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WASHINGTON REDSKINS TRADEMARK REGISTRATIONS CANCELLED FOR BEING DISPARAGING

by Mike Gilchrist

As the NFL kicks off another season on the field, its team in Washington, D.C. is fighting a battle off the field to maintain its federal trademark registrations. On July 8, 2015, a federal district court in Virginia upheld the cancellation of six federal trademark registrations that use the term “Redskins.” The trademark registrations were cancelled because the court affirmed a finding by the Trademark Trial and Appeal Board that the Redskins trademarks may disparage a substantial composite of Native Americans. The owner of the trademarks, Professional Football, Inc. (“the Team”), has appealed this ruling to the Fourth Circuit Court of Appeals, with initial briefing due September 15, 2015.

Disparaging Trademarks not Subject to Federal Registration

The Lanham Act, which sets forth the federal system for registering trademarks, prohibits the registration of trademarks “which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute.” The challengers, several Native Americans, presented strong evidence that the term “redskins” is derogatory and disparaging to a large portion of Native Americans. The Washington team asserted several arguments for why the registrations should nevertheless remain in force. The district court sided with the challengers and issued a ruling cancelling all six registrations.

Effect of the Cancellation

The cancellation means that it will be more difficult for the Team to prevent others from using confusingly similar names or logos. In a lawsuit against an alleged infringer, the trademarks will no longer be presumed to be valid, and the burden will shift to the Team to establish that these are valid trademarks. There are several remedies available to trademark registration owners that will also now not be available in a suit to enforce the trademarks.

Nevertheless, the cancellation of the trademark registrations will not prevent the Team from using the marks. The Team can still call itself the Redskins and can still make and sell merchandise that uses the marks of the cancelled registrations.

It may even still be possible for the Team to protect the trademarks based on common law rights apart from the registrations. Most states recognize the disparaging mark defense, but there are different standards and a new showing would be required by any alleged infringers.

The Team will still have at least one more shot at reversing the ruling. Its appeal will be heard by the Fourth Circuit Court of Appeals, with a ruling probably coming sometime next spring or summer.

Legal Arguments

The Team argued that the term Redskins was not disparaging as used in the trademarks, at least as of the dates they were registered (1967-1990). The Team’s basic argument was that because many Native Americans are not offended and do not find the term disparaging, the marks should not be considered disparaging. The Team cited as evidence in support of its position the fact that the Team has many Native American fans, and the use of the term

Don’t play games with your intellectual property.



MVS

MCKEE, VOORHEES & SEASE, PLC

801 GRAND AVENUE
SUITE 3200
DES MOINES, IOWA 50309-2721

515-288-3667 · WWW.IPMVS.COM

“redskins” by Native Americans in nondisparaging fashion, such as naming sports teams and instances in Native American papers and literature using the term in nondisparaging fashion. The court was not persuaded by this argument. Specifically, the court found that the statute does not require a showing that all or even most members of a group are disparaged by the term. It is sufficient to show that a significant composite of the group is disparaged, which the court found had easily been shown in this case. The Team also tried a defense that had worked in an earlier similar case, but was denied here. In a case filed in 1999, the Trademark Office initially cancelled several Redskins marks as being disparaging. On appeal to a district court, the district court dismissed that case based in part on laches. Basically, the laches defense is that the parties seeking cancellation waited too long to bring the case. In the earlier case where the defense was successful, the parties seeking cancellation were distinguished leaders of various Native American groups, who generally had been aware of the existence of the marks for many years before bringing the cancellation proceeding. In the case at hand, the parties seeking cancellation were all young adults, such that they could not have brought the case much earlier.

The Team also raised several Constitutional issues. The Team asserted that the cancellation violates its First Amendment right to free speech. The court rejected this argument on two grounds. First, the cancellation of the trademark registration in no way impedes the Team’s ability to use the marks. It may make it more difficult to prevent others from using the marks, but it does not place any impediments to the Team’s use of the marks. Second, the court considered the registrations to be government speech. It is axiomatic that the government has the power to control its own speech and is not violating the First Amendment making a determination of whether or not to cancel a trademark registration.

The Team also alleged that cancellation law is a violation of the Fifth Amendment prohibition against the government taking property without due process and just compensation. However, the court found that a trademark registration, as opposed to the underlying trademark rights, is not property within the meaning of the Fifth Amendment. Finally, the Team asserted that the “may disparage” section of the Lanham Act violates the due process clause of the Fifth Amendment because it is unconstitutionally vague. The court denied this argument. In particular the court found that the Team had sufficient notice at the time it filed its trademark applications both of the standards being applied by the Trademark Office and of the fact that the term redskin was widely considered to be offensive.

Some Lessons from this Case

Marks that are disparaging to a group of people, institutions, beliefs, or national symbols cannot be registered as federal trademarks. A similar prohibition prevents the registration of marks that are immoral, deceptive, or scandalous. Third parties that are injured by a mark that was incorrectly registered can cancel such registrations. Finally, it should be appreciated that federal trademark registrations are powerful tools that help in the enforcement of trademarks; however, lack of a registration will not necessarily prevent a trademark owner from using the mark, or from asserting common law rights to prevent others from using the mark.

REGISTERING YOUR TRADEMARKS AND COPYRIGHTS WITH THE U.S. CUSTOMS AND BORDER PROTECTION

by Jonathan L. Kennedy

The U.S. Customs and Border Protection (“CBP”), a bureau of the Department of Homeland Security, allows intellectual property owners to record their copyrights and registered trademarks. Recording your marks and copyrights with the CBP is a low-cost and effective way to stop the importation of infringing products. Surprisingly, this is often an underutilized protective measure.

One benefit of recording your mark or copyright with the CBP is that the CBP performs both random and targeted inspections of goods imported into the U.S. When the CBP finds goods suspected of infringement, the CBP has the authority to exclude, detain, and seize infringing goods. According to CBP records, in the 2014 fiscal year, there were 23,140 intellectual property seizures throughout U.S. ports with a value of \$1.2 billion.

CBP encourages IP owners to work with the bureau to prevent importation of infringing goods. The CBP has an electronic process for submitting information regarding shipments or shippers suspected of infringement. The CBP uses this information to target importation activities for examination and possible detention of the goods. This can be done through the CBP’s e-allegation system, which permits anonymous reporting. The CBP also encourages IP owners to educate the CBP about the owner’s products and the IP associated with the products. This can be done by providing Product Identification Guides or product training sessions (an in-person presentation to CBP officers and personnel responsible for examination). CBP provides suggestions for the types of information useful in a product guide or useful for presentation in a product training session. When goods are detained or seized as suspected of infringing, the CBP contacts the IP owner regarding the detention/seizure. The IP owner has the opportunity to

ask questions, receive pictures of the goods, obtain samples of the goods, inspect the goods, and get information regarding the shipper.

Recording your mark or copyright can be done electronically and is effective from the date the recordation is complete. A copyright recordation with the CBP is effective for twenty years or until the copyright expires if it expires in less than twenty years. A trademark recordation with the CBP is effective contemporaneous with the USPTO registration period. Thus, a trademark recordation with the CBP must be renewed with the USPTO renewal. The information needed to record a trademark or copyright with the CBP is:

- The trademark or copyright registration number;
- The name, complete business address, and citizenship of the IP holder;
- Identification of the place(s) of manufacture;
- The name and address of all individuals and businesses authorized to use the trademark or licensed to use the copyright; and

The proper information is critical to the recordation in order to prevent accidental detention or seizure of the IP owner's goods or their authorized licensees' goods. Trademark recordations with the CBP are specific to classes of goods. Each class must be separately recorded. The CBP fee for recording a trademark is currently \$190 per International Class; the renewal is \$80 per class. The CBP fee for recording a copyright is \$80 per copyright.

MVS ANNOUNCES THE FORMATION OF COPYRIGHT AND ENTERTAINMENT PRACTICE GROUP

by Brandon W. Clark

McKee, Voorhees & Sease, PLC is pleased to announce the formation of our Copyright and Entertainment Practice Group. This specialized practice group will be led by recent hire, Brandon W. Clark and will involve and draw upon the expertise of other attorneys within the firm.



Brandon joined MVS in May of 2015, having previously worked at music publishing companies, record labels, and his own law practice focusing on copyright, music industry transaction, and entertainment law. Brandon brings with him an established client base and broad knowledge of copyright and entertainment law. Brandon's diverse array of clients include artists, songwriters, publishing companies, record labels, clothing companies, photographers, actors, and film studios, among others. His broad background and experience in the music industry will allow us to offer additional services to existing clients while providing increased support to the ever expanding creative and artistic class of clients.

"I've been incredibly fortunate to work with wonderful clients and help them establish, enforce, and protect their legal rights and revenue streams. I'm passionate about working with and helping talented and creative people spend less time focusing on these matters and more time focusing on what they do best, creating. I'm thankful for the opportunity and I'm looking forward to developing and growing the Copyright and Entertainment Law Practice Group here at MVS."

Brandon is a graduate of the University of Northern Iowa and Drake University Law School. He is a frequent guest lecturer and currently serves on the Board of Directors for the Des Moines Social Club. He was profiled for his work with musicians last year by the Des Moines Register which can be found at the following link: <http://www.desmoinesregister.com/story/life/living-well/yp/2014/08/12/yp-spotlight-hafner-brandon-clark/13962727/>.

Please join us in welcoming Brandon to MVS and feel free to contact him directly at Brandon.Clark@ipmvs.com for all copyright and entertainment law matters.

CONGRATULATIONS TO EDMUND J. SEASE

Please join us in congratulating Edmund J. Sease on being named Interim Director of the Drake University Law School Intellectual Property Law Center. Ed holds a degree in chemistry and graduated Order of the Coif from Drake University Law School in 1967, where today he is an adjunct professor. He has taught copyright, trademark and patent law, as well as courses in intellectual property litigation. Ed has also taught at the University of Iowa College of Law. Ed has been an attorney with MVS since 1973, specializing in intellectual property law litigation and chemical patent prosecution. One of Ed's career highlights was his successful argument at the U.S. Supreme Court for utility patents relating to plants.

WE'RE THERE

August 10, 2015

Luke Mohrhauser, Greg Woods and Paul Mazzola played in a fundraising golf tournament benefiting the Boys and Girls Club and the First Tee program in Benton Harbor, MI.

August 16-20, 2015

Jill Link and Dan Lorentzen attended the 250th American Chemical Society National Meeting in Boston, MA.

August 25, 2015

Jill Link presented on IP protection strategies for small businesses at the SCORE meeting for small business in Montgomery, AL.

September 1-2, 2015

Jill Link and Heidi S. Nebel attended the Association of University Technology Managers (AUTM) Partnering Forum for Animal Health and Nutrition in Kansas City, MO.

September 14-16, 2015

Jill Link and Daniel Lorentzen will attend the AgInnovation Showcase in St. Louis, MO.

September 17-18, 2015

Ed Sease will attend the 2015 Midwest IP Institute CLE in Minneapolis, MN.

September 27-29, 2015

Heidi S. Nebel will attend the Intellectual Property Owners Association annual meeting in Chicago, IL.

October 1-2, 2015

Several attorneys will represent McKee, Voorhees & Sease, PLC at the Iowa Intellectual Property Law Association (IIPLA) meeting in Iowa City, IA.

October 9-13, 2015

Jill Link will be presenting at the Sieloff & Associates legal seminar in New Orleans, LA.

October 21, 2015

Kirk Hartung will attend the Technology Association of Iowa Innovation Expo in Coralville, IA.

October 28, 2015

Jill Link will be speaking at the Polk County Women's Attorney Luncheon in Des Moines, IA.

November 12-14, 2015

Kirk Hartung will attend the LEGUS fall meeting in Cape Town, South Africa.

December 7-11, 2015

Jill Link and Heidi S. Nebel will attend the American Seed Trade Association Annual meeting in Chicago, IL.

MVS FILEWRAPPER® BLOG

McKee, Voorhees & Sease maintains the Filewrapper® blog at www.filewrapper.com. The blog is regularly updated to report on topics such as recent intellectual property case law, legislation, proposed legislation, administrative policies, and other intellectual property developments. We consciously refrain from expressing opinions on this blog and instead, offer it as a form of information and education.

We have always been proud of the fact that the content is original content authored by MVS attorneys. Although there are many contributors, Daniel Lorentzen, Ph.D coordinates efforts and is also the firm's most prolific contributor.

We encourage clients interested in intellectual property developments to visit or subscribe to the blog.

**If you would like to receive the BRIEFS newsletter electronically,
please subscribe to briefs@ipmvs.com**

BRIEFS is published periodically and is intended as an information source for the clients of McKee, Voorhees & Sease, PLC. Its contents should not be considered legal advice and no reader should act upon any of the information contained in this publication without professional counsel.