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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Amanda Blackhorse, Marcus Briggs, Phillip Gover, Shquanebin Lone-Bentley, Jillian Pappan, and Courtney Tsotigh
v.
Pro Football, Inc.

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Cancellation No. 92046185

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Jesse A. Witten of Drinker, Biddle & Reath LLP for Blackhorse, Briggs, *et. al.*

Robert L. Raskopf of Quinn Emanuel Urquhart & Sullivan, LLP for Pro-Football, Inc.

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By Marc A. Bergsman, Administrative Trademark Judge.

Pursuant to Trademark Rule 2.120(i)(2) and the Board's inherent authority to control its docket, the parties are ordered to appear before the Board for a pretrial conference the week of April 4, 2011.[1] This proceeding mirrors prior litigation before the Board of a disparagement claim under Section 2(a) of the Trademark Act of 1946, 15 U.S.C. §1052(a), *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB

[1] Trademark Rule 2.120(i)(2) provides that "the Board may, upon its own initiative … request that the parties or their attorneys, under circumstances which will not result in undue hardship for any party, meet with the Board at its offices for a pretrial conference."

1999), but brought by different plaintiffs. The pleadings in *Harjo* and in this cancellation proceeding are identical but for two additional affirmative defenses based on violations of respondent's constitutional right to "due process." Also, we note that counsel are the same. In *Harjo,* Judge Walters noted the following:

> [T]he parties have been extremely contentious, and the evidence and objections thereto are voluminous. Further, in their zeal to pursue their positions before the Board, it appears that the parties have continued to argue, through the briefing period and at the oral hearing, certain issues that have already been decided by the Board in this case. … Additionally, respondent has devoted a significant portion of its lengthy brief to its argument regarding the constitutionality of Section 2(a) of the Trademark Act [previously decided in 30 USPQ2d 1828].

Harjo v. Pro-Football, Inc., 50 USPQ2d at 1709. In order to litigate this proceeding as efficiently as possible, a pretrial conference will help the Board and the parties focus the evidence and arguments at trial.

During the pretrial conference and in a post conference order, the Board will (i) analyze, discuss and make rulings on the pleadings, specifically the affirmative defenses, (ii) discuss the applicable law for the disparagement claim and primary affirmative defenses, and (iii) discuss the parties' preparations for trial, including anticipated witnesses (fact and expert), reliance on prior testimony and

scheduling,[2] and (iv) direct the parties how to prepare an evidentiary appendix for their main briefs.

The parties are further advised that the Board will not entertain any motions for summary judgment in this proceeding.

Applicable Law

The applicable law as discussed in the Board's previous decision in *Harjo* and the decisions by the District of Columbia District Court and District of Columbia Circuit Court of Appeals is set forth below. We invite the parties to submit their edits, additions, suggestions, etc. in writing prior to the conference.[3]

A. Disparagement

1. Whether the REDSKINS trademarks "may disparage" Native Americans is a question of fact. *Pro-Football, Inc. v. Harjo,* 284 F.Supp.2d 96, 68 USPQ2d 1225, 1241 (D.D.C. 2003).

2. Petitioners are required to demonstrate by a preponderance of the evidence that the REDSKINS trademarks "may disparage" Native Americans or "bring them into

[2] The parties' submission of a joint stipulation regarding submission of evidence and certain discovery issues, filed March 14, 2011, is acknowledged.

[3] While we have invited the parties to submit written comments regarding the law applicable to the claims and defenses, we seek no comments regarding the sufficiency or propriety of the claims or affirmative defenses. They will be discussed at the hearing.

contempt, or disrepute." *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1245.

3. Trademarks may disparage if they may "dishonor by comparison with what is inferior, slight, deprecate, degrade, or affect or injure by unjust comparison." *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1247; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1738.

4. In deciding whether the matter may be disparaging we look, not to the American public as a whole, but to the views of the referenced group. The perceptions of the general public are irrelevant. *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1247; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1739.

5. The views of the referenced group are "reasonably determined by the views of a substantial composite thereof." *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1247; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1739.

6. To determine the referenced group, the Board will look to "the perceptions of 'those referred to, identified or implicated in some recognizable manner by the involved mark.'" *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1247; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1739.

7. The question of disparagement must be considered in relation to the goods or services identified by the mark in the context of the marketplace. *Pro-Football, Inc. v.*

Harjo, 68 USPQ2d at 1247; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1739.

8. The test for disparagement comprises a two-step inquiry:

a. What is the meaning of the matter in question, as it appears in the marks and as those marks are used in connection with the goods and services identified in the registrations?

b. Is the meaning of the marks one that may disparage Native Americans?

Pro-Football, Inc. v. Harjo, 68 USPQ2d at 1248; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d at 1740-41.

9. Both questions are to be answered as of the various dates of registration of the involved marks. *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1248; *Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705, 1735 and 1741 (TTAB 1999).

B. Laches

1. The doctrine of laches runs from the time a party has reached the age of majority. *Pro-Football, Inc. v. Harjo,* 415 F.3d 44, 75 USPQ2d 1525, 1528 (D.C. Cir. 2005).

2. The possibility that respondent may never have security in its registrations because prospective plaintiffs may arise on a regular basis, as they reach the age of majority, does not warrant abandonment of the principle that laches attaches only to those who unjustifiably delay in

bringing suit after reaching the age of majority. *Pro-Football, Inc. v. Harjo,* 75 USPQ2d at 1528.

3. When the petitioner in question has brought his/her own claim, there is no reason why the laches of others should be imputed to him/her. *Pro-Football, Inc. v. Harjo,* 75 USPQ2d at 1528.

4. Any particular petitioner's delay, and any resulting prejudice to respondent, both are properly measured based on the period between petitioner's attainment of the age of majority and the filing of cancellation petition. *Pro-Football, Inc. v. Harjo,* 75 USPQ2d at 1528.

5. Pro-Football's laches defense in this case is only available under the common law if (1) the plaintiff Native Americans delayed substantially before commencing their challenge to the "redskins" trademarks; (2) the plaintiff Native Americans were aware of the trademarks during the period of delay; and (3) Pro-Football's ongoing development of goodwill during the period of delay engendered a reliance interest in the preservation of the trademarks (*i.e.*, prejudice to respondent). *Pro-Football, Inc. v. Harjo,* 57 USPQ2d 1140, 1144 (D.D.C. 2000) and 284 F.Supp.2d 96, 68 USPQ2d 1225 (D.D.C. 2003).

6. Prejudice arising during a named plaintiff's period of delay may be prejudice at trial due to loss of evidence or memory of witnesses, and/or economic prejudice

based on loss of time or money or foregone opportunity. *Pro-Football, Inc. v. Harjo,* 68 USPQ2d at 1261.

Evidentiary Appendix

In anticipation of a voluminous record, we require the parties to prepare and file an appendix of the testimony and other evidence specifying (1) the probative value of particular items or testimony in the evidence and (2) where in the record such items or testimony may be found. The latter shall be accomplished by drawing the Board's attention to the particular evidentiary submission (*e.g.*, depositions and notices of reliance) and particular entry in TTABVue, the Board's electronic case file system, where the evidentiary items or testimony appear. The appendix will be attached to their main briefs. A sample appendix is attached. Additional discussion of the appendix, and means for preparation of it, will occur during the conference.

Appearance at the pretrial hearing

As indicated above, we intend to schedule the pretrial hearing for the week of April 4, 2011 and we prefer that the parties appear in person. However, we are flexible as to the date and we are open to one or both of the parties appearing by video or telephone.

The parties are ordered to confer regarding dates and provide the Board with three options by Monday, March 28, 2011. Please contact Richard Kim, the interlocutory

attorney responsible for this proceeding, with the dates. Mr. Kim may be contacted at (571) 272-7326 and/or richard.kim2@uspto.gov. The Board will contact the parties to make the final arrangements for the conference.

Source	**Probative Value**	**TTABVue Entry and page**
Chase Dep., p. 23	Meaning of the word Redskins	57 page 25
Chase Dep., p. 45	Evidence that Redskins is disparaging	57 page 87