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

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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.

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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: HARJO AND BLACKHORSE .................................................................47
   A. THE WASHINGTON REDSKINS: HARJO V. PRO-FOOTBALL, INC .................................................................47
   B. THE WASHINGTON REDSKINS: BLACKHORSE V. PRO-FOOTBALL, INC .................................................................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

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

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3 Id.
4 Id.
7 Id.
10 Id.
11 Id.
Trademark Office (USPTO) deemed the Washington Redskins trademark disparaging on June 18, 2014.\textsuperscript{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.”\textsuperscript{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.\textsuperscript{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.\textsuperscript{16} The public can then challenge the mark through a cancellation proceeding or bring the cancellation action at a later date.\textsuperscript{17} However, if the USPTO decides to reject the trademark, the applicant may appeal to the Trademark Trial and

\textsuperscript{13} Travis Waldron, \textit{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/.


\textsuperscript{16} 37 CFR § 2.80 (2014).

\textsuperscript{17} Cancellation of a Registered Trademark, INTERNATIONAL TRADEMARK ASSOCIATION (2015), http://www.inta.org/TrademarkBasics/FactSheets/Pages/CancellationofaRegisteredTrademarkFactSheet.aspx (last visited Nov. 19, 2014).
THE WASHINGTON REDSKINS

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

The TTAB uses a two-part test for determining whether a mark is disparaging. 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.” 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.”

B. DISPARAGING TRADEMARKS: SOCIAL IMPACT

Trademarks serve a larger cultural purpose through their social impact and can create “cultural associations or mythical attachments.” For example, the trademark “Wimbledon” for clothing like blazers or “items associated with pastimes of the leisured class” brings to mind the tennis culture. 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. Thus, within limits, trademarks can give new meaning to a product.

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

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21 Id.
22 Id.
24 Id. at 307.
25 Id. at 308.
26 Id.
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. John Adams called Native Americans “[s]avages unfit for democracy,” and Thomas Jefferson wanted to exterminate Native Americans who opposed assimilation efforts. 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.” The Native American mascot is often seen as “primitive, aggressive, and unsophisticated.”

On a larger scale, this stereotype’s perpetuation stigmatizes Native Americans, resulting in harmful effects. 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.” Additionally, the suicide rate for Native Americans is three times greater than that for the United States population. 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.”

Native Americans may also feel excluded from sporting events and
choose not to go to these events in order to “avoid exposure to a misuse of their culture or religion.”

Charlene Teters, who attended University of Illinois and is Native American, explains the hurt caused by the Chief Illiniwek mascot:

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.

Overall, Native American trademarks prevent non-Native Americans from truly understanding Native Americans and their “historical and cultural experiences.”

A trademarked Native American mascot strips Native Americans of human qualities, making them “mythical ornaments” as opposed to multi-faceted human beings. For these reasons, both the American Psychological Association (APA) and American Sociological Association (ASA) have publicly supported ending the use of Native American mascots. 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] appear to have a negative impact on the self-esteem of American Indian children . . . . [and] undermine the ability of American Indian Nations to portray accurate and respectful images of their culture, spirituality, and traditions.

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.
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.\(^4^4\) 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.\(^4^5\) 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.\(^4^6\) 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.\(^4^7\) 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.\(^4^8\)

In another case, the TTAB held that the wine mark “Khoran” was disparaging under the two-part test.\(^4^9\) 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.\(^5^0\)

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.\(^5^1\) Dressed in quintessential slave attire with a handkerchief on her head, Aunt Jemima spoke with mangled English.\(^5^2\) African Americans resented her as a reference to slavery and specifically found her handkerchief to be a

\(^{4^5}\) Id. at 1267.
\(^{4^6}\) Id. at 1277.
\(^{4^7}\) Id.
\(^{4^8}\) Id. at 1279.
\(^{5^0}\) Id. at 1218–19.
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
55 Manring, supra note 52, at 172.
56 Smith, supra note 54.
58 Id. at 1830.
59 Id.
60 Id.
61 Id.
2000).
“question of first impression.” 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. 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.

Employing the two-part test, TTAB held that whether a disparaging meaning exists is “determined . . . at the time these registrations [were] issued.” The Washington Redskins registered their mark in 1967 and registered other marks and logos up to 1990. Thus, the TTAB would look at the period from 1967 to 1990.

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

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.” The word also appeared most often “in the context of savagery, violence and oppression.” Consequently, the Native American savagery 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.
68 Id.
69 Id. at 1748.
70 Id. at 1719.
71 Id.
72 Id.
73 Id.
74 Id.
sense of an implacable and ferocious foe.”

A variety of petitioners and experts testified to the disparaging nature of the term. The seven Native American petitioners attested to instances where “redskins” was used in a derogatory manner towards them. 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.”

Meanwhile, Pro-Football, Inc. argued that the term was neutral and has acquired a secondary, non-disparaging meaning in reference to the sports team. The violent nature of the word reflects “the troubled history of American Indians” as opposed to the troubling nature of the word itself. 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. Additionally, Pro-Football, Inc. claimed that the term is merely another way to reference Native Americans.

A survey of the general United States population and Native American population showed mixed results for the offensive nature of the term. 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. Next, in order from least offensive to most offensive, were “Indian,” “Brave,” “Buck,” and “Squaw” for both populations. “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. “Injun” was the most offensive term to both groups.

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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. 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.

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. 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.” 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,” it held that a substantial amount of evidence indicated the term has also referred to the football team since the 1960s. 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.

The TTAB then considered the second question in the disparaging two-part test: whether the meaning is disparaging to Native Americans. Based on a “cumulative effect of the entire record,” the TTAB found that the term “redskins” is disparaging to Native Americans. The TTAB found the general public’s responses and the Native American’s perceptions to be probative. 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. The TTAB based its decision on evidence that showed that

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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.
“half of the dictionaries at any point in the time period covered” had offensive usage labels. 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.” 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. 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.’”

Pro-Football, Inc. then appealed to the United States District Court in Harjo II. The court allowed the case to go to trial because, among other reasons, the defense of laches may have been available. 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. The court answered these three questions in the affirmative.

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. The court found that the TTAB based its decision mainly on linguistic and survey testimony. The linguistic testimony supported a finding of disparagement. However, due to the fact that the survey

97 Id.
98 Id. at 1745.
99 Id. at 1746.
100 Id. at 1747.
102 Id. at *22.
103 Id. at *16–17.
104 Id. at *17.
105 Id. at *17–18.
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.\textsuperscript{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.\textsuperscript{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.\textsuperscript{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.”\textsuperscript{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.\textsuperscript{113}

After this holding, Harjo appealed to the United States Court of Appeals in \textit{Harjo III}.\textsuperscript{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.”\textsuperscript{115} The court held that laches should only run when the bringer of the claim comes of age.\textsuperscript{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.\textsuperscript{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.\textsuperscript{118}

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

\textsuperscript{109} Id. at 119–20, 125.
\textsuperscript{110} Id. at 128–29.
\textsuperscript{111} Id. at 144.
\textsuperscript{112} Id. at 139.
\textsuperscript{113} Id. at 139, 140–41, 143.
\textsuperscript{114} Pro-Football, Inc. v. Harjo (\textit{Harjo III}), 415 F.3d 44 (D.C. Cir. 2005).
\textsuperscript{115} Id. at 48.
\textsuperscript{116} Id.
\textsuperscript{117} Id. at 49.
\textsuperscript{118} Id. at 50.
the defense of laches in Harjo IV. This is because Romero waited almost nine years after coming of age before trying to cancel the trademark. Romero was also aware of the mark as a child, before he came of age, further reinforcing the argument that he delayed his claim. Additionally, Pro-Football, Inc. demonstrated sufficient prejudice through the delay. 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. They also established economic prejudice by their continued investment in the mark. Ultimately, the Court of Appeals affirmed the District Court’s findings in Harjo V.

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. The TTAB went on to use the same disparaging two-part test. In regards to the first question, the parties agreed that “redskins” could be used to refer to Native Americans or to the football team. As established in Harjo I, the TTAB concluded that the term still “carries the allusion to Native Americans.” 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. 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.” In other words, the secondary meaning of the term in relation to the football context did not take away the

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).
127 Id. at 1087–88.
128 Id. at 1088.
129 Id.
130 Id. at 1089.
131 Id.
disparaging meaning.\textsuperscript{132}

The TTAB mainly focused on the second question of the two-part analysis.\textsuperscript{133} To answer the question, the TTAB considered a group statement and individual testimony of past views.\textsuperscript{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.”\textsuperscript{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.”\textsuperscript{136} This letter led to a meeting with Williams in 1972 with seven Native Americans.\textsuperscript{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.\textsuperscript{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.\textsuperscript{139}

Individual testimony included letters from various petitioners.\textsuperscript{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

\textsuperscript{132} Id. at 1091.
\textsuperscript{133} Id. at 1089.
\textsuperscript{134} Id. at 1099.
\textsuperscript{135} Id. at 1098, 1107.
\textsuperscript{136} Id. at 1099.
\textsuperscript{137} Id. at 1100.
\textsuperscript{138} Id.
\textsuperscript{139} Id. at 1101–02.
\textsuperscript{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 Fransisco [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.\footnote{141}{Id. at 1103.}

On the other hand, Pro-Football, Inc. included testimony to the contrary.\footnote{142}{Id. at 1104.} 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.”\footnote{143}{Id. at 1105.} 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.\footnote{144}{Id. at 1111.} Thus, the TTAB held that the mark should be cancelled.\footnote{145}{Id. at 1111–12.}

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.”\footnote{146}{Id. at 1111.} This is because laches includes a balancing of prejudice to the defendant, and it is difficult to justify balancing “financial interest . . . against human dignity.”\footnote{147}{Id. at 1112.} 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.\footnote{148}{Id.} Therefore, when there is a “broader public policy concern at issue,” laches does not apply.\footnote{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. 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. 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. In Blackhorse, the TTAB narrowed their evaluation to Native Americans’ opinions only. 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. In Harjo I, the TTAB denied the defense due to the public interest at stake in the case. 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. As long as the court evaluated the claim when all of the plaintiffs came of age, laches was available. In contrast, the TTAB held once again in Blackhorse that laches does not apply when a public policy interest is at issue. 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.

153 Blackhorse, 111 U.S.P.Q.2d at 1111.
156 Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d at 137, 139, 144.
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. With the Blackhorse decision, the TTAB was able to clarify and make the disparaging two part-test similar to that used by the court. 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.

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. Therefore, there could be a database of per se disparaging terms. 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.”

Within this per se disparaging terms list, some aspect of context would still be evaluated through their plain meaning. For example, the plain meaning of “redskin potatoes” does not raise an issue. 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.

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

161 Blackhorse, 111 U.S.P.Q.2d at 1111.
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. 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. Since the current issue where the TTAB and the court stand divided is laches, consensus on laches would be helpful.

Yet another critique of the disparaging trademark process is that it only prevents registration of the mark. 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.” 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.

B. VARYING STANDARDS: POLICY

The primary current policy issue is whether or not laches may be used as a defense. 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. 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.
173 Id. at 14.
174 Id. at 28.
176 Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d at 137, 139.
The Washington Redskins

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.
\(^ {184} \) Id.
\(^ {185} \) Id.
& Hazel by paying $50 million.\textsuperscript{186} At first, Colgate did nothing to change the name or logo despite criticism.\textsuperscript{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.”\textsuperscript{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.”\textsuperscript{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.\textsuperscript{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.”\textsuperscript{191} The executive director of ICCR added:

[As 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.\textsuperscript{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.\textsuperscript{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.”\textsuperscript{194} As of 2001, Mouth Jazz is still being sold but with a redesigned


\textsuperscript{187} KERRY SEGRAVE, \textsc{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.

\textsuperscript{188} \textit{Id.} at 197.


\textsuperscript{190} Segrave, \textit{supra} note 187, at 197.

\textsuperscript{191} \textit{Id.}

\textsuperscript{192} ‘Darkie’ Toothpaste Puts Company in a Squeeze, \textit{supra} note 189.

\textsuperscript{193} Segrave, \textit{supra} note 187, at 197.

\textsuperscript{194} \textit{Id.}
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

196 Darkie Drops Offensive Name and Logo, STRAINS 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.
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.’” 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.”

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 . . .”

In 1992, China banned Darlie toothpaste because it was deemed derogatory, yet it is still sold in China. 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.”

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. 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.

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

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207 Id.
208 Id.
210 Levitt, supra note 209.
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? We could look to dictionary definitions or historical information documenting the nature of the term in these Asian countries. 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. “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.

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. “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. 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. Thus,

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215 WIKIPEDIA, supra note 183.
216 ‘Darkie’ Toothpaste Puts Company in a Squeeze, supra note 189.
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.\textsuperscript{220} If the plaintiffs were of age and did delay a substantial amount of time, they would be barred from bringing the case.\textsuperscript{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.\textsuperscript{222}

One proposed policy change would be to create a list of per se disparaging terms, including terms that are disparaging in other countries.\textsuperscript{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.\textsuperscript{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.\textsuperscript{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.

\textsuperscript{220} Id.
\textsuperscript{221} Id.
\textsuperscript{222} Id. at *15.
\textsuperscript{223} Farley, supra note 163, at 1032.
\textsuperscript{224} Drescher, supra note 23, at 306.
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.
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. 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. 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.

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.” But, as the second question in the
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.\textsuperscript{236}

\footnotesize{washington-redskins-nfl-dan-snyder-letter; Daniel Snyder, WIKIPEDIA (Nov. 26, 2014), http://en.wikipedia.org/wiki/Daniel_Snyder.\textsuperscript{236} Holmes, supra note 6.}