

REDSKINS TRADEMARK CANCELLED – Q&A WITH BEAN, KINNEY & KORMAN

By now, you've no doubt heard the news that yesterday (June 18, 2014), the Trademark Trial and Appeal Board (TTAB), an administrative body of the U.S. Patent and Trademark Office (USPTO) cancelled the Washington NFL team's registered trademarks for "Redskins." The decision will not take effect until the team owner, Dan Snyder, has exhausted his appeal rights. But what does this mean from a practical perspective for the team, for Mr. Snyder and for people who want to use the name to make their own t-shirts?

Q. Does this mean the team has to stop calling itself the "Redskins"?

A. NO. The USPTO and the TTAB cannot use a cancellation decision to make a trademark owner stop using its trademark. Assuming the ruling is upheld on appeal, the decision only rescinds the team's rights to certain benefits that come with federal trademark registration, such as enlisting U.S. Customs and Border Patrol Service to stop importation of infringing or counterfeit merchandise, the right to use the federal registration ® symbol and certain presumptions which provide additional protection of a trademark in court. The team can keep calling itself the "Redskins" and using the trademark on all the things it usually does (merchandise, jerseys, etc.).

Q. So, I can sell "Redskins" jerseys now without getting sued?

A. Probably not. The cancellation won't take effect until the appeals have been heard, and even then, the team still has "common law" trademarks that can be enforced against infringers in courts. Common law trademark rights are established by using a name in commerce, in connection with your goods or services, before anyone else. The team still has these rights, and can enforce them under either state trademark laws or possibly federal false advertising laws and other similar statutes. Mr. Snyder seems to like going to court, so if you do start selling "Redskins" jerseys, prepare to be sued.

Q. Hasn't the team had the trademark "Redskins" for a really long time? How can the government decide now to cancel it?

A. Yes, under federal statute. Under the 1946 amendments to the trademark statutes, there are certain circumstances under which a federal trademark registration can be cancelled at any time, no matter when it was registered. One of the circumstances is if it is found (based on the evidence)

that a term was disparaging of a person, or brought them into "contempt or disrepute" -- *when it was registered*. The TTAB determined that the term "Redskins" was disparaging to Native Americans, even when the first registrations were granted to the team in 1967.

Q. Hasn't the team been down this path before, and won?

A. Yes and no. In 1992, a group of Native Americans filed to have the same marks cancelled on the same grounds, and the TTAB agreed that they were disparaging. However, that decision was overturned, after going back and forth on appeal. The last appellate decision found that the group who sued had waited too long to assert their rights under the doctrine of "laches." That is, if the group was so offended by the mark, the court said, they should have sued the team as soon as they were legally able to do so, at age 18 or soon thereafter. The lower appeal court had said the same, but also that it didn't think there was enough evidence to support the decision that the term was disparaging back when the marks were registered. However, because the higher appeals court didn't address the disparagement question, it's still open for consideration with a younger group of petitioners.

Q. What happens now?

A. The team has said they will appeal the TTAB decision. They can keep using the mark regardless of this decision, although they may find the court of public opinion is swinging against them. If they want to maintain federal registrations, they can either appeal this decision to the Federal Circuit or file a new civil suit. Their federal registration will continue in force until those appeals are exhausted. The last one took about 7 years to work its way through the various levels of appeals.

If you want more background on or have any questions about the USPTO, the TTAB, trademark laws, this decision or any implications for your business, feel free to contact Ashley R. Dobbs at adobbs@beankinney.com or 703-526-4701.

Helpful Links:

[Information regarding the case from USPTO](#)
[TTAB's full decision](#)
[Statement from the Washington Redskins](#)