

# The Washington Post

## Trademarks in the news!

By: David Post  
June 19, 2014

Just a brief addendum to [Eugene's post about the recent decision by the Trademark Trial and Appeal Board](#) cancelling the federal trademark registration for the "Redskins" mark. Personally, I could care less (especially during the World Cup!) whether the NFL club in DC keeps, or changes, its name; I understand that many people find it offensive, and that many people don't. And the constitutional question is also, for me, pretty cut-and-dried; this is precisely the sort of thing the First Amendment prohibits: an agency of the federal government doling out benefits on the basis of whether or not you have used a word or phrase that is 'disparaging,' or that "bring into contempt, or disrepute" any "institutions, beliefs, or national symbols." [All quotes from Sec. 2 of the Lanham Act, the provision in question in this case]. [Whether my view of the matter is in tune with current doctrine is another question entirely]

But the interesting little trademark wrinkle that Eugene mentions is worth a little more detail. The federal trademark statute governing this case, the Lanham Act, is a very strange beast. It grants no trademark rights at all; instead, it gives "the owner of a trademark" the right to register the trademark on the federal Trademark Register (and, as a consequence, to receive the benefit of certain presumptions and certain other statutory benefits), but it says nothing about who the "owner of a trademark" might be, or how they got to be the "owner of a trademark." [This is unlike the other two intellectual property statutes, the Copyright Act and the Patent Act, both of which describe the conditions under which copyrights/patents come into existence, and who owns the rights associated with them]. It leaves that, in short, to the common law of trademarks; if the common law of trademarks makes you the "owner of a trademark," you are the owner of a trademark, and then you can come to the PTO and register your ownership.

Second, the Lanham Act gives the owner of a registered trademark a cause of action for infringement against anyone who uses the mark in a way "likely to confuse." But strangely enough, it also gives the owner of an *unregistered* trademark the same cause of action. That is, even without having registered a mark, you can bring a federal trademark action in federal court, on the basis of your (state common law) trademark ownership rights.

So: you don't have to register your trademark to own the trademark rights, and you don't have to register your trademark in order to have a federal cause of action for trademark infringement. [If you understand this, you now know more about trademark law than 99% of US lawyers]. You do get certain ancillary benefits from registration (such as the ability to enlist the Customs and Border Patrol to look for and to seize infringing imports). But the impact of this

ruling (cancelling the registration) is pretty limited; Pro-Football, Inc., the owner of the “Redskins” mark, can not only continue, as Eugene pointed out, to *use* the Redskins mark, it can continue to *enforce* the mark in federal court, i.e. it still has federally-secured rights against infringers.

But here’s where things get interesting. Section 2 of the Lanham Act – the provision applied in this case – gives conditions under which a “trademark . . . shall be refused registration.” It’s a long and confusing list; the one applied here is that registration shall be refused if the mark “comprises . . . 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.”

But a number of federal courts have taken what I believe is a misguided step, and said: if you fall within one of those Section 2 categories, not only may the PTO not *register* your mark (which is what the statute actually says), but you don’t have a trademark at all (which it most assuredly does not say). Remember: this is a statute that leaves questions of trademark existence and trademark ownership entirely to state common law. But here, the federal standards governing registrability of trademarks have been turned into common law standards for trademarkability and trademark ownership. [There’s no name for this interpretive move, but there should be; I call it the Reverse Federal Common-Law Double Flip. File Under: "How Federal Courts Still Make Common Law, Even After Erie RR]

This matters, obviously, a lot to Pro-Football, Inc. It’s one thing to lose BCP enforcement (a small matter, I would think); quite another to lose all federally-protected trademark rights.

I hope they end up fighting it on appeal. Like I said, I have no skin in this game (no pun intended), but I’d like to hear what the DC Circuit has to say about either the First Amendment or Reverse Double Flip issue . . .

*-David Post is a Fellow at the Center for Democracy and Technology, an Adjunct Scholar at the Cato Institute, and a member of the Board of Trustees of the Nexa Center for Internet and Society.*