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## Notes

**\*1141 STOPPING THE "SAVAGE INDIAN" MYTH: DEALING WITH THE DOCTRINE OF LACHES  
IN LANHAM ACT CLAIMS OF DISPARAGEMENT**Steven R. Latterell [\[FNa1\]](#)

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## Introduction

Far out on the northern Great Plains, the tension between Euro-American and American Indian culture continues to unfold. In Grand Forks, North Dakota one of the nation's best college hockey teams, the University of North Dakota Fighting Sioux, plays in a newly-constructed hockey palace. Each of the seats in the more than 11,500 person-capacity arena is made of cherry wood and leather, and the concourse floors are made of granite. [\[FN1\]](#) On the end of every row of seats, emblazoned in gold, is an image of a Sioux Indian with a headdress of feathers and a prominent nose. [\[FN2\]](#) The same Sioux Indian image is built into the floor of the main entrance. [\[FN3\]](#) In fact, thousands of such images bombard all hockey fans that fill the seats of Ralph Engelstad Arena. [\[FN4\]](#)

The relationship between Euro-Americans and American Indians in the United States began as a story about land and bloodshed, [\[FN5\]](#) but today is about the control of image and jurisdiction. [\[FN6\]](#) A primary struggle during the last thirty years involves sports \*1142 teams that use American Indian nicknames, logos, and mascots (hereinafter "nicknames"). [\[FN7\]](#) The struggle over the use of American Indian nicknames occurs across the entire nation and at every level of athletics. These nicknames perpetuate the image that American Indians live a savage lifestyle; this false image of today's American Indians is known as the "savage Indian" myth. [\[FN8\]](#) Although some high schools and colleges have made changes, [\[FN9\]](#) many schools still use American Indian nicknames. [\[FN10\]](#) None of the six professional sports teams that use such nicknames have changed. [\[FN11\]](#)

The struggle over image has gradually progressed from one that was primarily conducted through demonstrations and protests, [\[FN12\]](#) to one that has increasingly looked to legal avenues as a catalyst for change. [\[FN13\]](#) Pro-Football, Inc. v. Harjo, [\[FN14\]](#) a recent decision by the United States District Court for the District of Columbia, involved a claim brought by Pro-Football, Inc. ("Pro-Football") to overturn a 1999 decision of the Trademark Trial and Appeal Board ("TTAB") canceling six team trademarks that used \*1143 some form of the word "redskin." [\[FN15\]](#) Suzan Shown Harjo, a member of a federally-recognized American Indian tribe, along with six other American Indians, successfully petitioned the TTAB to cancel the trademarks based on § 1052(a) (commonly referred to as, and hereinafter, § 2(a) [\[FN16\]](#) of the Federal Lanham Act. [\[FN17\]](#) The TTAB eliminated the federal protection of the six Pro-Football trademarks pursuant to § 2(a) because the trademarks disparaged American Indians. [\[FN18\]](#) The district court reversed the cancellations because of an insufficient record of disparagement to American Indians, and because laches barred the claim from consideration. [\[FN19\]](#) Because most professional sports teams have old trademarks pertaining to their American Indian nicknames, [\[FN20\]](#) the application of laches may provide the most trouble for future litigants challenging the trademarking of American Indian nicknames.

[\[FN21\]](#)

This Note will examine the recent Pro-Football, Inc. v. Harjo decision, and will present an argument to refute the use of laches in disparagement claims brought by American Indians. Part I of this Note will discuss the harms that the continued use of American Indian nicknames cause. Part II will provide an overview of the Pro-Football, Inc. v. Harjo decision in three steps. First, it will discuss the Lanham Act and its subsections (including § 2(a)). Second, a summary of laches will be presented. Third, this Note will examine the Pro-Football, Inc. v. Harjo decision with respect to its analysis of the § 2(a) claim of disparagement and laches. Part III will analyze the public interest exception to the laches doctrine and argue that this exception is the primary avenue available for refuting the application of laches to § 2(a) disparagement \*1144 claims [\[FN22\]](#) (thus avoiding the problem of Pro-Football, Inc. v. Harjo). [\[FN23\]](#) The Note will conclude that § 2(a) disparagement claims seeking to eliminate trademark protection of American Indian nicknames sufficiently implicates the public interest to defeat a laches defense.

I. Harms Created By American Indian Nicknames for Sports Teams

It is imperative to understand the harm that American Indian nicknames cause in order to appreciate the need to eliminate their use. Furthermore, from a legal standpoint, these harms enhance the American Indians' argument against laches. [\[FN24\]](#)

A. Creation of the "Savage Indian" Myth and Historical Harms to American Indians

Throughout the history of the United States, American Indians have been marginalized and treated as sub-humans, both at the hands of the United States government and by Euro-American citizens of the United States. [\[FN25\]](#) The ever-changing American Indian policies of the United States government have contributed to the oppression. At the earliest point, the government's policy was based on separation of American Indians and United States citizens. [\[FN26\]](#) As Chief Justice Marshall's decision in Johnson v. M'Intosh [\[FN27\]](#) pointed out, the nation preferred to assimilate the American Indians into the majority culture, although at the time it was not yet considered possible. [\[FN28\]](#) In the 1830s, the United States began to remove American Indians from \*1145 their homelands and relocate them onto reservations [\[FN29\]](#)-often land with poor soil, water, and vegetation. [\[FN30\]](#) During this period of American Indian removal, the "Trail of Tears" and other atrocities occurred. [\[FN31\]](#) The assimilation and allotment policy period, which lasted from 1871- 1928, was no kinder to American Indians. [\[FN32\]](#) The government's primary objective during this period was to assimilate American Indians to Euro-American ways by importing the Euro-American style of property rights into the tribal land holdings. [\[FN33\]](#) During this time, the reservation lands of the American Indians were diminished in order for Euro-Americans to obtain large portions of the best reservation land for their own development and use. [\[FN34\]](#)

While Euro-Americans increased in population and wealth, the declining American Indian population held less and less land. It is no coincidence that these two trends were occurring at the same time; the idea of nation building in the United States has always been linked to the destruction of the American Indian. [\[FN35\]](#) The Founding Fathers, for the most part, did not seek to aid the American Indians, but rather to subordinate their "savage" neighbors. John Adams referred to the Indians as "savages" unfit for democracy and Thomas Jefferson sought to "exterminate[]" the Indians of any tribe that resisted assimilation and dominance. [\[FN36\]](#) Studies show that by 1900 the population of American Indians was approximately 90% less than it was at the time of Euro-American settlement in North America. The arrival and settlement of Euro-Americans stands as the primary cause of this vast diminishment. [\[FN37\]](#)

These past harms are largely unrecognized by non-Indian Americans today. Those non-Indian Americans who know this history often choose to accept genocide as proper or inevitable. [\[FN38\]](#) The non-Indian American public of today can acquiesce to \*1146 historical acts of marginalization, maltreatment, and genocide of American Indians due to the current portrayal of American Indians as "savage Indian" relics of the past, rather than as a continuing presence in today's world. [\[FN39\]](#)

B. Perpetuation of the "Savage Indian" Myth Today

Unfortunately for American Indians, the image of the "savage Indian" did not die with John Adams or with the end of the allotment era. Even today, in the era of tribal self-determination, [\[FN40\]](#) the "savage Indian" image continues to be propagated through television, movies, and sports team nicknames. [\[FN41\]](#) By "savage Indian," this Note

means an image of American Indians as an uncivilized social group of aggressive and unintelligent persons. [\[FN42\]](#) This image has been handed down from the time of John Adams and Thomas Jefferson. The American Indian trademarks of sports teams promote this image today. The Cleveland Indians trademark of "Chief Wahoo" depicts a caricature of an American Indian face with a cartoon-like grin and a large nose, an Atlanta Braves trademark shows an American Indian in a "war cry" with a mohawk and feathers, and a Washington Redskins trademark portrays an American Indian head profile with war paint and feathers. [\[FN43\]](#) These trademarks represent Native Americans as aggressive and unsophisticated. [\[FN44\]](#)

The "savage Indian" message of the trademarked nicknames is made more harmful due to the removal and reservation policies of the past. These policies have resulted in most non-Indian Americans living far away from the nation's large American Indian reservation populations, [\[FN45\]](#) and thus, most non-Indian Americans have not had the contact with American Indians needed to break the "savage Indian" myth. Two main reasons cause the minimal contact to persist despite the fact that the majority of \*1147 American Indians today are "urban Indians" who do not live on reservations. [\[FN46\]](#) The first is that non-Indian Americans often do not know when they are interacting with urban Indians because the majority population often mistakes urban Indians for Asian or Hispanic Americans. [\[FN47\]](#) Thus, American Indians often suffer an outward loss of identity from the majority population. This outward loss of identity occurs in part because the urban Indians who work in blue and white collar jobs in the cities of the United States do not fit the stereotypical "savage Indian" profile that is fed to the majority population. [\[FN48\]](#)

Secondly, the amount of interaction is also minimized due to the small overall population of American Indians in the United States. The American Indian population makes up only 1.5% of the overall United States population, [\[FN49\]](#) and only eight states have an American Indian population that is at least 3.0% of the state's overall population. [\[FN50\]](#) This lack of interaction makes the mythical image of the "savage Indian," as depicted by American Indian nicknames of sports teams, even more dangerous to today's American Indians. [\[FN51\]](#) Without real world interactions non-Indian Americans easily mistake the "savage Indian" myth as reality.

The "savage Indian" myth has hampered the ability of tribal courts to assert jurisdiction. The opinion of the Supreme Court of the United States in *Nevada v. Hicks* [\[FN52\]](#) continued the modern trend of shrinking tribal jurisdiction and dismantling tribal rights. [\[FN53\]](#) In *Hicks*, the court was faced with the question of whether a tribal court had jurisdiction over an American Indian's civil claim against a state game warden for the improper execution of a search warrant in Indian Country. [\[FN54\]](#) The majority found \*1148 that the tribal court did not have jurisdiction over the law enforcement duties of state officers, [\[FN55\]](#) because the opposite decision would have allowed the tribe to override the duties of a state officer whenever it desired. [\[FN56\]](#) Through this decision, the Court suggests that while a state court has authority to override a state officer's execution of duties, it cannot trust a tribal court to fairly do the same [\[FN57\]](#)-an outsider will not get a fair trial in the "savage" tribal courts.

The "savage Indian" myth has also contributed to the internal loss of identity for American Indians, which leads to a negative stigmatization of American Indians. Some American Indian children have communicated that they are ashamed of being American Indians. [\[FN58\]](#) Such stigmatization can be very dangerous, as the Supreme Court made clear in *Brown v. Board of Education of Topeka* [\[FN59\]](#) in reference to the schooling of African-American children. One of the primary factors in the *Brown* decision was the fact that the negative stigmatization of African-American children led to a loss of success in their educational endeavors. [\[FN60\]](#) Likewise, American Indian children face negative consequences from the stigmatization created by the "savage Indian" myth. As the United States Commission on Civil Rights stated, "[t]he perpetuation of harmful stereotypes may exacerbate [the problem]" of American Indians maintaining "the lowest high school graduation rates in the nation and even lower college attendance and graduation rates." [\[FN61\]](#)

Thus, the American Indian image that John Adams spoke of beginning in the separation policy era of the United States continues to exist today in the form of the "savage Indian" myth. The "savage Indian" myth is perpetuated in the popular culture of the American majority through the use of, among other things, American Indian nicknames by sports teams, and this image continues to disparage American Indians and cause them many ills, both on a tribal and on a personal level. [\[FN62\]](#) As the United States Commission on Civil Rights stated, the false portrayals of American Indians through the use of nicknames "prevent[s] non-Native Americans from understanding the true historical and cultural experiences of American Indians. Sadly, [the false \*1149 portrayals] also encourage biases and prejudices that have a negative effect on contemporary Indian people." [\[FN63\]](#)

As Part III of this Note will explain, these harms provide the basis for the American Indians' public interest argument against laches.

## II. Examining the Laches Decision in *Pro-Football, Inc. v. Harjo*

The recent decision in *Pro-Football, Inc. v. Harjo* [FN64] is the leading case for analyzing the application of laches within the framework of Lanham Act § 2(a) disparagement claims. As previously stated, this Note seeks to develop an argument to counter the application of laches to § 2(a) disparagement claims. Before analyzing the public interest exception used for reaching this ultimate goal (this will be done in Part III) this Note will: (a) discuss the Lanham Act as it applies to disparagement claims against the use of American Indian nicknames, (b) discuss laches as it currently exists, and (c) discuss the manner in which laches was applied in the *Pro-Football* decision.

### A. The Lanham Act

The Federal Trademark Act of 1946, more commonly known as the Lanham Act ("Act") is the trademark protection law that serves to protect American Indian nickname trademarks. [FN65] The principal purpose of the Act is to "secur[e] to the owner [of the trademark] the good will of his business and [to protect] the public against spurious and false marked goods." [FN66] There are two provisions of the Act that are of importance for removing the trademark protection of American Indian nicknames for sports teams: § 2(a) and § 1052(d) (commonly referred to as, and hereinafter, § 2(d)).

#### 1. Section 2(a)

Section 2(a) of the Act is the key provision for litigants seeking to remove trademark protection from American Indian nicknames used by sports teams. [FN67] It is important to note that § 2(a) will not bar a team from using the nickname. [FN68] Rather, this approach assumes that once trademark protection is lost the team will face sufficiently severe economic consequences, thus causing the team to voluntarily stop using the nickname and switch to a non-American Indian nickname that it can trademark. [FN69]

\*1150 Section 2(a) states, in pertinent part, that no trademark shall be refused protection by its nature unless it "[c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute . . . ." [FN70] While the language of § 2(a) provides two distinct clauses for trademark cancellation, the significant clause for American Indian litigants, at issue in *Pro-Football*, is the second and in particular its provision discussing disparagement [FN71] (hereinafter "disparagement provision"). [FN72]

A trademark satisfies the disparagement provision if it meets the two-part test set forth by the TTAB. [FN73] It must be: (1) "reasonably understood as referring to the plaintiff," [FN74] and (2) "considered offensive or objectionable by a reasonable person of ordinary sensibilities." [FN75] The disparagement test looks only at the class of people that \*1151 the trademark refers to rather than the general public. [FN76] Thus, courts will not analyze whether non-Indian Americans believe the term "redskins" may disparage American Indians, but rather will analyze whether American Indians believe the term may disparage American Indians. Moreover, the disparagement inquiry is based on the attitudes that existed when the trademark was registered, not on present day attitudes. [FN77]

#### 2. Section 2(d)

Section 2(d) states in pertinent part that a trademark shall be refused registration if it "so resembles a mark registered in the Patent and Trademark Office . . . as to be likely, when used on or in connection with the goods of the applicant, to cause confusion, or to cause mistake, or to deceive . . . ." [FN78] For the purposes of this Note, § 2(d) is important because it has more developed case law than § 2(a), and therefore this Note will use it by analogy to analyze how a § 2(a) disparagement claim can use the public interest exception to overcome an otherwise successful laches argument.

### B. The Doctrine of Laches

Because the problems in *Pro-Football* that concern proving disparagement are largely evidentiary problems that apply solely to that case, the main area of concern in the post-*Pro-Football* legal environment will be the application of laches. [FN79] Laches is an equitable doctrine that "denies relief to a claimant who has unreasonably delayed . . . in asserting the claim, when that delay . . . has prejudiced the party against whom relief is sought." [FN80] To

analyze laches as it applies to § 2(a) disparagement claims, it is appropriate to look at how the common-law elements of laches apply to trademark infringement cases [\[FN81\]](#) for two reasons: (1) the infringement cases are easily applied by analogy to § 2(a); [\[FN82\]](#) and, (2) other than Pro-Football, there has been little litigation in the area of § 2(a) disparagement claims, and thus, little direct precedent exists. [\[FN83\]](#) The common-law approach to laches, used in Pro-Football, involves a two-prong test consisting of delay and prejudice. [\[FN84\]](#)

#### \*1152 1. The Delay Prong

Laches separates delays into two distinct categories: patently egregious and less egregious. [\[FN85\]](#) A delay is patently egregious if it extends for 100 years or more. [\[FN86\]](#) These delays generally result in an overall abandonment of the party's claims. [\[FN87\]](#) In contrast, a less egregious delay will often result in a bar of past claims, but might leave claims for prospective, injunctive relief alive. [\[FN88\]](#) Less egregious delays must be broken into reasonable and unreasonable delays. [\[FN89\]](#) Since the Act is a federal statute that does not set forth any statutory limitations on the time frame for bringing claims, it is customary for the court to look to the most applicable local law and apply its statute of limitations to the Act. [\[FN90\]](#) If the delay is within the local statute of limitations, then there is a presumption that the delay is not unreasonable, but if the delay is greater than the statute of limitations, then the delay is presumed to be unreasonable. [\[FN91\]](#) The burden of proof remains with the party using laches, even if the delay is greater than the statute of limitations. [\[FN92\]](#)

A party can allege several legitimate "excuses" that may persuade a court to deem a less egregious delay not unreasonable. For instance, reasonable time taken to settle a \*1153 potential dispute without litigation will not be included in the time calculus of laches. [\[FN93\]](#) It is also true that a change in circumstances concerning the trademark can bar the application of laches if the harms caused by the infringement have increased due to the change [\[FN94\]](#) and the change in circumstances was more than normal growth in the defendant's business. [\[FN95\]](#)

#### 2. The Prejudice Prong

Delay alone cannot support laches; [\[FN96\]](#) prejudice to the defendant must also be proved. There are two main forms of prejudice: (1) lost witnesses and evidence, and (2) monetary. [\[FN97\]](#) The primary focus of § 2(a) cases has been on monetary prejudice. [\[FN98\]](#) In analyzing monetary prejudice, courts do not focus on the total amount of money spent on creating a trademark, but rather on how much money has been spent that would not otherwise have been spent if not for the delay in bringing the claim. [\[FN99\]](#) Courts further \*1154 limit their focus by only considering money spent in relation to the development and promotion of the trademark that would not have been spent but for the delay. [\[FN100\]](#) Finally, reliance on the delay is not a requirement for showing monetary prejudice, and as the period of delay becomes longer the burden of showing monetary prejudice decreases. [\[FN101\]](#)

#### 3. The Public Interest Exception

Even if both unreasonable delay and monetary prejudice exist, a showing that the violation of the Act is not in doubt and that the violation sufficiently implicates the public interest can overcome an otherwise successful laches argument. For example, in a § 2(d) likelihood of confusion case, a claimant can defeat a valid laches argument when the public has an interest in avoiding confusion created by trademarks within the market [\[FN102\]](#) and confusion clearly exists. [\[FN103\]](#) Thus, the public interest dictates that the equitable nature of laches not be applied strictly in all scenarios. [\[FN104\]](#)

#### \*1155 C. The Laches Decision in Pro-Football, Inc. v. Harjo

The recent Pro-Football decision is the leading case for analyzing the application of laches to § 2(a) disparagement claims. The TTAB's decision to cancel Pro-Football's six federal trademarks was based on its conclusion that the marks disparage American Indians. [\[FN105\]](#) The first of the six trademarks was originally registered in 1967, the next three trademarks were all registered in 1974, the fifth trademark was registered in 1978, and the final trademark was registered in 1990. [\[FN106\]](#) The TTAB's decision was overturned by the district court on two separate grounds: (1) the record created by the TTAB did not support the conclusion that the marks disparage American Indians, [\[FN107\]](#) and (2) the petitioners' claims before the TTAB were barred by laches. [\[FN108\]](#)

Laches applies when there has been an unreasonable delay in beginning an action after the cause of action has accrued. [\[FN109\]](#) The court applied a test of laches that was analogous to the common-law test used in trademark infringement cases. [\[FN110\]](#) The court set forth a three-component test which requires: (1) substantial delay in bringing a suit, (2) knowledge of the trademarks during that delay, and (3) continued development of goodwill in the

trademarks during that delay. [\[FN111\]](#) Laches must be applied separately to all four of the relevant dates of registration for the six trademarks. [\[FN112\]](#) In its application of laches, the Pro-Football court concluded that: (1) the American Indians did substantially delay in bringing suit, (2) the American Indians had notice of the marks during that delay, and (3) the interests of Pro-Football were prejudiced by that delay. [\[FN113\]](#)

#### \*1156 1. The Delay Prong

The court concluded that in reference to the marks registered in 1967, 1974, and 1978, the delay was facially substantial. [\[FN114\]](#) The delay for the 1990 trademark (i.e., the "Redskinettes" trademark) was deemed substantial "given the context of this case." [\[FN115\]](#) The name "Redskinettes" has been used since 1962, and this thirty-year timeframe of use of the name, in conjunction with the existence of the other five trademarks and the lack of a challenge of the 1990 trademark until 1992, led the district court to conclude that the delay was substantial. [\[FN116\]](#)

The American Indians received clear notice of the trademarks in question when each of the six trademarks was published and again when each of the six trademarks was registered. [\[FN117\]](#) The TTAB has made it clear that the clock for laches begins to run when each trademark is published. [\[FN118\]](#) Not only did the American Indians have constructive notice, but they also had actual notice of the trademarks during the delay periods because they knew about the Washington Redskins football team. [\[FN119\]](#) The court concluded that there is no reasonable excuse for the delay created by the American Indians; thus, the delay was deemed unreasonable. [\[FN120\]](#)

#### \*1157 2. The Prejudice Prong

Delay in bringing a claim is not enough by itself to invoke laches; Pro-Football also had to show that it suffered a negative consequence or prejudice due to the delay. [\[FN121\]](#) The court stated that there had clearly been substantial investment and development in the Redskins "brand" throughout the period of delay, based on television contracts and the sale of merchandise and game tickets. [\[FN122\]](#) The court concluded that case law and common sense both pointed to economic prejudice against Pro-Football due to the long twenty-five-year delay and heavy investment in the trademark. [\[FN123\]](#) Thus, laches barred the American Indians' claim. [\[FN124\]](#)

#### 3. The Public Interest Exception

The district court noted that courts have historically found in favor of tardy § 2(d) likelihood of confusion claimants because the Act includes a public interest component. [\[FN125\]](#) Due to the public interest implicated in likelihood of confusion cases (§ 2(d) cases), [\[FN126\]](#) courts often apply the public interest exception to laches in these cases. [\[FN127\]](#) But, the district court concluded that in the context of § 2(a) disparagement cases, the public interest is narrower than in § 2(d) cases, because § 2(a) disparagement cases have a more narrow overall application. [\[FN128\]](#) The district court stated that it is inaccurate to say that laches is unavailable whenever the public interest is involved. [\[FN129\]](#) Such a rule would be too broad in application as all actions brought under § 2(a) would be outside of the reach of laches. [\[FN130\]](#) If the rule were to be boundless in this regard, the policy purposes of trademark protection would be undermined and dilatory behavior \*1158 would be rewarded. [\[FN131\]](#) Through this analysis, the court concluded that laches barred the disparagement claim despite the existing public interest in the claim. [\[FN132\]](#)

### III. Using the Public Interest Exception to Overcome Laches in a Post-Pro-Football, Inc. v. Harjo World

Laches, as applied in Pro-Football, is a major barrier to the use of § 2(a) [\[FN133\]](#) as a catalyst for changing the American Indian nicknames of sports teams. [\[FN134\]](#) The first step in a laches analysis is to decide whether the delay has been egregious. None of the sports team trademarks are so old that the delay in bringing the disparagement claim would be deemed "egregious" (i.e., a delay of 100 years). [\[FN135\]](#) Because the delay is a "less egregious" delay, American Indians have not abandoned their rights under § 2(a). [\[FN136\]](#) Unfortunately for American Indian litigants, their disparagement claims will face the following two problems in reference to laches: (1) the delay will likely exceed the local statute of limitations for nearly all sports team trademarks, thus creating a presumption of unreasonable delay; [\[FN137\]](#) and (2) the sports teams have already invested heavily in promoting their trademarks, thus leading to prejudice. [\[FN138\]](#) Assuming then that trademark owners can establish the two prong test for laches, American Indian litigants looking to avoid laches should turn to the public interest exception.

The Pro-Football court argued that the public interest exception to laches used by litigants bringing § 2(d) claims was unavailable to the American Indians' § 2(a) claim. This Note disagrees. Because the public has as much of a

stake in the American Indians' disparagement claims as they do in likelihood of confusion cases under § 2(d), the public interest exception should apply in § 2(a) cases as it does in § 2(d) cases. [\[FN139\]](#) To prove this, this Note will examine two questions: (1) Is the public \*1159 interest exception applicable to § 2(a) disparagement claims at all? [\[FN140\]](#) (2) Is the public interest within § 2(a) narrower than or equivalent to the level of public interest within § 2(d)?

#### A. The Public Interest Exception Is Applicable to the § 2(a) Disparagement Provision

The laches test that is applied to the § 2(a) disparagement provision in Pro-Football is adapted by analogy, with some changes, from the laches test from common-law infringement cases. This adaptation is appropriate given the procedural posture of the Pro-Football case. [\[FN141\]](#) The test used in common-law infringement cases states that laches is applicable if the following three requirements are met: "(1) a substantial delay . . . prior to filing suit; (2) . . . awareness that the disputed trademark was being infringed; and (3) a reliance interest resulting from . . . continued development of good-will during this period of delay." [\[FN142\]](#) The Pro-Football court's adjusted test for § 2(a) disparagement cases states that laches is applicable if the following three circumstances are met:

(1) the Native Americans delayed substantially before commencing their challenge to the "redskins" trademarks; (2) the 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. [\[FN143\]](#)

The adjustments made are because the party opposing the trademark is not itself a trademark owner. Such adjustments do not change the test's underlying structure or logic.

Since the laches test from the infringement line of cases is adjusted and applied by analogy to the § 2(a) disparagement cases, then the exceptions to the test in the infringement line of cases should come with it. The Pro-Football court agreed, stating that "even in a disparagement case, a court may be willing to invoke the public interest \*1160 behind section 2(a)." [\[FN144\]](#) The Pro-Football decision, in harmony with other cases, shows that § 1052 (including both § 2(a) and § 2(d)) involves public interest. [\[FN145\]](#)

This also makes sense from a policy perspective. The purpose of the public interest exception is to protect the interests of the public from being harmed due to the claimant's dilatory behavior, and it protects the public in lieu of the interests of the trademark owner who also may be harmed by the claimant's dilatory behavior. Thus, where laches is at play, the public interest exception is also at play, assuming a public interest exists for the claim brought. [\[FN146\]](#)

Even though the Pro-Football court stated that cases brought under § 1052 involve public interest, [\[FN147\]](#) this does not finish the inquiry, as courts have found that some types of cases under the Act involve primarily private interests-including some cases brought under the "false suggestion" clause of § 2(a). [\[FN148\]](#) The Bridgestone/Firestone Research court stated that the false suggestion provision's right of privacy purpose stems from the intent of the drafters and serves to differentiate the provision from the § 2(d) likelihood of confusion provision. [\[FN149\]](#) The Bridgestone/Firestone Research court only implicates the false suggestion provision of § 2(a) and does not implicate the disparagement provision of § 2(a). [\[FN150\]](#)

The disparagement provision of § 2(a) stands in a different relation to the public interest as compared to the false suggestion provision of § 2(a). Unlike the false suggestion provision, the disparagement provision does not have to be differentiated from the § 2(d) likelihood of confusion provision because the disparagement provision does not implicate the confusion of trademarks, while the false suggestion provision does. [\[FN151\]](#) Further, unlike the false suggestion provision, the disparagement provision does not have a primary interest of protecting privacy rights, [\[FN152\]](#) and no case law has shown or stated otherwise. Indeed, even the Pro-Football court did not state that the \*1161 disparagement provision was meant primarily to protect privacy interests; [\[FN153\]](#) rather, the court admitted that the disparagement provision included a public interest that could be invoked. [\[FN154\]](#) The problem is that the court found this interest to be too narrow.

#### B. The Public Interest in the American Indians' § 2(a) Disparagement Claim Is Equivalent to the Public Interest in § 2(d) Likelihood of Confusion Claims

The Pro-Football court correctly stated that the existence of the public interest within § 1052 does not mean that all litigants can use the public interest exception to laches. [\[FN155\]](#) The Pro-Football court held that while the public interest involved in § 2(d) is strong enough to encompass the exception to laches, the public interest involved in § 2(a) cases is narrower. [\[FN156\]](#) It makes this conclusion without citing any precedent and without providing convincing analysis. [\[FN157\]](#) The court's conclusion is based on the assumption that the § 2(a) disparagement analysis applies to only the American Indians, while the § 2(d) likelihood of confusion analysis applies to a larger portion of the general public. [\[FN158\]](#) The court's conclusion is misguided.

The public interest involved in the § 2(a) disparagement claims of the American Indians is equivalent to the public interest known to exist in § 2(d) likelihood of confusion claims for the following three reasons: (1) the level of public interest involved in a § 2(d) likelihood of confusion claim stems from the circumstances surrounding the claim not from the text of § 2(d) and thus is not an inherently heightened level of public interest, (2) the narrow scope of the § 2(a) disparagement inquiry is analogous to the narrow scope of the § 2(d) likelihood of confusion inquiry and thus does not create a narrow level of public interest under the disparagement provision, and (3) the harms to the public's interest under both provisions are equivalent because both involve substantial impacts to the economy of the United States. Based on these three reasons, the public interest exception that is clearly applied to § 2(d) likelihood of confusion claims should be applied in an equivalent manner to the § 2(a) disparagement claims of the American Indians. This Note now seeks to explain and further develop these three reasons that lead to this conclusion.

#### 1. Public Interest in the § 2(d) Likelihood of Confusion Provision Is Not a Heightened Level of Public Interest

The language of § 2(d)'s likelihood of confusion provision does not implicate a heightened public interest above that of the language of § 2(a)'s disparagement provision-neither provision expressly states the level of public interest involved. [\[FN159\]](#) \*1162 Still, the Pro-Football court found that § 2(d)'s language provided a basis for a higher public interest than § 2(a)'s language. Its analysis of § 2(d) put special emphasis on the phrase discussing the improper purposes that the section combats. Specifically, that a trademark should be cancelled where it "[c]onsists of or comprises a mark which so resembles a mark registered . . . as to be likely . . . to cause confusion, or to cause mistake, or to deceive," [\[FN160\]](#) was noted as providing a basis for the higher level of public interest in § 2(d) as compared to § 2(a).

The Pro-Football court, however, puts its emphasis on the wrong terms of § 2(d). The phrase requiring "likeness" is the key to the public interest issue. [\[FN161\]](#) To gain the application of the public interest exception under a § 2(d) claim, the purchaser's confusion or mistake must be more than "likely"; it must not be in doubt. [\[FN162\]](#) The level of public interest involved in a § 2(d) likelihood of confusion case is not enough to support the public interest exception until the confusion or mistake is no longer in doubt. [\[FN163\]](#)

Thus, the level of public interest needed to support the public interest exception does not exist in all § 2(d) cases where a § 2(d) violation has occurred-the needed level of public interest does not inhere in § 2(d)'s text. Rather, that level of public interest comes from the circumstances surrounding the claim itself. [\[FN164\]](#) Therefore, the § 2(d) likelihood of confusion provision on its face does not possess a heightened level of public interest above that of § 2(a)'s disparagement provision. Because the level of public interest in § 2(d) is not a heightened level, the next inquiry is to determine whether § 2(a)'s disparagement provision has a narrow level of public interest.

#### 2. The Narrow Scope of the Disparagement Inquiry Does Not Necessarily Create a Narrow Level of Public Interest in § 2(a) Disparagement Claims

The district court in Pro-Football concluded that because the disparagement question applied to American Indians rather than a larger portion of the general public, the public interest was narrower for disparagement cases than likelihood of confusion cases. [\[FN165\]](#) In doing so, the Pro-Football court conflated the disparagement inquiry with the public interest inquiry. In answering the question of whether disparagement of American Indians resulted from the use of American Indian nicknames by sports teams, only the opinions of American Indians are of concern. [\[FN166\]](#) But, the limited scope of this disparagement question is not the same scope that should be applied when inquiring \*1163 about the level of public interest involved in a § 2(a) disparagement claim for purposes of the public interest exception. [\[FN167\]](#)



By analogizing to the analysis of public interest elsewhere in the Act, [\[FN168\]](#) it becomes clear that the narrow scope of the disparagement inquiry does not necessarily narrow the scope of the public interest inquiry. In the classic § 2(d) likelihood of confusion case between two companies, it is the company that possesses the original trademark (hereinafter "Company A") that suffers the § 2(d) violation by the confusing mark of Company B. The likelihood of confusion analysis looks to compare the two marks and does not require a showing of actual confusion in the marketplace by individuals or the public at large. [\[FN169\]](#) On the other hand, a showing of an inevitable impact, or a showing of an actual impact, on the public is required to establish the public interest exception, because either of the showings ensures that confusion is not in doubt. [\[FN170\]](#) Thus, when a § 2(d) likelihood of confusion claim implicates the public interest, the exception dictates that laches should not be applied to a delayed claim by Company A if confusion is found to exist on the circumstances of the case. [\[FN171\]](#) Importantly, the scope of the likelihood of confusion inquiry, which only needs to look at the marks, is separate from and narrower than the scope of the public interest inquiry, which needs to look at the impact that the marks have as to individuals and the general public.

Similar to the likelihood of confusion cases, the § 2(a) disparagement inquiry is answered by analyzing a narrow context (here, the American Indians). [\[FN172\]](#) Thus, it should follow by analogy from the likelihood of confusion cases, that the public interest exception in disparagement cases does not necessarily become narrow simply because the disparagement inquiry is narrow. The disparagement provision is analogous to the likelihood of confusion provision in that the party with the rights under the Act and the analysis of that party's claim in no way limits the level of public interest associated with the applicable provision of the Act. This Note next contends that the public's interests are harmed by the disparagement of American Indians, and that this harm is equivalent to the harm to the public interest due to confusing goods under § 2(d). These harms are used as a barometer to ultimately conclude that the level of public interest associated with the two provisions is equivalent as well.

**\*1164 3. The Harm to the Public's Interests Due to Disparagement of American  
Indians Is Equivalent to the Harm to the Public's Interests Due to Confusing  
Goods**

Since it has already been established that § 2(d) does not possess a heightened level of public interest and that the narrow scope of the § 2(a) disparagement inquiry does not necessarily narrow the level of public interest associated with the § 2(a) disparagement provision, it is now important to directly compare the public interest of the claims under both provisions to ensure that the public interest in § 2(a) disparagement claims, brought against trademarked American Indian nicknames, provides a sufficient basis for the public interest exception. [\[FN173\]](#)

The public interest in the § 2(a) disparagement claim is implicated in two manners. First, disparagement caused by the use of American Indian nicknames results in the non-American Indian public being continually fed the "savage Indian" myth, which robs them of the opportunity to understand American Indians. [\[FN174\]](#) Non-American Indians have little contact with American Indians in today's society, making the "savage Indian" nicknames even more harmful because the relic images of American Indians are taken as reality. [\[FN175\]](#)

Second, the public interest is even more significantly implicated by the use of American Indian nicknames based on the impact that such nicknames have on the current experience of American Indian children in schools across the United States. [\[FN176\]](#) American Indian children have among the lowest high school graduation rates in the nation, and a link has been identified between these low graduation rates and the perpetuation of harmful American Indian stereotypes such as the "savage Indian" myth. [\[FN177\]](#) Low graduation rates in turn lead to a loss of economic productivity from these drop-out students. [\[FN178\]](#) As the Supreme Court of the United States clearly stated, "education provides the basic tools by which individuals might lead economically productive lives to the benefit of us all." [\[FN179\]](#) Thus, the public has an interest in ensuring that these stigmatizing American Indian nicknames are not given protection and legitimacy from the government through the trademark process. As was noted in *Brown v. Board of Education of Topeka* where the stigmatization of school children was involved, the negative effects of stigmatization are greater when sanctioned by the law. [\[FN180\]](#) Like African-American school children that were stigmatized due to the "separate-but-equal" regime, American Indian children are shown that they are thought of as overly-aggressive and unsophisticated by the majority culture when American Indian nicknames used by sports teams are given protection under federal law. [\[FN181\]](#) Thus, a significant level of public interest exists based on the disparagement claims of the American Indians.

Clearly the public interest outlined for the § 2(d) likelihood of confusion context is more closely related to the Act's stated purpose of protecting the public from spurious goods, [FN182] than the public interest outlined for the § 2(a) disparagement context. This fact should not be surprising and should not be determinative of whether the public interests of these two provisions exist at an equivalent level. The very structure of these two provisions dictates that this difference would exist; the likelihood of confusion claim belongs solely to a trademark owner, while the disparagement claim may be brought by any disparaged party without requiring the party to own a trademark protected by the Act. The expectation is that the public interest will take a different form in the disparagement provision because of this, and indeed that is the case. The public interest in the likelihood of confusion provision involves a single mechanism, the marketplace. On the other hand, the public interest in the disparagement provision involves a more diffuse set of mechanisms, which include social interactions and public education. The common thread is that harming the public interest through either provision ultimately has a negative effect on our nation's economy, [FN183] and it cannot be said that one's impact on the economy is larger than the other. [FN184] Our nation's history of social justice and focus on public education should not be ignored or minimized as to their impact on our economy. [FN185] Social justice and public education together establish a vital and substantial public interest that is at stake within § 2(a) disparagement claims brought to end the use of American Indian nicknames.

**\*1166** Thus, the public interest in disparagement cases involving American Indian nicknames used by sports teams exists at an equivalent level as compared to the public interest in likelihood of confusion cases (although in a different form). The public interest has been harmed due to the disparagement of American Indians through the "savage Indian" myth, and it is this harm to the public interest that should be upheld as sufficient to set aside laches through the public interest exception whenever the disparagement of American Indians is not in doubt. [FN186]

#### Conclusion

The use of American Indian nicknames by sports teams is a horrible tradition within the popular culture of the United States and is a tradition that should no longer be tolerated. The social avenues of demonstrations and pressure through grass roots public opinion have helped to change the American Indian nicknames of many high schools and universities, but have done nothing to change these same nicknames of professional sports teams. The approach of removing the trademark protection of these still unchanged sports team nicknames through the use of the Lanham Act will hopefully result in lost revenues to these teams, and will force the teams to change to a non-American Indian nickname in order to regain trademark protection and lost revenue levels. The recent application of laches to Lanham Act § 2(a) disparagement litigation aimed at eliminating trademark protection for American Indian nicknames is a large roadblock in removing this protection, but this roadblock can be overcome.

This Note has demonstrated that one way to overcome laches is through the public interest exception. The harms that are created by American Indian nicknames through the "savage Indian" myth have been around for too long and are still harms that American Indians face today. Recognizing the true magnitude of these harms from the perspective of the American Indian, assuming that these harms can be proven to exist, will shed light on the significant level of public interest that is interwoven into these nicknames, and should ultimately allow for the otherwise valid defense of laches to be overcome by the public interest exception. The eventual demise of the use of American Indian nicknames by sports teams will assist our nation to see the American Indian not as a mythical image of the past, but as a fellow American citizen of the present. And although the nonexistence of American Indian nicknames in sports likely will not end the "savage Indian" myth altogether, it will surely be one large step in the right direction.

[FN1]. J.D. Candidate 2005, Indiana University School of Law-Bloomington; B.A. 1999, Economics and Sociology, Indiana University-Bloomington. I would like to thank Professor David Williams for his helpful input on source material for Part I of this Note, and Steve Sharpe for his assistance and comments on earlier drafts of this Note. I would also like to thank my grandparents, parents, and family for their constant support and influence. Finally, I would like to thank my wife Tammy for her thoughts on earlier versions of this Note, and most importantly for being my inspiration and true love.

[FN1]. Arena overview, at [http://www.theralph.com/new2/Arena\\_Info\\_Section/Arena\\_Info\\_Main.htm](http://www.theralph.com/new2/Arena_Info_Section/Arena_Info_Main.htm) (last visited Jan. 3, 2005).

[FN2]. Photographs, at [http://www.zudnic.net/bob/graphics/Univ.\\_of\\_North\\_](http://www.zudnic.net/bob/graphics/Univ._of_North_)

Dakota\_CHTGFolder/Leather\_Seat.jpg (last visited Jan. 3, 2005).

[FN3]. Photographs, at [http://www.zudnic.net/bob/graphics/Univ.\\_of\\_North\\_Dakota\\_CHTGFolder/Solid\\_Marble\\_Sioux.jpg](http://www.zudnic.net/bob/graphics/Univ._of_North_Dakota_CHTGFolder/Solid_Marble_Sioux.jpg) (last visited Jan. 3, 2005).

[FN4]. David Dodds, Ralph Englestad Arena: NCAA minority panel questions arena as tourney site, Grand Forks Herald, Oct. 16, 2002 available at, <http://www.grandforks.com/mld/grandforksherald/news/local/4294107.htm> (last visited Jan. 3, 2005).

[FN5]. See, e.g., Robert M. Utley, The Indian Frontier of the American West 1846-1890, at 84-85 (Ray A. Billington et al. eds., 1984) (explaining the removal of the Navajo Indians to a wasteland known as Bosque Redondo).

[FN6]. Thankfully, tragedies such as the massacre at Wounded Knee and the battle of the Little Big Horn are not the types of struggles that are occurring today. Instead, American Indians face the shrinking of tribal court jurisdiction through unfavorable non-tribal court decisions. See [Nevada v. Hicks, 533 U.S. 353 \(2001\)](#) (limiting the reach of tribal jurisdiction on Indian Country so as not to reach civil claims against state officials for harms committed on Indian Country); [Washington v. Confederated Tribes of Colville Indian Reservation, 447 U.S. 134 \(1980\)](#) (extending the tax jurisdiction of the state onto Indian Country to tax sales of goods to non-Indians); [Oliphant v. Suquamish Indian Tribe, 435 U.S. 191 \(1978\)](#) (eliminating tribal jurisdiction over non-Indian versus non-Indian violent crimes committed on Indian Country). The line of cases concerning shrinking tribal jurisdiction will not be analyzed in this Note, but are of importance insofar as tribal jurisdiction is an area in which American Indians are feeling the negative impact of the "savage Indian" myth described in Part I.

[FN7]. See American Indian Sport Team Mascots, at <http://aistm.org/1chronologypage.html> (last visited Jan. 3, 2005).

[FN8]. See H.W. Peterson, Debunking Those Lingering Myths about American Indians (mentioning the myth that Indians are "basically a savage and barbaric people"), at <http://coas.missouri.edu/mas/articles/articledebunking.html> (last visited Jan. 3, 2005); Kentucky-Uruguay Cultural Heritage Education Project, Separating Fact From Fiction: Myths About Kentucky's Native Peoples (discussing the "savage Indian" myth), at [http://www.dinacyt.gub.uv/proykent/boone\\_myths.htm](http://www.dinacyt.gub.uv/proykent/boone_myths.htm) (last visited Jan. 3, 2005).

[FN9]. See American Indian Sport Team Mascots, *supra* note 7. Among the schools that have changed names are universities such as the Miami University RedHawks (formerly the Redskins), the St. John's University Red Storm (formerly the Redmen), and the Stanford University Cardinal (formerly the Indians). See *id.* As of 1998, nearly one-third of all public schools in the state of Wisconsin that used American Indian nicknames had ceased such use. *Id.*

[FN10]. Included among the numerous universities currently using American Indian nicknames are the University of North Dakota Fighting Sioux, the University of Illinois Fighting Illini, and the University of Utah Utes.

[FN11]. There are currently six professional sports teams that use American Indian nicknames within the National Football League ("NFL"), National Basketball Association ("NBA"), National Hockey League ("NHL"), and Major League Baseball ("MLB"). They are the Kansas City Chiefs (NFL), the Washington Redskins (NFL), the Golden State Warriors (NBA), the Chicago Blackhawks (NHL), the Atlanta Braves (MLB), and the Cleveland Indians (MLB).

[FN12]. See Russ Jamieson, Native Americans plan protests at World Series, at [http://www.cnn.com/US/9510/mascot\\_protest/](http://www.cnn.com/US/9510/mascot_protest/) (Oct. 21, 1995) (stating that the American Indian Movement ("AIM") conducted protests in 1991 and 1992 against the Atlanta Braves team nickname); Mordecai Spektor, Still not the REAL Indians, at <http://nativenet.uthscsa.edu/archive/nl/9505/0012.html> (May 1, 1995) (stating that protests also occurred at the 1992 Super Bowl against teams using American Indian nicknames).

[FN13]. See, e.g., American Indian Sport Team Mascots, *supra* note 7; Jamieson, *supra* note 12 (stating that after the 1991 and 1992 protests AIM moved on to file lawsuits in four cities where professional sports teams have American

Indian nicknames in hopes of changing the nicknames).

[FN14]. [284 F. Supp. 2d 96 \(D.D.C. 2003\)](#).

[FN15]. [Id. at 99](#).

[FN16]. [15 U.S.C. § 1052\(a\) \(2000\)](#).

[FN17]. [Pro-Football, Inc., 284 F. Supp. 2d at 99](#).

[FN18]. [Id. \(citing Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1749 \(T.T.A.B. 1999\), 1999 WL 37907\)](#).

[FN19]. [Id. at 145](#).

[FN20]. For example, the Kansas City Chiefs have active trademarks with American Indian references dating back to at least 1974 (registration number 0982132), the Washington Redskins have such trademarks dating back to at least 1967 (registration number 0836122), and the Atlanta Braves have such trademarks dating back to at least 1967 as well (registration number 0829309). United States Patent and Trademark Office, at <http://www.uspto.gov/index.html> (last visited Jan. 3, 2005). In comparison, the trademarks of schools tend to be more recently created. For example, the University of Illinois' "Fighting Illini" trademark dates back to only 1999 (registration number 2230527). [Id.](#) Other schools, such as the University of Utah and the University of North Dakota, do not possess such trademarks. See [id.](#)

[FN21]. Searches conducted through the United States Patent and Trademark Office website show that all six professional sports franchises with American Indian nicknames in the NFL, NBA, NHL, and MLB rely on trademark protection for their nicknames, and a few of the universities with American Indian nicknames also rely on trademark protection. See [id.](#) Thus, the laches problem is most troublesome in reference to professional sports franchises. Even where trademark protection exists for school nicknames it is less troublesome because pressure from local protests and demonstrations have been at least adequate in changing nicknames at the high school and college levels. See Paula L. Wagoner, *They Treated Us Just Like Indians* 23-31, 131-132 (Raymond J. DeMallie & Douglas R. Parks eds., 2002); see also [supra](#) note 9 and accompanying text. Protest and demonstration pressure has not worked at all to change professional sports team nicknames.

[FN22]. This avenue will be applicable to disparagement claims against the trademark protected use of American Indian nicknames by sports teams that are brought before the TTAB and at any further level of litigation or appeal associated with such a claim. This avenue could be immediately applied to the pending appeal of the Pro-Football decision. See [infra](#) note 123.

[FN23]. This Note will not analyze the evidentiary problems of the Pro-Football case. For a discussion of the evidentiary problems, see Rachel Clark Hughey, *The Impact of Pro-Football, Inc. v. Harjo on Trademark Protection of Other Marks*, 14 *Fordham Intell. Prop. Media & Ent. L.J.* 327 (2004).

[FN24]. This link of the harms to the public interest and the public interest exception to laches is the main point of this Note and is discussed in detail in Part III.

[FN25]. See, e.g., Fergus M. Bordewich, *Killing the White Man's Indian: Reinventing Native Americans at the End of the Twentieth Century* 173-74 (1996) (explaining that anthropologists were freely able to rob the graves of American Indians, while robbing the graves of any other racial group would have been a crime); Ward Churchill, *Bringing the Law Home: Application of the Genocide Convention in the United States*, in *Indians Are Us?: Culture and Genocide in Native North America* 11, 39 (1994) (explaining the 1970s policy of the Bureau of Indian Affairs Health Service to sterilize American Indian women on an involuntary basis); Richard Drinnon, *Facing West: The Metaphysics of Indian-Hating and Empire-Building* 75 (1980) (stating that American Indians were considered to be beastly and degradations of human beings).

[FN26]. David H. Getches et al., *Cases and Materials on Federal Indian Law* 84-87 (4th ed. 1998).

[FN27]. [21 U.S. \(8 Wheat.\) 543 \(1823\)](#).

[FN28]. [Id. at 590](#).

[FN29]. See Bordewich, *supra* note 25, at 45 (stating that in 1830 the Indian Removal Act was passed).

[FN30]. See *id.* at 47; Utley, *supra* note 5.

[FN31]. See Bordewich, *supra* note 25, at 47; see, e.g., Utley, *supra* note 5.

[FN32]. Indian Land Working Group, *Impact of Allotment on Indian Lands* (stating that this policy period reduced tribal lands and tore apart American Indian culture), at <http://www.ilwg.net/impact.htm> (last visited Jan. 3, 2005).

[FN33]. *Id.*

[FN34]. *Id.* (stating that statutorily forced sales of American Indian reservation land to Euro-Americans were in direct opposition to established treaties, and that the treaty terms were ignored due to the Euro-American greed for the reservation lands). Similar to the assimilation and allotment period was the termination policy period, which lasted from 1945-1961. See Getches et al., *supra* note 26, at 204. This period saw some American Indian reservations completely eliminated by the Federal government in hopes of creating rapid assimilation of the American Indians to the majority culture. *Id.*

[FN35]. See Drinnon, *supra* note 25, at 464.

[FN36]. *Id.* at 70, 75, 96, 103 (stating that the American Indians were deprived of liberty because the founders of the United States generally perceived the American Indians as savages, just like many other Euro-Americans perceived the American Indians).

[FN37]. See Bordewich, *supra* note 25, at 53 (stating that the population of American Indians in what is now the continental United States stood at merely 250,000 in 1900 as compared to the 2.6 million American Indian inhabitants at the time of Euro-American settlement).

[FN38]. See Ward Churchill, *In the Matter of Julius Streicher: Applying Nuremburg Precedents in the United States, in Indians Are Us?: Culture and Genocide in Native North America*, *supra* note 25, at 73, 79 (1994) (stating that the public acquiesces in the past genocide of American Indians due to the dehumanizing portrayal of American Indians as "strange, perverted, ridiculous, and often very dangerous things of the past") (emphasis in original). American civic ideology such as the "manifest destiny" of the United States contributes to this idea of inevitability.

[FN39]. See *id.* at 79 (stating that the American Indian has been "consigned to another dimension . . . , drifting as myths through the vast panorama of Americana").

[FN40]. See Getches et al., *supra* note 26, at 224 (stating that self-determination is the policy era that has existed since 1961). The self-determination policy's primary goal is to strengthen the autonomy of American Indians and tribes, such that the tribes can decide if they prefer to run certain administrative functions autonomously or if they would rather keep certain functions under the control of the Bureau of Indian Affairs. *Id.* at 227.

[FN41]. See Churchill, *supra* note 38, at 79-81.

[FN42]. See *supra* note 8.

[FN43]. See United States Patent and Trademark Office, *supra* note 20 (referencing Cleveland Indians trademark registration number 1590703, Atlanta Braves trademark registration number 0829309, and Washington Redskins trademark registration number 0836122).

[FN44]. This representation derives from the trademarks, and is further enhanced through actions associated with the trademarks (such as the "tomahawk chop" at Atlanta Braves baseball games).

[FN45]. See Infoplease, U.S. Federal and State Indian Reservations, at <http://www.infoplease.com/ipa/A0778676.html> (last visited Jan. 3, 2005).

[FN46]. More than two-thirds of all American Indians live off reservation in urban, large city environments. These American Indians are commonly referred to as "urban Indians." Donald L. Fixico, *The Urban Indian Experience in America 188* (2000).

[FN47]. *Id.* at 33.

[FN48]. See *id.* at 33, 37 (stating that American Indians that do not fit the savage stereotype are frequently not seen as American Indians at all).

[FN49]. Based on the 2000 United States census, American Indians (counting individuals that claimed to be multi-racial including American Indian as one of the races) made up only 1.5% of the overall United States population. The American Indian and Alaska Native Population: 2000, at 3 (Feb. 2002) (stating the total American Indian population as slightly more than 4.1 million persons), at <http://www.census.gov/prod/2002pubs/c2kbr01-15.pdf> (last visited Jan. 3, 2005).

[FN50]. *Id.* at 5. These eight states are Alaska, Arizona, Montana, New Mexico, North Dakota, Oklahoma, South Dakota, and Wyoming. *Id.*

[FN51]. United States Commission on Civil Rights, Statement of the U.S. Commission on Civil Rights on the Use of Native American Images and Symbols as Sports Symbols (stating that even where such symbols are used for a positive purpose, they create false perceptions which keep individuals from understanding the true American Indian of today), at <http://aistm.org/2001usccr.htm> (Apr. 13, 2001).

[FN52]. [533 U.S. 353 \(2001\)](#).

[FN53]. See [County of Yakima v. Confederated Tribes and Bands of the Yakima Indian Nation, 502 U.S. 251 \(1992\)](#) (deciding that the state can tax any alienable land held by a tribe or a tribal member on Indian Country); [Cotton Petroleum Corp. v. New Mexico, 490 U.S. 163 \(1989\)](#) (deciding that states have jurisdiction to tax non-Indians for oil and gas lease activity on Indian Country); see also *supra* note 6.

[FN54]. [Hicks, 533 U.S. at 355-57](#).

[FN55]. *Id.* at 373.

[FN56]. *Id.* at 365 (quoting [Anderson v. Creighton, 483 U.S. 635, 638 \(1987\)](#)).

[FN57]. Joseph William Singer, [Canons of Conquest: The Supreme Court's Attack on Tribal Sovereignty, 37 New Eng. L. Rev. 641, 645 \(2003\)](#) (stating that the Supreme Court is treating the tribal courts as "inherently suspect").

[FN58]. Fixico, *supra* note 46, at 35.

[FN59]. [347 U.S. 483, 493-94 \(1954\)](#). The analogy to *Brown* is used to show the consistency in the type of harm (although the harm may be different in scope) suffered by African-Americans during the time of "separate-but-equal" laws and that suffered by American Indians currently. Both result in stigmatization and sub-humanization of the victims by the majority.

[FN60]. *Id.* at 494 (stating that the stigmatization of inferiority negatively "affects the motivation of a child to learn").

[FN61]. [United States Commission on Civil Rights, supra note 51.](#)

[FN62]. See Churchill, *supra* note 38, at 82 ("Understand that the treatment of Indians in American popular culture is not 'cute' or 'amusing' or some sort of 'good, clean fun.' Know that it causes real pain to real people. Know that it threatens our very survival.") (emphasis in original).

[FN63]. [United States Commission on Civil Rights, supra note 51.](#)

[FN64]. [284 F. Supp. 2d 96 \(D.D.C. 2003\).](#)

[FN65]. [15 U.S.C. § 1052 \(2000 & Supp. 2004\).](#)

[FN66]. Ann K. Wooster, Annotation, "Post-Sale Confusion" in Trademark or Trade Dress Infringement Actions Under § 43 of Lanham Trade-Mark Act ([15 U.S.C.A. § 1125](#)), [145 A.L.R. Fed. 407 \(1998\)](#) (quoting S. Rep. No. 79- 1333 (1946)).

[FN67]. See [Pro-Football, Inc., 284 F. Supp. 2d at 102](#). The use of § 2(a) is important because there is no statutory time limit on § 2(a) claims. [15 U.S.C. § 1052](#). The only limitation is the equitable doctrine of laches.

[FN68]. [Pro-Football, Inc., 284 F. Supp. 2d at 144.](#)

[FN69]. The negative economic consequences would likely have to result from competitors using the formerly protected nickname on merchandise and the loss of investments from sponsor companies of the team due to the tenuous nature of the formerly protected nickname. Such negative consequences are possible because the sales of professional sports team apparel is a billion-dollar-per-year industry, and some universities make in excess of a million dollars per year selling similar merchandise. See Hughey, *supra* note 23, at 332.

[FN70]. [15 U.S.C. § 1052\(a\)](#) (emphasis added).

[FN71]. The TTAB decision, which preceded the Pro-Football court's decision, did not find the term "Redskins" to be immoral or scandalous to the public at large, and therefore the first clause of § 2(a) was not analyzed by the Pro-Football court. [Pro-Football, Inc., 284 F. Supp. 2d at 99-100](#). Thus, the immoral or scandalous matter clause of § 2(a) will not be examined in this Note.

[FN72]. The provision of the second clause discussing "contempt or disrepute" will not be discussed in specific, because the TTAB and the Pro-Football court have cast aside this provision of the second clause as being nothing more than duplicative of the disparagement provision of the same clause. See [Pro-Football, Inc., 284 F. Supp. 2d at 113-14](#); [Harjo v. Pro-Football, Inc., 50 U.S.P.Q.2d 1705, 1766 \(T.T.A.B. 1999\)](#), [1999 WL 375907, at \\*38](#). Likewise, the provision of the second clause discussing false suggestions will not be discussed in this Note as a means for eliminating the trademark protection of teams, because it was not analyzed by the Pro-Football court either. [Pro-Football, Inc., 284 F. Supp. 2d at 99-100](#). The false suggestion provision will be discussed in Part III.A. as a comparison to the disparagement provision.

[FN73]. Kristine A. Brown, [Native American Team Names and Mascots: Disparaging and Insensitive or Just a Part of the Game?](#), 9 Sports Law. J. 115, 124 (2002) (citing [Greyhound Corp. v. Both Worlds, Inc., 6 U.S.P.Q.2d 1635 \(T.T.A.B. 1988\)](#)).

[FN74]. *Id.* The use of the term "plaintiff" here is consistent with a party in the position of the American Indians in Pro-Football, even though the American Indians are not the plaintiffs in Pro-Football. In the Pro-Football case before the District Court, it is Pro-Football that is using laches despite the fact that Pro-Football is the plaintiff. [Pro-Football, Inc., 284 F. Supp. 2d at 99](#). This is able to occur because the Act allows a party who receives an unfavorable decision by the TTAB to bring a civil action to the District Court for the District of Columbia if there is diversity of the parties. [15 U.S.C. § 1071\(b\)\(1\), \(4\) \(2004\)](#). Thus, the Pro-Football case is not an appeal of the TTAB decision, it is a claim based on a cause of action created by [§ 1071](#). To avoid confusion, the terms "plaintiff" and "defendant" will not be used at all in reference to Pro-Football in this Note. Wherever used in reference to other

cases, the term "plaintiff" should be understood to mean a party in the position of the American Indians, while the term "defendant" should be understood to mean a party in the position of Pro-Football.

[FN75]. [Brown](#), supra note 73, at 124 (citing [Greyhound Corp.](#), 6 U.S.P.Q.2d at 1639). The two-part test set forth by the TTAB in [Greyhound Corp.](#) should be seen as analogous to the two-part test set forth by the TTAB in [Harjo](#), 50 U.S.P.Q.2d at 1741, and agreed upon by the district court. See [Pro-Football, Inc.](#), 284 F. Supp. 2d at 125-28 (stating that the two-part test looks at the meaning of the word used as the nickname, including its connection to the referenced group, and looks at whether the word is shown to be disparaging to a "substantial composite" of the referenced group).

[FN76]. See [Brown](#), supra note 73, at 124-25 (citing Jack Achiezer Guggenheim, [Renaming the Redskins \(And the Florida State Seminoles?\): The Trademark Registration Decision and Alternative Remedies](#), 27 Fla. St. U. L. Rev. 287, 297 (1999) (citing [In re Hines](#), 31 U.S.P.Q.2d 1685, 1688 (T.T.A.B. 1994))); see also [Pro-Football, Inc.](#), 284 F. Supp. 2d at 124-25.

[FN77]. [Pro-Football, Inc.](#), 284 F. Supp. 2d at 125.

[FN78]. [15 U.S.C. § 1052\(d\)](#) (Supp. 2004).

[FN79]. See infra Part II.C; see also [15 U.S.C. § 1069 \(2004\)](#) (allowing for laches to be applicable to the Lanham Act).

[FN80]. [Black's Law Dictionary](#) 396 (2d pocket ed. 2001).

[FN81]. See, e.g., [Univ. of Pittsburgh v. Champion Prods. Inc.](#), 686 F.2d 1040, 1044 (3d Cir. 1982) (citing [Gruca v. United States Steel Corp.](#), 495 F.2d 1252, 1258 (3d Cir. 1974)); [Anheuser-Busch v. Du Bois Brewing Co.](#), 175 F.2d 370, 373-74 (3d Cir. 1949), cert. denied, 339 U.S. 934 (1950).

[FN82]. [Pro-Football, Inc.](#), 284 F. Supp. 2d at 136-37.

[FN83]. [Id.](#) at 124.

[FN84]. See, e.g., [Univ. of Pittsburgh](#), 686 F.2d at 1044 (citing [Gruca](#), 495 F.2d at 1258); [Anheuser-Busch](#), 175 F.2d at 373-74. In [Pro-Football](#) the delay prong of the test is broken into two components (substantial delay and notice of the trademarks during the delay), thus giving the basic two-prong test three components for the overall analysis. See [Pro-Football, Inc.](#), 284 F. Supp. 2d at 139 (citing [Bridgestone/Firestone Research, Inc. v. Auto. Club de L'Ouest de la France](#), 245 F.3d 1359, 1361 (Fed. Cir. 2001)); see also infra note 111 and accompanying text.

[FN85]. [Univ. of Pittsburgh](#), 686 F.2d at 1044.

[FN86]. [Id.](#) (citing [Anheuser-Busch](#), 175 F.2d at 374).

[FN87]. [Id.](#) (citing [Anheuser-Busch](#), 175 F.2d at 374).

[FN88]. [Id.](#) (citing [Anheuser-Busch](#), 175 F.2d at 373-74); see also [Hot Wax, Inc. v. Turtle Wax, Inc.](#), 191 F.3d 813, 824 n.3 (7th Cir. 1999) (quoting [James Burrough, Ltd. v. Sign of Beefeater, Inc.](#), 572 F.2d 574, 578 (7th Cir. 1978)).

[FN89]. [Univ. of Pittsburgh](#), 686 F.2d at 1044-45 (citing [Menendez v. Holt](#), 128 U.S. 514, 523-24 (1888)).

[FN90]. [Hot Wax, Inc.](#), 191 F.3d at 821 (citing [Wilson v. Garcia](#), 471 U.S. 261, 266-67 (1985)); see also [Santana Prods., Inc. v. Bobrick Washroom Equip., Inc.](#), 249 F. Supp. 2d 463, 497-98 (M.D. Pa. 2003) (quoting [Wilson](#), 471 U.S. at 266).

[FN91]. [Tandy Corp. v. Malone & Hyde, Inc.](#), 769 F.2d 362, 365-66 (6th Cir. 1985), cert. denied, 476 U.S. 1158 (1986) (stating that the presumption enables objectivity and clarity of the analysis); see also [AmBrit, Inc. v. Kraft](#),



[Inc.](#), 812 F.2d 1531, 1546 (11th Cir. 1986), cert. denied, 481 U.S. 1041 (1987).

[FN92]. [Bridgestone/Firestone Research, Inc.](#), 245 F.3d at 1361 (citing [Cornetta v. United States](#), 851 F.2d 1372, 1380 (Fed. Cir. 1988)); see also [Analytic Recruiting, Inc. v. Analytic Res., L.L.C.](#), 156 F. Supp. 2d 499, 516 (E.D. Pa. 2001) (citing [Pappan Enters., Inc. v. Hardee's Food Sys., Inc.](#), 143 F.3d 800, 804 (3d Cir. 1998)); [Fed. Express Corp. v. United States Postal Serv.](#), 75 F. Supp. 2d 807, 814 (W.D. Tenn. 1999). Contra [Univ. of Pittsburgh](#), 686 F.2d at 1045 (stating that the burden of proof shifts to the plaintiff if the claim is brought outside of the statute of limitations) (citing [Gruca](#), 495 F.2d at 1258-59; [Burke v. Gateway Clipper, Inc.](#), 441 F.2d 946, 949 (3d Cir. 1971)). The Federal Express court correctly stated that the burden of proof remains with the defendant, but the court mistakenly interpreted the presumption of an unreasonable delay, as explained by the Tandy court, as a presumption that laches exists on a per se basis. [Fed. Express Corp.](#), 75 F. Supp. 2d at 814. The presumption of an unreasonable delay only applies to the delay prong of the laches test, and the prejudice portion of the analysis still must be proved to exist. [Tandy Corp.](#), 769 F.2d at 366-67. Therefore, the presumption of an unreasonable delay is not equivalent to a mandated application of laches.

[FN93]. See [Restatement \(Third\) of Unfair Competition § 31](#) cmt. c (1995). This excuse is not readily applicable to American Indians who are trying to stop the use of American Indian nicknames by sports teams, because the parties involved have not likely been conducting settlement meetings throughout the period of delay.

Trademark law is a subset of unfair competition law, and trademark law has been codified almost in its entirety by the Act. [Moseley v. V Secret Catalogue, Inc.](#), 537 U.S. 418, 428 (2003). Thus, it is appropriate to look at the manner in which laches is applied to unfair competition law.

[FN94]. [Analytic Recruiting, Inc.](#), 156 F. Supp. 2d at 518 (quoting [Guardian Life Ins. Co. of Am. v. Am. Guardian Life Assur. Co.](#), 943 F. Supp. 509, 520-21 (E.D. Pa. 1996)) (citing [Univ. of Pittsburgh](#), 686 F.2d at 1045); [Parrot Jungle Inc. v. Parrot Jungle Inc.](#), 512 F. Supp. 266, 270 (S.D.N.Y. 1981).

[FN95]. See [Restatement \(Third\) of Unfair Competition § 31](#) cmt. c (1995). This excuse does not appear to be a viable option for American Indians trying to stop the use of American Indian nicknames by sports teams either, because the professional and major college sports teams of the United States have already become national in their marketing and largely international as well. Thus, barring the unprecedented expansion of a professional sports team onto a new continent, the likelihood of there being a change into a new market that would not be considered normal growth is very small. The other limitation with this excuse is that a successful use of it would only bar the trademark from being used in that single new market, and would do nothing to stop the use of the trademark within a team's current markets. *Id.*

The excuses listed here and in note 93, *supra*, are mentioned as background and to show that other avenues were contemplated besides the public interest exception for refuting the application of laches. This strengthens the notion that the public interest exception is the best avenue to pursue.

[FN96]. [Bridgestone/Firestone Research, Inc.](#), 245 F.3d at 1362; see also [Univ. of Pittsburgh](#), 686 F.2d at 1045.

[FN97]. [Bridgestone/Firestone Research, Inc.](#), 245 F.3d at 1362.

[FN98]. See *id.* (stating that monetary prejudice is "economic prejudice based on loss of time or money or foregone opportunity").

[FN99]. [AmBrit, Inc. v. Kraft](#), 812 F.2d 1531, 1546 n.82 (11th Cir. 1986); see [Pro-Football, Inc. v. Harjo](#), 284 F. Supp. 2d 96, 143 (D.D.C. 2003). Although AmBrit is a trade dress infringement claim under § 43(a) of the Act (involving similar product wrappers and packaging on two different products), the touchstone of the analysis in such a case is "likelihood of confusion." [AmBrit, Inc.](#), 812 F.2d at 1535, 1538. Thus, the logic of the AmBrit court applies in a consistent manner to § 2(d) likelihood of confusion cases.

[FN100]. [AmBrit, Inc.](#), 812 F.2d at 1546 n.82. The money spent on the services of the company that would have been spent anyway for the continuing business is not of importance to the prejudice analysis. *Id.*; see also [Pro-Football, Inc.](#), 284 F. Supp. 2d at 143 (citing [Hot Wax, Inc. v. Turtle Wax, Inc.](#), 191 F.3d 813, 824 (7th Cir. 1999)). An argument that sports teams are not prejudiced because they do not spend money to promote their trademarks is

not likely to be successful. As any individual driving on an interstate in a major sports city can see out of a car window on any number of billboards or can see while watching television on any number of commercials, trademarked team nicknames are heavily marketed. The marketing creates sales of merchandise, and sales are bolstered by trademark protection. See *supra* note 69. Thus, this money likely would not be spent, at current levels, to promote the trademarks but for the delay.

[FN101]. [Bridgestone/Firestone Research, Inc., 245 F.3d at 1363](#) (citing [Hot Wax, Inc., 191 F.3d at 821](#); [A.C. Aukerman Co. v. R.L. Chaides Constr. Co., 960 F.2d 1020, 1042 \(Fed. Cir. 1992\)](#)); see, e.g., [Pro-Football, Inc., 284 F. Supp. 2d at 139](#).

[FN102]. The public's interests are harmed when trademark confusion interferes with consumers' reasons for purchasing specific goods rather than competing goods. Such reasons include the quality of the goods, where the goods were made, who made the goods, and what social values the goods represent. Trademark confusion can cause consumers to purchase goods that they otherwise would not have purchased. This in turn may lead to a decline in consumer confidence and trust in the marketplace. Thus, the ultimate harm to the public interest may be the harm to the economy as a whole. This harm to the public interest has been upheld as showing that a sufficient level of public interest exists to support the public interest exception. See [Ultra-White Co. v. Johnson Chem. Indus., Inc., 465 F.2d 891, 893-94 \(C.C.P.A. 1972\)](#).

[FN103]. See *id.*

[FN104]. [Bridgestone/Firestone Research, Inc., 245 F.3d at 1363](#); [Resorts of Pinehurst, Inc. v. Pinehurst Nat. Corp., 148 F.3d 417, 423 \(4th Cir. 1998\)](#); [Kason Indus., Inc. v. Component Hardware Group, Inc., 120 F.3d 1199, 1207 \(11th Cir. 1997\)](#) (stating that injunctive relief may be given where monetary damages are barred and that intentional infringement cases are not "the only cases where injunctive relief might be appropriate despite a plaintiff's delay"); [Harley-Davidson, Inc. v. Estate of O'Connell, 13 F. Supp. 2d 271, 285 \(N.D.N.Y. 1998\)](#).

[FN105]. [Pro-Football, Inc., 284 F. Supp. 2d at 99](#). The TTAB concluded that the marks were not to be cancelled on scandalous matter grounds. *Id.*

[FN106]. *Id.* at 105-07.

[FN107]. *Id.* at 145. The court noted that a major problem with this case is the lack of evidence on the record, and the court further noted that the decision should not be understood as a decision on whether the term "redskins" is disparaging to American Indians. *Id.* at 99, 145. This first ground for overturning the TTAB's decision is evidentiary-based and is not the focus of this Note. See *supra* note 23.

[FN108]. [Pro-Football, Inc., 284 F. Supp. 2d at 145](#). Laches is not excluded from claims made under § 2(a). *Id.* at 137 (quoting [Pro-Football, Inc. v. Harjo, 57 U.S.P.Q.2d \(BNA\) 1140, 1145 \(D.D.C. 2000\)](#)). This Note will focus solely on the second ground on which the TTAB's decision was overturned (i.e., laches).

[FN109]. [Pro-Football, Inc., 284 F. Supp. 2d at 136](#) (quoting [NAACP v. NAACP Legal Def. & Educ. Fund, Inc., 753 F.2d 131, 137 \(D.C. Cir. 1985\)](#)).

[FN110]. [Id. at 136-37](#). Infringement is an act that interferes with a trademark owner's rights in reference to the trademark. Black's Law Dictionary 348 (2d pocket ed. 2001). Thus, a likelihood of confusion case is simply a subset of the larger category of trademark infringement cases. Cf. [Dastar Corp. v. Twentieth Century Fox Film Corp., 539 U.S. 23, 32 n.5 \(2003\)](#) (stating that § 43(a) provides trademark infringement relief against any description that is likely to cause confusion as to sponsorship of goods).

[FN111]. [Pro-Football, Inc., 284 F. Supp. 2d at 137, 139](#); see also *supra* note 84 (explaining that the basic two-prong laches test is broken into three components by the Pro-Football court).

[FN112]. [Pro-Football, Inc., 284 F. Supp. 2d at 137](#).

[\[FN113\]. Id. at 140, 144.](#)

[\[FN114\]. Id. at 140.](#) The court stated that "whether a Lanham Act claim has been brought within the analogous state statute of limitations is not the sole indicator of whether laches may be applied in a particular case." [Id. at 139](#) (quoting [Hot Wax, Inc. v. Turtle Wax, Inc.](#), 191 F.3d 813, 821-22 (7th Cir. 1999)). Thus, the court did not look to the analogous state statute of limitations to decide whether the delay was unreasonable. See supra note 90 and accompanying text.

[\[FN115\]. Pro-Football, Inc., 284 F. Supp. 2d at 140.](#)

[\[FN116\]. Id.](#) In analyzing the 1990 "Redskinettes" trademark, the district court broke its own rule that each of the trademarks must be analyzed on its own merits when applying laches. See supra text accompanying note 112. The court should not be looking at the overall context of this case when analyzing this single particular trademark. Anything that occurred before the trademark was ever published is inconsequential to the analysis as well. See infra text accompanying note 118 (stating that the laches clock begins to run upon publication). This trademark was published on April 24, 1990, United States Patent and Trademark Office, supra note 20 (referencing trademark registration number 1606810), and the original claim in this case was filed in September 1992. [Pro-Football, Inc., 284 F. Supp. 2d at 96.](#) Thus, not even two-and-one-half years separate the publication date from the claim date. Therefore, an unreasonable delay has not facially occurred and the use of laches in regards to the "Redskinettes" trademark appears to be highly questionable, if not fully erroneous.

[\[FN117\]. Pro-Football, Inc., 284 F. Supp. 2d at 140.](#)

[\[FN118\]. Id.](#) (citing [Turner v. Hops Grill & Bar, Inc.](#), 52 U.S.P.Q.2d (BNA) 1310, 1312-13 n.3 (T.T.A.B. 1999)). It is worth noting that the Pro-Football court often refers to the registration date, even though the publication date starts the laches clock. See supra text accompanying notes 106, 114, 116. This conflation of terms is harmless, because the registration date will always create a shorter laches timeframe when compared to a timeframe beginning with the publication date. Thus, if laches exists based on the registration date, then it will also exist based on the publication date.

[\[FN119\]. Id. at 141.](#)

[\[FN120\]. Id. at 142.](#)

[\[FN121\]. Id.](#) (citing [Bridgestone/Firestone Research, Inc. v. Auto. Club de L'Ouest de la France](#), 245 F.3d 1359, 1362 (Fed. Cir. 2001)).

[\[FN122\]. Id. at 143.](#)

[\[FN123\]. Id. at 144.](#) It is worth noting that the court neglects to make any citations or references to cases that make up the "case law" that the court states as supporting the conclusion. *Id.*

[\[FN124\]. Id.](#) Harjo and the other six American Indians have appealed the decision of the District Court. See James V. Grimaldi, Taking a New Team into Court, Wash. Post, Nov. 3, 2003, at E1. For further information on the pending appeal of this case, see [Pro-Football, Inc. v. Harjo](#), No. 03-7162 2004 U.S. App. LEXIS 24616 (D.C. Cir. Nov. 24, 2004) (considering a motion to strike the amicus curiae brief of the National Congress of American Indians).

[\[FN125\]. Pro-Football, Inc., 284 F. Supp. 2d at 138](#) (citing [Bridgestone/Firestone Research, Inc.](#), 245 F.3d at 1363). In *Ultra-White*, the United States Court of Customs and Patent Appeals stated that within [§ 1052](#) the public interest is a consideration, and further stated that the public interest is the dominant consideration in situations where confusion is not only likely to occur, but is not in doubt (in *Ultra-White* [§ 2\(d\)](#) of [§ 1052](#) was applicable). [Ultra-White Co. v. Johnson Chem. Indus., Inc.](#), 465 F.2d 891, 893-94 (C.C.P.A. 1972).

[\[FN126\].](#) See supra note 102 and accompanying text.

[FN127]. [Pro-Football, Inc., 284 F. Supp. 2d at 138.](#)

[FN128]. Id. The district court did not cite to any precedents for this assumption. Id. The district court shows a pattern of making bold assumptions without noting precedent to back up the assumptions. See supra notes 116, 123.

[FN129]. [Pro-Football, Inc., 284 F. Supp. 2d at 137-38.](#)

[FN130]. Id.

[FN131]. Id. at 138-39.

[FN132]. Id. at 138-39, 144.

[FN133]. See supra Part II.C.

[FN134]. A successful [§ 2\(a\)](#) claim will have to provide proper evidence backing the disparagement claim as well. See supra notes 107-08 and accompanying text.

[FN135]. See supra note 20 and accompanying text; see also [Univ. of Pittsburgh v. Champion Prods. Inc., 686 F.2d 1040, 1044 \(3d Cir. 1982\)](#) (citing [Anheuser-Busch v. Du Bois Brewing Co., 175 F.2d 370, 374 \(3d Cir. 1949\)](#)).

[FN136]. See [Univ. of Pittsburgh, 686 F.2d at 1044](#) (citing [Anheuser-Busch, 175 F.2d at 374](#)).

[FN137]. See supra note 20 and accompanying text; see also [AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531, 1546 \(11th Cir. 1986\)](#), cert. denied, [481 U.S. 1041 \(1987\)](#); [Tandy Corp. v. Malone & Hyde, Inc., 769 F.2d 362, 365-66 \(6th Cir. 1985\)](#), cert. denied, [476 U.S. 1158 \(1986\)](#) (stating that the presumption enables objectivity and clarity of the analysis).

[FN138]. See supra note 100 and accompanying text.

[FN139]. [Ultra-White Co. v. Johnson Chem. Indus., Inc., 465 F.2d 891, 893-94 \(C.C.P.A. 1972\)](#). This Note agrees with the Pro-Football court that the likelihood of confusion provision of [§ 2\(d\)](#) is a proper, and pivotal, point of reference for analyzing the public interest exception's application to the [§ 2\(a\)](#) disparagement provision claims of the American Indians. [Pro-Football, Inc., 284 F. Supp. 2d at 138](#). This is proper for the following four reasons: (1) the Pro-Football court developed it laches test from infringement cases and [§ 2\(d\)](#) is a sub-set of infringement cases, (2) [§ 2\(d\)](#) is easily applied by analogy to the [§ 2\(a\)](#) disparagement provision because both have privacy interests that may be invoked, (3) [§ 2\(a\)](#)'s disparagement provision has little direct precedent of its own and thus needs to leverage the more highly developed precedents of [§ 2\(d\)](#) (especially in regard to the public interest exception), and (4) the privacy interest and harms to the interest are equivalent as between the two provisions. See supra notes 81-83 and accompanying text; see infra notes 142, 153-54 and accompanying text; see infra Part III.B.

[FN140]. The court in Pro-Football draws an analogy between the public interest involved in [§ 2\(d\)](#) likelihood of confusion cases and the public interest involved in [§ 2\(a\)](#) disparagement cases. [Pro-Football, Inc., 284 F. Supp. 2d at 138](#). Thus, it is reasonable to draw a further analogy between the public interest exception to laches as applied to [§ 2\(d\)](#) likelihood of confusion cases and to [§ 2\(a\)](#) disparagement cases. This public interest exception analogy also makes sense because the [§ 2\(a\)](#) disparagement provision laches test is derived from the laches test applied to the [§ 2\(d\)](#) likelihood of confusion provision. See id.

[FN141]. Id. This adaptation is consistent with the basic underpinnings of the laches test. See supra Part II.B.

[FN142]. [Pro-Football, Inc., 284 F. Supp. 2d at 136](#) (quoting [NAACP v. NAACP Legal Def. & Educ. Fund, Inc., 753 F.2d 131, 137 \(D.C. Cir. 1985\)](#)). See also supra note 110 and accompanying text (stating that [§ 2\(d\)](#) likelihood of confusion is a sub-set of infringement).

[FN143]. [Id. at 137.](#)

[FN144]. [Id. at 138.](#)

[FN145]. See, e.g., [id.](#) (quoting [Ultra-White Co. v. Johnson Chem. Indus., Inc.](#), 465 F.2d 891, 893-94 (C.C.P.A. 1972)).

[FN146]. See [supra](#) note 132 and accompanying text (stating that a public interest does exist for the disparagement claim of the American Indians).

[FN147]. [Pro-Football, Inc.](#), 284 F. Supp. 2d at 138 (quoting [Ultra-White Co.](#), 465 F.2d at 893-94).

[FN148]. E.g., [Bridgestone/Firestone Research, Inc. v. Auto. Club de L'Ouest de la France](#), 245 F.3d 1359, 1363 (Fed. Cir. 2001).

[FN149]. [Id. at 1363](#) (citing [Univ. of Notre Dame Du Lac v. J.C. Gourmet Food Imps. Co.](#), 703 F.2d 1372, 1376 (Fed. Cir. 1983)). As the Pro-Football court explains, the false suggestion provision of [§ 2\(a\)](#) has been stated as not implicating the public interest as its principle purpose. [Pro-Football, Inc.](#), 284 F. Supp. 2d at 137. Rather the principle purpose of the false suggestion provision is the protection of personal privacy.

[FN150]. See [Bridgestone/Firestone, Inc.](#), 245 F.3d at 1363. Although the false suggestion provision is part of [§ 2\(a\)](#), it is a separate provision and analysis from the disparagement provision of [§ 2\(a\)](#). [15 U.S.C. § 1052\(a\) \(2000\)](#); see also [supra](#) note 72.

[FN151]. See [Morehouse Mfg. Corp. v. J. Strickland & Co.](#), 407 F.2d 881, 888-89 (C.C.P.A. 1969).

[FN152]. This does not mean that there is no privacy interest involved in the disparagement provision, rather it means only that such a privacy interest is not primarily the purpose of the disparagement provision.

[FN153]. See [Pro-Football, Inc.](#), 284 F. Supp. 2d at 137-38.

[FN154]. See [supra](#) notes 132, 144 and accompanying text.

[FN155]. [Pro-Football, Inc.](#), 284 F. Supp. 2d at 137 (interpreting the position of the Federal Circuit in [Bridgestone/Firestone Research, Inc.](#), 245 F.3d at 1363).

[FN156]. [Id. at 138](#). Thus, it is clear that the district court recognizes that there is a public interest component in the [§ 2\(a\)](#) disparagement cases. [Id.](#); see [supra](#) notes 132, 144, 154 and accompanying text.

[FN157]. [Pro-Football, Inc.](#), 284 F. Supp. 2d at 138.

[FN158]. [Id.](#)

[FN159]. [15 U.S.C. § 1052 \(2000 & Supp. 2004\)](#).

[FN160]. [Pro-Football, Inc.](#), 284 F. Supp. 2d at 138 (quoting [15 U.S.C. § 1052\(d\)](#)) (alteration in original).

[FN161]. The phrase requiring "likeness" is denoted by the terms "as to be likely" in the statute. [15 U.S.C. § 1052](#).

[FN162]. [Ultra-White Co. v. Johnson Chem. Indus., Inc.](#), 465 F.2d 891, 893-94 (C.C.P.A. 1972).

[FN163]. See [id.](#)

[FN164]. [Id.](#) (looking at circumstances such as the identical nature of the parties' marks and goods, as well as the similarity of trade channels, market areas, and advertising media used by each party).

[FN165]. [Pro-Football, Inc., 284 F. Supp. 2d at 138.](#)

[FN166]. See supra note 76 and accompanying text.

[FN167]. The disparagement analysis exists under the Act, while the public interest is only of importance in conducting the laches analysis.

[FN168]. [15 U.S.C. § 1052\(d\).](#)

[FN169]. [Ultra-White Co. v. Johnson Chem. Indus., Inc., 465 F.2d 891, 893-94 \(C.C.P.A. 1972\).](#) Clearly, a showing of actual confusion of individuals in the marketplace would support the likelihood of confusion claim, but such a showing is not required. There is no requirement of showing that the confusion is not in doubt.

[FN170]. [Ultra-White Co., 465 F.2d at 893-94](#) (stating that a showing of inevitable confusion supports the application of the public interest exception). Clearly, a showing of concrete instances of confusion presented by witness testimony would also support the application of the public interest exception. See also supra text accompanying note 162.

[FN171]. See supra notes 102-03 and accompanying text.

[FN172]. See supra note 76 and accompanying text.

[FN173]. The public interest in [§ 2\(d\)](#) likelihood of confusion cases has already been shown to be at a sufficient level for supporting the public interest exception. See supra note 102 and accompanying text.

[FN174]. See supra notes 51, 63 and accompanying text.

[FN175]. See supra notes 45-51 and accompanying text.

[FN176]. See supra notes 58-61 and accompanying text.

[FN177]. See supra note 61 and accompanying text.

[FN178]. See Albert Cortez et al., *Dropping Out of School in Arizona: IDRA Conducts New Study*, IDRA Newsletter ("Intercultural Development Research Association"), Sept. 2002, available at <http://www.idra.org/Newsltr/2002/Sep/Albert.htm> (last visited Jan. 3, 2005); Richard St. Germaine, *Drop-Out Rates Among American Indian and Alaska Native Students: Beyond Cultural Discontinuity*, at <http://offchemmath.roshd.ir/ael01/eric/digests/edorc961.htm> (last visited Jan. 3, 2005).

[FN179]. [Plyler v. Doe, 457 U.S. 202, 221 \(1982\)](#) (emphasis added) (stating that because public education is for the benefit of the nation as a whole it cannot be denied to any children in the United States); see also Robert Holland, *The Heartland Institute High School Crisis: 3 in 10 Drop Out*, School Reform News, Jan. 1, 2003 (stating that becoming a drop-out lessens the chances of becoming a productive citizen of the United States), available at <http://www.heartland.org/Article.cfm?artId=11280> (last visited Jan. 3, 2005).

[FN180]. [347 U.S. 483, 494 \(1954\).](#)

[FN181]. This effect is likely multiplied due to schoolchildren being exposed to high school and college American Indian nicknames while they are themselves in school.

[FN182]. See Wooster, supra note 66 and accompanying text; see also supra note 102.

[FN183]. See supra notes 102, 178-79 and accompanying text.

[FN184]. The only other way to try to establish the public interest of [§ 2\(d\)](#) as being larger than the public interest of [§ 2\(a\)](#) disparagement claims is to claim that the number of people actually impacted by confusing trademarks is larger than the number of people actually impacted by disparaging trademarks. Clearly, this cannot be true, because the actual impact under both provisions will depend on the individual circumstances at play. For instance, confusing trademarks may only affect a small number of consumers if the trademarked good is not heavily consumed. Thus, there is no assurance that the number of consumers in the public impacted by the confusing trademark will be higher than the number of persons impacted by an act of disparagement due to a trademark.

[FN185]. See [Plyler, 457 U.S. at 221](#) (stating that Americans "have always regarded education and [the] acquisition of knowledge as matter[s] of supreme importance") (quoting [Meyer v. Nebraska, 262 U.S. 390, 400 \(1923\)](#)); supra notes 178-79 and accompanying text. The Supreme Court further states that public schools and the education of children are "the primary vehicle[s] for transmitting 'the values on which our society rests.'" [Plyler, 457 U.S. at 221](#) (quoting [Ambach v. Norwick, 441 U.S. 68, 76 \(1979\)](#)).

[FN186]. It is highly probable that not all disparagement cases (i.e., cases other than American Indian nickname trademark cases) would have the large public interest that exists here, and thus, not all disparagement cases would be able to take advantage of this ability to bar laches due to the harm to the public interest. Thus, the analysis presented here in Part III likely would not create a per se rule for all disparagement cases.

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