



## MEDIA FACT SHEET

### **Trademark Trial and Appeal Board (TTAB) Decision in *Blackhorse v. Pro Football, Inc.* (TTAB Cancellation No. 92046185)**

**Find the full decision and other resources at <http://www.uspto.gov/news/DCfootballtrademark.jsp>  
June 18, 2014**

The *Blackhorse v. Pro Football, Inc.* decision of the Trademark Trial and Appeal Board (TTAB or “Board”) today resolved the joint petition filed at the U.S. Patent and Trademark Office (USPTO) by five Native Americans, who sought cancellation of six federal registrations for trademarks that include the term “Redskins.”

The TTAB -- *an independent administrative tribunal within the USPTO* -- has determined, based on the evidence presented by the parties and on applicable law, that the *Blackhorse* petitioners carried their burden of proof. By a preponderance of the evidence, the petitioners established that the term “Redskins” was disparaging of Native Americans, when used in relation to professional football services, at the times the various registrations involved in the cancellation proceeding were issued. Thus, in accordance with applicable law, the federal registrations for the “Redskins” trademarks involved in this proceeding must be cancelled.

Pro Football, Inc., the respondent and owner of the involved registrations, had asserted as a defense that the petitioners should have been barred from seeking cancellation because the registrations have existed for so long, and been the subject of significant investment. But the TTAB found the defense inapplicable as to the petitioners in this case.

This decision by the TTAB does not necessarily put an end to the larger dispute between the parties, as Pro Football, Inc. may seek review by a federal court of today’s decision. The registrations will remain “on the federal register of marks” and not be listed in the USPTO’s records as “cancelled” until after any judicial review is completed.

- **What this decision means:** if the cancellation of the registrations for the trademarks involved in this case is not appealed or if affirmed following possible review by a federal court, Pro Football, Inc., as record owner of the involved registrations will lose the legal benefits conferred by federal *registration* of the marks. These benefits of federal registration include:
  - the legal presumptions of ownership and of a nationwide scope of rights in these trademarks;
  - the ability to use the federal registration ® symbol, and;
  - the ability to record the registrations with the U.S. Customs and Border Patrol Service so as to block the importation of infringing or counterfeit foreign goods.
  
- **What this decision does not mean:** this decision does not, however, require the Washington D.C. professional football team to change its name or stop using the trademarks at issue in this case.
  - Losing the federal registration of a trademark does not necessarily mean that the owner loses all legal rights in the mark. This is because trademark rights in the United States come from use of a mark on or in conjunction with goods or services, not merely from the additional, optional step of federal registration.
  - The TTAB determines only whether a mark can be *registered* with the federal government (and thus gain the additional legal benefits thereof), not whether it can be *used*.
  - The mark owner may still have rights in the mark based on *use*, known as “common law” rights - and those use-based rights may continue to exist even if a federal registration is cancelled.



*What is the Trademark Trial and Appeal Board and what does it do?*

- The TTAB is an independent administrative tribunal within the USPTO. It is authorized to determine a party's right to register a trademark with the federal government or, if the party already owns a registration, its right to maintain it. The Board is not authorized to determine whether a party has the right to *use* a trademark, just whether it has the right to *register* it. (And thus obtain the additional legal benefits thereof, as outlined, above.)

*What is a TTAB cancellation proceeding?*

- A cancellation is a TTAB proceeding in which a party seeks to cancel an existing registration of a mark.
- Under the law, a person (including any legal entity) who believes he will be damaged by the continuing registration of a mark may file a petition with the TTAB to cancel the registration, asserting one or more grounds for cancellation.
- Most USPTO cancellation proceedings assert grounds for cancellation under Section 2 of the Trademark Act, 15 U.S.C. § 1052, which specifies a variety of types of terms or marks that Congress has determined to be ineligible for federal registration, including those that are determined, as in this case, to disparage an individual or group.

*Can a registration that has been on the register for a long time, like the ones involved in this case, be the subject of a cancellation proceeding? Why?*

- Yes. According to federal trademark law, a long-standing registration can be the subject of a cancellation proceeding *at any time*, if an appropriate ground for cancellation is asserted.
- A claim that a registered trademark was *disparaging* of an individual or group at the time it was originally registered is one such example of a claim that can be appropriately brought at any time, regardless of the age of the registration.

*What are the options for appealing this TTAB decision?*

- A party dissatisfied with the Board's decision has two options to seek further judicial review of it.
  - The party can file an appeal to the U.S. Court of Appeals for the Federal Circuit in Washington, D.C.; or
  - The party can file a civil action in district court.
    - Any civil action would be filed in the U.S. District Court for the Eastern District of Virginia, which has jurisdiction over civil actions seeking review of TTAB cancellation proceedings. (Before 2011, the district court in the District of Columbia had jurisdiction over such actions, but Congress changed that provision of the Trademark statute when making various amendments to the Patent statute.)