Redskins in deciding an interesting question: whether the First Amendment protects the team's right to federally register their name as a trademark. *Pro-Football, Inc. v. Blackhorse*, No. 14-CV-1043, 2015 WL 4096277 (E.D.Va. July 8, 2015). The case began in 2006 when Amanda Blackhorse, along with four others, petitioned the Patent and Trademark Office to cancel the team's registrations for six trademarks containing the term "redskins." The petitioners argued that the registrations violated Section 2(a) of the Lanham Act, which denies registration to any mark that "[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." 15 U.S.C. § 1052(a). In June 2014, the TTAB ruled that all six marks consisted of material that "may disparage" Native Americans and ordered that the registrations be cancelled. Shortly thereafter, Pro-Football, Inc. (the company that owns the "redskins" trademarks) filed a suit for declaratory relief in the Eastern District of Virginia seeking a de novo review of the TTAB's decision and arguing that, among other things, Section 2(a) of the Lanham Act violated the First and Fifth Amendments of the United

States Constitution. After both sides filed cross-motions for summary judgment, the district court issued its opinion at the beginning of July 2015.

Judge Lee began by clearing up a crucial semantic point: the case concerned trademark *registration* not trademark *use*. That is, federal law does not create trademarks — it provides merely a uniform system for registering them on a nation-wide level and the benefits that registration confers. However, nothing the TTAB had done prevented the team or Pro-Football from continuing to use the "redskins" marks in commerce.

The district court then looked to the substantive arguments, beginning with Pro-Football's challenge that Section 2(a) violated the First Amendment. Relying predominantly on Federal Circuit precedent, Judge Lee held that the cancellation of a trademark registration does not suppress speech or limit public discourse about important social issues. Since Section 2(a) does not prevent a trademark owner from using its mark, the district court reasoned, the law does not "prohibit[] or penalize[] any speech." Relatedly, the court noted that an owner's right to continue using the trademark despite cancellation of its federal registration under Section 2(a) ensures that any debate over the mark's propriety can continue.

Judge Lee then considered whether federal trademark registrations constitute government speech, thus making First Amendment scrutiny of Section 2(a) inappropriate. In doing so, the district court applied the Fourth Circuit's "mixed/hybrid speech test" as well as the reasoning in *Walker v. Texas Division, Sons of Confederate Veterans*,

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*Inc.*, 135 S. Ct. 2239 (2015), which was decided earlier this summer by Supreme Court of the United States in a case where the Court upheld Texas’s right to deny the application for the issuance of a “vanity” license plate depicting the image of the confederate flag on the basis that a license plate bearing the image would be perceived as a message approved by the State. In applying the *Walker* test, the district court in the Redskins case noted that the federal government exercised editorial control over its registration program (by setting standards for what marks could be registered) and that granting federal registration to a mark, in effect, communicated the federal government’s approval. Yet while the district court conceded that the mark’s owner bears “ultimate responsibility” for the mark — given, for example, that it must defend the mark’s registration — it nonetheless concluded that federal trademark registrations, like the issuance of license plates, constitute a form of government speech. As a result, the government could determine the contents of its speech (here, what marks to register) without being subjected to scrutiny under the Free Speech clause.

After ruling against Pro-Football on the First Amendment issues, the court turned its attention to the Fifth Amendment arguments that Section 2(a) was (i) void for vagueness and (ii) constituted an unconstitutional taking. Regarding the former, Judge Lee held that both a facial and as-applied vagueness challenge against Section 2(a) failed because the law’s plain language gave fair warning of what it covered and could be applied consistently without the fear of arbitrary and discriminatory enforcement. Moreover, the district court noted that Pro-Football had notice even before it filed to register the “redskins” marks based on, among other things, how the term was defined in dictionaries at the time. Regarding Pro-Football’s arguments that Section 2(a) constituted an unconstitutional taking, Judge Lee simply noted that, per Federal Circuit precedent, the owner of the marks has an interest in the *trademark* not the *registration*.

Finally, the district court took up Pro-Football’s claim that the “redskins” marks did not contain material that — taken in the marks’ proper context — would disparage Native Americans. The court began by considering the marks’ context, finding that Pro-Football used all six marks as a reference to Native Americans. Judge Lee then looked at whether the marks contained potentially disparaging material, focusing on three categories of evidence: (i) dictionary definitions, (ii) scholarly, literary, and media reference, and (iii) statements from within the referenced group of people. For each category, the court found numerous examples defining or describing

the term “redskin” as an offensive term for Native Americans, with some examples dating as far back as 1911. Consequently, Judge Lee ruled that the marks contained material that “may disparage” Native Americans, held that the registrations for those marks were properly cancelled, and granted the cross-motion for summary judgment filed by Ms. Blackhorse et al.

The *Pro-Football* appeal will likely turn on the outcome of a pending en banc review of a recent Federal Circuit decision upholding the TTAB’s application of Section 2(a) to refuse registration to an “offensive” mark. In April 2015, the Federal Circuit decided *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015), holding that the Patent and Trademark Office’s refusal to register a band’s name called “The Slants” based on a determination that the name was offensive to Americans of Asian descent did not violate the First Amendment. Primarily, the *In re Tam* decision was based on precedent beginning with a case called *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981) which held that refusal to register a mark did “not affect his [or her] right to use it”, the same reasoning applied by the district court in *Pro-Football*. However, a concurring opinion in *Tam* (styled as “additional views”) likely triggered the en banc review of that case. In that panel opinion, the author argued at length that *McGinley* was wrong and should be overturned, that trademark registrations do not constitute government speech, and that, consequently, Section 2(a) violated the First Amendment. A week after the *Tam* decision, the Federal Circuit elected to reconsider the case en banc and issued instructions for the parties to brief the issue of whether Section 2(a) violates the First Amendment. Whatever the ultimate outcome, the Federal Circuit’s en banc opinion in *Tam* will, in all likelihood, dictate the fate of the “redskins” marks.

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