

No. 09-326

IN THE
Supreme Court of the United States

SUZAN S. HARJO, ET AL.,
Petitioners,
v.
PRO-FOOTBALL, INC.,
Respondent.

On Petition for a Writ of Certiorari to the
United States
Court of Appeals for the District of Columbia
Circuit

BRIEF OF AMICI CURIAE NATIONAL CONGRESS OF
AMERICAN INDIANS ET AL. IN SUPPORT OF THE
PETITION FOR A WRIT OF CERTIORARI

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BRIEF OF *AMICI CURIAE*
NATIONAL CONGRESS OF AMERICAN
INDIANS, *ET AL.*,
IN SUPPORT OF THE PETITION FOR A WRIT
OF CERTIORARI ¹

STATEMENT OF INTEREST

As reflected in the opinion of the U.S. District Court for the District of Columbia, counsel for Pro-Football, Inc., made the following statement during the hearing on its motion for summary judgment:

Do these seven petitioners strongly believe that our famous football team mark Washington Redskins is disparaging? Apparently. That's fine. They have an opinion, **but they are representing themselves and no one else.** There are 2.41 million Native Americans in this country, Your Honor. There are over 500 Native American tribes. So I ask, can petitioner's opinions, no matter how stridently held, be extrapolated to even one additional Native American by

¹ Pursuant to Supreme Court Rule 37.6, no counsel for a party authored this brief in whole or in part and no such counsel or party made any monetary contribution to the preparation or submission of this brief. Pursuant to Rule 37.2, counsel of record for both petitioners and respondent were notified of the intent to file this brief at least ten days prior to its filing, and the parties' letters of consent have been filed with the Clerk.

some method acceptable in a
courtroom?

(Pet. App. 155-56) (emphasis added).

The Native American organizations and federally recognized Indian tribes participating in this brief represent a broad cross-section of Native Americans who have joined together to ask this Court to grant the petition for writ of certiorari. The organizations and Indian tribes stand together to express with one voice their collective opinion on the fundamental fact underlying this case: the "Redskins" trademark is disparaging to Native Americans and perpetuates a centuries-old stereotype of Native Americans as "blood-thirsty savages," "noble warriors" and an ethnic group "frozen in history."

Amici have a long history of involvement in educational, cultural, economic, and policy issues affecting the Native American community – at the local, regional, and national levels. As a result, they can speak authoritatively about the harm caused by racially based Indian names and imagery used by sports teams. *Amici* believe that the "Redskins" mark is disparaging not only to petitioners individually, but to all Native American people and should never have been registered.²

² This long-held "opinion" of *amici* is also the conclusion reached through recent empirical research in the field of psychology by a group of esteemed scholars. *Of Warrior Chiefs and Indian Princesses: The Psychological Consequences of American Indian Mascots*, BASIC AND APPLIED SOCIAL PSYCHOLOGY, 30: 208-18 (2008).

Amicus **National Congress of American Indians ("NCAI")** was established in 1944 and is the oldest and largest national intertribal organization; it represents over 250 tribes, nations, pueblos, and Alaska Native villages with a combined enrollment of over 1.2 million.

Amici **Cherokee Nation of Oklahoma, Comanche Nation of Oklahoma, Oneida Indian Tribe of Wisconsin, and Seminole Nation of Oklahoma** are federally recognized Indian tribes that have adopted resolutions condemning the use of Indian names and mascots by sports teams.

Amicus **National Indian Education Association ("NIEA")** is the largest and oldest membership-based Indian education organization in the United States, representing scores of Native schools and educational institutions, as well as numerous Native educators and students.

Amicus **National Indian Youth Council ("NIYC")** was established in 1961 by a group of Native students in Gallup, New Mexico, and is the second oldest Indian rights organization; it works throughout the Western Hemisphere to preserve and establish the rights of indigenous people.

Amicus **National Indian Child Welfare Association ("NICWA")** is a private, non-profit organization dedicated to improving the lives of Indian children and their families, offering technical assistance related to Indian child welfare services and providing information regarding the needs and problems of Indian children.

Amicus **American Indian Higher Education Consortium ("AIHEC")** is the collective voice of the

36 Tribal Colleges and Universities ("TCUs") in the United States which have become increasingly important to educational opportunity for Native American students.

Amicus American Indian College Fund ("AICF") was established in 1989 by presidents of TCUs who recognized the need for private-sector funding to help transform Native American higher education.

Amicus National Native American Law Student Association ("NNALSA") is a student led non-profit corporation open to both Native and non-Native American students which promotes the development of Native American legal scholarship and fights for the advancement of Native Americans through our legal work.

Amicus Tulsa Indian Coalition Against Racism ("TICAR") is a broad-based coalition founded by American Indians from the 39 Indian Nations in Oklahoma; it was organized around the issue of eliminating the "Redskins" name and images from the public schools in Tulsa, Oklahoma.

Amicus Capitol Area Indian Resources ("CAIR") is a non-profit organization that encourages the development of all aspects of education for the American Indian community who reside in the Sacramento region, while affirming and preserving Native cultural and traditional values.

Amicus American Indian Studies-University of Illinois (Urbana Champaign) ("AIS-UI") is an academic program which offers research and courses focused on the lives and histories of Native American and other indigenous peoples; *Amicus Native*

American House ("NAH") is a student services unit at the University of Illinois. These two organizations led the effort to retire the University's former mascot – Chief Illiniwek – and continue their work to retire images that confine the perception of an entire people to a centuries-old stereotype.

Amicus Wisconsin Indian Education Association ("WIEA") "Indian" Mascot and Logo Taskforce was created by WIEA in 1997 to provide educational advocacy to eliminate all "Indian" logos, mascots and team names from Wisconsin public schools; to date, more than thirty Wisconsin School Districts have retired such names and mascots.

Amicus Native Americans at Dartmouth ("NAD") is a student organization comprised of the Native American and other students at Dartmouth College interested in the exploration and expression of the traditional and contemporary aspects of Native American intellectual, social, cultural, and spiritual life who have seen their educational experience disrupted by the expression of negatively stereotyped images of American Indians, including Indian Mascots.

Amicus Native Americans at Brown ("NAB") is an organization that provides a network for Native students through the local native community which brings political and cultural events of significance to Brown University and speaks out against destructive slander in the form of Indian mascots which jeopardize their academic success.

Amicus National Institute for Native Leadership in Higher Education ("NINLHE") was founded in 1993 to transform higher education

for Native students in the United States and Canada by promoting culturally appropriate practices and strengthening the capacity of higher education professionals responsible for improving Native student recruitment, retention and graduation rates.

Amicus **Society of American Indian Government Employees ("SAIGE")** is a national organization of federal employees who are Native American; its mission is to promote the recruitment, retention, development, and advancement of government employees who are Native American.

Amicus **Native American Journalists Association ("NAJA")** serves Native American journalists through programs and actions designed to enrich journalism and promote Native cultures and is committed to increasing the representation of Native journalists in mainstream media.

Amicus **Native American Finance Officers Association ("NAFOA")** is a national non-profit organization comprised of tribal finance officers, controllers, treasurers, accountants, auditors and financial advisors which works to build the financial strength of tribal governments and their enterprises.

Amicus **Indigenous Democratic Network ("INDN's List")** is a grassroots political organization devoted to recruiting and electing Native American candidates and mobilizing the vote for those candidates.

Amicus **Americans for Indian Opportunity ("AIO")** is a national non-profit organization established in 1970 with the goal of creating new avenues for international Indigenous interaction and

explore ways Indigenous peoples can influence globalization.

Amicus Alianza Indígena Sin Fronteras ("Alianza") is an Indigenous grassroots organization committed to promoting respect and protection of Indigenous rights, including Indigenous sovereignty and self-determination.

Amicus International Indian Treaty Council ("IITC") was founded in 1974; in 1977, it received formal recognition from the United Nations Economic and Social Council as a Non-Governmental Organization with Consultative Status, the first Indigenous NGO to be accorded such status. IITC focuses its work internationally, primarily before various United Nations human rights forums.

SUMMARY OF ARGUMENT

For almost forty years the Native American community has sought to retire Pro-Football's "Redskins" trademark. The mark is patently offensive, disparaging, and demeaning and perpetrates a centuries-old stereotype. Since 1968, when *amicus* NCAI began its effort to eradicate the use of Native American stereotypes, hundreds of high schools and colleges have discontinued their use of Indian names and mascots. Moreover, numerous organizations – including the United States Commission on Civil Rights and the NCAA – have issued declarations on this subject. The importance of this issue warrants this case being decided on the merits.

The decisions below have not only deprived Native Americans of the opportunity to pursue cancellation of the "Redskins" mark, they have also held petitioners to a far stricter standard than commercial plaintiffs are held in everyday intellectual property cases. In such cases – whether brought to enforce patent, copyright, or trademark rights – the plaintiff's delay in filing suit almost never bars it from securing relief against ongoing infringement. Absent affirmative conduct amounting to acquiescence, laches generally bars an award of damages but does not bar the issuance of an injunction. There is no reason why the Native Americans pursuing this case should be held to a higher standard than commercial plaintiffs in everyday intellectual property litigation.

REASONS FOR GRANTING THE PETITION

I. THIS CASE PRESENTS AN ISSUE WITH NATIONAL IMPLICATIONS THAT SHOULD BE DECIDED ON THE MERITS BECAUSE IT INVOLVES A REGISTERED TRADEMARK THAT DISPARAGES AN ENTIRE ETHNIC GROUP AND PERPETUATES A CENTURIES-OLD STEREOTYPE

The TTAB found that the laches defense was inapplicable to the disparagement claim brought by petitioners because the claim was based on:

[T]he broader interest—an interest beyond the personal interest being presented by the petitioners—in preventing a party from receiving the benefits of registration where a trial might show that respondent's marks hold a substantial segment of the population up to public ridicule.

(Pet. App. 18).

The courts below, however, applied the *equitable* doctrine of laches and focused on petitioners' "actual knowledge of the trademarks being used in the marketplace" as a measure for whether their delay in bringing suit was reasonable (Pet. App. 47). They went on to find that Pro-Football was *prejudiced* by the delay – even though it had actual knowledge ***since at least 1972*** that the mark is disparaging to Native Americans.

The truth of the matter is that, for nearly five decades, Native Americans have pressed for retirement of all team names and mascots that disparage Native Americans; their efforts have effected a sea change in the use of such symbols at the high school, college, and university levels. The public interest in eliminating such marks from the federal trademark register warrants this case being decided on the merits.

A. "Redskins" Is a Pejorative Term for Native Americans and Should Never Have Been Registered as a Federally Protected Trademark

Pro-Football's use of the "Redskins" mark disparages Native Americans just as "San Francisco Chinks, New York Jews, Dallas Wetbacks, Houston Greasers and the Green Bay Crackers" would disparage other groups if they were the subject of trademark registrations.³ Contemporary Native leaders, scholars, and writers have made similar observations:

As far as I can determine, there is only one species of human beings . . . that have sports teams named after the color of their skin – the American Indian.

Tim Giago (Oglala Sioux).⁴

³ Letter dated July 18, 1972 from Billy Kevin Gover (Comanche) to E.B. Williams, President of Pro-Football. Mr. Gover wrote to explain why the term "Redskins" is "offensive."

⁴ LARRY LIPMAN, *Are tomahawks, war chant racist?*, COX NEWS SERVICE, Oct. 9, 1991.

On its face, the term "Redskins" describes Native Americans by the color of their skin. This is demeaning to Native Americans, as it would be to any ethnic group. In comparison to all other Indian team names and mascots, Fred Veilleux (Ojibway) explains:

The Washington Redskins are the worst There is nothing more disrespectful or demeaning than to call an Indian a redskin. It would be like calling a black man a nigger.⁵

To many Native Americans, the term "Redskins" is associated with the barbaric practice of scalping.⁶ The record in this case is replete with evidence of bounty proclamations issued by the colonies and companies. These proclamations demonstrate that the term "Redskins" had its origins in the commodification of Indian skins and body parts; these "Redskins" were required as proof of Indian kill in order for bounty hunters to receive payment.⁷

⁵ DON BOXMEYER, *Humboldt urged to leave Indians in peace*, ST. PAUL-PIONEER PRESS DISPATCH, Nov. 29, 1987.

⁶ "Removal of all or part of the scalp, with hair attached, from an enemy's head." BRITANNICA CONCISE ENCYCLOPEDIA, at <http://www.britannica.com/EBchecked/topic/526434>. All of the URLs cited in this brief were last visited on Oct. 16, 2009.

⁷ See GEORGE A. BRAY III, SCALPING DURING THE FRENCH AND INDIAN WAR, at <http://www.earlyamerica.com/review/1998/scalping.html>; JOHN FRANCIS SPRAGUE, *A Proclamation – Indians*, 7 SPRAGUE'S JOURNAL OF MAINE HISTORY 47 (May June July 1919) (A 1755 Proclamation encouraged scalping as a means of providing valid "evidence" of having killed a Native American man, woman, or child).

Turning a blind eye to the term's heinous origins, Pro-Football maintains that its use of the mark is, and always has been, honorific. When beseeched by the Native American community to voluntarily discontinue the use of this name, Pro-Football denied that "Redskins" is a racial slur or that it is objectionable in any context.

**B. Native American Groups Brought
Their Case Directly to Pro-Football as
Early as 1972**

Neither petitioners nor the Native American community unreasonably delayed their effort to convince Pro-Football to drop its use of the "Redskins" name. In 1972, *amicus* AIO and other leaders of the Native American community⁸ reached out to the team's owners directly. Harold Gross, Director of the Indian Legal Information Development Service, sent a letter to Edward Bennett Williams, then President of Pro-Football, explaining why "Redskins" was disparaging:

Born at a time in our history when the national policy was to seize Indian land and resources, and hunt down Indian people who stood in the way, the term "Redskin" has been perpetuated through such media as western movies and television. Most often, the term is

⁸ The group included AIO President LaDonna Harris (Comanche), American Indian Movement Founder Dennis J. Banks (Leech Lake Chippewa), American Indian Press Association News Director Richard V. LaCourse (Yakama), and other Native American leaders.

coupled with other derogatory adjectives, as "dirty Redskin" or "pesky Redskin" which is used interchangeably with the word "savage" to portray a misleading and denigrating image of the Native American.⁹

(Pet. App. 247). At about the same time a consortium of Native American organizations, including *amicus* NCAI, issued five "Recommendations to the Washington, D.C. Professional Football Team," including the recommendation that "the derogatory racial epithet 'Redskins' be withdrawn."¹⁰ That same year, *Amicus* NIYC sent a separate letter to the team explaining that "Redskin" is a racial slur.¹¹

In 1988 and 1992, when the team participated in the Super Bowl, the Native American community conducted high-publicity demonstrations and protests to bring the public's attention to this issue. During the 1988 NFC championship game, Fans Against Indian Racism ("FAIR") sponsored a banner flown above RFK Stadium demanding: "MAKE WASHINGTON AMERICA'S TEAM. CHANGE

⁹ Letter of 1/18/72 from H.M. Gross to E.B. Williams. Mr. Gross added that Native American imagery "perpetuates stereotypes in which American Indians are seen as participating in scalp taking, war-whooping, and expressing themselves in ungrammatical grunts, ughs and other tontoisms." *Id.*

¹⁰ LEON F. COOK, *et al.*, *Recommendations . . .*

¹¹ Letter of 3/29/72 from R. Aguilar to Washington Redskins.

THE NAME."¹² The 1992 Super Bowl prompted four days of actions by approximately 3,000 Native Americans and their allies at the Metrodome in Minneapolis.¹³

Today, over 60,000 fans attend a typical NFL game each week, while another 10 million households watch one or more games on television.¹⁴ Super Bowl XLIII, played in January 2009, was seen by an estimated 151 million viewers in 230 countries and in 34 languages.¹⁵ Because Native Americans live in isolated and, in some cases, remote areas of the country, most Americans have never met a Native American person.¹⁶ Thus what most people learn and believe about Native Americans are the images and stereotypes provided via the media, particularly the immensely popular and widely-viewed games of the NFL.

Sadly, the success of Pro-Football on the field in the late 1980's and early 1990's hardened its

¹² MARK GROSSMAN, *'Redskins' irks Indians; protests planned*, FAIRFAX JOURNAL, Jan. 21, 1988, at A1.

¹³ MARGARET COHEN, *Indian mascot protest starts*, RAPID CITY JOURNAL, Jan. 24, 1992; ERIC HAASE, *3,000 Rally Against Racist Mascots*, LAKOTA TIMES, Jan. 28, 1992, at B1.

¹⁴ Hiestand, M., *Selected weekend TV ratings*, <http://www.usatoday.com/sports/weekend-tv-ratings.htm>.

¹⁵ Sports No Limit, *NFL: Americas Choice: Television: July 2009*, http://www.groundreport.com/Business/NFL-Americas-Choice-Television-July-2009_1/.

¹⁶ Pewewardy, C., *The Americanizing of "Pocahontas": Misconceptions and assimilation of an American Indian heroine*, November 1995 paper presented at the NIEA Annual Convention, Tucson, Arizona.

resistance to retiring the "Redskins" mark. And so this litigation ensued. But the seven petitioners have never stood alone. In 1993, *amicus* NCAI issued a "Resolution in Support of the Petition for Cancellation of the Registered Service Marks of the Washington Redskins AKA Pro-Football, Inc." In this statement, NCAI denounced the team's name:

[T]he term REDSKINS is not and has never been one of honor or respect, but instead, it has always been and continues to be a pejorative, derogatory, denigrating, offensive, scandalous, contemptuous, disreputable, disparaging, and racist designation for Native Americans.

(Pet. App. 246). Likewise, *amicus* NIEA sent a letter to the D.C. City Council explaining that the insult of the "Redskins" name went beyond the name itself, and included "fans in the stadium . . . acting out the worst possible Indian stereotypes."¹⁷

The cancellation petition filed by petitioners should be viewed against this historical backdrop. While the petition was not filed until 1992, it followed a twenty-year effort by the Native American community to convince the team to voluntarily change its name. Moreover, as discussed below, in 1968 – just one year after Pro-Football first registered the "Redskins" mark – the Native American community commenced a broad-scale effort to eradicate the use of Native American names

¹⁷ BUNTY ANQUOE, *D.C. Council to consider 'Redskins' protest*, LAKOTA TIMES, Mar. 4, 1992, at 1.

and imagery by schools and teams across the country.

C. Native American Groups Have Brought National Recognition to the Fact that Native American Team Names and Mascots Are Disparaging and Demeaning

With the advances of the civil rights movement in the 1950's and 1960's, Native organizations seized the opportunity to raise the public consciousness regarding the racist and demeaning depiction of Native Americans as sports mascots. As early as 1961, *amicus* NIYC organized against "Native" sports references and other promoters of demeaning depictions of actual Native American peoples. And, beginning in 1968, *amicus* NCAI launched its ongoing campaign to address Native American stereotypes in print and other media.¹⁸

Through nearly fifty years of effort, the Native American community has brought national awareness to the fact that Indian mascots and nicknames are disparaging and demeaning. As a result, more than two-thirds of an estimated 3,000 middle schools, high schools, colleges, and universities have retired their offensive mascots and changed their team names.¹⁹ Early examples include:

¹⁸ A Timeline of Change ("TIMELINE"), <http://www.ncai.org/ncai/resource/documents/governance/mastimeline.htm>.

¹⁹ COURTLAND MILLOY, *If the Redskins Care About Honor . . .*, THE WASHINGTON POST, Sep. 23 2009.

- 1970: The University of Oklahoma retired its "Little Red" dancing mascot.²⁰
- 1972: Dickinson State changed "Savages" to "Blue Hawks."²¹
- 1973: Stanford ended its "Indians" mascot and imagery.²²
- 1974: Dartmouth changed "Indian" to "Big Green."²³
- 1975: Syracuse changed "Saltine Warrior" to "Orange."²⁴
- 1980: Southern Oregon shortened "Red Raiders" to "Raiders."²⁵

More recent examples include:

- 1988: Siena College changed "Indians" to "Saints."²⁶
- 1988: St. Mary's College changed "Red Men" to "Cardinals."²⁷

²⁰ *Id.*

²¹ Chronology of the American Indian Sports Team Mascot Issue, <http://www.aistm.org/1chronologypage.html>.

²² STANFORD FACTS 2004, <http://www.gostanford.com/school-bio/stan-nickname-mascot.html>; DENNI DIANNE WOODWARD, *The Removal of the Indian Mascot of Stanford*, <http://nacc.stanford.edu/mascot>.

²³ TIMELINE, *supra*.

²⁴ SU'S MASCOT, <http://suathletics.syr.edu/sports/2001/8/8/mascot.aspx>.

²⁵ <http://www.aistm.org/1chronologypage.html>.

²⁶ *Id.*

- 1992: Simpson College did away with "Redmen" and "Lady Reds" in favor of "Storm" and "Thundercats."²⁸
- 1994: Marquette changed from "Warriors" to "Golden Eagles," following earlier elimination of various mascots, including "Willie Wampum," "Chief White Buck" and "First Warrior."²⁹
- 1994: St. John's changed from "Redmen" to "Red Storm."³⁰
- 1996: Tennessee stopped using its mascot, "Chief Moccannooga."³¹
- 1996: Adams State University changed its mascot from "Indian" to "Grizzly."³²
- 1998: Oklahoma City University gave up "Chiefs" for "Stars."³³
- 1998: Morningside College replaced "Maroon Chiefs" with "Mustangs."³⁴

²⁷ *Id.*

²⁸ *Id.*

²⁹ *Id.*

³⁰ TIMELINE, *supra*; RICK TELANDER, *Time's right for Illiniwek to dance off into sunset*, CHICAGO SUN-TIMES, Oct. 20, 2000.

³¹ *"Inappropriate" UTC Mascot Axed*, Chattanooga Free Press, July 3, 1996.

³² <http://www.aistm.org/1chronologypage.html>.

³³ *Id.*

³⁴ *Id.*

- 2001: Southwestern College went from "Apaches" to "Jaguars."³⁵
- 2001: Cumberland College changed from "Indians" to "Patriots."³⁶
- 2006: Northeastern State changed from "Redmen" to "RiverHawks."
- 2007: University of Illinois got rid of the dancing mascot, "Chief Illiniwek."³⁷

Moreover, scores of schools have discontinued the use of "Redskins" as a name and/or mascot, including, but not limited to:

- Central High School, North Dakota (1991)³⁸
- Naperville Central High School, Illinois (1992)³⁹
- Arvada High School, Colorado (1993)⁴⁰
- Seneca High School, Kentucky (1995)
- Miami University, Ohio (1996)⁴¹

³⁵ *Id.*

³⁶ *Id.*

³⁷ *Chief Illiniwek Will No Longer Perform*, PRESS RELEASE, Feb 16, 2007, <http://www.uillinois.edu/chief>

³⁸ *Journalist unprepared for reservation visit*, THE FORUM, Nov. 20, 1991, at A5.

³⁹ <http://www.ncusd203.org/central/html/who/mascot.html>

⁴⁰ <http://jeffcoweb.jeffco.k12.co.us/high/arvada/history.html>

⁴¹ JENNIFER E. MARKIEWICZ, *'Redskins' banned by University Senate*, MIAMI STUDENT, Apr. 13, 1993, at 1; TIMELINE, *supra*.

- Southern Nazarene University, Oklahoma (1998)⁴²
- Rickards High School, Florida (1999)
- Frontier High School, Massachusetts (2000)
- Saranac Lake School District, New York (2001)
- Scarborough High School, Maine (2001)⁴³
- Parsippany High School, New Jersey (2001)⁴⁴
- Marshall High School, Michigan (2002)⁴⁵
- Colusa Unified School District, California (2008).⁴⁶

At least five newspapers have adopted policies forbidding the use of "Redskins" to identify sports teams: the Oregonian (Portland, Ore.); the Portland (Maine) Press Herald; The St. Cloud (Minn.) Times;

⁴² TIMELINE, *supra*.

⁴³ GREGORY KESICH, *Sports teams down to wire on nickname . . .*, PORTLAND PRESS HERALD, Jan. 20, 2001, at 1B.

⁴⁴ The Associated Press State & Local Wire, *Redskins Out, Red Hawks In at Parsippany School*, May 26, 2001.

⁴⁵ CHRIS SPRINGSTEEN, *Marshall opts out of nickname: Civil rights case settlement approved*, BATTLE CREEK ENQUIRER, Sept. 24, 2002.

⁴⁶ DAN STEINBERG, *School Drops Redskins Name*, April 2008, http://voices.washingtonpost.com/dcsportsbog/2008/04/school_dr_ops_redskins_name.html.

the Kansas City (Mo.) Star, and the Lincoln (Neb.) Journal Star.⁴⁷

The national awareness on mascot issues led the United States Commission on Civil Rights to issue the following statement on April 13, 2001:

The Commission assumes that when Indian imagery was first adopted for sports mascots it was not to offend Native Americans. However, the use of the imagery and traditions, no matter how popular, should end when they are offensive.⁴⁸

In 2005, the NCAA announced a ban on the use of American Indian mascots during its postseason tournaments.⁴⁹ The ban followed objections lodged by more than 80 organizations representing Native Americans and four years of study, which included data-collection and considerable psychological and academic research.⁵⁰ It goes without saying that the ban has not diminished the popularity and fan

⁴⁷ See NAJA, *Reading Red Report 2003: A Call for the News Media to Recognize Racism in Sports Teams Nicknames and Mascots*, http://www.naja.com/03_ReadingRedReport.pdf.

⁴⁸ Statement of the United States Commission on Civil Rights on the Use of Native American Images and Nicknames as Sports Symbols, April 13, 2001, <http://aistm.org/fr.usccr.htm>.

⁴⁹ NCAA Executive Committee Issues Guidelines for Use of Native American Mascots at Championship Events, Aug. 5, 2005, <http://www.ncaa.org>.

⁵⁰ BERNARD M. FRANKLIN, *Challenges of the Indian mascot policy - Association's position backed by research and deliberation*, May 27, 2006, <http://www.ncaa.org>.

appeal of NCAA tournaments in the slightest – a fact that renders disingenuous any claim by Pro-Football of dire consequences were it to lose its "Redskins" registration.

Hundreds of high schools, colleges and athletic organizations have come to recognize that Native American mascots and team names are deeply offensive to Native Americans and that they perpetuate a centuries-old stereotype that holds Native Americans up to ridicule and contempt. Pro-Football is one of the few – and certainly the most visible – holdouts to this praiseworthy trend. It is unfortunate that the Native American community was forced to address this problem via litigation. It is even more unfortunate that the courts below refused to allow this important issue to be decided on the merits. This petition gives the Court the opportunity to meet this issue squarely, and to allow this matter to be determined on the merits.

II. THE APPLICATION OF THE LACHES DOCTRINE TO BAR PROSPECTIVE RELIEF FOR THE NATIVE AMERICAN PETITIONERS IS CONTRARY TO THE TREATMENT OF COMMERCIAL PLAINTIFFS IN EVERYDAY INTELLECTUAL PROPERTY CASES

One of the most ironic results of the decisions below is that they punish the Native American petitioners for their delay in seeking to cancel the "Redskins" trademark, thereby treating petitioners far more unfairly than commercial plaintiffs are treated in everyday litigation involving intellectual property rights. By the same token, in permitting Pro-Football to continue holding a federal registration for a highly visible mark that is patently offensive to an entire ethnic group, Pro-Football is being treated far more favorably than commercial defendants are treated in everyday intellectual property cases.

The underlying scenario of this dispute is no different from the scenario in many routine intellectual property cases involving purely commercial parties, *viz*:

- A plaintiff seeks to stop a defendant from ongoing conduct that infringes plaintiff's intellectual property rights;
- Citing plaintiff's lengthy delay in filing suit, the defendant argues that plaintiff is barred by laches from pursuing its claim; and

- To bolster its laches argument, defendant points to its enormous investment in utilizing the intellectual property in question to develop or grow its business.

In everyday cases involving intellectual property rights, the laches defense may bar relief for past infringement, but it rarely bars relief against ongoing infringement. Unless the defendant can show affirmative conduct by the plaintiff amounting to acquiescence (or so-called equitable estoppel), the court can enjoin the defendant from ongoing infringement ***no matter how long plaintiff delayed in asserting its rights.*** This well-established principle has its roots in this Court's 1888 decision in *Menendez v. Holt*, 128 U.S. 514, 523-24 (1888), a trademark infringement case in which the Court explained:

Mere delay or acquiescence cannot defeat the remedy by injunction in support of the legal right, unless it has been continued so long, and under such circumstances, as to defeat the right itself Acquiescence, to avail, must be such as to create a new right in the defendant....

So far as the act complained of is completed, acquiescence may defeat the remedy on the principle applicable when action is taken on the strength of encouragement to do it; but so far as the act is in progress, and lies in the future, the right to the intervention of equity is not generally lost by previous

delay, in respect to which the elements of an estoppel could rarely arise.

This principle has been consistently applied to intellectual property disputes involving patents⁵¹ and copyrights⁵² and, in most circuits, to disputes involving trademarks.⁵³ In such cases the plaintiff's

⁵¹ *A.C. Aukerman Co. v. R.L. Chaides Constr. Co.*, 960 F.2d 1020, 1039-41 (Fed. Cir. 1992) (laches will bar relief in a patent case only for infringement prior to suit, but not for ongoing infringement); *Leinoff v. Louis Milona & Sons*, 726 F.2d 734, 741 (Fed. Cir. 1984) (defendant's business investment during delay by plaintiff does not bar permanent injunction to stop infringement). Although this Court's decision in *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006), requires a court to apply the traditional four-factor equity test before awarding an injunction in a patent infringement case, laches alone will not bar such relief.

⁵² Under copyright law, each act of infringement gives rise to an independent claim for relief so that ongoing infringement may be enjoined even though it began prior to the three-year limitations period specified in 17 U.S.C. § 507(b). *Stone v. Williams*, 970 F.2d 1043, 1049-50 (2d Cir. 1992); *Mount v. Book-of-the-Month Club, Inc.*, 555 F.2d 1108, (2d Cir. 1977); see *Roley v. New World Pictures, Ltd.*, 19 F.3d 479, 481 (9th Cir. 1994). Moreover, while some courts have permitted laches to be asserted against claims brought *within* the three-year statutory period, in such cases laches only bars retrospective damages, not prospective relief such as an injunction. *Peter Letterese and Assocs., Inc. v. World Inst. of Scientology Enters., Int'l*, 533 F.3d 1287, 1320-21 (11th Cir. 2008); *Lyons P'ship v. Morris Costumes, Inc.*, 243 F.3d 789, 800 (4th Cir. 2001); but see *Danjag LLC v. Sony Corp.*, 263 F.3d 942, 959-60 (9th Cir. 2001).

⁵³ The vast majority of Circuits have recognized that laches is not a bar to relief against ongoing trademark infringement unless the delay in seeking relief also involves affirmative conduct that amounts to acquiescence. *ProFitness Physical*

delay in filing suit may well prevent an award of damages for past (or even post-complaint) infringement. And while laches would certainly prevent the entry of a preliminary injunction, laches alone will not prevent the entry of a permanent injunction enjoining the defendant's ongoing infringement. In order to bar relief against ongoing infringement, the defendant must establish

Therapy Center v. Pro-Fit Orthopedic and Sports Physical Therapy P.C., 314 F.3d 62 (2d Cir. 2002) (laches and acquiescence would not prevent injunctive relief if the likelihood of confusion outweighed the effect of plaintiff's delay); *University of Pittsburgh v. Champion Prods., Inc.*, 686 F.2d 1040 (3d Cir. 1982) (40-year delay in contesting defendant's sale of merchandise bearing the school's name and logo precluded the University's claim for an accounting but not its claim for an injunction); *Lyons P'ship v. Morris Costumes, Inc.*, 243 F.3d 789, 799 (4th Cir. 2001) ("[I]f the claim is one for injunctive relief laches would not apply"); *Conan Properties, Inc. v. Conans Pizza, Inc.*, 752 F.2d 145, 152 (5th Cir. 1985) ("A finding of laches alone ordinarily will not bar the plaintiff's request for injunctive relief, although it typically will foreclose a demand for an accounting or damages."); *Kellogg Co. v. Exxon Corp.*, 209 F.3d 562, 568 (6th Cir. 2000) ("Although laches precludes a plaintiff from recovering damages, it does not bar injunctive relief."); *Indep. Nail & Packing Co. v. Stronghold Screw Products, Inc.*, 205 F.2d 921, 927 (7th Cir. 1953) (mere delay in bringing suit does not affect the right to an injunction against further use of an infringing trademark); *SunAmerica Corp. v. Sun Life Assurance Co.*, 77 F.3d 1325 (11th Cir. 1996) (permanent injunction appropriate despite 60-year delay in filing suit). *But see N.A.A.C.P. v. N.A.A.C.P. Legal Defense & Educ. Fund, Inc.*, 753 F.2d 131, 138 (D.C. Cir. 1985) (mere delay was sufficient to bar injunctive relief) and *Prudential Ins. Co. v. Gilbraltor Fin. Corp.*, 694 F.2d 1150, 1152 (9th Cir. 1982) (laches alone sufficient to bar injunctive relief because the Ninth Circuit "for policy reasons" has chosen to read the Lanham Act "narrowly").

equitable estoppel based on ***affirmative acts of acquiescence*** by plaintiff.

In *Studiengesellschaft Kohle mbH v. Eastman Kodak Co.*, 616 F.2d 1315, 1325 (5th Cir. 1980), the Fifth Circuit explained the difference between mere laches and estoppel by acquiescence:

Although laches and estoppel are related concepts, there is a clear distinction between the two. The defense of laches may be invoked where the plaintiff has unreasonably and inexcusably delayed in prosecuting its rights and where that delay has resulted in material prejudice to the defendant. ***The effect of laches is merely to withhold damages for infringement which occurred prior to the filing of the suit.***

Estoppel, on the other hand, "arises only when one has so acted as to ***mislead*** another and the one thus misled has relied upon the action of the inducing party to his prejudice." Estoppel forecloses the patentee from enforcing his patent prospectively through an injunction or through damages for continuing infringement. (Emphasis added.)

Similarity, in *Nartron Corp. v. Stmicroelectronics, Inc.*, 305 F.3d 397, 412 (6th Cir. 2002), the Sixth Circuit stated:

[T]o defeat a suit for injunctive relief, a defendant must also prove elements of

estoppel which requires more than a showing of mere silence on the part of a plaintiff; defendant must show that it had been misled by plaintiff through actual misrepresentations, affirmative acts of misconduct, intentional misleading silence, or conduct amounting to virtual abandonment of the trademark.

Quoting SCI Sys., Inc. v. Solidstate Controls, Inc.,
748 F. Supp. 1257, 1261-62 (S.D. Ohio 1990).⁵⁴

All of these everyday commercial cases – whether based on patent, copyright, or trademark infringement – have one thing in common: as a result of the owner's delay in filing suit, the infringer had built up a significant business utilizing the intellectual property in question. While that delay barred the owner from seeking damages or an accounting for the defendant's past infringement, it did not bar the issuance of a permanent injunction prohibiting ongoing infringement. Thus while the infringer was entitled to retain whatever profits it had realized during the years prior to the lawsuit, it was forced to halt its ongoing infringement – despite

⁵⁴ It would be amusing to see Pro-Football attempt to prove that the Native American community affirmatively misled it into thinking that Native Americans approved of the "Redskins" name and that the team relied on that approval in improving its team, building its stadium, or expanding its line of team-related merchandise. Pro-Football could not conceivably make such a showing because, as noted above (*see* pp. 10-14, *supra*), it has been on notice since 1972 that the Native American community finds the "Redskins" mark degrading and humiliating.

the impact that might have on its business going forward. And that impact is almost always quite severe: a patent defendant loses the ability to manufacture or sell its product; a copyright defendant loses the right to sell or otherwise use copyrighted material; a trademark defendant loses the right to sell a product whose success is inextricably linked to the mark under which it is sold.

The Native American plaintiffs in this lawsuit – who seek to vindicate the public interest through a cancellation petition of a registered mark which disparages Native Americans – should not have to meet a stricter standard of timeliness than the commercial plaintiffs in everyday intellectual property cases who seek to vindicate only their own individual commercial interests. By the same token, Pro-Football should not be exempt from the requirement that, in order to justify continued registration of its mark, it must show that it relied on affirmative acts of acquiescence by plaintiffs as opposed to mere delay. Yet, as a result of the decisions below, Pro-Football has been afforded a greater right to continued registration of its disparaging trademark than defendants in routine intellectual property cases have in continued sale of a product that infringes a patent, copyright, or trademark.

And here is the final irony of this case. If another football team had accused Pro-Football of infringing its prior rights in the Redskins mark, Pro-Football's *ongoing use* of the mark would be enjoined absent proof of affirmative conduct showing that the other team had acquiesced in that use. Yet in this case,

where Native Americans have merely challenged Pro-Football's right to continue its Federal *registration* of the mark, the team's use of the mark over time – *and in the face of 40 years of protest by Native Americans* – has been found to give the team a right to the perpetual retention of its registration. There is no reason in law, logic, or public policy why this should be so.

CONCLUSION

The numerous Native American organizations who have sponsored this brief urge this Court to grant the petition for a writ of certiorari to the U.S. Court of Appeals for the District of Columbia.

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