

THE WASHINGTON REDSKINS AND THE CURRENT STANDARD FOR DISPARAGING TRADEMARKS: THE IMPACT OF DISPARAGING TRADEMARKS IN THE MODERN WORLD

BY: ALEXANDRIA CHU*

ABSTRACT

In 2014, the United States Patent and Trademark Office declared the Washington Redskins trademark to be disparaging and ignited a nationwide conversation. This Note addresses the current standard for determining disparaging trademarks while considering difficulties due to changes in the modern world. First, this Note investigates the history behind disparaging trademarks, including its background, social impact, and examples. Next, this Note tracks the decade of litigation behind the decision in order to compare the varying standards and policy concerns of the Trademark Trial and Appeal Board versus the District Court and Court of Appeals. Finally, this Note considers a case study of another possibly disparaging trademark and hypothetical results of the trademark being used in modern-day Asia and America.

* J.D. Candidate, University of Southern California Gould School of Law, 2016; Bachelor of Arts, Tufts University, 2013. Thank you to Vivian and Allison for their thoughtful edits. Special thank you to my mother and father for all their support.

TABLE OF CONTENTS

I. INTRODUCTION	40
II. DISPARAGING TRADEMARKS: BACKGROUND, SOCIAL IMPACT, AND EXAMPLES	42
A. DISPARAGING TRADEMARKS: BACKGROUND	42
B. DISPARAGING TRADEMARKS: SOCIAL IMPACT	43
C. DISPARAGING TRADEMARKS: EXAMPLES	46
III. THE WASHINGTON REDSKINS: <i>HARJO</i> AND <i>BLACKHORSE</i>	47
A. THE WASHINGTON REDSKINS: <i>HARJO V. PRO-FOOTBALL, INC.</i>	47
B. THE WASHINGTON REDSKINS: <i>BLACKHORSE V. PRO- FOOTBALL, INC.</i>	53
C. THE WASHINGTON REDSKINS: DIFFERING STANDARDS OF THE TTAB AND THE COURT	56
IV. VARYING STANDARDS: CRITICISM AND POLICY	57
A. VARYING STANDARDS: CRITICISM	57
B. VARYING STANDARDS: POLICY	58
V. BRINGING IT ALL TOGETHER: CASE STUDY OF DARKIE/DARLIE TOOTHPASTE	59
A. BACKGROUND OF DARKIE/DARLIE TOOTHPASTE	59
B. DARKIE/DARLIE TOOTHPASTE IN ASIA	62
C. DARKIE/DARLIE TOOTHPASTE IN THE UNITED STATES	64
VI. CONCLUSION.....	66

“The most popular mascots in the country are Indians and animals.”¹

I. INTRODUCTION

Popular folklore in the 1950s stated that the “reddish-brown tint” of the Washington Redskins team’s headquarters was from Native-American blood.² Samuel Henry, Chair of Oregon’s Board of Education, said, “When I was a kid, me and my friends, we really thought that they had captured and killed Native Americans and pasted them all over the

¹ *The Redskins’ Name – Catching Racism*, THE DAILY SHOW WITH JON STEWART (Sept. 25, 2014), <http://thedailyshow.cc.com/videos/189afv/the-redskins--name---catching-racism>.

² Haley Munguia, *The 2,128 Native American Mascots People Aren’t Talking About*, FIVETHIRTYEIGHTSPORTS (Sept. 5, 2014, 6:00 AM), <http://fivethirtyeight.com/features/the-2128-native-american-mascots-people-arent-talking-about/>.

2015]

THE WASHINGTON REDSKINS

41

building. We were just kids, we didn't know any better. But we really, honestly believed that."³ In 2012, Oregon instituted a statewide ban on Native American team names and mascots, and Henry has since said, "I'd love to see a boycott of all things Redskins."⁴

But the professional football team of the capital of the United States is still called the Washington Redskins.⁵ The term "redskins" dates back to its use in the Phips Proclamation in 1755, a document issued by the Massachusetts government calling for a bounty on Native Americans.⁶ Native Americans' bloody scalps were used as proof to claim the bounty, and these scalps were referred to as redskins.⁷ The Washington Redskins football team reinforces its reference to Native Americans with a logo of a Native American in profile, complete with reddish-brown skin, war paint, and feathers in his hair.⁸ Although the team does not have an official mascot at games, its unofficial mascot is Chief Zee, an African American man who attends games in a feathered war bonnet and tomahawk.⁹ Chief Zee's main purpose is entertainment, and he explains that a lot of his fans say, "You know, my wife won't even cook me dinner till she see you on TV and says, 'There's my Injun.'"¹⁰ He further explains, "The older people been watching me so long, they don't even say 'Indian.' They say, 'Injun. There's my Injun.' And it's on."¹¹ To showcase Chief Zee's popularity, fans often wear the similar feathered war bonnets to games.¹²

Following a decade of litigation involving the Washington Redskins trademark and its disparaging nature, the United States Patent and

³ *Id.*

⁴ *Id.*

⁵ *Washington Redskins*, WIKIPEDIA, http://en.wikipedia.org/wiki/Washington_Redskins (last visited Nov. 19, 2014).

⁶ Baxter Holmes, *A 'Redskin' Is the Scalped Head of a Native American, Sold, like a Pelt, for Cash*, *ESQUIRE* (June 17, 2014, 12:30 PM), <http://www.esquire.com/blogs/news/true-redskins-meaning>.

⁷ *Id.*

⁸ *Washington Redskins Logos*, SPORTSLOGOS.NET, http://www.sportslogos.net/logos/list_by_team/168/Washington_Redskins/ (last visited Nov. 19, 2014).

⁹ Mike Wise, *Chief Zee's Time as Redskins' Unofficial Mascot Is Nearly Over*, *THE WASHINGTON POST* (Sept. 3, 2013), http://www.washingtonpost.com/sports/redskins/chieff-zee-the-redskins-and-the-setting-sun/2013/09/03/94a3c7e0-14c6-11e3-a10066fa8fd9a50c_story.html.

¹⁰ *Id.*

¹¹ *Id.*

¹² Travis Waldron, *Washington Fans Wear Headdresses to Game Against Cleveland Browns*, *THINK PROGRESS* (Aug. 19, 2014, 12:57 PM), <http://thinkprogress.org/sports/2014/08/19/3472854/washington-football-fans-dress-up-in-native-american-headdresses-warpaint/>.

Trademark Office (USPTO) deemed the Washington Redskins trademark disparaging on June 18, 2014.¹³ Part II of this Note investigates the background of trademarks and the disparaging standard for cancellation with specific disparaging trademark examples. Part III analyzes litigation involving the Washington Redskins trademark. Part IV looks to the impact of the recent USPTO decision as well as its social and policy ramifications. Lastly, Part V is a case study on a different trademark with a racially disparaging background, Darkie or Darlie toothpaste.

II. DISPARAGING TRADEMARKS: BACKGROUND, SOCIAL IMPACT, AND EXAMPLES

A. DISPARAGING TRADEMARKS: BACKGROUND

According to the Lanham Act, a trademark is “any word, name, symbol, or device . . . used by a person . . . to identify and distinguish her or her goods . . . from those manufactured or sold by others and to indicate the source of the goods.”¹⁴ Therefore, trademarks assure consumers of the source of the goods they are purchasing. However, the Lanham Act also includes policy concerns beyond merely helping consumers in their purchases, since a trademark will be denied registration by an examiner if it is scandalous or disparaging. Although a trademark can provide benefits to both organizations and consumers, the Lanham Act enforces a policy that will decline the registration of a trademark that is scandalous or disparaging.¹⁵

The USPTO is the first body that determines whether a trademark is scandalous or disparaging. If the USPTO accepts a trademark, the mark is published in the Official Gazette for opposition.¹⁶ The public can then challenge the mark through a cancellation proceeding or bring the cancellation action at a later date.¹⁷ However, if the USPTO decides to reject the trademark, the applicant may appeal to the Trademark Trial and

¹³ Travis Waldron, *The Redskins Just Had Their Trademark Cancelled. Here's What Happens Next.*, THINK PROGRESS (June 19, 2014, 10:22 AM), <http://thinkprogress.org/sports/2014/06/19/3450729/redskins-trademark-decision-cost-lots-of-money/>.

¹⁴ 15 U.S.C. § 1127 (2006).

¹⁵ 15 U.S.C. § 1052 (2006).

¹⁶ 37 CFR § 2.80 (2014).

¹⁷ *Cancellation of a Registered Trademark*, INTERNATIONAL TRADEMARK ASSOCIATION (2015), <http://www.inta.org/TrademarkBasics/FactSheets/Pages/CancellationofaRegisteredTrademarkFactSheet.aspx> (last visited Nov. 19, 2014).

2015]

THE WASHINGTON REDSKINS

43

Appeal Board (TTAB).¹⁸ If the TTAB upholds the denial, the applicant may then appeal to the United States Court of Appeals for the Federal Circuit.¹⁹

The TTAB uses a two-part test for determining whether a mark is disparaging.²⁰ First, the TTAB determines “the likely meaning of the matter in question, taking into account not only dictionary definitions, but also the relationship of the matter to the other elements in the mark, the nature of the goods or services, and the manner in which the mark is used in the marketplace.”²¹ In layman’s terms, the first step looks at the meaning of the mark. In the second step, “[i]f that meaning is found to refer to identifiable persons, institutions, beliefs or national symbols,” then the TTAB asks whether the meaning is “disparaging to a substantial composite of the referenced group.”²²

B. DISPARAGING TRADEMARKS: SOCIAL IMPACT

Trademarks serve a larger cultural purpose through their social impact and can create “cultural associations or mythical attachments.”²³ For example, the trademark “Wimbledon” for clothing like blazers or “items associated with pastimes of the leisured class” brings to mind the tennis culture.²⁴ However, a trademark does not have limitless power; for example, applying the Wimbledon mark to blue jeans might not be as effective as it would be if it were attached to other types of clothing.²⁵ Thus, within limits, trademarks can give new meaning to a product.²⁶

Consequently, trademarks reflect the culture of our society as a whole.²⁷ Our perception of myths associated with trademarks intuitively reflects stereotypes, including derogatory and prejudicial racial

¹⁸ 15 U.S.C. § 1070 (2006).

¹⁹ 15 U.S.C. § 1071(a)(1) (2006).

²⁰ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 1267 (T.T.A.B. May 23, 2006).

²¹ *Id.*

²² *Id.*

²³ Thomas D. Drescher, *The Transformation and Evolution of Trademarks—From Signals to Symbols to Myth*, 82 TMR 301 (1992).

²⁴ *Id.* at 307.

²⁵ *Id.* at 308.

²⁶ *Id.*

²⁷ K.J. Greene, *Symposium: Creators vs. Consumers: The Rhetoric, Reality, and Reformation of Intellectual Property Law and Policy: Trademark Law and Racial Subordination: From Marketing of Stereotypes to Norms of Authorship*, 58 SYRACUSE L. REV. 431, 433 (2008).

stereotypes.²⁸ One example of a negative racial stereotype promoted through trademarks is that of the “savage Native American.”

The oppression of Native Americans through war, displacement, and assimilation has been prevalent ever since the arrival of Europeans in North America.²⁹ John Adams called Native Americans “[s]avages unfit for democracy,” and Thomas Jefferson wanted to exterminate Native Americans who opposed assimilation efforts.³⁰ This savage racial stereotype is most notably promoted through sports teams with Native American mascots, including the Cleveland Indians trademark “Chief Wahoo,” which “depicts a caricature of an American Indian face with a cartoon-like grin and a large nose,” or the Atlanta Braves trademark, which “shows an American Indian in a ‘war cry’ with a mohawk and feathers.”³¹ The Native American mascot is often seen as “primitive, aggressive, and unsophisticated.”³²

On a larger scale, this stereotype’s perpetuation stigmatizes Native Americans, resulting in harmful effects.³³ The United States Commission on Civil Rights stated that this stigma contributes to Native Americans having “the lowest high school graduation rates in the nation and even lower college attendance and graduation rates.”³⁴ Additionally, the suicide rate for Native Americans is three times greater than that for the United States population.³⁵ Even if there is no direct causal relationship between these statistics and the trademarks in question, the statistics “indicat[e] that native societies in the present day are particularly vulnerable and often have difficulty reconciling their culture with the modern world. The Native American experience has proven to be extremely difficult in the face of a modern society that continually attempts to misappropriate its heritage and cultural symbols.”³⁶

Native Americans may also feel excluded from sporting events and

²⁸ *Id.* at 434.

²⁹ Steven R. Latterell, *Stopping the “Savage Indian” Myth: Dealing with the Doctrine of Laches in Lanham Act Claims of Disparagement*, 80 IND. L.J. 1141, 1144–45 (2005).

³⁰ *Id.* at 1145.

³¹ *Id.* at 1146.

³² *Id.*

³³ *Id.* 1148.

³⁴ *Id.*

³⁵ John R. Wallace, *Discriminatory & Disparaging Team Names, Logos, & Mascots: Workable Challenges & the Misapplication of the Doctrine of Laches*, 12 RUTGERS RACE & L. REV. 203, 208 (2011).

³⁶ *Id.* at 208–09.

2015]

THE WASHINGTON REDSKINS

45

choose not to go to these events in order to “avoid exposure to a misuse of their culture or religion.”³⁷ Charlene Teters, who attended University of Illinois and is Native American, explains the hurt caused by the Chief Illiniwek mascot.³⁸

When I first arrived here [ten] years ago, it was with a great deal of excitement. I was honored to be here amongst you, attending the University of Illinois, a Big Ten University. I came full of dreams. But what I found . . . was a community permeated with Indian concoctions, a campus bar with a neon sign, HOME OF THE DRINKING ILLINI, a sorority MISS ILLINI SQUAW contest. Fraternity brothers wearing colored paper headdresses to go to the bar to drink, and act out negative stereotypes of Indians. My dream . . . turned to a nightmare.³⁹

Overall, Native American trademarks prevent non-Native Americans from truly understanding Native Americans and their “historical and cultural experiences.”⁴⁰ A trademarked Native American mascot strips Native Americans of human qualities, making them “mythical ornaments” as opposed to multi-faceted human beings.⁴¹ For these reasons, both the American Psychological Association (APA) and American Sociological Association (ASA) have publicly supported ending the use of Native American mascots.⁴² In particular, the APA noted that Native American mascots

[establish] an unwelcome and often times hostile learning environment for American Indian students that affirms negative images/stereotypes that are promoted in mainstream society . . . [Mascots] appea[r] to have a negative impact on the self-esteem of American Indian children . . . [and] undermin[e] the ability of American Indian Nations to portray accurate and respectful images of their culture, spirituality, and traditions.⁴³

³⁷ *Id.* at 209.

³⁸ *Id.* at 209–10.

³⁹ *Id.* at 210.

⁴⁰ Latterell, *supra* note 29, at 1148.

⁴¹ Wallace, *supra* note 35, at 207.

⁴² *APA Resolution Recommending the Immediate Retirement of American Indian Mascots, Symbols, Images, and Personalities by Schools, Colleges, Universities, Athletic Teams, and Organizations*, AM. PSYCHOLOGICAL ASS’N (2005), <http://www.apa.org/ABOUT/POLICY/MASCOTS.PDF>; *Statement by the Council of the American Sociological Association on Discontinuing the Use of Native American Nicknames, Logos, and Mascots in Sport*, AM. SOCIOLOGICAL ASS’N (Mar. 6, 2007), http://www.asanet.org/ABOUT/COUNCIL_STATEMENTS/USE_OF_NATIVE_AMERICAN_NICKNAMES_LOGOS_AND_MASCOTS.CFM.

⁴³ AM. PSYCHOLOGICAL ASS’N, *supra* note 42.

C. DISPARAGING TRADEMARKS: EXAMPLES

The TTAB has used the disparaging two-part test in a variety of cases involving disparaging trademarks. For example, in 2006, the TTAB investigated whether the “Squaw” or “Squaw One” mark on clothing, ski equipment, and stores was disparaging.⁴⁴ As an answer to the first question under the disparaging test, determining what the likely meaning of the matter in question is, the TTAB held that the meaning of the mark was an American Indian woman or wife.⁴⁵ In answer to the second question, whether the meaning is disparaging to the referenced group, the TTAB determined that this meaning *was*, in fact, disparaging.⁴⁶ However, the TTAB held that the mark would be appropriate when used for ski equipment or other ski-related goods, because “Squaw” is an abbreviation for ski resorts in Squaw Valley.⁴⁷ Therefore, the likely meaning of the term “Squaw” in relation to ski goods led the trademark to be upheld because the mark referenced Squaw Valley ski resorts, not Native Americans.⁴⁸

In another case, the TTAB held that the wine mark “Khoran” was disparaging under the two-part test.⁴⁹ First, the word would be perceived as a variation or misspelling of the Koran; second, the mark “would be disparaging to followers of Islam and their beliefs” because drinking alcohol is prohibited by the Koran.⁵⁰

A more recognized trademark example is Aunt Jemima’s pancake mixes, syrups, and flour. After seeing two comedians perform in a blackface minstrel show and sing a song about Aunt Jemima, the brand creators decided to use Aunt Jemima as their logo.⁵¹ Dressed in quintessential slave attire with a handkerchief on her head, Aunt Jemima spoke with mangled English.⁵² African Americans resented her as a reference to slavery and specifically found her handkerchief to be a

⁴⁴ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 1266 (T.T.A.B. May 23, 2006).

⁴⁵ *Id.* at 1267.

⁴⁶ *Id.* at 1277.

⁴⁷ *Id.*

⁴⁸ *Id.* at 1279.

⁴⁹ *In re Lebanese Arak Corp.*, 94 U.S.P.Q.2d 1215 (T.T.A.B. Mar. 4, 2010).

⁵⁰ *Id.* at 1218–19.

⁵¹ *Aunt Jemima*, *ADVERTISING AGE* (Mar. 29, 1999), <http://adage.com/article/special-report-the-advertising-century/aunt-jemima/140176/>.

⁵² M.M. MANRING, *SLAVE IN A BOX: THE STRANGE CAREER OF AUNT JEMIMA* 157, 176 (University of Virginia Press, 1998), *available at* http://www.sjsu.edu/people/ruma.chopra/courses/h170_MW_F12_9am/s0/Wk16_C.pdf.

2015]

THE WASHINGTON REDSKINS

47

“symbol of servitude and ignorance.”⁵³

Public diatribe against the trademark caused Quaker Oats to makeover Aunt Jemima without actual action through the TTAB.⁵⁴ Aunt Jemima is now a housewife, without slave attire, and wears a pair of earrings.⁵⁵ However, considering the two-part test in case law as well as difficulties experienced by the District Court and Court of Appeals in their *Harjo v. Pro-Football, Inc.* decisions, it is unclear whether a TTAB holding that Aunt Jemima is disparaging would be held up in court today.⁵⁶ Thus, Aunt Jemima’s makeover shows the possibility for change without engaging in the legal system.

III. THE WASHINGTON REDSKINS: *HARJO* AND *BLACKHORSE*

A. THE WASHINGTON REDSKINS: *HARJO V. PRO-FOOTBALL, INC.*

In 1994, a group of Native Americans brought a complaint to the TTAB to cancel the Washington Redskins trademark due to its disparaging nature, which will be referred to as *Harjo I*.⁵⁷ In response, Pro-Football, Inc., the owner of the Washington Redskins, aimed to provide evidence that would pass the TTAB’s two-part test.⁵⁸ First, Pro-Football, Inc. contended that the meaning of “redskins” was not disparaging towards Native Americans as the term had acquired secondary meaning purely in reference to the football team.⁵⁹ Second, due to this secondary meaning, Pro-Football, Inc. believed that Native Americans would not suffer any harm from the mark.⁶⁰ Pro-Football, Inc. also used the laches defense,⁶¹ which “bars relief to those who delay the assertion of their claims for an unreasonable time” and would thus block the plaintiff’s claim.⁶²

In response to the laches defense, TTAB remarked that it was a

⁵³ *Id.* at 157.

⁵⁴ Regan Smith, *Trademark Law and Free Speech: Protection for Scandalous and Disparaging Marks*, 42 HARV. C.R.-C.L. L. REV. 451, 463 (2007).

⁵⁵ Manring, *supra* note 52, at 172.

⁵⁶ Smith, *supra* note 54.

⁵⁷ *Harjo v. Pro Football, Inc. (Harjo I)*, 30 U.S.P.Q.2d 1828, 1829 (T.T.A.B. Mar. 11, 1994).

⁵⁸ *Id.* at 1830.

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ *Id.*

⁶² *Pro-Football, Inc. v. Harjo (Harjo II)*, 2000 U.S. Dist. LEXIS 19792, *15 (D.D.C. Dec. 11, 2000).

“question of first impression.”⁶³ The TTAB found that the laches defense was not available for cases of fraud, abandonment, descriptive or deceptive trademarks, and marks not controlled by the owner, since these matters include a public policy interest.⁶⁴ The TTAB found that due to the public interest inherent in the *Harjo I* case, “where a trial might show that respondent’s marks hold a substantial segment of the population up to public ridicule,” this defense was not available.⁶⁵

Employing the two-part test, TTAB held that whether a disparaging meaning exists is “determined . . . at the time these registrations [were] issued.”⁶⁶ The Washington Redskins registered their mark in 1967 and registered other marks and logos up to 1990.⁶⁷ Thus, the TTAB would look at the period from 1967 to 1990.⁶⁸

Based on the following evidence, the TTAB decided the trademark was disparaging and canceled it in *Harjo I*.⁶⁹ In its analysis, the Board first looked at the meaning of “redskins” at the time of registration.⁷⁰ Plaintiff Harjo’s argument was that

in the 1930s, government policies towards Native Americans began to be more respectful of Native American culture . . . however, these policies were not reflected in the activities and attitudes of the general public, who continued to view and portray Native Americans as “simple ‘savages’ whose culture was treated mainly as a source of amusement for white culture”; and . . . it was during this time that respondent first adopted the name “Redskins” for its football team.⁷¹

In documentation tracking the first written uses of the term, it was only used in “informal writings as a slur of the most demeaning sort and as an epithet.”⁷² The word also appeared most often “in the context of savagery, violence and oppression.”⁷³ Consequently, the Native American mascot was used to “‘strike fear into the hearts of opponents’ . . . to ‘evoke the

⁶³ *Id.*

⁶⁴ *Harjo I*, 30 U.S.P.Q.2d at 1831.

⁶⁵ *Id.*

⁶⁶ *Id.* at 1832.

⁶⁷ *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705, 1741 (T.T.A.B. Apr. 2, 1999).

⁶⁸ *Id.*

⁶⁹ *Id.* at 1748.

⁷⁰ *Id.* at 1719.

⁷¹ *Id.*

⁷² *Id.*

⁷³ *Id.*

2015]

THE WASHINGTON REDSKINS

49

sense of an implacable and ferocious foe.”⁷⁴

A variety of petitioners and experts testified to the disparaging nature of the term.⁷⁵ The seven Native American petitioners attested to instances where “redskins” was used in a derogatory manner towards them.⁷⁶ A historical expert, Dr. Frederick Hoxie, noted that Americans viewed Native Americans as fundamentally inferior and that the term “redskin” was “an artifact of the earlier period during which the public at large was taught to believe that American Indians were a backward and uncivilized people.”⁷⁷

Meanwhile, Pro-Football, Inc. argued that the term was neutral and has acquired a secondary, non-disparaging meaning in reference to the sports team.⁷⁸ The violent nature of the word reflects “the troubled history of American Indians” as opposed to the troubling nature of the word itself.⁷⁹ To bolster their argument, many linguistic experts stated that most dictionary entries for the term do not include the disparaging meaning, and those dictionaries that did include the disparaging meaning made a mistake.⁸⁰ Additionally, Pro-Football, Inc. claimed that the term is merely another way to reference Native Americans.⁸¹

A survey of the general United States population and Native American population showed mixed results for the offensive nature of the term.⁸² On a spectrum, 2 percent for the general population and 2.8 percent offensive for the Native American population believed that “Native American” was offensive, making this term the least offensive.⁸³ Next, in order from least offensive to most offensive, were “Indian,” “Brave,” “Buck,” and “Squaw” for both populations.⁸⁴ “Redskin” was the second-most offensive term to both groups, sampling at 46.2 percent offensive for the general population and 36.6 percent offensive for the Native American population.⁸⁵ “Injun” was the most offensive term to both groups,

⁷⁴ *Id.*

⁷⁵ *Id.* at 1723.

⁷⁶ *Id.*

⁷⁷ *Id.* at 1725.

⁷⁸ *Id.* at 1708.

⁷⁹ *Id.* at 1721.

⁸⁰ *Id.* at 1730.

⁸¹ *Id.*

⁸² *Id.* at 1733.

⁸³ *Id.*

⁸⁴ *Id.*

⁸⁵ *Id.*

sampling at 49.5 percent offensive for the general population and 50.6% offensive for the Native American population.⁸⁶ Pro-Football, Inc. rebutted this survey with the testimony of Jacob Jacoby, an expert in the area of marketing and trademark surveys. Jacoby explained that the survey had less than a 50 percent response rate, indicating a poorly conducted and non-representative survey.⁸⁷

In its analysis, the TTAB considered the time period from 1967 to 1990, which included the registered mark “The Redskins” in 1967, as well as other related marks and logos registered up to 1990.⁸⁸ On the first question in the two-part test concerning the meaning of “redskin,” the TTAB gave credit to both parties’ arguments concerning the meaning of “redskin.”⁸⁹ While the TTAB disagreed with the respondent’s assertion that the term “is a purely denotative term of reference for the professional football team with no connotative meaning whatsoever,”⁹⁰ it held that a substantial amount of evidence indicated the term has also referred to the football team since the 1960s.⁹¹ Still, by looking at the logo that includes a Native American’s profile with a spear, the TTAB found that the meaning of the term, even in the football context, carries an allusion to Native Americans.⁹²

The TTAB then considered the second question in the disparaging two-part test: whether the meaning is disparaging to Native Americans.⁹³ Based on a “cumulative effect of the entire record,” the TTAB found that the term “redskins” is disparaging to Native Americans.⁹⁴ The TTAB found the general public’s responses and the Native American’s perceptions to be probative.⁹⁵ For example, since a substantial amount of the general public thought the word was derogatory, “in the absence of evidence to the contrary, it is reasonable to infer that a substantial composite of Native Americans would similarly perceive the word” to be disparaging.⁹⁶ The TTAB based its decision on evidence that showed that

⁸⁶ *Id.*

⁸⁷ *Id.* at 1733–34.

⁸⁸ *Id.* at 1741.

⁸⁹ *Id.* at 1741–42.

⁹⁰ *Id.* at 1741.

⁹¹ *Id.*

⁹² *Id.* at 1742.

⁹³ *Id.*

⁹⁴ *Id.* at 1743.

⁹⁵ *Id.*

⁹⁶ *Id.* at 1744.

2015]

THE WASHINGTON REDSKINS

51

“half of the dictionaries at any point in the time period covered” had offensive usage labels.⁹⁷ Rare use of the term in historical documents from the 1950s onwards also convinced the TTAB of the disparaging nature of the term, regardless of whether, as Pro-Football, Inc. argued, the negative nature of the term was just due to “overall negative viewpoints of the writings.”⁹⁸ In terms of the survey, the TTAB held that even if it was a small sample, a substantial amount of the general and Native American populations found the term to be offensive.⁹⁹ Lastly, even though the Washington Redskins “is not responsible for the actions of the media or fans,” the fact that these groups portray Native Americans insensitively, is “probative of the general public’s perception of the word ‘redskins.’”¹⁰⁰

Pro-Football, Inc. then appealed to the United States District Court in *Harjo II*.¹⁰¹ The court allowed the case to go to trial because, among other reasons, the defense of laches may have been available.¹⁰² Pro-Football, Inc. argued that laches would have been available if Native Americans delayed substantially before challenging the trademark, if Native Americans were aware of the trademark during this period of delay, and if Pro-Football, Inc.’s “development of goodwill during the period of delay” created an interest in preserving their trademark.¹⁰³ The court answered these three questions in the affirmative.¹⁰⁴ Additionally, the court found that the Lanham Act stated that if laches could be applicable, it should be considered and applied.¹⁰⁵

At trial, the court held that there was insufficient evidence of disparagement of Native Americans during the relevant time period and thus the claim failed the second question in the disparagement two-part test.¹⁰⁶ The court found that the TTAB based its decision mainly on linguistic and survey testimony.¹⁰⁷ The linguistic testimony supported a finding of disparagement.¹⁰⁸ However, due to the fact that the survey

⁹⁷ *Id.*

⁹⁸ *Id.* at 1745.

⁹⁹ *Id.* at 1746.

¹⁰⁰ *Id.* at 1747.

¹⁰¹ *Harjo II*, 2000 U.S. Dist. LEXIS 19792 (D.D.C. Dec. 11, 2000).

¹⁰² *Id.* at *22.

¹⁰³ *Id.* at *16–17.

¹⁰⁴ *Id.* at *17.

¹⁰⁵ *Id.* at *17–18.

¹⁰⁶ *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 113 (D.D.C. 2003).

¹⁰⁷ *Id.* at 119.

¹⁰⁸ *Id.*

testimony showed mainly present-day attitudes and inferred that opinions of a group of Native Americans would apply to the entire group, the court was not convinced that the term was disparaging to Native Americans at the time of registration.¹⁰⁹ Additionally, the court held that the TTAB should only have looked to the views of Native Americans and not those of the general population.¹¹⁰

In response to the laches defense, the court held that it was available to Pro-Football, Inc. even if a public interest was implicated.¹¹¹ If Pro-Football, Inc.'s trademark could be cancelled at any time, the court believed that this "would seriously undermine the entire policy of seeking trademark protection in the first place."¹¹² Thus, in the three-part test for laches, the court held that Harjo had substantially delayed by waiting over twenty-five years, had notice on twelve occasions when the "six marks were each published and registered," and economic prejudice would arise since Pro-Football, Inc. "invested heavily in . . . and develop[ed]" the mark for years.¹¹³

After this holding, Harjo appealed to the United States Court of Appeals in *Harjo III*.¹¹⁴ Harjo's primary argument against laches was that the prior court had assessed laches in 1967, "for *all* seven Native Americans, even though one . . . was at that time only one year old."¹¹⁵ The court held that laches should only run when the bringer of the claim comes of age.¹¹⁶ Although Pro-Football, Inc. argued that the purpose of trademark would be defeated because "trademark owners could never have certainty, since a disparagement claim could be brought by an as yet unborn claimant," the court held that this is a consequence of the decision to not set a statute of limitations in the Lanham Act.¹¹⁷ Thus, the court remanded so the lower court could evaluate the one claim of the one-year-old Native American, Romero, at the time of registration.¹¹⁸

The lower court decided that Romero's claim was still barred under

¹⁰⁹ *Id.* at 119–20, 125.

¹¹⁰ *Id.* at 128–29.

¹¹¹ *Id.* at 144.

¹¹² *Id.* at 139.

¹¹³ *Id.* at 139, 140–41, 143.

¹¹⁴ *Pro-Football, Inc. v. Harjo (Harjo III)*, 415 F.3d 44 (D.C. Cir. 2005).

¹¹⁵ *Id.* at 48.

¹¹⁶ *Id.*

¹¹⁷ *Id.* at 49.

¹¹⁸ *Id.* at 50.

2015]

THE WASHINGTON REDSKINS

53

the defense of laches in *Harjo IV*.¹¹⁹ This is because Romero waited almost nine years after coming of age before trying to cancel the trademark.¹²⁰ Romero was also aware of the mark as a child, before he came of age, further reinforcing the argument that he delayed his claim.¹²¹ Additionally, Pro-Football, Inc. demonstrated sufficient prejudice through the delay.¹²² They established trial prejudice due to the fact that the president of the Redskins from 1965 to 1980 died while Romero waited to bring the case to trial and the fact that it was harder to collect evidence as time passed.¹²³ They also established economic prejudice by their continued investment in the mark.¹²⁴ Ultimately, the Court of Appeals affirmed the District Court's findings in *Harjo V*.¹²⁵

B. THE WASHINGTON REDSKINS: *BLACKHORSE V. PRO-FOOTBALL, INC.*

A new group of Native Americans made a claim against Pro-Football, Inc. while the overall *Harjo* Case was still in litigation.¹²⁶ The TTAB went on to use the same disparaging two-part test.¹²⁷ In regards to the first question, the parties agreed that “redskins” could be used to refer to Native Americans or to the football team.¹²⁸ As established in *Harjo I*, the TTAB concluded that the term still “carries the allusion to Native Americans.”¹²⁹ The TTAB looked at previous cases like those referenced above, including the “Khoran” case, where “an innocuous term” was made “into a disparaging one,” and the “Squaw” case, where the disparaging meaning was stripped from a term based on the context of ski goods.¹³⁰ The TTAB found that “redskins” was like “Squaw” in a non-ski related context, holding that the term was disparaging and “the goods and services did not change the meaning.”¹³¹ In other words, the secondary meaning of the term in relation to the football context did not take away the

¹¹⁹ Pro-Football, Inc. v. Harjo (*Harjo IV*), 567 F. Supp. 2d 46, 62 (D.D.C. 2008).

¹²⁰ *Id.* at 53–54.

¹²¹ *Id.* at 56.

¹²² *Id.*

¹²³ *Id.* at 56–57.

¹²⁴ *Id.* at 62.

¹²⁵ Pro Football, Inc. v. Harjo (*Harjo V*), 565 F.3d 880, 886 (D.C. Cir. 2009).

¹²⁶ Blackhorse v. Pro-Football, Inc., 111 U.S.P.Q.2d 1080, 1084 (T.T.A.B. June 18, 2014).

¹²⁷ *Id.* at 1087–88.

¹²⁸ *Id.* at 1088.

¹²⁹ *Id.*

¹³⁰ *Id.* at 1089.

¹³¹ *Id.*

disparaging meaning.¹³²

The TTAB mainly focused on the second question of the two-part analysis.¹³³ To answer the question, the TTAB considered a group statement and individual testimony of past views.¹³⁴ The group statement included a 1993 Resolution by the National Congress of American Indians stating that “redskin” was never a term of “honor or respect, but instead, it has always been and continues to be a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging and racist designation.”¹³⁵ Another group statement was a 1972 letter by the Director of Indian Legal Information Department Service to the part owner and president of the Washington Redskins, Edward Bennett Williams, asking the team to change its name because “it was disparaging, insulting and degrading to American Indians.”¹³⁶ This letter led to a meeting with Williams in 1972 with seven Native Americans.¹³⁷ The Native Americans were representatives of various Native American groups including the National Congress of American Indians (NCAI) and American Indian Movement (AMI), among others.¹³⁸ These groups occupy important leadership roles in the Native American community; for example, NCAI is “the oldest and largest national Indian group in the U.S” and represents 150 tribal governments while AMI is “the foremost advocacy organization representing and defending the spiritual, cultural, and political and treaty rights” of Native Americans.¹³⁹

Individual testimony included letters from various petitioners.¹⁴⁰ One such excerpt read:

To live up to your name, your team would field only two men to the opponents eleven. Your player’s wives would be required to face the men of the opposing team. After having lost every game in good faith, you would be required to remain in RFK stadium’s end zone for the rest of your life living off what the other teams had left you. (Which wouldn’t be much.) Since you would probably find this as distasteful as 300,000 Indians do, I would suggest a change in name. In sticking to

¹³² *Id.* at 1091.

¹³³ *Id.* at 1089.

¹³⁴ *Id.* at 1099.

¹³⁵ *Id.* at 1098, 1107.

¹³⁶ *Id.* at 1099.

¹³⁷ *Id.* at 1100.

¹³⁸ *Id.*

¹³⁹ *Id.* at 1101–02.

¹⁴⁰ *Id.* at 1102.

your ethnic theme, I would suggest the Washington Niggers as a start . . . This would start a fantastic trend in the league. We would soon be blessed with the San Francisco [sic] Chinks, New York Jews, Dallas Wetbacks, Houston Greasers, and the Green Bay Crackers. Great, huh? Mr. Williams, these would be very offensive to many people, just as Redskins is offensive to myself and others. You can take a stand that would show you and the team as true believers in civil rights, or you can continue to carry a name that keeps alive a threatening stereotype to Indian people.¹⁴¹

On the other hand, Pro-Football, Inc. included testimony to the contrary.¹⁴² For example, the Chief of the Choctaw Nation stated, “Sports teams traditionally adopt a namesake and image which they perceive as noble and powerful. The Washington Redskins is a team . . . that Indian people can be proud to be identified with.”¹⁴³ However, since statements between 1967 and 1990 showed that a substantial amount of Native Americans thought the term was disparaging, the TTAB found that the mark was disparaging to Native Americans.¹⁴⁴ Thus, the TTAB held that the mark should be cancelled.¹⁴⁵

Addressing the laches defense, the TTAB held that it “does not apply to a disparagement claim where the disparagement pertains to a group of which the individual plaintiff or plaintiffs simply comprise one or more members.”¹⁴⁶ This is because laches includes a balancing of prejudice to the defendant, and it is difficult to justify balancing “financial interest . . . against human dignity.”¹⁴⁷ To allow the laches defense would do away with the whole function of prohibiting disparaging trademarks, as after a certain time period, the mark could not be challenged.¹⁴⁸ Therefore, when there is a “broader public policy concern at issue,” laches does not apply.¹⁴⁹

¹⁴¹ *Id.* at 1103.

¹⁴² *Id.* at 1104.

¹⁴³ *Id.* at 1105.

¹⁴⁴ *Id.* at 1111.

¹⁴⁵ *Id.* at 1111–12.

¹⁴⁶ *Id.* at 1112.

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ *Id.* at 1113.

C. THE WASHINGTON REDSKINS: DIFFERING STANDARDS OF THE TTAB
AND THE COURT

The TTAB in *Harjo I* and *Blackhorse* and the court in *Harjo II* differed in their standards of judging the second question in the disparaging two-part test.¹⁵⁰ In *Harjo I*, the TTAB looked to the general public and Native American's perceptions to answer the second question in the disparaging two-part test.¹⁵¹ In contrast, the court in *Harjo II* felt that the TTAB should narrow their perception to that of Native Americans during the relevant time period, as Native Americans are the impacted group.¹⁵² In *Blackhorse*, the TTAB narrowed their evaluation to Native Americans' opinions only.¹⁵³ Thus, in the end, evaluations by the TTAB and the court are similar as of 2014.

In determining the availability of the laches defense, the TTAB and the court differed on whether or not it could be used.¹⁵⁴ In *Harjo I*, the TTAB denied the defense due to the public interest at stake in the case.¹⁵⁵ However, the courts in *Harjo II, IV, and V* held that the laches defense was available and was valid in dismissing the case because allowing a mark to be cancelled at any point in time was counterintuitive to the general point of trademark protection.¹⁵⁶ As long as the court evaluated the claim when all of the plaintiffs came of age, laches was available.¹⁵⁷ In contrast, the TTAB held once again in *Blackhorse* that laches does not apply when a public policy interest is at issue.¹⁵⁸ The TTAB found that allowing the laches defense would actually be counterintuitive to the purpose of trademarks because it would allow disparaging trademarks to exist as long as a substantial amount of time had passed.¹⁵⁹

¹⁵⁰ *Id.*; *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705, 1743 (T.T.A.B. Apr. 2, 1999); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 113 (D.D.C. 2003).

¹⁵¹ *Harjo v. Pro Football Inc.*, 50 U.S.P.Q.2d at 1743.

¹⁵² *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d at 113, 128–29.

¹⁵³ *Blackhorse*, 111 U.S.P.Q.2d at 1111.

¹⁵⁴ *Id.*; *Harjo I*, 30 U.S.P.Q.2d 1828, 1831 (T.T.A.B. Mar. 11, 1994); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d at 144.

¹⁵⁵ *Harjo I*, 30 U.S.P.Q.2d 1828, 1831 (T.T.A.B. Mar. 11, 1994).

¹⁵⁶ *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d at 137, 139, 144.

¹⁵⁷ *Harjo III*, 415 F.3d 44, 48 (D.C. Cir. 2005).

¹⁵⁸ *Blackhorse*, 111 U.S.P.Q.2d at 1113.

¹⁵⁹ *Id.* at 1112.

IV. VARYING STANDARDS: CRITICISM AND POLICY

A. VARYING STANDARDS: CRITICISM

Since the TTAB in *Harjo I* and the court in *Harjo II* came to opposite conclusions based on the same information, the disparaging trademark standard remains unclear.¹⁶⁰ With the *Blackhorse* decision, the TTAB was able to clarify and make the disparaging two part-test similar to that used by the court.¹⁶¹ However, even considering *Blackhorse*, whether laches can be used as a defense under trademark law in court remains to be seen since the TTAB has consistently ruled against it while the court held it to be viable in *Harjo II, IV, and V* and did not rule on it in *Blackhorse*.¹⁶²

Some feel that the entire disparaging two-part test is unclear. For example, for the first question in the two-part test, perhaps some words are offensive regardless of the context, and thus as to the second question, offensive to a respective group in every situation.¹⁶³ Therefore, there could be a database of per se disparaging terms.¹⁶⁴ Although there could be issues with determining a list of disparaging terms, some people argue that “making these determinations is more straightforward than the complicated and nuanced analysis that currently occurs when jurists attempts to go beyond a word’s plain meaning and interpret listeners’ contexts.”¹⁶⁵

Within this per se disparaging terms list, some aspect of context would still be evaluated through their plain meaning.¹⁶⁶ For example, the plain meaning of “redskin potatoes” does not raise an issue.¹⁶⁷ Yet, if the term “redskins” alone was used even in the context of redskin potatoes, the per se disparaging term bar would block the use of the term.¹⁶⁸

Additionally, critics argue that the per se disparaging nature of the

¹⁶⁰ *Harjo V*, 565 F.3d 880, 886 (D.C. Cir. 2009); *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705, 1743 (T.T.A.B. Apr. 2, 1999).

¹⁶¹ *Blackhorse*, 111 U.S.P.Q.2d at 1111.

¹⁶² *Id.*; *Harjo I*, 30 U.S.P.Q.2d 1828, 1831 (T.T.A.B. Mar. 11, 1994); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 144 (D.D.C. 2003).

¹⁶³ Christine Haight Farley, *A Review of Recent Decisions of the United States Court of Appeals for the Federal Circuit: Article: Stabilizing Morality in Trademark Law*, 63 AM. U. L. REV. 1019, 1040 (2014).

¹⁶⁴ *Id.* at 1030, 1032.

¹⁶⁵ *Id.* at 1033.

¹⁶⁶ *Id.* at 1039–40.

¹⁶⁷ *Id.* at 1040.

¹⁶⁸ *Id.*

term in question should be evaluated in today's context as "a USPTO examining attorney . . . need not be a linguistic historian" and the issue is whether the meaning offends the contemporary public.¹⁶⁹ This method of evaluation could do away with any laches issues since plaintiffs would not delay in bringing a trademark lawsuit if the date of evaluation for when they should have brought the suit was not when the trademark was registered and instead in modern day.¹⁷⁰ Since the current issue where the TTAB and the court stand divided is laches, consensus on laches would be helpful.¹⁷¹

Yet another critique of the disparaging trademark process is that it only prevents registration of the mark.¹⁷² Thus, "what the [Lanham] Act attempts to avoid—having matter in the marketplace that would offend or harm people—does nothing more than prevent the owner of that mark from being able to use the federal trademark symbol in connection with the offending mark."¹⁷³ Common law protection of the mark may still apply in certain geographic locations, and the mark may still use the "TM" symbol to dissuade others from selling merchandise.¹⁷⁴

B. VARYING STANDARDS: POLICY

The primary current policy issue is whether or not laches may be used as a defense.¹⁷⁵ In *Harjo II, IV, and V*, the court valued the economic concerns of prejudice to Pro-Football, Inc. in spending money in registering and maintaining a trademark, only for the trademark to be deemed disparaging and cancelled at any time by those who could bring the suit earlier.¹⁷⁶ However, *Blackhorse* showed that trademark owners would still not have certainty of their mark because younger plaintiffs,

¹⁶⁹ *Id.* at 1043.

¹⁷⁰ *Id.* at 1044.

¹⁷¹ *Blackhorse v. Pro-Football Inc.*, 111 U.S.P.Q.2d 1080, 1112 (T.T.A.B. June 18, 2014); *Harjo I*, 30 U.S.P.Q.2d 1828, 1831 (T.T.A.B. Mar. 11, 1994); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 144 (D.D.C. 2003).

¹⁷² Amanda E. Compton, *N.I.G.G.A., Slumdog, Dyke, Jap, and Heeb: Reconsidering Disparaging Trademarks in a Post-Racial Era*, SELECTED WORKS 1, 14 (2014), http://works.bepress.com/amanda_compton/2/.

¹⁷³ *Id.* at 14.

¹⁷⁴ *Id.* at 28.

¹⁷⁵ *Blackhorse*, 111 U.S.P.Q.2d at 1112; *Harjo I*, 30 U.S.P.Q.2d at 1831; *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 144 (D.D.C. 2003).

¹⁷⁶ *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d at 137, 139.

2015]

THE WASHINGTON REDSKINS

59

unbarred by laches, could still bring suit.¹⁷⁷ In other words, “why should laches bar *all* Native Americans from challenging Pro-Football’s “Redskins” trademark registrations because *some* Native Americans may have slept on their rights?”¹⁷⁸ The court held that laches would not bar all plaintiffs, as this is a consequence of the decision to not set a statute of limitations in the Lanham Act.¹⁷⁹ Thus, there is a way to get around laches in court.

In contrast, the TTAB is more concerned with the public policy interest and thus does not allow the defense of laches in any case.¹⁸⁰ The public policy interest is “preventing the disparagement of—and possibly the commercial discrimination and racism against—even a small segment of the U.S. population” which the TTAB found to be “a much loftier public interest than preventing consumer confusion over commonplace commercial goods.”¹⁸¹

V. BRINGING IT ALL TOGETHER: CASE STUDY OF DARKIE/DARLIE TOOTHPASTE

A. BACKGROUND OF DARKIE/DARLIE TOOTHPASTE

Around 1933, the CEO of Hawley & Hazel Chemical Company saw Al Jolson perform blackface in the United States and thought “Jolson’s wide smile and bright teeth would make an excellent toothpaste logo.”¹⁸² By 1933, Hawley & Hazel created Darkie toothpaste in Shanghai, China, and the brand expanded to be sold in Hong Kong and Taiwan.¹⁸³ “Darky” or “darkie” is an offensive term referring to African Americans in the United Kingdom and the United States.¹⁸⁴ The Darkie toothpaste logo was a smiling African American man wearing a bowtie and top hat.¹⁸⁵

In 1985, Colgate-Palmolive acquired a 50 percent interest in Hawley

¹⁷⁷ *Harjo III*, 415 F.3d 44, 49 (D.C. Cir. 2005).

¹⁷⁸ *Id.*

¹⁷⁹ *Id.*

¹⁸⁰ *Blackhorse*, 111 U.S.P.Q.2d at 1112; *Harjo I*, 30 U.S.P.Q.2d at 1831.

¹⁸¹ Jessica M. Kiser, *Article: How Dykes on Bikes Got It Right: Procedural Inequities Inherent in the Trademark Office’s Review of Disparaging Trademarks*, 46 U.S.F. L. REV. 1, 29 (2011).

¹⁸² Isaac Stone Fish, *Back to the Days of Blackface*, NEWSWEEK (Nov. 30, 2010), <http://www.newsweek.com/2010/11/30/china-s-controversial-toothpaste.html>.

¹⁸³ *Darlie*, WIKIPEDIA (Aug. 11, 2014), <http://en.wikipedia.org/wiki/Darlie>.

¹⁸⁴ *Id.*

¹⁸⁵ *Id.*

& Hazel by paying \$50 million.¹⁸⁶ At first, Colgate did nothing to change the name or logo despite criticism.¹⁸⁷ The company “insisted the term Darkie was not derogatory in the countries where the toothpaste was sold” and that it would not sell the product in the United States “or any Western English-speaking nation.”¹⁸⁸ Colgate’s Director of Corporate Development insisted the logo was only meant to be a “compliment to Jolson, since according to Chinese custom, imitation is the highest form of flattery.”¹⁸⁹

After a shareholder resolution and the Interfaith Center on Corporate Responsibility (ICCR) protested the name and logo of the toothpaste, Colgate began to test alternatives to the name and logo in 1987.¹⁹⁰ The ICCR director insisted, “[T]he use of the term ‘darkie’ has always been a pejorative one. The graphic . . . is a caricature that could be construed as being a black person. It is stereotypical and offensive.”¹⁹¹ The executive director of ICCR added:

[A]s you know, the term “darkie” is deeply offensive. We would hope that in this new association with Hawley & Hazel Chemical Co. . . . immediate action will be taken to stop this product’s name so that a U.S. company will not be associated with promoting racial stereotypes in the Third World.¹⁹²

In 1988, Hawley & Hazel began selling toothpaste in Japan called Mouth Jazz, which had a similar logo to Darkie—that of a silhouetted minstrel.¹⁹³ The Colgate spokesman at the time said, “I don’t think it’s indicative of a minstrel at all. It’s a black-faced person wearing a top-hat.”¹⁹⁴ As of 2001, Mouth Jazz is still being sold but with a redesigned

¹⁸⁶ Kenneth L. Whiting, *Darkie Toothpaste Changes Name*, ASSOCIATED PRESS (Apr. 17, 1989), http://fiji4.ccs.neu.edu/~zerg/lemurcgi/ISU_data/TREC/cd-data/vol1/ap/ap890417.

¹⁸⁷ KERRY SEGRAVE, *AMERICA BRUSHES UP: THE USE AND MARKETING OF TOOTHPASTE AND TOOTHBRUSHES IN THE TWENTIETH CENTURY 196–97* (Jan. 27, 2010), available at <http://books.google.com/books?id=w9F5eTkLwcYC>.

¹⁸⁸ *Id.* at 197.

¹⁸⁹ *‘Darkie’ Toothpaste Puts Company in a Squeeze*, THE AFRO AMERICAN (Mar. 1, 1986), <http://news.google.com/newspapers?id=WComAAAAIIBAJ&sjid=WP4FAAAAIBAJ&pg=5164,643000&dq=darkie+toothpaste+china+malaysia+thailand&hl=en>.

¹⁹⁰ Segrave, *supra* note 187, at 197.

¹⁹¹ *Id.*

¹⁹² *‘Darkie’ Toothpaste Puts Company in a Squeeze*, *supra* note 189.

¹⁹³ Segrave, *supra* note 187, at 197.

¹⁹⁴ *Id.*

2015]

THE WASHINGTON REDSKINS

61

logo—a man with a half-black, half-white face, a bowtie, and top hat.¹⁹⁵

Finally, in 1989, Colgate decided to change the name of Darkie and redesign the logo to the same one now used for Mouth Jazz.¹⁹⁶ This marketing happened in two steps; the name changed first, and then the logo.¹⁹⁷ Colgate’s Chairman stated that the name Darkie is “just plain wrong. It’s just offensive. The morally right thing dictated that we must change [in a way] that is least damaging to the economic interests of our partners.”¹⁹⁸ Economic interests were at the forefront of the Chairman’s mind due to the fact that Darkie “held 75 percent of the toothpaste market in Taiwan, 50 percent in Singapore, 30 percent in Malaysia and Hong Kong, and 20 percent in Thailand.”¹⁹⁹

Even after the English name change to Darlie toothpaste, the Chinese name of the product still remains “Black People Toothpaste.”²⁰⁰ Advertisements in Chinese tell consumers “black person toothpaste is still black person toothpaste.”²⁰¹ After Hawley & Hazel trademarked the name “Black Person Toothpaste” and the new logo, it sued two other Chinese companies for marketing toothpastes with a similar logo and the name “Black People.”²⁰² Colgate’s main argument is that “Black Person Toothpaste” is not considered offensive in Asia.²⁰³

However, it is questionable whether China is “a paradise of racial harmony.”²⁰⁴ In China, Africans face discrimination, and as a Ghanaian living in China explained, “a prospective employer told [me], ‘We can’t hire you because you’re black.’”²⁰⁵ This tension has been felt for decades. For example, in 1988 a mob of 300 people “broke into an African students’ dormitory at Nanjing University and destroyed their possessions

¹⁹⁵ Jerome F. Shapiro, “Mouth Jazz” Toothpaste, Aka “Darkie” Toothpaste and “Black Face” Toothpaste, ATOMIC BOMB CINEMA (2001), http://www.atomicbombcinema.com/english/image_gallery/art/art-16_detail.htm.

¹⁹⁶ *Darkie Drops Offensive Name and Logo*, STRAITS TIMES (Jan. 29, 1989), <http://www.mediafire.com/view/?2q4q1aikax00nnp>.

¹⁹⁷ Segrave, *supra* note 187, at 198.

¹⁹⁸ Fish, *supra* note 182.

¹⁹⁹ Whiting, *supra* note 186.

²⁰⁰ Fish, *supra* note 182.

²⁰¹ HKTVC Darlie 黑人牙膏 1990/20sec, YOUTUBE (Aug. 1, 2007), http://www.youtube.com/watch?feature=player_embedded&v=EM9C2esCG24.

²⁰² Fish, *supra* note 182.

²⁰³ “Darkie” Toothpaste Puts Company in a Squeeze, *supra* note 189.

²⁰⁴ Fish, *supra* note 182.

²⁰⁵ *Id.*

while chanting ‘down with the black devils.’”²⁰⁶ Although in 2012 the number of Africans living in Guangzhou, China hit 20,000 and undocumented immigrants may include as many as 200,000, most Chinese people “have little to no contact with them In the media, Africa is portrayed as a house of horrors, with a huge number of people dying from diseases, wars and extremely high crime rates.”²⁰⁷ Culturally, a dislike of darker skin is prevalent, and whitening cosmetic products are sold throughout Asia since “darker skin is associated with being a peasant [many people think] peasants are oafish and backwards”²⁰⁸

In 1992, China banned Darlie toothpaste because it was deemed derogatory, yet it is still sold in China.²⁰⁹ In fact, “Black Sister toothpaste” is also available in China, as well as a remedy for muscle pain called “n-word oil” with a logo that includes “a black man with a rag on his head, with the word ‘darkie’ written underneath his image, an Arab with a black beard, or no human logo at all” and a tanning product called also “n-word Oil.”²¹⁰

B. DARKIE/DARLIE TOOTHPASTE IN ASIA

What would be the result if we analyzed Darkie/Darlie toothpaste in Asia through the American trademark disparaging standard of the TTAB and the court? We must break the trademark down to answer the disparaging two-part test: 1) We must consider the meaning of the term and 2) We must ask whether that meaning is disparaging to the group of people referenced in the term.²¹¹ As of 2014, the disparaging two-part test is similar in both the TTAB and the court and only differs on the use of the laches defense.²¹²

For the first part of the test, we must ask: what is the meaning of the

²⁰⁶ Gabrielle Jaffe, *Tinted Prejudice in China*, CNN (July 24, 2012), <http://www.cnn.com/2012/07/24/world/asia/china-tinted-prejudice/>.

²⁰⁷ *Id.*

²⁰⁸ *Id.*

²⁰⁹ Jonathan Levitt, *N-word Products in China Are Commonplace*, THE GRIO (Oct. 8, 2011), <http://thegrio.com/2011/10/08/products-in-china-labeled-with-the-n-word/>; Alisa L. Mosley, *Colgate’s Distasteful Toothpaste*, THE MCGRAW HILL COMPANIES (2005), http://novellaqalive2.mhhe.com/sites/dl/free/007000000x/216468/briefintegrativeCase1_Colgate.pdf.

²¹⁰ Levitt, *supra* note 209.

²¹¹ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 1267 (T.T.A.B. May 23, 2006).

²¹² *Blackhorse v. Pro-Football Inc.*, 111 U.S.P.Q.2d 1080, 1112 (T.T.A.B. June 18, 2014); *Harjo I*, 30 U.S.P.Q.2d 1828, 1831 (T.T.A.B. Mar. 11, 1994); *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 144 (D.D.C. 2003).

term “Darkie” or “Black Person Toothpaste” as of 1933 or of the term “Darlie” as of 1989 in Asian countries where the toothpaste is sold?²¹³ We could look to dictionary definitions or historical information documenting the nature of the term in these Asian countries.²¹⁴ However, given that “Darkie” was based off a disparaging English term rather than a disparaging Chinese term, it may be difficult to find this kind of information.²¹⁵ “Black Person Toothpaste” is probably not disparaging in Chinese, and “Darlie,” a nonsensical term, is likely not disparaging without the English context of its predecessor Darkie toothpaste. Thus, as Colgate argued before changing the Darkie name, “Darkie,” “Black Person Toothpaste,” and “Darlie” would all likely pass the first question in the disparaging two-part test, as there are no disparaging meanings for those terms in Asia.²¹⁶

Passing the first question raises an important issue in today’s world. Since present day technology makes countries increasingly interconnected, inspiration based on other cultures is also increasingly possible. What if a product is named after another country’s disparaging term? This creates a roadblock within the disparaging two-part test, where an examiner would conceivably have to look into the translation of the term. In a melting pot like the United States, one could imagine this becoming a problem, where although the questioned term may not be offensive in English, it is offensive in another language.

For the second question, we would consider whether or not the term is disparaging to Africans living in Asian countries where the toothpaste is sold.²¹⁷ “Darkie” or “Black Person Toothpaste” is probably more offensive than “Darlie.” However, if “Darkie” or “Black Person Toothpaste” were shown to be offensive to Africans, would the suit be barred due to laches? The TTAB would not allow laches to be used because of public policy issues.²¹⁸ However, according to the court, laches would be available if this group of Africans substantially delayed before challenging the trademark, knew of the trademark during the delaying period, and if the defendant toothpaste company would be prejudiced by this delay.²¹⁹ Thus,

²¹³ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 1267 (T.T.A.B. May 23, 2006).

²¹⁴ *Harjo v. Pro-Football Inc.*, 50 U.S.P.Q.2d 1705, 1730 (T.T.A.B. Apr. 2, 1999).

²¹⁵ WIKIPEDIA, *supra* note 183.

²¹⁶ ‘Darkie’ Toothpaste Puts Company in a Squeeze, *supra* note 189.

²¹⁷ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 1267 (T.T.A.B. May 23, 2006).

²¹⁸ *Blackhorse*, 111 U.S.P.Q.2d 1080, 1112 (T.T.A.B. June 18, 2014); *Harjo I*, 30 U.S.P.Q.2d 1828, 1831 (T.T.A.B. Mar. 11, 1994).

²¹⁹ *Harjo II*, 2000 U.S. Dist. LEXIS 19792, *16–17 (D.D.C. Dec. 11, 2000).

we would then have to consider when the African plaintiffs moved to Asia, when they came to be aware of the toothpaste, and when they came of age.²²⁰ If the plaintiffs were of age and did delay a substantial amount of time, they would be barred from bringing the case.²²¹

Thus, for trademark holders on the defensive, we find two loopholes in the disparaging two-part test. Since we only look at the meaning of the term in the country where it is sold, trademark holders can base their term on foreign disparaging words. Most powerfully of all, laches can bar these types of suits.²²²

One proposed policy change would be to create a list of per se disparaging terms, including terms that are disparaging in other countries.²²³ This would solve the problem of immigrants being offended by a term which may be disparaging in their home country and which is being used in their new country. However, there would still remain the issue of laches, as well as the fact that cancellation does not preclude use, and thus the brand could still be used and sold in the market. People opposed to the trademark would hope that the trademark holder would lose so much money from negative publicity or others capitalizing on their mark that it would be more beneficial to change the name.

As discussed, trademarks can have a detrimental social effect on groups as they serve an important cultural role.²²⁴ Thus, the importance of protection from disparaging trademarks is crucial. Yet at the same time, we do not want to create a police state where many names are banned. If we look to the example of Darkie/Darlie toothpaste in the United States, perhaps it can shed more light on what policy changes should be made.

C. DARKIE/DARLIE TOOTHPASTE IN THE UNITED STATES

Would selling Darkie, Black Person Toothpaste, or Darlie in the United States raise the same issues as it would if it were sold in Asia? Once again, we should start at the disparaging two-part test.²²⁵ For the purposes of this hypothetical, we will assume that Colgate would try to sell Darkie, Black Person Toothpaste, or Darlie in 2014 and trademark the product in the United States.

²²⁰ *Id.*

²²¹ *Id.*

²²² *Id.* at *15.

²²³ Farley, *supra* note 163, at 1032.

²²⁴ Drescher, *supra* note 23, at 306.

²²⁵ *In re Squaw Valley Dev. Co.*, 80 U.S.P.Q.2d 1264, 1267 (T.T.A.B. May 23, 2006).

First, we should look to the meanings of the terms “Darkie,” “Black Person Toothpaste,” and “Darlie” in 2014.²²⁶ “Darkie” is an easy outcome—it is likely still disparaging in meaning as of 2014. However, since “Black Person Toothpaste” is printed in Chinese, could this be disparaging in meaning based on the translation into “Black Person Toothpaste?” This raises the issue discussed above of considering foreign terms. Finally, since “Darlie” is a nonsensical term, we would not have the issue of it being disparaging without the history of the mark.

For the second question in the disparaging two-part test, we would have to look to whether African Americans in the United States are offended by “Darkie,” “Black Person Toothpaste,” or “Darlie.”²²⁷ Again, “Darkie” is an easy case, and African Americans would likely answer in the affirmative. For “Black Person Toothpaste” written in Chinese on the toothpaste, it would again depend on whether the translation was included. Finally, African Americans would likely answer in the negative for “Darlie” unless the history of the toothpaste was considered. For this section, we would not have the issue of laches, unless African Americans delayed in bringing the suit after 2014.²²⁸

This case study brings to light the important issue of not being able to consider the trademark’s history. An example of this same issue is reflected in the case of Aunt Jemima’s pancake mix, which is a trademark based on a minstrel show.²²⁹ After hearing the minstrel show’s songs, the creators of Aunt Jemima used the name and likeness of the “Southern mammy” on their packaging.²³⁰ The creators of the product even “hired a former domestic to appear as Aunt Jemima at the 1893 World’s Fair in Chicago.”²³¹ However, the Aunt Jemima packaging was redesigned, and, because of the redesign, the Aunt Jemima trademark is not considered disparaging. Similar to the Aunt Jemima packaging redesign that cured the trademark from being disparaging, “Black Person Toothpaste” and “Darlie” would likely pass both questions in the two-part test, since we cannot take into account the mark’s history.

Therefore, again for trademark holders on the defensive, we find another loophole in the disparaging two-part test. Since the history of the

²²⁶ *Id.*

²²⁷ *Id.*

²²⁸ *Harjo II*, 2000 U.S. Dist. LEXIS 19792, *15 (D.D.C. Dec. 11, 2000).

²²⁹ LOVALERIE KING & RICHARD SCHUR, *AFRICAN AMERICAN CULTURE AND LEGAL DISCOURSE* 193 (2009).

²³⁰ *Id.* at 193.

²³¹ *Id.* at 194.

mark is not considered, trademarks can be cleverly reinvented to allow the brand to be sustained. In other words, a trademark with an offensive history can still be sold as long as the current name is changed.²³² A per se disparaging list of terms could solve this problem, but this list would have to consider the history of marks after marks are reinvented. Most of all, once again, we have to consider whether laches should be used.

The laches defense shows frightening possibilities. For example, Darkie could be sold in the United States if African Americans were judged to have delayed in bringing their case.²³³ Although we do not want to punish mark-holders who have followed protocol by registering and investing in their mark, the overall social harms of disparaging trademarks should not be ignored.

VI. CONCLUSION

In the future, trademark issues like those illustrated by Darkie/Darlie toothpaste will likely become more and more commonplace. As the world becomes more interconnected, companies will likely become more influenced by other cultures. Thus, the trademark disparaging standard will become more complicated as years go on. Additionally, the defense of laches is a very real and present issue. Like in *Harjo II, IV, and V*, Native Americans can be punished for not bringing suit sooner against a huge company like the Washington Redskins, and thus their suit may be barred. There are currently over 2,000 Native American mascots in the United States, likely with long histories where laches may be used against a minority with little bargaining power.²³⁴

At its core, laches becomes a question of whether we will protect groups from disparaging marks or value companies' financial investments. Washington Redskins owner and billionaire Dan Snyder argues that "Washington Redskins is more than a name we have called our football team for over eight decades. It is a symbol of everything we stand for: strength, courage, pride, and respect—the same values we know guide Native Americans and which are embedded throughout their rich history as the original Americans."²³⁵ But, as the second question in the

²³² 'Darkie' Toothpaste Puts Company in a Squeeze, *supra* note 189.

²³³ *Harjo II*, 2000 U.S. Dist. LEXIS 19792, at *15.

²³⁴ Munguia, *supra* note 2.

²³⁵ Steve Busfield, *Washington's NFL Owner Dan Snyder Defends Redskins Name in Letter to Fans*, THE GUARDIAN (Oct. 9, 2013), <http://www.theguardian.com/sport/2013/oct/09/>

2015]

THE WASHINGTON REDSKINS

67

disparagement two-part test reflects, it is difficult to make this argument when Native Americans themselves find the term disparaging. Allowing a term that effectively means a dead Native American used for bounty to be protected through the loophole of laches is entirely counterintuitive to the Lanham Act.²³⁶

washington-redskins-nfl-dan-snyder-letter; *Daniel Snyder*, WIKIPEDIA (Nov. 26, 2014), http://en.wikipedia.org/wiki/Daniel_Snyder.

²³⁶ Holmes, *supra* note 6.