

30 U.S.P.Q.2d 1828, 1994 WL 262249 (Trademark Tr. &amp; App. Bd.)

Trademark Trial and Appeal Board  
Patent and Trademark Office (P.T.O.)

SUZAN SHOWN HARJO, RAYMOND D. APODACA, VINE DELORIA, JR., NORBERT S. HILL, JR., MATEO ROMERO, WILLIAM A. MEANS, AND MANLEY A. BEGAY, JR.

v.

PRO FOOTBALL, INC.

Cancellation No. 21,069

March 11, 1994

Before Sams, Rice and Seeherman  
Administrative Trademark Judges

By the Board:

J.D. Sams, J.E. Rice and E.J. Seeherman  
Administrative Trademark Judges

Petitioners, Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr., as Native American persons and as enrolled members of federally recognized Indian tribes, seek to cancel the following registrations owned by Pro Football, Inc.: Registration No. 1,606,810 for the mark REDSKINETTES issued July 17, 1990; Registration No. 1,343,442 for the mark SKINS issued June 18, 1985; Registration No. 1,085,092 for the mark REDSKINS issued February 7, 1978; Registration No. 987,127 for the mark THE REDSKINS & DESIGN issued June 25, 1974; Registration No. 986,668 for the mark WASHINGTON REDSKINS & DESIGN issued June 18, 1974; Registration No. 978,824 for the mark WASHINGTON REDSKINS issued February 12, 1974; and Registration No. 836,122 for the mark THE REDSKINS (stylized letters) issued September 26, 1967.

Petitioners allege, as grounds for cancellation, that the term "REDSKIN" is a pejorative, derogatory, degrading, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation for a Native American person; that, in particular, the marks in Registration Nos. 986,668 and 987,127, which include the stylized depiction of an Indian, in the context used by respondent, are offensive, disparaging and scandalous; that respondent's use of the registered marks offends petitioners and other Native Americans, causing them to be damaged by the continued registration of the marks; that respondent's registered marks consist of or comprise matter which disparages Native American persons and brings them into contempt, ridicule, and disrepute, in violation of Section 2(a) of the Trademark Act [15 U.S.C. § 1052(a)]; and that the marks consist of or comprise scandalous matter, also in violation of Section 2(a) of the Act.

Respondent, in its answer to the petition for cancellation, has denied the essential allegations therein. Respondent asserts, as affirmative defenses: that the petition fails to state a claim upon which relief may be granted (paragraph 4); that petitioners lack standing (paragraph 5); that the petition is barred by the doctrine of equitable estoppel (para-

graph 6); that the petition is barred by laches (paragraph 7); that through long, substantial and widespread use, advertising and promotion in support thereof and media coverage, said marks have acquired a strong secondary meaning identifying the entertainment services provided by respondent in the form of professional games in the National Football League (paragraph 8); that upon information and belief, petitioners have not been and are not and will not be damaged by the continued registration of respondent's registered marks (paragraph 9); that upon information and belief, petitioners have failed to state specifically and cannot state specifically any special damages by virtue of the acts complained of in the cancellation petition herein (paragraph 10); that petitioners' claims under Section 14 of the Lanham Act, 15 U.S.C. § 1064, are barred because they are based upon Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), which abridges the respondent's right to freedom of speech provided by the First Amendment to the United States Constitution; that respondent's registered marks are a form of speech protected by the First Amendment to the United States Constitution and thus cannot be regulated or cancelled merely because these petitioners may find them objectionable (paragraph 11); that petitioners' claims are barred because the statutory language of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), relied upon by petitioners in connection with the cancellation petition herein under Section 14 of the Lanham Act, 15 U.S.C. § 1064, is unconstitutionally overbroad (paragraph 12); and that petitioners' claims are barred because the statutory language of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a), relied on by petitioners herein under Section 14 of the Lanham Act, 15 U.S.C. § 1064, is unconstitutionally void for vagueness (paragraph 13).

This case now comes up for consideration of petitioners' motion to strike the affirmative defenses set forth in paragraphs 4, 5, 6, 7, 8, 9, 10, 11, 12 and 13 of respondent's answer to the petition for cancellation. This motion has been fully briefed by the parties.

Under Fed.R.Civ.P. 12(f), the Board may grant a motion to strike from a pleading any insufficient defense. However, motions to strike are not favored and a defense will not be stricken if the insufficiency of the defense is not clearly apparent, or if it raises factual issues that should be determined on a hearing on the merits. See Wright & Miller, Federal Practice and Procedure: Civil 2d § 1381 (1990).

We turn first to petitioners' motion to strike respondent's affirmative defenses that the petition fails to state a claim upon which relief may be granted and that petitioners do not have standing (paragraphs 4 and 5). In order to state a proper claim, petitioners must allege facts which, if proved, would establish that (1) they have standing to challenge respondent's registrations and (2) there is a valid ground for cancelling the subject registrations. See *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185 (CCPA 1982). Standing is a threshold inquiry directed solely to establishing a plaintiff's interest in the proceeding. The purpose in requiring standing is to prevent litigation where there is no real controversy between the parties, i.e., where a plaintiff is no more than a mere intermeddler. In order to assert a legally sufficient pleading of standing, a plaintiff must plead facts which, if later proved, would establish that the plaintiff has a real interest in the outcome of the proceeding, that is, a personal interest in the outcome of the case beyond that of the general public. See: *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 U.S.P.Q.2d 2021 (Fed.Cir.1987); *International Order of Job's Daughters v. Lindenburg and Company*, 727 F.2d 1087, 220 USPQ 1017 (Fed.Cir.1984); and *Lipton Industries Inc. v. Ralston Purina Co.*, supra.

We believe petitioners have pleaded a legitimate interest in the outcome of this proceeding. As set forth in the pleadings, petitioners have alleged that they are Native American persons and that they are enrolled members of federally recognized Indian tribes. Moreover, petitioners have asserted that the word "REDSKINS," which appears in respondent's registered marks, is a derogatory term referring to Native Americans and that it offends petitioners and other Native Americans. Clearly, these facts, if proved, would be sufficient to establish that petitioners have standing to be heard herein, that is, that petitioners have a personal interest in the proceeding beyond that of the general public. See: *Brombery v. Carmel Self Service, Inc.*, 198 USPQ 176 (TTAB 1978). Whether these allegations are true is a question of fact to be determined at trial.

Moreover, it is clear that petitioners have set forth statutory grounds for seeking to cancel the registrations--namely,

claims under Section 2(a) of the Trademark Act that the registered marks are scandalous and that they are disparaging to petitioners.

We turn next to petitioners' motion to strike the equitable defenses of estoppel and laches (paragraphs 6 and 7). Petitioners contend that the plain language of Section 14(3) of the Trademark Act--language that allows cancellation of registrations "at any time" on certain grounds, including those grounds asserted by petitioners--precludes the application of the laches and estoppel defenses in this proceeding. Petitioners also argue that laches is not available as a defense in this proceeding, because petitioners seek to remove registrations from the register which were clearly void ab initio; and that estoppel and laches are not available in this proceeding because there is an overriding public policy to remove registrations of marks that are scandalous or disparaging. Respondent, on the other hand, states that there is no authority which holds that the equitable defenses of laches and estoppel are unavailable in a cancellation proceeding brought under Section 2(a) against marks alleged to be scandalous and/or disparaging.

The Board has held that the equitable defenses of laches and estoppel are not available against claims of fraud and abandonment because there exists a broader interest--a "public policy" interest--in addition to a private interest in removing from the register those registrations procured or maintained by fraud and those registrations for marks that have been abandoned. Similarly, for public policy reasons, the Board has held that laches and estoppel are not available to a defendant in a proceeding where a plaintiff is claiming that the mark sought to be registered is merely descriptive, deceptive or deceptively misdescriptive, or that use of a certification mark is not being controlled by the owner of the mark. See *Midwest Plastic Fabricators Inc. v. Underwriters Laboratories Inc.*, 5 U.S.P.Q.2d 1067 (TTAB 1987); *Consolidated Foods Corp. v. Big Red, Inc.*, 226 USPQ 829 (TTAB 1985); and *American Speech-Language-Hearing Assn. v. National Hearing Aid Society*, 224 USPQ 798 (TTAB 1984).

Respondent argues that, here, the closest decision on point is *Treadwell's Drifters, Inc. v. Marshak*, 18 U.S.P.Q.2d 1318 (TTAB 1990). In *Treadwell's*, the Board found that the claim, under Section 2(a), that a mark falsely suggested a connection with opposer was more in the nature of a claim of likelihood of confusion (against which equitable defenses had been permitted) than it was to fraud, abandonment, descriptiveness, or genericness (against which equitable defenses had not been permitted). Respondent maintains that here, as in *Treadwell's*, there is no overriding public policy interest to preclude assertion of its equitable defenses, because petitioners' Section 2(a) claims, again like those in *Treadwell's*, are personal in nature. In support of its position that the claims are personal, respondent relies on the Board's decision in *Greyhound Corp. v. Both Worlds Inc.*, 6 U.S.P.Q.2d 1635, 1639 (TTAB 1988), where the Board stated that "disparagement is essentially a violation of one's right of privacy--the right to be 'let alone' from contempt or ridicule."

In citing this language from the Board's opinion in *Greyhound*, respondent has misapprehended the context in which the Board made its decision. The mark under challenge in *Greyhound* was a design portraying a defecating dog. The cancellation petitioner asserted, among other grounds for cancellation, that the design was disparaging. In stating that "disparagement is essentially a violation of one's right of privacy," the Board was attempting to make the point that, to prevail on its disparagement claim, petitioner's proof had to show that the challenged mark (the defecating dog design) held petitioner, as an entity, up to ridicule; it was not enough to prove that the challenged mark was a take-off on, or ridiculed, petitioner's trademark (the running greyhound design).

Yet, the question remains: in a cancellation proceeding before the Board, are the equitable defenses of estoppel and laches available against Section 2(a) claims of disparagement and scandalousness? We believe this to be a question of first impression.

In the present case, we find that there exists a broader interest--an interest beyond the personal interest being asserted by the present petitioners--in preventing a party from receiving the benefits of registration where a trial might show that respondent's marks hold a substantial segment of the population up to public ridicule. Of course, such a showing has yet to be made. But we will not deny petitioners the right to attempt to make their case by allowing respondent's equitable defenses.

Our decision here should not be taken as a general rule concerning the availability of the equitable defenses of laches and estoppel against a claim, under Section 2(a), that a mark disparages or is scandalous. There might be a case in which a petitioner's allegations under Section 2(a) do not embody a broader, public policy, interest sufficient to bar application of equitable defenses. Our decision here is only that the allegations of the present petition for cancellation are such that, in this case, the asserted equitable defenses are not available.

We turn next to petitioners' motion to strike respondent's defense that its marks have acquired secondary meaning (paragraph 8). Petitioners argue that a secondary meaning defense is not available against a Section 2(a) claim. However, respondent maintains that this is not a classic secondary meaning defense but rather a defense that refutes petitioners' allegation that the registered marks are scandalous and disparaging. Respondent contends that the long use, advertising and promotion of its registered marks have clearly caused the public to associate and identify the marks solely with respondent and the favorable goodwill embodied in the names and symbols of the Washington Redskins football franchise, and that even in the unlikely event that the words were reasonably understood by the general public to refer in the abstract to Native Americans in a disparaging manner when adopted many decades ago, that is clearly no longer the case.

Proof that respondent's marks have acquired "secondary meaning"--that is, that they have come to identify and distinguish respondent's goods and services from the like goods and services of others--would not establish a good defense to petitioners' claims under Section 2(a). To state the matter differently: a trademark or service mark may be distinctive and, at the same time, disparaging and/or scandalous. But, after considering respondent's statements in explanation of paragraph 8 of its answer, we believe respondent recognizes that it may not rely on a "secondary meaning" defense. And, we do not read paragraph 8 as a "secondary meaning" defense, but as a mere elaboration of respondent's denial of the allegations of paragraphs 1, 2 and 3 of the petition for cancellation. For that reason, we will not strike the paragraph from respondent's answer.

We would point out, though, that the critical dates in this case, for both petitioners and respondent, are the issue dates of respondent's registrations. That is, the case will be determined by deciding whether, at the time these registrations issued, the various marks were scandalous and/or disparaging. See *Consorzio del Prosciutto di Parma v. Parma Sausage Products, Inc.*, 23 U.S.P.Q.2d 1894, 1898-9 (TTAB 1992) [plaintiff seeking cancellation of a registration, which was more than twenty years old, for the mark "PARMA," on grounds that "PARMA" was a geographically deceptive term, required to establish that the mark was geographically deceptive as of the time the registration issued, it being held insufficient for plaintiff to establish merely that "PARMA" was geographically deceptive as of the time of trial]; *Board of Trustees of the University of Alabama v. BAMA-Werke Curt Baumann*, 231 USPQ 408, 410-11 (TTAB 1986) [plaintiff seeking cancellation of a 30-year-old registration of the term "BAMA," on the grounds that the mark falsely suggested a connection with plaintiff, required to establish that the term "BAMA" pointed uniquely to plaintiff as of time the registration issued, not as of the time of the filing of the petition for cancellation]; and *Neapco Inc. v. Dana Corp.*, 12 U.S.P.Q.2d 1746 (TTAB 1989) [in the case of a registration less than five years old, proof by petitioner that the registered mark was merely descriptive when the registration issued was held a sufficient basis to grant the petition to cancel, even if the registrant could establish that, at the time of trial, the mark had become distinctive].

Next to consider is petitioners' motion to strike respondent's affirmative defenses that petitioners are not damaged by respondent's registrations and that petitioners have failed to allege any special damages (paragraphs 9 and 10). Petitioners argue that it is well established that a petitioner is not required to prove damage in order to establish its standing or to prevail in a cancellation proceeding. Respondent, on the other hand, argues that lack of special damages is a valid defense because the disparagement prong of Section 2(a) requires the same proof as the torts of disparagement and defamation.

The term "damage" as used in Sections 13 and 14 of the Trademark Act concerns only a party's standing to file an opposition or petition to cancel, respectively. As previously indicated, a party may establish its standing to oppose or

to petition to cancel by showing that it has a real interest in the case, that is, a personal interest beyond that of the general public. There is no requirement that actual damage be pleaded and proved in order to establish standing or to prevail in an opposition or cancellation proceeding. See: *Books on Tape Inc. v. Booktape Corp.*, 836 F.2d 519, 5 U.S.P.Q.2d 1301 (Fed.Cir.1987); *Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, supra; and *International Order of Job's Daughters v. Lindeburg & Co.*, 727 Fed.2d 1087, 220 USPQ 1017 (Fed.Cir.1984). Moreover, respondent has not cited any pertinent authority to support its assertion that proof of "special damages" is--or ought to be--an element of petitioners' claims under Section 2(a); indeed, respondent has failed even to make clear what it means by "special damages" in the context of this case.

We turn, then, to petitioners' motion to strike respondent's affirmative defenses that petitioners' claims are barred because they are based on Section 2(a), which abridges respondent's right to freedom of speech; that respondent's marks are a protected form of speech which cannot be regulated or cancelled merely because these petitioners may find them objectionable (paragraph 11); and that petitioners' claims are barred because the portion of Section 2(a) relied on is overbroad (paragraph 12) and is void for vagueness (paragraph 13). Respondent maintains that it has not requested that the Board strike down Section 2(a), but instead has requested that the Board apply the statute in a constitutional manner. In particular, respondent maintains that cancellation of these registrations on the particular grounds stated in the petition would be unconstitutional as applied to respondent under the First Amendment. The allegations in paragraph 11 do not constitute an affirmative defense, because, as we read them--and notwithstanding respondent's arguments to the contrary-- the allegations amount only to a charge that the provisions of Section 2(a) on which petitioners have based their claims are unconstitutional. Moreover, to the extent that respondent is requesting that the Board find Section 2(a) to be at odds with the First Amendment, such a finding is beyond the Board's authority to make. An administrative tribunal such as the Trademark Trial and Appeal Board has no authority to declare provisions of the Lanham Act unconstitutional. See: *Panola Land Burgers Assn. v. Shuman*, 762 F.2d 1550 (11th Cir.1985); *McGowan v. Marshall*, 604 F.2d 885, 892 (5th Cir.1979); and *Finnerty v. Cowen*, 508 F.2d 979 (2d Cir.1974). See also *Public Utilities Comm. v. U.S.*, 355 U.S. 355, 78 S.Ct. 446 (1958). Similarly, the Board has no authority to determine whether Section 2(a) is overbroad or vague.

IT IS ORDERED:

In view of the foregoing, petitioner's motion to strike is granted to the extent that paragraphs 4, 5, 6, 7, 9, 10, 11, 12 and 13 of respondent's defenses are hereby stricken.

Proceedings herein are accordingly resumed and the parties are allowed until thirty days from the date of this order in which to respond to any outstanding discovery requests.

Trial dates, including the period for discovery, are set in the accompanying trial order.

J.D. Sams

J.E. Rice

E.J. Seeherman

Administrative Trademark Judges, Trademark Trial and Appeal Board

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