The PTO as PC Monitor

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When the Supreme Court denied certiorari in Harjo v. Pro-Football, 130 S.Ct. 631 (2009) (Harjo V), last November, it closed what may not prove to be the last chapter in a long standing dispute between a football franchise and Native Americans offended by the mark, Redskins.

The dispute began with the filing in 1992 of a petition to cancel a mark initially registered in 1967 as well as related marks registered later. Following loss in the PTO, the franchise got a reversal on the merits in *Harjo I,* 284 F.Supp.2d 96, 136 (D.D.C. 2003). As a preliminary matter, the court also reversed the TTAB's finding that petitioners' delay did not constitute laches. *Id.* at 99.

On appeal, the D.C. Circuit court reversed and remanded; *Harjo II,* 415 F.3d 44 (D.C. Cir. 2005). Addressing only laches, the appeals court found that too little attention had been given to Mateo Romero, a petitioner born in 1968. *Id.* at 50.

On remand, the district court again found laches, in part because Romero had reached the age of majority well before the petition was filed. That might have been insufficient to constitute laches, but in the interim, for example, a key witness had died and the franchise had continued to invest in Redskins and related marks. *Harjo III,* 567 F.Supp.2d 46, 57, 61-62 (D.D.C. 2008).

The D.C. Circuit affirmed, finding "it neither a stretch of imagination nor an abuse of discretion to conclude that Pro-Football might have invested differently… had Romero acted earlier…. "*Harjo IV,* 565 F.3d 880, 886 (D.C. Cir. 2009).

As mentioned, denial of certiorari may not close the books on this case. In *Harjo II,* Pro-Football had complained that failure to find laches "would logically mean that… a disparagement claim could be brought by an as yet unborn claimant for an unlimited time after a mark is registered." 415 F.3d at 49.

The D.C. Circuit answered, "even if registrations of some marks would remain perpetually at risk, it is unclear why this fact authorizes — let alone requires — abandonment of equity's fundamental principle that laches attaches only to parties who have unjustifiably delayed in bringing suit. Pro-Football forgets that 'laches is not, like limitation, a mere matter of time.'" *Id.* (citation omitted). The court went on to note that the result was dictated because § 15(3) of the Act permits a petition "at any time" to cancel a registration that was "was obtained… contrary to the provisions of" § 2(a) of the Act.

The upshot is that the PTO can be faced with a nearly impossible task — attempting to determine, many years after the fact, whether a mark when registered "consist[ed] of or comprise[d]… 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…." Lanham Act § 2(a), 15 U.S.C. § 1052(a).

The Act sets up a situation perplexing on many fronts. Section 2(a) appears to be constitutional for lack of effect on speech. *See, e.g.,* In re McGinley, 660 F.2d 481, 484 (1981) ("With respect to appellant's First Amendment rights, it is clear that the PTO's refusal to register appellant's mark does not affect his right to use it."). Yet, for the same reason, it may accomplish little. Refusal to register does not preclude use. Moreover, if relief is denied based, for example, on an owner's unclean hands, surely the situation is not improved by having two disparaging parties, one of whom is also misleading consumers as to source. If the owner's use can be and is halted despite the First Amendment, the trademark falls for lack of use. *Cf.* Jacob Siegel Co. v. FTC, 327 U.S. 608 (1946) (reversing an order requiring Siegel to cease use of an allegedly misdescriptive mark). If use cannot be halted, as above, the result is unlikely to benefit consumers.

The contrast in relevant time frames is also perplexing. On the merits, if a widely used mark is significantly disparaging at the time of registration, surely offended parties

will notice and promptly oppose or petition to cancel. Failure to do so goes far in indicating that the mark was not disparaging at that time. In that respect, it is useful to contrast two now-related definitions in The Random House Dictionary of the English Language (Unabridged edition, 1967): (1) "Redskin, n. *Often Offensive.* a North American Indian." [capitals & emphasis in original]; (2) "Squaw, n. a North American Indian woman, esp. a wife."

Despite no evidence of offensiveness in a forty-three-year-old dictionary, the second term is now seen as, if anything, more offensive. *See, e.g.,* In re Squaw Valley Development Co., 80 U.S.P.Q.2d 1264 (TTAB 2006). Thus, it has already been banned from official use in many states. *See, e.g.,* Paul Currier, *The "Squaw" Word,* Portland Press Herald, June 27 (2000) (recounting events in Maine shortly after the term was banned from all place names).

If a mark is currently disparaging, why should its meaning many years earlier be relevant? Lack of a good answer is the third perplexing aspect of sections 2(a) and 15(3), taken together.

As to that, Webster's Word Histories, *x* (Merriam-Webster 1989), is enlightening: "If a word is used often enough in negative contexts, the negative coloring may become an integral part of the meaning…. A *villian* [a peasant] was certainly not a scoundrel." Likewise a *scavenger* was a type of tax collector; a *cretin,* a Christian; and *puny* meant "younger." *Id.*

Conversely, pejorative terms may become flattering. *Nice* meant "foolish" in the fourteenth century. *Id.* Later, the same volume observes in part, "Ignorant of the word's history, many commentators regarded [gay] as an euphemism… foisted upon the heterosexual majority. Homosexuals themselves seemed to regard it as a positive designation… far preferable to a host of blatantly offensive words." *Id.* at 191. It is difficult to imagine why the PTO would be expected to mediate evolving linguistic preferences beyond descriptiveness and genericism,

That such a role should be unnecessary is well illustrated by the experience of the late Sambo's restaurant chain as briefly recounted in the Wikipedia at http://en.wikipedia.org/wiki/Sambo%27s (visited Jan. 24, 2010). With a mark derived from the founders' names, that chain once had well over a thousand restaurants spanning the country, Through no apparent fault of its owners, its mark came to be seen as pejorative by African-Americans. Within five years it shrank back to one location. Public perceptions of the owners' culpability, even if unfounded, may not have guaranteed Sambo's demise. Yet it was surely a major factor.

In light of that, Congress should consider whether the PTO's policing trademark registrations ought ever to reach beyond the capacity of marks to promote or hinder competition on the merits.