

# The Trademark Reporter®



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**COMMENTARY****REDSKINS, ESKIMOS, AND INDIANS:  
THE CANADIAN APPROACH TO DISPARAGING  
TRADEMARKS**

*By Tamara Céline Winegust,\* Noelle Engle-Hardy,\*\*  
and Susan J. Keri\*\*\**

**I. INTRODUCTION**

In *Pro-Football, Inc. v. Amanda Blackhorse*<sup>1</sup> (“the REDSKINS decision”), the U.S. District Court for the Eastern District of Virginia upheld an earlier decision of the Trademark Trial and Appeal Board of the United States Patent and Trademark Office (USPTO) canceling six trademark registrations containing the term REDSKINS on the basis that they may disparage Native Americans. The decision raises interesting questions for trademark practitioners in Canada, where issues regarding Aboriginal peoples have recently taken a front seat in the national consciousness.

In June 2015, the Truth and Reconciliation Commission of Canada released its summary report on forced residential schooling of First Nations children.<sup>2</sup> This report—the conclusion of a six-year examination of the history and legacy of residential schools—encouraged Canadians to revisit and reconsider their history in the treatment of First Nations’ peoples. This national introspection raises the question of whether trademarks such as REDSKINS, EDMONTON ESKIMOS, and INDIAN MOTORCYCLE, all of which are registered as trademarks in

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1. *Pro-Football, Inc. v. Blackhorse*, Case No. 1:14-cv-01-43-GBL-IID (E.D. Va. 2015).

2. The 381-page summary of the final report, due later in 2015, was read aloud by Justice Murray Sinclair, Chair of the Truth and Reconciliation Commission, on June 2, 2015. Residential Schools were government-sponsored religious schools established by the government and administered by the Roman Catholic, Anglican, Methodist, United, and Presbyterian Churches to assimilate Aboriginal children into Euro-Canadian culture, between 1880 and 1969. The report concluded that the legacy of residential schools—described as a cultural component to a government-led policy of cultural genocide—has continued to manifest in racism, systemic discrimination, poverty, and dying indigenous languages.

Canada, may face successful challenges in Canada as well on the basis that they no longer represent socially acceptable commercial designations. This commentary will briefly look at the Canadian statutory regime governing scandalous trademarks, and how it might apply to a REDSKINS-like claim.

## II. WHAT TRADEMARKS ARE PROHIBITED IN CANADA?

Section 9(1)(j) of the Canadian Trade-marks Act<sup>3</sup> prohibits any person from adopting “in connection with a business, as a trademark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for . . . (j) *any scandalous, obscene or immoral word or device.*” This is distinguishable from the analogous provision in Section 2(a) of the Lanham Act,<sup>4</sup> relied on in the REDSKINS decision, in several notable respects.

Under the Canadian Trade-marks Act, the grounds upon which a mark may be attacked are much narrower than under U.S. law, which applies not only to trademarks that consist of “immoral, deceptive, or scandalous matter” but also to marks consisting of 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.” In addition, the effect of the prohibition in Canada is wholly different. In the United States, only *registration* is prohibited. This was critical in the REDSKINS decision, where cancellation of the registration did not preclude use of the mark (and thus, in the view of the Court, did not impinge on any First Amendment free speech rights). In Canada, Section 9(1)(j) is an outright prohibition against any adoption of the mark, be it registered or unregistered.

## III. WHEN MUST THE MARK BE CONSIDERED OBSCENE OR UNACCEPTABLE?

In the REDSKINS decision, the Court was restricted to considering whether the mark should be cancelled because it disparaged a substantial composite of Native Americans *as of the date the marks were registered* (the earliest mark being registered in 1967, the latest in 1990), relying on prior decisions considering this issue.<sup>5</sup> An analogous provision under the Canadian Trade-marks Act would be Section 18(1)(a), which permits a trademark registration to be invalidated if it was not registrable *at the date of*

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3. Section 9(1)(j) of the Canadian Trade-marks Act, R.S.C. 1985 c. T-13 (emphasis added).

4. 15 U.S.C. § 1052(a).

5. *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080, Cancellation No. 92046185 (T.T.A.B. 2014); *see also supra* note 1, at 36; *See Harjo v. Pro-Football, Inc.*, 30 U.S.P.Q.2d 1828, 1833 (T.T.A.B. 1994); and 50 U.S.P.Q.2d 1705, 1710 (T.T.A.B. 1999).

*its registration* on the basis that it was scandalous, obscene, or immoral, in violation of Section 9(1)(j) of the Trade-marks Act. However, other sections of the Canadian Trade-marks Act could conceivably be relied on to support the position that a registration, valid at the date of its issuance, may, over time, and taking into consideration changing social mores, be deemed unregistrable as of the date on which the attack is made.

For example, under Section 18(1)(b) of the Trade-marks Act, a registration can be invalidated on the basis that the trademark is not distinctive *at the time the proceedings bringing the validity of the registration into question are commenced*. When combined with a Section 9(1)(j) prohibition, an argument can be advanced that as of the date when the proceedings are commenced, the mark is considered, among the general public, to represent scandalous, obscene, or immoral terminology, and, therefore, can no longer be distinctive of any single source.

Alternatively, an application can be made to the Federal Court under Section 57(1) of the Trade-marks Act by “any person interested” to expunge an entry from the Register on the basis that it “does not accurately express or define the *existing* rights of the person appearing to be the registered owner of the mark.” (emphasis added). Under this section, the existing rights of the registered owner would be assessed as of the date on which the proceedings are initiated. Moreover, the recent Federal Court decision in *Victoria’s Secret Stores Brand Management, Inc. v. Thomas Pink Limited*,<sup>6</sup> interpreted the words “any person interested” broadly, leaving the door open for a Section 57(1) application to be brought by any person affected, or who reasonably apprehends they will be affected, to challenge the validity of a registration. This broader reading of the law could open the door for a group of First Nations citizens, similar to the plaintiffs in the REDSKINS decision, to challenge REDSKINS or a similar mark in Canada on the basis that it is contrary to Section 9(1)(j) of the Trade-marks Act, being a scandalous, obscene, or immoral word or device and cannot, therefore, express an existing right to registration.

However, these are, admittedly, novel arguments that have not been addressed in Canadian jurisprudence. Nevertheless, in light of the REDSKINS decision in the United States, Canadian courts may be willing to find a way to support the position that a trademark, originally registrable at the date of its registration but truly objectionable at the date on which the registration is attacked, should be removed from the Register. If not, then this may be an issue for Canadian trademark legislative reform.

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6. 2014 F.C. 76.

#### IV. WHO MUST BE OFFENDED?

In the REDSKINS decision, the Court considered the view of the target group rather than that of the general public, looking to whether the referenced group understood the term to be disparaging. Under that approach, only a “substantial composite,” not necessarily a majority, of that group need find that the mark “may” disparage in order for the registration to be struck.

A review of current Canadian case law and examination guidelines suggests that the Canadian approach would consider a group somewhat broader than the “target” group. Although there is not a significant body of case law on the subject, decisions considering the offensiveness of a mark tend to look to the views of Canadians in general, rather than just the referenced group. For example, in *Miss Universe, Inc. v. Bohna*,<sup>7</sup> the Trademarks Opposition Board declined to find that an application to register the trademark MISS NUDE UNIVERSE violated Section 9(1)(j), instead holding that the critical issue was “what are the acceptable standards today and what would still be considered immoral, scandalous, or obscene by some people by no means few in number.” Similarly, in *Drolet v. Stiftung Gralsbotschaft*,<sup>8</sup> the Federal Court of Canada held that the subjective feelings of a group of people who felt a mark was being used to spread a false message, and were therefore offended, was insufficient to find that a mark violated Section 9(1)(j). Arguably, the Canadian approach sets a higher bar for a plaintiff to meet, insofar as the general public may not consider a term offensive or disparaging, while the target group, being more sensitized, would.

The Canadian Intellectual Property Office’s Trademarks Examination Manual reflects the broad view of the courts, stating that the prohibition extends to words or designs that are “generally defined as causing general outrage or indignation” or “regarded as taboo in polite usage.” With regard to slurs on nationality specifically, the Manual requires that the slur be “generally regarded as offensive,” but also suggests that individual perceptions may not be entirely irrelevant, acknowledging that the prohibition can extend to matter that is “offensive to the public or individual sense of propriety or morality.”<sup>9</sup>

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7. (1991), 36 C.P.R. (3d) 76 (T.M.O.B.).

8. 2009 F.C. 17 at para. 166.

9. Canadian Intellectual Property Office’s Trademarks Examination Manual (emphasis added). Although not law, the Manual may be considered persuasive authority on trademarks law in Canada, as it sets out the guidelines used by the Trademarks Office to assess the registrability of a mark.

## V. CONCLUSIONS FROM A CANADIAN PERSPECTIVE

In Canada, the REDSKINS trademark registration, owned by Pro-Football Inc., has not, to date, been the subject of a challenge. However, a review of recent press surrounding the REDSKINS name and mark suggests that at least some Canadians may be reluctant to continue its use. In 2014, a human rights complaint was brought against an Ontario pee-wee football team using the REDSKINS name and logo.<sup>10</sup> The complaint was brought, in part, by the Assembly of First Nations, one of the leading national advocacy organizations representing First Nation citizens in Canada, and was resolved after the team changed its name to the “Eagles.” In the past twenty years, at least two high schools in Eastern Ontario have also abandoned the use of “REDSKINS” in their team names.

Beyond athletics, it is clear that the word “redskin” is no longer considered appropriate to many Canadians. The Canadian Oxford English Dictionary identifies the term “redskin” as “(*dated, offensive*) a North American Indian.”<sup>11</sup> The 2015 Truth and Reconciliation Commission also cited use of the word “redskin” in public school textbooks to reference Aboriginal people as a means by which racist stereotypes were perpetuated.

Contemporary perceptions of trademarks such as REDSKINS, EDMONTON ESKIMOS, or INDIAN MOTORCYCLE within the general public may well precipitate an attack on the validity of these registrations in Canada. However, contrary to the situation in the United States, where the marks must be considered disparaging by a substantial composite of the target group *at the time they issued to registration*, arguments can be advanced in Canada to support the position that a trademark registration can be invalidated on the basis that it is scandalous, obscene, or immoral having regard to social mores within the general population *as of the date on which the registration is attacked*. Most importantly, and unlike the U.S. situation, where cancellation of a trademark registration does not preclude its use, a finding of invalidity under Section 9(1)(j) of the Canadian Trade-marks Act would result not only in the cancellation of the registration, but also in an outright prohibition against any adoption of the mark in association with a business. Hence, for famously polite Canadians, changes in societal mores may well result in the cancellation of a trademark registration as well as the

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10. The use of the REDSKINS name and logo was licensed by the owners of the Washington, D.C., football team.

11. See Canadian Oxford Dictionary 1296 (2d ed. 2004). Similar dictionary definitions were pointed to in the REDSKINS decision. See *supra* note 1, at 37, 42-46.

prohibition against its use in Canada on the basis that it no longer represents a socially acceptable commercial designation.

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