

Client Alert

A report
for clients
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of the Firm February 2009

Harjo's Legacy: *In re Heeb Media*

The U.S. Patent and Trademark Office's recent denial of registration of the trademark "Heeb" has left some trademark practitioners scratching their heads. Applicant, publisher of the popular magazine by the same name and himself Jewish, applied for registration of the mark for apparel and entertainment purposes, specifically for "clothing, namely jackets, jerseys, sweat pants, sweat shirts, track suits, t-shirts, tank tops and pants, and headwear" and "entertainment, namely, conducting parties." *In re Heeb Media LLC*, 89 U.S.P.Q.2d 1071, 1072 (T.T.A.B. 2008). Applying the two-prong analysis articulated in *Pro-Football v Harjo*, 50 U.S.P.Q.2d 1705, 1736 (T.T.A.B. 1999), the Trademark Trial and Appeal Board (TTAB) affirmed the examining attorney's denial of registration. The TTAB noted that the applicant may have had "good intentions" in its proposed use of the mark, namely as a "source of pride" among a new generation of "young, progressive Jews." Yet, the TTAB concluded that among a substantial composite of Jews, the term "Heeb" retained its derogatory meaning. *Id.* at 1077.

Framing the issue is the relevant statutory language and the 1999 *Harjo* decision. The Lanham Act prohibits registration of marks that "may disparage" persons or

institutions "or bring them into contempt or disrepute." 15 USC § 1052.¹ The proper test for determining whether a mark may disparage a particular group, however, went unresolved until litigation in the 1990s concerning use of the mark Washington Redskins. In 1992, Suzanne Shown Harjo and other Native Americans petitioned the TTAB to cancel six trademarks containing the term "Redskins."² Five years after issuing an earlier order in Harjo's favor, the TTAB cancelled the "Redskins" marks, enunciating a two-prong analysis: first, the "likely meaning" of the term must be determined, taking into account the goods and services identified in the application; and second, in view of the likely meaning, whether or not the term would be perceived as disparaging by a "substantial composite" of *the referenced group*. *See id.* at 1739. Applying this new formulation of the test, the TTAB concluded that "Redskins" "clearly carries the allusion to Native Americans" and that Pro Football's use of the marks "may be disparaging of Native Americans to a substantial composite of this group of people." *Id.* at 1748.

Not surprisingly, Pro Football appealed, and the Board's decision was reversed on other grounds.³ The test from *Harjo* remains, however, and its application has resulted in a conflicting body of law, especially with regard to attempts by members of certain groups to use a term that is *self-disparaging* as a trademark. The TTAB developed the *Harjo* test in connection with

¹ This section provides: "No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it -- (a) Consists 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".

² The six challenged marks were: THE WASHINGTON REDSKINS and REDSKINS for "entertainment services -- namely, presentations of professional football contests"; REDSKINETTES for "entertainment services, namely, cheerleaders who perform dance routines at professional football games and exhibitions and other personal appearances"; a cursive "Redskins" logo for "entertainment services -- namely, football exhibitions rendered live in stadia and through the media of radio and television broadcasts"; and two logos incorporating the text with an image of a "chief" for "entertainment services -- namely, presentations of professional football contests." *See Harjo*, 50 USPQ2d at 1707.

³ In 2003, the district court found plaintiffs' claims time-barred under the doctrine of laches and granted summary judgment in favor of the team. *Pro Football v. Harjo*, 284 F. Supp. 2d 96 (D.D.C. 2003). Plaintiffs appealed. The D.C. Circuit affirmed in part and remanded for consideration of laches as to one plaintiff who had not reached the age of majority at the time of the mark's registration. *Pro Football v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005). On remand, the district court dismissed the remaining plaintiff's claim. *Pro Football v. Harjo*, 567 F. Supp. 2d 46 (D.D.C. 2008).

the use of an allegedly disparaging mark by a *non-member* of the group identified by the mark; use of such a mark by a *member* of the identified group raises a somewhat different set of concerns. Group members promoting registration of allegedly self-disparaging marks characterize their efforts as steps toward reclaiming the derogatory label; in other words, rendering nondisparaging a mark that formerly was viewed universally as disparaging by members of the referenced group and others. However, others in the identified group may continue to take offense at the label's use, and therein lies the TTAB's quandry.

Applying the *Harjo* test in *In re Heeb Media*, the Board found that the term "Heeb" had only one meaning, *i.e.* "a Jewish person," and had not developed any secondary or specific meaning in the marketplace for clothing and entertainment services. Compare *In re Squaw Valley*, 80 U.S.P.Q.2d 1264 (challenge to use of mark "Squaw Valley" in relation to ski resort rejected as term had acquired market connection to skiing and ski apparel). Under the second prong, the TTAB concluded that the referenced group consisted of "all members of the American Jewish public" because there was no limit to potential encounters with "the HEEB mark in advertising in newspapers, billboards, or magazines, . . . on a website, or . . . in stores selling the clothing . . . and, . . . all public places where the clothing is worn." *In re Heeb Media*, at 1075. Extrapolating from dictionary definitions and online testimonials, and regardless of evidence suggesting the existence of disparate views, if not a sharp generational divide, the Board found sufficient evidence to conclude that the term "Heeb" was still considered derogatory by a "substantial composite" of the referenced group. *Id.* at 1077. Applicant's arguments -- that the decision offered "a veto to a small minority over a term that is a source of pride to many young, progressive Jews," that such a veto conflicted with the spirit of the Lanham Act, and that the determination failed to "take account of a situation where, as here, a term considered negatively by a small group of a larger community is a source of pride to another, perhaps even larger group" -- were summarily rejected. *Id.*

That other groups using self-disparaging marks in commerce have had decidedly mixed success makes the results of future efforts to trademark self-disparaging terms unpredictable. It also makes the *Heeb Media* decision difficult to distinguish from previous decisions, and thus to justify. The mark DYKES ON BIKES was registered in 2005, although it took the applicant three years and three appeals. See 81 U.S.P.Q.2d

1212 (T.T.A.B. 2006) (dismissing challenge to DYKES ON BIKES registration for lack of standing). The USPTO had no problem registering QUEER EYE FOR THE STRAIGHT GUY, QUEER AS FOLK, or FAG ("Fabulous and Gay" as applied to grooming products). See Reg. No. 2,905,014; Reg. No. 2,592,636; Reg. No. 2,997,761. However, attempts by members of the African-American community to register the term "nigga" have failed. In 1995, a group called "Naturally Intelligent God Gifted Africans" was denied a trademark. Serial No. 76/639,548. More recently, in 2006, actor/comedian Daymon Wayans conducted a 14-month fight to register "nigga" for use on clothing and was similarly denied on the grounds that the term was disparaging to a substantial composite of the referenced group.⁴ Similarly, SPIC, for "Spanish People in Control," was denied registration for use in connection with apparel. Yet, JAP, although initially denied, was registered upon reconsideration. See Serial No. 76/082,591; *In re Condas*, 188 U.S.P.Q. 544 (T.T.A.B. 1975) (reversing initial determination based on a district court's finding that the term "Jap" was not disparaging to Japanese-Americans). All of these applicants were members of the group that the proposed mark allegedly disparaged.

A few other factors combine to create these uneven results. First, there is no percentage or fixed number of people, much less a majority, required to make up a "substantial composite." *In re McGinley*, 660 F.2d 481, 211 USPQ 668, 673 (C.C.P.A. 1981). Second, USPTO reviewers are permitted, in large part, to base their decisions as to a term's meaning to a referenced group by reference to dictionary definitions and printouts of testimonials from a Nexis database. See *In re Heeb Media*, 89 U.S.P.Q.2d at 1072; *Squaw Valley*, 80 U.S.P.Q.2d at 1272. Lastly, reviewers are not required to give precedential value to previously accepted registrations, even when they involve the same mark in a different use. The mark "Heeb," for example, was registered in 2004 in connection with Heeb Magazine; "The Big Heeb Brewing Company" was denied registration the following year. See Reg. No. 2,858,011; see Serial No. 78/432,597.

So what conclusion can be drawn from this? At present, one conclusion to be drawn is that even certain "transforming" marks are unable to shrug off the weight of history and of Merriam-Websters. But the word "certain" in the last sentence is a necessary word of limitation, because the history of the TTAB's disparaging marks decisions is fraught with unpredictability.

⁴ See Rogers Cadenhead, "Actor Tries to Trademark 'N' Word," *Wired* (Feb. 23, 2006), available at <http://wired.com/print/science/discoveries/news/2006/02/70259>.

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