



THE LAW REVIEW OF THE FRANKLIN PIERCE CENTER FOR  
INTELLECTUAL PROPERTY

VOLUME 61 — ISSUE 3

---

**EDITORIAL BOARD**

EDITOR-IN-CHIEF

MEREDITH E. FOOR

NOTES & COMMENTS EDITOR

NICHOLAS TELLA

MANAGING EDITORS

KURT HOPPMANN  
AUSTIN LORCH

LEAD ARTICLES EDITOR

RYAN RIEKER

SYMPOSIUM & E-MEDIA EDITOR

HALEY BREEDLOVE

SENIOR EDITORS

NANCY BRAMAN

MASON CARR  
CHRISTOPHER GLUECK

HALEY GOECKEL

ASSOCIATE EDITORS

NICOLE DEMAS  
JI HYE HWANG  
PAUL KLINE  
CAMERON LINDSAY

J. MITCHELL LOWE  
JUSTIN MADER  
LOGAN MURR  
KAVYASRI NAGUMOTU

KATARINA OVERBERG  
YILING SUN  
ELEANOR WALKER

**FACULTY ADVISORS**

JON CAVICCHI & RYAN VACCA

UNIVERSITY OF NEW HAMPSHIRE FRANKLIN PIERCE SCHOOL OF LAW

**BUSINESS MANAGER**

LAURI CONNOLLY

UNIVERSITY OF NEW HAMPSHIRE FRANKLIN PIERCE SCHOOL OF LAW



***IDEA***<sup>®</sup>: *The Law Review of the Franklin Pierce Center for Intellectual Property* (ISSN 0019-1272) is published three times a year by the students of the University of New Hampshire Franklin Pierce School of Law (UNH Law), and provides practical articles relating to patent, copyright, trademark, trade secret, unfair competition, and general intellectual property law issues from around the world. Subscription information is available in the back of the Law Review.

Our mission is to be recognized worldwide as the premier intellectual property publication providing practical articles that timely address new, controversial, and potential developments in intellectual property law and related fields.

The opinions of the authors are not necessarily those of the Board of Editors, Editorial Advisory Board, Faculty Advisor(s), or UNH Law.

*IDEA*<sup>®</sup>: *The Law Review of the Franklin Pierce Center for Intellectual Property* is indexed in Current Law Index, Legal Resources Index, Index to Legal Periodicals, and Legal Contents and is available online on EBSCOhost<sup>®</sup>, HeinOnline<sup>®</sup>, WESTLAW<sup>®</sup>, LEXIS<sup>®</sup>, and at <https://law.unh.edu/IDEA>.

For additional information, call or write:

***IDEA***<sup>®</sup>: *The Law Review of the Franklin Pierce Center for Intellectual Property*

University of New Hampshire Franklin Pierce School of Law  
Two White Street  
Concord, New Hampshire 03301  
United States of America  
603.228.1541

[subscriptions@law.unh.edu](mailto:subscriptions@law.unh.edu)  
<https://law.unh.edu/IDEA>

© 2021 University of New Hampshire Franklin Pierce School of Law

Copyright in all published material in this issue is retained by the respective authors pursuant to *IDEA*'s Publishing Agreement available on the website. Copyright in the collected work is retained by UNH Law. Where UNH Law holds copyright, it grants permission for copies of articles to be made for classroom use, provided that copies are distributed at or below cost; the author and *IDEA: The Law Review of the Franklin Pierce Center for Intellectual Property* are identified; proper notice of copyright is affixed to each copy; and *IDEA: The Law Review of the Franklin Pierce Center for Intellectual Property* is notified of the use.

**Cite as: 61 IDEA \_\_ (2021).**

Notwithstanding anything to the contrary, *IDEA* should always be cited in the above-noted manner.

## SUBSCRIBER RENEWAL REQUIREMENT

Subscriptions of IDEA run on a calendar year. Payment is due before the shipment of issue one of the next volume. If you have not paid for Volume 62 directly or through your agent, your subscription will cease with this issue unless payment is received by January 31, 2022. Thank you for being a valued subscriber.

**TABLE OF CONTENTS**  
**VOLUME 61 — ISSUE 3**

---

**ARTICLES:**

**WHO ARE YOU WEARING? AVATARS, BLACKFACE  
AND COMMODIFICATION OF THE OTHER**

WILLAJEANNE F. MCLEAN.....455

**OPEN-ISH GOVERNMENT LAWS AND THE  
DISPARATE RACIAL IMPACT OF CRIMINAL  
JUSTICE TECHNOLOGIES**

BEN WINTERS .....507

**THE BELATED AWAKENING OF THE PUBLIC  
SPHERE TO RACIST BRANDING AND RACIST  
STEREOTYPES IN TRADEMARKS**

FADY J.G. AOUN .....545

**TEMPORALITY IN A TIME OF *TAM*, OR TOWARDS A  
RACIAL CHRONOPOLITICS OF INTELLECTUAL  
PROPERTY LAW**

ANJALI VATS.....673

## **A NOTE FROM THE EDITORS**

The articles contained within this publication are authored by distinguished individuals who presented at *IDEA's* Fall 2020 Symposium on Race & Intellectual Property. Please be advised that some of the articles contained within this publication include highly offensive images and derogatory language. While we understand that these may cause serious offense, our editorial team and authors have elected to include them for the purposes of providing a more accurate representation and preserving the academic record of the subject matter explored within.

## WHO ARE YOU WEARING? AVATARS, BLACKFACE AND COMMODIFICATION OF THE OTHER

WILLAJEANNE F. MCLEAN\*

### ABSTRACT

*The question “Who are you wearing?” generally elicits the name of the haute couture designer, particularly when asked during the awards season. This Article, however, uses the question to interrogate the seemingly pervasive (mis)uses of bodies of color, whether in real or virtual world spaces. As explained by bell hooks, “[w]hen race and ethnicity become commodified as resources for pleasure, the culture of specific groups, as well as the bodies of individuals, can be seen as constituting an alternative playground where members of dominating races, genders, sexual practices affirm their power-over in intimate relations with the Other.”*

*Using examples taken from various facets of American life, the Article also touches upon how the use of technology and*

---

\* Distinguished Professor of Law, University of Connecticut. An earlier version of this article was presented at the 4th National People of Color Legal Scholarship Conference at American University Washington College of Law in March, 2019. The ideas in this article were greatly enhanced by comments from my co-panelists and audience. My thanks to my colleagues, Professors Tom Morawetz and Steven Wilf, who graciously gave of their time to discuss with me my ideas or to read drafts, to Anne Rajotte for her eagle eye in finding and correcting Bluebook errors and the other reference librarians at UCONN Law who expedited my requests even in the midst of the pandemic. I also thank Dr. Kishonna L. Gray for providing me with some of her articles and sources on video gaming. My thanks also to the editors of IDEA. Any errors are, of course, all mine.

*intellectual property, in particular trademarks, has helped to maintain the status quo and further the perception of “otherness.” However, in this pivotal social movement, consumers are challenging various corporate entities to abandon or to avoid practices of cultural appropriation and commodification. To achieve this goal, it is paramount that there be representation at all levels, and that any decision making include collaboration with constituent, relevant groups to determine the impact, intent, and significance of a particular social practice.*

Abstract.....	455
I. Introduction.....	457
II. Avatars .....	458
III. Blackface.....	463
A. Digital Blackface .....	467
B. Video Games.....	469
C. Commodification and Appropriation of the Other .....	473
D. Blackface as Fashion.....	478
IV. Questions Presented .....	485
V. Conclusions.....	500
VI. Appendix.....	505



**I. INTRODUCTION**

*Who you wearing? Sean John, Calvin Klein  
Donna Karan's fashion line  
Valentino, YSL  
Ferragamo and Chanel  
Holsten, Gucci, Figla, Rucci  
Don't forget my Pucci  
Fendi and Armani  
God, I miss Gianni. . .*<sup>1</sup>

Who are you wearing?

That question is asked frequently on the red carpet for the Golden Globes, the Oscars, and the Emmys. The question was first asked by Joan Rivers in 1994,<sup>2</sup> and generally elicits the name of the designer of the gown or the purveyor of the jewels worn by the actresses as they arrive at the awards venue.<sup>3</sup> However, this paper seeks to upend that question by applying it to the use of avatars, blackface and the bodily appropriation of others to interrogate the use of technology and intellectual property in maintaining the power of dominant, read white, culture.

Technology has brought us the ability not only to be connected 24/7, but also the ability to play video games, for example, at any moment of time and anywhere. Supposedly the ability to transport oneself into another world and transform oneself provides respite from an angst-ridden real

---

<sup>1</sup> Jimmy James, *Fashionista* (Made Records 2006).

<sup>2</sup> See generally Erin Mayer, *What She Meant to the Red Carpet*, BUSTLE (Sept. 4, 2014), <https://www.bustle.com/articles/38636-what-joan-rivers-meant-to-the-red-carpet-she-was-the-first-person-to-not> [<https://perma.cc/5LRM-MNUD>].

<sup>3</sup> This interaction between reporters and celebrities has been criticized as shallow, and there have been efforts to get reporters to ask other questions. See, e.g., Jennifer L. Schmidt, *Blurred Lines: Federal Trade Commission's Differential Responses to Online Advertising and Face to Face Marketing*, 19 J. HIGH TECH. L. 442 (2019).

world, but that is not necessarily true, particularly if the virtual world is like the real world. Unfortunately, it appears to be the case that the same unconscious racial (and misogynistic) tropes that are present in the real world rear their ugly heads in the virtual one.

The first part of the article will examine avatars in online gaming as well as viral memes and their relationship to that of the 19<sup>th</sup> central minstrel shows. The second part continues the theme of blackface and discusses how it has continued to permeate the culture in both the appropriation and commodification of others. The last sections briefly discuss the problems in determining the difference between cultural appropriation and appreciation, and the difficulties of eradicating the “racial imaginary.”<sup>4</sup>

## II. AVATARS<sup>5</sup>

*Avatars form one of the central points at which users intersect with a technological object and embody themselves, making the virtual environment and the variety of phenomenon it fosters real.*<sup>6</sup>

In an old *New Yorker* cartoon, which depicts two dogs “talking” to each other about the internet, one dog exclaims to the other that “on the internet, nobody knows

---

<sup>4</sup> See Patricia J. Williams, *Revisiting the Racial Imaginary (Again. . .)*, MADLAWPROFESSOR’S WEBLOG (Feb. 19, 2019, 6:20 PM), <https://madlawprofessor.wordpress.com/2019/02/21/revisiting-the-racial-imaginary-again/> [<https://perma.cc/M5PB-NCEZ>].

<sup>5</sup> LISA NAKAMURA, CYBERTYPES: RACE, ETHNICITY, AND IDENTITY ON THE INTERNET 31 (2002) (“Avatars are the embodiment, in text and/or graphic images, of a user’s online presence in social spaces.”).

<sup>6</sup> T.L. Taylor, *Living Digitally: Embodiment in Virtual Worlds*, in THE SOCIAL LIFE OF AVATARS: PRESENCE AND INTERACTION IN SHARED VIRTUAL ENVIRONMENTS 40, 41 (Ralph Schroeder ed., 2002).

that you're a dog."<sup>7</sup> This concept applies to humans as well. The internet and video gaming open up worlds of possibilities regarding one's persona. Imagine that someone black, short, and chubby with awesome glasses could transform herself on the web into the slightly taller, willowy Angela Bassett-type she always wanted to be. Or she could become a cat. . .<sup>8</sup>

Thus, the internet allows for the reinvention of self. *But whose self?* Certainly, one might think that racial representation in video games, for example, should not matter because it is, after all, only a game.<sup>9</sup> An early prevalent conception about the internet and its gaming community was that virtual worlds would be "post-racial,"<sup>10</sup>

---

<sup>7</sup> I was reminded of this cartoon when reading Lisa Nakamura's essay: Lisa Nakamura, *Race in/for Cyberspace: Identity Tourism and Racial Passing on the Internet*, 13 WORKS & DAYS 181 (1995), reprinted in MIT MEDIA LAB: SOCIABLE MEDIA GROUP, <https://smg.media.mit.edu/library/nakamura1995.html> [<https://perma.cc/SHN8-C6TA>]. For the etiology of the phrase and cartoon, see Glenn Fleishman, *Cartoon Captures Spirit of the Internet*, N.Y. TIMES, Dec. 14, 2000, at G8.

<sup>8</sup> See D. Fox Harrell & Chong-U Lim, *Reimagining the Avatar Dream: Modeling Social Identity in Digital Media*, COMMUNICATIONS OF THE ACM (July 2017), <https://cacm.acm.org/magazines/2017/7/218864-reimagining-the-avatar-dream/fulltext> [<https://perma.cc/5CZQ-52C2>] (quoting Neal Stephenson ("Your avatar can look any way you want it to, up to the limitations of your equipment. If you're ugly, you can make your avatar beautiful. If you've just gotten out of bed, your avatar can still be wearing beautiful clothes and professionally applied makeup. You can look like a gorilla or a dragon or . . ." (citation omitted))).

<sup>9</sup> See Dmitri Williams et al., *The Virtual Census: Representations of Gender, Race and Age in Video Games*, 18 NEW MEDIA & SOCIETY 815, 818–20 (2009) (enumerating the reasons why representation matters).

<sup>10</sup> Pauline Hope Cheong & Kishonna Gray, *Mediated Intercultural Dialectics: Identity Perceptions and Performances in Virtual Worlds*, 4 J. INT'L & INTERCULTURAL COMM'N 265, 266 (2011) [hereinafter *Mediated Dialectics*]; Jerry Kang, *Cyber-Race*, 113 HARV. L. REV. 1130, 1206 (2000) (arguing that "[b]y designing cyberspace appropriately, we may be able to alter American racial mechanics").

and utopian sites where “people choose their own abilities, gender, and skin tone instead of having them imposed by accidents of birth.”<sup>11</sup>

Yet that optimism about the internet and its virtual worlds has not yet come to fruition. There are many articles, both scientific and in the popular press,<sup>12</sup> about the systemic racism that is present and even prevalent in the video gaming world,<sup>13</sup> and on the internet, in general.<sup>14</sup> Part of the inability to have a color-blind internet or video games is because, in spite of best efforts, the development, coding and marketing are mostly under the aegis of white cis-gender men who replicate themselves at every level.<sup>15</sup> When there is no diversity in the room, the lack of representation leads

---

<sup>11</sup> David J. Gunkel & Ann Hetzel Gunkel, *Terra Nova 2.0 — The New World of MMORPGs*, 26 *CRITICAL STUD. MEDIA COMM’N* 104 (2009) (quoting Edward Castronova, *Virtual Worlds: A First-Hand Account of Market and Society on the Cyberian Frontier* (2001) (unpublished manuscript) <https://ssrn.com/abstract=294828> [<https://perma.cc/Z6RB-GNLD>]).

<sup>12</sup> See generally Jennifer C. Mueller et al., *Racism and Popular Culture: Representation, Resistance, and White Racial Fantasies*, in *HANDBOOKS OF SOCIOLOGY AND SOCIAL RESEARCH* 69 (Pinar Batur and Joe R. Feagin, eds., 2018).

<sup>13</sup> See generally Jordan E. Mazurek and Kishonna L. Gray, *Visualizing Blackness — Racializing Gaming: Social inequalities in virtual Gaming Communities*, in *ROUTLEDGE INTERNATIONAL HANDBOOK OF VISUAL CRIMINOLOGY* (Michelle Brown & Eamonn Carrabine, eds., 2017).

<sup>14</sup> See Kishonna L. Gray, *Power in the Visual: Examining Narratives of Controlling Black Bodies in Contemporary Gaming*, 81 *VELVET LIGHT TRAP* 62 (2018) (commenting on the representation of Black bodies in the media); Mueller et al., *supra* note 12, at 83 (noting that “race has been built into the Internet”); RUHA BENJAMIN, *RACE AFTER TECHNOLOGY* (2019) (arguing that emerging technology is based on the “New Jim Code” which amplifies racial discrimination).

<sup>15</sup> Elizabeth Hackney, *Eliminating Racism and the Diversity Gap in the Video Game Industry*, 51 *J. MARSHALL L. REV.* 863, 868–72 (2018) (discussing the demographics in the industry).

to what one scholar calls “the presence of absence.”<sup>16</sup> That is, the underrepresentation of minority characters “functions to reinforce whiteness . . . [and] the idea of the “Other,” where “people” (whites) interact with racial minorities who are driven by aspects of their collective ‘nature.’”<sup>17</sup>

Researchers have found that there are differences in social interactions between light and dark-skinned avatars.<sup>18</sup> This could be explained by realizing that “[m]uch more is at stake than just fun and games. Prejudice, bias, stereotyping, and stigma are built not only into many games, but other forms of identity representations in social networks, virtual worlds, and more. These have real-world effects on how we see ourselves and each other.”<sup>19</sup>

Take, for example, the described performative experience of law professor Jerry Kang, who chose for his avatar an African American “skin.”<sup>20</sup> He explains that he engaged in what he termed “cyber-passing,”<sup>21</sup> not only because it afforded him an opportunity to engage in a

---

<sup>16</sup> See David R. Dietrich, *Avatars of Whiteness: Racial Expression in Video Game Characters*, 83 SOCIO. INQUIRY 82, 84 (2013) [hereinafter *Avatars of Whiteness*].

<sup>17</sup> *Id.*

<sup>18</sup> *Id.* at 85 (discussing the research findings of Paul Eastwick and Wendi L. Gardner that racial animus against blacks was present despite the fact that the avatars were not “real”).

<sup>19</sup> See Elisabeth Soep, *Chimerical Avatars and Other Identity Experiments from Prof. Fox Harrell*, BOINGBOING (Apr. 19, 2010) <https://boingboing.net/2010/04/19/chimerical-avatars-a.html> [<https://perma.cc/8NZX-ZHF8>]; see also David Leonard, “Live in Your World, Play in Ours”: *Race, Video Games, and Consuming the Other*, 3 STUD. IN MEDIA & INFO. LITERACY EDUC. 1, 2 (2003) [hereinafter, *Live in Your World*] (“[R]ace matters in video games because many of them affirm the status quo”); *Avatars of Whiteness*, *supra* note 16, at 85 (“the impact of the racialized structuring of virtual worlds. . . should not be underestimated simply because it is not ‘real.’”).

<sup>20</sup> Kang, *supra* note 10, at 1133.

<sup>21</sup> *Id.* at 1179.

“transgressive challenge to American racial mechanics,”<sup>22</sup> but would also allow him the ability “to learn something about being a Black man in American society.”<sup>23</sup> Yet, at the same time, he acknowledged the pitfalls of his performance: that, among others, it risked being stereotypical due to his consumption of the tropes that are at work in the media, and that his “audience,” in not realizing that he is not black would “reinforce [Kang’s] own stereotypes about what Blackness means.”<sup>24</sup> In fact, using avatars that conform to common racial stereotypes can intensify prejudicial attitudes.<sup>25</sup>

This is a cautionary tale because, according to Professor T.L. Taylor,

Avatars are in large part the central artifacts through which [sic] people build not only social lives, but identities. They become access points in constructing affiliations, socializing, communicating, and working through various selves. They are the material out of which people embody and make themselves real. What they are and what they can be matters.<sup>26</sup>

Yet people of color may not be able to generate avatars that resemble themselves. In general, the player of color will end up “passing” for white because the “skins” and

---

<sup>22</sup> *Id.* at 1180.

<sup>23</sup> *Id.* at 1181.

<sup>24</sup> *Id.* at 1184.

<sup>25</sup> See Grace S. Yang et al., *Effects of Avatar Race in Violent Video Games on Racial Attitudes and Aggression*, 5 SOC. PSYCH. & PERSONALITY SCI. 698 (2014); Alan Neuhouser, *Study: Video Games May Reinforce Racist Stereotypes*, U.S. NEWS (Mar. 21, 2014), <https://www.usnews.com/news/articles/2014/03/20/video-games-may-reinforce-racist-stereotypes-study-finds> [https://perma.cc/YCU3-UPWX] (noting the effects the perceptions of race has on game developers and the belief the adherence to those perceptions have on the industry).

<sup>26</sup> Taylor, *supra* note 6, at 60.

features of the avatar are just darkened <sup>27</sup> — a virtual blackface, if you will.<sup>28</sup>

### III. BLACKFACE

*Consider the advantages of invisibility. You can do mischief—more than mischief, real harm—and avoid responsibility. If others cannot see you acting, they cannot identify you. . . . Disguise, thus, is invisibility on the cheap. One ceases to be recognizable and suspends personal responsibility without the difficulty and drawbacks of being incorporeal.*<sup>29</sup>

The beginnings of blackface are rooted in the 1800s when white actors blacked their faces to *(re)present* their take on African-American minority life.<sup>30</sup> According to historian Eric Lott, “[t]he minstrel show was, on the one hand, a socially approved context of institutional control; and, on the other, it continually acknowledged and absorbed black culture even while defending white America against it.”<sup>31</sup> Although one could argue that minstrelsy has, at least

---

<sup>27</sup> See *Avatars of Whiteness*, *supra* note 16, at 88–90 (reporting that a survey of games from 2000–2010 showed that in very few would there be a possibility to have a skin tone that was darker than tan). I will not even discuss the problems of generating hair color, hair styles or facial features.

<sup>28</sup> *Id.*

<sup>29</sup> THOMAS MORAWETZ, MAKING FACES PLAYING GOD: IDENTITY AND THE ART OF TRANSFORMATIONAL MAKEUP 117–18 (2001). Although not written about blackface, *per se*, but about masks and makeup in Hollywood, I believe that Professor Morawetz is correct that disguise and anonymity provide cover for actions one might not take if unmasked.

<sup>30</sup> See generally MICHAEL D. HARRIS, COLORED PICTURES: RACE AND VISUAL REPRESENTATION 51–56 (2003) (discussing the history of blackface minstrelsy in the United States).

<sup>31</sup> ERIC LOTT, LOVE AND THEFT: BLACKFACE MINSTRELSY AND THE AMERICAN WORKING CLASS 41 (1993).

in its 19<sup>th</sup>-century form, disappeared, the use of blackface has not diminished over time.<sup>32</sup>

Certainly, this has been borne out with the recent spate of elected officials shown in deeply disturbing photographs.<sup>33</sup> Also, as posited by the epigraph above, personal responsibility is abrogated. The excuses that one is or is not the person pictured,<sup>34</sup> or that it was done in fun,<sup>35</sup> ring hollow.

Politicians, though, are not the only bad actors.<sup>36</sup> Think of the various movies and television shows in the

---

<sup>32</sup> Actually, blackface never left. *See generally* Bim Adewunmi, *Blackface Hasn't Just Returned — It Never Left*, BUZZFEED NEWS (Feb. 15, 2019), <https://www.buzzfeednews.com/article/bimadewunmi/blackface-ralph-northam-gucci-black-history-month> [https://perma.cc/X7R6-BXS9]; Hafsa Quraishi, *Blackface Didn't End In The 1980s*, NPR (Feb. 13, 2019), <https://www.npr.org/2019/02/13/692517756/blackface-didnt-end-in-the-1980s> [https://perma.cc/FR3Y-DJMK].

<sup>33</sup> *See generally* Lauren Hard and Margaret Kramer, *When Blackface Photos Cause Political Storms*, N.Y. TIMES (Feb. 2, 2019), <https://www.nytimes.com/2019/02/02/us/politicians-blackface.html> [https://perma.cc/64RS-JZ7P].

<sup>34</sup> When confronted about a picture in his medical school yearbook, Virginia Governor Northam, in the space of 24 hours, admitted being the person in blackface and then denied any knowledge of that picture. He did, however, allow, that at some point he had donned black shoe polish. *See* Alan Blinder, *Was That Ralph Northam in Blackface? An Inquiry Ends Without Answers*, N.Y. TIMES (May 22, 2019), <https://www.nytimes.com/2019/05/22/us/ralph-northam-blackface-photo.html> [https://perma.cc/P2ZD-5VFU].

<sup>35</sup> Nichelle Smith, *Ralph Northam Was Far From Alone: Why Blackface Keeps Coming Up*, USA TODAY (Feb. 6, 2019), <https://www.usatoday.com/story/news/investigations/2019/02/06/blackface-first-ralph-northam-now-mark-herring-why-so-prevalent/2792247002/> [https://perma.cc/C6FG-MVFJ] (discussing Governor Northam, the history and persistence of blackface and the argument that those who participate in wearing blackface are “just having fun imitating black people, especially the celebrities they love”).

<sup>36</sup> The list of entertainers who have performed in blackface is staggering. *See List of Entertainers Who Performed in Blackface*, WIKIPEDIA (Feb.



recent past that employed blackface — *Bamboozled*, *30 Rock*, *The Office* and *Mad Men*, to name a few.<sup>37</sup> While it could be argued that the use of blackface in these shows was satirical or in the service of providing historical context or to provoke a discussion of racism,<sup>38</sup> it is still the case that its use highlights and exaggerates differences.<sup>39</sup>

Another striking example of blackface portrayal, also known as blackfishing<sup>40</sup> or reverse passing,<sup>41</sup> is provided in

---

18, 2021), [https://en.wikipedia.org/wiki/List\\_of\\_entertainers\\_who\\_performed\\_in\\_blackface](https://en.wikipedia.org/wiki/List_of_entertainers_who_performed_in_blackface) [<https://perma.cc/T3KD-7REH>].

<sup>37</sup> See Aisha Harris, *A Brief Guide to 21st-Century Blackface*, N.Y. TIMES (Sept. 25, 2020) [hereinafter *A Brief Guide*], <https://www.nytimes.com/interactive/2020/09/25/opinion/blackface-tv-movies-race.html> [<https://perma.cc/D6N2-J3NR>].

<sup>38</sup> *Id.*

<sup>39</sup> *Id.* While it is not within the scope of this paper to discuss the same denigrating uses of yellowface or redface, I want to acknowledge that these also are “the fruit of the same poisonous tree — namely, white supremacy.” See Erik Brady, *Redface, Like Blackface, Is a Sin of White Supremacy*, THE UNDEFEATED (Feb. 25, 2019), <https://theundefeated.com/features/redface-like-blackface-is-a-sin-of-white-supremacy/> [<https://perma.cc/V9GV-MWPV>].

<sup>40</sup> “Blackfishing” is the term used when “non-Black folks ‘fish’ for features that make them appear Black, mixed-race or racially ambiguous, like altering skin tone, hairstyle or facial and body modification that they profit from or are celebrated for when the culture they’re stealing from has been historically punished for those exact things.” Chelsea Candelario, *What Is Blackfishing? The Controversial Beauty Trend You \*Don’t\* Want to Get Behind*, PURE WOW (July 24, 2020), <https://www.purewow.com/wellness/what-is-blackfishing> [<https://perma.cc/ZB8G-Q997>]. It has also been termed the “new blackface.” See Amber Borden, *Blackfishing is the New Blackface*, THE TORCH (Dec. 5, 2018), <https://www.torchonline.com/opinion/2018/12/05/blackfishing-is-the-new-blackface/> [<https://perma.cc/GXW5-XLNX>].

<sup>41</sup> The term “reverse passing” was first coined and analyzed by Khaled A. Beydoun and Erika K. Wilson. See Khaled A. Beydoun and Erika K. Wilson, *Reverse Passing*, 64 UCLA L. REV. 282, 282 (2017) (in which the authors use the example of Rachel Dolezal to illustrate their examination of “reverse passing—the process in which whites conceal their true racial identity and present themselves as nonwhite”).

the person of Rachel Dolezal,<sup>42</sup> who, according to one commentator, used blackface to “experience blackness, avoid white responsibility, and co-opt blackness to authenticate herself and her work.”<sup>43</sup> Similarly, and more recently, Jessica Krug, a former professor at George Washington University, was forced to admit that for her entire professional career she had claimed to be a black Caribbean woman, when, in reality, she is white and Jewish.<sup>44</sup>

Their reasons for doing so are not entirely clear — Krug claimed that it stemmed from severe trauma in her early life,<sup>45</sup> while Dolezal has asserted multiple rationales, including growing up with adopted Black siblings.<sup>46</sup> However what is clear is that this is another exemplar of white privilege — that is, being able to appropriate features or a culture that is not one’s own, and then discard it when it no longer serves its purpose.<sup>47</sup>

---

<sup>42</sup> *Id.* at 284–88 (discussing Rachel Dolezal’s passage from “white” to “black”).

<sup>43</sup> Naomi W. Nishi, Cheryl E. Matias & Roberto Montoya, *Exposing the White Avatar: Projections, Justifications, and the Ever-Evolving American Racism*, 21 SOC. IDENTITIES 459, 459 (2015).

<sup>44</sup> See Jessica A Krug, *The Truth, and the Anti-Black Violence of My Lies*, MEDIUM (Sept. 3, 2020), <https://medium.com/@jessakrug> [<https://perma.cc/4K8J-953Z>].

<sup>45</sup> *Id.*

<sup>46</sup> See Jessica Krug: The Psychodrama of Appropriation, WORD OF MOUTH OPINION (Sept. 4, 2020), <https://wordofmouthopinion.wordpress.com/2020/09/04/jessica-krug-the-psychodrama-of-appropriation/> [<https://perma.cc/64GV-4Y27>].

<sup>47</sup> See Taylyn Washington-Harmon, *What Is Blackfishing and Why Would Anyone Do It?*, MSN (Aug. 17, 2020), <https://www.msn.com/en-us/health/wellness/what-is-blackfishing-and-why-would-anyone-do-it/ar-BB184pVO> [<https://perma.cc/3W8P-MQGD>] (discussing the rationales for “blackfishing” and its base in privilege); *What Is ‘Blackfishing’? How Some Influencers Can Insinuate They Are Black When They Aren’t*, INSIDE EDITION (Dec. 4, 2018), <https://www.insideedition.com/what-blackfishing-how-some->

### A. Digital Blackface

*Wearing a mask has long been part of the social internet. The web has operated like a Party City costume shop since dotcom-era chat rooms made cool the idea of inhabiting made-up identities and hiding behind usernames. These personas could be intensely liberating, allowing people to explore hidden ideas or sexualities, or simply enjoy a carnivalesque permissiveness to say or do something outrageous. It's all just a joke. For clout. For show.*

*But the mask of Blackness cannot be worn without consequences. It can't be worn as a joke without reaching into some deep cultural and historical ugliness, without opening a wound of abuse and humiliation.<sup>48</sup>*

Consider the internet trend known as “digital blackface.”<sup>49</sup> According to Professor Lauren Jackson, “[d]igital blackface uses the relative anonymity of online identity to embody blackness,”<sup>50</sup> and is an updated version of blackface.<sup>51</sup>

---

influencers-can-insinuate-they-are-black-when-they-arent-48928  
[<https://perma.cc/LKJ9-MR75>].

<sup>48</sup> Jason Parha, *TikTok and the Evolution of Digital Blackface*, WIRED (Aug. 4, 2020, 06:00 AM), <https://www.wired.com/story/tiktok-evolution-digital-blackface/> [<https://perma.cc/Q6BC-Z6PN>].

<sup>49</sup> The term “digital blackface” describes “the act of producing, posting or circulating ‘black reaction gifs’ online and especially on social media threads.” See Aaron Nyerges, *Explainer: What Is ‘Digital Blackface’?*, UNITED STATES STUDIES CENTRE (Aug. 23, 2018), <https://www.ussc.edu.au/analysis/what-is-digital-blackface> [<https://perma.cc/J7MQ-BR3C>].

<sup>50</sup> Lauren Michele Jackson, *We Need to Talk About Digital Blackface in Reaction GIFs*, TEEN VOGUE (Aug. 2, 2017), <https://www.teenvogue.com/story/digital-blackface-reaction-gifs> [<https://perma.cc/5V5N-F3UP>].

<sup>51</sup> See Shermarie Hyppolite, *Face It, Digital Blackface Is A Huge Issue on Tik Tok*, AFFINITY (Nov. 22, 2019),

As we all know, images and memes often go viral on the internet but those containing black people are more prone to circulate widely.<sup>52</sup> Professor Jackson noted that “black people and black images are thus relied upon to perform a huge amount of emotional labor online on behalf of nonblack users.”<sup>53</sup> As a result, she commented, “[w]e are your sass, your nonchalance, your fury, your delight, your annoyance, your happy dance, your diva, your shade, your ‘yass’ moments.”<sup>54</sup>

The problem with digital blackface is that it becomes just “another way Black bodies are consumed by non-Black people in a harmful and stereotype-forming manner.”<sup>55</sup> Many who write about digital blackface reflect on the harm that it does—that it “helps reinforce an insidious dehumanization of Black people by adding a visual component to the concept of the single story.”<sup>56</sup> According to the author Chimamanda Ngozi Adichie, “the single story creates stereotypes, and the problem with stereotypes is not that they are untrue, but that they are incomplete. They make

---

<http://culture.affinitymagazine.us/face-it-digital-blackface-is-a-huge-issue-on-tik-tok/> [<https://perma.cc/7Z3F-8DF7>].

<sup>52</sup> Amanda Hess & Shane O’Neill, *The White Internet’s Love Affair with Digital Blackface*, N.Y. TIMES (Dec. 22, 2017), <https://www.nytimes.com/video/arts/100000005615988/the-white-internets-love-affair-with-digital-blackface.html> [<https://perma.cc/DZ9Q-8C93>]

<sup>53</sup> Jackson, *supra* note 50.

<sup>54</sup> *Id.*

<sup>55</sup> See Naomi Day, *Reaction GIFs of Black People Are More Problematic Than You Think*, MEDIUM (Jan. 3, 2020), <https://onezero.medium.com/stop-sending-reaction-gifs-of-black-people-if-youre-not-black-b1b200244924> [<https://perma.cc/28UY-EKKX>].

<sup>56</sup> See *id.*; Madeline Howard, *What Is Digital Blackface? Experts Explain Why the Social Media Practice Is Problematic*, WOMEN’S HEALTH (July 20, 2020), <https://www.womenshealthmag.com/life/a33278412/digital-blackface/> [<https://perma.cc/79BA-F6FD>] (discussing the problems inherent in utilizing digital blackface).

one story become the only story.”<sup>57</sup> This certainly becomes true when the only experience of the “other” is through the lens of a gaze that “fixes” its subject, and “cut[s] sections of [that person’s] reality”<sup>58</sup>.

The manifestation of blackface on the internet is not solely found in its use as digital GIFs or as avatars in virtual worlds, but also in the performative aspects of digital gaming, which allows the player “to try on the other”<sup>59</sup> — just as one might put on clothing in a retail store.<sup>60</sup>

## **B. Video Games**

*Video games, like any form of media, tell stories.*<sup>61</sup>

---

<sup>57</sup> Chimamanda Ngozi Adichie, *The Danger of a Single Story*, TED (July, 2009), [https://www.ted.com/talks/chimamanda\\_ngozi\\_adichie\\_the\\_danger\\_of\\_a\\_single\\_story](https://www.ted.com/talks/chimamanda_ngozi_adichie_the_danger_of_a_single_story) [<https://perma.cc/53J4-8R8X>]; see Day, *supra* note 55 (discussing Chimamanda Ngozi Adichie’s TED talk on the single story); K. L. Gray, *Deviant Bodies, Stigmatized Identities, and Racist Acts: Examining the Experiences of African-American Gamers in Xbox Live*, 18 NEW REV. HYPERMEDIA & MULTIMEDIA 261, 263 (2012) [hereinafter *Deviant Bodies*] (noting “this narrow account is the only one visible situating them as the only possible narrative”).

<sup>58</sup> See generally Nishi et al., *supra* note 43, at 461 (citing FRANZ FANON, *BLACK SKIN, WHITE MASKS* 95 (Grove Press 2008)).

<sup>59</sup> David J. Leonard, *High Tech Blackface — Race, Sports Video Games and Becoming the Other*, 4 INTELLIGENT AGENT 1,1 (2004), [http://intelligentagent.com/archive/Vol4\\_No4\\_gaming\\_leonard.htm](http://intelligentagent.com/archive/Vol4_No4_gaming_leonard.htm) [<https://perma.cc/T5QB-3RE9>] (citing MICHAEL ROGIN, *BLACKFACE, WHITE NOISE: JEWISH IMMIGRANTS IN THE AMERICAN MELTING POT* 35 (1998)).

<sup>60</sup> Susana Morris, *Black Bodies at Play: An Essay*, PLAYTIME (Jan. 2018), <http://playtime.pem.org/?p=1523/> [<https://perma.cc/9CHZ-FDRK>].

<sup>61</sup> See M. C. R. Burgess et al., *Playing with Prejudice: The Prevalence and Consequences of Racial Stereotype in Video Games*, 14 MEDIA PSYCH. 289, 308 (2011).

What are the stories that video games tell?<sup>62</sup> If one looks at the genre of “urban” games, then one might decide that it is nothing more than a “pixelated minstrel show”.<sup>63</sup> A relevant example may be drawn from the video game *Grand Theft Auto* (GTA) — one of the most successful franchises in the video gaming industry.<sup>64</sup> Known for its fidelity in replication of fictional cities based on real locales,<sup>65</sup> it is the game’s verisimilitude of urban areas that entices players.<sup>66</sup> Yet its portrayal of urban life is “premised on notions of difference that, ultimately, reproduce rather than contest racial hierarchies.”<sup>67</sup>

Unfortunately, lack of representation in the rooms where decisions about the games are made also leads to gamers playing within the confines of stereotypical tropes attached to bodies of color; such as athletes, thugs or

---

<sup>62</sup> *Id.* (finding “the stories told about minorities in [video] games . . . are largely told by underrepresentation and overreliance on stereotypes”).

<sup>63</sup> Michel Marriot, *The Color of Mayhem in a Wave of Urban Gamer*, N.Y. TIMES, Aug. 12, 2004, at G1.

<sup>64</sup> Adam Ezomo, *Call of Duty, FIFA, Grand Theft Auto: What Game Made the Most Money in 2020?*, GIVEMESPORT (Jan. 7, 2021), <https://www.givemesport.com/1635768-call-of-duty-fifa-grand-theft-auto-what-game-made-the-most-money-in-2020>

[<https://perma.cc/657U-GYUW>] (Ezomo reported that Grand Theft Auto 5 came in third with earnings of \$911 million in 2020).

<sup>65</sup> See *E.S.S. Entm’t 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095 (9th Cir. 2008) (where plaintiff, the owner of a strip club, sued Rock Star Videos, the maker and distributor of GTA games, for trademark infringement claiming that GTA impermissibly used a trademark and trade dress similar to that of the strip club).

<sup>66</sup> See Anna Everett & S. Craig Watkins, *The Power of Play: The Portrayal and Performance of Race in Video Games*, in *THE ECOLOGY OF GAMES: CONNECTING YOUTH, GAMES, AND LEARNING* 141, 144–46 (Katie Salen ed., 2008) [hereinafter *Power of Play*] (arguing that the authenticity of the representation of urban life as depicted in games like GTA is an effective means of transmitting uncontested ideas about race and culture).

<sup>67</sup> *Id.* at 147.

prostitutes.<sup>68</sup> For example, the GTA series of games is frequently criticized for its stereotypical portrayals,<sup>69</sup> as well as its violence and misogyny.<sup>70</sup> The game invites the player to step into urban gangster culture, completing missions, generally of a criminal nature, as a means of advancing in the game.<sup>71</sup> As a result, the player has “the opportunity to interact with and *perform* fantasy-driven notions of black masculinity”;<sup>72</sup> that is, encounter or “be” the stereotypical black male who is either athletic or thuggish.<sup>73</sup>

Adam Clayton Powell III referred to such stereotyping as “high-tech blackface”,<sup>74</sup> observing that “[a]ny game has a certain stereotype, negative or positive, but a computer game is going to pass that message along

---

<sup>68</sup> See *Deviant Bodies*, *supra* note 57, at 262 (citing *Live in Your World*, *supra* note 19 (noting that researchers found that “80% of all African-American characters are depicted as athletic competitors in sports-oriented games and are much more likely to display aggressive behaviors such as trash talking and pushing than their white counterparts”)).

<sup>69</sup> Michael Klappenbach, *Grand Theft Auto Series Most Controversial Moments*, LIFEWIRE (Apr. 19, 2019), <https://www.lifewire.com/gta-series-most-controversial-moments-812433> [<https://perma.cc/KH44-M79T>].

<sup>70</sup> See Burgess et al., *supra* note 61, at 291 (where it is explained that the original GTA: Vice City, as explained by Reuters and CNN.com, urged players to “Kill the Haitians!” and also to “Kill the Cubans!” — this enraged representatives and activists from both of those communities). See also Dylan Dembrow, *15 Times Grand Theft Auto Games Went Way Too Far*, SCREENRANT (Mar. 22, 2018), <https://screenrant.com/grand-theft-auto-vide-game-controversies/> [<https://perma.cc/CGX6-K5QM>].

<sup>71</sup> Elizabeth Hackney, *Eliminating Racism and the Diversity Gap in the Video Game Industry*, 51 J. MARSHALL L. REV. 863, 882 (2018).

<sup>72</sup> *Power of Play*, *supra* note 66, at 149 (emphasis added).

<sup>73</sup> Nishi et al., *supra* note 43, at 467–68.

<sup>74</sup> The term “High tech Blackface” was coined by Adam Clayton Powell III to refer to stereotypical portrayals of black characters in video games. See Michel Marriott, *Blood, Gore, Sex and Now: Race*, N.Y. TIMES (Oct. 21, 1999), <https://www.nytimes.com/1999/10/21/technology/blood-gore-sex-and-now-race.html> [<https://perma.cc/9GG5-YT9A>].

pretty powerfully.”<sup>75</sup> In fact, studies have shown that “the depiction of racial representations within a video game may negatively impact individuals” who are playing the game.<sup>76</sup> Researchers posit that the “imagery that associates African-American men with the negative stereotypes of aggression, hostility, and criminality conditions viewers to associate this constellation of negativity with African-American men in general.”<sup>77</sup>

Again, this may be because “users don’t just consume images of race when they play video games. . . they perform them.”<sup>78</sup> However, in general, people of color do not have equal access to accurate self-representation, since many, if not most, characters that one can choose in a game are, by default, white.<sup>79</sup> As explained, quite starkly, by one commentator, “Black players don’t get to look like themselves in video games.”<sup>80</sup>

---

<sup>75</sup> *Id.*

<sup>76</sup> Vincent Cicchirillo & Osei Appiah, *The Impact of Racial Representations in Video Game Contexts: Identification with Gaming Characters*, 26 NEW MEDIA & MASS COMM’N 14, 16 (2014); *Mediated Dialectics*, *supra* note 10, at 268 (remarking that “imagery in virtual worlds reinforces certain cultural stereotypes which further deepens extant prejudices toward marginal and minority populations”).

<sup>77</sup> Burgess, *supra* note 61, at 292–93.

<sup>78</sup> Lisa Nakamura & Peter Chow-White, *Introduction— Race and Digital Technology: Code, the Color Line, and the Information Society*, in RACE AFTER THE INTERNET 8 (2011); Everett, *supra* note 66, at 148 (noting that urban/street gaming “establish dynamic environments for performing race and gender”).

<sup>79</sup> Cale J. Passmore, Max V. Birk & Regan L. Mandryk, *The Privilege of Immersion: Racial and Ethnic Experiences, Perceptions, and Beliefs in Digital Gaming*, CHI 2018: CHI CONFERENCE ON HUMAN FACTORS IN COMPUTING SYSTEMS (2018) [hereinafter *Privilege of Immersion*] (noting that “white avatars remain the ‘default’ option . . . players of color who wish to self-represent settl[e] for options that are ‘skin deep’” (citations omitted)).

<sup>80</sup> Xavier Harding, *Black Character Creator Options in Video Games Still Have a Long Way to Go*, MIC (May 4, 2017), <https://mic.com/articles/176085/black-character-creator-options-in->



In fact, a recent article found that the representation of racially and ethnically diverse characters in video games is worsening instead of improving.<sup>81</sup> Unsurprisingly, this mirrors the underrepresentation of people of color employed by game companies.<sup>82</sup> One possible reason that games are not populated with people of color acting in non-stereotypical ways is due to the industry's awareness that their games will still sell if, as one commentator noted, "the gameplay is good."<sup>83</sup>

### **C. *Commodification and Appropriation of the Other***

*The commodification of Otherness has been so successful because it is offered as a new delight, more intense, more satisfying than normal ways of doing and feeling. Within commodity culture, ethnicity becomes spice, seasoning that can liven up the dull dish that is mainstream white culture.*<sup>84</sup>

Who is this "other?" "The Other" is a way of distinguishing between "us" and them."<sup>85</sup> It is a construct,

---

video-games-still-have-a-long-way-to-go#.E02xL0GFg  
[<https://perma.cc/4MXD-5SCG>].

<sup>81</sup> *Privilege of Immersion*, *supra* note 79, at 383.

<sup>82</sup> *Id.*

<sup>83</sup> Evan Narcisse, *Come On, Video Games, Let's See Some Black People I'm Not Embarrassed By*, KOTAKU (Mar. 29, 2012, 5:00 PM), <http://kotaku.com/5897227/come-on-video-games-lets-see-some-black-people-im-not-embarrassed-by> [<https://perma.cc/M5Z5-3RDS>] ("They haven't had to worry about [pushing culture forward] at this point, because they're still going to sell a ton of games if the basic gameplay is good.").

<sup>84</sup> bell hooks, *BLACK LOOKS: RACE AND REPRESENTATION* 21 (1992).

<sup>85</sup> Stephen Harold Riggins, *The Rhetoric of Othering*, in *THE LANGUAGE AND POLITICS OF EXCLUSION: OTHERS IN DISCOURSE* 3–10 (Stephen Harold Riggins, ed., 1997) (describing the concept of "the other"); MICHAEL PICKERING, *STEREOTYPING: THE POLITICS OF*

much like its conjoined twin, the stereotype, used to fix in place those designated as “different.”<sup>86</sup> The stereotype “attempts to establish an attributed characteristic as natural and given in ways inseparable from the relations of power and domination through which it operates.”<sup>87</sup> Together, “[t]he stereotype of the other is used to control the ambivalent and to create boundaries.”<sup>88</sup> When one adds the concept of representation which, through signs and symbols, provides “ways of describing and . . . thinking about [social] groups and categories,”<sup>89</sup> one can begin to see how the commodification of the other is the next logical step in keeping the *status quo*. And what better way to do that than by employing trademark law?<sup>90</sup>

Trademarks, which have expressive and communicative functions,<sup>91</sup> are a perfect vehicle for the

---

REPRESENTATION 71–73 (2001) [hereinafter STEREOTYPING] (describing the concept of “the other”).

<sup>86</sup> STEREOTYPING, *supra* note 85, at 73.

<sup>87</sup> *Id.* at 5.

<sup>88</sup> *Id.* at 47 (quoting ELISABETH BRONFEN, *OVER HER DEAD BODY: DEATH, FEMININITY AND THE AESTHETIC* 182 (1992)).

<sup>89</sup> *Id.* at xiii.

<sup>90</sup> See *id.*; K.J. Greene, *Trademark Law and Racial Subordination: From Marketing of Stereotypes to Norms of Authorship*, 58 SYRACUSE L. REV. 431, 444 (2008) (noting that “[t]rademarks historically played a central role in perpetuating racial subordination . . .”); Anjali Vats, *Marking Disidentification: Race, Corporeality, and Resistance in Trademark Law*, 81 S. COMM’M.J. 237, 237 (2016) (arguing that “trademarks have shaped and continue to shape racial orders in significant ways. They are a visual means through which whiteness is centered, hierarchies of race are normalized, and racial identities circulate as hypervisible/unseen parts of the cultural landscape”).

<sup>91</sup> See generally Rita Heimes, *Trademarks, Identity, and Justice*, 11 J. MARSHALL REV. INTELL. PROP. L. 133, 137 (2011) (suggesting that “[trademarks] are symbols—if not drivers—of the age of consumption in which we live.”); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L. J. 1717 (1999); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397, 397–98 (1990);

commodification of the other. They are imbued with a symbolism that affects not only how the products are viewed,<sup>92</sup> but also affect the perceptions of and about the consumer who purchases the branded goods or services.<sup>93</sup> The usage of ethnicity to embody brand mascots and the use of degrading images on products helped to enforce and reinforce feelings of dominance — both moral and

---

Giulio Ernesto Yaquinto, Note, *The Social Significance of Modern Trademarks: Authorizing the Appropriation of Marks as Source Identifiers for Expressive Works*, 95 TEX. L. REV. 739, 744 (2017) (“People rely on them [trademarks] constantly, not only for commercial purposes when it comes to differentiating between goods, but also for communicative purposes when it is easier to convey an idea embodied in a trademark by simply invoking the mark.”); Katia Assaf, *Brand Fetishism*, 43 CONN. L. REV. 83, 89 (2010) (where author posits that “some trademarks serve as social tools of interpersonal communication, and at times are even used to satisfy spiritual needs of the consumers”); Malla Pollack, *Your Image is My Image: When Advertising Dedicates Trademarks to the Public Domain—With an Example from the Trademark Counterfeiting Act of 1984*, 14 CARDOZO L. REV. 1391, 1393 (1993) (“Trademarks may become communicative symbols standing for something besides the source or sponsorship of the product in whose service they originated.”).

<sup>92</sup> Steven Wilf, *Who Authors Trademarks?*, 17 CARDOZO ARTS & ENT. L. J. 1, 6 (1999) (noting that “a trademark is a creature of symbolic language”); Dustin Marlan, *Visual Metaphor and Trademark Distinctiveness*, 93 WASH. L. REV. 767, 789 (2018) (describing a trademark as “a symbol”).

<sup>93</sup> Two judges, separated by about 50 years, noted the psychological power of trademarks: Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 974 (1993) (noting that “our vision of the world and of ourselves is shaped by the words we use and by the images that fill our fantasies. The words and images of trade are an important part of this panorama.”) and Felix Frankfurter in his opinion, *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942) (where he pronounced, “*The protection of trade-marks is the law’s recognition of the psychological function of symbols. If it is true that we live by symbols, it is no less true that we purchase goods by them*” (emphasis added)).

intellectual — held by those in power.<sup>94</sup> By the same token, it also ensured that those depicted remained “the other.”<sup>95</sup>

I have argued elsewhere,<sup>96</sup> as have others, that trademarks provide a window on our society.<sup>97</sup> Take, for example, Aunt Jemima.<sup>98</sup> Derived from the minstrel show,

---

<sup>94</sup> See DAVID SPURR, *THE RHETORIC OF EMPIRE: COLONIAL DISCOURSE IN JOURNALISM, TRAVEL WRITING, AND IMPERIAL ADMINISTRATION* 110 (1993) (“The primary affirmation of colonial discourse is one which justifies the authority of those in control of the discourse through demonstrations of moral superiority.”).

<sup>95</sup> Rosemary J. Coombe, *Embodied Trademarks: Mimesis and Alterity on American Commercial Frontiers*, 11 *CULT. ANTHRO.* 202, 210 (1996) (noting “In their visual consumption of imagery and their bodily consumption of goods, Americans envisioned and incorporated the same signs of otherness that the national body politic was simultaneously surveilling. . .”); Deseriee A. Kennedy, *Marketing Goods, Marketing Images: The Impact of Advertising on Race*, 32 *ARIZ. ST. L. J.* 615, 652 (2000) (discussing theorists’ arguments that Black media stereotypes “perpetuate and legitimate a culture in which serious inequalities in class, race, and gender exist.” (citation omitted)).

<sup>96</sup> Willajeanne F. McLean, (Re)presentations of Race and Culture in Trademarks of the European Union and the United States, (unpublished manuscript) (on file with the author).

<sup>97</sup> See generally Sonia K. Katyal, *Trademark Intersectionality*, 57 *UCLA L. REV.* 1601, 1606 (2010) (noting that “[s]ince trademarks inhabit a multiplicity of meanings, they can operate as devices of owned property, and at other times, they can also operate as devices of expression and culture.”); Coombe, *supra* note 95, at 167 (discussing “the central role of trademarks in what we might call the visual culture of the nation”); MALTE HINRICHSEN, *RACIST TRADEMARKS: SLAVERY, ORIENT, COLONIALISM AND COMMODITY CULTURE* 102 (2013) (commenting that “the study of trademark stereotypes can shed light on historical conditions and contemporary realities of racial exclusion”).

<sup>98</sup> There are other examples just as problematic including, *inter alia*, “Uncle Ben,” who “personified” rice for decades and is depicted as happy and servile. See K.J. Greene, *Intellectual Property at the Intersection of Race and Gender: Lady Sings the Blues*, 16 *AM. U. J. GENDER. SOC. POL’Y & L.* 365, 375 (2008) (characterizing Uncle Ben as “comforting, non-threatening, de-sexualized, and there to serve whites”). Also, there is United Fruit Company’s use of race and gender (in the form of a racialized and sexualized banana and, later, woman) to define

Aunt Jemima had “her” beginning, in the late 1800’s during the Jim Crow era,<sup>99</sup> as a “white man” in drag and blackface.<sup>100</sup> The ads used to represent the product (and brand mascot) were steeped in the prevailing stereotypes of the day.<sup>101</sup> Despite successive updates of the image of AUNT JEMIMA, reflecting the changing culture,<sup>102</sup> it was not until the catalyzing events of the summer of 2020 that Quaker Oats decided to retire the logo and, eventually, the brand name.<sup>103</sup>

---

the features of its Chiquita Banana. See Maria Iqbal, *Bodies, Brands, and Bananas: Gender and Race in the Marketing of Chiquita Bananas*, 4 PRANDIUM J. HIST. STUD. 2 (2015), <http://jps.library.utoronto.ca/index.php/prandium/article/view/25691> [https://perma.cc/HE8Y-QHLV].

<sup>99</sup> The earliest live trademark on record for AUNT JEMIMA bears a registration date of 1906, with the first use of the mark claimed in 1889. The description of the mark reads as follows: “THE TRADE-MARK CONSISTS OF THE REPRESENTATION OF THE HEAD OF A NEGRESS AND THE WORDS ‘AUNT JEMIMA’ ASSOCIATED THEREWITH.” See AUNT JEMIMA, Registration No. 51,056.; See *infra* Figure 1 for the trademark registered in 1890.

<sup>100</sup> Malte Hinrichsen, *Racist Trademarks and the Persistence of Commodity Racism in Europe and the United States*, in DIVERSITY IN INTELL. PROP.: IDENTITIES, INTERESTS, AND INTERSECTIONS 130, 134–35 (Irene Calboli & Srividhya Ragavan eds., 2015).

<sup>101</sup> See *infra* Figure 2 for an example of the vernacular attributed to “Aunt Jemima.”

<sup>102</sup> For example, Aunt Jemima in 1990 traded in her headscarf for pearl earrings and a lace collar. The trademark prosecution history shows the attorney of record seeking to amend the depiction of Aunt Jemima, arguing that “the elimination of the *old-fashioned and unpopular* bandana and the addition of earrings” were “non-essential to the mark,” and left “*the wholesome, motherly face*” unchanged. See AUNT JEMIMA *supra* note 99 (Paper Correspondence Incoming of AUNT JEMIMA trademark file). Elsewhere, “Aunt Jemima” is described as a “working grandmother.” See M. M. MANRING, SLAVE IN A BOX: THE STRANGE CAREER OF AUNT JEMIMA 177 (Edward L. Ayers, ed. 1998).

<sup>103</sup> The murder of George Floyd created a groundswell of public outrage, prompting changes in the usages of racially insensitive and offensive marks. Quaker Oats announced that it would retire AUNT JEMIMA,

Unfortunately, there are already entrepreneurs who have submitted intent to use applications for food items using the very same trademarks, AUNT JEMIMA, ESKIMO PIE and UNCLE BEN’S- whose demise social activists were celebrating just a few short months ago.<sup>104</sup> The endurance and perpetuation of these stereotypes as brand signifiers and objects of commodification give salience to the observation by sociologist Howard Winant that “the quandary of race . . . stubbornly refuses to disappear.”<sup>105</sup> The same can be said of stereotypes<sup>106</sup> and blackface.

#### D. *Blackface as Fashion*

*Blackface is, in essence, a kind of fashion—one rooted in the dark, arrogant insecurity of white supremacy, one inspired by this country’s original sin—that keeps evolving year after year until each iteration is just a little bit different from the previous one. But they are all of a piece. Blackface isn’t a fad or a one-off. It’s a classic that’s embedded in the cultural vocabulary. Reimagined, modernized, stylized.*<sup>107</sup>

---

followed by other brands promising to review their marks. See generally Tiffany Hsu, *Aunt Jemima Brand to Change Name and Image Over ‘Racial Stereotype’*, N.Y. TIMES, (June 17, 2020), <https://www.nytimes.com/2020/06/17/business/media/aunt-jemima-racial-stereotype.html> [<https://perma.cc/RKM8-C59V>].

<sup>104</sup> See Beth Kowitt, *Inside the Cottage Industry Trying To Revive Aunt Jemima and Other Brands With Racist Roots*, FORTUNE, Dec. 8, 2020, <https://fortune.com/2020/12/08/aunt-jemima-uncle-bens-eskimo-pie-brands-racist-roots-revived-black-lives-matter-movement-trademarks> [<https://perma.cc/9VRX-PJNG>].

<sup>105</sup> Howard Winant, *The Dark Side of the Force: One Hundred Years of the Sociology of Race*, in *SOCIOLOGY IN AMERICA: A HISTORY* 535, 571 (Craig Calhoun, ed., 2007).

<sup>106</sup> STEREOTYPING, *supra* note 85, at pmb1. (noting that “[s]tereotyping is a problem that refuses to go away”).

<sup>107</sup> Robin Givhan, *Blackface is White Supremacy as Fashion—and It’s Always Been in Season*, WASHINGTON POST (Feb. 7, 2019), <https://www.washingtonpost.com/lifestyle/blackface-is-white->

## Who Are You Wearing? Avatars, Blackface and Commodification of the Other 479

*For better or worse, fashion is an extension of culture. Which means the ills of a culture will inevitably appear in its fashion.*<sup>108</sup>

The fashion industry has long been accused of cultural misappropriation and commodification.<sup>109</sup> However, the issue came to a head in 2019, when there were several fashion *faux pas*,<sup>110</sup> which resulted in scathing critiques of the fashion industry and the influencers who don the clothes and sometimes design them.<sup>111</sup> Particularly

---

supremacy-as-fashion--and-its-always-been-in-season/2019/02/07/fdb60c06-2b1e-11e9-b2fc-721718903bfc\_story.html?utm\_term=.f075fb919fa0 [https://perma.cc/EW79-82WW].

<sup>108</sup> Emilia Petrarca, *Is Fashion Finally Ready to Face Its Blackface Problem?*, THE CUT (Feb. 12, 2019), <https://www.thecut.com/2019/02/fashion-brands-blackface-problem.html> [https://perma.cc/R9R3-FZKM].

<sup>109</sup> See J. Janewa Osei-Tutu, *Cultural IP vs. Commercial IP*, 12 LANDSLIDE 18, 19 (2020); Brigitte Vézina, *Curbing Cultural Appropriation in the Fashion Industry with Intellectual Property*, 4 WIPO MAG. 9 (2019); Maeve McDermott, *Blackface and Beyond: Fashion Brands' Most Controversial Designs*, USA TODAY (Feb. 22, 2019), <https://www.usatoday.com/story/life/people/2019/02/22/blackface-gucci-prada-zara-burberry-fashion-most-controversial-designs/2926837002/> [https://perma.cc/KBD7-ZAY9] (discussing many fashion houses that used blackface imagery).

<sup>110</sup> This is an understatement.

<sup>111</sup> See Madeline Fry Schultz, Opinion, *A Solution for Fashion's Blackface Problem: Stop Designing Ugly Clothes*, WASHINGTON EXAMINER (Feb. 20, 2019), <https://www.washingtonexaminer.com/opinion/a-solution-for-fashions-blackface-problem-stop-designing-ugly-clothes> [https://perma.cc/64X6-EZ6B]; Crystal A. DeGregory, *From Blackface to Nooses in Fashion, Why Enough Is Enough*, FOOTWEAR NEWS (Feb. 25, 2019), <https://footwearnews.com/2019/influencers/power-players/blackface-nooses-fashion-black-history-month-crystal-degregory-1202748672> [https://perma.cc/U9RT-SRTB]; Kyle Hodge, *This Black History Month Shows Fashion Still Has a Race Problem*, HIGHSNOBIETY (Feb. 2019), <https://www.highsnobiety.com/p/fashion-race-issues/> [https://perma.cc/4YFD-8QMJ]; Patricia J. Williams, *White People Can't Quit Blackface*, THE NATION (Feb. 20,

galling were the incidents of racial insensitivity that occurred in February, a month celebrating the notable achievements of those Americans who are members of the African diaspora, known as either “Black History” or “African-American History” Month.<sup>112</sup>

For example, there was the Gucci brand balaclava sweater, which featured a cutout for the mouth and oversized red lips.<sup>113</sup> Although the fashion house claimed that it was “[i]nspired by vintage ski masks,”<sup>114</sup> many saw an inappropriate use of blackface.<sup>115</sup> Gucci apologized, removed the sweater, and vowed that it would “do better.”<sup>116</sup> These assertions of regret, understandably, rang hollow in the face of multiple other instances of fashion houses

---

2019), <https://www.thenation.com/article/archive/blackface-covington-gucci-virginia/> [<https://perma.cc/2LKW-EJNN>].

<sup>112</sup> For an introduction to the origins of Black History Month and its predecessor, Black History Week, see Lisa Vox, *The Origins of Black History Month*, THOUGHTCO (July 3, 2019), <https://www.thoughtco.com/origins-of-black-history-month-p2-45346> [<https://perma.cc/H6MR-ZY48>]; Julia Zorthian, *This Is How February Became Black History Month*, TIME (Jan. 29, 2016) <https://time.com/4197928/history-black-history-month/> [<https://perma.cc/R9T8-LPSM>].

<sup>113</sup> See Sarah Young, *Gucci Jumper ‘Resembling Blackface’ Removed From Sale After Angry Backlash*, THE INDEPENDENT (Feb. 9, 2019), <https://www.independent.co.uk/life-style/fashion/gucci-blackface-sweater-balaclava-apology-reaction-twitter-controversy-a8767101.html> [<https://perma.cc/XV8A-MXPG>]; *infra* Figure 3.

<sup>114</sup> *Id.*

<sup>115</sup> See Maeve McDermott, *Blackface Shoes and Holocaust T-Shirts: Fashion Brands’ Most Controversial Designs*, USA TODAY (Feb. 22, 2019), <https://www.usatoday.com/story/life/people/2019/02/22/blackface-gucci-prada-zara-burberry-fashion-most-controversial-designs/2926837002/> [<https://perma.cc/G758-9YVW>] (noting that for consumers the sweater design was “reminiscent of blackface”).

<sup>116</sup> See Allyson Chiu, *‘Haute Couture Blackface’: Gucci Apologizes and Pulls ‘Racist’ Sweater*, WASHINGTON POST (Feb. 7, 2019), <https://www.washingtonpost.com/nation/2019/02/07/haute-couture-blackface-gucci-apologizes-pulls-racist-sweater/> [<https://perma.cc/D7NL-8XQA>].



claiming “ignorance.”<sup>117</sup> However, after meetings with black fashion influencer and designer, Daniel Day—also known as Dapper Dan—Gucci pledged to begin a diversity training program, to be more intentional in diversity hiring at leadership levels, and to fund a multicultural design scholarship program.<sup>118</sup>

On the heels of the Gucci debacle, the KATY PERRY brand shoes made their debut.<sup>119</sup> The sandal ornamentation, designed to approximate facial features, included large “red lips.”<sup>120</sup> According to the pop singer, the shoes were “envisioned as a nod to modern art and surrealism.”<sup>121</sup> Unfortunately, the design, when placed on a black shoe, evoked blackface, and some critics of the shoes observed that the sandals would complement the Gucci

---

<sup>117</sup> See Kirsten Holtz Naim, *Why It’s Ridiculous for Gucci to Claim “Ignorance” in Its Blackface Designs*, SLATE (Feb. 18, 2019), <https://slate.com/human-interest/2019/02/gucci-blackface-controversy-racism-history-fashion.html> [<https://perma.cc/N5AU-3Z9R>].

<sup>118</sup> See Luisa Zargani, *Gucci Launches Initiatives to Foster Cultural Diversity and Awareness*, WWD (Feb. 15, 2019), <https://wwd.com/fashion-news/designer-luxury/gucci-launches-initiatives-to-foster-cultural-diversity-and-awareness-1203028610/> [<https://perma.cc/V97N-PRCU>].

<sup>119</sup> See Megan Cerullo, *Katy Perry Accused of Evoking “Blackface” Imagery in Shoe Design*, CBS NEWS (Feb. 12, 2019), <https://www.cbsnews.com/news/katy-perry-blackface-shoes-accused-of-evoking-racist-imagery/> [<https://perma.cc/4WQY-A8A6>]; see *infra* Figure 4.

<sup>120</sup> See generally Raquel Laneri, *Katy Perry’s Shoes Pulled After ‘Blackface’ Backlash*, NEW YORK POST (Feb. 11, 2019), <https://nypost.com/2019/02/11/katy-perrys-shoes-pulled-after-blackface-backlash/> [<https://perma.cc/ES83-FNVP>] (describing the shoes as “resembling minstrel makeup”).

<sup>121</sup> See generally Christina Caron, *Katy Perry Pulls Shoes Resembling Blackface: ‘Our Intention Was Never to Inflict Any Pain,’* N.Y. TIMES (Feb. 12, 2019), <https://www.nytimes.com/2019/02/12/style/katy-perry-blackface-shoes.html> [<https://perma.cc/H98D-BB6L>].

brand sweater.<sup>122</sup> In the face of withering backlash, Katy Perry apologized and pulled the shoes from the market.<sup>123</sup>

Both of these scenarios illustrate the concerns voiced by bell hooks when she wrote:

When race and ethnicity become commodified as resources for pleasure, the culture of specific groups, as well as the bodies of individuals, can be seen as constituting an alternative playground where members of dominating races, genders, sexual practices affirm their power-over in intimate relations with the Other.<sup>124</sup>

However, neither of these above examples of the use of blackface in fashion bring home the reality of this statement as does the ill-conceived creation of designer Peggy Noland.<sup>125</sup> Ms. Noland, in collaboration with another designer, Sally Thurer, photoshopped the face of Oprah on unidentified nude black female bodies of various sizes.<sup>126</sup>

---

<sup>122</sup> See Kelly Wynne, *Katy Perry Shoe Designs Accused of Blackface, Removed From Shelves*, NEWSWEEK (Feb. 11, 2019), <https://www.newsweek.com/katy-perry-shoe-designs-accused-blackface-removed-shelves-1326931> [<https://perma.cc/3UWU-3LCK>].

<sup>123</sup> Caron, *supra* note 121.

<sup>124</sup> bell hooks, *Eating the Other: Desire and Resistance*, in MEDIA AND CULTURAL STUDIES: KEYWORKS 308 (Meenakshi Gigi Durham & Douglas M. Kellner eds., 2d ed. 2012).

<sup>125</sup> Peggy Noland is an artist and a fashion designer. For more information about her and her various projects, see [peggynoland.com](http://peggynoland.com) [<https://perma.cc/95QV-99WL>].

<sup>126</sup> These “body types” are “skinny, average and obese.” Alicia Eler, *Dumb Racist Art Project: White Woman Sells Naked Oprah*, HYPERALLERGIC (Nov. 19, 2013), <https://hyperallergic.com/author/alicia-eler/> [<https://perma.cc/XNL7-RKAT>]. There is also a version with Oprah made up as a member of the band KISS, as a “nod to how ridiculous the fashion industry is at times.” See Veronica Wells, *WTF?! Designer Peggy Noland Crafts “Naked Oprah Dress”*, MADAMENOIR (Nov. 15, 2013), <https://madamenoire.com/323117/wtf-designer-peggy-noland-crafts-naked-oprah-dress/> [<https://perma.cc/4E2U-9Z9J>]. Although one can

Her rationale was that “one of Oprah’s most effective qualities is that *she’s a placeholder, she’s a stand-in for you* with her foibles and her failures — especially with her public weight issues.”<sup>127</sup>

Here, one can see the ultimate “alternative playground” at work—affirmed by Ms. Noland, who said that the use of Oprah was “kind of my own personal exploration and exploitation of [access to celebrities].”<sup>128</sup> One might ask why she did not choose Fergie, formally known as the Duchess of York, who also has had many public struggles with weight loss and weight gain.<sup>129</sup> This is not to say that such a depiction would be any less troubling,<sup>130</sup> but it is the *appropriation of the body of an African-American woman* which is so perturbing, given the nation’s complex racial history.<sup>131</sup>

Ms. Noland’s statements to the press about her motivations in crafting the dress and the “really meaningful philosophical layers” that it brought to feeling that “they’re

---

find pictures of the various sized dresses on the web, including one modeled by the designer, I chose *not* to include one for this article out of respect for Oprah and the unnamed and dehumanized “body doubles.”

<sup>127</sup> Kathleen Lee Joe, *Naked Oprah Dress Sparks Controversy*, STUFF (Nov. 19, 2013), <https://www.stuff.co.nz/life-style/fashion/9413336/Naked-Oprah-dress-sparks-controversy> [https://perma.cc/YXR5-NT2H] (emphasis added).

<sup>128</sup> See Wells, *supra* note 126.

<sup>129</sup> Fergie was once ridiculed for her weight and referred to in the popular press as the “Duchess of Pork.” See Miriam Habtesellasié, *Sarah Ferguson Weight Loss—How the Duchess of York Lost an Incredible Five Stone*, WOMAN & HOME (July 26, 2018), <https://www.womanandhome.com/us/life/royal-news/sarah-ferguson-weight-loss-292416/?region-switch=1611088892/> [https://perma.cc/J4VM-E3R3].

<sup>130</sup> Eler, *supra* note 126 (Making this point particularly clear. She wrote: “these dresses consider female bodies—specifically black ones—as objects that are commodified and ultimately meant for the garbage. It’s unacceptable for any woman’s body to be thought of this way, no matter who’s looking.”)

<sup>131</sup> See *id.*

[public figures] ours, too,”<sup>132</sup> sparked (mostly) thoughtful commentary about her commodification of Oprah.<sup>133</sup> One of the more insightful observations was found in Carolyn Edgar’s article in SALON.<sup>134</sup> The article lays bare the stark reality of what Peggy Noland and her collaborator did with their crass (mis)use of Oprah’s visage: “[i]n [their] rendering, Oprah is no longer a person with her own (carefully crafted) public image. She’s no longer a person whose humanity we have to recognize, let alone respect.”<sup>135</sup> At the time,<sup>136</sup> for Ms. Noland, the ultimate answer to the question “who are you wearing?” was “[y]ou’re wearing Oprah instead of a designer.”<sup>137</sup>

---

<sup>132</sup> See Wells, *supra* note 126.

<sup>133</sup> See Eler, *supra* note 126 (giving her commentary on “hipster racism” and the comments offered by readers); Wells, *supra* note 126 (discussing the attempt “to exploit ‘Oprah’s image’ and the unclothed black body for attention and economic gain”).

<sup>134</sup> See Carolyn Edgar, *Naked Screaming Oprah Dress Treats Black Women’s Bodies as Placeholders*, SALON (Nov. 15, 2013), [https://www.salon.com/2013/11/15/naked\\_screaming\\_oprah\\_dress\\_treats\\_black\\_womens\\_bodies\\_as\\_placeholders/](https://www.salon.com/2013/11/15/naked_screaming_oprah_dress_treats_black_womens_bodies_as_placeholders/) [<https://perma.cc/88KT-Y5SV>].

<sup>135</sup> *Id.*

<sup>136</sup> Ms. Noland now regrets the dress. In an interview with Emily Cox for The Pitch, undated, but posted on Noland’s website, Noland notes that “in 2013 when the Oprah dress was made and I received criticism for it, I was a long way from being able to see it was racist . . . .” She continued by saying, “I grossly assumed permission of Oprah because she was a public figure. I failed to see that by only seeing Oprah as a ‘public figure’ it erases her experience as a black woman and the history that comes with that . . . .” See Emily Cox, Questions by Emily Cox (The Pitch) <https://docs.google.com/document/d/10aeaYVfgY3sj5rhikAjNI3cp3PErOAaCPuy3QWkDwqo/edit> [<https://perma.cc/H6CC-R6ZD>].

<sup>137</sup> Wells, *supra* note 126.

#### IV. QUESTIONS PRESENTED

*Appropriation is a form of dubious representation . . .  
[t]he question is, who has the power and privilege to  
represent another culture?*<sup>138</sup>

The sixty-four-thousand-dollar question is who has the right to represent another culture? Who has the authority to use that culture or its features, defined broadly, for commercial gain? Unfortunately, the line between cultural *appreciation* and *appropriation* is thin—one whose delineations have caused much spilled ink.<sup>139</sup> As noted by Professor Patricia Williams, “[t]he politics of representation are never easy.”<sup>140</sup>

---

<sup>138</sup> Tonya Blazio-Licorish & Obi Anyanwu, *How Cultural Appropriation Became a Hot-button Issue for Fashion*, WWD (Nov. 3, 2020), <https://wwd.com/fashion-news/fashion-features/how-cultural-appropriation-became-a-hot-button-issue-for-fashion-1234579968/> [<https://perma.cc/6M9J-BCAN>] (quoting Dr. Serkan Delice).

<sup>139</sup> See generally SUSAN SCAFIDI, WHO OWNS CULTURE?: APPROPRIATION AND AUTHENTICITY IN AMERICAN LAW (2005); Kenneth Shelton, *Understanding Cultural Appreciation v. Cultural Appropriation* (Mar. 5, 2020), <https://kennethshelton.net/understanding-cultural-appreciation-v-cultural-appropriation> [<https://perma.cc/3AD3-W8NB>] (featuring a chart with questions to help one determine if the contemplated action is appropriation or appreciation); Nadra Kareem Nittle, *A Guide to Understanding and Avoiding Cultural Appropriation*, THOUGHTCO. (June 18, 2020), <https://www.thoughtco.com/cultural-appropriation-and-why-iits-wrong-2834561> [<https://perma.cc/6EMS-FG6T>]. But see Kwame Anthony Appiah, *Cultural Borrowing is Great; the Problem is Disrespect*, WALL ST. J. (Aug 30, 2018), <https://www.wsj.com/articles/cultural-borrowing-is-great-the-problem-is-disrespect-1535639194> [<https://perma.cc/W4KQ-WC7H>] (arguing that cultural appropriation is an idea that is “ripe for the wastebasket” but that the real offense is that of disrespect).

<sup>140</sup> Patricia J. Williams, ‘White Voice,’ Blackface, and the Ethics of Representation, THE NATION (Aug. 17, 2018), <https://www.thenation.com/article/archive/white-voice-blackface-and-the-ethics-of-representation/> [<https://perma.cc/5KHL-ZD42>].

Nevertheless, it is important to think through the ramifications of creating intellectual properties based on the cultures of others. When Kim Kardashian, whom one could label a serial cultural appropriation offender,<sup>141</sup> proposed use of the term “kimono” as a trademark for her brand of women’s shapewear garments, she created a firestorm.<sup>142</sup> Apparently, Kardashian did not realize that the “kimono has an active imaginative function in the lives and minds of modern Japanese; it does not simply represent the dead weight of a traditional culture.”<sup>143</sup> Her apology was the same as countless others who have been called out for

---

<sup>141</sup> There are multiple popular press stories about Kim Kardashian’s appropriated hairstyles, accessories, and dress. See e.g., Gibson Johns, *Kim Kardashian’s Latest Magazine Cover Sparks Claims of Cultural Appropriation: ‘You Are Better than This’*, AOL.COM (Dec. 19, 2019), <https://www.aol.com/article/entertainment/2019/12/19/kim-kardashians-latest-magazine-cover-sparks-claims-of-cultural-appropriation-you-are-better-than-this/23884447/> [<https://perma.cc/E2EL-D4VF>] (detailing numerous instances where Kardashian has been accused of cultural appropriation).

<sup>142</sup> See Joyce Boland-DeVito, *Fashion(ing) a Political Statement: A Review of the Legal & Social Issues that Arise from Banned Political Clothing and Other Controversial Fashion Items in Light of the U.S. Supreme Court’s Decision in Minnesota Voters Alliance v. Mansky*, 30 *FORDHAM INTELL. PROP. MEDIA & ENT. L. J.* 493 (2020) (discussing, *inter alia*, the Kim Kardashian West controversy); Vanessa Friedman, *Kim Kardashian West and the Kimono Controversy*, N.Y. TIMES (June 27, 2019), <https://www.nytimes.com/2019/06/27/fashion/kim-kardashian-west-kimono-cultural-appropriation.html> [<https://perma.cc/TD4Z-UVK4>]; Lauren Thomas, *Kim Kardashian Is Renaming Her ‘Kimono’ Company After Causing an Uproar*, CNBC (July 1, 2019), <https://www.cnbc.com/2019/07/01/kim-kardashian-is-renaming-her-kimono-company-after-causing-uproar.html> [<https://perma.cc/3FQ2-NCJT>].

<sup>143</sup> See Susan Scafidi, *Intellectual Property and Cultural Product*, 81 *B.U. L. Rev.* 793, 812 (2001) (quoting Anne Hollander) (citation omitted).

cultural appropriation and commodification: “I did so with the best intentions in mind.”<sup>144</sup>

While it is important to acknowledge that not all appropriations are exploitative, when those appropriations are, in fact, solely for the purposes of making money, “best intentions” do not, and will not, save the day. When “borrowing” cultural elements, per Professor Susan Scafidi, one should consider the three S’s: the source, significance, and similarity of the elements.<sup>145</sup> That is, if the element emanates from a source community that has been subjected to discrimination or oppression, think again. If the element has great significance, either spiritual or cultural, proceed with caution, and, finally, determine if the product is an exact copy as opposed to something that is inspired by the borrowed item.<sup>146</sup>

In an essay taken from his book, *The Lies That Bind: Rethinking Identity*, Professor Kwame Anthony Appiah takes a different approach to the issue.<sup>147</sup> He argues that one

---

<sup>144</sup> Christie D’Zurilla, *Kim Kardashian West Finally Caves on Kimono Brand After Cultural Appropriation Accusation*, L.A. TIMES (July 1, 2019), [https://www.latimes.com/entertainment/la-et-kim-kardashian-west-kimono-solutionwear-new-name-20190701-story.html#:~:text=%E2%80%9CWhen%20I%20announced%20the%20name%20of%20my%20shapewear,change%20the%20name.%20\(Laura%20Thompson%20/%20TNS\)](https://www.latimes.com/entertainment/la-et-kim-kardashian-west-kimono-solutionwear-new-name-20190701-story.html#:~:text=%E2%80%9CWhen%20I%20announced%20the%20name%20of%20my%20shapewear,change%20the%20name.%20(Laura%20Thompson%20/%20TNS)) [<https://perma.cc/L5V2-U2AA>].

<sup>145</sup> Jeena Sharma, *When Does Cultural Inspiration Become Appropriation in the Fashion World?*, SOUTH CHINA MORNING POST (Nov. 6, 2017), <https://www.scmp.com/magazines/style/fashion-beauty/article/2118609/when-does-cultural-inspiration-become-appropriation> [<https://perma.cc/D6SE-3MVH>] (quoting Scafidi: “To distinguish harmful misappropriation from positive inspiration, I use a rule of three Ss: source, significance and similarity.”).

<sup>146</sup> See Francesca Willow, *How To Have the Cultural Appropriation Conversation this Halloween*, ETHICAL UNICORN (Oct. 30, 2018), <https://ethicalunicorn.com/2018/10/30/how-to-have-the-cultural-appropriation-conversation-this-halloween/> [<https://perma.cc/X8DR-KQJ3>].

<sup>147</sup> Professor Appiah has described the idea of cultural appropriation as “ripe for the wastebasket.” See Kwame Anthony Appiah, *From Yoga to*

should be cautious when using the term “cultural appropriation” as an indictment because “all cultural practices and objects are mobile; they like to spread, and almost all are themselves creations of intermixture.”<sup>148</sup> Rather, the problem occurs when the borrowing is accompanied by disrespect. According to Professor Appiah, “the offense isn’t appropriation; it’s the insult entailed by trivializing something another group holds sacred.”<sup>149</sup> Unfortunately, most of the time the disrespect is “compounded by power inequities,”<sup>150</sup> because “[t]here is a long history of treating the bodies of peoples of color as objects of white possession . . . .”<sup>151</sup>

There are other questions as well that are raised by the practice of walking in another’s skin, just as fraught, that bear some consideration.<sup>152</sup> For example, might there be instances in which putting on blackface, in whatever form, is acceptable?

Frederick Douglass had an answer—a harsh one. He called the actors who performed in blackface “the filthy scum of white society, who have stolen from us a

---

*Rap, Cultural Borrowing is Great; the Problem is Disrespect*, THE WIRE (Sept. 4, 2018), <https://thewire.in/books/cultural-borrowing-kwame-anthony-appiahbook-extract-lies-that-bind> [<https://perma.cc/265Q-HZQC>]. Similarly, Minh-Ha T. Pham thinks that the uses of the terms “appropriation” and “appreciation” have reached the limit of their usefulness and suggests the term “racial plagiarism” instead. See Minh-Ha T. Pham, *Racial Plagiarism and Fashion*, 4 QED: A JOURNAL IN GLBTQ WORLDMAKING 67, 68–70 (2017).

<sup>148</sup> See KWAME ANTHONY APPIAH, *THE LIES THAT BIND: RETHINKING IDENTITY* 208 (2018).

<sup>149</sup> *Id.* at 210.

<sup>150</sup> *Id.* at 209.

<sup>151</sup> Robbie Fordyce et al., *Avatars: Addressing Racism and Racialized Address*, in *WOKE GAMING: DIGITAL CHALLENGES TO OPPRESSION AND SOCIAL INJUSTICE* 247 (Kishonna L. Gray & David J. Leonard, eds., 2020).

<sup>152</sup> I thank my colleague, Steven Wilf, for posing these questions and encouraging me to think more deeply about them.



complexion denied them by nature, *in which to make money*, and pander to the corrupt taste of their white fellow citizens.”<sup>153</sup> However, Mr. Douglass was talking about someone stepping into another’s skin in order to mock and demean the other’s perceived characteristics for filthy lucre. Might Douglass have felt differently about John Howard Griffin, an author and civil rights activist (and a white Southerner), who, with the help of medicine and a sunlamp, darkened his skin for six weeks so as to report on life below the Mason-Dixon line?<sup>154</sup> Yes, he made money—he wrote a book about his experiences—but, arguably, that was not his first intent. How would Mr. Douglass judge Professor Kang, whose forays into the virtual world represented by a black avatar were undertaken so that he could learn something about being black?<sup>155</sup> What would he think about Rachel Dolezal or Jessica Krug?<sup>156</sup> Further complicating matters, there is Spike Lee’s *Bamboozled*—a movie that scrutinized and problematized America’s love-hate-love affair with blackface.<sup>157</sup>

It is too facile an answer to assert that blackface has no place anywhere, anytime. If one were trying to analyze the use of blackface along a continuum of acceptability, one must take the context, intent, as well as the impact of the use into consideration. For example, the use of blackface in

---

<sup>153</sup> Lott, *supra* note 31, at 15 (emphasis added).

<sup>154</sup> See JOHN HOWARD GRIFFIN, *BLACK LIKE ME* (1961).

<sup>155</sup> See Kang, *supra* note 10, at 1131 (discussing Professor Kang’s experiences in cyberspace).

<sup>156</sup> See Beydoun, *supra* note 41, at 284–88 (discussing Dolezal and Krug).

<sup>157</sup> See David Dennis, Jr., ‘*Bamboozled*’ 20 Years Later: *We All Shortchanged Spike’s Classic Film*, MEDIUM (Jan. 8, 2020), <https://level.medium.com/bamboozled-20-years-later-we-all-short-changed-spikes-classic-film-6a2830d0bbc0> [<https://perma.cc/5WET-GMXX>]. For a nuanced take on the significance of the film and black performance, see ELIZABETH L. SANDERSON, *SPIKE LEE’S BAMBOOZLED AND BLACKFACE IN AMERICAN CULTURE* (2019).

minstrelsy, which Douglass castigated, was solely to denigrate and use the black body as a locus for fun. This is, unfortunately, no different now when donned for college parties or Hallowe'en. Such a cavalier and disrespectful attitude toward bodies of color surely places these usages in the “unacceptable and inappropriate at any time category.”

When analyzing the use of an avatar (Kang) or medical intervention (Griffin) in order to have an “unvarnished” experience of “being black” in possible hostile environments, the waters become a bit murky. Here the usage is bounded by the claim of academic curiosity—the ability to learn something about the condition of blackness. While Mr. Griffin merely wanted a better understanding of racism by experiencing it,<sup>158</sup> Professor Kang hoped that the transmutation (cyber-passing) approach would “disrupt the very notion of racial categories.”<sup>159</sup> At the same time, Professor Kang realized that in doing so there was the real possibility that racial stereotypes would be reinforced,<sup>160</sup> and that those engaging in cyber-passing would soon tire of it because maintaining multiple identities takes work.<sup>161</sup> However laudable the goals may be, those who engage in cyber-passing still have the luxury of dropping the racial veil whenever they tire of playing with blackness. In other words: “everybody wanna be black but don’t nobody wanna be black.”<sup>162</sup>

---

<sup>158</sup> Griffin realized that it would not be possible in the 1950s South to have a frank conversation about race, racism, and its corrosive effects. He wrote, “[h]ow else except by becoming a Negro could a white man hope to learn the truth . . . Neither really knew what went on with those of the other race. The Southern Negro will not tell the white man the truth . . . The only way . . . to bridge the gap between us was to become a Negro.” See GRIFFIN, *supra* note 154, at 3.

<sup>159</sup> Kang, *supra* note 10, at 1136.

<sup>160</sup> *Id.* at 1184.

<sup>161</sup> *Id.* at 1183.

<sup>162</sup> This is the politically correct version of a phrase attributed to Paul Mooney. See Michael P. Jeffries, *Rachel Dolezal a Lesson in How*

Then, in the murkiest of all waters, there are Rachel Dolezal and Jessica Krug who appropriated blackness and personally operated in black spaces. Part of the furor surrounding their outings seems to be about the apparent duplicity involved<sup>163</sup> and, for those close to them, feelings of being used.<sup>164</sup>

Most of the critiques of this “performative blackness” are based on the theory that Dolezal and Krug operated within a system of choice—that is, they could at any time forego their decision to take on the mantle of blackness.<sup>165</sup>

---

*Racism Works*, BOSTON GLOBE (June 13, 2015), <https://www.bostonglobe.com/opinion/2015/06/13/rachel-dolezal-story-lesson-how-racism-works/J8R27qgq2YfDRUuOVhpYGI/story.html>

[<https://perma.cc/T77C-Q44T>] (quoting Mooney in a discussion of Rachel Dolezal); ZamaMdoda, *Everybody Wanna Be Black, but Nobody Wanna Be Black*, AFROPUNK (Feb. 11, 2019), <https://afropunk.com/2019/02/everybody-wanna-be-black-but-nobody-wanna-be-black/> [<https://perma.cc/JU57-R5W8>] (discussing blackface and cultural appropriation).

<sup>163</sup> See Matthew Pratt Guterl, *Racial Fakery and the Next Postracial: Reconciliation in the Age of Dolezal*, in *RACIAL RECONCILIATION AND THE HEALING OF A NATION: BEYOND LAW AND RIGHTS* (2017) (discussing “racial fakery” and its wider implications).

<sup>164</sup> See generally, Claire Lampen, *There’s a New Rachel Dolezal*, NEW YORK MAGAZINE (Sept. 9, 2020), <https://www.thecut.com/2020/09/historian-jessica-krug-admits-to-posing-as-a-black-woman.html> (last visited Mar. 23, 2021) [<https://perma.cc/NP7M-GRER>] (discussing the pain of the George Washington community after Krug’s admission).

<sup>165</sup> See Errin Whack, *Choosing to Be Black Is the Epitome of White Privilege*, POLITICO MAGAZINE (June 17, 2015), <https://www.politico.com/magazine/story/2015/06/black-white-privilege-rachel-dolezal-119126/> [<https://perma.cc/B49J-HDBA>] (arguing that “[b]eing black is not a lifestyle or a choice”); Emily Cashour, *Rachel Dolezal And White Privilege*, MEDIUM (July 13, 2018), <https://emilycashour.medium.com/recently-i-decided-to-watch-the-documentary-the-rachel-divide-it-follows-rachel-dolezal-and-takes-2b5411ff2e7f> [<https://perma.cc/UC6G-U4Y6>] (arguing that “[p]eople of color do not have the privilege of deciding to be another race; the

Yet Dolezal, unlike Krug,<sup>166</sup> has persisted in her claims of black identity: she has legally changed her name to Nkechi Amare Diallo and has asserted that she is “transracial.”<sup>167</sup> Her refusal of “whiteness,”<sup>168</sup> and her “passing confounds our visually privileging cultural logic. It confuses the real with the artifice, and often even after a careful social excavation, it is hard to determine which is what.”<sup>169</sup> Here, the problem with the transgressive nature of Dolezal’s actions is not her intent, but the impact that it has. As observed by one commentator: “the image of Rachel Dolezal inverts the beliefs of racial indifference without tackling the racial inequality that exists. To claim that one can transition from race to race implies that we are all on a

---

appearance of their skin at birth defines how they will be received and treated by society.”). *But see* Marquis Bey, *Incorporeal Blackness: A Theorization in Two Parts—Rachel Dolezal and Your Face in Mine* 20 CR: THE NEW CENTENNIAL REVIEW 205, 207 (2020), [muse.jhu.edu/article/773420](https://muse.jhu.edu/article/773420) [<https://perma.cc/X47P-JNKB>]. While not arguing in support of Dolezal’s transracial claims, Bey suggests that Dolezal “highlights how we might reassess our intellectual and sociopolitical understandings of subjectivity, of ontology, of what is possible for us to be in the world.”

<sup>166</sup> See Krug, *supra* note 46.

<sup>167</sup> See Denene Miller, *Why Rachel Dolezal Can Never Be Black*, NPR (Mar. 3, 2017), <https://www.npr.org/sections/codeswitch/2017/03/03/518184030/why-rachel-dolezal-can-never-be-black>.

[<https://perma.cc/UN6J-HJMP>]. The questions that swirl around how blackness is defined and the concept of transracialism are fraught. See Beydoun & Wilson, *supra* note 41, at 285 (discussing the definition of transracialism before and after Dolezal); Alisha Gaines, *Epilogue: The Last Soul Sister*, in *BLACK FOR A DAY: WHITE FANTASIES OF RACE AND EMPATHY* 171 (2017) [hereinafter *Epilogue*] (discussing why Dolezal’s theory of being “transracial” is invalid).

<sup>168</sup> See *Epilogue*, *supra* note 167, at 169 (commenting that “Dolezal’s self-definition of blackness is the epitome of white privilege.”); *but see* Bey, *supra* note 165, at 216 (arguing that instead of appropriating blackness, Dolezal “might be wishing to *reject whiteness*”).

<sup>169</sup> Bey, *supra* note 165 (quoting C. Riley Snorton, “*A New Hope*”: *The Psychic Life of Passing* (citation omitted)).

level playing field . . .”<sup>170</sup> Unfortunately, the playing field is not (yet) level, thus the ability for a Dolezal or a Krug to lay a false claim to blackness is but another glaring example of white privilege.<sup>171</sup>

In addition, these appropriative actions come with negative effects that allyship does not pose: the possible reallocation of precious resources that are meant for members of an underserved population.<sup>172</sup> For example, Krug obtained financial support for her academic work that was reserved for those who are people of color or first-generation students.<sup>173</sup> The concern is that “white people who can perform a nonwhite identity . . . will merely reify

---

<sup>170</sup> Sarah Samira El-Taki, *White Skin, Black Masks: Rachel Dolezal, Cultural Appropriation and the Myth of Trans-Racialism*, (June 2, 2017) (thesis, Lund University) [https://www.academia.edu/36858654/White\\_Skin\\_Black\\_Masks\\_Rachel\\_Dolezal\\_Cultural\\_Appropriation\\_and\\_the\\_Myth\\_of\\_Trans\\_Racialism](https://www.academia.edu/36858654/White_Skin_Black_Masks_Rachel_Dolezal_Cultural_Appropriation_and_the_Myth_of_Trans_Racialism) [<https://perma.cc/6SCF-66SY>]; Whack, *supra* note 165 (noting that, “[f]or Dolezal to be able to ‘opt in’ suggests that those of us who were born black can ‘opt out.’”).

<sup>171</sup> See *Epilogue*, *supra* note 167, at 169 (calling “Dolezal’s self-definition of blackness . . . the epitome of white privilege.”); Elwood Watson, *Rachel Dolezal and the Complex Politics of White Privilege*, HUFFPOST (June 17, 2015), [https://www.huffpost.com/entry/rachel-dolezal-and-white-privilege\\_b\\_7600366](https://www.huffpost.com/entry/rachel-dolezal-and-white-privilege_b_7600366) [<https://perma.cc/J93D-VZMS>].

<sup>172</sup> See Robyn Autry, *Jessica Krug, Rachel Dolezal and America’s White Women Who Want To Be Black*, THINK (Sept. 7, 2020), <https://www.nbcnews.com/think/opinion/jessica-krug-rachel-dolezal-america-s-white-women-who-want-ncna1239418> [<https://perma.cc/38HT-5EMW>] (noting that, “to masquerade as the oppressed is to seek out greater rewards beyond those of whiteness itself: more social media followers, more credibility, more access to spaces and initiatives reserved for people who have been historically marginalized, including college admissions . . .”).

<sup>173</sup> See M. Yvonne Taylor, *Jessica Krug Is Just Another Culture-Appropriating White Supremacist*, DAILY BEAST (Sept. 5, 2020, 12:41 AM), <https://www.thedailybeast.com/jessica-krug-is-just-another-culture-appropriating-white-supremacist> [<https://perma.cc/9AG4-VZBD>] (discussing Krug’s receipt of an academic scholarship reserved for people of color and first-generation students).

the existing racial order, and further bolster the privileges and power attendant with whiteness.”<sup>174</sup>

Dolezal’s actions thus raise the issues of power, identity and self-determination. Similar concerns are also implicated in trademark law. Trademark law affords mark owners a similar power over (brand) identity in that the law confers a right to enjoin others from actions that are likely to confuse, to dilute, or to tarnish the owned mark.<sup>175</sup> As Professor Martha Minow observed, “[t]he relative *power* enjoyed by some people compared with others *is partly manifested through the ability to name oneself and others*, and to influence the process of negotiation over questions of identity.”<sup>176</sup>

So, too in trademark law. At the heart of the trademark cases *Harjo*, *Blackhorse*, and *Tam* were the issues of self-identity and the right of self-expression.<sup>177</sup> For the plaintiffs *Harjo* and *Blackhorse*, the issue centered on their refusal to remain “othered”;<sup>178</sup> while for *Tam*, it was about the right to subvert and claim the slur, thereby reconstructing Asian American identity.<sup>179</sup> Part of the problem in

---

<sup>174</sup> See Beydoun & Wilson, *supra* note 41, at 352.

<sup>175</sup> See 15 U.S.C. § 1114 (allowing the owner of a federally registered mark to bring an action in infringement); 15 U.S.C. § 1125(a) (allowing an infringement action for an unregistered mark); 15 U.S.C. § 1125(c) (allowing an action for dilution or tarnishment).

<sup>176</sup> Martha Minow, *Identities*, 3 YALE J. L. & HUMAN. 97, 98–99 (1991) (citation omitted) (emphasis added).

<sup>177</sup> See *Pro-Football, Inc. v. Harjo*, 565 F. Supp. 3d 439 (D.C. Cir. 2019); *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D.V.A. 2015), *vacated*, 709 F. App’x 182 (4th Cir. 2018).

<sup>178</sup> See Suzan Shown Harjo, *Offensive Mascots Belong in Museums and History Books*, INDIANZ.COM (Dec. 15, 2017), <https://www.indianz.com/News/2017/12/15/suzan-shown-harjo-offensive-mascots-belo.asp> [<https://perma.cc/A7C8-WA67>] (discussing *Harjo* and *Blackhorse* and distinguishing them from *Matal*).

<sup>179</sup> See Richard Schur, *Authentic Black Cool? Branding and Trademarks in Contemporary African American Culture*, in ARE YOU ENTERTAINED?: BLACK POPULAR CULTURE IN THE TWENTY-FIRST CENTURY (Simone C.

determining which of these remedies should be preferred—cancellation of the mark or annulment of the law which would allow for the cancellation of the mark—lies in the work that trademarks are asked to perform. Trademarks, as posited by Professor Sonia Katyal, are “neither completely commercial nor completely expressive” and therefore are situated in the intersection of both.<sup>180</sup> These are two seemingly irreconcilable positions and present an interesting conundrum for how to view them in a legal sphere.

To oppose racialized trademarks, such as those held by the Washington Football team, was an uphill battle for the Native American plaintiffs bringing the case,<sup>181</sup> because, even had they wanted to engage in transgressive uses of the mark, the law “ensures that these identities cannot be tarnished or blurred and protects against fraudulent or deceptive uses of name or identities, even if the crafted corporate identities rely on questionable assumptions or

---

Drake & Dwan K. Henderson, eds., 2020) [hereinafter *Black Cool*]; Simon Tam, Opinion: *At Supreme Court, the Slants Are ‘Fighting for More Than a Band Name’*, NBC NEWS (Jan. 17, 2017), <http://www.nbcnews.com/news/asian-america/opinion-supreme-court-case-slants-are-fighting-more-band-name-n707831>

[<https://perma.cc/9NHT-9QXP>] (“It was startling and deeply frustrating to realize that despite trying to use language to help protect my community from stereotypes and racism, I was being denied the right to trademark my band’s name because of my race.”).

<sup>180</sup> Katyal, *supra* note 97, at 1641.

<sup>181</sup> The quest to cancel the Pro-Football-owned trademarks by Harjo *et al.* was long and multi-layered. Westlaw shows a history of seventy-five matters before the USPTO and federal courts. See *Harjo*, 565 F.3d 880 (determining that laches barred the case). Blackhorse picked up the mantle and filed to cancel the same registrations. See *Blackhorse*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014). This case was eventually vacated due to the U.S. Supreme Court case *Matal v. Tam*; see *infra* note 184. For a layperson’s history of the trademark battle, see Alicia Jessop, *Inside The Legal Fight To Change The Washington R\*\*\*\*\*s’ Name*, FORBES (Oct. 15, 2013), <https://www.forbes.com/sites/aliciajessop/2013/10/15/a-look-at-the-legal-fight-to-change-the-washington-redskins-name/?sh=386ed8494b20> [<https://perma.cc/GR3G-E9BG>].

stereotypes.”<sup>182</sup> The sole recourse that the plaintiffs possessed was that of an action for cancellation<sup>183</sup> on the grounds that the trademark was disparaging.<sup>184</sup>

Ultimately this, too, failed, because the United States Supreme Court sided with Simon Tam.<sup>185</sup> Tam, in a trademark case that also dealt with a racial slur, successfully argued that the disparagement clause was unconstitutional.<sup>186</sup> The rationale of the Court was that the clause “offends a bedrock First Amendment principle: Speech may not be banned on the ground that it expresses ideas that offend,”<sup>187</sup> thereby paving the way for racialized, stereotypical tropes, which may abound regardless of the offense given to those so depicted.

Professor Katyal’s elegant article calling for a nuanced approach to the now-defunct disparagement clause was written prior to the Supreme Court’s decision.<sup>188</sup> However, in the article she posited that one way to determine the appropriate response to the adoption of a mark for the purposes of self-expression and one that is commodified by a third party is to look at “whether the mark is operating in a

---

<sup>182</sup> Richard Schur, *Legal Fictions: Trademark Discourse and Race*, in *AFRICAN AMERICAN CULTURE AND LEGAL DISCOURSE* 204 (Loverly King & Richard Schur, eds., 2009).

<sup>183</sup> It should be noted that cancellation would not have prevented the Washington team from using the mark; it would have only prevented them from estopping others from using the mark in a multiplicity of ways.

<sup>184</sup> The disparagement clause, found in 15 U.S.C. § 1052(a), prohibited the registration of a trademark “which may disparage . . . persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute.” See 15 U.S.C. § 1052(a).

<sup>185</sup> The case effectively ended with the Supreme Court’s decision that §1052(a) of the Lanham Act, also referred to as Section 2(a), was unconstitutional. See *Matal v. Tam*, 137 S.Ct. 1744 (2017).

<sup>186</sup> *Id.* at 1751.

<sup>187</sup> *Id.*

<sup>188</sup> Compare Katyal, *supra* note 97, (written in 2010), with *Matal*, 137 S.Ct. 1744 (decided in 2017, seven years later).



commercial sphere or a political sphere, [which] also depend[s] on intent, audience and context.”<sup>189</sup> I suggest that this is an appropriate extralegal way for corporations to evaluate the possible use of an “intersectional trademark.”

Note that even the commodification of bodies for “good”; that is, to effectuate social change, can be an exercise full of land mines. In startling, even shocking, advertising,<sup>190</sup> Benetton tried promoting social change by using bodies of color clothed in its colorful fashion lines.<sup>191</sup> Unlike AUNT JEMIMA, which evoked nostalgia for “old times . . . not forgotten,”<sup>192</sup> Benetton used its trademark, UNITED COLORS OF BENETTON, “to transform the color palette of Benetton into the color of the skin . . .”<sup>193</sup> in order to promote discussions of race and other social concerns.<sup>194</sup>

Despite Benetton’s lofty goals, some of their ads were deemed so controversial that they drew opprobrium in the United States.<sup>195</sup> This is because Benetton advertising executives were not aware of the connotations Americans would draw when seeing, for example, an advertisement

---

<sup>189</sup> See Katyal, *supra* note 97, at 1693.

<sup>190</sup> Benetton intended to shock viewers with its advertising. According to its ad manager, “[Benetton] believe[s] our advertising needs to shock—otherwise people will not remember it.” See Kimberly Sugden, *Benetton Backlash: Does Controversy Sell Sweaters?*, 13 ADVERT. & SOC’Y REV. 1, 5 (2012) (internal quotations omitted).

<sup>191</sup> See Henry A. Giroux, *Benetton’s “World without Borders”: Buying Social Change*, <https://www.csus.edu/indiv/o/obriene/art7/readings/benetton.htm> [<https://perma.cc/B4PF-JUL8>] (“Linking the colors of Benetton clothes to the diverse ‘colors’ of their customers from all over the world, Toscani attempted to use the themes of racial harmony and world peace to register such differences within a wider unifying articulation.”).

<sup>192</sup> DANIEL DECATUR EMMETT, *I WISH I WAS IN DIXIE’S LAND* (Firth, Pond & Co. 1860).

<sup>193</sup> Sugden, *supra* note 190, at 3, 5.

<sup>194</sup> *Id.* at 4.

<sup>195</sup> See Judith Graham, *Benetton ‘colors’ the race issue*, *Advertising Age*, Sept. 11, 1989, at 3.

featuring a black woman nursing a white baby.<sup>196</sup> Perhaps if someone more culturally aware and sensitive at the helm in Benetton’s corporate hierarchy had thought about the optics and considered the audience and context in conjunction with the intended message, there would not have been such an outcry.<sup>197</sup>

This is a cautionary tale for all who would appropriate bodies to commodify products because “even when well-intentioned, the deployment of commoditised (sic) representations is not always harmless.”<sup>198</sup> Also “cultural meaning can easily shift from critical reappropriation to stereotype and back again.”<sup>199</sup>

Certainly, this is the case when considering the use of blackface in the entertainment sphere. For example, depictions of blackface within the movie and television industry, arguably sites of white privilege, also implicate the questions of context, intent and impact. If the use of blackface is merely gratuitous or for provocation, then it should be cut from the production. On the other hand, if it is being used as a critique or to provide an historical context, then perhaps the use should be considered fair. As noted by Aisha Harris, “[c]onsidering the use of blackface within its distinct narrative context — and not just as a referential snippet or meme — reveals that the mere presence of it does not necessarily mean something offensive is taking place.”<sup>200</sup>

---

<sup>196</sup> This ad for many “conjured up historical images of slavery and of black people being subservient.” See Kim Foltz, *Campaign on Harmony Backfires for Benetton*, N.Y. TIMES, Nov. 20, 1989, at D8.

<sup>197</sup> Sugden, *supra* note 190, at 6 (quoting the president and co-founder of Essence magazine who thought Benetton’s error lay in being “not aware...” (internal quotations omitted)).

<sup>198</sup> Stewart Muir, *The Good Of New Age Goods: Commodified Images of Aboriginality in New Age and Alternative Spiritualities*, 8 *Culture and Religion* 233, 247 (2007).

<sup>199</sup> *Black Cool*, *supra* note 179, at 187.

<sup>200</sup> *A Brief Guide*, *supra* note 37.

Yet, in the race to be viewed as culturally sensitive during the height of summer 2020, many in the industry removed evidence of the use of blackface in their movies, skits and television series.<sup>201</sup> The erasure of an ugly part of history does not mean it never happened, and there are valuable lessons that could be learned from looking at it head-on.<sup>202</sup> For example, Lionsgate Television, which distributes the period show *Mad Men*, decided not to remove a scene where one of the characters appears in blackface.<sup>203</sup> Instead, it decided to add a disclaimer explaining the prevalence of racism during the 1960s.<sup>204</sup> The disclaimer explained why they chose to take this step, noting that “the series producers are committed to exposing the injustices and inequities within our society that continue to this day so we can examine even the most painful parts of our history in order to reflect on who we are today and who we want to become.”<sup>205</sup>

---

<sup>201</sup> Andrew Tejada, *Eliminating Blackface Doesn't Start By Pretending It Didn't Happen*, TOR (Aug. 4, 2020), <https://www.tor.com/2020/08/04/eliminating-blackface-doesnt-start-by-pretending-it-didnt-happen/> [<https://perma.cc/UAY8-YAYH>] (discussing the various television and movie creators who did (not) remove blackface content from their shows).

<sup>202</sup> *Id.*; see also *A Brief Guide*, *supra* note 37 (noting that the erasure of blackface from various shows worked a disservice to those who want to understand the context of blackface in the particular show, what it represents and why it persists).

<sup>203</sup> Tejada, *supra* note 201; Denise Petski, ‘*Mad Men*’ Adds Disclaimer To Blackface Episode Ahead Of Streaming Launch, DEADLINE (July 1, 2020), <https://deadline.com/2020/07/mad-men-adds-disclaimer-blackface-episode-ahead-streaming-launch-1202975214/> [<https://perma.cc/X8SX-MQMQ>].

<sup>204</sup> Petski, *supra* note 203; Christopher Brito, ‘*Mad Men*’ won’t remove scene showing actor in blackface but will add a disclaimer, CBS NEWS (July 2, 2020), <https://www.cbsnews.com/news/mad-men-blackface-episode-john-slattery-content-warning/> [<https://perma.cc/8JH9-Z5BR>].

<sup>205</sup> Brito, *supra* note 204.

## V. CONCLUSIONS

*Being woke is not enough.*<sup>206</sup>

Here I have used avatars, blackface in some of its guises, and the misappropriation of the female body from Aunt Jemima to Oprah to show how technology and the law can be used to reify and calcify hurtful and damaging stereotypes. And yet, both can be powerful tools for changing the dynamic.

The video game industry is slowly awakening to the necessity of creating games and gaming spaces that are welcoming to all, regardless of race, gender, sexual orientation or creed. For example, there are anti-racist games that take on the challenge of providing players with the opportunity to experience different forms of discrimination.<sup>207</sup> There are social activist organizations that provide video game designers the ability to produce games that help promote social change.<sup>208</sup> These are some hopeful signs of change.

Furthermore, companies within the gaming industry have issued statements signaling a commitment to inclusion

---

<sup>206</sup> See Kishonna L. Gray & David J. Leonard, *Not a Post-Racism and Post-Misogyny Promised Land: Video Games as Instruments of (In)Justice*, in *WOKE GAMING: DIGITAL CHALLENGES TO OPPRESSION AND SOCIAL INJUSTICE* 3, 20 (Kishonna L. Gray & David J. Leonard eds., 2018) [hereinafter *Not Post-Racism*]; see also Meher George, *Why Being 'Woke' Is Not Enough*, *BERKELEY POL. REV.* (Apr. 18, 2019), <https://bpr.berkeley.edu/2019/04/18/why-being-woke-is-not-enough/> [<https://perma.cc/H84F-L69X>] (discussing the concept and etiology of the term “woke”, and how its ubiquity can engender a false sense of security).

<sup>207</sup> Fordyce et al., *supra* note 151, at 241–46 (describing an Australian anti-racist game, *Everyday Racism*).

<sup>208</sup> See, e.g., Taylor Anderson-Barkley and Kira Fogelson, *Activism in Video Games: A New Voice for Social Change*, in *WOKE GAMING: DIGITAL CHALLENGES TO OPPRESSION AND SOCIAL INJUSTICE* 252, 252 (Kishonna L. Gray & David J. Leonard eds., 2018).

and diversity.<sup>209</sup> Yet, words are cheap; merely having diversity as a goal is insufficient but should be a starting point to effectuate change.<sup>210</sup> At the end of the day, “[d]iversity is about variety, getting bodies with different genders and colors into the room. Equity is about how those bodies get in the door and what they are able to do in their posts.”<sup>211</sup>

The deployment of social media, such as the use of TWITTER, forced offending and offensive clothing lines to be removed, and trademarks to be changed.<sup>212</sup> A posting on Facebook led not only to Prada’s apologies, but also to the removal of its Sambo-like keychain.<sup>213</sup>

---

<sup>209</sup> See generally *Inclusion & Diversity*, ELECTRONIC ARTS, <https://www.ea.com/commitments/inclusion-and-diversity> [<https://perma.cc/DV7M-6GKA>] (Electronic Arts (EA)’s form of diversity statement).

<sup>210</sup> See *Not Post-Racism*, *supra* note 206, at 19 (arguing that “it is important to push conversations about gaming and gamers beyond diversity...”).

<sup>211</sup> David J. Leonard, *Virtual Anti-racism: Pleasure, Catharsis, and Hope in Mafia III and Watch Dogs 2*, 44 HUM. & SOC’Y 111, 118 (2020) (quoting Rinku Sen) (internal quotations and citation omitted).

<sup>212</sup> For example, #KimOhNo quickly began to trend after Kardashian announced her ill-conceived plan to market her shapewear bearing the mark KIMONO. After “listening” to her critics, Kardashian changed the brand name. See Maari Sugawara, #KimOhNo: Kim Kardashian’s Culturally Offensive ‘Kimono’ Shapewear, JAPAN IN CANADA.COM (July 13, 2019), <https://japanincanada.com/kimohno/> [<https://perma.cc/UPQ2-NQ2P>]; see also Carrie Goldberg, *Kim Kardashian West Announced the Relaunch of Her “Kimono” Line As “SKIMS”*, HARPER’S BAZAAR (Aug. 26, 2019), <https://www.harpersbazaar.com/celebrity/a28244665/kim-kardashian-kimono-new-name/> [<https://perma.cc/5HXS-WAG3>].

<sup>213</sup> See Teddy Grant, *Prada Apologizes Over Selling ‘Blackface’ Keychains*, EBONY (Dec. 14, 2018), <https://www.ebony.com/news/prada-apologizes-over-selling-blackface-keychains/> [<https://perma.cc/57LT-3HFF>].

In addition, the creative use of New York City’s Human Rights Law,<sup>214</sup> which is touted as “one of the broadest and most protective antidiscrimination laws in the country”,<sup>215</sup> and the decision of the New York City Commission on Human Rights (NYCCHR) to take on anti-black racism projects in the city,<sup>216</sup> caused an unprecedented settlement agreement between Prada and the NYCCHR.<sup>217</sup> Prada agreed to put staff and executives, including those in Italy, through racial equity training as well as to create scholarships and paid internships for underrepresented groups.<sup>218</sup>

On the other hand, it was social activists and their public outrage at racial injustices that forced the hands of CEOs of major food companies to end the “servitude” of their brand mascots, such as Aunt Jemima,<sup>219</sup> and the Washington Football team to end the use of its offensive team name.<sup>220</sup> Ironically, these changes occurred without

---

<sup>214</sup> N.Y.C. ADMIN. CODE § 8-107.

<sup>215</sup> See Gurjot Kaur and Dana Sussman, *Unlocking the Power and Possibility of Local Enforcement of Human and Civil Rights: Lessons Learned from the NYC Commission on Human Rights*, 51 COLUM. HUM. RTS. L. REV. 582, 598 (2020).

<sup>216</sup> *Id.* at 648, 654–55 (discussing the Commission’s anti-Black initiatives in general, and the *Prada* case, in particular).

<sup>217</sup> See Vanessa Friedman, *Miuccia Prada Will Be Getting Sensitivity Training*, N.Y. TIMES (Feb. 4, 2020), <https://www.nytimes.com/2020/02/04/style/Prada-racism-City-Commission-on-Human-Rights.html> [<https://perma.cc/YF42-WMPR>] (discussing the settlement agreement between the fashion house and New York City Commission on Human Rights).

<sup>218</sup> *Id.*

<sup>219</sup> Tiffany Hsu, *Aunt Jemima Brand to Change Name and Image Over ‘Racial Stereotype’*, N.Y. TIMES (June 17, 2020), <https://www.nytimes.com/2020/06/17/business/media/aunt-jemima-racial-stereotype.html> [<https://perma.cc/DPD8-VNFF>].

<sup>220</sup> See generally Max Burman, *Washington’s NFL team retires name long condemned as anti-Indigenous slur*, NBC NEWS (July 13, 2020), <https://www.nbcnews.com/news/sports/washington-s-nfl-team-retires->

the force of federal trademark law because the law which allowed for the cancellation of the marks, is now defunct.<sup>221</sup>

However, racism is deeply rooted and hard to deracinate. This begs the question: *Quis custodiet ipsos custodes?* Some would argue that in removing the legal guardrails that existed to prohibit disparaging trademarks, the duty to guard devolves to the consumers. In other words, the market will do its work and weed out speech and stances that are objectionable.<sup>222</sup>

Another argument is that because consumer activists are participants in corporate social responsibility, corporations will hew to the causes that their investors support.<sup>223</sup> As Noah Rothman noted: “Corporations and brands used to resist even vaguely political messaging . . . [n]ot anymore. Consumers across the political spectrum now specifically seek out brands associated with an explicit social or political ‘stance’.”<sup>224</sup> Unfortunately, the change in corporate behavior is not because effectuating equitable change is the right thing to do *per se*; rather, the motivation is that the bottom line is not affected and, in some instances, is actually improved.<sup>225</sup>

---

name-long-condemned-anti-indigenous-n1233624

[<https://perma.cc/Y8C6-3DY9>].

<sup>221</sup> See *Matal*, 137 S.Ct. at 1765.

<sup>222</sup> See Jake MacKay, *Racist Trademarks and Consumer Activism: How the Market Takes Care of Business*, 42 LAW & PSYCH. REV. 131, 141 (2018) (arguing that “[t]he well-informed consumer may not purchase a product if she is offended by the view it expresses . . .”).

<sup>223</sup> SARAH BANET-WEISER, *Branding Politics: Shopping for Change?*, in AUTHENTIC™: THE POLITICS OF AMBIVALENCE IN A BRAND CULTURE 125, 127 (2012).

<sup>224</sup> Noah Rothman, *Woke Brands and the Sorry Fad of Entry-Level Politics*, DAILY WIRE (Jan. 17, 2019), <https://www.dailywire.com/news/rothman-woke-brands-and-sorry-fad-entry-level-daily-wire> [<https://perma.cc/Z9RK-P2S6>].

<sup>225</sup> *Id.* (noting that Nike’s sales jumped by 10% in the wake of its campaign featuring Colin Kaepernick).

Just as being “woke” is insufficient, for consumers to think that “buying good is doing good” is also an inadequate response because “what counts, culturally and politically as good” depends on having a large enough consumer base (or megaphone) to make it worth the cultural shift for the corporation.<sup>226</sup> The change in momentum that occurred this summer was a unique moment, and companies scrambled to meet it.

What is needed for “the hill we climb,”<sup>227</sup> not only in the video gaming world, but also in fashion houses, and corporate board rooms, is “accuracy, collaboration, and information”.<sup>228</sup> Accuracy in representation is necessary to make sure that there is no single story;<sup>229</sup> while collaboration is required to insure buy-in from constituent groups. Finally, information about the source material is critical in order to obviate the excuse of ignorance. In turn, we, if we wish to be activist consumers, need to consider the source, the significance, and the context of the games we play, the trademarks we consume and the clothing we wear.

So, who are *you* wearing?

---

<sup>226</sup> BANET-WEISER, *supra* note 223, at 147.

<sup>227</sup> With apologies to Amanda Gorman: Jennifer Liu, *Read the full text of Amanda Gorman’s inaugural poem ‘The Hill We Climb’*, CNBC (Jan. 20, 2021), <https://www.cnb.com/2021/01/20/amanda-gormans-inaugural-poem-the-hill-we-climb-full-text.html> [<https://perma.cc/Q7GR-66TY>].

<sup>228</sup> Passmore et al., *supra* note 79, at 10 (noting that “accuracy, collaboration and information are paramount...[i]f digital gaming intends to represent humans then it must do so carefully, as it risks harmful negative representations.”). I would argue that any outward-facing entity should employ these same criteria.

<sup>229</sup> *Id.* at 3 (noting that “accuracy in representation is imperative”, because “[u]nawareness of these nuances and complexities leads to unintentional stereotypes (e.g., high-tech blackface) and miscommunications.”).



VI. APPENDIX

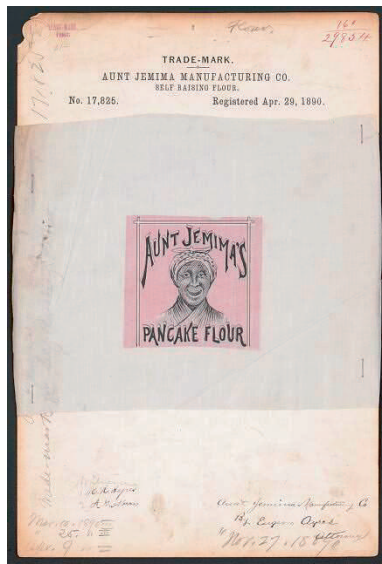


Figure 1: Early U.S. Trademark Registration for AUNT JEMIMA<sup>230</sup>



Figure 2: AUNT JEMIMA ad, circa 1940s, which exemplifies the pervasive stereotypes of the day<sup>231</sup>

<sup>230</sup> AUNT JEMIMA, *supra* note 99.

<sup>231</sup> African American Museum of Iowa, *Aunt Jemima "I'se in town, Honey!"*, YOUTUBE (Feb. 7, 2013), <https://blackiowa.org/collections-corner-aunt-jemima/> [<https://perma.cc/5Z3W-5KRN>].



Figure 3: Gucci balaclava sweater withdrawn from the market after social media protests<sup>232</sup>



Figure 4: Katy Perry “RUE” slip-on loafer, removed from the market one week after the Gucci sweater<sup>233</sup>

---

<sup>232</sup> Young, *supra* note 113.

<sup>233</sup> See Samantha Lyster, *Gucci Blackface Latest in History of Fashion Political Incorrectness*, BELLA VITA STYLE (Feb. 17, 2019), <http://www.bellavitastyle.com/gucci-blackface-latest-in-history-of-fashion-political-incorrectness/> [<https://perma.cc/5HCB-NGWF>].

# OPEN-ISH GOVERNMENT LAWS AND THE DISPARATE RACIAL IMPACT OF CRIMINAL JUSTICE TECHNOLOGIES

BEN WINTERS\*

## ABSTRACT

*Automated decision-making systems are used widely and opaquely in and around the U.S. criminal justice cycle. There are serious transparency and oversight concerns around the use of these tools in a system that severely disadvantages already marginalized communities. The Intellectual Property exemptions included in open government laws are one key aspect that prevents public understanding of important details of these tools. This paper attempts to explain the harm compounded by the use of these tools as well as the lack of access to meaningful information about them through government transparency mechanisms and analyze various harm-mitigation options.*

Abstract.....	507
I. Introduction.....	508
II. A Sampling of the Technology and the Particularly Racialized Harms .....	514
III. The Problems with These Tools and How They are Racially Exacerbated .....	520

---

\* Equal Justice Works Fellow, Electronic Privacy Information Center (EPIC). The fellowship and research supporting it are primarily funded by the Philip M. Stern Foundation through Equal Justice Works. The article reflects the current state of legal and risk assessment model developments at the time of publication.

A. Opacity .....	521
1. Opacity in fact.....	521
2. Opacity in law .....	525
B. Performance Issues – Accuracy and Bias .....	529
C. Process Issues.....	533
IV. Harm-Mitigation Approaches .....	535
A. Constrain trade secret protections within open government laws .....	535
B. Procurement policies and decisions .....	536
C. Targeted legislation about specific technologies	537
D. Assessments and audits: alternatives to blanket transparency of source code.....	540
E. The value and limits of transparency .....	542
V. Conclusion .....	543

## I. INTRODUCTION

On a given day, a single individual may interact with several automated decision-making systems<sup>1</sup> that individually and opaquely surveil, collect, store, and analyze data about them. For example, a person may be required to use facial recognition scanners to enter public housing or encounter algorithms that determine benefit eligibility.<sup>2</sup>

---

<sup>1</sup> *Automated Decision Systems: Examples of Government Use Cases*, AI NOW INST., <https://ainowinstitute.org/nycadschart.pdf> [<https://perma.cc/26GB-2EV3>] (defining “Automated Decision Systems” as “technical systems that aim to aid or replace human decision making”).

<sup>2</sup> See, e.g., Lola Fadulu, *Facial Recognition Technology in Public Housing. Prompts Backlash*, N.Y. TIMES, (Sept. 24, 2019), <https://www.nytimes.com/2019/09/24/us/politics/facial-recognition->

Predictive policing systems feed in past arrest data to help determine where police should use enforcement resources,<sup>3</sup> leading to added police presence in already over-policed neighborhoods.<sup>4</sup> Simultaneously, property surveillance systems like Ring doorbells on houses across many neighborhoods may be connected to the local police.<sup>5</sup> If a person is stopped by a police officer and arrested, that individual's information is entered into a process of risk assessment tools that informs determinations of bail and detention.<sup>6</sup> Those who have additional medical needs, apply for benefits, or have family and friends interacting with the

---

technology-housing.html [https://perma.cc/2ZMU-XXNF]; Colin Lecher, *What Happens When an Algorithm Cuts Your Health Care*, VERGE (Mar. 21, 2018), https://www.theverge.com/2018/3/21/17144260/healthcare-medicaid-algorithm-arkansas-cerebral-palsy [https://perma.cc/Y2AY-A768].

<sup>3</sup> Andrew G. Ferguson, *Policing Predictive Policing*, 94 WASH. U. L. REV. 1109, 1113 (2017).

<sup>4</sup> *Id.* at 1148.

<sup>5</sup> See Kim Lyons, *Amazon's Ring Now Reportedly Partners with More Than 2,000 US Police and Fire Departments*, VERGE (Jan. 31, 2021), https://www.theverge.com/2021/1/31/22258856/amazon-ring-partners-police-fire-security-privacy-cameras [https://perma.cc/ETF5-PUEB]; Drew Harwell, *Doorbell-Camera Firm Ring Has Partnered with 400 Police Forces, Extending Surveillance Concerns*, WASH. POST (Aug. 28, 2019), https://www.washingtonpost.com/technology/2019/08/28/doorbell-camera-firm-ring-has-partnered-with-police-forces-extending-surveillance-reach/ [https://perma.cc/ZG4Z-JZH6]; Jane Wakefield, *Ring Doorbells to Send Live Video to Mississippi Police*, BBC NEWS (Nov. 5, 2020), https://www.bbc.com/news/technology-54809228 [https://perma.cc/KGL9-A9XL].

<sup>6</sup> See generally *AI and Human Rights: Criminal Justice System*, ELEC. PRIV. INFO. CTR. (EPIC) [hereinafter *AI and Human Rights*], https://epic.org/ai/criminal-justice/#foia [https://perma.cc/3BSG-MQ7D] (showing various documents from public records requests on this page and what inputs go into various risk assessments at pre-trial and in parole processes).

criminal justice system, may also be labeled as riskier by a given actuarial tool.<sup>7</sup>

If applying for a job, a resume scanning algorithm might determine if someone's quality of education is deemed inadequate, or there may be an inaccurate data set and/or misguided values embedded into the system that identifies that they are unfit for a certain job. Another possibility in the job application process is that an algorithm has determined that an applicant does not have the right mood, facial expressions, or tone to match the culture of a job.<sup>8</sup> The automated decision-making around job applications critically connects to the risk assessment tools used pre-trial, at trial, and during parole which use details around a person's job status to make determinations about their risk level.<sup>9</sup> This piece will show that these tools are all connected

---

<sup>7</sup> *Level of Service Inventory – Revised*, IDAHO DEP'T CORR., <https://epic.org/EPIC-19-11-21-ID-FOIA-20191206-ID-lsi-paper-scoresheet-tips-and-hints.pdf> [<https://perma.cc/HY9W-YPGT>] (annotated by the Idaho Department of Corrections).

<sup>8</sup> *See In re HireVue*, ELEC. PRIV. INFO. CTR., <https://epic.org/privacy/ftc/hirevue/> [<https://perma.cc/QAU5-3527>]; Aarti Shahani, *Now Algorithms Are Deciding Whom to Hire, Based on Voice*, NPR (Mar. 23, 2015), <https://www.npr.org/sections/alltechconsidered/2015/03/23/394827451/now-algorithms-are-deciding-whom-to-hire-based-on-voice> [<https://perma.cc/2N3G-52YF>]; *see also* Fiona J McEvoy, *3 Reasons to Question the Use of Emotion-Tracking AI in Recruiting*, VENTUREBEAT (Mar. 12, 2018), <https://venturebeat.com/2018/03/12/3-reasons-to-question-the-use-of-emotion-tracking-ai-in-recruiting/> [<https://perma.cc/GC2W-6X9K>] (critiquing the use of AI in hiring).

<sup>9</sup> *See, e.g., Re: FOIA Request - 20-FOIA-00095*, PRETRIAL SERVS. AGENCY FOR D.C. OFF. PLAN., POL'Y & ANALYSIS (Feb. 21, 2020), at 6, <https://epic.org/EPIC-20-01-08-DC-FOIA-20200308-DCPSA-Factors-Change-2015-2019.pdf> [<https://perma.cc/GG6B-5M6U>] (showing employment status as part of pre-trial tool, which is also used as part of the trial); *Nevada Parole Risk Assessment*, NEV. PAROLE DEP'T, [http://parole.nv.gov/uploadedFiles/parolenvgov/content/Information/N\\_V\\_ParoleRiskAssessmentForm.pdf](http://parole.nv.gov/uploadedFiles/parolenvgov/content/Information/N_V_ParoleRiskAssessmentForm.pdf) [<https://perma.cc/3NU4-E3X9>] (showing employment history as part of parole risk determination).

and operating in the same criminal justice cycle, and that they almost all fail to be meaningfully transparent on several levels. There are various legal and factual levers that keep (1) the existence and use of the tools, and (2) key information such as the factors, the weights, the policies surrounding use and the developer hidden away from public view and public scrutiny.

Automated decision-making tools are being used significantly and opaquely in the U.S. Criminal Justice System.<sup>10</sup> Although the function of these tools vary, many encode series of judgments about the likelihood an individual will, for example, be arrested based on a series of defined factors.<sup>11</sup> Race, gender, socioeconomic status, and age, in addition to proxies of these factors, are often included as factors in these loaded predictions.<sup>12</sup> When advocates and community members aim to understand the full scope of where and how this technology is being used, they are often stifled in part by overbroad trade secret exemptions that are in open government laws invoked by the contractors that

---

<sup>10</sup> See *Liberty at Risk: Pre-Trial Risk Assessment Tools in the U.S.*, ELEC. PRIV. INFO. CTR., at 5–8 (Sept. 2020) [hereinafter *Liberty at Risk*], <https://epic.org/LibertyAtRiskReport.pdf> [<https://perma.cc/DN34-SLJQ>] (showing the status of the usage of pre-trial risk assessment tools in every state); *Overview*, PREDPOL, <https://www.predpol.com/about/> [<https://perma.cc/9239-A6NR>] (stating that “PredPol is currently being used to help protect one out of every 33 people in the United States.” This shows that one of the Predictive Policing tools covers many jurisdictions, while other tools in the market also exist); *Automatic License Plate Reader Documents: Interactive Map*, ACLU, <https://www.aclu.org/issues/privacy-technology/location-tracking/automatic-license-plate-reader-documents-interactive-map?redirect=maps/automatic-license-plate-reader-documents-interactive-map> [<https://perma.cc/NBE6-66UU>] (showing how widely automated license plate readers are used in the United States).

<sup>11</sup> See, e.g. *Level of Service Inventory – Revised*, *supra* note 7.

<sup>12</sup> Chelsea Barabas et al., *Interventions over Predictions: Reframing the Ethical Debate for Actual Risk Assessment*, 81 PROC. MACH. LEARNING RSCH. 1, 3 (2018).

made the system.<sup>13</sup> The limitations prevent seamless public understanding about the tools their government is adopting, and consequently limit advocacy around tools with accuracy, bias, or privacy concerns. Although the adoption and use of these tools requires significant reform, the time and cost of battling trade secret claims on open government requests to even understand *what* is being used by their police department or courts is a clear place to start reform that could result in improved transparency in this space.

These tools allow agencies to evade accountability and perpetuate, rather than confront, racial, ethnic, and socioeconomic bias. The developers of these tools conceal the inner workings of their programs and embrace trade

---

<sup>13</sup> See, e.g., Letter from Jeanean West, FOIA Officer, Office of General Counsel, to author (Feb. 11, 2020), <https://epic.org/PDN%20Response%20to%20FOIA%20Requester.pdf> [<https://perma.cc/PEV9-CH7H>] (notifying a FOIA requestor of the required redisclosure notification being provided to the trade secret holder); Letter from Andrea Barnes, Staff Attorney, Miss. Dep’t of Corrections, to author (Dec. 5, 2019), <https://epic.org/Winters.Ben.EPIC.Response.11.25.19.12.03.19.pdf> [<https://perma.cc/7UTF-G6G5>] (notifying requestor that a third-party has been put on notice due to trade secret concerns). See generally *Open Gov’t Guide*, REPS. COMM. FOR FREEDOM PRESS, <https://www.rcfp.org/open-government-guide> [<https://perma.cc/5R42-B3ZA>] (showing freedom of information laws in 50 states and includes the trade secret/commercial protections). The Reporters Committee for Freedom of the Press resource highlights several examples of trade secret protection. In Wisconsin, for example, “Trade secrets, as defined in the Uniform Trade Secrets Act, Wis. Stat. § 134.90(1)(c), may be closed” and, when it comes to contracts, proposals, and bids, they “are subject to the balancing test, but may be closed if competitive or bargaining reasons require.” *Id.* (citing WIS. STAT. §§ 19.36(5), 19.85(1)(e), and 19.35(1)(a)). In New Mexico, “[t]rade secrets are exempt from disclosure.” *Id.* (citing N.M. STAT. ANN § 14-2-1(F) (2019)). In Louisiana, “proprietary or trade secret information provided to public bodies by the developer, owner, or manufacturer of a code, pattern, formula, design, device, method or process in order to obtain approval for sale or use in the state is specifically exempted from the Public Records Act.” *Id.* (citing LA. STAT. ANN. § 44:3.2).



secret protections at trials against both individual defendants and in response to open government requests.<sup>14</sup> This opacity diminishes accountability, transparency, trust, and the exercise of a complete criminal defense, to the detriment of defendants. From what researchers have accessed, this policy of secrecy embraces, rather than confronts, the reasons these biases and their effects proliferate.<sup>15</sup>

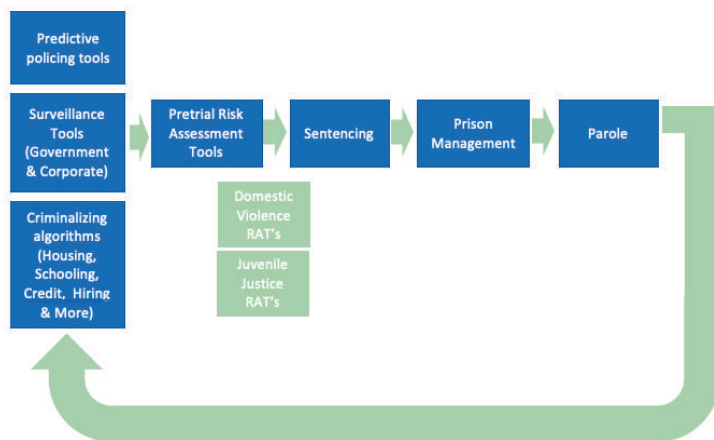
This article will: (1) illustrate the harms that this cycle of using automated decision-making tools in and around the criminal justice system causes and why the opacity exacerbates those harms specifically along racial lines; (2) explain the overbroad commercial intellectual property (IP) protections at both trial and in open government contexts; and (3) survey harm-mitigation strategies for increased opacity when technology implicates high-risk governmental functions.

---

<sup>14</sup> Rebecca Wexler, *Life, Liberty, and Trade Secrets: Intellectual Property in the Criminal Justice System*, 70 STAN. L. REV. 1343, 1343 (2018) (stating that “[d]evelopers often claim that details about how their tools work are trade secrets and refuse to disclose that information to criminal defendants or their attorneys.”); *id.* at 1366 (saying that “[i]n addition to facilitating law enforcement evasion of judicial scrutiny, trade secret claims may also motivate—or even compel—such evasion; companies may require law enforcement agencies to conceal the use of their products or engage in ‘parallel construction,’ in which police disguise the actual methods they use by describing alternative ones, in order to protect sensitive information from courtroom disclosure.”); *See also EPIC v. DOJ (Criminal Justice Algorithms)*, ELEC. PRIV. INFO. CTR., <https://epic.org/foia/doj/criminal-justice-algorithms/> [<https://perma.cc/5R5F-JH9C>] (showing a FOIA case fighting disclosure of report on the use of predictive analytical tools in the criminal justice system).

<sup>15</sup> *See Liberty at Risk*, *supra* note 10, at 1; *Mapping Pretrial Injustice: A Community-Driven Database*, MOVEMENT ALL. PROJECT, [hereinafter *Mapping Pretrial Injustice*], <https://pretrialrisk.com/> [<https://perma.cc/R57Q-63KL>]; *see generally* sources cited *infra* note 79.

## II. A SAMPLING OF THE TECHNOLOGY AND THE PARTICULARLY RACIALIZED HARMS



**Figure 1: An approximate cycle of the different algorithms and automated decision-making systems used in the criminal justice cycle**

There are near-endless streams of automated decision-making tools used in and around the U.S. criminal justice system that can be categorized by the different users of the technology. These can take the form of predictive algorithms, synthesized databases, or surveillance tools. Some technologies are used by government entities for criminal justice purposes, like police departments and corrections departments.<sup>16</sup> Other users are government entities outside the criminal justice context, like health departments, that use algorithms to support decision-making, resource allocation, and benefits.<sup>17</sup> Others are

<sup>16</sup> See *Liberty at Risk*, *supra* note 10, at 2–4.

<sup>17</sup> See DAVID FREEMAN ENGSTROM ET AL., GOVERNMENT BY ALGORITHM: ARTIFICIAL INTELLIGENCE IN FEDERAL ADMINISTRATIVE AGENCIES 10 (2020), <https://www-cdn.law.stanford.edu/wp-content/uploads/2020/02/ACUS-AI-Report.pdf> [<https://perma.cc/LCR8-FEVM>] (providing examples of algorithm use by United States administrative agencies); Lecher, *supra* note 2

corporations that deploy profiling products themselves such as Clearview AI, and some are corporations that sell surveillance products to consumers such as Ring Doorbell, while often networking these cameras and working with law enforcement.<sup>18</sup> This section will not chronicle every type of technology, as it is nearly impossible to do so partially due to minimal transparency requirements and frequent changes in adoption. Also, significant work mapping out racial harms of technologies around the criminal justice system has been done by scholars and journalists.<sup>19</sup> The next several paragraphs in this section will expand on Figure 1 above, which focuses on algorithmic tools and other technology used in and around the criminal justice system.

Predictive Policing is “any policing strategy or tactic that develops and uses information and advanced analysis to inform forward-thinking crime prevention.”<sup>20</sup> Predictive policing comes in two main forms: location-based and person-based.<sup>21</sup> Location-based predictive policing works by identifying places of repeated property crime in an

---

(discussing using an algorithm to set the required number of hours that a caretaker could visit patients).

<sup>18</sup> See Kashmir Hill, *The Secretive Company That Might End Privacy As We Know It*, N.Y. TIMES (Jan. 18, 2020), <https://www.nytimes.com/2020/01/18/technology/clearview-privacy-facial-recognition.html> [<https://perma.cc/C7V5-VQAJ>]; Rani Molla, *How Amazon’s Ring is Creating a Surveillance Network with Video Doorbells*, VOX (Jan. 28, 2020), <https://www.vox.com/2019/9/5/20849846/amazon-ring-explainer-video-doorbell-hacks> [<https://perma.cc/F85P-VVUR>].

<sup>19</sup> For a current piece focusing on the breadth of racially impactful technologies around policing, see Laura Moy, *A Taxonomy of Police Technology’s Racial Inequity Problems*, 2021 U. ILL. L. REV. 139.

<sup>20</sup> CRAIG D. UCHIDA, A NATIONAL DISCUSSION ON PREDICTIVE POLICING: DEFINING OUR TERMS AND MAPPING SUCCESSFUL IMPLEMENTATION STRATEGIES 1 (2009), <https://www.ojp.gov/pdffiles1/nij/grants/230404.pdf> [<https://perma.cc/AW8R-8T2X>].

<sup>21</sup> See Ferguson, *supra* note 3, at 1114.

attempt to predict *where* similar crimes will occur next.<sup>22</sup> Person-based predictive policing aims to pinpoint *who* might be committing a crime (i.e. trying to measure the risk that a given individual will be arrested for allegedly committing a crime.)<sup>23</sup> Both types of predictive policing are used in different jurisdictions and rely on past policing data as the main input for these predictions, creating a cycle of arresting resources.<sup>24</sup> The Bureau of Justice Assistance has and continues to give grants to police departments around the country to create and pilot these programs.<sup>25</sup> Simultaneously, two high profile jurisdictions recently stopped using predictive policing tools limited effectiveness and significant demonstrated bias, and some jurisdictions are banning the use of the technology.<sup>26</sup>

---

<sup>22</sup> See *id.* at 1127.

<sup>23</sup> See *id.* at 1137.

<sup>24</sup> *Id.* at 1149.

<sup>25</sup> U.S. DEP'T. JUST., PREDICTIVE ANALYTICS IN LAW ENFORCEMENT: A REPORT BY THE DEPARTMENT OF JUSTICE 4–5, Department of Justice (2014), <https://epic.org/foia/doj/criminal-justice-algorithms/EPIC-16-06-15-DOJ-FOIA-20200319-Settlement-Production-pt1.pdf> [<https://perma.cc/B39T-ZJXW>].

<sup>26</sup> Caroline Haskins, *The Los Angeles Police Department Says It is Dumping A Controversial Predictive Policing Tool*, BUZZFEED NEWS (Apr. 21, 2020), <https://www.buzzfeednews.com/article/carolinehaskins1/los-angeles-police-department-dumping-predpol-predictive> [<https://perma.cc/P9K2-FVU4>]; Jeremy Gerner & Annie Sweeney, *For Years Chicago Police Rated the Risk of Tens of Thousands Being Caught Up in Violence. That Controversial Effort Has Quietly Been Ended*, CHI. TRIBUNE (Jan. 24, 2020), <https://www.chicagotribune.com/news/criminal-justice/ct-chicago-police-strategic-subject-list-ended-20200125-spn4kjmrxrh4tmktdjckhtox4i-story.html> [<https://perma.cc/EMK3-KZYY>]; Kristi Sturgill, *Santa Cruz Becomes the First U.S. City to Ban Predictive Policing*, L.A. TIMES (June 26, 2020), <https://www.latimes.com/california/story/2020-06-26/santa-cruz-becomes-first-u-s-city-to-ban-predictive-policing> [<https://perma.cc/8QW4-UWDK>]; Ryan Johnston, *Oakland, Calif., Set to Ban Predictive Policing, Biometric Surveillance Tools*, STATESCOOP (Dec. 17, 2020), <https://statescoop.com/oakland-calif-set-to-ban->

Surveillance Tools encompass a large swath of technologies and functions that can be used to track and store information about a person. This ranges from Ring doorbells and Clearview AI, which partners with law enforcement, to facial recognition systems at the border and in U.S. cities.<sup>27</sup>

“Criminalizing algorithms” include algorithms used in housing, credit determinations, healthcare, hiring, and school choice.<sup>28</sup> Many of these have been shown to make recommendations and decisions that negatively affect marginalized communities, encode systemic racism, and improperly lead people through Criminal Justice system.<sup>29</sup> The results of these criminalizing algorithms and the data points collected in their use can lead to higher determinations of riskiness and greater interaction with the criminal justice system.

---

predictive-policing-biometric-surveillance-tools/  
[<https://perma.cc/EV3P-8TB9>].

<sup>27</sup> See generally Wakefield, *supra* note 5; Zach Whittaker, *Amazon’s Ring Neighbors App Exposed Users’ Precise Locations and Home Addresses*, TECHCRUNCH (Jan. 14, 2021, 10:00 AM), <https://techcrunch.com/2021/01/14/ring-neighbors-exposed-locations-addresses/> [<https://perma.cc/723J-VJSG>] (discussing how the Ring’s Neighbors app exposed the private location data of its users); Oscar Williams, *Clearview AI Facial Recognition Startup Partners with “600” Law Enforcement Agencies*, NEW STATESMEN (Jan. 20, 2020), <https://tech.newstatesman.com/security/clearview-ai-facial-recognition-startup> [<https://perma.cc/SSS4-FD8M>]; Abrar Al-Heeti, *US Border Protection Used Facial Recognition on 23 Million Travelers in 2020*, CNET (Feb. 11, 2021, 3:15 PM), <https://www.cnet.com/news/us-border-patrol-used-facial-recognition-on-23-million-travelers-in-2020/> [<https://perma.cc/TU2C-ZV5T>]; Shirin Ghaffary & Rani Molla, *Here’s Where the US Government is Using Facial Recognition Technology to Surveil Americans*, VOX (Dec. 10, 2019, 8:00 AM), <https://www.vox.com/recode/2019/7/18/20698307/facial-recognition-technology-us-government-fight-for-the-future> [<https://perma.cc/AD2W-NSXT>].

<sup>28</sup> *AI and Human Rights*, *supra* note 6.

<sup>29</sup> See generally sources cited *infra* note 79.

Risk Assessment Tools are used in almost every state in the U.S.—and many use them in a pre-trial setting, although they are also used at sentencing, in prison management, and for parole determinations.<sup>30</sup> There are also specific risk assessment tools used to assess risk for particular purposes such as in domestic violence or juvenile justice cases, with the understanding that they are designed to predict behavior more specific than general criminal risk or violent criminal risk of rearrest or re-offense.<sup>31</sup>

Pretrial Risk Assessment Tools are designed to attempt to predict future behavior by defendants and incarcerated persons and quantify the associated risk.<sup>32</sup> The tools vary, but make estimates using “actuarial assessments” like (1) “the likelihood that the defendant will re-offend before trial” (“recidivism risk”) and (2) “the likelihood the defendant will fail to appear at trial” (“FTA”).<sup>33</sup> These Pretrial Risk Assessment Tools use factors such as socioeconomic status, family background, neighborhood crime, employment status, as well as other considerations to reach a supposed prediction of an individual’s criminal risk and report the risk using a simplified metric.<sup>34</sup>

Significant empirical research has shown disparate impacts of risk assessment tools on criminal justice outcomes based on the race, ethnicity, and age of the

---

<sup>30</sup> *Liberty at Risk*, *supra* note 10, at 1, 5–8.

<sup>31</sup> Chris Baird et al., *A Comparison on Risk Assessment Instruments in Juvenile Justice*, NAT’L COUNCIL ON CRIME AND DELINQ. (Aug. 2013), [http://www.evidentchange.org/sites/default/files/publication\\_pdf/nccd\\_fire\\_report.pdf](http://www.evidentchange.org/sites/default/files/publication_pdf/nccd_fire_report.pdf) [<https://perma.cc/2SS8-49C9>]; *Ontario Domestic Assault Risk Assessment*, MENTAL HEALTH CTR. PENETANGUISHENE RSCH. DEP’T (last visited Apr. 9, 2021), <https://grcounseling.com/wp-content/uploads/2016/08/domestic-violence-risk-assessment.pdf> [<https://perma.cc/CP8N-XQZS>].

<sup>32</sup> *Liberty at Risk*, *supra* note 10, at 1.

<sup>33</sup> *Id.*

<sup>34</sup> *Id.* at 22–24.

accused.<sup>35</sup> The concerns with the use of these tools do not stop there.

Over the last several years, prominent groups such as Pretrial Justice Institute (PJI) strongly advocated for the broad introduction of these Pretrial Risk Assessment Tools.<sup>36</sup> However, in February 2020, PJI reversed their stance on this position, specifically stating that they “now see that pretrial risk assessment tools, designed to predict an individual’s appearance in court without a new arrest, can no longer be a part of our solution for building equitable pretrial justice systems.”<sup>37</sup> One week later, Public Safety Assessment, a widely used pretrial risk assessment tool, developed by the Laura and John Arnold Foundation, released a statement in which they clarified that “implementing a [risk] assessment alone cannot and will not result in the pretrial justice goals we seek to achieve.”<sup>38</sup>

The perils of these risk-calculation tools and their inter-relatedness is aptly described as part of “a cycle of injustice,” in a report by Our Data Bodies, the community-led technology resistance group led by Tawana Petty et al..<sup>39</sup>

[T]he collection, storage, sharing, and analysis of data as part of a looping cycle of injustice that results in diversion from shared public resources, surveillance of families and communities, and violations of basic

---

<sup>35</sup> See sources cited *infra* note 79.

<sup>36</sup> *Updated Position on Pretrial Risk Assessment Tools*, PRETRIAL JUST. INST. (Feb. 7, 2020), <https://www.pretrial.org/wp-content/uploads/Risk-Statement-PJI-2020.pdf> [<https://perma.cc/M45P-XWZX>].

<sup>37</sup> *Id.*

<sup>38</sup> Madeline Carter & Alison Shames, *APPR Statement on Pretrial Justice and Pretrial Assessment*, ADVANCING PRETRIAL POL’Y & RSCH. (Feb. 2020), <https://mailchi.mp/7f49d0c94263/our-statement-on-pretrial-justice?e=a01efafabd> [<https://perma.cc/Q7EP-ZNEN>].

<sup>39</sup> Tawana Petty et al., *Our Data Bodies: Reclaiming Our Data*, OUR DATA BODIES PROJECT, at 1 (June 15, 2018), [https://www.odbproject.org/wp-content/uploads/2016/12/ODB-InterimReport.FINAL\\_.7.16.2018.pdf](https://www.odbproject.org/wp-content/uploads/2016/12/ODB-InterimReport.FINAL_.7.16.2018.pdf) [<https://perma.cc/6W55-JJMC>].

human rights. Connected to the experience of power and powerlessness, the theme of “set-up” concerns [the ways in which] data collection and data-driven systems often purport to help but neglect and fail Angelinos. Interviewees described these set-ups as “traps” or moments in their lives of being forced or cornered into making decisions where human rights and needs are on a chopping board. When using social services to meet basic needs or expecting that a 9-1-1 call in an emergency will bring health and/or safety support into their homes or communities, our interviewees spoke about systems that confuse, stigmatize, divert, repel, or harm. These systems—or the data they require—give people the impression of helping, but they achieve the opposite. They ask or collect, but rarely give, and that leads to mistrust, disengagement, or avoidance. Furthermore, systems perpetuate violent cycles when they are designed to harm, criminalize, maintain forced engagement.<sup>40</sup>

### **III. THE PROBLEMS WITH THESE TOOLS AND HOW THEY ARE RACIALLY EXACERBATED**

This section will outline key issues with the suite of tools used throughout the criminal justice cycle. These issues include: opacity, accuracy, lack of clear purpose or evaluation metrics, validation studies, and bias. This is an inexhaustive list of issues with these tools, but outlines how these tools being used simultaneously harm people of color and socioeconomically disadvantaged people. This section samples the technologies used that carry different levels of risks, but this section is not comprehensive. Therefore, although the concerns that will be discussed herein resonate for most predictive technology used throughout the criminal justice cycle, one limitation of this paper will be that there is

---

<sup>40</sup> *Id.* at 20.



limited discussion of mapping specific concerns onto specific technologies.<sup>41</sup>

### **A. Opacity**

Different laws and norms govern the transparency around: (1) private companies using private software or other technological techniques; (2) public entities using publicly developed software or other technological techniques; and (3) public entities using privately contracted software or other technical tools.<sup>42</sup> Functionally, people are subject to tools from each of these categories that impact and can compound each other. There is both opacity in fact and opacity in law; while not mutually exclusive, it can be helpful to identify separate strands of the opacity problems.

#### **1. Opacity in fact**

Opacity in fact is multifaceted, but represents the dynamic in which people are unaware that a tool is being used on them. An individual might not know if a given camera leads to a database, if that database uses facial recognition software, and/or if that database is shared with the police or a company. A starker version of factual opacity is when there are invisible automated decision-making

---

<sup>41</sup> See generally Moy, *supra* note 19, for a more in depth exploration of concerns that arise out of the police's use of predictive technology.

<sup>42</sup> Regarding situation (1), there are no known laws limiting these tools. They are market-controlled. Regarding (2) and (3), see generally Hannah Bloch-Wehba, *Access to Algorithms*, 88 *FORDHAM L. REV.* 1265 (2020) (discussing the role of the Freedom of Information Act and the First Amendment in providing legal support for algorithmic transparency).

systems in applications such as credit scoring,<sup>43</sup> health determinations,<sup>44</sup> and within the criminal justice system.<sup>45</sup>

Without specific requirements for transparency on both private and public forms of automated decision-making, there is significant opacity in fact. Jurisdictions often fail to publish key information about the automated decision-making tools they use within the criminal justice cycle, leaving startling news stories of severe algorithmic harm to fill the gap in knowledge.<sup>46</sup> An example of where it is made obvious that a system is being used, while still not making meaningful disclosures about data collection use and error rates, as well as several other requirements that would be included in algorithmic impact assessments, is in airports that offer facial recognition for airplane boarding.<sup>47</sup>

In other locations, feeds from cameras in public places are later synthesized and analyzed using facial

---

<sup>43</sup> FRANK PASQUALE, *THE BLACK BOX SOCIETY: THE SECRET ALGORITHMS THAT CONTROL MONEY AND INFORMATION* 31 (2015); Danielle Keats Citron & Frank Pasquale, *The Scored Society: Due Process for Automated Predictions*, 89 WASH. U. L. REV. 1, 17 (2014).

<sup>44</sup> Rebecca Robbins & Erin Brodwin, *An Invisible Hand: Patients Aren't Being Told About the AI Systems Advising Their Care*, STAT (July 15, 2020), <https://www.statnews.com/2020/07/15/artificial-intelligence-patient-consent-hospitals/> [<https://perma.cc/92ST-9V9H>].

<sup>45</sup> See *Liberty at Risk*, *supra* note 10, at Executive Summary.

<sup>46</sup> See, e.g., Kashmir Hill, *Wrongfully Accused By an Algorithm*, N.Y. TIMES (June 24, 2020), <https://www.nytimes.com/2020/06/24/technology/facial-recognition-arrest.html> [<https://perma.cc/K7UL-UF5L>]; Julia Angwin et al., *Machine Bias: There's Software Used Across the Country to Predict Future Criminals. And It's Biased Against Blacks*, PROPUBLICA (May 23, 2016), <https://www.propublica.org/article/machine-bias-risk-assessments-in-criminal-sentencing> [<https://perma.cc/7P7E-5ZSL>].

<sup>47</sup> See Kathryn Steele, *Delta Expands Optional Facial Recognition Boarding to New Airports, More Customers*, DELTA AIR LINES (Dec. 8, 2019, 1:39 AM), <https://news.delta.com/delta-expands-optional-facial-recognition-boarding-new-airports-more-customers> [<https://perma.cc/V9G6-SZ4S>].

recognition systems or combined with other datasets.<sup>48</sup> In this situation, you do not know what picture is being captured of you, how that picture is being used, or how accurately it can be matched to a given person. One of the reasons that this can be problematic is borne out with one study that illustrates how misidentification can be dangerous and damaging along racial lines. Amazon’s Rekognition algorithm misidentified members of Congress as criminals when running their faces against a criminal database and did so disproportionately for black members.<sup>49</sup> Transparency, here, is not a panacea but a starting point for advocates and community members.<sup>50</sup> The bias of automated decision-making systems will be discussed at length in subsection B.

Another issue is the accuracy rate in risk assessments.<sup>51</sup> One risk assessment published through a

---

<sup>48</sup> Ayyan Zubair, *Domain Awareness System*, SURVEILLANCE TECH. OVERSIGHT PROJECT (Sep. 26, 2019), <https://www.stopspying.org/latest-news/2019/9/26/domain-awareness-system> [<https://perma.cc/9NWY-N8NL>].

<sup>49</sup> Jacob Snow, *Amazon’s Face Recognition Falsely Matched 28 Members of Congress with Mugshots*, ACLU (July 26, 2018, 8:00 AM), <https://www.aclu.org/blog/privacy-technology/surveillance-technologies/amazons-face-recognition-falsely-matched-28> [<https://perma.cc/4VPN-4Q3T>].

<sup>50</sup> See Ari Ezra Waldman, *Power, Process, and Automated Decision-Making*, 88 FORDHAM L. REV. 613, 617 (2019) (saying, “[i]ndeed, the very characteristics that make automated decision-making systems so attractive—predictive abilities, complexity, power, and independence—are also what make them so problematic for the rule of law and legal legitimacy. Proposals aimed at making algorithms accountable to the law are attempts to address these problems. And yet. . . the proposals are bandages that ignore the underlying incompatibility between algorithmic decision-making and a society based on normative values like equality and fairness.”).

<sup>51</sup> *Validation*, MAPPING PRETRIAL INJUSTICE, <https://pretrialrisk.com/the-basics/pretrial-risk-assessment-instruments-prai/validation/> [<https://perma.cc/5C65-9WNL>] (pointing out that “[a] common statistical way of measuring accuracy and predictive validity is through the ‘area under the curve,’ or AUC. The AUC score is supposed

public records request was a validation study for pre-trial risk assessment tools which identified that the desired threshold for statistical validity was that of a coin flip or better.<sup>52</sup> Even for these systems that are adopted and given a significant amount of credence without transparency disclosures, audits, impact assessments, or other requirements, even if everything is going according to “plan,” many will only accurately predict if someone gets rearrested around 55-65% of the time.<sup>53</sup> If the accuracy rates were more publicly available for specific tools in specific jurisdictions, public oversight might influence more thoughtful procurement.

---

to show how well the tool balances its correct and incorrect predictions—how often it correctly answers the question at hand (like how ‘risky’ someone is), and how often it gets the prediction wrong. The closer an AUC score is to 1, the more accurate a tool is said to be. **An AUC score of 0.5 is no better than chance in predicting risk:** a 50/50 shot. Some RATs have AUC scores as low as 0.55, barely more accurate than random chance or a coin toss. Several common tools have scores around 0.65, which is considered ‘good’ in criminology research but “poor” in other fields; a score of 0.65 means over one third of those judged by these tools are being mislabeled. And unlike many other fields, there is a lack of independent evaluation of these validation studies, which severely limits any claims that pretrial RATs are truly predictive. Sarah Desmarais and Evan Lowder point out that ‘demonstrating predictive validity does not equate with research demonstrating implementation success.’ Even if a tool is considered highly ‘accurate’ by these standards, it doesn’t mean that RATs are being implemented as intended or in a decarceral or racially unbiased way. The predictions they make are not always accurate, not always listened to even if accurate, and are applied inconsistently and in structurally racist ways.”)

<sup>52</sup> Email from Zachary K. Hamilton, Director, Washington State Institute for Criminal Justice, to Doug Koebernick, Nebraska Department of Correctional Services (July 14, 2016, 5:34 PM) [hereinafter Hamilton-Koebernick Email], <https://epic.org/EPIC-19-11-08-NEDCS-FOIA-20191112-D-Koebernick-Z-Hamilton-Email.pdf> [<https://perma.cc/RZ49-8KRR>].

<sup>53</sup> *Validation*, *supra* note 51.

In addition to the very real concerns about the details of the use and results of a given system, there are broader trust issues caused by a lack of proactive disclosure from law enforcement entities. The feeling of powerlessness could increase, especially among communities in which these technologies have been shown to have significant error disparities specifically on racial lines.<sup>54</sup>

Legal protections, such as trade secret exemptions in open government laws cover the automated decision-making tools adopted around the U.S. criminal justice system, creating significant legal barriers between citizens and the actions of their government. Minimizing these additional protections for contractors developing these systems may lead to more thoughtful adoption of tools and an increased quality of the systems that is reflective of the serious decisions they help make. In Part IV this article will explore some solutions that can be used by jurisdictions looking to hold contractors and themselves more accountable. One through-line for this and many other aspects of technology regulation, however, is that there needs to be curbing of economic incentives in the short term for the tradeoff of a higher-quality demand in the long term, prioritizing human rights and constitutional rights over adoption of new technologies.

## **2. Opacity in law**

Opacity in law starts with trade secrets and other commercial protection. This is borne out in both open government laws for the general public, and in court for specific defendants already subject to a given tool in a cognizable way.<sup>55</sup> After a significant fight in court, defendants can sometimes gain access to nonpublic

---

<sup>54</sup> See Petty et al., *supra* note 39, at 20; see also sources cited *infra* note 79.

<sup>55</sup> Wexler, *supra* note 14, at 1351. See generally Bloch-Wehba, *supra* note 42.

information about a Criminal Justice technology through a one-time agreement typically only giving access to the specific defendant via an often expansive protective order.<sup>56</sup> Agreements for protective orders are not guaranteed for defendants, but the practice functionally recognizes the need for access to details about the tools as part of adequate representation.

In addition to concerns of fairness and equity, Natalie Ram has illustrated both criminal due process and confrontation clause concerns associated with secrecy for criminal justice tools.<sup>57</sup> The limits in both scope of information shared and who it is shared with disadvantages the public in their oversight function, as well as the communities most commonly subject to these tools.<sup>58</sup>

There are exemptions in open government laws that extend trade secret protection through explicit statutory language.<sup>59</sup> While state analogues vary in exact wording of what is protected, an exemption from the federal Freedom of Information Act (“FOIA”) provides that trade secrets or “information which is (1) commercial or financial, (2)

---

<sup>56</sup> Bloch-Wehba, *supra* note 42, at 1287.

<sup>57</sup> Natalie Ram, *Innovating Criminal Justice*, 112 NW. U. L. REV. 659, 692 (2018) (saying that “[t]rade secret assertion in the context of criminal justice tools also raises constitutional concerns. The secrecy surrounding the existence, use, and function of criminal justice tools interfere with defendants’ and courts’ efforts to ensure that the government does not engage in unreasonable searches. Such secrecy is also at least in tension with, if not in violation of, defendants’ ability to vindicate their due process interests throughout the criminal justice process, as well as their confrontation rights at trial.”).

<sup>58</sup> Hannah Bloch-Wehba, *supra* note 42 at 1272 (saying, “compromises between the private vendors’ commercial interests and the liberty interests of those affected by algorithmic governance overlook the public’s separate and independent interest in oversight and monitoring of government decision-making.”).

<sup>59</sup> *See generally Open Gov’t Guide*, *supra* note 13 (showing freedom of information laws in 50 states, including the trade secret/commercial protections).

obtained from a person, and (3) privileged or confidential” is exempted.<sup>60</sup>

In *Food Marketing Institute v. Argus*, the trade secret exemption was expanded, reversing decades of precedent requiring a showing of competitive harm if the “trade secret” were to be released under FOIA.<sup>61</sup> Instead, now the entity must only prove either that it (1) treats a piece of information as confidential or, (2) if it is the type of information that is usually kept confidential, that there is either express or implied assurance by the government that it will maintain confidentiality.<sup>62</sup> The Department of Justice issued guidance after the *Food Marketing Institute* decision and updated practitioner guidance.<sup>63</sup> When the government has not made any “express or implied indications at the time the information was submitted that the government would publicly disclose this information,” there is a presumption of valid trade secrecy if the entity customarily held the information as private.<sup>64</sup>

To varying extents, state open government laws across the country have similar commercial protections for trade secrets.<sup>65</sup> The justifications of trade secret protection

---

<sup>60</sup> 5 U.S.C. § 552(b)(4) (2016); ELEC. PRIV. INFO. CTR., LITIGATION UNDER THE FEDERAL OPEN GOVERNMENT LAWS 113 (Marc Rotenberg et al. eds., 25th ed. 2010) (citing Pub. Citizen Health Rsch. Grp. v. F.D.A., 185 F.3d 898, 903 (D.C. Cir. 1999); Nat’l Parks & Conservation Ass’n v. Morton (I), 498 F.2d 765, 766 (D.C. Cir. 1974); Brockway v. Dep’t of Air Force, 518 F.2d 1184, 1188 (8th Cir. 1975)).

<sup>61</sup> *Food Mktg. Inst. v. Argus Leader Media*, 139 S. Ct. 2356, 2361 (2019).

<sup>62</sup> *Step-by-Step Guide for Determining if Commercial or Financial Information Obtained from a Person is Confidential Under Exemption 4 of the FOIA*, U.S. DEP’T OF JUST., <https://www.justice.gov/oip/step-step-guide-determining-if-commercial-or-financial-information-obtained-person-confidential> [<https://perma.cc/F2BM-H4TL>].

<sup>63</sup> *Id.*

<sup>64</sup> *Id.*

<sup>65</sup> See generally *Open Gov’t Guide*, REPS. COMM. FOR FREEDOM PRESS, <https://www.rcfp.org/open-government-guide> [<https://perma.cc/5R42-B3ZA>].

including competition, innovation, and labor ownership,<sup>66</sup> should be weighed against the interests at stake. Trade secrets being applied to the criminal setting is a relatively recent legal development, but it is becoming more common.<sup>67</sup> Preservation of commercial viability and promoting commercial innovation for policing tools and tools that directly affect bail and sentencing decisions risks people’s liberty while maximizing profit and minimizing accountability. In criminal cases, as Rebecca Wexler explains, civil trade secret protection applied to criminal cases is dangerous because it “will almost certainly lead to systemic overclaiming and wrongful exclusion of relevant evidence; impose an unreasonable burden on defendants’ discovery and subpoena rights; and undermine the legitimacy of criminal proceedings by implying that the government values intellectual property owners more than other groups affected by criminal proceedings.”<sup>68</sup>

In the open government context, the evidentiary mechanisms are not present like they are in criminal cases. But, as Hannah Bloch-Wehba articulates, they “codif[y] expectations regarding the government’s disclosure of information to the *public*, ... [and] operat[e] both to protect the balance of power between the public and the government and to ensure that key information regarding government decision-making is open to public scrutiny.”<sup>69</sup> Open government laws provide a right to government records without having to be personally affected by a tool, and policies about disclosure exemptions should reflect that. In applications where documents related to automated

---

<sup>66</sup> See generally Michael Risch, *Why Do We Have Trade Secrets?*, 11 MARQ. INTELL. PROP. L. REV. 1, 26–37 (2007) (explaining the justifications for trade secrets).

<sup>67</sup> See Rebecca Wexler, *supra* note 14 at 1388–94 (summarizing the history of the trade secret privilege in criminal proceedings).

<sup>68</sup> *Id.* at 1395.

<sup>69</sup> Bloch-Wehba, *supra* note 42, at 1268.



decision-making tools used by the government to help make decisions around bail, policing resources, parole and investigations are statutorily exempt from public view, the interest in liberty and public scrutiny outweighs the interest in competition or innovation.

**B. Performance Issues – Accuracy and Bias**

Inaccuracy plagues many forms of predictive automated decision-making. Many pre-trial risk assessment tools use the measure of about 55– 65% predictive validity, barely better than the chance of a coin flip outcome, when trying to predict who will be arrested again.<sup>70</sup> Those tools are trying to predict “criminality,” a concept that cannot be clearly defined nor predicted, posing additional accuracy challenges. For example, a public records request to the Nebraska Department of Corrections yielded emails between a developer of a risk assessment algorithm and administrators in the Department of Corrections where the developer explained that the rate at which they test if something is statistically valid is if it is more than 50% likely to be accurate.<sup>71</sup>

The primary criterion for creating a validated tool to improve the prediction of recidivism beyond random chance (i.e. a coin flip). . . one should not simply be concerned that the tool improves beyond random chance but that its prediction is more accurate than any other tool under consideration. Again, I cannot argue that the YLS/CMI has been identified to provide a better prediction than random chance in more places than any other tool. However, we attempted to create the STRONG-R to be more accurate than the

---

<sup>70</sup> *Validation*, *supra* note 51; see Hamilton-Koebnick Email, *supra* note 52.

<sup>71</sup> Hamilton-Koebnick Email, *supra* note 52.

YLS/CMI and to customize the prediction for the specific population it is being used to assess.<sup>72</sup>

This is under-acknowledged by the entities adopting the tool and, often by design, is unknown by those affected by the tool. A lack of widespread regulations requiring regular, independently done validation studies on the population that it is used on combined with the limited access to this data due to commercial protections yield only limited knowledge of accuracy rates.<sup>73</sup> Transparency can help dispel the myth that automated decision-making systems, just because they use computers or are based off of statistical analysis, are more accurate or useful than other tools or strategies to make the justice system more equitable.

Validation studies will be covered under section IV.c, but, as a start, validation studies are processes by which statistical analysis is done to evaluate a given automated decision-making system to check its predictive validity by comparing predictions against actual outcomes in a given jurisdiction.<sup>74</sup> Mapping Pretrial Injustice surveyed jurisdictions using pretrial risk assessment tools about their validation practices and found that 21% of the jurisdictions performed validation checks 5-10 years ago, 21% of the validation checks used nonlocal data, 9% of the checks used validation studies from over 10 years ago, and only 28%

---

<sup>72</sup> *Id.*

<sup>73</sup> See *Validation*, supra note 51 (finding that “[m]any jurisdictions are using tools that have not been validated with their local population or have not been validated at all.”). One example of a regulation addressing validation is §2(e) Miss. H.B. 585 (2014), <https://www.mdoc.ms.gov/Documents/House%20Bill%20585%20as%20approved%20by%20the%20Governor.pdf> [https://perma.cc/U87Y-3MSL] (stating, “‘Risk and needs assessment’ means the use of an actuarial assessment tool validated on a Mississippi corrections population to determine a person’s risk to reoffend and the characteristics that, if addressed, reduce the risk to reoffend.”).

<sup>74</sup> *Validation*, supra note 51.

used validation studies with local data within 5 years.<sup>75</sup> Using local data to validate a tool is important because, due to different populations, different police forces, different crime histories, and different goals—a factor that predicts criminal risk in one jurisdiction may not accurately predict the same measure in another. Performing proper validation studies frequently can help track whether the tool used by a given jurisdiction is actually helping to achieve its goals. For many validation studies, it is also key to point out that they have thresholds as low as a 55% accuracy<sup>76</sup> benchmark to determine accuracy—a worryingly low bar.

Evaluating bias is a necessary complement to the evaluation of accuracy and other metrics of a given system. Even when a system is technically accurate, systems can encode or reinforce systemic biases or be inherently dangerous systems. One example of inaccuracy and bias is an analysis of a pre-trial risk assessment tool, done by ProPublica in 2016. The analysis showed that nearly twice as many black defendants were labeled as high risk to reoffend, but did not actually reoffend, as white defendants.<sup>77</sup> The inverse was also true—twice as many white defendants were labeled low risk but ended up reoffending compared to black defendants.<sup>78</sup> Several other studies of risk assessment tools, as well as predictive policing tools, have shown disparate scoring and ineffectiveness based on ethnicity, age, zip code, and more.<sup>79</sup>

---

<sup>75</sup> *Id.*

<sup>76</sup> *Id.*

<sup>77</sup> Angwin et al., *supra* note 46. 23.5% of white defendants were labeled higher risk but did not re-offend. 44.9% of black defendants were labeled higher risk but did not re-offend. *Id.*

<sup>78</sup> *Id.* 47.7% of white defendants were labeled lower risk but did re-offend. 28% of black defendants were labeled lower risk but did re-offend. *Id.*

<sup>79</sup> See, e.g. Megan T. Stevenson, *Assessing Risk Assessment in Action*, 103 MINN. L. REV. 303, 329 (2019); Melissa Hamilton, *The Biased Algorithm: Evidence of Disparate Impact on Hispanics*, 56 AM. CRIM.

The risk of bias is not limited to risk assessment-type tools. A study from the National Institute of Standards and Technology (“NIST”) analyzed the facial recognition algorithms of a “majority of the industry” and found that some software was up to 100 times more likely to return a false positive of a non-white individual than it was for white individuals.<sup>80</sup> Specifically, NIST found “for one-to-many matching, the team saw higher rates of false positives for African American females,” which they highlight “are particularly important because the consequences could include false accusations.”<sup>81</sup> As of now, a well-funded and powerful entity like NIST has to both choose to do a study like this and be limited to systems they have access to. Audits or validation studies are often done by the company itself or an outside tester that they hire, without independent evaluation, resulting in conflicts of interest.<sup>82</sup> This conflict

---

L. REV. 1553, 1560–61 (2019); Megan T. Stevenson & Christopher Slobogin, *Algorithmic Risk Assessments and the Double-Edged Sword of Youth*, 96 WASH. U. L. REV. 681, 681 (2018); Songül Tolan et al., *Why Machine Learning May Lead to Unfairness: Evidence from Risk Assessment for Juvenile Justice in Catalonia*, INT’L CONF. ON AI AND L. (2019), [https://chato.cl/papers/miron\\_tolan\\_gomez\\_castillo\\_2019\\_machine\\_learning\\_risk\\_assessment\\_savry.pdf](https://chato.cl/papers/miron_tolan_gomez_castillo_2019_machine_learning_risk_assessment_savry.pdf) [<https://perma.cc/9WJC-W3T9>]; Will Douglas Heaven, *Predictive Policing Algorithms are Racist. They Need to be Dismantled*, MIT TECH. REV. (Jul. 17, 2020), <https://www.technologyreview.com/2020/07/17/1005396/predictive-policing-algorithms-racist-dismantled-machine-learning-bias-criminal-justice/> [<https://perma.cc/Q79W-BQM6>].

<sup>80</sup> *NIST Study Evaluates Effects of Race, Age, Sex on Face Recognition Software*, NAT’L INST. STANDARDS & TECH. (Dec. 19, 2019), <https://www.nist.gov/news-events/news/2019/12/nist-study-evaluates-effects-race-age-sex-face-recognition-software> [<https://perma.cc/L7S7-62JK>].

<sup>81</sup> *Id.*

<sup>82</sup> See Mona Sloane, *The Algorithmic Auditing Trap*, ONEZERO (Mar. 17, 2021) <https://onezero.medium.com/the-algorithmic-auditing-trap-9a6f2d4d461d> [<https://perma.cc/4G2E-ZUNY>]; *Validation*, *supra* note 51 (“And unlike many other fields, there is a lack of independent evaluation of these validation studies, which severely limits any claims

arises in part because it is against a company's interest to publish information illustrating that their software is inaccurate or biased. The legal and practical infrastructure supporting the lack of transparency in these systems directly obfuscates the opacity and bias in these systems. With more transparency, more robust, independent testing can be done, leading to increased oversight.

### **C. Process Issues**

In addition to the performance issues of risk assessment tools and other criminal justice automated decision-making systems, there are significant process issues in the procurement and execution process that enable and exacerbate the negative effects articulated above. Process issues result in a lack of transparency around who is developing a tool, the stated purpose of a tool, input data, logic of a tool, decision-making matrix, and data sharing and retention policies.<sup>83</sup>

Procurement regulations differ greatly between states and regulate how governments contracts services.<sup>84</sup> As of now, without complementary regulation of automated

---

that pretrial RATs are truly predictive.”); *see also, e.g.*, Northpointe, *Results from a Psychometric Study Conducted for the Wisconsin Department of Corrections Division of Adult Institutions*, EPIC (Feb. 11, 2014), <https://epic.org/EPIC-19-11-08-NEDCS-FOIA-20191112-Northpointe-Self-Validation.pdf> [https://perma.cc/KVP5-HH2M]; Northpointe, *Predictive Validity of the COMPAS Reentry Risk Scales: An Outcomes Study Conducted for the Michigan Department of Corrections: Updated Results on an Expanded Release Sample*, EPIC (Aug. 22, 2013), <https://epic.org/EPIC-19-11-08-NE-DCS-FOIA-20191112-Northpointe-Self-Validation-2.pdf> [https://perma.cc/9ZBU-ANG7].

<sup>83</sup> *See Liberty at Risk*, *supra* note 10, at 15.

<sup>84</sup> *See generally 2018 Survey of State Procurement Practices*, NAT'L ASS'N STATE PROCUREMENT OFFS. (2018), [https://www.naspo.org/wp-content/uploads/2019/12/2018-FINAL-Survey-Report\\_6-14-18.pdf](https://www.naspo.org/wp-content/uploads/2019/12/2018-FINAL-Survey-Report_6-14-18.pdf) [https://perma.cc/X3HE-XLLB].

decision-making, procurement processes can be levied to meet the current need for transparency and oversight. It is a field ripe for updating given the increasing automation of the administrative state.<sup>85</sup> It is through the procurement process that agreements with contractors that give this level of deference are accepted, where hundreds of thousands of dollars are spent on a given automated decision-making system, and where simple changes can be made to ensure transparency and other forms of public oversight.

Particularly, the lack of a requirement for the entity adopting an automated decision-making tool to articulate the purpose for adopting the tool, benchmarks for evaluation of the effectiveness of a tool, and regular, independent, and localized evaluation and validation studies of the purpose of a tool diminishes thoughtful procurement and accountability.<sup>86</sup>

In terms of data privacy and security, minimum baseline standards and policies should be instituted that can help limit the improper sale of data, introduce safeguards for accuracy, require data collection and use to be directly proportional to the needs of a system, and empower an oversight body.

Additional opportunities to improve process issues come in creating rights for people to understand exactly what data of theirs is being used in a given system, what system is being used against them, and how they can contest and understand an algorithmically supported decision that might be erroneous. This model is used in a limited way for consumer credit reporting in the U.S.<sup>87</sup> and more generally

---

<sup>85</sup> See ENGSTROM ET AL., *supra* note 17, at 9–10; *Liberty at Risk*, *supra* note 10, at Executive Summary.

<sup>86</sup> See *Liberty at Risk*, *supra* note 10, at 15.

<sup>87</sup> Fair Credit Reporting Act, 15 U.S.C. §§ 1681–1681x (providing rights to examine credit reports, dispute incomplete or inaccurate information, and giving obligations to consumer reporting agencies to delete inaccurate information).

in Europe through the General Data Protection Regulation,<sup>88</sup> and should be a minimum for people subject to these systems throughout the criminal justice cycle. Targeted surveillance oversight laws, discussed more in Section IV, is one path towards more transparency and accountability.

#### **IV. HARM-MITIGATION APPROACHES**

Jurisdictions should improve opacity, alleviating some of the harms discussed above, by constraining protections in open government regulations for trade secret and commercial protections. Additionally, while sweeping algorithmic transparency and accountability bills are currently difficult to pass in legislatures,<sup>89</sup> this section explores different targeted improvements that legislators can make as well as how administrators can improve the quality of procurement for many government-contracted criminal justice technologies.

##### ***A. Constrain trade secret protections within open government laws***

For automated decision-making systems in and around the criminal justice system, exemptions within the trade secret and other commercial protections in open

---

<sup>88</sup> See generally Regulation 2016/679, of the European Parliament and of the Council of 27 April 2016 on the protection of natural persons with regard to the processing of personal data and on the free movement of such data, and repealing Directive 95/46/EC (General Data Protection Regulation), §§ 1–5, 2016 O.J. (L 119) 1, 39–47.

<sup>89</sup> For bills that did not get passed, see, e.g., Algorithmic Accountability Act of 2019, H.R. 2231, 116th Cong. (2019); An Act Relating to Establishing Guidelines for Government Procurement and Use of Automated Decision Systems in Order to Protect Consumers, Improve Transparency, and Create More Market Predictability, Wash. S.B. 5116, 67th Legislature (2021) (Wash.), <https://app.leg.wa.gov/billsummary?BillNumber=5116&Initiative=false&Year=2021> [<https://perma.cc/5YLQ-6XG9>].

government statutes should be expressly given. This allows jurisdictions to take a risk-based approach, not tearing down trade secrets for all purposes, but giving the public the power to oversee important decisions made by their government. At the federal level, Congress should pass legislation increasing amend FOIA following the expansion of trade secret protections in *Food Marketing Institute*<sup>90</sup> to increase citizen access.

### ***B. Procurement policies and decisions***

Governments contracting with the companies that develop these tools should procure more transparently and purposefully, raising the standard of quality, accuracy, and disclosure. Following a report that the CEO of a surveillance company contracting with the state of Utah had ties to the Ku Klux Klan,<sup>91</sup> the state auditor released a set of recommended guidelines for the procurement or development of software for the state.<sup>92</sup> The “Software Application Procurement Principles for Utah Government Entities” include:

- (1) “Limit Sharing of Sensitive Data”;
- (2) “Minimize Sensitive Data Collection and Accumulation”;
- (3) “Validate Technology Claims – including Capability Review[,]” particularly “Asserted use of AI

---

<sup>90</sup> See *Food Mktg. Inst.*, 139 S. Ct. at 2361.

<sup>91</sup> Matt Stroud, *CEO of Surveillance Firm Banjo Once Helped KKK Leader Shoot Up a Synagogue*, ONEZERO (Apr. 28, 2020), <https://onezero.medium.com/ceo-of-surveillance-firm-banjo-once-helped-kkk-leader-shoot-up-synagogue-fdba4ad32829> [https://perma.cc/W85A-6MVN].

<sup>92</sup> *Application Procurement Principles for Utah Government Entities*, OFF. STATE AUDITOR (Feb. 1, 2021) (Utah), <https://auditor.utah.gov/wp-content/uploads/sites/6/2021/02/Office-of-the-State-Auditor-Software-Application-Procurement-Principles-Privacy-and-Anti-Discrimination-Feb-2-2021-Final.pdf> [https://perma.cc/Q8GJ-AVWF].



[Artificial Intelligence]) or ML [Machine Learning]). . . proposed use of disparate data sources, especially social media or integration of government and private sources, and. . . Real-time capabilities. . .”;

(4) “Perform In-Depth Review of. . . Algorithms”;

(5) “Review Steps Taken to Mitigate Discrimination”;

(6) “Determine Ongoing Validation Procedures”; and

(7) “Require Vendor to Obtain Consent of Individuals Contained with Training Datasets. . . .”<sup>93</sup>

This list is a starting point of how contracting agencies can procure with higher standards and help to protect their citizens, regardless of if these steps are required by law. According to an analysis of surveillance oversight laws throughout the country, ten of the sixteen jurisdictions surveyed require surveillance tools to be approved through an oversight process, but many empower communities and increase the levels of transparency.<sup>94</sup> Not all of the automated decision-making systems used throughout the criminal justice cycle would be covered by surveillance technology laws or the principles proposed by the Utah auditor, but it’s an important blueprint when beginning to regulate procurement and transparency into automated decision-making.

### ***C. Targeted legislation about specific technologies***

In March 2019, Idaho became the first state to enact a law specifically promoting transparency, accountability,

---

<sup>93</sup> *Id.*

<sup>94</sup> Rebecca Williams, *Everything Local Surveillance Laws Are Missing in One Post*, HARV. KENNEDY SCH.: BELFER CTR. FOR SCI. & INT’L AFFS. (Apr. 26, 2021), <https://www.belfercenter.org/publication/everything-local-surveillance-laws-are-missing-one-post> [<https://perma.cc/WWF7-ZU68>].

and explain-ability in pre-trial risk assessment tools.<sup>95</sup> The Idaho law prevents trade secrecy or IP defenses in criminal cases, requires public availability of “all documents, data, records, and information used by the builder to build or validate the pretrial risk assessment tool,” and empowers defendants to review all calculations and data that went into their risk score.<sup>96</sup>

Other direct approaches simply respond to a particularly problematic technology by banning or placing a moratorium on its use. For example, over a dozen jurisdictions in the United States have banned face recognition for one purpose or another. There have been bans or moratoriums on the use of Facial Surveillance systems in Alameda, CA; Berkeley, CA; Boston, MA; Brookline, MA; Cambridge, MA; Jackson, MS; Northampton, MA; Oakland, CA; Portland, ME; Portland, OR; San Francisco, CA; Somerville, MA; and Springfield, MA.<sup>97</sup> Although important for certain technologies, it forces jurisdictions to continually play catch-up and many only regulate police use. In order to increase the likelihood of enforcement, significant penalties and a private right of action for violations should be included in any bans or moratoriums on specific technology.

Another, although highly imperfect, strategy towards achieving transparency around some automated decision-making systems used by the government is to utilize a task force or commission in a government entity specifically set up to understand how an automated decision-making system is used throughout the state. These exist in Alabama, Vermont, New York State, and New York City, among

---

<sup>95</sup> IDAHO CODE § 19-1910 (2019).

<sup>96</sup> *Id.*

<sup>97</sup> *Map, BAN FACIAL RECOGNITION*, <https://www.banfacialrecognition.com/map/> [https://perma.cc/7TSK-EGPA].

others.<sup>98</sup> The results of these task forces are more likely to alleviate the factual opacity of what systems are being used, rather than to publish details such as what factors are used in a given tool that are important to understand and make sure are correct when an automated decision-making system is used.<sup>99</sup> If sufficiently empowered, task forces can be an important transparency function for public automated

---

<sup>98</sup> See S.J. Res. 71 (May 15, 2019) (Ala.), <http://alisondb.legislature.state.al.us/ALISON/SearchableInstruments/2019RS/PrintFiles/SJR71-int.pdf> [<https://perma.cc/B8NX-PNCX>]; H. 378 (May 21, 2018) (Vt.), <https://legislature.vermont.gov/Documents/2018/Docs/ACTS/ACT137/ACT137%20As%20Enacted.pdf> [<https://perma.cc/SE9N-NU44>]; S. 3971B (Feb. 22, 2019) (N.Y.), <https://www.nysenate.gov/legislation/bills/2019/s3971> [<https://perma.cc/DZH2-PD2Z>]; N.Y.C. Local L. 49 (Jan. 11, 2018) (N.Y.C.) <https://legistar.council.nyc.gov/LegislationDetail.aspx?ID=3137815&GUID=437A6A6D-62E1-47E2-9C42-461253F9C6D0#> [<https://perma.cc/VEP2-HGNZ>].

<sup>99</sup> See *Confronting Black Boxes: A Shadow Report of the New York City Automated Decision System Task Force*, AI NOW INST., at 94 (Dec. 2019), <https://ainowinstitute.org/ads-shadowreport-2019.pdf> [<https://perma.cc/U4Z5-8GY4>] (saying, “New York City Automated Decision Systems Task Force members repeatedly requested information about ADS currently used because the local context was necessary to fulfill the statutory mandate, but many agencies resisted cooperating or only provided selective information about one system. To avoid similar problems, similar government bodies or processes must be given authority to request and access information about all existing ADS, without special exemptions or carveouts that can undermine necessary analysis and subsequent recommendations. While it may be difficult for a task force or government process to undertake a thorough analysis of each ADS system, a task force or government process should be empowered to select representative ADS that reflect the variety of ways these systems can impact human welfare.” This illustrates the fact that even being able to discover and publish the uses of automated decision-making systems by the government is not something these task forces are routinely empowered to do effectively.).

decision-making and prime legislators for broader regulatory proposals.<sup>100</sup>

***D. Assessments and audits: alternatives to blanket transparency of source code***

One approach that does not require voluminous source code and other developmental documents to be made fully public is to require some sort of required assessment or audit that is designed to ensure key aspects of an automated decision-making system are considered, purposeful, and public. One potential benefit to this approach is that it could solve some transparency and accountability issues while allowing IP holders to avoid disclosure of a large swath of their source code and other proprietary information.

The content of assessments varies, mostly because they are not very widely deployed yet. However, one widely deployed assessment is for public entities in Canada.<sup>101</sup> The assessment guides users through questions about why they are adopting a given system, what capabilities their system holds, how explainable it is, what kind of decisions it helps make, how much intervention is involved, how sensitive their data is, how synthesized the data is, who the adopting agency is consulting about the adoption, mitigating measures, procedural fairness, and more.<sup>102</sup> Depending on

---

<sup>100</sup> See, e.g., N.Y. S. A6042, 2020-2021 Legis. Session (2021) (N.Y.), <https://www.nysenate.gov/legislation/bills/2021/A6042> [<https://perma.cc/PGR7-T685>]; Vt. H. 263 (2021) (Vt.), <https://legislature.vermont.gov/bill/status/2022/H.263> [<https://perma.cc/72AZ-EGQD>]. These illustrate strong proposed bills in jurisdictions following the establishment and proceedings of task forces.

<sup>101</sup> See *Directive on Automated Decision-Making*, GOV'T CAN. (last modified May 2, 2019), <https://www.tbs-sct.gc.ca/pol/doc-eng.aspx?id=32592> [<https://perma.cc/YFL7-RSD3>].

<sup>102</sup> *Algorithmic Impact Assessment*, GOV'T CAN. (last modified Mar. 22, 2021), <https://open.canada.ca/aia-eia-js/?lang=en> [<https://perma.cc/9MKL-MXE8>].

the results, the agency is required to take mitigating measures, provide more information, or use a different system.<sup>103</sup>

For this option to maximize trust and accountability, assessments should be mandatory, robust, public, and part of an infrastructure that legitimizes it. A landmark report of how Algorithmic Impact Assessments can be operationalized describes a robust process of requiring a pre-acquisition review, initial agency disclosure requirements, comment period, due process challenge period, and renewal.<sup>104</sup> In this report, AI Now addresses the trade secret barrier for assessments by saying:

While there are certainly some core aspects of systems that have competitive commercial value, it is unlikely that these extend to information such as the existence of the system, the purpose for which it was acquired, or the results of the agency's internal impact assessment. Nor should trade secret claims stand as an obstacle to ensuring meaningful external research on such systems. AIAs provide an opportunity for agencies to raise any questions or concerns about trade secret claims in the pre-acquisition period, before entering into any contractual obligations. If a vendor objects to meaningful external review, this would signal a conflict between that vendor's system and public accountability.<sup>105</sup>

---

<sup>103</sup> See *id.*; *Framework for the Management of Compliance*, GOV'T CAN. (last modified Aug. 27, 2010), <https://www.tbs-sct.gc.ca/pol/doc-eng.aspx?id=17151&section=html> at 9.10-9.12 (explaining the range of consequences of not complying with certain government directives, including *Directive on Automated Decision-Making*) [<https://perma.cc/XP67-6CVW>].

<sup>104</sup> Dillon Reisman et al., *Algorithmic Impact Assessments: A Practical Framework for Public Agency Accountability*, AI NOW INST. (Apr. 2018), at 7–10, <https://ainowinstitute.org/aiareport2018.pdf> [<https://perma.cc/8Z6U-QVYV>].

<sup>105</sup> *Id.* at 14.

Requiring assessments in this regular, overseen fashion could be a helpful alternative to the status quo without jeopardizing substantial competitive harm, since they would require disclosure of basic operations about their tools and the impacts they cause, rather than the source code.

*E. The value and limits of transparency*

Transparency is not, itself, the end goal for advocates trying to ensure equity in systems used by governments and corporations. However, transparency can go hand-in-hand with accountability, and, without any transparency, the hope for change is depleted. Without knowledge, citizens and advocates cannot exercise their rights in the democratic environment effectively because they do not have the resources to understand how the automated decision-making systems might be affecting them or their communities. Improving transparency can help alleviate the outweighed pressure and negative effect of automated decision-making systems on communities of color. It can allow third-party researchers to test datasets as well as the algorithms themselves to expose inequities.

Automated decision-making systems require an entity to articulate which factors they want to include in helping determine outcomes like how likely someone is going to be arrested again, receive a second interview for a job, and more.<sup>106</sup> These outcomes are determined by entities now adopting automated decision-making tools to help automate the continued determination of those outcomes. Adopting a tool and passing the burden of justifying complicated decisions to a third-party contractor who can

---

<sup>106</sup> See Miranda Bogen, *All the Ways Hiring Algorithms Can Introduce Bias*, HARV. BUS. REV. (May 6, 2019), <https://hbr.org/2019/05/all-the-ways-hiring-algorithms-can-introduce-bias> [<https://perma.cc/736N-CTBB>]; Heaven, *supra* note 79; see generally *Liberty at Risk*, *supra* note 10.

protect any disclosure with the overbroad commercial and trade secret protections in open government laws leaves people with little hope for recourse.<sup>107</sup> Each decision about what factor is included in a tool, and how much weight it will hold is a decision that is not simple and is not objective. Increasing the transparency about what automated decision-making systems are used by their government and how they work is necessary for public engagement and input about how their government is operating. The reason that this is particularly salient for the uses of automated decision-making in the criminal justice system is because the stakes are extremely high, where an automated decision-making system influences the length of a prison sentence or the likelihood of a police encounter.

Although transparency is not a panacea and will not stop either the use of these tools by themselves or the harm they cause, it is helpful to have identifiable legal and organizational forces that can be improved upon.

## V. CONCLUSION

There is a wide variety of automated decision-making tools used by government entities and corporations alike which operate in and around the criminal justice system in the United States. There is a huge variety of the type, quality, and frequency of these tools, but they all hold immense power. The tools discussed in this piece have an outsized impact on communities of color and communities that are lower income. Transparency in this particular field is very elusive, which is especially damaging to communities who burden the harm most. Trade secrets and

---

<sup>107</sup> See, e.g., *State v. Loomis*, 881 N.W.2d 749, 761–62 (Wis. 2016) (stating, “[a]dditionally, this is not a situation in which portions of a PSI are considered by the circuit court, but not released to the defendant. The circuit court and Loomis had access to the same copy of the risk assessment.”).

other commercial protections included in open government laws, combined with a lack of procurement regulations, contribute to this and must be changed.

Moving forward, a more transparent approach towards adoption of automated decision-making tools can allow equity to be built, and more thoughtful adoption of these tools to take hold. By minimizing commercial protections for the details concerning these tools as part of a suite of improvements around this set of very sensitive government uses, jurisdictions can prioritize the health, safety, and equity of their citizens over supporting a criminal justice technology “industry.”



# THE BELATED AWAKENING OF THE PUBLIC SPHERE TO RACIST BRANDING AND RACIST STEREOTYPES IN TRADEMARKS

FADY. J.G. AOUN\*

\*Readers are advised that this Article contains highly offensive, demeaning, and derogatory representations of Indigenous Australians, Native Americans, Black and ethnic minorities. While these may cause serious offense, they have been included here to provide a more accurate account of the racist trademarks and racist branding circulating in historical and contemporary liberal democratic societies.\*

## ABSTRACT

*The transformative Black Lives Matter social justice movement has shone a harsh light on endemic structural racism in Western civil societies, especially as it relates to police brutality and hegemonic perceptions of oppressed minorities. A small, but important consequence of this powerful movement is the long overdue mobilization of the contemporary public sphere against longstanding racist branding and racist stereotypes in trademarks. This encouraging outcome — exemplified by the archetypal*

---

\*Senior Lecturer, The University of Sydney Law School. My sincere gratitude must go to the participants at the Australian and New Zealand IP Academics' Mini-Conference, Melbourne Law School, 3 & 4 September 2020, the Race & IP Symposium, November 6, 2020, University of New Hampshire Franklin Pierce School of Law, and the 2nd Biennial Conference on Race + IP, April 5 & 6, 2019 at NYU Law School, for their helpful comments and questions. Special thanks must go to Graeme Austin, Kathy Bowrey, Peter Gerangelos, Mark Davison, Michael Handler, and Kimberlee Weatherall for their excellent comments and provocative suggestions on earlier drafts and/or my doctoral dissertation, a portion of which appears in this article. I also acknowledge the excellent editorial assistance of James Tanna, Ryan Rieker and Meredith Foor. All errors remain mine.

*intergenerational Native American struggle against the Washington Football team's suite of marks and similar battles across the Atlantic and in the Antipodes — is due largely to the sustained efforts of diverse minority groups drawing to the attention of the broader public the societal problem of certain racist trademarks.*

*Xenophobic commercial signs operate as odious communicative vectors resonating far beyond their traditional roles in the market economy as mere signifiers of merchant goods or services, or as species of private property. This article delves into historical trademark registers with a view to setting out various harmful racist tropes circulating as registered trademarks, branding, and advertising in the transatlantic and transpacific public sphere and charts both their stubborn resilience and the almost autochthonous resistance to such marks by marginalized (i.e. counterpublic) groups in these jurisdictions. Building on relevant trademark jurisprudence and normative models of deliberative democracy, it then makes the case that challenging racist commercial insignia is in the democratic public interest.*

*It is worth noting here that though federal trademark law in the United States, the United Kingdom, and Australia emerged from similar foundations, those countries' paths regarding the registrability of racist trademarks have recently diverged. The post-Matal v. Tam epoch, for instance, forecloses the contributions of U.S. trademark law in this space and once more speaks to the law's general valorization of free speech and proprietary interests. Yet in the United Kingdom and Australia, both common law liberal democracies without constitutionally entrenched rights to free speech, trademark law still offers emancipatory potential for those rallying against racist commercial symbols. Nevertheless, in all the jurisdictions identified above, multiple and disparate avenues for pursuing this public interest remain. These counterpublic energies and*

*The Belated Awakening of the Public Sphere to Racist Branding and Racist Stereotypes in Trademarks* 547

*their contribution to the promotion of truly egalitarian and vibrant democratic civil societies are explored below.*

*“Only events which are perceived as dramatic or social movements can trigger drastic shifts in opinions.”<sup>1</sup>*

*“We’d already won this fight in terms of gaining a societal understanding of the issues. There were thousands of people involved, spanning generations. The Washington team could have joined with the people of good conscience a long time ago.”<sup>2</sup>*

*“[T]he public interest may sometimes support decisions about the exploitation of trade signs which are not in the particular interests of either consumers or traders as such but which, for example, promote a free and accessible communicative sphere.”<sup>3</sup>*

Abstract.....	545
I. Introduction.....	548
II. Historical Trademark Registrations and Resistance In the Transpacific and Transatlantic Public Sphere.....	566
A. Racist Trademark Registrations in the Anglo-American and Anglo-Australian Public Sphere.....	569

---

<sup>1</sup> JÜRGEN HABERMAS, EUROPE: THE FALTERING PROJECT 164 (Ciaran Cronin trans., 2009) [hereinafter “HABERMAS, *Europe*”].

<sup>2</sup> Suzan Harjo quoted in Courtland Milloy, *Suzan Harjo fought for decades to remove the Redskins name. She’ll wait to celebrate*, WASH. POST (July 15, 2020, 7:20 PM), [https://www.washingtonpost.com/local/suzan-shown-harjo-redskins-name-fight/2020/07/14/6f382d16-c5f4-11ea-b037-f9711f89ee46\\_story.html](https://www.washingtonpost.com/local/suzan-shown-harjo-redskins-name-fight/2020/07/14/6f382d16-c5f4-11ea-b037-f9711f89ee46_story.html) [<https://perma.cc/Y596-UT59>].

<sup>3</sup> Patricia Loughlan, *The Campomar Model of Competing Interests in Australian Trade Mark Law*, 27 EUR. INTELL. PROP. REV. 289, 292 (2005) [hereinafter “Loughlan, *Campomar*”].

B. Resistance to Racism and Racist Representations of the Other .....	587
III. Habermasian Public Sphere Theory: Early Thoughts .....	591
IV. Was the Historical Public Sphere ‘Open and Accessible’ to All? .....	599
A. Challenging Habermas’ Historical Account: Normative Implications .....	599
B. Normative Modification.....	611
V. Deliberative Democracy in Action: Native American Counterpublics Strike Back Against Stigmatizing Trademarks, And Then There’s Simon Tam’s Counterpublic.....	625
A. The Law, as Always, Eventually Liberates (Some): Simon Tam’s THE SLANTS Case Study .....	627
B. The Law, as Always, Disappoints: Native American Case Study .....	632
VI. Conclusion .....	668

## **I. INTRODUCTION**

The transformative Black Lives Matter (‘BLM’) global social justice movement which first gained prominence as a hashtag, #blacklivesmatter, has shone a harsh light on endemic structural racism in Western civil societies, especially as it relates to police violence and the hegemonic treatment and perceptions of oppressed minorities. A small but important consequence of this powerful racial justice-seeking counterpublic is the long overdue mobilization of the contemporary public sphere against various harmful racist tropes reproduced and

reinforced in racist trademarks and associated commercial branding referencing people of color.<sup>4</sup>

These welcomed changes did not occur in a vacuum. Sustained counterpublic contestatory efforts by marginalized groups (and their supporters) in the public sphere and, in some cases, through trademark law had earlier laid the necessary groundwork that eventually forced the demise of time-honored stereotypically-racist trademarks. Icons of Black servitude embodied in trademarks such as AUNT JEMIMA,<sup>5</sup> UNCLE BEN,<sup>6</sup> MRS

---

<sup>4</sup> For a historical and legal analysis of the differences between the wider concept of ‘brands’ and the narrower concept of ‘trademarks’, see, for example, John Mercer, *A Mark of Distinction: Branding and Trade Mark Law in the UK from the 1860s*, 52 *BUS. HIST.* 17 (2010); Stefan Schwarzkopf, *Turning Trademarks into Brands: How Advertising Agencies Practiced and Conceptualized Branding, 1890-1930*, in *TRADEMARKS, BRANDS AND COMPETITIVENESS* (Teresa da Silva Lopes & Paul Duguid eds., 2009); Alexandra George, *Brand rules: When branding lore meets trade mark law*, 13 *J. BRAND MGMT.* (2006).

<sup>5</sup> For counterpublic academic agitation, see for example, Riché Richardson, *Can We Please, Finally, Get Rid of ‘Aunt Jemima?’* *N.Y. TIMES* (June 24, 2015), <https://www.nytimes.com/roomfordebate/2015/06/24/besides-the-confederate-flag-what-other-symbols-should-go/can-we-please-finally-get-rid-of-aunt-jemima> [<https://perma.cc/Z5R2-A94S>]; Samantha Kubota, *Aunt Jemima to remove image from packaging and rename brand*, *TODAY* (June 17, 2020, 7:04 AM), <https://www.today.com/food/aunt-jemima-remove-image-packaging-rename-brand-t184441> [<https://perma.cc/ZHZ2-ZNCC>]. Note how the company is very selective in its wording, conceding that Aunt Jemima is based on a “racial” (i.e., not racist) stereotype.

<sup>6</sup> Press Release, Caroline Sherman, *Uncle Ben’s Brand Evolution*, (June 17, 2020), <https://www.mars.com/news-and-stories/press-releases/uncle-bens-brand-evolution> [<https://perma.cc/Z4BB-75QY>]. While acknowledging its responsibility as a “global brand... to take a stand in helping put an end to racial bias and injustices” and the importance of listening to the “voices of consumers, especially the Black community”, Mars does not concede the brand’s unmistakable racist past but merely concedes “now is the right time to evolve Uncle Ben’s brand, including its visual brand identity”.

BUTTERWORTHS,<sup>7</sup> and CREAM OF WHEAT,<sup>8</sup> and those of Native American or Inuit Canadian alterity, evident in the LAND O LAKES,<sup>9</sup> ESKIMO PIE,<sup>10</sup> Washington REDSKINS,<sup>11</sup> Edmonton ESKIMOS,<sup>12</sup> and Cleveland INDIANS<sup>13</sup> trademarks were abandoned in quick

---

<sup>7</sup> Press Release, Conagra Inc., *Conagra Brands Announces Mrs. Butterworth's Brand Review*, CONAGRA BRAND NEWS RELEASE (June 17, 2020), [conagrabrands.com/news-room/news-conagra-brands-announces-mrs-butterworths-brand-review-prn-122733](https://conagrabrands.com/news-room/news-conagra-brands-announces-mrs-butterworths-brand-review-prn-122733) [https://perma.cc/QWT3-J4H9].

<sup>8</sup> Marie Fazio, *Cream of Wheat to Drop Black Chef From Packaging, Company Says*, N.Y. TIMES (Sep. 27, 2020), <https://www.nytimes.com/2020/09/27/business/cream-of-wheat-man.html> [https://perma.cc/5WNA-KK56].

<sup>9</sup> Christine Hauser, *Land O'Lakes Removes Native American Woman From Its Products*, N.Y. TIMES (Apr. 17, 2020), <https://www.nytimes.com/2020/04/17/business/land-o-lakes-butter.html> [https://perma.cc/BEW6-756R].

<sup>10</sup> Sophie Lewis, *Dreyer's to drop "derogatory" Eskimo Pie name after 99 years*, CBS NEWS (June 20, 2020, 12:39 PM), <https://www.cbsnews.com/news/dreyers-retires-derogatory-eskimo-pie-name-99-years/> [https://perma.cc/FB6T-S6JK]. In a rare example of corporate plain-speaking, Elizabell Marques, head of marketing, conceded that the company is “committed to being a part of the solution on racial equality, and recognize[s] the term is derogatory”.

<sup>11</sup> See *infra* Part V.

<sup>12</sup> Norma Dunning, *Edmonton finally drops the Eskimos — and may my grandchildren never hear the E-word again*, THE CONVERSATION (July 22, 2020, 10:11 AM), <https://theconversation.com/edmonton-finally-drops-the-eskimos-and-may-my-grandchildren-never-hear-the-e-word-again-143170> [https://perma.cc/V62Q-YTQM].

<sup>13</sup> The Cleveland team has transitioned away from the ‘Chief Wahoo’ insignia in recent years, removing this sign entirely from uniforms in 2019, and has since abandoned the name ‘Indian’. See Camila Domonoske, *Cleveland Indians Will Remove ‘Chief Wahoo’ From Uniforms In 2019*, NPR, (Jan. 29, 2018, 3:00 PM), <https://www.npr.org/sections/thetwo-way/2018/01/29/581590453/cleveland-indians-will-remove-chief-wahoo-from-uniforms-in-2019> [https://perma.cc/8LS7-TBBZ]; see also Vince Grzegorek, *Here's Paul Dolan's Letter on Ditching the Indians and the Future Name of the Cleveland Baseball Team*, CLEV. SCENE (Dec. 14, 2020),

succession. Similar battles were fought and won in the Antipodes against Allen's REDSKINS and CHICOS trademarks,<sup>14</sup> and COON<sup>15</sup> cheese, the latter's 'retirement' marking the culmination of a 20-year battle by Indigenous Australian social justice advocate Stephen Hagan.<sup>16</sup>

The decisive trigger for this long sought-after change, admittedly, had little to do with the finer points of trademark law. It had more to do with nervous owners of racist commercial symbols seeking to rid themselves of branding they now consider untenable in the wake of George Floyd's senseless custodial murder. The subsequent groundswell of grassroots civic engagement uniting under the BLM movement demanding racial justice, principally through social media agitation, raised awareness of (for those who were unaware) and generated widespread support to tackle racial prejudice in the U.S. and elsewhere.<sup>17</sup> It is

---

<https://www.clevescene.com/scene-and-heard/archives/2020/12/14/heres-paul-dolans-letter-to-cleveland-on-the-future-of-the-name-for-the-baseball-team> [<https://perma.cc/3S7E-9PWH>] (including the letter, in full, from Paul Dolan, part-owner and CEO of the team, to fans regarding the team's change).

<sup>14</sup> Pallavi Singhal, *Nestle to change names of Allen's Lollies products Red Skins and Chicos*, SYDNEY MORNING HERALD (June 23, 2020, 3:31 AM), <https://www.abc.net.au/news/2020-06-23/nestle-red-skins-chicos-allens-lollies-rebrand-overtone/12384986> [<https://perma.cc/Z6VB-BCFM>].

<sup>15</sup> Press Release, Saputo Dairy Australia, *COON Cheese Statement* (July 24, 2020), <https://www.saputodairyaustralia.com.au/en/our-company/newsroom/coon-cheese-statement> [<https://perma.cc/38YS-NL97>].

<sup>16</sup> Mackenzie Scott, *Activists Cheer New Cheese*, THE AUSTRALIAN, Jan. 14, 2021, at 3.

<sup>17</sup> See *About Black Lives Matter*, BLACK LIVES MATTER, <https://blacklivesmatter.com/about/> [<https://perma.cc/HH5U-KHHX>] (stating "We are a collective of liberators who believe in an inclusive and spacious movement. We also believe that in order to win and bring as many people with us along the way, we must move beyond the narrow nationalism that is all too prevalent in Black communities. We must ensure we are building a movement that brings all of us to the front").

somewhat remarkable that it took such a seismic event and its reverberating aftershocks around the world to coerce corporate boardrooms into retiring the contested racist commercial imagery that they had peddled for years.

Viewed against this background, stigmatizing trademarks and branding— commercial symbols that generally dehumanize, denigrate, and disparage Others<sup>18</sup> — are, irrespective of their ‘authorship’,<sup>19</sup> striking in their own embodiment and for provoking critical responses in equal measure. Stigmatizing trademarks not only perform traditional roles as badges of origin and private property, they also carry many other negative stereotyped messages and associations as part of their broader function as cultural resources trademarks.<sup>20</sup> Here, the limitations of classical

---

<sup>18</sup> Fady J. G. Aoun, *Whitewashing Australia’s History of Stigmatising Trademarks and Commercial Imagery*, 42 MELB. U. L. REV. 671, 672 (2019). The focus of this Article is on racist branding and racist stereotypes in trademarks. Racist and gendered trademarks targeting marginalized groups undoubtedly form the dominant subset of stigmatizing trademarks, but there may be instances where the group the subject of a stigmatizing trademark forms part of the dominant hegemony, see for example, @KRAZYKAREN, Serial No. 90069952 (for Class 25, clothing).

<sup>19</sup> Complexities abound when racist terms are self-appropriated, a relatively rare but growing subset of registered trademarks, see *infra* Part V.A. The dominant narrative, however, suggests that non-referenced groups own most racist marks, see *infra* Part V.

<sup>20</sup> On the various functions of trademarks generally, see, for example, Graeme W. Austin, *Trademarks and the Burdened Imagination*, 69 BROOK. L. REV. 827 (2004); Barton Beebe, *The Semiotic Analysis of Trademark Law*, 51 UCLA L. REV. 621 (2004); Robert C. Denicola, *Trademarks as Speech: Constitutional Implications of the Emerging Rationales for the Protection of Trade Symbols*, 1982 WIS. L. REV. 158 (1982); Thomas D. Drescher, *The Transformation and Evolution of Trademarks: From Signals to Symbols to Myth*, 82 TRADEMARK REP. 301 (1992); Rochelle Cooper Dreyfuss, *Expressive Genericity: Trademarks as Language in the Pepsi Generation*, 65 NOTRE DAME L. REV. 397 (1990); K. J. Greene, *Trademark Law and Racial Subordination: From Marketing of Stereotypes to Norms of Authorship*



economic theory, underpinning much of trademark law, are rendered obvious.<sup>21</sup> In the words of K.J. Greene, “trademarks that promote racial stereotypes, such as AUNT JEMIMA” may well “nicely reduce consumer search costs but [they] increase social costs of discrimination that result from negative stereotypes.”<sup>22</sup>

(Post)-colonial, feminist, and critical race theorists, along with sociologists, and communication theorists recognise that racist branding may also play a destructive role in constructing identity.<sup>23</sup> Although the main argument

---

*Symposium: Creators v. Consumers: The Rhetoric, Reality and Reformation of Intellectual Property Law and Policy*, 58 SYRACUSE L. REV. 431 (2007); Sonia K. Katyal, *Trademark Intersectionality* 57 UCLA L. REV. 1601 (2010); Dorean M. Koenig, *Joe Camel and the First Amendment: The Dark Side of Copyrighted and Trademark-Protected Icons*, 11 T.M. COOLEY L. REV. 803 (1994); Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U L. REV. 960 (1993); Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839 (2007); Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717 (1999). For Australian and New Zealand jurisprudence including those dealing with race/gender, see, for example, Jason Bosland, *The Culture of Trade Marks: An Alternative Cultural Theory Perspective*, 10 MEDIA & ARTS L. REV. 99 (2005); Aoun, *supra* note 18; Loughlan, *Campomar*, *supra* note 3; Rochelle Cooper Dreyfuss & Susy Frankel, *Trade Marks and Cultural Identity*, in *ACROSS INTELLECTUAL PROPERTY: ESSAYS IN HONOUR OF SAM RICKETSON* (Graeme W. Austin, et al. eds., 2020); Megan Richardson, *Trade Marks and Language* (2004) 26 SYDNEY L. REV. 193 (2004).

<sup>21</sup> See, e.g., William M. Landes & Richard A. Posner, *The Economics of Trademark Law*, 78 TRADEMARK REP. 267 (1988); cf. Jonathan Aldred, *The Economic Rationale of Trade Marks: An Economist’s Critique*, in *TRADE MARKS AND BRANDS: AN INTERDISCIPLINARY CRITIQUE* (Lionel Bently, et al. eds., 2008).

<sup>22</sup> Greene, *supra* note 20.

<sup>23</sup> There is, for example, a vast amount of literature on the use of stereotypical and dehumanizing portrayals of Native Americans in advertising, and the commensurate impact on the self-esteem of Native Americans, particularly Native American children. For a useful summary of the deleterious impacts and leading references, see

pressed in this Article does not rest on post-colonial, feminist, or critical race theory, these discourses provide valuable insights into deconstructing stigmatizing racial epithets and imagery and offer combative strategies to such imagery. Critical race theorists note, too, how the creation of racialized and stereotypical images or “signifying” constructs operate as “*modes of power* to control space, style and value”.<sup>24</sup> Such images and/or trademarks, often “crafted” by a dominant culture, can prove an “insidious political force, [misinforming] people”.<sup>25</sup> By reducing “people to a few simple, essential [and exaggerated] characteristics... fixed by Nature”, the “signifying practice” of racial stereotyping, writes Stuart Hall, serves a central role in racialized discourse, especially the construction of

---

AMERICAN PSYCHOLOGICAL ASSOCIATION, *Resolution Recommending the Immediate Retirement of American Indian Mascots, Symbols, Images, and Personalities by Schools, Colleges, Universities, Athletic Teams, and Organizations* (Sept., 2005), <https://www.apa.org/about/policy/mascots.pdf> [<https://perma.cc/9WN6-PVW3>]. More generally, see ERVING GOFFMAN, *GENDER ADVERTISEMENTS* (1979) (coining the phrase the “ritualization of subordination”); HOMI K. BHABHA, *THE LOCATION OF CULTURE* (1994); ANNE MCCLINTOCK, *IMPERIAL LEATHER: RACE, GENDER AND SEXUALITY IN THE COLONIAL CONQUEST* (1995); ROSEMARY J. COOMBE, *THE CULTURAL LIFE OF INTELLECTUAL PROPERTIES* (1998); ANTHONY JOSEPH CORTESE, *PROVOCATEUR: IMAGES OF WOMEN AND MINORITIES IN ADVERTISING* (1999); ANANDI RAMAMURTHY, *IMPERIAL PERSUADERS* (2003); RANDALL KENNEDY, N\*\*\*\*\* (2003) (censor added); PAMELA ODIH, *ADVERTISING IN MODERN AND POSTMODERN TIMES* (2007).

<sup>24</sup> C. Richard King & Charles Fruehling Springwood, *Introduction to TEAM SPIRITS 1, 7* (C. Richard King and Charles Fruehling Springwood eds., 2001) (emphasis altered). See also Dennis J. Banks, *Tribal Names and Mascots in Sports* 17 J. SPORTS & SOC. ISSUES 5 (1993); C. Richard King, *This is Not Indian*, 28 J. SO & SOC. ISSUES 3 (2004).

<sup>25</sup> Annette Jaimes, *Introduction: Weapons of Genocide*, in Ward Churchill, *FANTASIES OF THE MASTER RACE: LITERATURE, CINEMA AND THE COLONIZATION OF AMERICAN INDIANS*, as cited in Ellen J. Staurowsky, *Sockalexis and the Making of the Myth at the Core of Cleveland’s “Indian” Image*, in *TEAM SPIRITS*, *supra* note 24, at 88.

“Otherness” and in engendering exclusion.<sup>26</sup> Cultural anthropologist and eminent legal scholar Rosemary Coombe likewise argues that the proliferation of marginalized Others as commercial imagery has serious negative consequences. Indigenous peoples, she explains, who “find themselves represented as signs of alterity that are protected as properties within cultures of commerce... find their own voices inaudible in the public sphere”: in short, their “stereotyped representation is more visible than their social existence”.<sup>27</sup>

In this way, stigmatizing trademarks and associated commercial imagery have a similar effect that hate speech has on referenced groups,<sup>28</sup> especially in that it curbs their free speech and impinges on other civic rights they enjoy. In Habermasian terms, such marks — particularly when uncontested in liberal democracies — shrink the political public sphere for marginalized groups implicated by racist commercial symbols and diminish the broader public sphere’s democratic credentials. This is not to say anything of the lasting psychological damage, social exclusion, and indignity and disrespect suffered by marginalized groups.

---

<sup>26</sup> Stuart Hall, *The Spectacle of the Other*, in REPRESENTATION: CULTURAL REPRESENTATION AND SIGNIFYING PRACTICES 223, 257 (Stuart Hall ed., 1997). Racial stereotypes, or what Hall refers to as a “racialized regime of representation”, can be ambivalent and speak both to myth and perceptions of reality, see generally *id.* at ch. 4. On the “ambivalent power” of stereotypes, see especially BHABHA, *supra* note 23, at ch. 3.

<sup>27</sup> Coombe, *supra* note 23, at 288.

<sup>28</sup> See, e.g., Wojciech Sadurski, *On “Seeing Speech Through an Equality Lens”: A Critique of Egalitarian Arguments for Suppression of Hate Speech and Pornography*, 16 OXFORD J. LEGAL STUD. 713 (1996); HATE SPEECH AND FREEDOM OF SPEECH IN AUSTRALIA (Katherine Gelber & Adrienne Stone eds., 2007); KATHARINE GELBER, SPEAKING BACK: THE FREE SPEECH VERSUS HATE SPEECH DEBATE (2002); JEREMY WALDRON, THE HARM IN HATE SPEECH LAWS (2012). For a critical race perspective, see MARI MATSUDA ET AL., WORDS THAT WOUND (1993).

Drawing a link between aspects of Habermas’ work and trademark theory is not novel. Patricia Loughlan refers to (one of) Habermas’ core ideas of a civil society that is infiltrated (possibly corrupted) by commercial and consumerist interests.<sup>29</sup> She has argued that trademarks are “vectors”,<sup>30</sup> “drag[ing] values, associations and relations from one sphere into another”, and thus “contribut[ing] to the interpenetration of commerce and culture”.<sup>31</sup> Lauren Berlant challenges feted notions of “abstraction in the national public sphere” in light of the “surplus corporeality of racialized and gendered subjects”.<sup>32</sup> Rosemary Coombe, too, has used Habermasian ideas to critique stigmatizing marks. In referencing Native American struggles against “commercial imitations of their embodied alterity”, she observes that such stereotypical images “mark their continuing colonization in mass-mediated culture, *precluding full political engagement in the public sphere*”.<sup>33</sup>

Against the background of the welcome and timely intervention of the Black Lives Matter social justice movement, this Article contributes to the above scholarship

---

<sup>29</sup> See, e.g., Patricia Loughlan, *Trademarks: Arguments in a Continuing Contest*, 3 INTELL. PROP. Q. 294, 294–5 (2005) [hereinafter “Loughlan, *Trademarks*”]; Loughlan, *Campomar*, *supra* note 3, at 292.

<sup>30</sup> According to the Oxford English Dictionary, vector comes from the Latin *vehēre*, which means “to carry” and is defined in Medicine and Biology as a “person, animal, or plant which carries a pathogenic agent and acts as a potential source of infection for members of another species”, *Vector*, *Oxford English Dictionary*. Similarly, the *Macquarie Dictionary* defines a vector, in Biology, as “an insect or other organism transmitting germs or other agents of disease”, *Vector*, *Macquarie Dictionary*, <https://www.macquariedictionary.com.au/features/word/search/vector/> [https://perma.cc/S6KU-W2W7].

<sup>31</sup> Loughlan, *Trademarks*, *supra* note 29, at 295.

<sup>32</sup> Lauren Berlant, *National Brands/National Body*, in *THE PHANTOM PUBLIC SPHERE* 178 (Bruce Robbins ed., 1993). See Michael Warner, *The Mass Public and Mass Subject*, in *HABERMAS AND THE PUBLIC SPHERE* (Craig J. Calhoun ed., 1992).

<sup>33</sup> Coombe, *supra* note 23, at 198 (emphasis added) (citations omitted).

by exploring the problem of racist branding and trademarks through the lens of Habermasian discourse theory and, in particular, by documenting the struggles of Native Americans challenging their commodification and/or racial slurs in commercial symbols using the law and other means of resistance within this normative framework. This Article demonstrates that these normative and empirical harms, insofar as they affect Native Americans, are real, and advances the argument (without entering the vortex of ever-expanding First Amendment jurisprudence)<sup>34</sup> that contesting stigmatizing trademarks through the law and alternative combative strategies (such as through social media campaigns, shareholder activism, and consumer boycotts) is in the democratic public interest. The singular advantage of exploring relief through the law and its related administrative processes in removing registered racist marks from the register — *viz* through trademark cancellation proceedings — is that it engages the same system that made possible the state’s registration of racist marks in the first place, thus speaking to the law’s amenability towards embracing regenerative change. But for Native Americans, the emancipatory promise of *law* championed by Habermas’ discourse theory of democracy was found wanting, thus respite from oppressive commercial symbols had to be found elsewhere. Yet, paradoxically, similar arguments about counterpublic identity realization in deliberative democracies marshalled above in respect of *challenging* registered racist marks may be applied *mutatis mutandis* to

---

<sup>34</sup> See *Iancu v. Brunetti*, 139 S. Ct. 2294, 2302 (holding that the “immoral... or scandalous matter” clause in § 2(a) of the Lanham Act, codified at 15 U.S.C. § 1052(a), also violates the Free Speech Clause of the First Amendment). For a critical appraisal of the problems of applying First Amendment jurisprudence in the realm of trademark law, see especially Rebecca Tushnet, *The First Amendment Walks into a Bar: Trademark Registration and Free Speech*, 92 NOTRE DAME L. REV. 381 (2016).

minorities seeking to *register* stigmatizing marks they are seeking to “reclaim”, as contended in *Matal v. Tam* (*Tam*).<sup>35</sup> As we shall see, juxtapositions and paradoxes at the interface of race, law, and social justice are plentiful.<sup>36</sup>

Although there is no present need to revisit the findings in *Tam*,<sup>37</sup> a few points that frame my thinking are worth setting out. First, I find the warm embrace of the right to “hate” evident in Justice Alito’s judgment<sup>38</sup> most befuddling, and, as an outsider looking in, the expansion of First Amendment jurisprudence to U.S. trademark registration is to my mind regrettable.<sup>39</sup> In stark contrast to

---

<sup>35</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1765 (2017) (holding that the disparagement provision of the Lanham Act, codified at 15 U.S.C. § 1052(a), was unconstitutional on the grounds that it violated the Free Speech Clause of the First Amendment).

<sup>36</sup> Recall the well-known “This ... is Why” meme juxtaposing the suffering of George Floyd at the hands and knee of police officer Derek Chauvin with the former San Francisco QB Colin Kaepernick ‘taking a knee’ during the U.S. National Anthem, see LeBron James (@kingjames), INSTAGRAM (May 27, 2020), [https://www.instagram.com/p/CAq3fpCgyve/?utm\\_source=ig\\_embed](https://www.instagram.com/p/CAq3fpCgyve/?utm_source=ig_embed).

<sup>37</sup> For thorough analysis, see, for example, Mark Conrad, *Matal v. Tam - A Victory for the Slants, a Touchdown for the Redskins, but an Ambiguous Journey for the First Amendment and Trademark Law*, 36 CARDOZO ARTS & ENT. L.J. 83 (2018); Lisa P. Ramsey, *Free Speech Challenges to Trademark Law after Matal v. Tam Trademark Law: Institute for Intellectual Property & Information Law Symposium*, 56 HOUS. L. REV. 401 (2018).

<sup>38</sup> *Tam*, 137 S. Ct. at 1764 (2017) (observing that the government’s interest in preventing speech expressing ideas that offend... strike[s] at the very heart of the First Amendment). “Speech that demeans on the basis of race, ethnicity, gender, religion, age, disability, or any other similar ground is hateful; but the *proudest boast of our free speech jurisprudence is that we protect the freedom to express “the thought that we hate.”* *Id.* (citing *United States v. Schwimmer*, 279 U.S. 644, 655 (1929) (Holmes, J., dissenting)) (emphasis added).

<sup>39</sup> I am not alone in my thinking here, see Tushnet, *supra* note 34, at 382; Ilhyung Lee, *Tam through the Lens of Brunetti: The Slants, Fuct Essays*, 69 EMORY L.J. 2002, 2004–05 (2019); Dreyfuss & Frankel, *supra* note 20, at 31.

the U.S. position, analogous legislative provisions facilitating the denial of ‘offensive’ trademarks in many liberal democracies not ensnared by constitutionally entrenched free speech rights, such as in Australia,<sup>40</sup> New Zealand,<sup>41</sup> and the United Kingdom,<sup>42</sup> do not generate anywhere near as much angst as they do in the U.S. and are comfortably accommodated within longstanding international legal regimes.<sup>43</sup> In Australia, for example, the legislative restriction on registering “scandalous marks” (which nowadays would include obscene and racist marks) is most unlikely to enliven the “implied freedom of political communication” in connection to political and governmental matters.<sup>44</sup> And even if it does, this prohibition in the

---

<sup>40</sup> *Trade Marks Act 1995* (Cth) s 42 (Austl.).

<sup>41</sup> *Trade Marks Act 2002*, s 17 (N.Z.).

<sup>42</sup> *Trade Marks Act 1994*, s. 3 (UK).

<sup>43</sup> See, for example, the Paris Convention on the Protection of Industrial Property 1883 art 6(B)(3), opened for signature 14 July, 1967, 828 U.N.T.S. 305 (entered into force 26 Apr., 1970) [hereinafter “Paris Convention”], which denies the registration or permits the invalidation of trademarks “when they are contrary to morality or public order....”. See also Council Directive 2008/95, art. 3(1)(f), 2008 O.J. (L 299/25) (EC) [hereinafter “Trademark Directive”], and Council Regulation 207/2009, art. 7(1)(f), 2009 O.J. (L 78/1) (EC) [hereinafter “Community Trademarks Regulation”], the former of which is implemented in Trade Marks Act 1994, s. 3(3)(a) (UK) (stating “[a] trademark shall not be registered if it is: (a) contrary to public policy or to accepted principles of morality”). See also Marrakesh Agreement art. 15(2), opened for signature 15 Apr. 1994, 1867 U.N.T.S. 3 (entered into force 1 Jan., 1995) annex 1C [hereinafter “Agreement on Trade-Related Aspects of Intellectual Property Rights”], which, by virtue of art 2(1), incorporates the abovementioned provision of the Paris Convention. See further international instruments and the suggestion that the “custom in international law” is to adopt such prohibitions. Lisa P. Ramsey, *A Free Speech Right to Trademark Protection*, 106 TRADEMARK REP., 811–12 (2016).

<sup>44</sup> See generally *Nationwide News Pty Ltd v Wills* (1992) 177 CLR 1 (Austl.); *Australian Capital Television Pty Ltd v Commonwealth* (1992) 177 CLR 106 (Austl.); *Theophanous v Herald & Weekly Times Ltd* (1994) 182 CLR 104 (Austl.); *Stephens v West Australian Newspapers*

impugned legislation may well likely satisfy the proportionality and compatibility testing set out by the High Court of Australia.<sup>45</sup>

As for the debate on whether trademarks constitute ‘commercial speech’,<sup>46</sup> an Antipodean view eschews First Amendment jurisprudence entirely and might merely suggest that trademarks are primarily commercial symbols, functioning as private species of property with a public orientation and meeting the competing demands of traders, consumers, and the general public.<sup>47</sup> The same constellation of interests inheres in trademark registration systems, so that the state, too, is seen as performing an important regulatory function.<sup>48</sup> As such, registered trademarks are particularly vulnerable where larger public interests intrude.<sup>49</sup> There

---

*Ltd* (1994) 182 CLR 211 (Austl.); *Lange v Australian Broadcasting Corporation* (1997) 189 250; *Coleman v Power* (2004) CLR 1 (Austl.); *McCloy v NSW* (2015) 257 CLR 178 (Austl.); *Brown v Tasmania* (2017) 261 CLR 328 (Austl.).

<sup>45</sup> See, e.g., Meaghan Annett, *When Trademark Law Met Constitutional Law: How a Commercial Speech Theory Can Save the Lanham Act*, 61 B.C. L. REV. 253 (2020) (arguing trademarks should be treated as commercial speech).

<sup>46</sup> See *Brown v Tasmania* (2017) 261 CLR 328 (Austl.).

<sup>47</sup> See, e.g., Loughlan, *Campomar*, *supra* note 3; Sonia K. Katyal, *Brands Behaving Badly Commentary*, 109 TRADEMARK REP. 819, 827–28 (2019).

<sup>48</sup> For a detailed treatment on the functions of, and competing rationales for, trademark registration systems, see Robert Burrell & Michael Handler, *The Intersection between Registered and Unregistered Trade Marks*, 35 FED. L. REV. 375 (2007); Robert Burrell, *Trade Mark Bureaucracies*, in TRADE MARK LAW AND THEORY: A HANDBOOK OF CONTEMPORARY RESEARCH (Graeme B. Dinwoodie & Mark D. Janis eds., 2008); Rebecca Tushnet, *Registering Disagreement: Registration in Modern American Trademark Law*, 130 HARV. L. REV. 867 (2017).

<sup>49</sup> See *JT International v Commonwealth* (2012) 250 CLR 1 (Austl.) (holding by a majority of 6:1 that Australia’s tobacco plain packing legislation restricting the use of tobacco trademarks did not constitute acquisition of the company’s property). As to the vulnerability of registered trademark rights, see especially *Id.* at 42 [78] (Gummow, J.).



have even been suggestions in Australia that the registration of objectionable marks could bring scandal on the Registrar,<sup>50</sup> implicating “stakeholders and other interested parties potentially including foreign governments [who] will rightly hold the Registrar accountable for the state of the Register”.<sup>51</sup>

In the European law context, Lionel Bently and Brad Sherman have also found “freedom of expression” arguments unconvincing: “in our view, the implications for ‘free speech’ of refusal to register a trademark are negligible, and these considerations [are] irrelevant”.<sup>52</sup> In all these jurisdictions, the distinction between the right to *register* a mark and the right to *use* a mark carries weight, such that denying registration (and its benefits) does not necessarily mean denial of use, thereby mitigating any ‘free speech’ concerns. In this way, the free speech concerns in these jurisdictions are a furphy.

The second point I wish to make is that while I can understand Simon Tam’s claims that ‘THE SLANTS’ was chosen “to ‘reclaim’ the term and drain its denigrating force” as a derogatory term for Asian persons,<sup>53</sup> I remain unconvinced that reclamation required registration. In any event, the price paid was too high, and perhaps this betrays my greater sympathy with marginalized groups who have no choice in the adoption of commoditized slurs that reference them. Third, this Article is not an apologetic argument for

---

<sup>50</sup> *Peter Hanlon’s Application* [2011] ATMO 45, 15 [50] (Austl.).

<sup>51</sup> *Id.* ¶19. For an example of foreign government interjection with respect to an offensive mark, see the United Kingdom’s intervention in support of OHIM’s position refusing registration to PAKI. The United Kingdom’s argument here was unequivocal: PAKI is a racist and derogatory term and should be denied registration: see *PAKI Logistics GmbH v OHIM T-526/09* (E.C.R., 2011) (Eur.).

<sup>52</sup> LIONEL BENTLY & BRAD SHERMAN, *INTELLECTUAL PROPERTY LAW* 961 (4th ed., 2014), 961. But see *Constantin Film Produktion GmbH v EUIPO* (Case C-240/18 P) (CJEU, 2020) (Eur.), [56].

<sup>53</sup> *Tam*, 137 S. Ct. at 1751.

market forces regulating the public sphere with respect to racist and/or gendered trademarks. If the preservation of human dignity and respect is the test, then markets fail.<sup>54</sup> Even if we were to borrow the language of the market, market mechanisms have not addressed the devastating ‘negative externalities’ generated by stigmatizing trademarks and their contribution to the suffering of marginalized groups.<sup>55</sup> More to the point, the historical trademark register betrays serious instances of market failure insofar as protecting the interests of marginalized groups are concerned, notwithstanding their autochthonous resistance to stigmatizing commercial imagery. The steering mechanism of the capitalist market is profit, meaning racist trademarks proliferate if there is a viable market exploiting marginalized groups, which history has shown us occurs when marginalized group interests are ignored.

Another related point here is that the recent slate of trademark owners jettisoning their stigmatizing trademarks, while encouraging, should not be celebrated as being emblematic of effective market regulation and trader metanoia. Traders have been on notice about their troubling commercial signifiers for decades, but those signifiers’ ‘retirement’ occurred only because of the exogenous shock of the BLM movement and the concomitant unyielding

---

<sup>54</sup> For discussions covering *Matal v. Tam*’s influence on future trademark filings in the United States, see Timothy T. Hsieh, *The Hybrid Trademark and Free Speech Right Forged from Matal v Tam*, 7 N.Y.U. J. INTELL. PROP. & ENT. L 1 (2018); Jake MacKay, *Racist Trademarks and Consumer Activism: How the Market Takes Care of Business*, 42 L. & PSYCH. REV. 131 (2018); Tanya Behnam, *Battle of the Bank: Exploring the Unconstitutionality of Section 2(A) of the Lanham Act and the Fate of Disparaging, Scandalous, and Immoral Trademarks in a Consumer-Driven Market*, 38 LOY. L.A. ENT. L. REV. 1 (2017).

<sup>55</sup> See also Katyal, *supra* note 20, at 1621–30 (explaining the inability of trademark law in accommodating ‘social externalities’, including ‘moral’ and ‘cultural’ externalities, flowing from trademark’s expressive functions).

pressure, together with a multiplicity of invigorated counterpublics (including shareholder activists) forcing many trademark owners to release carefully worded mealy-mouthed statements<sup>56</sup> and/or engage in historical revisionism to defend their position.<sup>57</sup> Besides, the communicative impact and suffering caused by racist marks circulated in civil society is not easily erased.

A final, probably controversial point relates to the U.S. Supreme Court's insistence in *Tam* that trademarks are only private speech (not government speech), the implication being that the act of registration does not constitute an (implied) state-sanctioned imprimatur, or at least the *appearance* of a state-sanctioned imprimatur.<sup>58</sup> From the perspective of marginalized groups and the general public, technical lawyerly distinctions here may mean little. Faced with stigmatizing trademarks in their daily lives, marginalized groups may well view such trademarks, when registered, as a form of institutionalized prejudice where the

---

<sup>56</sup> Sherman, *supra* note 6. The statement does not concede its unequivocal racist past, but rather contends that after *listening* to the “voices of consumers, especially in the Black community, and to the voices of ... Associates worldwide”, “now is the right time to evolve the Uncle Ben’s Brand, including its visual brand identity”. *Id.*

<sup>57</sup> See, e.g., Conagra, *supra* note 7 (stating that the Mrs. Butterworth’s brand is “intended to evoke the images of a loving grandmother”, making no mention of the ‘mammy’ stereotype on which this commercial symbol is based. B & G Food similarly neglects to mention ‘Rastus’ and other racist tropes that dominated Cream Of Wheat advertisements before their original trademark was replaced by a photo of Frank L. White, see *infra* n.101–03 and accompanying text.

<sup>58</sup> See also Jasmine Abdel-khalik, *To Live In In-"Fame"-Y*, 25 CARDOZO ARTS & ENT. L.J. 173, 212 (2007); Anne Gilson LaLonde & Jerome Gilson, *Trademarks Laid Bare*, 101 TRADEMARK REP. 1476, 1485 (2011); Christine Haight Farley, *Registering Offense: The Prohibition of Slurs as Trademarks*, in DIVERSITY IN INTELLECTUAL PROPERTY: IDENTITIES, INTERESTS AND INTERSECTIONS 105, 125 (Irene Calboli & Srividhya Ragavan eds., 2015); Rebecca Tushnet, *supra* note 34, at 389–93.

state either directly or indirectly legitimizes harmful communicative messages.

The rest of this Article is organized into five parts. Part II sets out legislative prohibitions on registering what may broadly be termed ‘offensive’ marks in historical U.S., U.K., and Australian trademark registration statutes before delving into the historical trademark registers to document some of the many and varied racist tropes manifested as registered trademarks circulating in these nation states and frequently across the transpacific and transatlantic public sphere. This section documents both the stubborn persistence of these racist tropes in trademarks and associated branding, as well as the almost autochthonous resistance to such marks by affected marginalized (i.e., counterpublic) groups. Part III provides an overview of early Habermasian public sphere theory as presented in Jürgen Habermas’ earliest and most accessible work, *The Structural Transformation of the Public Sphere* (‘Structural Transformation’) and is intended mainly for those unfamiliar with his work.<sup>59</sup> Part IV outlines Habermas’ revised conception of the public sphere — as informed by Nancy Fraser’s classic critique<sup>60</sup> — which facilitates the accommodation of multiple, overlapping, and contestatory counterpublic spheres in a wider democratic framework.<sup>61</sup>

---

<sup>59</sup> JÜRGEN HABERMAS, THE STRUCTURAL TRANSFORMATION OF THE PUBLIC SPHERE (1989) [hereinafter “HABERMAS, *Structural Transformation*”].

<sup>60</sup> Nancy Fraser, *Rethinking the Public Sphere*, in HABERMAS AND THE PUBLIC SPHERE 109 (Craig Calhoun ed., 1992) [hereinafter “Fraser, *Rethinking the Public Sphere*”].

<sup>61</sup> See generally JÜRGEN HABERMAS, BETWEEN FACTS AND NORMS: CONTRIBUTIONS TO A DISCOURSE THEORY OF LAW AND DEMOCRACY (William Rehg trans., 1996) [hereinafter “HABERMAS, *Between Facts and Norms*”]. There have been important modifications to Habermas’ position since then that cannot be dealt with fully here, see especially, HABERMAS, *Europe*, *supra* note 1, at ch. 14; HUGH BAXTER, HABERMAS: THE DISCOURSE THEORY OF LAW AND DEMOCRACY ch. 9 (2011).

This section demonstrates that counterpublics — sites where marginalized groups in stratified societies can deliberate and generate effective counterdiscourses to the dominant paradigm — are the normative vehicles that may be employed both by Native Americans *against* the Washington REDSKINS trademarks and by Simon Tam in his reclamation crusade *for* the registration of the stigmatizing ‘THE SLANTS’ trademark. The next section, Part V, recounts the shortcomings of both the law and the market (and conceivably deliberative democratic models generally) in meeting the demands of Native Americans, either because levers then available within the law were not actuated and/or were later overwhelmed by proprietary and ‘free speech’ considerations. Again, from Simon Tam’s vantage point, the acceptance of his counterpublic protestations and the subsequent invalidation of the disparagement clause evidence that the law functioned as it should pursuant to the deliberative democratic model. By way of a further paradox, this section discusses how racist trademarks in the post-*Tam* era could have survived indefinitely, yet obstinate commercial considerations, which for so long had proven to be the driving force oppressing these marginalized groups, met their day of reckoning in the post-BLM fallout. With the wider public sphere woken from its slumber and demanding change, owners of valuable registered racist trademarks, such as the Washington REDSKINS,<sup>62</sup> were unceremoniously frog-marched into abandoning their marks, and in the end, this came with remarkably rapidity. The final section concludes.

---

<sup>62</sup> See, e.g., John Keim, *How the events of 2020 have changed the Washington Football Team*, ESPN (Aug. 21, 2020), [https://www.espn.com/nfl/story/\\_/id/29460299/how-events-2020-changed-washington-football-team](https://www.espn.com/nfl/story/_/id/29460299/how-events-2020-changed-washington-football-team) [<https://perma.cc/EE2Y-JR7L>].

## II. HISTORICAL TRADEMARK REGISTRATIONS AND RESISTANCE IN THE TRANSPACIFIC AND TRANSATLANTIC PUBLIC SPHERE

The similarities in early trademark law in the United States, the United Kingdom, and Australia are unsurprising given shared common law origins. The first *federal* trademark registration statutes in the U.S. and Australia even generated constitutional wrinkles that were ironed out respectively by the U.S. Supreme Court and the High Court of Australia.<sup>63</sup> More relevantly, formative legislative provisions in the U.S.,<sup>64</sup> U.K.,<sup>65</sup> and Australia<sup>66</sup> restricting

---

<sup>63</sup> In the United States, the Supreme Court invalidated the Act of 1870 on constitutional grounds, specifically, that the wrong head of constitutional power (Art. 1, § 8, cl. 8) was relied on to support its enactment, whereas the Commerce Clause ought to have been the source of legislative authority, see *In re Trade-mark Cases* 100 U.S. 82, 99 (1879). This was rectified by the Trademark Acts of 1881 and 1905 which relied on the Commerce Clause. In Australia, the High Court, by majority, found Pt. VII of the *Trade Marks Act 1905* (Cth) which facilitated the registration of so-called “worker marks” (also known as “white labour” marks) was beyond the constitutional power of Parliament and thus rendered invalid. Such marks were found not to fall within the concept of a trademark as this was then understood: *Attorney-General for NSW v Brewery Employees’ Union of NSW* (1908) 6 CLR 469 (Austl.) (also known as the “Union Label case”).

<sup>64</sup> Trademark Act of 1905, ch. 592, 33 Stat. 724, § 5.

<sup>65</sup> See e.g. *Trade Marks Registration Act 1875*, 38 & 39 Vict, c. 91, s 6 (UK). *But see Trade Marks Act 1994* s 3(3)(a) (UK) (applying a more general standard).

<sup>66</sup> For colonial statutes, see, for example, *Trade Marks Registration Act 1876* (Vic) 40 Vict, No 539 (Austl.), s 8. Identical provisions were later included in the trademark laws of other colonies, see, for example, *Patents, Designs and Trade Marks Act 1884* (Qld) 48 Vict, No 13, s 72 (Austl.); *Designs and Trade Marks Act 1884* (WA) 48 Vict, No 7, s 30 (Austl.); *Trade Marks Act 1892* (SA) 55 & 56 Vict, No 551, s 17 (Austl.); *Patents, Designs and Trade Marks Act 1893* (Tas) 57 Vict, No 6, s 81 (Austl.). For the first federal statute, see *Trade Marks Act 1905* (Cth), s 114 (stating “[n]o scandalous design, and no mark the use of which would by reason of its being likely to deceive or otherwise be deemed

the registration of ‘immoral’ or ‘scandalous’ trademarks employed remarkably similar form of words and passed into law with scant congressional<sup>67</sup> or parliamentary debate. (The passage of the *Lanham Act* also reveals little by way of legislative guidance regarding the ‘disparagement clause.’)<sup>68</sup> In Australia, some Members of Parliament merely viewed the restriction on registering ‘immoral’ or ‘scandalous’ as an indispensable element of the Australian trademark registration system.<sup>69</sup> Joseph Cook, for instance, praised this “very proper prohibition of any offence against morality — a prohibition which should, and no doubt does, find a place

---

disentitled to protection in a court of justice, or the use of which would be *contrary to law or morality*, shall be used or registered as a trademark or part of a trademark” (emphases added)). The ‘morality clause’ was subsequently removed following Dean Committee’s recommendation, see Commonwealth, *Report of the Committee Appointed by the Attorney-General of the Commonwealth to Consider What Alterations Are Desirable in the Trademarks Law of the Commonwealth* (Commonwealth Government Printer, 1954), 83 (Austl.). This change was reflected in the *Trade Marks Act 1955* (Cth), s 28 (Austl.). The prohibition on registering ‘scandalous’ matter is now contained in *Trade Marks Act 1995* (Cth), s 42 (Austl.).

<sup>67</sup> See e.g., Abdel-khalik, *supra* note 58, at 186. For an excellent treatment of the historical roots of this prohibition on scandalous and immoral matter in the US, see *id* at 186–95. Carpenter and Murphy have lamented the “dearth of information behind § 2(a)” and the resulting speculation as to its object, Megan M. Carpenter & Kathryn T. Murphy, *Calling Bullshit on the Lanham Act: The 2(a) Bar for Immoral, Scandalous, and Disparaging Marks Symposium: On Intellectual Property Law*, 49 U. LOUISVILLE L. REV. 465, 467–68 (2010). But see Chris Cochran, *It’s Fuct: The Demise of the Lanham Act*, 59 IDEA 333, 340 (2018) (describing this prohibition on registration as a “relic of another age” and its inclusion in the Lanham Act “an enigma”).

<sup>68</sup> Trademark Act of 1946, Pub. L. No.79-489, § 2(a), 60 Stat. 427, 428 (the “Lanham Act”), codified at 15 U.S.C. § 1052(a) (2012). See especially Jasmine Abdel-khalik, *Disparaging Trademarks: Who Matters*, 20 MICH. J. RACE & L. 287, 298–301 (2014).

<sup>69</sup> Commonwealth, *Parliamentary Debates*, House of Representatives, 28 Nov. 1905, 5894 (Joseph Cook) (Austl.).

in every Trademarks Bill.”<sup>70</sup> In essence, the legislature appears to have taken as given its right to maintain the integrity of the register, and this, as was applied, largely meant anything that was considered ‘indecent’ or offensive to Anglo-Australian and Anglo-American Judeo-Christian sensibilities.<sup>71</sup>

The similarities across these jurisdictions do not end there.<sup>72</sup> In all three of these jurisdictions, racist trademarks commoditizing the Other found their way onto the trademark registers. No ethnic minority was spared. Traders operating in international markets secured, often through colonial agents, registration of their favored racist commercial symbol across multiple jurisdictions.<sup>73</sup> These historical vignettes offer a view to the racial degradation and

---

<sup>70</sup> *Id.* See also Commonwealth, *Parliamentary Debates*, House of Representatives, 14 Nov. 1905, 5090 (Dugald Thomson) (Austl.).

<sup>71</sup> For Australian law and practice, see, for example, ROBERT BURRELL & MICHAEL HANDLER, *AUSTRALIAN TRADE MARK LAW* 164–69 (2nd ed., 2016), MARK DAVISON & IAN HORAK, *SHANAHAN’S AUSTRALIAN LAW OF TRADE MARKS & PASSING OFF* 249–50 (Lawbook, 6th ed., 2016); DAVID PRICE ET AL., *INTELLECTUAL PROPERTY: COMMENTARY AND MATERIALS* 671–75 (Lawbook, 6th ed., 2017). For the U.K., see, for example, BENTLY & SHERMAN, *supra* note 52, at 961–62.

<sup>72</sup> See also early statutes criminalizing false marking, for example, *Merchandise Marks Act 1862*, 25 & 26 Vict c. 88 (UK).

<sup>73</sup> See e.g., BRIAN D. BEHNKEN & GREGORY D. SMITHERS, *RACISM IN AMERICAN POPULAR MEDIA: FROM AUNT JEMIMA TO THE FRITO BANDITO* 26–27 (describing N.K. Fairbank’s so called ‘Gold Dust’ twins trademark which was a remarkable commercial success). This device mark was registered in the U.S., U.K., and Australia, reproduced and discussed in Aoun, *supra* note 18, at 687–90. For the U.S. representation of this device mark, see Registration No. 30,219. The N.K. Fairbank Company, Chicago, IL; St. Louis, MO; New York, NY; and Montreal, Canada, filed this application on April 29, 1897, for detergents or washing powders, claiming usage since June 5, 1887. The essential feature is described as a “representation of the head and bodies of two negro children”. N.K. Fairbank also applied for and secured registration of the GOLD DUST word mark in the same volume, see GOLD DUST, Registration No. 330,115.



subordination of the Other and the excesses of global capitalism and its commensurate impact on human dignity. That these registered racist trademarks illustrate extraordinary conformity in racist tropes, as well as unique hybridity and inventive amalgamations of racist tropes, is, for anyone invested in racial and social justice, both startling and sobering.

**A. *Racist Trademark Registrations in the Anglo-American and Anglo-Australian Public Sphere***

Having spent hundreds of hours poring over Australian, U.S., U.K. trademark registers and historical advertisements, one cannot help but be shocked by the proliferation and pervasiveness of racist tropes that come to life in trademarks and branding. Native Americans were by far the most commoditized Other, followed by Black people, and other ‘Othered’ people. Reflecting the then (obvious) structural racism in the law and market economy, racist trademarks sullied the first trademark registers across all these jurisdictions and intensified both in frequency and crassness in the late nineteenth and early twentieth centuries. Such racist trademark registrations existed before and after legislative prohibitions on registering ‘scandalous’, ‘immoral’ or later ‘disparaging’ marks.<sup>74</sup> Evidently, the registration of racist marks were not then considered ‘immoral’, ‘scandalous’, or ‘disparaging’, with commercial immorality here targeting unscrupulous business practices and trademarks irreligiously referencing Judeo-Christian

---

<sup>74</sup> Disparaging trademarks still made it onto the register, but they diminished in number as the law and market began slowly to respond to its surrounds. *But see* In re Mavety Media Group Ltd., 33 F.3d 1367 (Fed. Cir. 1994) (facilitating the registration of BLACK TAIL, Registration No. 2,376,322, arguably a disparaging double commodification of Blackness and female form).

matter. The market, like the law, was similarly slow in responding to oppositional voices challenging racist branding and trademarks.

Limitations of space (and considerations of decency) prevent me from going into detail as to the extensiveness of horrible dehumanizing and derogatory representations of the Other that secured trademark registration or floated freely in the public sphere, so my discussion can only be limited to a few popular racist tropes. Contextualizing some of these racist trademarks in their socio-cultural historical milieu further illuminates why certain tropes were more common in certain jurisdictions. Settler-colonialism, for instance, obviously played a significant role in presenting traders with nuanced racist tropes referencing Indigenous people in settler-colonial states, such as Indigenous Australians in Australia and Native Americans in the United States. Of course, there were considerable cross-cultural borrowings, especially when it came to the stigmatizing of Africans,<sup>75</sup> Asians,<sup>76</sup> Mexicans,<sup>77</sup> Turks<sup>78</sup> and so on.

With respect to the representation of Black people, there is no doubt that the transatlantic slave trade had a telling impact in sustaining continued notions of supposed Black inferiority and subservience, whether that was part of

---

<sup>75</sup> See *infra* Part II.A.

<sup>76</sup> See, for example, BLINK, Trademark No. 248,431 as shown in 27 G.B. TRADE MARKS J. 1347–48 (1902) (UK).

<sup>77</sup> See, e.g., Trademark No. 22,851. The application was by The United States Graphite Company, Saginaw, MI, filed on March 1, 1893 for Plumbago Axle-Grease, as described in 63 OFF. GAZ. PAT. OFFICE. (1893) (claiming use since January 1, 1893). The essential feature of the mark is described as “the bust picture of a Mexican wearing a sombrero and the word ‘MEXICAN’”. *Id.* (on file with author).

<sup>78</sup> See, e.g., Trademark No. 28,270. The application was by Augustus Tshinkel Söhne, Prague, Austria-Hungary, filed on August 31, 1895 for coffee substitute, as described in 75 OFF. GAZ. PAT. OFFICE. (Apr.-June 1896) (claiming use since August 28, 1890) (on file with author).

the British imperial project or American plantation slavery.<sup>79</sup> Through their experiences of colonialism and exploitation of New World countries, and the earlier appalling treatment of Black people via slavery, British traders with state imprimatur and support by pseudo-scientific racist theories,<sup>80</sup> later constructed often contradictory stereotypes of Black people as lazy, obedient or bumbling servants, heathens, hypersexualized, bestial, noble savages, minstrels, childlike, uncivilized and unclean peoples requiring Western enlightenment.<sup>81</sup> In a similar way, American traders also invoked these and other tropes such as ‘beasts of burden’<sup>82</sup> in their subjugation strategies, particularly in the ‘Jim Crow’ era.<sup>83</sup> These damaging racist stereotypes carried over into commercial imagery and are all reflected in trademark registrations across the Anglo-Australian and Anglo-American public sphere, especially during the late nineteenth and early twentieth century. What is more, modern manifestations of these racist tropes ought not be

---

<sup>79</sup> See, e.g., Trademark No. 28,228; Trademark No. 20,229. The applications were by James Wilson Difenderfer, Philadelphia, PA, filed on September 3, 1891 for carpet chain and carpet warp, as described in 57 OFF. GAZ. PAT. OFFICE. (Oct. 1891) (claiming use since January 1, 1887). The marks describe scenes from plantation slavery. *Id.* (on file with author).

<sup>80</sup> For an excellent treatment of this subject, see NANCY STEPAN, *THE IDEA OF RACE IN SCIENCE* (1982).

<sup>81</sup> For an interesting treatment of all these stereotypes in Western culture, see especially JAN NEDERVEEN PIETERSE, *WHITE ON BLACK* (1992); J. Stanley Lemons, *Black Stereotypes as Reflected in Popular Culture, 1880-1920*, 29 AM. Q. (1977). For the classic discussion of the stereotypes of Black personality, see GEORGE M FREDRICKSON, *THE BLACK IMAGE IN THE WHITE MIND* (1971).

<sup>82</sup> See, for example, the 1921 Cream of Wheat advertisement reproduced in JASON CHAMBERS, *MADISON AVENUE AND THE COLOR LINE* 7 (2008).

<sup>83</sup> For a sobering collection of racist stereotypes in the U.S., see Popular and Pervasive Stereotypes of African Americans, SMITHSONIAN NAT’L MUSEUM AFRICAN AM. HIST. & CULTURE, <https://nmaahc.si.edu/blog-post/popular-and-pervasive-stereotypes-african-americans> [<https://perma.cc/6CLE-AJ4Q>].

viewed as mere aberrations, but rather as disjointed vignettes drawn from a deeply entrenched racist history, of which the trademark register played its part.



FIGURE 1: MASON'S CHALLENGE MARK (1894)<sup>84</sup>

The Black other as ‘ape’ or ‘monkey’<sup>85</sup> is one common vulgar trope that regrettably resurfaces regularly in Australia and the United States.<sup>86</sup> A different widespread

---

<sup>84</sup> Registration No. 23,993. James. S. Mason Company, Philadelphia, PA applied to file this device mark for shoe blacking, as described in 66 OFF. GAZ. PAT. OFFICE. (Jan.-Feb. 1894) (claiming usage since 1843). The essential feature of the mark is described as follows: “the word ‘CHALLENGE’ in connection with the words ‘MASON BLACKING’, and the representation of a dancing negro, having a boot on one arm, and a brush in the hand of the other arm. A large polished boot occupies the middle of the picture, in which appears the reflection of a dog’s head, while near the boot the dog is shown, as in the attitude of fright and in the endeavor to escape. A lad stands near the boot with one hand pointing to the reflection in the boot”. *Id.* Registration was later granted. *See* 67 OFF. GAZ. PAT. OFFICE. 14 (Apr. 1894).

<sup>85</sup> For an Australian example, see LUBRA boot polish device mark, discussed and reproduced in Aoun, *supra* note 18, at 702–04.

<sup>86</sup> *See, e.g.,* Brent Staples, *The Racist Trope That Won’t Die*, N.Y. TIMES (June 17, 2018), <https://www.nytimes.com/2018/06/17/opinion/roseanne-racism-blacks-apes.html> [https://perma.cc/3YUN-7GEF];

trope invoked Black skin color in extolling the colorfastness of blacking products, paint or stockings,<sup>87</sup> and often referenced actual Africans<sup>88</sup> and caricatured children, such as the ‘BLACK KID’<sup>89</sup> or ‘WE NEVER CHANGE COLOUR’<sup>90</sup> device marks. Many of these trademarks experienced significant longevity. For instance, we know that the dancing minstrel device mark depicted in **Figure 1** above circulated in the public sphere and market economy for 50 years *before* the trader sought trademark registration.

---

Tracey Holmes, *Collingwood Football Club is guilty of systemic racism, review finds*, ABC NEWS (Jan. 1, 2021, 3:31 AM), <https://www.abc.net.au/news/2021-02-01/collingwood-is-guilty-of-systemic-racism-review-finds/13055816> [https://perma.cc/LW6X-YTT7].

<sup>87</sup> See, for example, the ‘COON BLACK’ device mark, Trademark No. 20,314. Lindekes, Warner & Schurmeier, St. Paul, MN filed this application on October 8, 1891 for stockings, as described in 57 OFF. GAZ. PAT. OFFICE. (Nov. 1891) (claiming use since July 1, 1885). The mark is described as the “representation of the head of a negro, appearing in profile, with the words ‘COON BLACK’, the whole executed in lines and letters of white upon a black ground”. *Id.* (on file with author).

<sup>88</sup> See, e.g., NUBIAN, Registration No. 15,889 (UK) (described as “for Blacking” in 4 G.B. TRADE MARKS J. 143 (1879)). See also Registration No. 1,211 (Austl.) (described in 2 NSW TRADE MARKS REG. (July–Aug. 1885)); ETHIOPIAN MARKING INK, Registration No. 54,253 (UK) (described in 11 G.B. TRADE MARKS J. 887–88 (1886)).

<sup>89</sup> Trademark No. 37,291. Iowa Knitting Company, Des Moines, IA, filed this application on September 21, 1901 for gentlemen’s socks and ladies, misses’ and children’s stockings, as described in 97 OFF. GAZ. PAT. OFFICE (Nov. 1901) (claiming use since May 1, 1901). The essential feature describes the mark as a “pictorial representation of a negro infant holding in *its* outstretched hand’s a lady’s stocking darker in color than the infant and the words ‘Black Kid’”. *Id.* (emphasis added) (on file with author).

<sup>90</sup> Trademark No. 257,628 (UK); Trademark No. 257,629 (UK). J.T. Brown & Com., 11 & 19 Queen Street, Glasgow, applied for the marks in Classes 31 (Silk Piece Goods) and 34 (Cloths and Stuffs of Wool, Worsted, or Hair), respectively, as described in 28 G.B. TRADE MARKS J. 1363 (1903) (on file with author).

Another unforgettable representation of imperialist ideology — further underscoring the points made above — are a series of ‘first contact’ or ‘wonderment’ marks, where commoditized ‘dumfounded’ Others express alarm or wonderment at their first exposure to Western commodities. Such trademarks entrench racist stereotypes of supposed Black backwardness. The NEGROLINE mark (**Figure 2** below) deserves some attention because not only does it reflect the contemptuous disrespect shown to Black people, it shows that ambitious traders developed their racist marks over time and took their branding strategy seriously, regularly seeking registrations in different national trademark registration systems. It also indicates that the propagation of stigmatizing trademarks between the United Kingdom and Australia was not unidirectional. After applying to register the *word* mark ELECTRIC NEGROLINE in the colonies of NSW<sup>91</sup> and Tasmania,<sup>92</sup> Australian chemist Charles Cameron Forster then registered the ELECTRIC NEGROLINE *device* mark under the colonial Victorian trademarks regime,<sup>93</sup> and before securing registration of this mark in the United Kingdom.<sup>94</sup>

---

<sup>91</sup> Registration No. 845 (Austl.). CC Forster applied to register this mark on 20 April 1883 in Class 50 (Composition for polishing, softening and preserving leather), see 2 NSW TRADE MARKS REG. (June 1879–July 1883) (on file with author).

<sup>92</sup> Registration No. 125 (Austl.). CC Forster, of Stanwell, Colony of Victoria applied to register this mark on 26 April 1883 in Class 50 (Composition for polishing, softening and preserving leather), see 2 TAS. TRADE MARKS REG. (1883–1886) (on file with author).

<sup>93</sup> Registration No. 707 (Austl.). CC Forster, of Stanwell, Colony of Victoria applied to register this mark on 29 April 1883 in Class 50 (Composition for polishing, softening and preserving leather), see 2 VICT. TRADE MARKS J. 240-41 (1881–1883).

<sup>94</sup> Registration No. 32,780 (UK). For the advertisement of the UK application and subsequent registration, see 8 G.B. TRADE MARKS J. 446 (1883).



**FIGURE 2:** ELECTRIC NEGROLINE DEVICE MARK (1880s) (AUS) (UK)

One more common bigoted trope prevalent in the transatlantic and transpacific public sphere involved juxtaposing Blackness/Whiteness for soaps, detergents, cleansing products with Indigenous Australians, Africans and Black Others regularly referenced in stigmatizing imagery. Not only did they reflect and reinforce supposed racial hierarchies, but they appear also to have exploited the then-common idea among the dominant hegemony of supposed Black dirtiness, sub-humanity, subservience, and incivility. Such imagery, whether in the form of racist branding or registered device marks, was often coupled with advertising tag lines that lauded the supposedly incredible ‘cleansing’ powers of the vendor’s goods and spoke to soap’s ‘civilizing or imperialist mission’.<sup>95</sup>

---

<sup>95</sup> See MCCLINTOCK, *supra* note 23; ODIH, *supra* note 233; Stuart Hall, *The Spectacle of the Other*, in REPRESENTATION: CULTURAL REPRESENTATIONS AND SIGNIFYING PRACTICES, 223, 241 (Stuart Hall ed., 1997) (explaining that “[s]oap symbolized this ‘racializing’ of the domestic world and the ‘domestication’ of the colonial world”).



FIGURE 3: LAUTZ BRO’S & CO’S TRADE CARD (C. LATE 19<sup>TH</sup> CENTURY)<sup>96</sup>

In one example, Lautz Bros and Co’s trade card in **Figure 3** above with the tag line “BEAT THAT IF YOU CAN” evidently speaks to the imagined efficacy of the vendor’s soap in washing Blackness/Dirtiness ‘clean’.<sup>97</sup> As I have discussed elsewhere, the pervasiveness of this trope meant that merchants often quarreled over the registrability of Black imagery framed by traditional trademark principles, such as preventing consumer confusion and invoking property-based arguments.<sup>98</sup> The point here is that traders

<sup>96</sup> Lautz Bro’s and Co.’s Soaps, Buffalo, NY, cropped image of original trade card (on file with author).

<sup>97</sup> For other examples in the U.K., see various iterations of Pears’ *Transparent Soap*, in JOHN JOHNSON ARCHIVE OF PRINTED EPHEMERA, <http://johnjohnson.chadwyck.co.uk/home.do> [<https://perma.cc/X9UM-P4WA>]; DIANA HINDLEY & GEOFFREY HINDLEY, ADVERTISING IN VICTORIAN ENGLAND, 1827-1901, Figure 6.3 (1972); LEONARD DE VRIES, VICTORIAN ADVERTISEMENTS 25 (1968); MCCLINTOCK, *supra* note 23, at 213. For Australia, see Velvet Soap advertisements and Kitchen & Son’s trademarks discussed in Aoun, *supra* note 18, at 697, 724.

<sup>98</sup> See *Re Beal’s Trade Mark Application No. 9129*, Aug. 4 1905 (Aus)(discussing a trademark dispute between two Victorian colonial traders over competing claims to racist anti-Black imagery in their soap products ‘Darkey Brand’ and ‘Scrubbo’ Soap), see also Fady Aoun, *The*



considered racist stereotypes embodied in trademarks valuable and moved quickly to defend their financial interests all within the legal and administrative frameworks established by the state.

Popular culture offered additional fertile grounds from which racist stereotypes could be drawn, transformed, and pressed into further semiotic service as trademarks and associated commercial branding. Joel Chandler Harris' first *Uncle Remus* (1881) novel, for instance, introduced the character 'Brer Rastus', which then gave rise to the stereotypically joyful black man, considered a variation of the SAMBO trope.<sup>99</sup> It was not uncommon for two or more racist tropes to morph into registered trademarks and commercial advertising, such as in **Figure 4** below, where the Rastus caricature is fused with the bigoted watermelon trope.<sup>100</sup> The 'Rastus' caricature, it must not also be forgotten, was also the first 'mascot' chef utilized by the Cream of Wheat company. Having secured trademark registration over the Cream of Wheat word mark<sup>101</sup> and 'original Rastus' chef device mark,<sup>102</sup> this trader, like many

---

*Battle to Own Racist Trade Marks and Commercial Imagery in Colonial Australia*, (Working Paper, 2020).

<sup>99</sup> See, e.g., PIETERSE, *supra* note 81, at 153.

<sup>100</sup> See, e.g., William R. Black, *How Watermelons Became a Racist Trope*, ATLANTIC (Dec. 8, 2014), <https://www.theatlantic.com/national/archive/2014/12/how-watermelons-became-a-racist-trope/383529/> [<https://perma.cc/U4LP-WC85>].

<sup>101</sup> CREAM OF WHEAT, Registration No. 30,943. Cream of Wheat Company, Minneapolis, MN applied to register the CREAM OF WHEAT word mark on May 18, 1897 for Breakfast food, as described in 85 OFF. GAZ. PAT. OFFICE (Dec. 1897) (claiming usage since March 1, 1895).

<sup>102</sup> Registration No. 34,067. Cream of Wheat Company, Minneapolis, MN applied to register this mark on December 9, 1899 for breakfast food, as described in 90 OFF. GAZ. PAT. OFFICE (Jan. 1900) (claiming usage since March 1, 1895). The essential feature is described as a 'half-length representation of a negro cook or chef dressed in a white coat and cap and the words "CREAM OF WHEAT"'. *Id.* (on file with author).

contemporaries, exploited contrived minstrel dialect and the watermelon trope in its early twentieth century advertisements.<sup>103</sup>



FIGURE 4: RASTUS TRADEMARK (1928) (US)<sup>104</sup>

By way of another example of popular culture influencing racist commercial trade practices, think through how Harriet Beecher Stowe's bestselling nineteenth century anti-slavery novel, *Uncle Tom's Cabin* (1852), popularized and further entrenched many stereotypes of Black people. Many of its characters later found their way into trademark registers across the world and became the subject of commercial rivalries, sometimes mediated by trademark bureaucrats. For example, one colonial trader's application to register the 'TOPSY' device mark (**Figure 5** below), itself

---

<sup>103</sup> See Dan Anderson, *Cream of Wheat*, FOOD TELLS A STORY (Feb. 10, 2017), <https://foodtellsastory.wordpress.com/2017/02/10/cream-of-wheat-1/> [<https://perma.cc/UN9M-D5JV>] (including an advertising poster where an objectified African American boy chooses to eat Cream of Wheat over a watermelon). Various 'origin' stories of Rastus exist. See, e.g., SCOTT BRUCE & BILL CRAWFORD, *CEREALIZING AMERICA* 69–71 (1995); MARILYN KERN-FOXWORTH, *AUNT JEMIMA, UNCLE BEN AND RASTUS*, 45–46 (1994); HAL MORGAN, *SYMBOLS OF AMERICA* 131 (1986).

<sup>104</sup> Kramer & Barcus, Leesburg, FL. filed this application on June 6, 1928, for Class 46 (for fresh watermelons), Serial No. 267,560, see 372 OFF. GAZ. PAT. OFFICE (July 1928) (claiming usage since May 5, 1927). The mark secured registration as Trademark No. 247,972, see 375 OFF. GAZ. PAT. OFFICE (Oct. 1928).

a literal cutout of American trader's 'TOPSY' trademark,<sup>105</sup> was refused due to another colonial Australian trader earlier securing rights to a more elaborate 'TOPSY' device mark.<sup>106</sup>



**FIGURE 5:** TOPSY TRADEMARK (1892) (NSW)<sup>107</sup>

---

<sup>105</sup> Registration No. 24,877. William P. Ward, NY, filed this application on May 4, 1892, for cigarettes, as described in 67 OFF. GAZ. PAT. OFFICE (Apr.–June 1894) (claiming use since March 1, 1892) (on file with author). The U.S. registration depicted here is in greyscale. *Id.* See also Registration No. 28,475. This is the running TOPSY device mark applied for by Wellman & Dwire Tobacco Company, Quincy, IL, filed June 2, 1896, as described in 75 OFF. GAZ. PAT. OFFICE (Apr.–June 1896) (claiming usage since December 1878). Wellman & Dwire Tobacco Company also registered the UNCLE TOM'S CABIN device mark, Registration No. 28,474, as depicted in 75 OFF. GAZ. PAT. OFFICE (Apr.–June 1896).

<sup>106</sup> Registration No. 2,132 (Austl.). Heyde Todman & Co of York St, Sydney, NSW applied to register this mark described as including “the principal figure of a representation of a negro girl dancing and playing a banjo” on 11 April 1888 in class 45 (tobacco), as shown in 4 NSW TRADE MARKS REG. (Oct. 1887–Dec. 1888). A handwritten notation evidences that this registered mark was later transferred to W.D. and H.O Wills (Australia) Ltd. *Id.* (on file with author).

<sup>107</sup> Trademark No. 3,753 (Austl.) Richards & Ward Ltd, of 46, Holborn, Viaduct, London, England, applied to register this mark described as including “A label bearing in the centre the representation of a negro girl wearing a red pocket-handkerchief on her head” on 11 July 1892 in Class 45 (tobacco), as described in 7 NSW TRADE MARKS REG. (Aug. 1891–

Topsy, the young, enslaved girl representing the ‘pickaninny’ stereotype, the titular character Uncle Tom, and other stock characters such as Sambo and Mammy, were all registered as trademarks in the U.S., U.K., and Australia. One version of the Mammy stereotype — i.e. the supposedly faithful, contented, self-sacrificing enslaved person attending to the domestic and needs of white masters and their children — proved an immensely popular trope to incorporate into consumer goods. The prevalence of the faithful slave narrative (whether via Uncle, Mammy, or Aunt stereotypes) grew in the antebellum era, offering a ‘reassuring aura’<sup>108</sup> to (white) audiences and functioning as “cornerstone of paternalistic defenses to slavery and ... patterns of domesticity”.<sup>109</sup>

While much ink has been spilled on the most (in)famous and commercially successful mammy trademark, AUNT JEMIMA,<sup>110</sup> ‘her’ various iterations,<sup>111</sup> and the actor, former enslaved person Nancy Green playing ‘Aunt Jemima’, it is worth emphasizing that the mammy trope-*cum* trademark was everywhere in the late nineteenth century and early twentieth century, even making its way onto U.K.<sup>112</sup> In

---

Sep. 1892). A handwritten annotation underlines the prohibition in the Government gazette denying trademark registration where “such Trade-Mark is so like some other Trade-Mark”, here referencing Trade Mark Registration No. 2,132 (on file with author). But this trader registered this mark in other Australian colonies, see, for example, Registration No. 1,115 (Austl.), as depicted in 2 QLD TRADE MARKS REG. (Nov. 1891–June 1896).

<sup>108</sup> See PIETERSE, *supra* note 81, at 155.

<sup>109</sup> See MICKI MCELYA, CLINGING TO MAMMY: THE FAITHFUL SLAVE IN TWENTIETH-CENTURY AMERICA 7 (2007).

<sup>110</sup> See *generally id.*; KERN-FOXWORTH, *supra* note 103.

<sup>111</sup> See HAL MORGAN, SYMBOLS OF AMERICA, 55 (Penguin Books 1986).

<sup>112</sup> For an illustration of this racist stereotype, see Liverpudlian Ross & Son’s registration of the MAMMY BRAND mark for Class 43 (Fermented liquors and spirits), Registration No. 516,872, as described in 55 G.B. TRADE MARKS J. 1708, 2031 (1930) (on file with author).

the US, for example, there were MAMMY'S PRIDE,<sup>113</sup> AUNT LENA,<sup>114</sup> and various AUNT DINAH trademarks, the latter, such as depicted in **Figure 6** below, possibly referencing the Dinah the Cook mammy figure in the *Bobbsey Twin* novel series. As if to underscore the connection between plantation goods and slavery, and perhaps speak to the 'authenticity' of their product, yet another trader's AUNT DINAH<sup>115</sup> device mark was applied to molasses.



**FIGURE 6:** DINAH COOK TRADEMARK (1928)<sup>116</sup>

---

<sup>113</sup> The Light Grain & Milling Co, Liberal, Kansa applied to register this word mark on April 30, 1929 for wheat flour, Serial No. 283,285, as described in 383 OFF. GAZ. PAT. OFFICE (June 1929) (claiming use since April 16, 1929) (on file with author).

<sup>114</sup> Cornelius A. Levy, trading as Lord Baltimore Baked Ham Company, Baltimore, MD, filed to register the minstrel AUNT LENA device mark on May 1, 1928 for ham spread, Serial No. 265,976, as described in 371 OFF. GAZ. PAT. OFFICE (June 1928) (claiming use since March 1, 1928) (on file with author).

<sup>115</sup> Penick & Ford, Ltd, New York, NY, filed to register the mammy figure on August 2, 1928 for molasses, Serial No. 270,500, as described in 374 OFF. GAZ. PAT. OFFICE (Sep. 1928) (claiming use since February, 1907) (on file with author). From the related mark, Serial No. 270,199, filed on July 26, 1928, we learn the mammy's name is Aunt Dinah.

<sup>116</sup> Western Chair Company, Boston, MA applied to file this device mark on December 27, 1928 for breakfast sets and tea-room furniture, Serial No. 277,260, as described in 379 OFF. GAZ. PAT. OFFICE (Feb. 1929) (claiming use since September 17, 1927) (on file with author).

Going far beyond selling consumer wares, these representations of Black Others—whether in collectible figurines,<sup>117</sup> trademarks, and/or associated branding—had a degrading and deleterious impact on African Americans and intensified and propagate racist ideologies. As Micki McElya puts it, the sheer pervasiveness of these products meant that they:

[I]nfiltrated the intimate spaces of people’s daily lives and reinforced ideas of white supremacy and black servility as much as they sold products. They represented an early twentieth century commodity culture that promoted the faithful slave and other derogatory black images in the print media and mass-produced materials such as statuettes, coin banks, dishes, and ashtrays aimed at predominately-white consumers.<sup>118</sup>

Presumably under the guise of ‘humor’, some racist representations invoked prejudiced tropes of imbecility, wanton carelessness, or childish immaturity, or of eternal entertainer, such as minstrel barber figures<sup>119</sup> or generic MINSTREL figures. These tropes can be seen in **Figure 7** below or minstrel barber figures, including the SAMBO imagery depicted in **Figure 8** below.<sup>120</sup> The vile crassness

---

<sup>117</sup> John G. Hicks and John McGreer, Chicago, IL filed an application for a trademark depicting a collectible figurine on Sept 22, 1897, which later registered as Registration No. 28,054 (on file with author); see also a companion filing, Registration No. 28,056 (on file with author).

<sup>118</sup> MCELYA, *supra* note 109, at 127.

<sup>119</sup> William A. Shull, Philadelphia, PA filed this application on April 8, 1892, for razor-strops, Trademark No. 21,073, as described in 59 OFF. GAZ. PAT. OFFICE (May 1892) (claiming usage since October 20, 1891; the essential feature describes the mark as the “pictorial representation of a horse, and a negro barber engaged in stropping a razor upon the tail of the horse”).

<sup>120</sup> See PIETERSE, *supra* note 81, at 154.

of other marks, such as the ‘PICKANINY BRAND’<sup>121</sup> device mark as applied to “prophylactic rubber articles for the prevention of contagious diseases”.



FIGURE 7: SATIN SOAP TRADEMARK (1896) (UK)<sup>122</sup>

---

<sup>121</sup> Olympia Laboratory, New Orleans, LA, filed the application to register PICKANINY BRAND device mark on October 23, 1928 for the “prophylactic rubber articles for the prevention of contagious diseases” (Class 44) claiming usage since January 1, 1927, Serial No. 274,172, as described in 377 Off. Gaz. Pat. Office (Dec. 1928). Although the mark does not appear to be registered, other applications did secure registration, see, for example, Serial No. 274,170.

<sup>122</sup> Walter Knowlsey Massam and Ernest Arthur Dibb, trading as Massam & Dibb, 25, High Street, Yorkshire, Soap Manufacturer, applied to register and later secured registration of this trade mark, Registration No. 194,817 (UK.), in Class 47 (Soap) and identical mark, Registration No. 195,574 in Class 48 (Soap), as shown in 21 G.B. TRADE MARKS J. 624–25, 800 (1896).

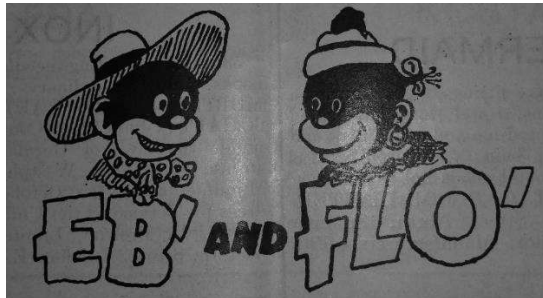


FIGURE 8: EB' & FLO' TRADEMARK (1933) (UK)<sup>123</sup>

By way of another illustration of commodity racism, consider Philadelphia firm Bean & Rabe's late nineteenth century application to register the "fanciful term 'CHING CHONG' and a Chinese scene, some of the characters therein apparently cleansing different articles and others watching the work."<sup>124</sup> This firm also sought to register labels entitled 'CHINESE CLOTHES CLEANERS'<sup>125</sup> and 'CHINESE RENOVATORS'.<sup>126</sup> Racist stereotypes of Chinese people engaged in laundry services<sup>127</sup> and/or in

---

<sup>123</sup> Albert & Henry Bassat (London) Ltd, 117 Central Street, London, applied to register and later secured registration of this trade mark, Registration No. 537,087 (UK), in Class 12 (Razor Blades), as described in 58 G.B. TRADE MARKS J. 61, 362 (1933).

<sup>124</sup> Bean & Rabe, Philadelphia, PA filed this application on September 21, 1882, for preparation for "cleaning garments, fabrics, silverware &c", Trademark No. 9,723, as described in 22 OFF. GAZ. PAT. OFFICE (Oct.–Dec.1882). Certificates of registration for trademarks numbers 8,191 and upward were registered under the Trademark Act of 1881.

<sup>125</sup> Bean & Rabe, Philadelphia, PA filed this application on September 21, 1882, Label No. 2,779, as described in 22 OFF. GAZ. PAT. OFFICE (Oct.–Dec.1882).

<sup>126</sup> Bean & Rabe, Philadelphia, Pa filed this application on September 21, 1882, Label No. 2,780, as described in 22 OFF. GAZ. PAT. OFFICE (Oct.–Dec.1882).

<sup>127</sup> Bernheimer & Walter, New York, NY filed an application to register a device mark on November 30, 1901 for cotton piece goods (on file with author). The essential feature of the mark is described as the "representation of a Chinaman in the act of lifting a piece of textile fabric



connection with sanitary products<sup>128</sup> continued well into the twentieth century, such as in the ‘NO = SMELL = Y’ trademark depicted in **Figure 9** below:



**FIGURE 9:** THE SANITATION & SUPPLY CO’S TRADEMARK (1907) (US)

It is probably safe to say that the average (white) trader and (white) consumer in the Anglo-Australian and Anglo-American public sphere considered the above representations as unremarkable. Anti-Chinese sentiment was then palpable in Australia,<sup>129</sup> as it was in the United States.<sup>130</sup> As for racist imagery of the Black Other, the

---

out of a tub”, Trademark No. 37,540, as described in 97 OFF. GAZ. PAT. OFFICE (1901).

<sup>128</sup> The Sanitation and Supply Co, Ballston Spa, NY filed an application to register this device mark on March 22, 1907 in Class 6 (Chemicals not otherwise classified), NO-SMELL-Y, Trademark No. 26,150 (describing application for goods such as “disinfectants and deodorizers”), as described in 128 OFF. GAZ. PAT. OFFICE 872 (May 1907).

<sup>129</sup> See, e.g., *Immigration Restriction Act 1901* (Cth) and the subsequent laws which together formed the ‘White Australia’ policy.

<sup>130</sup> See, e.g., *Chinese Exclusion Act 1882*, Pub. L 47–126, 22 Stat. 58, 126.

transatlantic slave trade and Britain’s subsequent colonial exploits, and American plantation slavery were so deeply embedded in Anglo-American popular culture that their influence continued even long after abolition and colonial independence respectively. Many commentators have even pointed to the irony of increased intensification of racial prejudice *after* abolition and legal emancipation.<sup>131</sup>

In addition to the important work done by cultural historians and postcolonial theorists in problematizing generalist attitudes to race, race historian Douglas Lorimer, writing more broadly, observes that the amplification in mid-Victorian England of a “more crassly racist stereotype of the Negro occurred while English commentators were becoming more assertive about Anglo-Saxon racial superiority”.<sup>132</sup> In the U.S., mid-nineteenth century decisions such as *Dred Scott v. Sandford*,<sup>133</sup> reflected entrenched institutionalized racism, which continued notwithstanding the intervention of the American Civil War and subsequent amendments to the U.S. Constitution by way of the Thirteenth and Fourteenth

---

<sup>131</sup> See, e.g., DOUGLAS LORIMER, *COLOUR, CLASS AND THE VICTORIANS* ch. 10 (1978); RICHARD HUZZEY, *FREEDOM BURNING* (2012); Robert Burroughs, *Slave Trade Suppression and the Culture of Anti-Slavery in Nineteenth Century Britain*, in *THE SUPPRESSION OF THE ATLANTIC SLAVE TRADE* 125 (Robert Burroughs and Richard Huzzey eds., 2015); NANCY STEPAN, *THE IDEA OF RACE IN SCIENCE* ch. 1 (1982); Christine Bolt, *Race and the Victorians*, in *BRITISH IMPERIALISM IN THE NINETEENTH CENTURY* 126, 127 (CC Eldridge ed., 1984) (noting how “racial attitudes changed and hardened during [the Victorian] era”).

<sup>132</sup> LORIMER, *supra* note 131, at 90. Lorimer goes on to observe that the “growth of a more stereotyped vision and the rise of racialism were concurrent, but they did not stand in the relation of cause and effect.... [These caricatures] reinforced rather than caused this growth in English racial conceit”. *Id.* at 90–91. See also CHRISTINE BOLT, *VICTORIAN ATTITUDES TO RACE* xi (1971) (stating that “the aggressive assertion of white superiority which is such a pronounced feature of the 1850s and 1860s prepared the way for the next great phase of British expansion towards the end of the century”).

<sup>133</sup> 60 U.S. 393 (1857).

Amendments. To be sure, derogatory representations of blacks continued to dominate popular culture and reinforced contrived black inferiority “even as real blacks tried to claim the full privileges of citizenship in the early twentieth century”.<sup>134</sup> This potted historiography of *some* of the racist trademarks that entered the trademark registers reflects aspects of the deeply entrenched racism in Western liberal democracies and speaks to why modern manifestations of racist tropes cannot be dismissed as mere aberrations. They rightly attract strong contestation.

**B. *Resistance to Racism and Racist Representations of the Other***

We must at once disabuse ourselves of any flawed notion that there was little or no resistance to these racist endeavors either by referenced group, or by supportive networks drawn from the dominant hegemony. Resistance was widespread, never-ending, and far too extensive to document here.<sup>135</sup> It is sufficient for present purposes to point out that, at the very least, in the U.K., U.S., and Australia, counterpublic spheres existed to challenge the

---

<sup>134</sup> CHAMBERS, *supra* note 82, at 6.

<sup>135</sup> See, e.g., KIMBERLY WALLACE-SANDERS, *MAMMY: A CENTURY OF RACE, GENDER, AND SOUTHERN MEMORY* (2008); ROBERT E. WEEMS, *DESEGREGATING THE DOLLAR: AFRICAN AMERICAN CONSUMERISM IN THE TWENTIETH CENTURY* (1998); David Krasner, *The Real Thing*, in *BEYOND BLACKFACE AFRICAN AMERICANS AND THE CREATION OF AMERICAN POPULAR CULTURE, 1890-1930* (W. Fitzhugh Brundage ed., 2011); John Stauffer, *Creating and Image in Black*, in *BEYOND BLACKFACE AFRICAN AMERICANS AND THE CREATION OF AMERICAN POPULAR CULTURE, 1890-1930* (W. Fitzhugh Brundage ed., 2011); Stephanie Dunson, *Black Misrepresentation in Nineteenth-Century Sheet Music Illustration*, in *BEYOND BLACKFACE AFRICAN AMERICANS AND THE CREATION OF AMERICAN POPULAR CULTURE, 1890-1930* (W. Fitzhugh Brundage ed., 2011); BEHNKEN & SMITHERS, *supra* note 73.

then-status quo.<sup>136</sup> For example, regarding matters of race, there were in the U.K. many enlightened individuals<sup>137</sup> and philanthropists (including traders) who, through their abolitionist and anti-racism crusades,<sup>138</sup> voiced their opposition to the poor treatment of ‘Others’, and later to problematic racist portrayals, such as the comic minstrel.<sup>139</sup>

---

<sup>136</sup> See JAMES WALVIN, *BLACK AND WHITE* (1973); PHILIP D. CURTIN, *THE IMAGE OF AFRICA* ch. 15 (1973). For more recent contributions to the literature, see HUZZEY, *supra* note 131, and *THE SUPPRESSION OF THE ATLANTIC SLAVE TRADE* (Robert Burroughs & Richard Huzzey eds., 2015).

<sup>137</sup> Such as anti-racism campaigner, Catherine Impey, a Quaker, who founded the Society for the Recognition of the Brotherhood of Man. Impey’s circle of friends and supporters included British racial minorities who were “both victims of, and active in resistance to, the prevalent racism of the age”. See Douglas A. Lorimer, *Race, Science and Culture*, in *VICTORIANS AND RACE*, 13, 17 (Shearer West ed., 1996).

<sup>138</sup> See, e.g. the efforts of the Quaker-inspired abolitionist movement, *The British Society for Effecting the Abolition of the Slave Trade*, founded in 1787, and whose famous members included William Wilberforce and Josiah Wedgwood, as explained in MICHAEL R. WATTS, *THE DISSENTERS: VOL. II* 439 (1995):

[T]he treatment of negroes as inferior beings violated the principle of spiritual equality of all men implicit in the Quaker doctrine of the inner light, and the discrimination which had prompted so many Quakers to leave Europe for the New World gave Friends a bond of sympathy with the negroes and at the same time brought them face to face with the realities of slavery and the slave-trade (citation omitted).

Lorimer claims that “by the last quarter of the eighteenth century, English opinion about the nature and proper status of Africans was divided, and thus no simple generalized description can encompass the variety of racial attitudes prevalent at that time ... English attitudes towards blacks ... did not display a rigid continuity”. LORIMER, *supra* note 131, at 24–25.

<sup>139</sup> Of course, as Lorimer explains that the success of abolitionist propagandists paradoxically intensified Victorian race consciousness and helped reinforce the idea of the African slave and noble savage. However, this “philanthropic image of the Negro”, he notes, was soon

Racist imagery of black ‘cleansing’ and other degrading images of the late Victorian era, Anandi Ramamurthy reminds us, “drew criticism...even among imperialists [where] there were conflicting attitudes and opinions”.<sup>140</sup> In Australia, Aboriginal counterpublic spheres like the Aborigines Progressive Association and wider counterpublics united against racist stereotypes and dehumanizing commercial imagery as part of the 1920s and 1930s Aboriginal Australian civil rights marches, claiming citizenship and other civic rights then denied to Aboriginal Australians.<sup>141</sup>

In the United States, African American subaltern counterpublics<sup>142</sup> rallied against all forms of oppression (including stigmatizing commercial imagery) in the quest for equal socio-economic, political, and civil rights. Resistance was formidable and the resilience strategies employed by African Americans against racist branding took many and varied political and economic forms. In one particularly effective strategy, African Americans challenged this commodified ‘subservience’ and invoked Black consumer activism to disrupt the status quo and garner respect.<sup>143</sup> In his groundbreaking work, *Desegregating the Dollar*, eminent historian Robert Weems demonstrates extensive African American economic resistance to and retribution against racist commercial practices via Black consumerism.<sup>144</sup> He recounts contemporaneous Black resistance against despised racist tropes in commercial

---

overrun by a “more crassly racist figure of the comic minstrel”. See LORIMER, *supra* note 131, at 70, 90–91.

<sup>140</sup> RAMAMURTHY, *supra* note 23, at 26.

<sup>141</sup> See, e.g., Aoun *supra* note 18, at 726–30 (including relevant references cited therein).

<sup>142</sup> See, for example, the important work of the National Negro Business League, Colored Merchant’s Association, and National Association of Colored Women documented in WEEMS, *supra* note 135, at 17–20.

<sup>143</sup> CHAMBERS, *supra* note 82, at 6.

<sup>144</sup> WEEMS, *supra* note 135.

branding, such as Aunt Jemima,<sup>145</sup> along with the significant contribution of David J. Sullivan, a pioneering African American market researcher, who helped transform U.S. marketing practices by demanding that businesses eschew racist tropes in their advertising practices.<sup>146</sup> Building on this work, Jason Chambers stresses the important contribution of African American advertising professionals in shifting paradigms within and outside the advertising industry.<sup>147</sup> Other commentators writing more broadly have traced Black resistance through to Black abolitionists who took advantage of new and emerging forms of visual imagery to project positive images of African Americans in the public sphere.<sup>148</sup>

The central point here is that racist branding and racist stereotypes in trademarks were never uncontested, but rather that most of the dominant hegemony typically ignored those contestatory efforts. However, as marginalized groups grew in economic strength and enjoyed improved civil rights, so too did their resistance and their concerted efforts in rehabilitating, for example, the public image of Black Other. With the increased receptiveness of the public sphere, market, and the law, in heeding those arguments over a prolonged period, and especially the Civil Rights Movement of the 1950s and 1960s, (overt) racist trade imagery was largely disavowed. Yet, as we have seen, some traders held onto their deep-rooted racist marks. Those trademarks were only recently dislodged by intense BLM

---

<sup>145</sup> *Id.* at 24–25 (quoting the views of Black consumer reactions to “Aunt Jemima Pancake Flour” advertisements, as set out in PAUL K. EDWARDS, *THE SOUTHERN URBAN NEGRO AS A CONSUMER* 242–45 (1932)).

<sup>146</sup> *Id.* at 35–36 (quoting Sullivan’s list of marketing ‘don’ts’ to businesses seeking Black consumer patronage, as set out in David J. Sullivan, *Don’t Do This — If You Want to Sell Your Products to Negroes!*, 52 *SALES MGMT.* 48, 50 (1943)). Many of the ‘don’ts’ are reflected in the trademarks discussed in this Part *infra* and *supra*.

<sup>147</sup> See CHAMBERS, *supra* note 82, at 8.

<sup>148</sup> Stauffer, *supra* note 135, at 67.

intervention, which arguably reflects the latest iteration in the long struggle against racialized oppression. While many of these racist trademarks are now consigned to the dustbin of history, it is hoped that others do not come along, pick them up, and dust them off seeking registration. Having seen the past, one cannot help but fear for the future and the possibility of some traders adopting racist floating signifiers as their preferred communicative vehicles in the market economy and vectors invading in the ‘lifeworld’<sup>149</sup> and ‘public sphere’, concepts to which we now turn.

### III. HABERMASIAN PUBLIC SPHERE THEORY: EARLY THOUGHTS

The ‘public sphere’ means different things to different people. Not only has this concept entered the common vernacular, but it also has an incredibly wide application to diverse fields across the academic multiverse, including political and legal theory, history, sociology, and media and communication studies, taking on “a life of its own in scholarly and public debates”.<sup>150</sup> Where, then, should we begin in our efforts to understand this concept? An appropriate starting point is with Habermas’ own description of the public sphere as “a realm of our social life in which something approaching public opinion can be

---

<sup>149</sup> The *lifeworld* (whose structural components are culture, society and personality) contains “the normative structures, worldviews and shared meanings through which members of society makes sense of themselves and their social and physical environments”: ANDREW EDGAR, *THE PHILOSOPHY OF HABERMAS*, 108, 166–73 (2005) (citations omitted). Habermas says that it “forms, as a whole, a network of communicative action”. Habermas, *Between Facts and Norms*, *supra* note 61, at 354.

<sup>150</sup> John Durham Peters, *Distrust of Representation: Habermas on the Public Sphere*, 15 *MEDIA CULT. SOC.* 541, 542 (1993).

formed”;<sup>151</sup> an arena where “[p]ublic debate was supposed to transform voluntas into a ratio... [where the] ... public competition of private arguments came into being as the consensus about what was practically necessary in the interests of all”.<sup>152</sup>

Thus, the public sphere is the realm where responsible citizens, in their capacity as private persons, gather voluntarily to engage in open, rational argumentation on matters of universal concern.<sup>153</sup> According to Habermas:

[a] portion of the public sphere comes into being in every conversation in which private individuals assemble to form a public body... [in other words] when they confer in an unrestricted fashion — that is, with the guarantee of freedom of assembly and

---

<sup>151</sup> Jürgen Habermas, *The Public Sphere: An Encyclopaedia Article (1964)*, 3 *NEW GERMAN CRIT.* 49, 49 (1974) [hereinafter “Habermas, *Encyclopaedia*”].

<sup>152</sup> HABERMAS, *Structural Transformation*, *supra* note 59, at 83 (emphasis altered). Habermas here was speaking in the context of a transition from a literary public sphere to a political public sphere.

<sup>153</sup> For similar definitions, see Crossley & Roberts, *Introduction*, in *AFTER HABERMAS: NEW PERSPECTIVES ON THE PUBLIC SPHERE* 1, 2 (Nick Crossley and John Michael Roberts eds., 2004); Robert C. Holub, *JÜRGEN HABERMAS: CRITIC IN THE PUBLIC SPHERE* 3 (1991); Max Pensky, *Historical and Intellectual Concepts*, in, *JÜRGEN HABERMAS: KEY CONCEPTS* 13, 23 (Barbara Fultner ed., 2011) (stating that “[t]he public sphere is a space that participatory modern politics opens up between the everyday lived world of shared particular experiences and attitudes, on the one side, and the hierarchical, bureaucratic institutions of modern governance, on the other. This... is... where subjects, as citizens, exercise their rational agency by participating in informal discourses of matters of shared interest”); Geoff Eley, *Nations, Publics, and Political Cultures*, in Craig Calhoun (ed), *HABERMAS AND THE PUBLIC SPHERE* 289, 290 (1992) (stating “[i]n a nutshell, the public sphere means ‘a sphere which mediates between society and state, in which the public organizes itself as the bearer of public opinion’”).



*The Belated Awakening of the Public Sphere to Racist Branding and Racist Stereotypes in Trademarks* 593

association and the freedom to express and publish their opinions — about matters of general interest.<sup>154</sup>

The pursuit of a truly public consensus through rational deliberation is something that features heavily in Habermasian public sphere theory; in fact, the importance of rational-critical debate (*öffentliches Raisonement*)<sup>155</sup> in democratic societies is central. Not only is ‘public competition of private arguments’ the cornerstone of democratic legitimacy in Western representative democracies — an *ideal* arguably not borne out in reality — but it is also viewed as containing enormous emancipatory potential. This communicative discourse can lead to self-betterment and an enriched, more representative democracy. Another succinct summary is offered by Fraser, who describes the public sphere as:

[A] theater in modern societies in which political participation is enacted through the medium of talk. It is the place in which citizens deliberate about their common affairs, and hence an institutionalized arena of discursive interaction. This arena is conceptually distinct from the state; it is a site for the production and circulation of discourses that can in principle be critical of the state. The public sphere in Habermas’s sense is also conceptually distinct from the official economy; it is not an arena of market relations but rather one of discursive relations, a theater for debating and deliberating rather than for buying and selling. Thus this concept of the public sphere permits us to keep in view the distinctions among state apparatuses, economic markets, and democratic associations, distinctions that are essential to democratic theory.<sup>156</sup>

---

<sup>154</sup> Habermas, *Encyclopaedia*, *supra* note 151, at 49.

<sup>155</sup> See HABERMAS, *Structural Transformation*, *supra* note 59, at 28.

<sup>156</sup> Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 110–11.

The public sphere — which is constituted by private people — emerges from the Hegelian conception of ‘civil society’,<sup>157</sup> yet is a distinct concept.<sup>158</sup> Conceptually, it is quite separate from the authority of the state and the official economy. At its simplest, this “narrow and fragile space”<sup>159</sup> performs the important function of “mediat[ing] between society and the state”:<sup>160</sup> that is, between civil society and the family (‘Private Realm’), and the state and the ruling elite (‘Spheres of Public Authority’).<sup>161</sup> It is through the

---

<sup>157</sup> For Habermas, the private sphere “comprised civil society in the narrow sense”: i.e., the “realm of commodity exchange and of social labour” in which the “family with its interior domain (*Intimsphäre*)” was “imbedded”. HABERMAS, *Structural Transformation*, *supra* note 59, at 30. In the broader Hegelian sense, civil society means all those areas (apart from family) of society distinct from the state. However, note Habermas’ later refined conception of civil society in light of his revised view of the public sphere. HABERMAS, *Between Facts and Norms*, *supra* note 61, at 367.

<sup>158</sup> Landes usefully notes that Habermas isolates the public sphere as a “structure within civil society”. Joan B. Landes, *The Public and the Private Sphere: A Feminist Reconsideration in FEMINISTS READ HABERMAS: GENDERING THE SUBJECT OF DISCOURSE* 91, 92 (Johanna Meehan ed., 1995) [hereinafter “FEMINISTS”]. Eriksen and Weigård describe the “modern public sphere [as being] localised in civil society as a ‘state-free’ room ... without historical parallels”. ERIK ODDVAR ERIKSEN & JARLE WEIGÅRD, *UNDERSTANDING HABERMAS: COMMUNICATIVE ACTION AND DELIBERATIVE DEMOCRACY* 179 (2003).  
<sup>159</sup> Pensky, *supra* note 153, at 23. Habermas later describes the public sphere as a “delicate structure of communication... [performing] an essential social foundation of the exacting political self-understanding of modern societies, namely that of constitutional democracies as self-determining associations of *free and equal citizens*”. HABERMAS, *Europe*, *supra* note 1, at 181 (emphasis added).

<sup>160</sup> Habermas, *Encyclopaedia*, *supra* note 151, at 50.

<sup>161</sup> For a diagrammatic representation of a slightly more complicated “schema of social realms”, where the [bourgeois] public sphere is divided into a political public sphere (‘public sphere in the political realm’) and a literary public sphere (‘public sphere in the world of letters’), see HABERMAS, *Structural Transformation*, *supra* note 59, at 30.

conduit of critical public opinion that public (essentially state) accountability is ensured. In this normative framework, which Habermas asserts is grounded in historical experience, the public sphere is charged with the political task of challenging (and eventually informing) state power:

The bourgeois public sphere may be conceived above all as the sphere of private people come [sic] together as a public; they soon claimed the public sphere regulated from above against the public authorities themselves, to engage them in a debate over the general rules governing relations in the basically privatized but publicly relevant sphere of commodity exchange and social labor. The medium of this political confrontation was peculiar and without historical precedent: people's public use of their reason (*öffentliches Raisonement*).<sup>162</sup>

Many critics have castigated Habermas for, amongst other things, conflating descriptive and normative aspects in his research. They have argued that his conception of the public sphere is both overly idealistic and historically problematic.<sup>163</sup> In particular, his assumption of general accessibility to the public sphere has spawned an enormous

---

<sup>162</sup> HABERMAS, *Structural Transformation*, *supra* note 59, at 27.

<sup>163</sup> For an excellent summary of early criticisms, see Peter Uwe Hohendahl, *Critical Theory, Public Sphere and Culture: Jürgen Habermas and His Critics*, 16 NEW GERMAN CRIT. 89, 95–110 (1979). For a more recent summary of Habermasian public sphere criticisms, see LUKE GOODE, JÜRGEN HABERMAS: DEMOCRACY AND THE PUBLIC SPHERE ch. 2 (2005), and Crossley & Roberts, *supra* note 153, at 10–17.

body of critical literature, from feminists,<sup>164</sup> Marxists,<sup>165</sup> historians,<sup>166</sup> critical race theorists,<sup>167</sup> sociologists, systems theorists,<sup>168</sup> and media and communications theorists.<sup>169</sup> For instance, political and social theorists Fraser and Coombe<sup>170</sup>

---

<sup>164</sup> See, e.g., RITA FELSKI, *BEYOND FEMINIST AESTHETICS* (1989); Marie Fleming, *Women and the 'Public Use of Reason*, in *FEMINISTS*, *supra* note 158, at 116; Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 109; NANCY FRASER, *UNRULY PRACTICES: POWER, DISCOURSE, AND GENDER IN CONTEMPORARY SOCIAL THEORY* (1989); JOAN B. LANDES, *WOMEN AND THE PUBLIC SPHERE IN THE AGE OF THE FRENCH REVOLUTION* (1988); Landes, *supra* note 158, at 91; Mary P. Ryan, *Gender and Public Access*, in *HABERMAS AND THE PUBLIC SPHERE* 259 (Craig Calhoun ed., 1992).

<sup>165</sup> See especially OSKAR NEGTE & ALEXANDER KLUGE, *PUBLIC SPHERE AND EXPERIENCE* (1993); see also Fredric Jameson, *On Negt and Kluge* in Bruce Robbins (ed), *THE PHANTOM PUBLIC SPHERE* 42 (1993).

<sup>166</sup> See, e.g., Eley, *supra* note 66, at 289; Ryan, *supra* note 164; Anthony J. La Vopa, *Conceiving a Public: Ideas and Society in Eighteenth-Century Europe*, 64 *J. MOD. HIST.* 79 (1992); Harold Mah, *Phantasies of the Public Sphere: Rethinking the Habermas of Historians*, 72 *J. MOD. HIST.* 153 (2000); Andreas Gestrich, *The Public Sphere and the Habermas Debate*, 24 *GERMAN HIST.* 413 (2006); BRIAN COWAN, *THE SOCIAL LIFE OF COFFEE* (2005).

<sup>167</sup> See, e.g., *THE BLACK PUBLIC SPHERE* (The Black Public Sphere Collective ed., 1995); Catherine R. Squires, *Rethinking the Black Public Sphere: An Alternative Vocabulary for Multiple Public Spheres*, 12 *COMM. THEORY* 446 (2002).

<sup>168</sup> See generally the scholarship of Niklas Luhmann.

<sup>169</sup> See, e.g., PETER DAHLGREN, *TELEVISION AND THE PUBLIC SPHERE: CITIZENSHIP, DEMOCRACY AND THE MEDIA* (1996); Nicholas Garnham, *The Media and the Public Sphere*, in *HABERMAS AND THE PUBLIC SPHERE* 359 (Craig Calhoun ed., 1992); Goode, *supra* note 163; Benjamin Lee, *Textuality, Mediation, and Public Discourse*, in Craig Calhoun (ed), *HABERMAS AND THE PUBLIC SPHERE* 402 (1992); Dana Polan, *The Public's Fear, or Media as Monster in Habermas, Negt and Kluge*, 25-26 *SOCIAL TEXT* 260 (1990); Peters, *supra* note 150, at 541; MICHAEL WARNER, *PUBLIC AND COUNTERPUBLICS* (2002); Warner, *supra* note 32, at 377.

<sup>170</sup> Drawing on the work of Iris Marion Young and from the perspective of 'cultural appropriations', Coombe shares many of Fraser's criticisms. See COOMBE, *supra* note 23, at 275. Coombe, however, is also

both argue that Habermas' public sphere (as developed in *Structural Transformation*) does not adequately deal with late-capitalist 'stratified'<sup>171</sup> democratic societies.<sup>172</sup> For other critics, the public sphere praised by Habermas (imagined as a phenomenon actually situated in *places* like coffeehouses, etc.) was never quite as inclusive (and is not today as inclusive) as his early work suggests. Cowan labelled the idea a "myth".<sup>173</sup> More recently, Nancy Fraser contends Habermas' "Westphalian framing of the public-sphere" is implausible, noting that "current mobilizations of public opinion seldom stop at the boundaries of territorial states."<sup>174</sup> The Black Lives Matter contribution to racial justice, now nominated for a Nobel Peace Prize, illustrates this point about transnational opinion-formation nicely.

Habermas accepts some of these criticisms,<sup>175</sup> but argues that the "concept of the public sphere" is an

---

particularly critical of Habermas' "privileging of rationalist forms of communication", thus she favors the concept of "dialogic democracy". *Id.* Coombe defines "cultural appropriation" as "shorthand for cultural agency and subaltern struggle within media-saturated consumer societies". *Id.* at 209.

<sup>171</sup> Stratified societies are those societies where "unequal social groups" exist because of institutional structures that maintain "structural relations of dominance and subordination". Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 122. Nor is the Habermasian conception of an overarching monolithic public sphere appropriate for "egalitarian, multicultural societies" because this would "effectively privilege the expressive norms of one group over others". *Id.* at 126–28.

<sup>172</sup> *Id.* at 137.

<sup>173</sup> See COWAN, *supra* note 97, at 253, 246. Instead, Cowan argues that the public sphere in the political realm was "born out of the practicable exigencies of partisan political conflict". *Id.* at 256.

<sup>174</sup> Nancy Fraser, *The Theory of the Public Sphere*, in THE HABERMAS HANDBOOK: NEW DIRECTIONS IN CRITICAL THEORY 251 (Hauke Brunkhorst, et al. eds., 2017).

<sup>175</sup> See, e.g., Habermas, *Further Reflections on the Public Sphere*, in HABERMAS AND THE PUBLIC SPHERE, 421 (Craig Calhoun ed., 1992)[hereinafter "Habermas, *Further Reflections*"]; Jürgen Habermas, *Concluding Remarks*, in HABERMAS AND THE PUBLIC SPHERE, at 462,

“analytical tool for ordering certain phenomena... [that] has inevitable normative implications”.<sup>176</sup> Nevertheless, he asserts that the public sphere is not merely an ideal; it is grounded in historical experience,<sup>177</sup> albeit a highly romanticized experience. In any event, it would be wrong to neglect Habermas’ theoretical model of the public sphere on account of the difficulties in his historical-sociological narrative of the bourgeois public sphere, as it is “this abstract model, rather than any particular historical version, that attained normative and even utopian status for modern society”.<sup>178</sup>

We can therefore recognize the serious limitations of Habermas’ historical account and problematic assumptions, including his fixation on mass media<sup>179</sup> and “quality newspapers”,<sup>180</sup> yet still use the essence of his participatory democratic framework to support an argument in favor of challenging stigmatizing marks, including via social media and emerging internet technologies.<sup>181</sup> By analyzing the

---

463–65, (Craig Calhoun ed., 1992) [hereinafter “Habermas, *Concluding Remarks*”].

<sup>176</sup> Habermas, *Concluding Remarks*, *supra* note 175, at 462–63.

<sup>177</sup> Habermas, *Encyclopaedia*, *supra* note 151, at 50 (stating “the concept of the public sphere... [acquires its] specific meaning from a concrete historical situation”).

<sup>178</sup> Jean L Cohen & Andrew Arato, *From a Literary to a Political Public Sphere: Jürgen Habermas*, in JÜRGEN HABERMAS: VOL. II 389, 395 (David M Rasmussen & James Swindal eds., 2002). Keith Michael Baker argues that some historical critiques “lose force” once it is realized that the Habermasian public sphere is “more a normative ideal (or ideological fiction) than as fully actualized social reality”: Keith Michael Baker, *Defining the Public Sphere in Eighteenth-Century France*, in HABERMAS AND THE PUBLIC SPHERE 181, 188 (Craig Calhoun ed., 1992).

<sup>179</sup> See HABERMAS, *Europe*, *supra* note 1, at 164 (stating “[t]he network of media and of news agencies form the infrastructure of the public sphere”).

<sup>180</sup> See *id* at 169–70.

<sup>181</sup> Nancy Fraser, *The Theory of the Public Sphere*, *supra* note 174, at 253 (noting the current “structural transformation” in public

effect of stigmatizing trademarks on referenced groups in modern society, as well their counterpublic resistance to such trademarks strengthened recently by the Black Lives Matter movement, the following section suggests yet another application for deliberative models of democracy invoking the public sphere.

#### **IV. WAS THE HISTORICAL PUBLIC SPHERE ‘OPEN AND ACCESSIBLE’ TO ALL?**

##### **A. *Challenging Habermas’ Historical Account: Normative Implications***

The bourgeois public sphere (and in particular its merchant class) that Habermas idealistically refers to — whether in eighteenth century English coffee houses, French salons, German table and literary societies, or other European cities — in fact orbited around exclusionary axes, particularly those of race and gender. The early public sphere was not open and accessible to all: neither social status nor differences across race or gender “disregarded altogether”.<sup>182</sup> Merchant traders and other members of the bourgeois public sphere, including members of parliament and the judiciary, contributed to the oppressive historical public sphere for Black Others and women. Black people, Houston Baker further reminds us, arrived on “New World shores precisely as *property* belonging to the bourgeoisie”.<sup>183</sup> That the early Habermasian bourgeois public sphere was hostile to Black people and women is

---

communication and the continued relevance of Habermasian public sphere theory). See also HARMUT WESSLER, *HABERMAS AND THE MEDIA* ch. 5 (2018) (discussing the deliberative qualities and limitations of various social media platforms, blogs, etc.).

<sup>182</sup> HABERMAS, *Structural Transformation*, *supra* note 59, at 36.

<sup>183</sup> Houston Baker, Jr., *Critical Memory and the Black Public Sphere*, in *THE BLACK PUBLIC SPHERE*, *supra* note 167, at 5, 13 (emphasis in original).

hardly surprising, given that both groups were effectively denied basic democratic rights through which to contest their subjugation. Michael Hanchard explains that even though the early public sphere replaced feudalism, it was still exclusionary:

Unpropertied social groups, who were never *private* citizens under the previous socio-economic order, still remained outside the category of citizens within the new public sphere. The mark of difference ... haunted these unpropertied social groups as they were reinscribed into newly subordinate social relationships. ... [T]he bourgeois public sphere was simultaneously *expansive and exclusive*. It burgeoned with new forms of social inequality to parallel new forms of public authority and financial organization.<sup>184</sup>

Seen in this broader context, it is unremarkable that trademarks stigmatizing people of color, women, and other politically excluded groups circulated as racist branding and later entered trademark registers as property. Racist branding and racist trademarks in the nineteenth century — including racist images most likely functioning as widely circulated advertising trade cards,<sup>185</sup> or potentially adorning

---

<sup>184</sup> Michael Hanchard, *Black Cinderella?*, in *THE BLACK PUBLIC SPHERE*, *supra* note 167, at 169, 172 (emphasis altered).

<sup>185</sup> See, e.g., Figure 3; Part II.A *supra*. Trade cards were the precursor to the modern business card. See Maxine Berg & Helen Clifford, *Selling Consumption in the Eighteenth Century: Advertising and the Trade Card in Britain and France*, 4 *CULTURAL & SOC. HIST.* 145 (2007). They primarily served as aide mémoires to consumers, contained text, and later images, including racist imagery. *Id.* Trade cards were immensely popular in Paris and London in the 17<sup>th</sup> and 18<sup>th</sup> centuries, and in the United States in the mid to late 19<sup>th</sup> century. *Id.*; see also Robert Jay, *The Trade Card in Nineteenth Century America* (1987); *Advertising Trade Cards: A Short History*, Cornell Univ., <https://rnc.library.cornell.edu/tradecards/exhibition/history/index.html#modalClosed> [<https://perma.cc/YU7C-QNV6>]. For further reading on



the walls of the very coffeehouses at the heart of the public sphere — further illustrate their exclusionary and prejudicial features, and the state, through its trademarks registration system, contributed to this situation. Writing in the U.S. context, Robert Weems maintains that the relative impunity in which white businesses denigrated African Americans in their derogatory advertisements, especially at the turn of the twentieth century, could be traced to perceived black “powerlessness in the realms of politics and economics”.<sup>186</sup> But to leave the discussion there would be to cave into normative defeat and paint too pessimistic a picture, and understate the historical and continued resistance to racism generally. It would also misrepresent important advancements in Habermas’ normative model of deliberative democracy developed since *Structural Transformation*, which, notwithstanding that model’s limitations,<sup>187</sup> offer hope to marginalized groups.

Habermas’ early work suggests a “unitary public sphere”<sup>188</sup> from which certain concerns — ‘private’ concerns — are firmly excluded. Fraser challenges four problematic assumptions on which this vision of the bourgeois, patriarchal public sphere is predicated, and in so doing, her feminist critique makes a significant contribution

---

the rise of visual culture, see, for example, Stauffer, *supra* note 135, at 118.

<sup>186</sup> WEEMS, *supra* note 135, at 8.

<sup>187</sup> See especially Brian Z. Tamanaha, *The View of Habermas from below: Doubts about the Centrality of Law and the Legitimation Enterprise*, 76 DENV. U. L. REV. 989, 1006–07 (1999); Rosemary J. Coombe & Jonathan Cohen, *The Law and Late Modern Culture: Reflections on Between Facts and Norms from the Perspective of Critical Cultural Legal Studies*, 76 DENV. U. L. REV. 1029 (1999).

<sup>188</sup> But see MICHAEL WARNER, PUBLICS AND COUNTERPUBLICS 55 (2002) (arguing that academics have misread Habermas and observing that the “ideal unity of the public sphere is best understood as an imaginary convergence point”).

to the general academic discourse surrounding Habermasian public sphere theory.<sup>189</sup> These assumptions are:

- (1) Public sphere interlocutors can “bracket status differentials and deliberate *as if* they were social equals”, thus suggesting that political democracy can still operate where there is social inequality;
- (2) An explosion of a “multiplicity of competing publics is necessarily a step away from, rather than toward, greater democracy”, and that a “single, comprehensive public sphere” is more desirable than “a nexus of multiple publics”;
- (3) Public sphere discourse should only be about the “common good”, and that discussion of “private interests and private issues” is always unwelcome;
- (4) A “functioning democratic public sphere” demands a “sharp separation between civil society and the state”.<sup>190</sup>

Rejecting these assumptions creates space for a different way of thinking about the public sphere — or rather, spheres and counterspheres. Like Habermas, Fraser operates within the paradigm of critical theory, though she is said to belong to the ‘postmodern school’ because her work emphasizes the “inherently conflictual and contested nature of public communication”; that is, it seeks to draw attention to the need for a “public sphere with ‘open’ boundaries” and point out the historical processes that have constructed the “boundaries and limits of that which is defined as normative”.<sup>191</sup> The answer to a gendered public sphere,

---

<sup>189</sup> The following discussion will reference Fraser’s contribution to Calhoun’s collection of essays: *HABERMAS AND THE PUBLIC SPHERE* (Craig Calhoun ed., 1992).

<sup>190</sup> Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 117–18.

<sup>191</sup> Crossley & Roberts, *supra* note 153, at 1, 14–5. Roberts and Crossley assert that Fraser is the “most vocal spokesperson for a post-modern

Calhoun notes, is not gender neutrality and a quarantining of so-called “private interests”<sup>192</sup> from public deliberation. This is because terms such as public and private are incapable of conclusive meaning,<sup>193</sup> and as such, it is simply nonsensical to employ rigid boundaries between public and private, or, correspondingly, to delineate what is discussable and non-discussable in the public sphere. According to Fraser, “there are no naturally given, a priori boundaries”; rather, what should be prized is that matters of “common concern will be decided precisely through *discursive contestation*”, meaning that “no topics should be ruled off limits in advance of such contestation.”<sup>194</sup> In other words, it is the free-for-all no-topics-barred deliberative jousting that is valuable, and should be encouraged.

By stressing the importance of the *deliberative processes* helping to establish a common good, and eschewing ex-ante presumptions of what it means to speak of the common good or what issues “the public” may concern itself with, Fraser is in many ways channeling (or perhaps prefiguring) Habermas’ later works on deliberative democracy.<sup>195</sup> This provides opportunities for minorities

---

conception of the public sphere”. *Id.* at 14. They refer at length to Nancy Fraser, *Politics, Culture, and the Public Sphere: Toward a Postmodern Conception*, in *SOCIAL POSTMODERNISM: BEYOND IDENTITY POLITICS* 287 (Linda J Nicholson and Steven Seidman eds., 1995). Roberts and Crossley identify two other schools of thought, the ‘late-modern’ school, which emphasizes a desire to establish truth and general norms through improving access to information and doing away with privilege (represented by Cohen and Arato), and the ‘relational and institutional’ school, which designates the public sphere as an ‘institution’ and seeks to situate it in various historical and relational settings (represented by Somers). Crossley & Roberts, *supra* note 153, at 13–14, 16–17.

<sup>192</sup> Crossley & Roberts, *supra* note 153, at 35.

<sup>193</sup> See Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 129, 131.

<sup>194</sup> *Id.* at 129 (emphasis added).

<sup>195</sup> *Id.* at 130. In a footnote, Fraser explicitly acknowledges her point here to be in “the spirit of a strand of Habermas’ recent normative thought, which stresses the procedural, as opposed to the substantive,

and outsiders “to convince others that what in the past was not public in the sense of being a matter of common concern should now become so”.<sup>196</sup> Coombe likewise prefers Habermas’ later works to his early conception of the public sphere, but favors the more inclusive concept of “dialogic democracy” as the model through which marginalized groups can better articulate their concerns.<sup>197</sup> These kinds of adjustments to this model such as well as incorporating notions of “affective publics”<sup>198</sup> and “*deliberative listening*”,<sup>199</sup> and facilitating additional forms of mean-making such as incorporating memes, parody and satire,<sup>200</sup> serve as powerful discursive trigger points may also be viewed as improvements to the deliberative processes envisaged in the discourse theory of law and democracy.

---

definition of a democratic public sphere”: that is, where the “public sphere is defined as an arena for a certain type of discursive interaction, not as the arena for dealing with certain types of topics and problems”. *Id.* at n.33, 142.

<sup>196</sup> *Id.* at 129 (citations omitted).

<sup>197</sup> Coombe, *supra* note 23, at 278. Coombe adopts Iris Marion Young’s notion of “communicative democracy” here because it “respects other forms of mean-making activity than those of rational argument”. *Id.* Habermas’ focus on rational-critical debate, she contends, “contain cultural biases that devalue forms of understanding and expression characteristic of those that are socially marginalized” and may reflect a “gender bias to the extent that women’s use of language” is more cautious and “conciliatory” (citations omitted). *Id.* Perhaps these criticisms lose some of their force if one accepts Habermas’ concept of “self-legislation” (i.e., reflective law). *See supra* n.271–80 and accompanying text.

<sup>198</sup> *See, e.g.*, Wessler’s revised conception of Zizi Papacharissi’s “affective publics”, i.e., publics that can accommodate emotion so long such emotion is tied to reason, is attractive, WESSLER, *supra* note 181, at 141–45. (citing Zizi Papacharissi, *AFFECTIVE PUBLICS: SENTIMENT, TECHNOLOGY, AND POLITICS* (2015)).

<sup>199</sup> *Id.*

<sup>200</sup> *See, e.g.*, *Saturday Night Live* (NBC television broadcast Nov. 7, 2020) (depicting a skit “featuring” Aunt Jemima and Uncle Ben troubled about their employment opportunities following their forced retirement).

Brand owners of racist marks, we are told, are now doing a lot of “listening” to the Black community as well as investing in Black communities.<sup>201</sup>

Domestic violence against women is cited as one example of how “sustained discursive contestation” was necessary in “making it a common concern” and thus changing the views of those (being the majority of people) who had previously pigeon-holed domestic violence as a private concern affecting an insignificant number of heterosexual couples.<sup>202</sup> Today, contestation rages around the racial injustice suffered by people of color. In this connection, the Black Lives Matter movement’s communicative onslaught against racial injustice, and efforts to raise awareness of ingrained societal racist prejudice and stereotypes often manifest through commercial symbols, have served as an effective channel for society’s reckoning with the fact that racial injustice is everyone’s concern.

The archetypal twenty-first century struggle in the United States is the so-called Native American mascot controversy, whereas across the Atlantic and in Australia, similar battles were fought (and won) against the GOLLIWOG<sup>203</sup> and COON<sup>204</sup> brands respectively. The

---

<sup>201</sup> See Uncle Ben Press Release, *supra* note 6; see also Press Release, *The Next Step in Our Equality Journey*, PEPSICO, [https://www.pepsico.com/docs/album/esg-topics-policies/the-next-step-in-our-equality-journey.pdf?sfvrsn=11dad5cc\\_8](https://www.pepsico.com/docs/album/esg-topics-policies/the-next-step-in-our-equality-journey.pdf?sfvrsn=11dad5cc_8) [https://perma.cc/T45Q-3LD9].

<sup>202</sup> Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 129.

<sup>203</sup> See, e.g., David Millward, *Well-Preserved Golly Retires After 91 years*, DAILY TELEGRAPH (Aug. 23, 2001), <https://www.telegraph.co.uk/news/uknews/1338229/Well-preserved-Golly-retires-after-91-years.html> [https://perma.cc/A4HF-VZCC].

<sup>204</sup> Though retired now, ‘COON’ cheese is supposedly named in honor of Edward William Coon, an American cheese manufacturer who patented a method for ripening cheese. See *A Brief History: Coon Cheese*, COON (2021), <http://www.coon.com.au/> [https://perma.cc/8C5P-3FET] (on file with author). Notwithstanding any supposed connection with Edward Coon above, it is worth

Native American mascot controversy — which loosely describes the contemporary efforts of Native Americans (and civic-minded citizens) challenging racist caricatures of Native Americans commoditized in registered trademarks, slogans, and other logos in the public sphere — usefully illustrates how “sustained discursive contestation” is employed in an attempt to transform majoritarian viewpoints. As things are, Native Americans and their supporters experienced some earlier success in “making this a common concern”.<sup>205</sup> Absent this thematizing, the vast majority may otherwise remain ignorant, prioritize the proprietary interests of commercial undertakings, or simply dismiss any Native American campaign as a private matter: in other words, a matter that is not yet worthy of characterization as a matter of ‘universal concern’.

---

emphasizing that ‘coon’ was (as it is now) an offensive slur, similar to ‘n\*\*\*\*r’, with racist connotations at the time of the original registration. For some early counterpublic contestation of the supposedly non-racist origins of COON cheese, see Tanya Chilcott, *Campaigner targets Coon cheese after success in Toowoomba*, News.com.au (Sept. 17, 2009) <https://www.news.com.au/news/coon-cheese-is-next-says-campaigner/newsstory/172c7b4b56a3d71467f3eeeda90c6665?sv=f67ab1e7dec7ec4a7453fa8b45aef7da> [<https://perma.cc/6DBW-CAMX>]. See also LUCIUS LINCOLN VAN SLYKE & WALTER VAN PRICE, CHEESE 296 (1952) (stating “Erekson, [in discussing shelf-curing, cites] the process patented by Coon in 1926 for producing the *black, wax-coated cheese* which was *known in the trade* as ‘Coon Cheese’” (emphasis added); it is unclear whether the black packaging (surprisingly not mentioned in the trader’s historical narrative) or the surname is in fact responsible for the trademark’s etymology). The original patent held by William Edward Coon, Process for Ripening Cheese, U.S. Patent No. 1,579,196, makes no mention of this this black wax-coated cheese.

<sup>205</sup> See, Bob Cook, *Oregon Bans Native American-Themed School Mascots, but Battle Goes on Elsewhere*, FORBES (May 18 2012, 5:47 PM), <http://www.forbes.com/sites/bobcook/2012/05/18/oregon-bans-native-american-themed-school-mascots-but-battle-goes-on-elsewhere/> [<https://perma.cc/6YR2-FSSS>] (discussing the ban in Oregon, taking effect from 2017, against the use of Native American mascots, nicknames, and logos in high schools).

Fraser warns us that deliberative processes do not necessarily ensure the “discovery of a common good in which conflicts of interest evaporate”.<sup>206</sup> Historically, for example, the scant parliamentary discussion surrounding the prohibition on registering ‘scandalous’ marks or those “contrary to morality”<sup>207</sup> made no reference to racial or gender sensitivities; outsiders were simply not heard. But things are changing: “sustained discursive contestation” is making [stigmatizing trademarks] a “common concern”.<sup>208</sup> At least in relation to *most* racist trademarks applied for in Australia, this has made a difference as such marks are now typically denied registration because of their ‘scandalousness’.<sup>209</sup> Again, it is the unrelenting agitation that is important in making both the state and the market economy more receptive to minority concerns, and hopefully, in time, these sustained efforts should ultimately triumph in expunging all stigmatizing trademarks from the (dominant) public sphere.

Of equal importance to some public sphere theorists are the actual *deliberative processes* that facilitate the consolidation and airing of minority grievances in wider society. Given that the idyllic model of “full participatory parity in public debate and deliberation” is not realizable in

---

<sup>206</sup> Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 130.

<sup>207</sup> See *infra* Part II.

<sup>208</sup> Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 129 (emphasis in original).

<sup>209</sup> See *Trademarks Office Manual of Practice and Procedure 2. Scandalous signs*, IP AUSTRALIA (Mar. 12, 2021), <http://manuals.ipaustralia.gov.au/trademark/2.-scandalous-signs> [<https://perma.cc/DR32-HTS3>]. But see, for example, the recent racist stereotypical representation of an ‘ethnic’ cleaning woman rooted in the W.O.G device mark registered by Michael Berne for Class 3: window cleaners (polish); window cleaners in spray form; window cleaning compositions, see Registration No. 1,988,695. A ‘wog’ is an ethnic slur against Mediterranean people. See also Australian comedian Nick Giannopoulos’ successful ‘reclamation’ and registration of WOGBOYS, Registration No. 723,110 (Austl.).

stratified societies, Fraser contends that encouraging a “plurality of competing publics better promote[s] the ideal of participatory parity than does [Habermas’ earlier conception of] a single, comprehensive, overarching public” because this “best narrow[s] the gap in participatory parity between dominant and subordinated groups”.<sup>210</sup> In this way, and in the course of problematizing many of the assumptions set out in Habermas’ articulation of the public sphere, Fraser introduces invaluable novel concepts to public sphere theory — that of *subaltern counterpublics* and the concept of *weak* and *strong* public spheres.

Drawing inspiration from theorists such as Spivak and Felski,<sup>211</sup> Fraser coins the term *subaltern counterpublics*, which she defines as “parallel discursive arenas where members of subordinated social groups invent and circulate counterdiscourses to formulate oppositional interpretations of their identities, interests, and needs”.<sup>212</sup>

---

<sup>210</sup> Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 122. Fraser earlier establishes that bracketing social inequality advantages dominant societal groups and disadvantages subordinate groups, meaning that problematizing these inequalities is appropriate. Moreover, because social inequality “infects formally inclusive existing public spheres”, thereby “tainting discursive interaction” therein, Fraser suggests that social quality is a “necessary condition for participatory parity in public spheres”. *Id.* at 120–21.

<sup>211</sup> Fraser acknowledges taking the term ‘counterpublic’ from Felski. *Id.* at n. 21, 140.

<sup>212</sup> *Id.* at 123 (citations omitted). This implicitly relies on Negt and Kluge. Felski has similarly described counterpublic spheres as “critical oppositional forces [ie ‘discursive spaces’] within the society of late capitalism”. FELSKI, *supra* note 164, at 166 (referencing Negt and Kluge). The task of these counterpublic spheres, she elaborates, is to “define themselves *against* the homogenizing and universalizing logic of the global megaculture of modern mass communication as a debased pseudopublic sphere, and to voice needs and articulate oppositional values”. *Id.* (emphasis in original). Asen and Brouwer further point out that “counterpublics derive their ‘counter’ status in significant respects from varying degrees of exclusion from prominent channels of political discourse and a corresponding lack of political power”. Robert Asen &



Naturally, citizens may inhabit multiple, overlapping spheres. For Fraser, subaltern counterpublics are not only the conceptual vehicles in which the arguments and minority or outsider group concerns are cultivated in preparation for their assault on the dominant discourse and thinking, but they also serve as “spaces of withdrawal and regroupment”.<sup>213</sup> The “emancipatory potential” of subaltern counterpublics rests in this tension between their dual functions since it is here that marginalized groups can partially counterbalance the “unjust participatory privileges” enjoyed by dominant social groups in stratified societies.<sup>214</sup> We should be careful though not to misconstrue subaltern counterpublics as constituting parallel and unconnected universes vis-à-vis wider, dominant public spheres, because subaltern counterpublics also aim to engage with and reform the latter.

Subaltern counterpublic are not ‘enclaves’: like all *public* spheres, they assume a wider “*publicist* orientation” that embodies hopes of “disseminat[ing] one’s discourse to ever widening arenas”.<sup>215</sup> The objectives of the feminist counterpublic sphere (or “other oppositional communities defined in terms of racial or ethnic identity or sexual preference”), Felski explains, are not only to develop a “self-conscious oppositional identity”, but “insofar as it is a *public* sphere, its arguments are also directed outward, toward a dissemination of feminist ideas and values throughout

---

Daniel C. Brouwer, *Introduction*, in COUNTERPUBLICS AND THE STATE 1, 2–3 (Robert Asen and Daniel C Brouwer eds., 2001).

<sup>213</sup> Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 124; *see also* FELSKI, *supra* note 164, at 166–67.

<sup>214</sup> Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 124.

<sup>215</sup> *Id.* (emphasis in original). Fraser does recognise, however, that subaltern counterpublics are “often involuntarily enclaved”. *Id.* at 124 (emphasis in original).

society as a whole”.<sup>216</sup> In taking up this line of thinking, Rosemary Coombe emphasizes that:

Differentiated “counterpublics” are both necessary and desirable to enable subordinated social groups to circulate counterdiscourses, formulating oppositional interpretations in idioms that might be unwelcome, unacceptable, or simply inaudible in a single dominant public sphere.<sup>217</sup>

This dialectic is further exemplified in Fraser’s notions of strong and weak public spheres (as well as various ‘hybrid forms’), which she presents in her demolition of the early Habermasian assumption that a functioning democratic public sphere mandates a strict separation from civil society. Weak publics are those “publics whose deliberative practice consists exclusively in opinion-formation”.<sup>218</sup> They do not possess decision-making powers. By contrast, strong publics are those “publics whose discourse encompasses both opinion-formation *and* decision making”.<sup>219</sup> Sovereign parliament is the archetypal strong public sphere because it functions as a “public sphere *within* the state”.<sup>220</sup> Weak and strong public sphere interaction may improve democratic legitimacy and accountability because opinions generated in weak public spheres may later on be strengthened and transformed into binding decisions through strong public spheres.<sup>221</sup>

---

<sup>216</sup> FELSKI, *supra* note 164, at 167 (emphasis in original). Felski says its external function aims at convincing “society as a whole of the validity of feminist claims, challenging existing structures of authority through political activity and theoretical critique”. *Id.* at 168.

<sup>217</sup> Coombe, *supra* note 23, at 277.

<sup>218</sup> Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 134.

<sup>219</sup> *Id.* (emphasis added).

<sup>220</sup> *Id.* (emphasis in original).

<sup>221</sup> *See id.*

For Coombe, opinion-formation and the “public orientation”<sup>222</sup> of weak subaltern counterpublic spheres in dialogic democracies often mean that such spheres require access to stigmatizing commercial signifiers in the sense that it must be possible to appropriate, comment on, and parody such signifiers in order to communicate with broader publics. “Culturally disenfranchised” and “deprived of means to public participation” in the broader public sphere, she emphasizes that for counterpublics:

to properly express [themselves they] must reach out into a wider public and appeal to a wider audience to recognize [their] claims. To do so... [they need] to avail [themselves] of widely recognized and publicly meaningful (but privately controlled) cultural forms.<sup>223</sup>

Political contestation and the articulation of new social identities by counterpublic spheres, then, demands access to these cultural forms, and, in particular, challenging and transforming the meaning of stigmatizing commercial signifiers.<sup>224</sup>

### **B. Normative Modification**

Habermas’ own views have developed in response to criticisms of his early, idealized conception of a single public sphere. He now agrees it is “wrong to speak of one single public”, and claims that a “different picture emerges” of the early bourgeois public sphere if one accepts “*from the very beginning, the coexistence of competing public spheres*” and

---

<sup>222</sup> Coombe, *supra* note 23, at 277 (stating that “[t]heir ‘public’ orientation is accomplished through the use of publicly recognized symbols pervasive in commercial media to express particular positions in wider contexts of public consideration”).

<sup>223</sup> *Id.* at 281.

<sup>224</sup> *Id.* at 295–97. See *infra* Part V.

then incorporates the dynamic communicative processes that are ‘excluded from the dominant public sphere’ and which entail a “pluralization of the public sphere”.<sup>225</sup> Moving away from his ‘rigid’ model, Habermas admits that the “modern public sphere comprises several arenas in which, through printed [and other] materials dealing with matters of culture information and entertainment”, we would include here stigmatizing trade imagery and the responses they engender, “a conflict of opinions is fought out more or less discursively”.<sup>226</sup>

While sticking to earlier concerns about a “power-infiltrated public sphere”<sup>227</sup> and its changed infrastructure, Habermas abandons his overly pessimistic account in *Structural Transformation*, especially the “simplistic” diagnosis of “politically active publics” withdrawing into “bad privacy”, that is “from a culture-debating public to a culture-consuming public”.<sup>228</sup> Revision is necessary here because, by his own admission, and without the benefit of civil rights and feminist social movements,<sup>229</sup> Habermas previously underestimated the “resisting power” and “critical potential of a pluralistic, internally much

---

<sup>225</sup> Habermas, *Further Reflections*, *supra* note 175, at 425 (emphasis altered). These comments are made in relation to the exaggerated homogeneity of the bourgeois public sphere, and the emergence of the plebeian public sphere. *Id.* at 425–26.

<sup>226</sup> *Id.* at 430. The “tensions” with Others in the “liberal public sphere” should therefore be seen as “potentials for self-transformation”. HABERMAS, *Between Facts and Norms*, *supra* note 61, at 374. Habermas repeats his claim that the labor movement and feminism, for example, by joining the “universalist discourses of the bourgeois public sphere [which] could no longer immunize themselves against a critique from within”, thus caused the structures that had constituted them as “the other” to be “shattered”.: HABERMAS, *Between Facts and Norms*, *supra* note 61, 374 *Id.*

<sup>227</sup> Habermas, *Further Reflections*, *supra* note 175, at 437.

<sup>228</sup> *Id.* at 438.

<sup>229</sup> HABERMAS, *Structural Transformation*, *supra* note 59, was published before the post-1960s explosion of these important social movements.

*The Belated Awakening of the Public Sphere to Racist Branding and Racist Stereotypes in Trademarks* 613

differenced mass public”.<sup>230</sup> These sites of potential political resistance or “opinion forming associations” distinct from both the state and the economy in Western societies include “voluntary unions” such as “churches, cultural associations, academies, independent media, sport and leisure clubs, debating societies, groups of concerned citizens, and grass-roots petitioning”.<sup>231</sup>

Habermas no longer views “an immensely expanded public sphere”<sup>232</sup> and the “unresolved plurality of competing interests”<sup>233</sup> as undermining critical publicity and deliberative democracy. In extolling the position of the normative public sphere (particularly its critical communicative role) in *Between Facts and Norms: Contributions to a Discourse Theory of Law and Democracy*, the public sphere is viewed as a “communicative structure rooted in the lifeworld through the associational network of civil society”.<sup>234</sup> The public sphere is recast:

[A]s a network for communicating information and points of view (i.e. opinions expressing affirmative or negative attitudes); [where] the streams of communication are, in the process, filtered and synthesized in such a way that they coalesce into bundles of totally specified *public* opinions.<sup>235</sup>

---

<sup>230</sup> Habermas, *Further Reflections*, *supra* note 175, at 438–39.

<sup>231</sup> *Id.* at 453–54.

<sup>232</sup> HABERMAS, *Structural Transformation*, *supra* note 59, at 233.

<sup>233</sup> *Id.* at 234.

<sup>234</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 359.

<sup>235</sup> *Id.* at 360 (emphasis in original). For some, the public sphere here is “conceived as the totality formed by the communicative interaction of *all groups*, even nominally dominant and subaltern”, which they take as speaking to the “universalism of the human, ‘as human,’ even if it was never fully realized as such”. Mike Hall & Warren Montag, *Introduction*, in *MASSSES, CLASSES, AND THE PUBLIC SPHERE* 3–4 (Mike Hall & Warren Montag eds., 2000) (emphasis added).

Following Fraser’s work,<sup>236</sup> Habermas further elaborates on the dialectic between *weak* and *strong* public spheres in his broader theory of deliberative democracy.<sup>237</sup> The ‘public sphere’ (comprised of these weak publics) is essentially all about ‘public opinion’. This “opinion-formation uncoupled from [binding] decisions” is achieved by means of:

[A]n open and inclusive network of overlapping, subcultural publics having fluid temporal, social, and substantive boundaries. Within a framework guaranteed by constitutional rights, the structures of such a pluralistic public sphere develop more or less spontaneously. The currents of public communication are channelled by mass media and flow through different publics that develop informally inside associations.<sup>238</sup>

---

<sup>236</sup> Habermas does not specifically refer to the terms weak and strong public spheres, but after referencing Nancy Fraser’s work, his adoption of the Fraserian distinction is unmistakable. Default references to public sphere(s) are almost always references to weak public spheres, in contradistinction to the strong public spheres fixed within the state.

<sup>237</sup> This theory in turn applies his earlier discourse theory of validity.

<sup>238</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 307. Habermas, at 373–74, later expands on this formulation:

In complex societies, the public sphere consists of an intermediary structure between the political system, on the one hand, and the private sectors of the lifeworld and functional systems, on the other. It represents a highly complex network that branches out into a multitude of overlapping international, national, regional, local, and subcultural arenas... [There are various differentiations of public spheres] ... accessible to lay persons (for example, popular science and literary publics, religious and artistic publics, feminist and “alternative” publics, publics concerned with health-care issues, special welfare, environmental policy). Moreover, the public sphere is differentiated into levels according to the density of communication,

The “wild complex” and “anarchic structure” of “informal” weak publics makes them more vulnerable than strong publics, yet at the same time therein lays their advantage of “*unrestricted* communication” where “new problems” can be identified and many responses cultivated with “fewer compulsions than in procedurally regulated [i.e., strong] public spheres”.<sup>239</sup> Put another way, these weak publics, ‘anchored’ in civil society’s institutions,<sup>240</sup> are sensitized to societal needs, and serve as a “warning system with sensors”<sup>241</sup> for the formalized political public sphere. Even though their capacity to solve problems is “limited”, Habermas observes that they are tasked with “identifying”,

---

organizational complexity, and range — from the *episodic* publics found in taverns, coffeehouses, or on the streets; through the *occasional* or “arranged” publics of particular presentations and events, such as theater performances, rock concerts, party assemblies, or church congress; up to the *abstract* public sphere of isolated readers, listeners, and viewers scattered across large geographic areas, or even around the globe, and brought together only through the mass media. *Id.* (emphasis in original).

<sup>239</sup> *Id.* at 307–08 (emphasis in original).

<sup>240</sup> *Id.* at 366. In moving away from his earlier Marxist conception of civil society, Habermas now describes its “institutional core” as a composition of “nongovernmental and noneconomic connections and voluntary associations that anchor the communication structures of the public sphere in the society component of the lifeworld”. *Id.* at 366–67. He expounds, at 367, on its structure and functional role:

Civil society is composed of those more or less spontaneously emergent associations, organization, and movements that, attuned to how societal problems resonate in the private life spheres, distill and transmit such reactions in amplified form to the public sphere. The core of civil society comprises a network of associations that institutionalizes problem-solving discourses on questions of general interest inside the framework of organized public spheres. *Id.* (citations omitted).

<sup>241</sup> *Id.* at 359.

“amplifying”, “convincingly and *influentially*” “thematizing and dramatizing” civil society’s problems, as well as suggesting solutions to be “taken up and dealt with by parliamentary complexes”.<sup>242</sup>

In contrast to the network of weak public spheres (i.e., the public sphere) that form the ‘periphery’ of political power in constitutional democracies, strong public spheres comprise the ‘core’.<sup>243</sup> In this revised formulation of the public sphere in the Habermasian model of deliberative democracy, parliamentary bodies are, of course, the classic strong public sphere, i.e., formal or institutionalized sites of official decision-making. In performing their decision-making function, parliamentary bodies not only rely on the “administration’s preparatory work and further processing”, but, crucially, also depend on the efforts of a “procedurally unregulated public sphere that is borne by the general public of citizens”.<sup>244</sup> Habermas later elaborates on the symbiotic interplay between strong and weak public spheres:

[I]nstitutionalized opinion-and will-formation depends on supplies coming from the informal contexts of communication found in the public sphere, in civil society, and in spheres of private life. In other words, the political action system is embedded in lifeworld contexts.<sup>245</sup>

Other strong public spheres — like courts and administrative bodies (e.g., trademark registries) — are, to varying degrees, also involved in this interplay.<sup>246</sup> Bearing

---

<sup>242</sup> *Id.* (emphasis in original).

<sup>243</sup> In describing the circulation of power and communicative processes in constitutional democracies, Habermas adopts Bernhard Peters’ ‘core-periphery’/’sluice’ model. *Id.*; see also *infra* Figure 10 and surrounding text.

<sup>244</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, 307.

<sup>245</sup> *Id.* at 352.

<sup>246</sup> But note the increased blurring of this separation, see especially *Id.* at 371–73, 437–43.



in mind that Habermas approaches law-making from the perspective of the civil law tradition,<sup>247</sup> parliaments (as the dominant strong public sphere) are said to make the “metalevel decisions”, “interpreting and elaborating and creating rights”, whereas the judiciary aims at ensuring coherent decision-making.<sup>248</sup> Nevertheless, the judiciary, he says, cannot merely rely on these “juristic discourses of application” (presumably legal positivism per se); it must also take “elements” from “discourses of justification”.<sup>249</sup> In other words, judicial law-making is “legitimated” not only by obligating “courts to justify opinions before an enlarged critical forum specific to the judiciary”, but also through “the institutionalization of a legal public sphere... sufficiently sensitive to [making] important court decisions the focus of public controversies”.<sup>250</sup> Similar comments are made regarding bureaucratic decision-making.<sup>251</sup>

Through this normative and empirical framework, Habermas explains the connection between law and public

---

<sup>247</sup> Habermas’ blind spot to the common law tradition and the legitimation dilemma it raises has been subject to strong criticism, see especially, Catherine Kemp, *Habermas Among the Americans: Some Reflections on the Common Law*, 76 DENV. U. L. REV. 961 (1999); Tamanaha, *supra* note 187, 1006–07; BAXTER, *supra* note 61, 116–19. But as Baxter points out, at 116, the common law’s missing “connection to citizenry’s communicate activity” (required for democratic legitimacy in Habermas’ model) can be mitigated, at least in “highly visible cases”, by amici curiae. *Id.* at 116.

<sup>248</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 439. In the common law tradition, the courts are arguably at greater liberty to perform this “law making function”, especially as it relates to the creation and elaboration of rights.

<sup>249</sup> *Id.*

<sup>250</sup> *Id.* at 440. For Baxter, this goes some way in addressing Habermas’ common law legitimation dilemma, at least for those courts in the common law system (e.g., Supreme Court, High Court) that must “with some sort of necessity, take on new lawmaking or quasi-lawmaking functions”. BAXTER, *supra* note 61, at 119.

<sup>251</sup> See the discussion of “legitimation filters” in administrative bodies: HABERMAS, *Between Facts and Norms*, *supra* note 61, 440–41.

opinion (i.e., a discourse theory of law and democracy).<sup>252</sup> In this model, “public opinions” “generated more or less discursively in open controversies”<sup>253</sup> (i.e., rational-critical debate) once channeled through “sluices”<sup>254</sup> like “general elections and various forms of participation”, are:

converted into a communicative power that authorizes the legislature and legitimates regulatory agencies, while a publicly mobilized critique of judicial [and perhaps administrative] decisions imposes more-intense justificatory obligations on a judiciary [and bureaucracy] engaged in further developing the law.<sup>255</sup>

---

<sup>252</sup> In later writings, Habermas once more reworks his model, but the public sphere remains the “loosely structured periphery to the densely populated institutional center of the state, and it is rooted in turn in the still more fleeting communicative networks of civil society”, and retains its role as “steering” and “filtering” legitimated political communication, see HABERMAS, *Europe, supra* note 1, at 159. He later contends, at 165, that “journalists” and:

[v]arious [influence seeking] actors... enter the forum of the public sphere from [different] angles... politicians and political parties come from the centre of the political system; lobbyists and special interest groups represent functional systems [i.e., the economy]; and advocates, public interest groups, churches, intellectuals, and nongovernmental organizations have their roots in civil society. *Id.*

See further *id.* at Figure 9.2 “Public Sphere: Inputs and Outputs”, 171 (stating that “[a]ll actors, whether they come from the centre of the political system, from the ensemble of functional systems [i.e., market economy] or from civil society, intervene with the same intention of engaging in the shaping and reshaping of public opinion”). For a useful discussion, see BAXTER, *supra* note 61, at 234–36.

<sup>253</sup> HABERMAS, *Between Facts and Norms, supra* note 61, at 371.

<sup>254</sup> General elections are considered the “most important sluice” for the “discursive rationalization of the decisions of an administration bound by law and statute”. *Id.* at 300.

<sup>255</sup> *Id.* at 442.

*The Belated Awakening of the Public Sphere to Racist Branding and Racist Stereotypes in Trademarks* 619

Law is seen as playing *the* pivotal role in bridging the concepts of communicative and administrative power.<sup>256</sup> For in exercising “administrative power”, the state cannot “ignore” the influence of “communicative power” or “communicatively-produced power” arising from “undeformed [i.e., uncorrupted weak] public spheres”.<sup>257</sup> Habermas claims that the ideal modern constitutional state, then, should now be perceived as a model where:

the administrative system, which is steered through the power code, [is] tied to the lawmaking communicative power and kept free of illegitimate interventions of social power (ie of the factual strength of privileged interests [asserting] themselves). Administrative power should not reproduce itself on its own terms but should only be permitted to regenerate from the conversion of communicative power.<sup>258</sup>

To restate, Habermas no longer wishes to “erect a dam against the colonizing encroachment of [market and

---

<sup>256</sup> Building on Hannah Arendt’s notion of communicative power, Habermas maintains that this “scarce resource” of political autonomy, which cannot be “possessed” or “produced”, ultimately gives law its legitimacy. *Id.* at 146–49.

<sup>257</sup> *Id.* at 147–48. In fact, Habermas later warns, at 386, that the “political system fails as a guardian of social integration if its decisions...can no longer be traced back to legitimate law”. *Id.* This “legitimation dilemma” arises when the “independence of illegitimate power” is coupled with a “weak” civil society and public sphere: that is, when the “administrative system becomes independent of communicatively generated power”, “if the social power of functional systems and large organizations (including mass media) is converted into illegitimate power”, or if “lifeworld resources for spontaneous public communication no longer suffice to guarantee an uncoerced articulation of social interests”. *Id.*

<sup>258</sup> *Id.* at 150. Habermas again emphasizes, at 169, that the “idea of the constitutional state can be ...expounded with the aid of principles according to which legitimate law is generated from communicative power and the latter is in turn converted from administrative power via legitimately enacted law”. *Id.*

state] system imperatives”,<sup>259</sup> but continuing this water-themed metaphor, he now incorporates “sluices” or “channels” as the conduits through which “subjectless” public opinion is converted into communicative power, and then via law, communicative power is transformed into administrative power — real change.

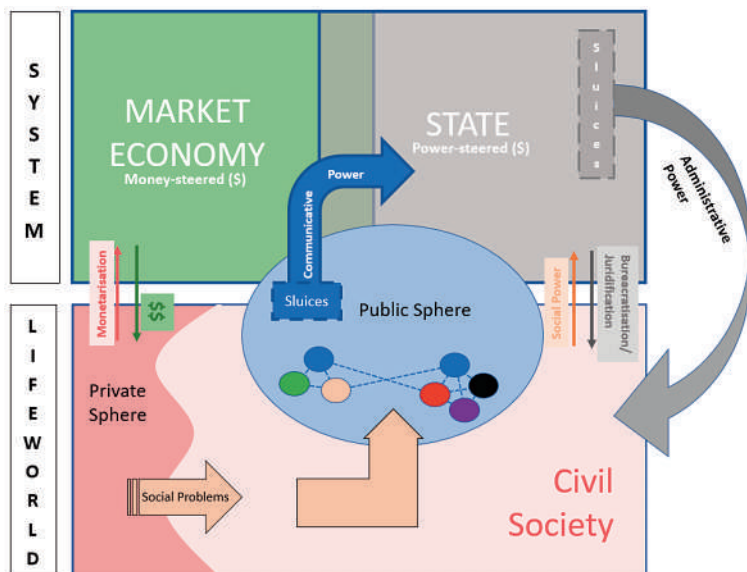


FIGURE 10: HABERMAS’ PUBLIC SPHERE IN MODERN DEMOCRATIC SOCIETY

While there are more communicative/administrative and other flows in this complex model,<sup>260</sup> **Figure 10** above

<sup>259</sup> Habermas, *Further Reflections*, *supra* note 175, at 444. Although Habermas concedes here, to the chagrin of many Marxists, that the “goal is no longer to supersede and economic system having a capitalist life of its own and a system of domination having a bureaucratic life of its own”, his later work clearly demonstrates his continued commitment to radical democracy and Marxist ideology.

<sup>260</sup> For instance, there is also the flow of administrative power from the Executive (administrative system) to the economic system, and the flow of social power from the economic system to civil society and

presents a simplified schema utilizing the lifeworld/system framework in highlighting basic communication flows from public opinion generated in the public sphere, to communicative power, and then to administrative power affecting civil society. This diagram does not reveal, however, the finer details of (1) how power circulates in constitutional democracies or (2) the normative safeguards in place to secure ‘just’, ‘legitimate’, or ‘rational’ laws. In relation to the first matter, Habermas, influenced by Niklas Luhmann,<sup>261</sup> distinguishes between the ‘official’ and ‘unofficial’ or ‘informal’ circulation of power in constitutional democracies. The official circulation of power is familiar to most lawyers: the public (through the public sphere) provides the democratic mandate (via, for example, elections and opinion-formation) for congressional or parliamentary law-making. The passage, implementation, and interpretation of laws falls according to the traditional separation of powers: parliament makes law, the executive administers law, and the judiciary interprets or declares the law and settles disputes.

However, in speaking of an “*opposing, self-programming circulation of power*”<sup>262</sup> — where, in actuality, power unofficially circulates (i.e., ‘countercirculates’) from the ‘core’ of the political system (i.e., strong public spheres) to the ‘periphery’ (civil society) — Habermas in his later work claims that change depends on the extent to which the “settled routines” of these strong public spheres “remain open to the renovative impulses from

---

government. For an excellent table representing communicative, administrative, and social power flows of power in Habermas’ constitutional democratic model, see DAVID INGRAM, HABERMAS: INTRODUCTION AND ANALYSIS, 202–03 (2010).

<sup>261</sup> See, e.g., HABERMAS, *Between Facts and Norms*, *supra* note 61, at 335.

<sup>262</sup> *Id.* at 482 (emphasis in original). See further *id.* at 356–57, 381, 383–84.

the periphery”.<sup>263</sup> Put another way, resetting the official circulation of power is possible when a ‘mobilized public sphere’ applies so much pressure that the political system must respond.<sup>264</sup> Here, sustained discursive contestation (particularly in academic circles)<sup>265</sup> is also needed to keep contentious matters in the public consciousness and thus make the state ‘system’ more receptive to change. Habermas is being optimistic, but not naïve. He recognizes that the “unofficial circulation of power” predominates, and that it is only in certain conditions (e.g., crises, civil disobedience, etc.) that “civil society can acquire influence in the public sphere, have an effect on the parliamentary complex (and the courts) through its own public opinions, and compel the political system to switch over to the official circulation of power”.<sup>266</sup> This seems to have materialized through the BLM movement, which has functioned as a circuit breaker and then generated astonishing influence in drawing attention to the problem of systemic racism in Western liberal democracies.

The second matter regarding ‘rational’ law requires us to accept Habermas’ idea of ‘self-legislation’, that is where citizens are simultaneously considered both the authors and addressees of laws.<sup>267</sup> While a detailed discussion of how this fits into his surrounding ‘rights’<sup>268</sup>

---

<sup>263</sup> *Id.* at 357.

<sup>264</sup> *Id.* at 384.

<sup>265</sup> Universities, charitable associations, professional agencies, and the like have “oversight” functions, form the inner periphery, and occupy the “edges of the administration”. *Id.* at 355.

<sup>266</sup> *Id.* at 373.

<sup>267</sup> *Id.* at 120, 123, 126–27.

<sup>268</sup> See especially *id.* at 121–23. For a useful discussion of how these rights are divided according to the private autonomy (addressee)/public or political autonomy (author) dichotomy, and where they sit in Habermas’ broader analysis of constitutionalism (individual rights) and democracy (liberalism and popular sovereignty), see LASSE THOMASSEN, *HABERMAS: A GUIDE FOR THE PERPLEXED*, 121–26 (2010).

categories or his treatment of law and morality<sup>269</sup> is not possible here, it suffices to say that ‘self-legislation’ is more than about what is morally just to individuals (it must be “conceived more abstractly”).<sup>270</sup> Legitimate law also demands that citizens have *equal opportunities* of participation in the “opinion and will-formation” processes through which they can “exercise their political autonomy”; it is only through these deliberative processes that “legal subjects also become *authors* of their legal order”.<sup>271</sup>

In this framework, “legitimate” democratic law-making not only “relies on citizens making use of their communicative and participatory rights”, but, crucially, also depends on “*an orientation toward the common good*”.<sup>272</sup> In other words, legitimate law demands that “enfranchised citizens switch from the role of private legal subjects” and put themselves in the position of “participants who are engaged in the process” of working out an “understanding about the rules for their life in common” (i.e., society’s self-understanding).<sup>273</sup> Although this mind-set cannot be forced on citizens, it may be realized if “communicative liberties are utilized for the ‘public use of reason’” rather than in the “pursuit of personal interests”.<sup>274</sup> As Andrew Edgar explains, citizens are motivated to take this civic-minded approach because:

Now Habermas opens the possibility that the self-understanding of the community is actually developed through the formation of law. If the law is perceived as unjust, if it is challenged by sections of the community, then this is an indictment not just of the law but of the communal self-understanding that

---

<sup>269</sup> For a useful summary, see EDGAR, *supra* note 149, at 250–53.

<sup>270</sup> See HABERMAS, *Between Facts and Norms*, *supra* note 61, at 121.

<sup>271</sup> *Id.* at 123 (emphasis altered).

<sup>272</sup> *Id.* at 461 (emphasis added).

<sup>273</sup> *Id.*

<sup>274</sup> *Id.*

produced it. Bad laws... raise uncomfortable questions about the sort of people we think we are.<sup>275</sup>

In short, law serves as a mirror to society, and any serious injustice perpetuated though law reflects poorly on us all. This notion operates as an important safeguard when broader society ignores the concerns of marginalized groups. The implications are clear: where law protects stigmatizing trademarks, and where the struggles of marginalized Others remain unsupported by the broader public sphere, society is lessened, and some democratic legitimacy is lost. While the notion of ‘self-legislation’ goes some way in explaining why citizens in Habermas’ normative framework may orientate towards the public good, and in so doing thematize social problems militating against social integration, a separate question remains as to ‘how’ this is achieved. This is where we return to the public sphere, and its various constituent weak publics. Habermas says that the heavy lifting of “rational political opinion-and will-formation” is not accomplished merely through “individuals or group motivations per se”, but rather by the “*social* level of institutionalized processes of deliberation and decision-making”.<sup>276</sup> Put another way, the public sphere must carry a “good portion” of the heavy burden of “normative expectations” placed on democratic society.<sup>277</sup>

Some ideas from Habermas’ model of deliberative democracy relevant to this Article are worth restating here. Habermas now adopts the notion of multiple ‘spheres’ in his model of deliberative democracy, including networks of counterpublics, i.e., weak public spheres (such as those of marginalized groups), together with strong public spheres (often characterized as the core). Ensuring that ‘sluices’ are

---

<sup>275</sup> ANDREW EDGAR, HABERMAS: THE KEY CONCEPTS 85 (2006).

<sup>276</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 461–62 (emphasis in original).

<sup>277</sup> *Id.* at 461.



properly functioning between these weak and strong public spheres is important because it is through these sluices that, amongst other things, the concerns of marginalized groups are communicated to strong public spheres.<sup>278</sup> However, the core concern of Habermas' early work remains: the legitimacy of law and exercising power depends on reasoned, critical public debate to which all must have some means of access in order to air their grievances.

**V. DELIBERATIVE DEMOCRACY IN ACTION: NATIVE AMERICAN COUNTERPUBLICS STRIKE BACK AGAINST STIGMATIZING TRADEMARKS, AND THEN THERE'S SIMON TAM'S COUNTERPUBLIC**

Thinking about contemporary responses to a few stigmatizing trademarks referencing Native American alterity may better serve to demonstrate the more technical points in Habermas' broader deliberative democratic model and illustrate how once minority concerns can transform into broader societal concerns. In the post-*Tam* epoch, this begs the questions *which minority* and for *what purpose*? Native Americans' struggle against racist stereotypes, exemplified by efforts to cancel the Washington REDSKINS trademarks and Simon Tam's efforts to register THE SLANTS, suggests that at least two competing counterpublic tales may be spun through the deliberative democracy normative framework.

In the first and possibly more sympathetic narrative that will dominate the discussion below, the law's normative emancipatory potential through trademark cancellation proceedings, buttressed by compelling counterpublic resistance, did not materialize. To be sure, Native American counterpublics supplied the requisite pressure, actuated all the necessary levers available within the law, and remained stoic, even when met with early setbacks. However, those

---

<sup>278</sup> For a later restatement, see HABERMAS, *Europe*, *supra* note 1, at 143.

efforts and the communicative power they generated — at least in *law* — did not cut through,<sup>279</sup> and were in vain.

From the perspective of Native American counterpublics and their supporters, the United States Supreme Court in *Tam* had snuffed out the natural translational implications of these communicative energies into positive legal change. For many Native Americans and their supporters, *Tam* was thus a devastating blow: the struggle for communicative equality, respect, and human dignity<sup>280</sup> was once again undermined. The Supreme Court’s emphatic decision made it clear that both sides could not win, even though there was debatably scope for some middle ground to accommodate protection against disparaging trademarks as well as allow generative space for the registration of ‘self-disparaging’ marks.<sup>281</sup> It appears that First Amendment free speech principles in the United States, as currently interpreted, are a blunt and uncompromising tool.

---

<sup>279</sup> See, e.g., *Pro-Football, Inc v. Harjo*, 415 F.3d 44, 75 (D.C. Cir, 2005), *cert. denied*, 558 U.S. 2105 (2019). Also see the case discussed in Part V *infra*.

<sup>280</sup> See, e.g., Victoria F. Phillips, *Beyond Trademark: The Washington Redskins Case and the Search for Dignity*, 92 CHI-KENT L. REV. 1061, 1064–65 (2017) (arguing, before *Tam*, that continued registration of the REDSKINS trademark constitutes “dignity taking” pursuant to Bernadette Atuahene’s conceptual framework).

<sup>281</sup> See, e.g., Todd Anten, *Self-Disparaging Trademarks and Social Change: Factoring the Reappropriation of Slurs into Section 2(a) of the Lanham Act*, 106 COLUM. L. REV. 388 (2006); Katyal, *supra* note 20; Amanda E. Compton, *N.I.G.G.A., Slumdog, Dyke, Jap, and Heeb: Reconsidering Disparaging Trademarks in a Post-Racial Era*, 15 WAKE FORREST J. BUS. & INTELL. PROP. L. 3, 34 (2014).

A. *The Law, as Always, Eventually Liberates (Some): Simon Tam’s THE SLANTS Case Study*

A very different conclusion emerges in the second narrative involving Simon Tam. Here, Tam’s successful invocation of the First Amendment in challenging the government’s denial of his claimed right to ‘reclaim’ or ‘de-stigmatize’ a stigmatizing trademark through *registration* is fêted as a correction to ‘bad’ law and illustrates the translation of communicative power into administrative power, and more generally, an effective rule of law democracy. While the potency of Simon Tam’s THE SLANTS counterpublic in “publicly mobilizing critique of judicial decisions [and imposing] more-intense justificatory obligations on a judiciary engaged in further developing the law”<sup>282</sup> cannot be doubted, the impact of these counterpublic energies arguably underscores the law’s strong receptiveness towards free speech and property-based arguments.<sup>283</sup> By extension, it also speaks to the strong inflection of free speech and property interests manifest in deliberative democracy models, arguably reminiscent of the historical bourgeois public sphere that privileges those with access to resources, and perhaps even serves as a further reminder to historically-oppressed groups that the law as expounded does not reflect their lived reality or meet its emancipatory promise.

---

<sup>282</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 442. Recall that the historical bourgeois public sphere was white, male, and propertied, see Warner, *supra* note 32, at 382 (stating that “[a]ccess to the [bourgeois public sphere] came in whiteness and maleness”).

<sup>283</sup> See Coombe, *supra* note 23, at ch. 1, 259–61 (noting the tension between property interests and public speech interests, with the former invariably predominating); Katyal, *supra* note 20; ANJALI VATS, *THE COLOR OF CREATORSHIP: INTELLECTUAL PROPERTY, RACE, AND THE MAKING OF AMERICANS*, 126–29 (2020).

Some concerned and sympathetic eminent commentators have described *Tam* as an “unimaginable win”<sup>284</sup> for Simon Tam’s band ‘THE SLANTS’, but for many historically oppressed people and critical race scholars *Tam* probably comes as no surprise. In this way, Anjali Vats, in her stirring new book, *The Color of Creatorship*, contends that *Tam* masks the “structural whiteness” inherent in free speech principles and market economies,<sup>285</sup> and underlines the normative trouble that it invites to people of color:

The rhetoric of self-determination around *Tam* tends to ignore and dismiss the manner in which the case represents a move toward racial libertarianism, a philosophy with a laissez-faire, market-based attitude toward race. This move is consistent with post-discourses of self-actualization and self-branding that harm people of color by refusing to acknowledge that racism is ongoing and pervasive.<sup>286</sup>

Putting critical race skepticism regarding minority groups reclaiming racial slurs to one side for now,<sup>287</sup> the idea of seeking reclamation through trademark counterpublicity and registration generates provocative issues that certainly deserve more attention than can be provided here. Nonetheless, if, as Nancy Fraser says, “participation means being able to speak in one’s own voice, and thereby constructing and expressing one’s cultural identity through idiom and style”,<sup>288</sup> then Simon Tam’s claimed reclamation of THE SLANTS may well offer powerful explanatory value

---

<sup>284</sup> Angela R. Riley & Sonia K. Katyal, *Aunt Jemima Is Gone. Can We Finally End All Racist Branding?*, N.Y. TIMES (June 19, 2020), <https://www.nytimes.com/2020/06/19/opinion/aunt-jemima-racist-branding.html> [https://perma.cc/9FNK-TNVW].

<sup>285</sup> VATS, *supra* note 283, at 120.

<sup>286</sup> *Id.*

<sup>287</sup> *Id.* at 120–29; Greene, *supra* note 20, at 437.

<sup>288</sup> Fraser, *Rethinking the Public Sphere*, *supra* note 60, at 126.

*The Belated Awakening of the Public Sphere to Racist  
Branding and Racist Stereotypes in Trademarks*    **629**

for counterpublic identity formation and transformation.<sup>289</sup> There is some evidence in support of<sup>290</sup> and against<sup>291</sup> the claimed benefits of reclamation.

But do counterpublics *really* need trademark registration to vindicate their rights and reach self-fulfillment? Simon Tam’s articulate Ted-talks,<sup>292</sup> op-ed pieces,<sup>293</sup> journal articles,<sup>294</sup> and now memoir<sup>295</sup> suggest so.

---

<sup>289</sup> See, e.g., U.S. Trademark Serial No. 76/639548 (filed Dec. 22, 2005) (showing Damon Wayan’s unsuccessful attempt at trademarking NIGGA; the application was ultimately abandoned); *In re Heeb Media, LLC* 89 U.S.P.Q.2d 1071 (T.T.A.B., 2008) (denying an application to register the trademark HEEB because it is “disparaging to Jewish people”); *McDermott v. S.F. Women’s Motorcycle Contingent*, 240 Fed.Appx 865 (Fed. Cir., 2006) (affirming the dismissal of McDermott’s opposition to the registration of the trademark DYKES ON BIKES, ultimately paving the way for its approval).

<sup>290</sup> See, e.g., James L. Gibson et al., *Taming Uncivil Discourse*, 41 POL. PSYCH. (2020) (finding that reappropriation appears to work by “defusing insults”, with the degree of success turning on observers being able to ascertain the intent and motives of the speakers). But it is unclear to what extent, if any, trademark registration is necessary in this reclamation project.

<sup>291</sup> See Cody Uyeda, *Considering Matal v. Tam: Does Trademarking Derogatory Terms Further Reclamation Practices for Minority Communities?* Notes, 29 S. CAL. REV. L. & SOC. JUST. (2019) (maintaining that reclamation does not sound in tangible benefits and may even prove damaging/detrimental); Vicki Huang, *Trademarks, Race and the Science of Appropriation: An Empirical Analysis of the US Register*, U ILL. L. Rev. (forthcoming, 2021) (arguing that self-appropriation is effective for minority groups).

<sup>292</sup> Simon Tam, *How to Talk with a White Supremacist*, TEDx (July 25, 2015) <https://www.youtube.com/watch?v=FVdI6eJIAwY> [<https://perma.cc/5GPW-7F4T>].

<sup>293</sup> Simon Tam, *The Slants on the Power of Repurposing a Slur*, N.Y. TIMES (June 23, 2017), <https://www.nytimes.com/2017/06/23/opinion/the-power-of-repurposing-a-slur.html> [<https://perma.cc/R69H-F35Q>] [hereinafter “*Repurposing*”].

<sup>294</sup> See Simon Tam, *First Amendment, Trademarks, and the Slants: Our Journey to the Supreme Court*, 12 BUFF. INTELL. PROP. L.J. 1 (2018).

<sup>295</sup> SIMON TAM, *SLANTED: HOW AN ASIAN AMERICAN TROUBLEMAKER TOOK ON THE SUPREME COURT* (2009). The book’s title is arguably

He has likened the reclamation of THE SLANTS to a poison being used for medicinal purposes,<sup>296</sup> explaining more recently that the band adopted THE SLANTS as a way of “seizing control of a racial slur, turning it on its head and draining it of its venom”: in short, the “act of reclaiming an identity can be transformational” and “provide healing and empowerment”.<sup>297</sup>

While this may be true for him and members of his band, even though trader origin stories are often enveloped in myth<sup>298</sup> or embellishment,<sup>299</sup> Tam’s putative reclamation should not necessarily be received uncritically and itself may be subject to counterpublic resistance. We must consider others within referenced groups who may not derive any

---

somewhat of a misnomer given that the Supreme Court was mostly receptive to the band’s claims and legal arguments.

<sup>296</sup> *The Difference between “The Redskins” Case and Ours*, The Slants (Apr. 26, 2016), <http://www.theslants.com/the-difference-between-the-redskins-case-and-ours/> [<https://perma.cc/J3AG-DDE2>] (acknowledging that in the “wrong hands, with the wrong intent, the poisons can cause damage”).

<sup>297</sup> *Repurposing*, *supra* note 293.

<sup>298</sup> ESPN’s Keith Olbermann has done much to debunk the myth that the franchise’s then-owner, George Preston Marshall, named the team in honor of its supposedly Sioux Indian coach, William “Lone Star” Dietz. Historians have shown that Dietz was in fact a fraudster who assumed an Indian identity to avoid being drafted for World War 2, see Richard Leiby, *The Legend of Lone Star Dietz*, WASH. POST (Nov. 6, 2013), [https://www.washingtonpost.com/lifestyle/style/the-legend-of-lonestar-dietz-redskins-namesake-coach--and-possibleimposter/2013/11/06/a1358a76-466b-11e3-bf0c-cebf37c6f484\\_story.html](https://www.washingtonpost.com/lifestyle/style/the-legend-of-lonestar-dietz-redskins-namesake-coach--and-possibleimposter/2013/11/06/a1358a76-466b-11e3-bf0c-cebf37c6f484_story.html) [<https://perma.cc/KX4X-PXJ3>].

<sup>299</sup> If the band’s time-stamped Wikipedia entries are anything to go by, the reclamation argument advanced in choosing the band’s name and First Amendment narrative has gone from strength to strength and a cynic might suggest that these entries have been crafted to suit the then impending court actions, see the first, single sentence Wikipedia entry on 13 January 2007 and subsequent carefully cultivated entries where the legend of the origin story grows, *The Slants*, WIKIPEDIA, [https://en.wikipedia.org/wiki/The\\_Slants](https://en.wikipedia.org/wiki/The_Slants) [<https://perma.cc/ZS8Z-8HBC>].

reappropriation or commercial benefit and simply consider THE SLANTS trademark as poisonous per se to their identity formation. (I am particularly mindful of those silent voices in subaltern counterpublics.). Moreover, the pecuniary benefits that attach to Tam's reclamation cannot be discounted entirely. In other words, the bottom line here might be a real concern for the *bottom line*, with commercial and publicity interests predominating.<sup>300</sup>

The greatest irony in this space is that — in much the same way that nineteenth century and early twentieth century traders employed trademark law to battle over their claimed rights to stigmatizing trademarks of Others — the battlefield may now be redrawn with different combatants, specifically, members of the same marginalized group with competing claims to 'reclaimed' stigmatizing marks.<sup>301</sup> As has occurred in the U.S., there might even be more spurious arguments by non-referenced groups promulgating racist imagery under the broad cover of reclamation or perceived acceptance of racist imagery by the referenced group.<sup>302</sup>

---

<sup>300</sup> These commercial considerations served as a catalyst for the trademark registration, see *Repurposing*, *supra* note 293.

<sup>301</sup> See, e.g., Shannon Deery & Suzan Delibasic, *Nick Giannopoulos puts fellow comedians on notice for using 'wogs' in shows*, HERALD SUN (Nov. 23, 2019) (showcasing the dispute between Australian 'ethnic' comedians over use of the word 'wog'), <https://www.heraldsun.com.au/news/victoria/nick-giannopoulos-puts-fellow-comedians-on-notice-for-using-wog-in-shows/news-story/80575aa587b21a4d58f9818cfc03424c> [https://perma.cc/9S8M-CWD2].

<sup>302</sup> See, e.g., Jenny Strasbourg, *ABERCROMBIE & GLITCH: Asian Americans rip retailer for stereotypes on T-shirts* (Apr. 18, 2002) (including comments by Hampton Carney of Paul Wilmore Communications, the public relations firm addressing concerns about Abercrombie & Fitch's controversial "Wong Brothers Laundry Service – Two Wongs Can Make it White" campaign. Carney asserted that "we personally thought Asians would love this T-Shirt"), <https://www.sfgate.com/news/article/ABERCROMBIE-GLITCH-Asian-Americans-rip-2850702.php> [https://perma.cc/89LW-5LTZ].

That history repeats itself should come as no surprise, even if the actors and their supposed motives occasionally do. Whatever the best response is to these and other difficult issues,<sup>303</sup> what is clear is that law in substance and procedure preferred Simon Tam’s free speech and commercial interests in seeking registration of self-disparaging marks to Native American interests in not being disparaged,<sup>304</sup> and it is the latter struggle that demands our further attention.

### ***B. The Law, as Always, Disappoints: Native American Case Study***

Before moving to discuss the mobilization of the revamped public sphere and recounting some hard-fought — but short-lived — jurisprudential victories for Native Americans through trademark law according to the deliberative democracy discourse theoretical model, it is first necessary to deconstruct the (often damaging) cultural role accorded to Native Americans by some historical marks. Ignoring for now the formulaic stereotypical exploitation of Native Americans for tobacco and medicinal products,<sup>305</sup> three registered trademarks below evidence the application of a Native American’s profile across various classes, for the better part of the twentieth century, by British and American

---

<sup>303</sup> Another obvious concern lies in unfulfilled reclamation projects that contribute to the further spread of racial epithets, or if a supposedly ‘reclaimed’ trademark is then assigned to a non-referenced group, say white supremacists, for valuable consideration.

<sup>304</sup> *Compare* Harjo et al. v. Pro-Football, Inc., 130 S. Ct. 631 (2009) (denying Susan Harjo’s petition for certiorari in her fight against the REDSKINS trademark), *with* Lee v. Tam, 137 S. Ct. 30 (2016) (granting Simon Tam’s petition of certiorari in his endeavors to register THE SLANTS trademark).

<sup>305</sup> The trademark registers in the UK, US, and Australia reveal that racist representations depicting Native Americans are most common in these classes of goods, see, for example, ERIC BAKER & TYLER BLIK, TRADEMARKS OF THE 20S & 30S 77–89 (1985).



merchants and manufacturers. Similar representations were registered in Australian colonial and then federal registers.<sup>306</sup> In the first trademark, **Figure 11** below, a London merchant's registered LAUTRAF device trademark in Class 2 (Artificial Manures and Fertilizers) is depicted.<sup>307</sup> In another insulting registered trademark (**Figure 12**), the sacred Native American feathered headdress is misappropriated for the promotion of "feather dusters, brushes, cleaning materials and non-electric instruments and utensils for cleaning purposes, all included in Class 21".<sup>308</sup> Although these representations prima facie appear more dignified than other offensive trademarks demeaning Native Americans, the goods which are promoted via these registered trademarks must be noted. The LAUTRAF mark is applied to artificial manures and fertilizers, and is thus stigmatizing, while the HIAWATHA mark, applied to feather dusters, is, at the very least, culturally offensive.<sup>309</sup> Native American peoples subject to genocide, such as the Cheraw, were also the subject of registered trademarks, with traders imagining their personhood in the promotion of their

---

<sup>306</sup> See, e.g., *supra* Part II.

<sup>307</sup> Registration No. 236,847. Advertisement of the Lautaro Nitrate Company applied to register the mark, see 36 G.B. TRADEMARKS J. 498, 873 (1901). The application was made on 16 March 1901, and registration confirmed in the List of Registered Proprietors, 8–14 August, 1901.

<sup>308</sup> Dusters Ltd. of 52 Havelock Road, Hastings, Sussex, applied to register this trademark on 28 November 1973. For the advertisement of the application and registration of Trademark No. 1,021,448, respectively, see 100 G.B. TRADEMARKS J. 13, 732 (1975).

<sup>309</sup> For a legislative framework that can deal with the different types of offensive marks in settler colonial states, see, for example, *Trade Marks Act 2002*, s 17 (N.Z.). See also Dreyfuss & Frankel, *supra* note 20.

wares.<sup>310</sup> The hateful semiotic freight in the final trademark, **Figure 13**,<sup>311</sup> is self-explanatory.



**FIGURE 11: THE LAUTRAF TRADEMARK (1901) (UK)**

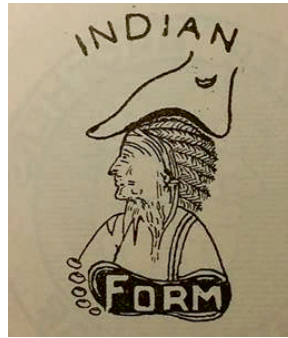


**FIGURE 12: THE HIAWATHA TRADEMARK (1975) (UK)**

---

<sup>310</sup> Julius Sellers MacGregor, trading as Ruby Canning Company, applied to register CHERAW device mark, Serial No. 516,577, on January 29, 1947 in Class 46 (Canned vegetables), see 602 OFF. GAZ. PAT. OFFICE (Sep. 1947). The mark published on September 2, 1947 and registration later was granted as Registration No. 435,000, see 605 OFF. GAZ. PAT. OFFICE (Dec. 1947). The notation explains that “Cheraw is the name of an extinct Indian tribe” and that the “picture of the Indian maid is purely fanciful”. *Id.* (on file with author).

<sup>311</sup> Irving Wm. Blum, of New York, NY applied to register this trademark on March 25, 1932, Serial No. 325,459, for Class 39 (shoes made of leather, rubber, fabric, and combinations of these materials for men, women, and children) (disclaiming the word “Form”), see 418 OFF. GAZ. PAT. OFFICE 1123 (1932).



**FIGURE 13:** INDIAN FORM MARK (1932) (US)

Trademark law and theory — through the regulatory tools available at the time — had the potential to prevent the registration of these trademarks and the resulting harm caused by these racist vectors. That harm, amplified by state-sanctioned registration which, at the very least, mandates usage<sup>312</sup> includes the perpetuation of pernicious stereotypes stigmatizing Native Americans, including the myth of a ‘vanishing race’, which in turn impairs identity formation and the capacity to participate in public debates on an equal footing, vis-à-vis non-stigmatized groups. Chickasaw citizen and father, M. Alexander Pearl, explains how such stereotypical images and a lack of Native American counterimages in mainstream media “construct a box around who [his family] are and what [they] are capable of doing and being”, before moving to lament the law’s role in “reinforc[ing] that box, to [his family’s] collective detriment and sustained harm”.<sup>313</sup> Thus, for their concerns to be treated seriously within the democratic framework, this marginalized group (either before or in conjunction with articulating other grievances) must contest stigmatizing representations that are protected by strong public spheres

---

<sup>312</sup> Cf. *Trade Marks Act 1995*, Pt. 17 (Cth) (providing legal grounds for the registration of “defensive trade marks”).

<sup>313</sup> M. Alexander Pearl, *Redskins: The Property Right to Racism*, 38 *CARDOZO L. REV.* 231, 234 (2016).

(i.e., the state), promulgated in the market economy, ‘colonizing the lifeworld’, and infiltrating the *Intimsphäre*. How, then, would this play out under the deliberative framework explained earlier?<sup>314</sup>

In the historical public sphere, and especially in Habermas’ earlier bourgeois public sphere populated by white, propertied men, challenges (if any) to such representations were of limited efficacy. This is in part because an essential pre-condition of communicative power, the “legal institutionalization of ... public opinion—and will-formation” (i.e., “rights of political participation”),<sup>315</sup> was lacking for those referenced in stigmatizing marks. For example, the oppression of Native Americans and Indigenous Australians (together with other marginalized groups such as Blacks and Women) is well-known. Such groups were disenfranchised and had a limited capacity to resist these marks. Further, the efforts of civic-minded and enfranchised counterpublic spheres (e.g., religious organizations such as the Quakers), though encouraging, were routinely ignored. As a result, the problem of stigmatizing trademarks was particularly pronounced in the historical public sphere.

However, in modern democracies, where there is (at least notional) equality of political participation, stigmatizing trademarks do not remain uncontested. Various counterpublics — “autonomous publics of an *Öffentlichkeit* [Ethical Life] type”<sup>316</sup> — now play a re-invigorated role in rallying against racist trademarks and branding in the modern public sphere. Indeed, in various public and private communicative spheres, much has been said and written challenging the misappropriation of Native American imagery in North American sporting arenas. Countless

---

<sup>314</sup> See *infra* Part IV.B.

<sup>315</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 151.

<sup>316</sup> Habermas, *Concluding Remarks*, *supra* note 175, at 462, 469.

*The Belated Awakening of the Public Sphere to Racist  
Branding and Racist Stereotypes in Trademarks*    **637**

journal articles,<sup>317</sup> books,<sup>318</sup> mainstream media outlets,<sup>319</sup>  
academic symposia,<sup>320</sup> public protests,<sup>321</sup> interconnected

---

<sup>317</sup> See, e.g., Stephen R. Baird, *Moral Intervention in the Trademark Arena*, 83 TRADEMARK REP. 661, 715–16 (1993); Kristin E. Behrendt, *Cancellation of the Washington Redskins' Federal Trademark Registrations*, 10 SETON HALL J. SPORT L. 389 (2000); Justin G. Blankenship, *The Cancellation of Redskins as a Disparaging Trademark*, 72 U. COLO. L. REV. 415 (2001); J. Gordon Hylton, *Before the Redskins were the Redskins: The Use of Native American Team Names in the Formative Era of American Sports, 1857-1933*, 86 N.D. L. REV. 879 (2010); Bruce C. Kelber, *Scalping The Redskins*, 17 HAMLIN L. REV. 533 (1994); George Likourezos, *A Case of First Impression*, 78 J. PAT & TRADEMARK OFF. SOC'Y 275 (1996); Paul E. Loving, *Native American Names in Athletics*, 13 LOY. L.A. ENT. L.J. 1 (1992); Gary Myers, *It's Scandalous - Limiting Profane Trademark Registrations after Tam and Brunetti*, 27 J. INTELL. PROP. L. 1 (2019); M. Alexander Pearl, *supra* note 313; Victoria F. Phillips, *Beyond Trademark: The Washington Redskins Case and the Search for Dignity*, 92 CHI-KENT L. REV. 1061 (2017); Ethan G. Zlotchew, *Scandalous or Disparaging - It Should Make a Difference in Opposition and Cancellations Actions: Views on the Lanham Act's Section 2(a) Prohibitions Using the Example of Native American Symbolism in Athletics*, 22 COLUM.--VLA J.L. & ARTS 217 (1998). Compare those that argue against cancellation on free speech and other grounds, see Michelle B. Lee, *Section 2(a) of the Lanham Act as a Restriction on Sports Team Names*, 4 SPORTS L.J. 65 (1997); Jeffrey Lefstin, *Does The First Amendment Bar Cancellation of Redskins?*, 52 STAN. L. REV. 665 (2000); Kimberly A. Pace, *The Washington Redskins Case and the Doctrine of Disparagement* 22 PEPP. L. REV. 7 (1994); Cameron Smith, *Squeezing the Juice Out of the Washington Redskins*, 77 WASH. L. REV. 1295 (2002); Robert H. Wright, *Today's Scandal Can Be Tomorrow's Vogue: Why Section 2(a) of the Lanham Act Is Unconstitutionally Void for Vagueness Symposium: Intellectual Property and Social Justice*, 48 HOWARD L.J. (2004).

<sup>318</sup> See, e.g., CAROL SPINDEL, *DANCING AT HALFTIME* (2000); TEAM SPIRITS, *supra* note 24; C. RICHARD KING & CHARLES FREUHLING SPRINGWOOD, *BEYOND THE CHEERS* (2001); Rosemary J. Coombe, *Sports Trademarks and Somatic Politics*, in SPORTCULT 262 (Randy Martin & Toby Miller eds., 1999); Coombe, *supra* note 23.

<sup>319</sup> In February 1992, the *Portland Oregonian* became the first major newspaper that refused to refer to racist team names. The *Washington Post* also campaigned against the REDSKINS name at that time and since August 2014 has refused to use the word in editorials. Sport

counterpublic social media sites,<sup>322</sup> and campaigns<sup>323</sup> have called for an end to the dehumanizing representations of Native Americans as mascots in the public sphere, and in so doing have exposed the fabrication that the Washington team was named in honor of its supposedly first Native American coach.<sup>324</sup>

---

broadcasters Steve Smith, Keith Olbermann, and Skip Bayliss have been particularly vocal critics, with the latter being a trenchant critic of the name for decades. Bob Franken called Snyder a “bigot” for refusing to change the name, see Bob Franken, *Time to get rid of racist symbols*, LODI ENTERPRISE (July 1, 2020), [https://www.lhgnews.com/lodi\\_enterprise/article\\_392f4b94-8e6a-541f-80b8-536a5bad3b3d.html](https://www.lhgnews.com/lodi_enterprise/article_392f4b94-8e6a-541f-80b8-536a5bad3b3d.html) [<https://perma.cc/7R2T-T94J>].

<sup>320</sup> See, e.g., Symposium, *Braves or Cowards? Use of Native American Images and Symbols as Sports Nicknames*, 1 VA. SPORTS & ENT. L.J. 257 (2002).

<sup>321</sup> Most famously, the Native American protests during the Washington Redskins 1991–92 football season, and especially Superbowl XXVI, January 26, 1992 where Washington played Buffalo. Some 2,000 protestors attended that demonstration. Suzan Shown Harjo, *Fighting Name-Calling in TEAM SPIRITS*, *supra* note 24, at 189, 198.

<sup>322</sup> See, e.g., the Oneida Nation’s website, CHANGE THE MASCOT, <http://www.changethemascot.org/> [<https://perma.cc/3PGY-J3XB>]; NATIVE VOICE NETWORK, <http://nativevoicenetwork.nationbuilder.com/> [<https://perma.cc/V4JH-323M>]; AMERICAN INDIAN MOVEMENT <http://www.aimovement.org/ncrsm/index.html> [<https://perma.cc/N7HH-RSBS>].

<sup>323</sup> See especially the “Proud to Be” Campaign made by the Change the Mascot organization and promoted by the National Conference of American Indians a few days before the 2014 Superbowl, *Proud to be*, YOUTUBE (Jan. 27, 2014), <https://www.youtube.com/watch?t=112&v=mR-tbOxlhvE> [<https://perma.cc/N5CF-PM49>].

<sup>324</sup> For further discussion of Dietz, see note 298 *supra*. Moreover, Marshall, an infamous segregationist, maintained a ‘white only’ roster and resisted signing black players until the government forced him to do so in 1961, thus making his ‘honorific’ naming claim implausible, see Theresa Vargas, *Granddaughter of Former Redskins Owner George P. Marshall Condemns Team’s Name*, WASH. POST (July 23, 2014), <https://www.washingtonpost.com/local/granddaughter-of-former-redskins-owner-george-p-marshall-condemns-teams->

Even former President Barack Obama weighed in on the controversy by querying whether “attachment to a particular name should override the real legitimate concerns that people have about these things” and suggesting that if he were the owner of a team name that “offended a sizeable group of people”, he would “think about changing” it.<sup>325</sup> Obama’s Democratic predecessor, President Bill Clinton, refused to wear a baseball cap with the grinning ‘CHIEF WAHOO’ logo (see **Figure 21** below) when invited to throw the ceremonial opening pitch of the 1994 season at the Cleveland Indians’ home field.<sup>326</sup> In stark contrast, former President Donald Trump dismissed proposed name changes to the Washington REDSKINS and Cleveland INDIANS as “politically correct”.<sup>327</sup>

These “mythical representations...owned by others have greater precedence in the public sphere”<sup>328</sup> than the daily concerns of Native Americans. The widely-held view now is that “Native American mascots perpetuate

---

name/2014/07/22/eb9dd3b0-11cd-11e4-9285-4243a40ddc97\_story.html [https://perma.cc/RC68-5B5C].

<sup>325</sup> Associated Press, *AP Interview: Obama on Redskins Name Change*, YOUTUBE (Oct. 5 2013), <https://www.youtube.com/watch?v=A9uqmh0dquw> [https://perma.cc/5UMC-CFU7]. For a handy list of Native American organizations, prominent politicians and persons, government agencies, religious leaders, media outlets, and eclectic associations in civil society urging a change to the Washington REDSKINS name, see *Change the Mascot!*, CHANGE THE MASCOT, <http://www.changethemascot.org/wp-content/uploads/2014/01/Supporters-List.pdf> [https://perma.cc/X7H4-CENH].

<sup>326</sup> John B. Rhode, *The Mascot Name Change Controversy: A Lesson In Hypersensitivity*, 5 MARQ. SPORTS L.J. 141, 141 (1994).

<sup>327</sup> See @realDonaldTrump, TWITTER (July 6, 2020, 2:13 PM) (Account now suspended), [https://twitter.com/realDonaldTrump/status/1280203174008303616?ref\\_src=twsrc%5Etfw](https://twitter.com/realDonaldTrump/status/1280203174008303616?ref_src=twsrc%5Etfw). For an archived copy of the tweet, see The Trump Archive, <https://www.thetrumparchive.com/?searchbox=%22redskins%22> [https://perma.cc/EDA7-ETWQ].

<sup>328</sup> Coombe, *supra* note 23, at 197.

inappropriate, inaccurate, and harmful understandings of living people, their cultures, and their histories”<sup>329</sup> and so ought to be retired, which is currently happening en masse. But homage must be paid to the many Native American activists and their allies from dominant groups who had gone further and earlier sought to force the relevant mascots’ retirement through the courts and state bureaucracies.<sup>330</sup>

Proud Cheyenne and Hodulgee Muscogee social justice advocate Suzan Shown Harjo, who in 2014 was awarded the United States’ highest civilian honor, the Presidential Medal of Freedom, warrants special attention here, as does Stephen Baird, the then-young lawyer who was attracted to this cause following the well-publicized 1992 Superbowl protest. In Harjo’s words, Baird then doing research for his seminal paper pointing out the “untapped” potential of § 2(a) of the *Lanham Act*,<sup>331</sup> “took [her] to school” on the USPTO and trademark law, thus proving the catalyst for the cancellation proceedings.<sup>332</sup> So, in 1992, Harjo, together with six other prominent Native Americans, sought cancellation of six REDSKINS marks on the grounds that they were ‘scandalous’, ‘disparaged’ Native Americans, and/or brought them into ‘contempt or disrepute’.<sup>333</sup> In 1999, following several discovery and pre-trial motions, the TTAB cancelled these six contested registrations because the term ‘REDSKINS’ and its variants disparaged Native

---

<sup>329</sup> TEAM SPIRITS, *supra* note 24, at 7 (citations omitted).

<sup>330</sup> For a useful summary of legal avenues then available to challenge this imagery, see, for example, Scott R. Rosner, *Legal Approaches to Native American Logos*, 1 VA. SPORTS & ENT. L.J. 258 (2002).

<sup>331</sup> Baird, *supra* note 317, at 676 (stating that “[s]ection 2(a) of the Lanham Act is a largely untapped and unique source of protection for religious, racial, and other groups that may be offended by the subject matter of certain trademark registrations or registration applications”).

<sup>332</sup> Harjo, *supra* note 321, at 199.

<sup>333</sup> 15 U.S.C. § 1052(a) (2006) (providing grounds for legal challenge under the Lanham Act).



Americans.<sup>334</sup> The trademark owners, Pro-Football Inc, successfully appealed, with United States District Judge Colleen Kollar-Kotelly agreeing with their arguments that the TTAB's finding of disparagement was "not supported by substantial evidence" and that laches nonetheless barred the petitioners' claims.<sup>335</sup> After much subsequent contestation,<sup>336</sup> the pendulum eventually swung back in favor of Native American petitioners. In what seemed to be

---

<sup>334</sup> *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d 1705 (T.T.A.B. 1999). But the marks were not found to be scandalous per se. The TTAB had earlier rejected Pro-Football's laches defense because their interests were outweighed by the broader public policy interests advocated by the petitioners. *See Harjo v. Pro-Football Inc.*, 1994 WL 262249, \*3 (T.T.A.B. 1994).

<sup>335</sup> *Pro-Football, Inc. v. Harjo*, 284 F.Supp.2d 96, 145 (D.D.C. 2003).

<sup>336</sup> The petitioners appealed both findings to the United States Court of Appeals for the District of Columbia Circuit. Although the Court of Appeal left open the substantive issue regarding disparagement, it found that Kollar-Kotelly, D.C.J., erred by failing to apply the laches defense from the time the petitioners reached majority. In effect, this meant a reconsideration of the laches defense to the youngest petitioner in the original suit, Mateo Romero. *Pro-Football, Inc. v. Harjo*, 415 F.3d 44, 75 (D.C. Cir. 2005). On remittal, Kollar-Kotelly, D.C.J., nonetheless concluded that Romero's eight-year delay in bringing the petition after reaching majority was "unreasonable" and had caused "trial and economic prejudice" to Pro-Football. *Pro-Football, Inc. v. Harjo*, 567 F.Supp.2d 46, 87 (D.D.C. 2008). The petitioners' further appeal on the laches point insofar as it applied to Romero was dismissed, but the wider substantive matter of disparagement was not discussed by the Court of Appeal. *Pro-Football, Inc. v. Harjo*, 565 F.3d 880, 881 (D.C. Cir. 2009). On 16 November 2009, the U.S. Supreme Court denied the petitioners' (431-page) writ of certiorari petition focusing solely on the laches point. *Harjo*, 415 F.3d at 75., *cert. denied*, 558 U.S. 1025 (2019). But seeing the writing on the wall, a fresh action was launched in 2006 by new Native American petitioners that had just reached majority, with the lead plaintiff being Amanda Blackhorse, a member of the Navajo people. *See Blackhorse v. Pro-Football, Inc.*, 2014 WL 2757516, \*3 (T.T.A.B. 2014) (discussing the prior filing by petitioner Amanda Blackhorse and others; the original petition is unpublished, as it was put on hold while proceedings in *Harjo v. Pro-Football, Inc.* concluded).

an important round of litigation, laches had no scope to operate because youthful petitioners brought the cancellation action. After more or less permitting the entire *Harjo* evidentiary record, the TTAB, by majority, held in *Blackhorse v. Pro-Football* that REDSKINS marks disparaged Native Americans at the times the marks secured registration and that their federal registrations should (once more) be cancelled.<sup>337</sup>

It is worth noting, however, that the marks were to remain on the register until Pro-Football had exhausted its appeals. Pro-Football was more than willing to pursue the matter to the U.S. Supreme Court, but that need did not arise as *Tam* had crushed any hope of cancelling the REDSKINS trademark through trademark law.<sup>338</sup> Its owner, life-long REDSKINS fan Dan Snyder, celebrated churlishly,<sup>339</sup> having some years earlier refused to modify his team's name, infamously declaring to reporters that "we will never

---

<sup>337</sup> *Blackhorse v. Pro-Football, Inc.*, 111 U.S.P.Q.2d 1080 (T.T.A.B. 2014). Technically, the TTAB held that the evidence supported the conclusion that, between 1967 and 1990, the relevant marks consisted of matter that "may disparage" a substantial composite of Native Americans. The TTAB used the word "disparage" as an "umbrella term" encompassing the phrase "may disparage... or bring them into contempt or disrepute". *Id.* at n.33. The TTAB's conclusion was upheld by U.S. District Court Judge Gerald Bruce Lee, see *Pro-Football, Inc. v. Blackhorse*, 112 F.Supp.3d 439 (E.D.Va. 2015). Lee, J., agreed with the TTAB's finding that "laches does not apply because of the public interest implicated". *Id.* at 489.

<sup>338</sup> *Pro-Football, Inc. v. Blackhorse*, 112 F.Supp.3d 439 (E.D.Va. 2015), *vacated*, 709 F.App'x 182, 184 (4th Cir. 2018).

<sup>339</sup> @MasterTes, TWITTER (June 20, 2017, 11:57 AM), <https://twitter.com/mastertes/status/876831267970584580?lang=en> [<https://perma.cc/N7RA-ZAY2>] (reporting on Redskins Owner, Dan Snyder, and his statement following the Supreme Court's ruling).

change the name. It's that simple. NEVER — you can use caps",<sup>340</sup> and reassuring fans that "it's who we are".<sup>341</sup>

Think about that for a moment: non-Native Americans claim that a pejorative slur adopted as a team name defines them and may speak to mythical identities they forged with the help of trademark registration, which, save for bad faith, traditionally awarded trademark ownership on a 'first come, first served'<sup>342</sup> basis. Trademark law has thus proven an important site where various stakeholders have wrestled over competing public and private interests — and what it means to speak of the public interest — in the registration of racist trademarks. Nevertheless, in the post-BLM world, where an upsurge of grassroots public opinion formation hold largely antagonistic views towards racist marks, the team's commercial backers saw the writing was on the wall, and even Dan Snyder could no longer deny what had become obvious: the racist trademarks had to go.<sup>343</sup>

---

<sup>340</sup> Erik Brady, *Daniel Snyder Says Redskins Will Never Change Name*, USA TODAY (May 9, 2013), <http://www.usatoday.com/story/sports/nfl/redskins/2013/05/09/washington-redskins-daniel-snyder/2148127/> [<https://perma.cc/6SX9-KKTJ>]. Snyder has consistently maintained this position since buying the team he supported as a child. The previous owner, Jack Kent Cooke, made and kept a similar vow, see Spindel, *supra* note 321, at 205.

<sup>341</sup> Dan Synder, *Letter from Washington Redskin Owner Dan Snyder to Fans*, WASH. POST (Oct. 9, 2013), [https://www.washingtonpost.com/local/letter-from-washington-redskins-owner-dan-snyder-to-fans/2013/10/09/e7670ba0-30fe-11e3-8627-c5d7de0a046b\\_story.html](https://www.washingtonpost.com/local/letter-from-washington-redskins-owner-dan-snyder-to-fans/2013/10/09/e7670ba0-30fe-11e3-8627-c5d7de0a046b_story.html) [<https://perma.cc/MNK5-H589>].

<sup>342</sup> See, e.g., WILLIAM HENRY BROWNE, A TREATISE ON THE LAW OF TRADE-MARKS 277 (1873) (stating that "[w]hen a thing has no lawful owner, the first actual occupant obtains the exclusive right to it. This rule is as applicable to trade-marks as to any other property"). Browne made this point after drawing an analogy to nation states racing to take "possession of a *savage* or uninhabited country". *Id.* (emphasis added).

<sup>343</sup> A short, four-paragraph statement acknowledged, amongst other things, the "recent events around our country and feedback from our community" and "discussions the team has been having with the league". It also referenced "input from our alumni, the organization, sponsors, the

Because of this outcome, the details of the legal machinations and proceedings around the cancellation of the Washington football team’s suite of REDSKINS trademarks are too extensive to detail here and are, in any event, not necessary for the purposes of this Article.<sup>344</sup> Three points emerging from the proceedings are, however, important in sustaining my argument. First, the harm caused by this and other stigmatizing trademarks misappropriating Native American imagery is real, not theoretical. Second, problematizing stigmatizing trademarks by way of continuous and intense discursive contestation in academic, political, legal, and other weak spheres rooted in national and transnational civil society (and in global fora)<sup>345</sup> at one point made the transformation of the public sphere’s attendant communicative power into administrative power by, for example, denying or withdrawing registration for such marks in those jurisdictions that retain prohibitions on registering ‘offensive’, ‘immoral’, or ‘disparaging’ marks.<sup>346</sup> Third, from a normative standpoint, the capacity of counterspheres to contest images like the REDSKINS

---

National Football League and the local community”. Press Release, Wash. Redskins Football Team, Statement from the Washington Redskins, July 3, 2020.

<sup>344</sup> As the (complex) litigation was run over 35 years, a detailed account of it is not possible. For useful summaries, see *Harjo*, 415 F.3d at 75. See also *Blackhorse*, 112 F.Supp.3d at 448–51 (summarizing much of the litigation thus far).

<sup>345</sup> See, e.g., James Anaya, *Report of the Special Rapporteur on the Rights of Indigenous Peoples: United States*, 2012 H.R.C. 6 U.N. Doc. A/HRC/21/47/Add 1, ¶¶ 9–11. The Special Rapporteur fielded complaints from indigenous representatives as to how these stereotypes “obscure[ed] understanding of the reality of Native Americans today... instead... keep[ing] alive racially discriminatory attitudes”. *Id.* ¶9.

<sup>346</sup> Unregistered trademarks retain their common law rights but obviously enjoy fewer protections and advantages compared to their registered counterparts. In the post-*Tam* United States, these translational energies must be directed elsewhere, such as to the market economy.

mark is not enough. If we are to engage the (revised) Habermasian public sphere theory, this contestation must ideally find a response from strong public spheres: marginalized groups *must ideally* find remedy within the legal and bureaucratic system. This is due to the *nature of the harm*; the harm caused by stigmatizing marks and associated commercial imagery is not just personal, psychological harm. It is harm that actively reduces the capacity of counterpublic spheres to be heard and respected in general political debate, as reflected in Australian and U.S. experience vis-à-vis Indigenous Australians and African Americans. As such, these marks actively block the sluices that should enable other political concerns of marginalized groups to be taken seriously, and thus responded to, within strong public spheres.

Suzan Shown Harjo has spoken of her dehumanizing experience at the first (and last) NFL football game she attended in 1974, where she was called a ‘redskin’ and objectified (she was literally petted) by sports fans.<sup>347</sup> She explains that the term ‘redskin’ is a genocidal referent. It has ‘despicable origins’ in Indian bounty hunting in the seventeenth and eighteenth centuries, which involved the “practice of paying bounties for the *bloody red skins* and scalps as evidence of Indian kill”.<sup>348</sup> A wide range of dictionary definitions demonstrates that redskin(s) is a

---

<sup>347</sup> *The Shame of Stereotypes as Team Mascots*, GREEN AMERICA, [http://www.greenamerica.org/pubs/greenamerican/articles/Fall2014/shame-of-stereotypes-as-team-mascots.cfm/\[https://perma.cc/YUF2-47ME\]](http://www.greenamerica.org/pubs/greenamerican/articles/Fall2014/shame-of-stereotypes-as-team-mascots.cfm/[https://perma.cc/YUF2-47ME]) (last visited Apr. 26, 2021).

<sup>348</sup> Compare Harjo, *supra* note 321, at 190 (emphasis added), with Ives Goddard, “*I am a Red-Skin*”: the Adoption of a Native American Expression (1769–1826), 19 NATIVE AM. STUD. 1 (2005) (criticizing Harjo’s characterization of the origin of the term “redskin”), and *Blackhorse*, 111 U.S.P.Q.2d at \*24–\*34 (including expert testimony challenging Harjo’s origin of the term “redskin”).

pejorative racial epithet,<sup>349</sup> and for many, it is the worst kind that can be levelled against Native Americans, analogous to ‘n\*\*\*\*\*r’ for Blacks.<sup>350</sup> The TTAB in *Blackhorse* remained unconvinced by Pro-Football’s argument that the word ‘often’, as in ‘often offensive’, found in some of the REDSKIN definitions somehow qualified its offensiveness, thereby facilitating inoffensive uses of this slur.<sup>351</sup>

Evidence was presented in *Blackhorse* and *Harjo* to prove that various Native American counterpublics (such as the American Indian Movement and National Congress of American Indians) and individuals have long demanded an end to these stigmatizing trademarks.<sup>352</sup> According to the National Congress of American Indians, the REDSKINS

---

<sup>349</sup> See, e.g., *Blackhorse*, 111 U.S.P.Q.2d at \*28–\*34; IRVING LEWIS ALLEN, UNKIND WORDS: ETHNIC LABELLING FROM REDSKIN TO WASP 18 (1990). Allen says that the redskin slur name first appeared in written form in 1699. *Id.* at 3.

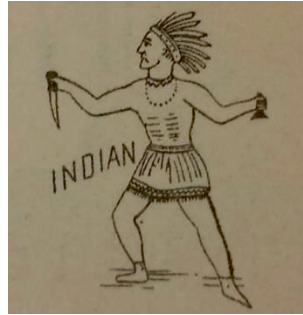
<sup>350</sup> See, e.g., *Blackhorse*, 111 U.S.P.Q.2d at \*14, \*26 (including testimony by one of the petitioners and expert evidence). For the findings of fact in relation to the word ‘redskin(s)’, see *id.* at \*59–\*63. As to the N-word, see generally KENNEDY, *supra* note 23.

<sup>351</sup> *Blackhorse*, 111 U.S.P.Q.2d at n.179.

<sup>352</sup> See, for example, the March 1972 meeting involving then president and part owner of the Washington Redskins, Harold Gross from the National Congress of American Indians, and other representatives. Dan Steinberg, *The Great Redskins Name Debate of ... 1972?*, WASH. POST. (June 3, 2014), <https://www.washingtonpost.com/news/dc-sports-bog/wp/2014/06/03/the-great-redskins-name-debate-of-1972/> [https://perma.cc/9DLJ-X7PD]. For a useful timeline outlining resistance, see Dan Bernstein, *Redskins name change timeline: How Daniel Snyder’s ‘NEVER’ gave way to Washington Football Team*, SPORTING NEWS (Nov. 27, 2000), <https://www.sportingnews.com/us/nfl/news/redskins-name-timeline-washington-football-team/1uk394uouwi631k7poirtqlv1s> [https://perma.cc/359D-YDVW]. See also Resolution in Support of the Petition for Cancellation of the Registered Services Marks of the Washington Redskins AKA Pro-Football, Inc., National Congress of American Indians, Resolution No EX DC-93-11 (Jan. 18–19 1993). For these protests and further instances of resistance, see *Blackhorse*, 111 U.S.P.Q.2d at \*40–\*55.

*The Belated Awakening of the Public Sphere to Racist Branding and Racist Stereotypes in Trademarks* 647

mark perpetuates a centuries-old stereotype of Native Americans as “blood-thirsty savages”, “noble warriors”, and an ethnic group “frozen in history”.<sup>353</sup> Trademark registers across the transatlantic and transpacific are replete with such racist portrayals as seen in **Figures 14 and 15** below:



**FIGURE 14: INDIAN MARK (1893)(US)**<sup>354</sup>



**FIGURE 15: THE PATHFINDER BRAND (1883) (NSW)**<sup>355</sup>

---

<sup>353</sup> Brief for National Congress of American Indians et al. as Amici Curiae Supporting Petitioners, *Harjo v Pro-Football, Inc*, 558 U.S. 1025 (2009) (No 09-326), 2009 WL 6439655, at \*2.

<sup>354</sup> Bay State Belting Company, Boston, MA, applied to register this device mark on April 25, 1893 for Belt & Lace Leather, claiming usage from January 15, 1885, see Registration No. 23,185, as depicted in 63 OFF. GAZ. PAT. OFFICE (Apr.-June 1893).

<sup>355</sup> Tobacco company Cameron Bros & Co, of Virginia Factory, Sydney, NSW applied to register this mark described on 26 February 1883, in class 45 (tobacco), securing registration and then subsequently transferring to WD & HO Wills, see Trademark Registration No. 822

In another example, Billy Kevin Gover, a Comanche from Oklahoma, makes clear in his letter to the Washington Redskins’ former part-owner and then president that “the name ‘Redskins’ is very offensive”, “shows little human interest or taste”, and compounds the “misconceptions” that Native Americans have about themselves.<sup>356</sup> In denying Pro-Football’s attempts to exclude this letter on the grounds of relevance,<sup>357</sup> the TTAB instead found it to be of significant probative value. The ‘established facts’ certainly focused on this evidence in determining the disparagement issue from the perspective of Native Americans.<sup>358</sup>

In the cancellation proceedings surrounding the REDSKINS mark, the petitioners tendered extensive evidence that stigmatizing Native American trademarks and imagery perpetuate negative ethnic stereotypes, causing lasting psychological damage such as anxiety, depression, and low self-esteem.<sup>359</sup> This depression is reflected in the suicide rate of adult Native Americans, which is three times that of the American general population, and the suicide rate of Native American children, which is five times that of the general population.<sup>360</sup>

Despite several attempts by Native American petitioners to thematize the issue of psychological harm

---

(Austl.), as depicted in 2 NSW TRADE MARKS REG. (June 1879 –July 1883).

<sup>356</sup> See, e.g., *Blackhorse*, 111 U.S.P.Q.2d at \*22.

<sup>357</sup> *Id.* \*17–\*19.

<sup>358</sup> *Id.* at \*25–\*28. However, letters of protest from non-Native Americans against the REDSKINS name, while speaking to a “broader consensus”, were of limited probative value to the disparagement issue and were thus not relied on in evidence. *Id.* at \*22–\*23.

<sup>359</sup> *Harjo*, 50 U.S.P.Q.2d at \*22 (including social science experts testified that “such stereotyping is extremely damaging to the self-esteem and mental health of the targeted group”).

<sup>360</sup> *Id.* at \*23.



caused by racist trade imagery in legal settings,<sup>361</sup> decision-makers have felt it unnecessary to ‘draw conclusions’ on this matter because proving psychological distress is not a necessary element of § 2(a) cancellation petitions.<sup>362</sup> Nonetheless, the harm is *very real*. Academics have demonstrated a causal link between discriminatory mascots and poor mental health outcomes, as well as substance and alcohol abuse, for Native Americans.<sup>363</sup> Since 2005, the American Psychological Association (APA) has called for the immediate retirement of all Native American mascots, symbols, and imagery. Citing the growing body of social science literature demonstrating the injurious effects that racist stereotyping has on the mental health of Native Americans, particularly on the “social identity and self-esteem of American Indian youth”,<sup>364</sup> the APA has more

---

<sup>361</sup> See, e.g., Brief for National Congress of American Indians et al. as Amici Curiae Supporting Petitioners, *Harjo v. Pro-Football, Inc.*, 2004 WL 1926878, \*26–\*29 (D.C. Cir. 2004) (citing, interestingly, *Brown v. Board*, 347 U.S. 483 (1954) and the psychological damage caused to African Americans youth by segregation in schools) (on file with author).

<sup>362</sup> See, e.g., *Harjo*, 50 U.S.P.Q.2d at \*22. This point of contention was not discussed in *Blackhorse*.

<sup>363</sup> See especially MICHAEL A. FRIEDMAN, THE HARMFUL PSYCHOLOGICAL EFFECTS OF THE WASHINGTON FOOTBALL MASCOT (2013), available at <http://www.changethemascot.org/wp-content/uploads/2013/10/DrFriedmanReport.pdf> [<https://perma.cc/3QQL-CSHN>]. Even mascots with “neutral” or “positive” association cause result in “harmful psychological effects”, see Pearl, *supra* note 313, at 241–51.

<sup>364</sup> AMERICAN PSYCHOLOGICAL ASSOCIATION, SUMMARY OF THE APA RESOLUTION RECOMMENDING RETIREMENT OF AMERICAN INDIAN MASCOTS (2011), available at <http://www.apa.org/pi/oema/resources/indian-mascots.aspx> [<https://perma.cc/9DXH-45AQ>]. For the APA’s American Indian Mascot resolution, replete with literature references, see AMERICAN PSYCHOLOGICAL ASSOCIATION, APA RESOLUTION RECOMMENDING THE IMMEDIATE RETIREMENT OF AMERICAN INDIAN MASCOTS, SYMBOLS, IMAGES, AND PERSONALITIES BY SCHOOLS, COLLEGES, UNIVERSITIES,

recently repeated this plea.<sup>365</sup> Other professional associations that sit in the public sphere’s ‘inner periphery’— like the American Sociological Association (since 2007) and American Counselling Association (since 2011)— have added their support to this cause. The Amicus Curiae brief lead by Eugene Borgida, Professor of Psychology, and filed in the US Supreme Court in the unsuccessful *Harjo* petition observed that:

The public has a compelling interest in the cancellation of disparaging trademarks – such as the Redskins mark – that embody invidious racial and ethnic slurs. Such slurs have profound and lasting negative impacts on American Indians and non-Indians alike. These negative impacts, and the corresponding public interest in the cancellation petition, are magnified by the pervasive exposure of the public to the offensive Redskins mark.<sup>366</sup>

These experiences in the *Intimsphäre* also serve as an effective springboard for articulating the strong public interest involved in removing the registration of the Washington REDSKINS mark and offering succor for further counterpublic resistance. Consistent with the reformulated Habermasian deliberative democratic framework, a broader (i.e., non-Native American) network of counterpublics has more recently been up to the task of

---

ATHLETIC TEAMS, AND ORGANIZATIONS (2005), available at <http://www.apa.org/about/policy/mascots.pdf> [<https://perma.cc/356Q-YX5L>].

<sup>365</sup> See, e.g., *Legislative efforts to eliminate native-themed mascots, nicknames, and logos: Slow but steady progress post-APA resolution*, American Psychological Association (Aug. 2010) (noting steps taken to further the efforts while acknowledging the ground still to cover), <https://www.apa.org/pi/oema/resources/communique/2010/08/native-themed-mascots> [<https://perma.cc/DNN5-S84M>].

<sup>366</sup> Brief of Psychology Professors as Amici Curiae Supporting Petitioners, *Harjo v. Pro-Football, Inc.*, 558 U.S. 1025 (2009) (No. 09-326), 2009 WL 3359185, at \*2.

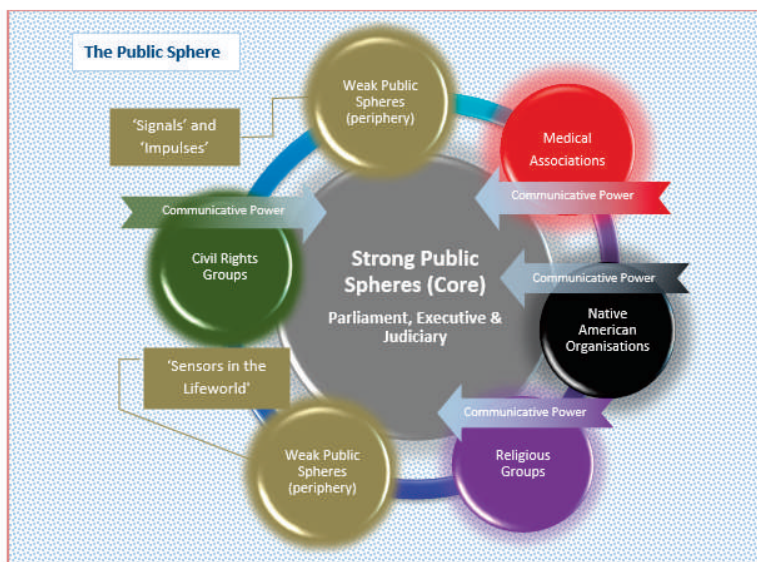
providing effective sites of contestation in the public sphere. These not-for-profit organizations (religious,<sup>367</sup> and otherwise)<sup>368</sup> rooted in civil society strengthened calls to abandon Native American mascot imagery in the public sphere. For instance, the Center for American Progress (a not-for-profit organization “dedicated to promoting a strong, just and free America” and ensuring equality of opportunity) has demanded such imagery’s discontinuation, pointing to the hostile learning environments it creates and the resulting significant harmful effects on Native *and* non-Native American youth.<sup>369</sup> With the struggle rapidly gaining momentum in local, transnational, and international legal and humanitarian public spheres, it appeared that it was only a matter of time before this dehumanizing imagery would be stripped of its trademark registration. Then came *Tam*.

---

<sup>367</sup> See, for example, an interfaith statement on this “important moral issue”, Letter from Sixty-One Religious Leaders, to Roger S. Goodell, Commissioner, National Football League & Daniel M. Snyder, Owner, Washington Redskins, (Dec. 5 2013), available at <http://www.changethemascot.org/wp-content/uploads/2013/12/NFL-Owner-Letter-with-Signatures.pdf> [<https://perma.cc/LMT6-EY4W>].

<sup>368</sup> See, e.g., U.S. Commission on Civil Rights, *Statement of the U.S. Commission on Civil Rights on the Use of Native American Images and Nicknames as Sports Symbols* (2001) (calling for an end to the use of Native American images and team names by non-Native schools).

<sup>369</sup> ERIK STEGMAN & VICTORIA PHILLIPS, *MISSING THE POINT: THE REAL IMPACT OF NATIVE MASCOTS AND TEAM NAMES ON AMERICAN INDIAN AND ALASKA NATIVE YOUTH* (2014).



**FIGURE 16:** THE MODERN PUBLIC SPHERE CONTESTING RACIST TRADEMARKS

Before *Tam*, these overlapping and interconnected counterpublics had coalesced to form a network (i.e., the public sphere) to articulate a public discourse battling these marks through the legal system. This “impulse-generating periphery” of the public sphere grounded in civil society (pink border) and functioning as “sensors in the lifeworld” for the political system, Habermas explains, “surrounds the political center...cultivating normative reasons... affecting all parts of the political system without intending to conquer it”.<sup>370</sup> By this he means that participants in the public sphere can acquire “influence, [but] not political power”.<sup>371</sup> It is only when the critical influences (i.e., public opinion) of

<sup>370</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 442. Earlier, Habermas, speaks of the public sphere’s “informal, highly differentiated and cross-linked channels of communication” forming the “real periphery” of the core-periphery circulation of power model. *Id.* at 355–56.

<sup>371</sup> *Id.* at 371.

these various counterpublics (e.g., Native Americans, civil rights groups, medical and other professional associations, and religious groups) are “filtered” and “transformed into communicative power” via the public sphere that the requisite authorization (and thus legitimacy) for the legislature, regulatory agencies, and judiciary is provided.<sup>372</sup> (The transformation into communicative power, which occurs through connecting sluices in the public sphere, is depicted diagrammatically by way of the color transition in the notched arrows above.) Habermas further elaborates on this interplay between communicative and administrative power:

The popular sovereignty set communicatively aflow cannot make itself felt solely in the influence of informal public discourse – not even when these discourses arise from autonomous public spheres. To generate *political power*, their influence must have an effect on the democratically regulated deliberation of democratically elected assemblies and assume an authorized form in formal decisions. This also holds, *mutatis mutandis*, for courts [and bureaucracies] that decide politically relevant cases.<sup>373</sup>

We see from the above discussion how two assumptions necessary for Habermas’ “official circulation of power” (i.e., a state responsive to the interests of its citizens) at one stage proved true. First, there is an active citizenry which has the capacity to “ferret out, identify and effectively thematize latent problems of social integration (which require political solutions)”.<sup>374</sup> Change is possible through introducing “parliamentary (or judicial) sluices into the political [or legal] system in way that *disrupts* the latter’s

---

<sup>372</sup> *Id.* at 371, 442.

<sup>373</sup> *Id.* at 371–72 (emphasis added).

<sup>374</sup> *Id.* at 357. Habermas has since modified the circulation of power model, see BAXTER, *supra* note 61, at ch 5.

routines”.<sup>375</sup> In this way, Habermas recognizes that real change demands quite a lot from its citizenry because:

it places a good part of the normative expectations connected with deliberative politics on the peripheral networks of opinion-formation. *The expectations are directed at the capacity to perceive, interpret, and present society wide problems in a way that is both attention catching and innovative.* The periphery can satisfy these strong expectations only insofar as the networks of noninstitutionalized public communication make possible more or less spontaneous processes of opinion-formation. Resonant and autonomic public spheres of this sort must in turn be anchored in the voluntary associations of civil society embedded in liberal patterns of political culture and socialization; in a word, they depend on a rationalized lifeworld that meets them half way.<sup>376</sup>

As the protracted Native American mascot controversy illustrates, the broader public sphere is often slow to respond to the concerns of marginalized Others. Nevertheless, Native and non-Native Americans continue to present stigmatizing Native American imagery as a societal problem in ever more provocative and innovative ways. Challenging the dominant power paradigm, the ‘FIGHTING WHITIES’ — a college basketball team made up of Native American, White, and Latino players — has courted much controversy in its confrontational counterpublic energies (**Figure 17** below).<sup>377</sup>

---

<sup>375</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 358 (emphasis in original).

<sup>376</sup> *Id.* (emphasis added)

<sup>377</sup> The team generated so much revenue through t-shirt sales that a sizable scholarship for Native American Students (the “Fightin’ White Minority Scholarship”) was created at the University of Northern Colorado, see *Short-lived Fightin Whites team products hot*, DENVER POST (Oct. 24, 2009, 7:27 PM), <https://www.denverpost.com/2009/>



**FIGURE 17:** UNIVERSITY OF NORTHERN COLORADO'S FIGHTING WHITIES (2002)

Moreover, Native American activists have also found fertile ground for effective resistance in existing stigmatizing Native American trademarks and imagery. This is because a trademark's “*economic and symbolic power* ... ironically provides the site for emergent forms of counterpublicity” and “public opportunities to effect a form of detournement”.<sup>378</sup> As Coombe further explains, the goodwill attached to these trademarks provides useful opportunities to “dispel old stereotypes and ... educate the public about a wider range of Indian concerns and issues”.<sup>379</sup> The works of Native American cartoonists have been particularly effective in this respect. Marty 2 Bulls Jr's' culture-jammed Cleveland Indians Chief Wahoo (**Figure 18** below) has communicated to the wider public the social alienation and psychological damage (e.g., self-loathing, anxiety, and depression) suffered by Native Americans and caused by stigmatizing imagery.

---

10/24/short-lived-fighting-whites-team-products-hot/  
[<https://perma.cc/U842-6XSK>]. However, as at the time of writing, there is no trademark application even though, post-*Tam*, ‘FIGHTING WHITIES’ would most likely secure trademark registration.

<sup>378</sup> COOMBE, *supra* note 23, at 198 (citation omitted) (emphasis added).

<sup>379</sup> *Id.*



FIGURE 18: THE ANGST GENERATED BY CLEVELAND’S CHIEF WAHOO

As **Figures 19–24** below further demonstrate, different registered stigmatizing trademarks have offered Native American activists and sympathizers further valuable opportunities for meaningful trademark counterpublicity. Reappropriating protected symbols through these sorts of creative critical enterprises is “more effective than written references to [them] especially when the positive connotations associated with a commodity/sign are challenged”.<sup>380</sup> For Coombe, such efforts are not only desirable; they are *essential* for counterpublics to articulate effectively their sense of identity and concerns in the postmodern world.<sup>381</sup> Other commentators have come to the fore in the post-*Tam* epoch and offered marginalized groups a legal framework to defend their trademark counterpublicity against claims of trademark infringement by trademark owners.<sup>382</sup>

---

<sup>380</sup> *Id.* at 261.

<sup>381</sup> *Id.* at 296. *See also id.* at 281.

<sup>382</sup> *See* Esther H. Sohn, *Countering the “Thought We Hate” with Reappropriation Use Under Trademark Law*, 94 N.Y.U. L. REV. 1729, 1758–64 (2019) (advancing a three-step “re-appropriation use” defense to trademark infringement claims). In Australia, such counterpublicity invoking registered marks is likely protected by the “implicit defence”





FIGURE 19: WASHINGTON REDSKINS TRADEMARK COUNTERPUBLICITY (2014)<sup>383</sup>

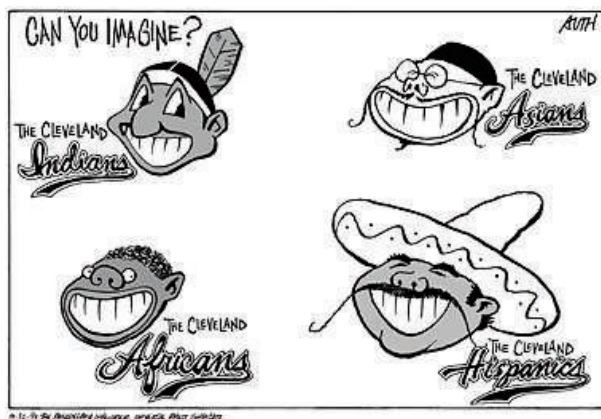


FIGURE 20: TONY AUTH'S 'CAN YOU IMAGINE?' CARTOON (1997)<sup>384</sup>

---

that such culture-jammed marks are not “use[d] as a trademark”, see *Trade Marks Act 1995* (Cth) s 120.

<sup>383</sup> One of many examples of trademark counterpublic culture.

<sup>384</sup> SPINDEL, *supra* note 318, at 209 (reproducing Tony Auth’s cartoon, originally published in the *Philadelphia Inquirer* on October, 22 1997).

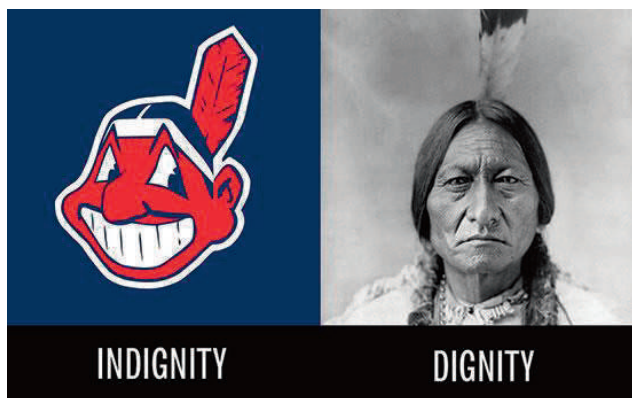


FIGURE 21: COUNTERPUBLICITY: CHIEF WAHOO VS SITTING BULL (2014)<sup>385</sup>



FIGURE 22: CLEVELAND INDIAN TRADEMARK COUNTERPUBLICITY<sup>386</sup>

<sup>385</sup> *The Shame of Stereotypes as Team Mascots*, *supra* note 348 (including an image of Chief Wahoo and Sitting Bull).

<sup>386</sup> Where is the Honor? (illustration), American Indian Movement, [www.aimovement.org/ncrsm/index.html](http://www.aimovement.org/ncrsm/index.html) [https://perma.cc/N7HH-RSBS]. The image on the right is taken from Larry Durstin, *I Will Shill No More Forever*, CLEV. LEADER (Apr. 1, 2011), <http://www.clevelandleader.com/archives/node/16451> (the original link with the image is broken, however a copy of the article can be found at <https://coolcleveland.com/2011/03/wahoo-resigns/>; the image does not appear in this copy, however the image can be found by searching “Crying Chief Wahoo” in Google search). See also another counterpublic culture-jammed faux Washington Team logo reproducing a potato in Randy Oliver, Fans Give Various Ideas for the Washington Redskins Name Change (July 2, 2020),

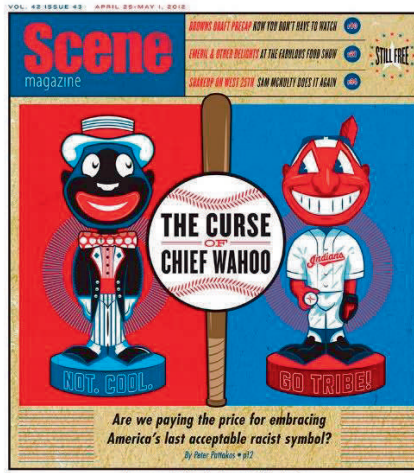


FIGURE 23: SCENE MAGAZINE'S COUNTERPUBLICITY<sup>387</sup>

The second assumption Habermas requires to challenge the “unofficial circulation of power” (i.e., where there is “illegitimate independence of social and administrative power vis-à-vis democratically generated communicative power”) is that the public sphere has had “sufficient occasion to exercise” the abovementioned “capabilities”.<sup>388</sup> This is plainly evident in the discourse involving stigmatizing trademarks. For Native Americans, the issue has reached crisis levels, and has prompted “accelerated learning processes”.<sup>389</sup> Moreover, in true Habermasian spirit, Harjo has demonstrated across multiple communicative platforms her profound willingness to

---

<https://dailysnark.com/2020/07/02/social-media-gives-various-ideas-for-the-washington-redskins-name-change/> [https://perma.cc/3P4Z-DHK4]. This image appears with others, such as the WASHINGTON KARENS. *Id.*

<sup>387</sup> Illustration drawing a connection between black face minstrelsy and the Native American mascot controversy, in SCENE MAGAZINE, Apr. 25–May 1, 2012 (cover page).

<sup>388</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 358.

<sup>389</sup> *Id.*

engage in rational argumentation in the public sphere concerning this issue. Not only has she published in books<sup>390</sup> and online,<sup>391</sup> but she has also engaged in internet chat room discussions,<sup>392</sup> engaged with traditional media, and most recently delivered an academic keynote address attended virtually by hundreds of participants scattered across the world.<sup>393</sup> Others in the public sphere, including sympathizers in mass media, have joined the struggle against commodified Native American otherness and invoked the disruptive power of social media and the internet, which even Habermas with his traditional bias towards print media and ‘quality newspapers’ now accepts as having some deliberative advantages over traditional mass media forms.<sup>394</sup>

The historical record reveals the discursive contest over the Washington REDSKINS trademarks was bitterly fought. The property rights enjoyed by the Washington REDSKINS generated significant revenue streams and were

---

<sup>390</sup> Harjo, *supra* note 331, at 189.

<sup>391</sup> See, e.g., Suzan Harjo, *Dirty word games*, INDIAN COUNTRY TODAY (June 17, 2005), <http://indiancountrytodaymedianetwork.com/content.cfm?id=1096411092> [<https://perma.cc/62HC-D9XC>].

<sup>392</sup> See, e.g., *Harjo: Get educated*, ESPN (June 3, 1999), <http://espn.go.com/otl/americans/harjochat.html> [<https://perma.cc/G35U-23EP>].

<sup>393</sup> Suzan Shown Harjo, *From Sacred Places to Playing Fields — The Long Struggle for Dignity and Respect at 9th Annual Peter A. Jaszi Distinguished Lecture on Intellectual Property* (Oct. 1, 2020).

<sup>394</sup> See HABERMAS, *Europe, supra* note 1, at 157 (stating “[i]nternet communication on the World Wide Web seems to counterbalance the weaknesses associated with the anonymous and asymmetrical character of mass communication because it makes it possible to reintegrate interactive and deliberative elements into an unregulated exchange between partners who communicate with one another as equals, if only virtually.”). Habermas then reverts to his pessimistic Frankfurt School shell and concerns about the internet “fragmenting” the “huge mass public”, before appearing to limit the Internet’s potential to ‘authoritarian regimes’. *Id.* at 158. See further WESSLER, *supra* note 181, at ch 5, 133–35.

not relinquished easily. Trader claims emphasizing substantial investment in the REDSKINS brand, and the development of a ‘secondary meaning’ divorced from its stigmatizing origins, simply compounds the ‘injury’ to Native Americans.<sup>395</sup> Lawyers for the Washington Redskins had regularly contributed to opinion-formation in academic<sup>396</sup> and non-academic publics.<sup>397</sup> In dismissing the unsuccessful 2009 Supreme Court certiorari petition, their lead attorney commented that “obviously, we’re pleased; it’s been a long road. We’re not surprised the court didn’t see *any issue worthy of review*”.<sup>398</sup> Notwithstanding their TTAB defeat, the Pro-Football organization had expressed confidence in the legal merits of its appeal. Somewhat cynically, some Native Americans, against the wishes of their nation, were even ‘recruited’ to support the REDSKINS cause.<sup>399</sup>

If experience was anything to go by, the REDSKINS cancellation provisions would be bogged down by further

---

<sup>395</sup> COOMBE, *supra* note 23, at 197.

<sup>396</sup> Robert Raskopf, No Turning Back the Clock: The Significance of Laches in *Pro-Football, Inc. v. Harjo, et.al.* at the 19<sup>th</sup> Annual Intellectual Property Law Conference (Apr. 1–2, 2004).

<sup>397</sup> See, e.g., Press Release, Robert Raskopf, *Open Letter* (June 8, 2014) (on file with author).

<sup>398</sup> Robert Raskopf as quoted in Robert Barnes, *High Court Won’t Hear Case Involving Redskins’ Nickname*, WASH. POST (Nov. 17, 2009), <http://www.washingtonpost.com/wp-dyn/content/article/2009/11/16/AR2009111601298.html> [<https://perma.cc/8E9V-MN2F>]

<sup>399</sup> See, e.g., Barry Petchesky, *Disgraced, Soon-To-Be-Former Navajo Nation President Attends ‘Skins Game*, DEADSPIN (Oct. 12, 2014), <http://deadspin.com/disgraced-soon-to-be-former-navajo-nation-president-at-1645509844> [<https://perma.cc/8MQD-8UDQ>]. Free tickets and merchandise are also offered as inducement to Native American high schools; see Ian Shapira, *In Arizona, A Navajo High School Emerges as a Defender of the Washington Redskins*, WASH. POST (Oct. 26, 2009), [https://www.washingtonpost.com/local/in-arizona-a-navajo-high-school-emerges-as-a-defender-of-the-washington-redskins/2014/10/26/dfc773a-592b-11e4-8264-deed989ae9a2\\_story.html](https://www.washingtonpost.com/local/in-arizona-a-navajo-high-school-emerges-as-a-defender-of-the-washington-redskins/2014/10/26/dfc773a-592b-11e4-8264-deed989ae9a2_story.html) [<https://perma.cc/SL5T-EK2Q>].

legal technicalities and obfuscations. But then came *Tam*, rendering all this moot. Despite the complications generated by the *Tam* decision, the issue for Native Americans remained fundamentally about human dignity, which should and did ultimately prevail.<sup>400</sup> Critical publicity meant that Native American concerns could no longer be ignored. The opening of public sphere’s sluices has resulted in an inundation of material in the strong public spheres that make the state and the market more attentive to those concerns. With regard to states, numerous bills were proposed,<sup>401</sup> and Acts passed<sup>402</sup> seeking the removal of Native American mascots from the public sphere. In May 2014, 50 US Senators, half the U.S. Senate, penned a letter to NFL Commissioner Roger Goodell demanding the REDSKINS change its name.<sup>403</sup>

Even on the global stage, James Anaya, the UN Special Rapporteur on the rights of Indigenous peoples, has called on the Washington REDSKINS to change its name. Anaya reminded team owners that, for many, the “term ‘redskin’ is inextricably linked to a history of suffering and dispossession”, and that it is a “pejorative and disparaging term that fails to respect and honor the historical and cultural legacy of the Native Americans”.<sup>404</sup> Through this local and

---

<sup>400</sup> Habermas notes that not all rights have “absolute validity”; each right is subject to “limits”, which are “ultimately justified by the *principle of equal respect for each person*”. HABERMAS, *Between Facts and Norms*, *supra* note 61, at 204 (emphasis added).

<sup>401</sup> See H.R. 684, 114th Cong. (2015).

<sup>402</sup> See Assemb. B. No. 13, Reg. Sess. (Cal. 2005–06) (showing an act to add Article 3.5 to Chapter 2 of Part 1 of the Education Code, relating to schools).

<sup>403</sup> Mark Maske, *Senate Democrats urge NFL to endorse name change for Redskins*, WASH. POST (May 22, 2014), [https://www.washingtonpost.com/sports/senate-democrats-urge-nfl-to-endorse-name-change-for-redskins/2014/05/22/f87e1a4c-e1f1-11e3-810f-764fe508b82d\\_story.html](https://www.washingtonpost.com/sports/senate-democrats-urge-nfl-to-endorse-name-change-for-redskins/2014/05/22/f87e1a4c-e1f1-11e3-810f-764fe508b82d_story.html) [<https://perma.cc/EAS5-5HQ7>].

<sup>404</sup> Office of the High Commissioner for Human Rights, USA: ‘Redskins’ Team Mascot Hurtful Reminder of Past Suffering of Native

transnational bombardment of the state apparatus, we see how “communicative power is exercised in the manner of a siege”, influencing “judgment and decision making in the political system without intending to conquer the system itself.”<sup>405</sup> In other words, even though it took much too long, change had begun.

Before the unwelcomed intrusion of *Tam*, it appeared that the animated public sphere was maintaining this domestic and international pressure with a view to ensuring the fulfilment of law’s legitimacy and by this we mean the cancellation of registered racist trademarks. After all, when one contemplates the damaging cultural role of such trademarks, trader and consumer (i.e., supporter) interests should give way to the broader public interest in preventing their registration. But, as we noted, the Supreme Court did not see it that way, instead preferring *Tam*’s free speech (and proprietary interests) over the competing public interest of non-disparagement. In other words, the ‘sluices’, which offered so much promise, were forced shut, raising uncomfortable questions (which cannot be pursued here) about whether engagement in the trademark bureaucratic processes and legal actions reproduced and reinforced the hierarchies that further institutionalized Native American oppression.<sup>406</sup>

---

Americans – UN rights expert, U.N. Press Release (Apr. 11 2014), available at <http://www.ohchr.org/EN/NewsEvents/Pages/DisplayNews.aspx?NewsID=14497&LangID=E#sthash.AqLRtWnq.dpuf> [<https://perma.cc/5VWU-8ZUP>].

<sup>405</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 486–87.

<sup>406</sup> See especially Brian Tamanaha’s skepticism as to discourse theory and the perception of law through the eyes of marginalized groups, stating “[t]he most dominant experience of law from below is that it is irrelevant”, Tamanaha, *supra* note 187, at 997. See also BRIAN TAMANAHA, *A GENERAL JURISPRUDENCE OF LAW AND SOCIETY* (2001).



FIGURE 24: CHANGE THE NAME SOCIAL MEDIA CAMPAIGN<sup>407</sup>

Shorn of any effective legal remedy courtesy of *Tam* and recalling Habermas’ warning that “communication structures of the public sphere must ... be kept intact by an energetic civil society”,<sup>408</sup> the extraordinary BLM-inspired mobilization of the broader public sphere against all forms of racial injustice, including racist symbols, proved a lifeline for Native Americans and their allies. Racist trademarks invoking Black servitude, such as the ‘mammy stereotype’ embodied in the AUNT JEMINA trademark, were also in the cross hairs. This coalescence of multiple and overlapping counterpublics and supporters in the dominant groups then focused on pressuring transgressing actors in the market economy (e.g., brands owners of racist marks and their suppliers) and lobbying agents in the strong public sphere (e.g., politicians). The overwhelming shift in public opinion harnessed through the BLM movement in turn provided unstoppable momentum for Native American

<sup>407</sup> Taken from Taika Waititi’s “Change It” tweet rallying against the continued use of Redskins trademarks that are “destructive to Native communities and cannot be tolerated any longer”, see @taikaWaititi, TWITTER (June 25, 2020, 12:13 PM), <https://twitter.com/taikawaititi/status/1276186696728449025?lang=en> [<https://perma.cc/29H2-CYMV>] (last visited May 27, 2021).

<sup>408</sup> HABERMAS, *Between Facts and Norms*, *supra* note 61, at 369. Here, Habermas was praising social movements as he recognizes that “basic constitutional guarantees alone, of course, cannot preserve the public sphere and civil society from deformations”. *Id.*



counterpublic resistance, including the Oneida Nation led Change the Mascot campaign (see **Figure 24** above).

Politicians insisted that any ambitions that the Washington REDSKINS harbored to build a new stadium in Washington, D.C. would be frustrated unless they changed their name.<sup>409</sup> Further, and importantly, Native American and sustainable investment firms (financial counterpublics) that had earlier pursued innovative ways to pressure FedEx, the team's major sponsor for more than 20 years,<sup>410</sup> intensified their efforts during the BLM-inspired racial awakening in the US.<sup>411</sup> This was a telling move because FedEx and other sponsors succumbed to this pressure and forced Dan Snyder's hand to change the team name.<sup>412</sup> The

---

<sup>409</sup> See Liz Clarke, *Unless Daniel Snyder changes Redskins' name, RFK site is off the table, officials say*, WASH. POST (July 2, 2020), <https://www.washingtonpost.com/sports/2020/07/01/unless-daniel-snyder-changes-redskins-name-rfk-site-is-off-table-officials-say/> [https://perma.cc/23XJ-56BP].

<sup>410</sup> Timothy Spangler, *Washington Redskins sponsors under pressure over team name controversy*, GUARDIAN, (June 27, 2014), <https://www.theguardian.com/sustainable-business/2014/jun/26/washington-redskins-sponsors-pressure-team-name-controversy> [https://perma.cc/9M5M-WV3P]; Mark Holan, *Activist shareholders denied vote on FedEx's association with Washington Redskins*, WASH. BUS. J. (July 15, 2014), <https://www.bizjournals.com/washington/blog/2014/07/activist-shareholders-denied-vote-on-fedexs.html> [https://perma.cc/HF3Z-4WTV] (discussing Brandon Stevens, of the Oneida Tribe, together with corporate ally shareholders urging FedEx and its CEO Fred Smith to “demonstrate their commitment to diversity and respect for Native American culture and tradition by taking a stand against this racist team name”).

<sup>411</sup> Representing a combined value of \$620 billion in assets, these investor groups referenced the BLM movement and encouraging sponsors to “meet the magnitude of the moment” and force the team to change its name, see Alison Kosik, *FedEx asks the Washington Redskins to change their name after pressure from investor groups*, CNN BUS. (July 3, 2020), <https://edition.cnn.com/2020/07/02/business/fedex-washington-redskins/index.html> [https://perma.cc/YC5R-TJPG].

<sup>412</sup> Fed-Ex's general counsel penned a letter citing “reputational damage” caused by continued sponsorship and would no longer sponsor the team

team is now called the Washington Football Team. Having “won the argument” in the public sphere and noting the Native American movement’s incredible multi-decadal success in decommissioning thousands of racist sports mascots and imagery, Suzan Harjo explains her frustration at the obstinacy of the Washington football team, likening their position to “Custer’s last stand”.<sup>413</sup>

Trader abandonment of (and atonement for) racist trademarks may now go some way in repairing “some of the harm ... inflicted on Native Americans’ self-esteem by decades of exposure to demeaning names and mascots”.<sup>414</sup> As Ray Halbritter explains, “future generations of Native youth will no longer be subjected to this offensive and harmful slur every Sunday during football season”.<sup>415</sup> These changes may well contribute to an enlargement of the public sphere for Native Americans — involving the articulation of their broader democratic, economic, and socio-cultural interests — in a similar way that some commentators say that the abandonment of blackface minstrelsy and stigmatizing Black commercial imagery in the late twentieth century public sphere created the “cultural space for the creation of

---

unless the name was changed, costing the team \$45 million a year for the remaining 6 years of the stadium naming deal, see Adam Kilgore & Scott Allen, *Washington’s name change happened fast, but it was decades in the making*, WASH. POST (July 14, 2020), <https://www.washingtonpost.com/sports/2020/07/13/washingtons-name-change-happened-fast-it-was-decades-making/> [https://perma.cc/LE3G-72PH].

<sup>413</sup> Milloy, *supra* note 2. But note the team’s political machinations seeking to circumvent this political resistance. *Id.*

<sup>414</sup> Brief for National Congress of American Indians et al., *supra* note 362, at \*29.

<sup>415</sup> Ray Halbritter, *The terrible R-word that football needed to lose*, CNN (July 14, 2020), <https://edition.cnn.com/2020/07/13/opinions/renaming-washington-redskins-football-team-halbritter/index.html> [https://perma.cc/33DP-QT4V].

African American identities,”<sup>416</sup> and facilitated the redeployment of precious counterpublic energies for the articulation of broader African American political, economic and democratic concerns.<sup>417</sup>

The final point that needs to be made here is that the Native American struggle for communicative equality illustrates that the trademark registration process and legal system did not operate as they should. (Although for critical race theorists, perhaps the system operated as expected.) It ought not to have been this difficult to respond to the communicative interests of marginalized Others contesting troubling registrations in the public sphere that affected them. As indicated above, contestation in the US through the law and trademark registration in the post-*Tam* milieu process is rendered moot. Now totally free from the civilizing restraints of the disparagement provision (at least as interpreted in modernity), more traders may seek to register their racist trade signifiers,<sup>418</sup> whether they are ‘reclaimed’ or just ‘claimed’. It remains to be seen whether the empirical evidence supports these theoretical musings,<sup>419</sup> but fears about re-colonizing the images of the Other are

---

<sup>416</sup> COOMBE, *supra* note 23, at 297. Also urging that the “imagery of Indian alterity... be abandoned (or gifted) to create political room in the public sphere of mass commerce”. *Id.* at 297–98.

<sup>417</sup> See CHAMBERS, *supra* note 82, at 4–6; ch 3 (exploring blacks’ struggles in the market economy and for the “full privileges of citizenship”, especially via the Civil Rights Movement and its mutually beneficial concomitant effect on the advertising industry); WEEMS, *supra* note 135, at 8 (linking Black disenfranchisement in politics and the economy to the ubiquity of demeaning images of blacks at the turn of the last century).

<sup>418</sup> But post-*Tam*, see the growing tendency of the USPTO employing (albeit inconsistently) the “failure to function” grounds to deny registration to N-word marks discussed in Huang, *supra* note 291.

<sup>419</sup> Early indications suggest that the proverbial floodgates have not opened, but as the historical record shows, Native American imagery continues to be the most dominant form of racialized trademark registered by non-referenced groups: *see id.*

real. As Nancy Fraser points out, not all subaltern counterpublics are “virtuous”,<sup>420</sup> so there is little that might thwart right-wing extremists (e.g., QANON, ALT-RIGHT) securing intolerable trademark registrations. Whether there amounts to a trickle or a flood is beside the point; the fact that symbols of hate may now circulate as registered species of property in the U.S., aided and abetted by the advantages that federal trademark registration provides, is troubling.

## VI. CONCLUSION

Trademarks operate not only in the market economy, they also circulate in and inhabit private, weak and strong public spheres. In democratic societies, racist trademarks — especially registered (contentiously ‘state-sanctioned’) racist marks — are against the public interest because they have negative practical and normative repercussions in civil society, mostly for marginalized groups implicated by such marks. We saw, for example, that legitimating trademarks

---

<sup>420</sup> Compare Fraser, *supra* note 60, at 124 (stating “I do not mean to suggest that subaltern counterpublics are always necessarily virtuous. Some of them, alas, are explicitly antidemocratic and antiegalitarian....”), with WESSLER, *supra* note 181, at 150–51, writing:

From a Habermasian perspective it is thus not enough for counterpublic actors to voice moral feelings of indignation and contempt in what they perceive as a moral transgression, even if they manage to secure a counterpublic space for themselves or a strong voice in the dominant public sphere, the legitimacy of the claim matters, too, and it *hinges on the degree to which the claim can be backed up by good arguments that the feeling of indignation or violation reacts to actual injustice*. This is why right-wing counterpublics such as... the “alt-right” movement in the United States cannot be considered subaltern counterpublics. They do not express the injustice experience by subordinated social groups, but by and large aim at maintaining structures of domination and exclusion. (emphasis added).

that contain harmful communicative messages through registration impinges on the communicative capacities of marginalized groups to challenge this legitimation in the broader public sphere. This Article has situated the problem of racist branding and stereotypes in trademarks in the broader context of Habermas' public sphere and his discourse theory of deliberative democracy, as well as against the milieu of the BLM social justice movement. The main argument pursued is that contesting and eradicating stigmatizing trademarks — particularly registered ones — contributes to a more inclusive public sphere for marginalized groups formerly implicated by such marks.

Considerable attention was paid to explaining Habermasian public sphere theory, as first set out in *Structural Transformation*, and later revised by Habermas in response to strong criticisms of his early conception of the public sphere. Abstractions are one thing, but normative discussion benefits greatly from grounded historical experience. Thus, limited historical examples of stigmatizing commercial imagery and trademark registrations drawn from the archives and reproduced in this Article are studied. These historical trademark registrations show that the legal system (including the trademark registration process) did not operate in a manner sensitive to the problem of racist trademarks, mainly because decision-makers seemed callously indifferent or perhaps oblivious to such marks' inherently problematic nature. At first, despite autochthonous resistance, racist trademark registrations were not eradicated straightaway, mainly because marginalized groups, effectively disenfranchised at that time, could not garner broader societal support regarding the relevant trademarks' problematic nature, or challenge those marks' registration through relevant but obscure administrative processes. Put bluntly, oppressed groups in settler colonial countries were busy trying to survive. The historical public sphere demonstrates that the market also did

not offer a timely correction to stigmatizing commercial symbols because it, too, did not consider such symbols problematic. As a result, legally protected and commercially viable stigmatizing trademarks long lingered in the public sphere, some for over a century,<sup>421</sup> before they became matters of universal concern in liberal democracies. While counterpublics managed much success against racist branding and stereotypes through political and economic resistance (including through consumer boycotts), efforts which strengthened as civic rights expanded, stubborn tropes referencing Native Americans and Black people nonetheless remained.

By way of the Native American Mascot controversy, this Article then focused on Native American intergenerational challenges to the Washington REDSKINS trademarks through deliberative democratic models and then-available legal avenues. These encounters witnessed strong resistance by trademark owners, faltering efforts, and, for a fleeting moment, appeared promising. Through their collective responses (including trademark counterpublic cultural reappropriation) to stigmatizing trademarks referencing them, and by enlivening legal mechanisms then available, marginalized groups in modern democracies were making some progress in challenging the law's determined protection of disparaging marks. That is to say, the limited success enjoyed by Native American petitioners following their successful cancellation proceedings of the Washington REDSKINS suite of trademarks demonstrates that there was at *one* point valuable sluices within the legal system (especially trademark law) amenable to the public sphere's communicative power. Expounding on this point, we saw, through the lens of Habermasian discourse theory, how unrelenting, informal opinion-formation challenging

---

<sup>421</sup> See, for example, AUNT JEMIMA, UNCLE BEN, and other racist stereotypes depicted in Part II *supra*.

stigmatizing representations (cultivated in a network of weak or counterpublic public spheres) influenced strong public spheres (i.e., those within the state) by demanding removal of those representations via trademark cancellation proceedings. Moreover, it was surmised that engaging trademark law's administrative and legal systems to remove racist marks that had much earlier facilitated their registration would improve the democratic legitimacy of modern liberal democracies, particularly for marginalized groups.

But, alas, in the United States, for Native Americans and others who had hoped to challenge stigmatizing marks in a similar way, that democratic undertaking never saw completion through the law; *Tam* had snatched jurisprudential victory in the cruelest of ways. There are evidently limits as to what deliberative democracy can do when it meets the roadblock of an unforgiving conception of Free Speech, which in the United States now facilitates the potential registration of hate speech masquerading as commercial symbols. However, in other liberal democracies where there are prohibitions on the registration of offensive marks, marginalized groups can rely on their local laws to challenge stigmatizing trademarks,<sup>422</sup> including those that enjoy registration in the United States.

Nonetheless, in perhaps the biggest paradox of all, the law, in the end, did not matter that much and greater democratic legitimacy was in fact realized through the international mobilization of the public sphere and the political struggle against all forms of racial prejudice, including those embodied in racist brands and trademarks. Notwithstanding *Tam*, and perhaps even because of the long shadow it cast, the Black Lives Matter movement filled the

---

<sup>422</sup> See, e.g., Vicki Huang, *Comparative Analysis of US and Australian Trade Mark Applications for the SLANTS*, 40 EUR. INTELL. PROP. REV. 429, 430 (2018) (regarding IP Australia's denial of a trademark application for 'THE SLANTS').

corrective void left by the law's inability or unwillingness to address the longstanding issue of racist branding and trademarks. Here, in this moment of crisis, and notwithstanding the threat to life and limb brought on by the COVID pandemic, Black Lives Matter, Native American, and other subaltern counterpublics were joined by allies drawn from the dominant hegemony, further buttressing the calls for justice. In this way, the powerful Black Lives Matter counterpublic served as a lightning rod for race consciousness in Western liberal democracies and proved that it is possible to combat institutionalized racism through online discursive communities coupled with mass demonstrations. Considerable extra-legal avenues, including weeks-long national and international protests, threats of boycott, shareholder activism, and intense social media civic agitation helped secure liberation from oppressive symbols. Evidently, that is what is required to eliminate enduring racist trademarks and branding from the public sphere. The work of this Article, then, is to draw to attention both the problem of racist trademarks and the importance of resisting these marks in the public sphere. In so doing, it calls, where it is possible, for trademark law to address the issue of stigmatizing trademarks, and where this is not possible, for a combination of acerbic tweets and the power of the streets.



## TEMPORALITY IN A TIME OF TAM, OR TOWARDS A RACIAL CHRONOPOLITICS OF INTELLECTUAL PROPERTY LAW

ANJALI VATS\*

### ABSTRACT

*This Article examines the intersections of race, intellectual property, and temporality from the vantage point of Critical Race Intellectual Property (“CRTIP”). More specifically, it offers one example of how trademark law operates to normalize white supremacy by and through judicial frameworks that default to Euro-American understandings of time. I advance its central argument—that achieving racial justice in the context of intellectual property law requires decolonizing Euro-American conceptions of time—by considering how the equitable defense of laches and the judicial power to raise issues sua sponte operate in trademark law. I make this argument through a close reading of the racial chronopolitics of three cases: Harjo v. Pro-Football, Inc. (2005), Matal v. Tam (2018), and Pro-*

---

\* Anjali Vats is Associate Professor of Law at the University of Pittsburgh School of Law with a secondary appointment in the Department of Communication at the University of Pittsburgh. This Article develops arguments initially presented in her book, *The Color of Creatorship: Intellectual Property, Race and the Making of Americans* (Stanford UP, 2020). Thank you to Michael Madison for his thoughtful comments on an earlier version of this Article and the editors at *IDEA: The Law Review of the Franklin Pierce Center for Intellectual Property* for their hard work on this symposium. My gratitude as well to all of those who have attended and supported Race + IP over the years. The ideas and community shared at that conference have made this a stronger piece. This Article is dedicated to Margaret Chon, whose mentorship and care have made me a better scholar. The theoretical interventions here have been profoundly shaped by conversations with her and engagements with her scholarship.

*Football, Inc. v. Blackhorse (2015). Through this critical examination, I aim to illuminate where and how time works to hinder racial justice in trademark law and encourage lawyers and judges invested in progressive intellectual property to intentionally decolonize their Euro-American temporal defaults.*

Abstract.....	673
Introduction.....	675
I. Situating Race in Trademark Law .....	684
A. That Washington Football Team .....	688
B. The Band With No Name .....	693
C. Free Speech as Racial Triangulation.....	696
II. Critical Race Intellectual Property and the Politics of Time .....	699
A. Temporal Attunement in Intellectual Property Law .....	702
B. Laches, Racial Time & Equity.....	705
C. Sua sponte, Racial Time & Judicial Decision-making .....	711
III. The Racial Chronopolitics of (Trademark) Law.....	715
A. Racial Time Maps in Legal Practice .....	719
B. Mapping Racial Time in Harjo, Blackhorse, and Tam. ....	722
C. Decolonizing Trademark Law’s Temporalities ..	728
IV. Conclusion .....	732

## INTRODUCTION

After Joseph Biden won the 2020 presidential election, in an episode hosted by Dave Chappelle, *Saturday Night, Live!* led with a trademark skit.<sup>1</sup> A lot of people have lost their jobs recently, Chappelle reminded us, including unfortunately a lot of Black people.<sup>2</sup> “Sadly,” he said, “these two Black people may never get their jobs back.”<sup>3</sup> The skit then cut to a non-descript skyscraper, followed by a board room, before zooming in on Maya Rudolph in a red sweater with a white bow, a yellow bandana, bright red lipstick, and pearl earrings sitting across from two white men and a white woman, played by Alec Baldwin, Mikey Day, and Heidi Gardner.<sup>4</sup> The emotional scene began with Rudolph:

“Who doesn’t love my pancakes?!?”

“*Everyone* loves your pancakes, Aunt Jemima.”

“It’s you. You’re the problem.”

“Me? What did I do?”

“It’s not what you did. It’s how you make us feel about what we did.”

“But you can’t fire me. I’m a slave! That’s the only good thing about your job, is the job security!”<sup>5</sup>

The two white men and one white woman in the room proceeded to fire Aunt Jemima, as well as Uncle Ben and Count Chocula, with the Allstate Man, who defended

---

<sup>1</sup> *Saturday Night Live: Uncle Ben*, (NBC television broadcast Nov. 7, 2020), <https://www.nbc.com/saturday-night-live/video/uncle-ben/4262856> [<https://perma.cc/2XNH-LM5V>].

<sup>2</sup> *Id.*

<sup>3</sup> *Id.*

<sup>4</sup> *Id.*

<sup>5</sup> *Id.*

himself by saying “I sell security, my deep Black voice makes white people feel safe, like they’re in good hands,”<sup>6</sup> barely escaping the same fate as the fictitious characters next to him despite pointing out that he’s a real person. The joke, of course, was that these familiar, long-lived trademarks were finally being canceled, because white people were no longer comfortable with their potential costs not because they recognized the injustice of their ways.<sup>7</sup>

Beyond the apparent critique of racist trademarks, this sketch makes a pointed commentary on anti-Black racism. Like the fictional characters in the room, Chappelle’s Allstate Man is treated as a potential liability. Even after he reminds his employers that he’s a real person, Baldwin persists because it is “better to be safe.”<sup>8</sup> The audience is reminded that anti-Blackness extends far beyond trademarked images. This skit showcases the tendency of branding to operate as racial practice and white liberalism to center superficial solutions, such as changing trademarks, at the expense of genuine equity, such as employing Black people.<sup>9</sup> Baldwin’s comments reveal that the object of the

---

<sup>6</sup> *Id.*

<sup>7</sup> In summer 2020, a number of racist trademarks were retired by their owners. But as attempts to revive those trademarks show, brand culture is deeply linked with race. Beth Kowitt, *Inside the Cottage Industry Trying to Revive Aunt Jemima and Other Brands with Racist Roots*, FORTUNE (Dec. 8, 2020), <https://fortune.com/2020/12/08/aunt-jemima-uncle-bens-eskimo-pie-brands-racist-roots-revived-black-lives-matter-movement-trademarks/> [<https://perma.cc/P9EA-WEK5>].

<sup>8</sup> *Saturday Night Live: Uncle Ben*, *supra* note 1.

<sup>9</sup> Lauren Berlant traces how (white) American identity was forged through differentiation from people of color represented in popular brands. See generally LAUREN BERLANT, *THE FEMALE COMPLAINT: THE UNFINISHED BUSINESS OF SENTIMENTALITY IN AMERICAN CULTURE* (2008). See also Rosemary J. Coombe, *Marking Difference in American Commerce: Trademarks and Alterity at Century’s End*, 19 POLAR: POL. & LEGAL ANTHROPOLOGY REV. 105, 106, 108 (1996) (showing that trademarks are integral to the negotiation of identity in the public sphere); Sarah Banet-Weiser & Charlotte Lapsansky, *RED is the New*

firings is to make white people comfortable, not repair the damage of structural racism. The Allstate Man's response, that his voice makes white people feel safe, comedically highlights the coded dance of racism by hyperfocusing on the experiences and feelings of white people to avoid getting fired. Unlike the Allstate Man, who reminds the audience that his real name is Man from *Waiting to Exhale*, Aunt Jemima appeals to her *own* feelings, not those of the white people hiring and firing her. Her appeals fail, partly due to her (quasi-)fictional status and partly due to their focus on her own interiority.<sup>10</sup> Whiteness prevails, even in anti-racism, because it centers the wishes of white people.

---

*Black: Brand Culture, Consumer Citizenship and Political Possibility*, 2 INT'L J. OF COMM'N 1248, 1261 (2008) (arguing that race itself can operate as a brand in a culture that values "wokeness").

<sup>10</sup> See, e.g., Eden Osucha, *The Whiteness of Privacy: Race, Media, Law*, 24 CAMERA OBSCURA: FEMINISM, CULTURE, & MEDIA STUD. 67, 78, 97 (2009). Osucha observes how white people were assumed to have an interiority that needed protecting, contra their Black and Brown counterparts:

By "representational protocols" I mean to suggest how racial difference was elaborated in visual culture through the conjunction of honorific deployments of photography with a thoroughly repressive grammar of popular stereotype related to the taxonomic gaze established in the visual practices of science and the state. The nonindividuating modes of representation conventional for the depiction of people of color stand in contrast to the routine signification of whiteness in nineteenth-century visual culture through explicitly individuating forms of image making — most prominently, the commercially produced, privately circulated photographic portrait. Such practices affirmed whites' supposedly natural endowment with capacities for "self-elaboration" and also aligned white subjectivity with the very notion of self-possessive interiority that [Samuel] Warren and [Louis] Brandeis describe as the natural basis of the privacy rights claim. *Id.* at 78 (internal quotation marks omitted).

The *SNL* skit also highlights that branding creates *temporal* problems as well as racial ones. The trademarks in the sketch represent the past and present of American racial politics, weaving a complex narrative of when and how race has operated in the nation. Aunt Jemima, played by the racially ambiguous Rudolph, bridges the Antebellum with the Postbellum. The character is dressed in her “updated” attire, in Quaker Oat’s vision of post-civil rights era apparel.<sup>11</sup> Situated alongside Uncle Ben, she reminds the viewer that both trademarks were created in order to reproduce the racial order of the American South in a post-Emancipation era.<sup>12</sup> Count Chocula, a character who came out of the 1960s, stirred up controversy for reasons more related to Dracula than to race.<sup>13</sup> He is fired even though he arguably never represented a Black man at all.<sup>14</sup> The Allstate Man, like Aunt Jemima 2.0, represents the racial present, as well as the inequalities that mark it. He also demonstrates that, though white people’s comfort level about their own racism has evolved over time, Black

---

<sup>11</sup> This, of course, misses the reality that Aunt Jemima originated from minstrel shows and racialized labor. Her character, I would argue, is forever inseparable from “the afterlives of slavery.” M. M. MANRING, *SLAVE IN A BOX: THE STRANGE CAREER OF AUNT JEMIMA* 60, 66–67 (1998); SAIDIYA V. HARTMAN, *LOSE YOUR MOTHER: A JOURNEY ALONG THE ATLANTIC SLAVE TRADE ROUTE TERROR* 6 (2007). See also Devon Powers & Ashley Pattwell, *Immortal Brands? A Temporal Critique of Promotional Culture*, 13 *INT’L J. OF MEDIA & CULTURE* 202 (2015).

<sup>12</sup> See Richard Schur, *Legal Fictions: Trademark Discourse and Race*, in *AFRICAN AMERICAN CULTURE AND LEGAL DISCOURSE* 191 (Loveralie King & Richard L. Schur eds., 1st ed. 2009); see also Coombe, *supra* note 9, at 106.

<sup>13</sup> Jake Rossen, *The Weirdly Controversial History of Count Chocula, Franken Berry, and Boo Berry*, *MENTAL FLOSS* (Oct. 20, 2016), <https://www.mentalfloss.com/article/87686/when-count-chocula-court-controversy> [<https://perma.cc/EFK7-JRX8>] (arguing that the controversies around Count Chocula had to do with everything but race).

<sup>14</sup> *Id.*

Peoples' situations have remained dire, with events like economic depression and global pandemic having a disproportionate effect on their well-being and survival.<sup>15</sup>

I begin with this skit because it offers an important entrée into the subject of this Article: the intersecting politics of race and time in intellectual property law. Temporal concerns, as legal scholars have repeatedly observed, are inescapable in legal contexts.<sup>16</sup> They are also the product of cultural *choices*, not immutable facts.<sup>17</sup> Thinking about time, specifically how it operates and the implications of its flows, is valuable to understanding, as Orly Lobel puts it, “the contingency and range of possibilities for regulating temporalities and social interaction.”<sup>18</sup> I build on existing interdisciplinary work at the intersections of law and time by attending to the contours of temporality in the context of intellectual property law, as they implicate racial justice. I show how, in trademark law, the decision to default to Euro-American imaginaries of time work in the service of whiteness. More specifically, I show that courts have considerable discretionary authority to invoke and impose “racial time maps,”<sup>19</sup> which they have exercised in trademark law to the detriment of Indigenous Peoples specifically and people of color more generally.

---

<sup>15</sup> See, e.g., Steven Greenhouse, *The Coronavirus Pandemic Has Intensified Economic Racism Against Black Americans*, THE NEW YORKER (July 30, 2020), <https://www.newyorker.com/news/news-desk/the-pandemic-has-intensified-systemic-economic-racism-against-black-americans> [<https://perma.cc/QG7J-3LNJ>]. This, of course, is after a period in which white nationalism and overt racism once again became commonplace.

<sup>16</sup> As Todd D. Rakoff writes: “there is a lot of law that has a substantial impact on how we organize and use time.” TODD D. RAKOFF, *A TIME FOR EVERY PURPOSE: LAW AND THE BALANCE OF LIFE 2* (2002).

<sup>17</sup> *Id.* at 3.

<sup>18</sup> Orly Lobel, *Book Review: The Law of Social Time*, 76 *TEMPLE L. REV.* 357, 361 (2003).

<sup>19</sup> Charles W. Mills, *The Chronopolitics of Racial Time*, 29 *TIME & SOC'Y* 297, 299–300, 303 (2020).

Charles Mills incisively writes: “Whose *space* it is depends in part on whose *time* it is, on which temporality, which version of time, can be established as hegemonic.”<sup>20</sup> Margaret Chon’s term “procedural gaslighting”<sup>21</sup> provides a framework for thinking about how such temporal management can operate as a mechanism through which courts deny and invalidate the realities of marginalized groups through the workings of legal procedure. In brief, she contends that gaslighting, “the act of undermining another person’s reality by denying facts, the environment around them, or their feelings,”<sup>22</sup> can occur through the strategic use of legal procedure. The impact of this can be significant as “targets of gaslighting are manipulated into turning against their cognition, their emotions, and who they fundamentally are as people.”<sup>23</sup> I maintain that one strand of procedural gaslighting functions through the invocation of one conception of time over another, with considerable racial implications. Racial time maps, as Mills understands them, are cultural and political topographies of race and temporality, built around the perspectives of particular groups of people. Racial time maps are a means of understanding “racial chronopolitics;”<sup>24</sup> they help to home in on the relationships between social and political choices, race, and time. Mills explains: “The past is ‘packaged’ through ‘schemata’ that can be likened to ‘mental relief maps’ designed to accommodate particularly ‘historical narratives’ . . . that purport to establish ‘defining moments.’”<sup>25</sup>

---

<sup>20</sup> *Id.* at 301 (emphasis added).

<sup>21</sup> Unpublished Phone Conversation Between the Author and Margaret Chon (Feb. 7, 2021).

<sup>22</sup> Robin Stern, *Gaslighting, Explained*, VOX (Jan. 3, 2019, 10:22 AM), <https://www.vox.com/first-person/2018/12/19/18140830/gaslighting-relationships-politics-explained> [<https://perma.cc/G95L-PYGX>].

<sup>23</sup> *Id.*

<sup>24</sup> Mills, *supra* note 19; *see also* LISA M. CORRIGAN, BLACK FEELINGS: RACE AND AFFECT IN THE LONG SIXTIES 34–35 (2020).

<sup>25</sup> Mills, *supra* note 19, at 300 (internal citation omitted).



For instance, as Mills argues, a racial time map centered by Judaism necessarily conflicts with a racial time map centered by Islam when differing narratives of history, memory, religion, property, and resources collide.<sup>26</sup> In an example that resonates strongly for many in this moment in its references to Al Nakba, land ownership is determined by racialized temporalities.<sup>27</sup> In this instance, the reading of Al Nakba as completed event v. ongoing struggle is shaped by race, ethnicity, and religion.

This Article reflects on the relationships among race, intellectual property, and temporality from the vantage point of Critical Race Intellectual Property (“CRTIP”).<sup>28</sup> More specifically, it offers one example of how trademark law operates to normalize white supremacy by and through judicial frameworks that default to Euro-American racial time maps. I advance its central argument—that achieving racial justice in the context of intellectual property law requires decolonizing Euro-American conceptions of time—by considering how the equitable defense of laches and the judicial power to create issues sua sponte operate in trademark law. I make this argument through a close reading of the intersections of race and time in three cases: *Harjo v. Pro-Football, Inc.* (2005), *Matal v. Tam* (2018), and *Pro-Football, Inc. v. Blackhorse* (2015). Through this critical examination, I aim to illuminate where and how time works to hinder racial justice in trademark law and encourage lawyers and judges invested in progressive intellectual property to intentionally decolonize their Euro-American

---

<sup>26</sup> *Id.* at 301–02.

<sup>27</sup> *Id.*

<sup>28</sup> Anjali Vats & Deidré Keller, *Critical Race IP*, 36 *CARDOZO ARTS & ENT.* 735, 736 (2018). Keller and I previously used “Critical Race IP” as the shorthand to speak about the intersections of Critical Race Theory and intellectual property. However, CRTIP seems to have gained purchase in race and intellectual property communities.

temporal defaults. The Article is divided into three parts, followed by a brief conclusion.

Part I tells the stories of *Blackhorse* and its antecedents and *Tam* and its antecedents and situates both cases in the larger context of CRTIP. *Blackhorse* followed *Harjo*, a disparaging trademark case that ended with the defendants invoking a laches defense that the deciding court found to be dispositive.<sup>29</sup> *Tam* was decided on First Amendment grounds after the appellate court sua sponte requested briefing on the free speech issues raised by Section 2(a) of the Lanham Act despite the fact that, prior to *Tam*,<sup>30</sup> courts had long used *In re McGinley* (1981) as precedent to justify the constitutionality of disparaging and scandalous trademark provisions in the statute.<sup>31</sup> *Tam* and *Blackhorse* collided in *Iancu v. Brunetti* (2019),<sup>32</sup> which struck down Section 2(a)'s ban on scandalous trademarks on the grounds that its content-based determinations violate the First Amendment. Adopting an intersectional CRTIP approach focused on racial chronopolitics reveals why and how these cases turned out as they did.

The remainder of the Article considers how the temporal politics of *Harjo*, *Blackhorse*, and *Tam* are embedded in larger histories of race and colonialism. Put succinctly, making the Euro-American racial time maps of *Blackhorse* and *Tam* visible reveals how the attorneys and

---

<sup>29</sup> See *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d. 96 (D.D.C. 2003).

<sup>30</sup> *In re Tam*, 808 F.3d 1321, 1334 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016), *aff'd sub nom. Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>31</sup> Mark Conrad, *Matal v. Tam: A Victory for the Slants, A Touchdown for the Redskins, But an Ambiguous Journey for the First Amendment and Trademark Law*, 36 CARDOZO ARTS & ENT. L. J. 83, 96–97 (2018) (“Written as a ‘macro’ analysis of the relationship between the First Amendment and trademark law, this opinion [in *In re Tam*] urges a re-examination of the justification for the disparagement clause and urges that *McGinley*, the leading precedent, be reexamined in light of the passage of time.” *Id.* at 99.).

<sup>32</sup> *Iancu v. Brunetti*, 139 S. Ct. 2294, 2296 (2019).

judges in those cases were able to strategically weaponize time and procedure to reinforce racism and colonialism. I demonstrate that, by using settler colonial logics similar to those in cases such as *Johnson v. M'Intosh* (1823), *Harjo* invoked Euro-American equitable conceptions of time to uphold white supremacy.<sup>33</sup> Meanwhile, following cases like *Citizens United v. FEC* (2010), *Tam* invoked implicitly Euro-American “colorblind”<sup>34</sup> conceptions of what Charlotte Garden terms the deregulatory First Amendment to uphold white supremacy and neoliberal capitalism.<sup>35</sup>

Part II examines two mechanisms through which courts manage time, i.e. the equitable defense of laches and the judicial power to create issues sua sponte, and their

---

<sup>33</sup> See generally *Johnson v. M'Intosh*, 21 U.S. 543 (1823). For a critique of the racist and temporal overreach of the Supreme Court in *Johnson v. M'Intosh* (1823), see generally Addie C. Rolnick, *The Promise of Mancari: Indian Political Rights as Racial Remedy*, 86 N.Y.U. L. REV. 958–1045 (2011). For a critique of how courts impose “fictive temporalities” on Indigenous Peoples in the service of denigrating their personhood and rights, see generally Kevin Noble Maillard, *The Pocahontas Exception: The Exemption of American Indian Ancestry from Racial Purity Law*, 12 MICH. J. RACE & L. 351 (2006) (noting the tendency of Federal Indian Law to “relegate Indians to existence only in a distant past, creating a temporal disjuncture to free Indians from a contemporary discourse of racial politics.” *Id.* at 357. Such representations “assess Indians as abstractions rather than practicalities, or as fictive temporalities characterized by romantic ideals...either essentializing a pre-modern and ahistorical culture, or trivializing this ancestry as inconsequential ethnicity.” *Id.*).

<sup>34</sup> I put the term “colorblind” in scare quotes because of its underlying ableism and practicality, as well as its cooption by those in the radical right.

<sup>35</sup> Charlotte Garden, *The Deregulatory First Amendment at Work*, 51 HARV. C.R.-C.L. L. REV. 323–62 (2016) (commenting on those cases that (1) “expand the scope of activity to which the First Amendment applies” (2) “embrace a more absolutist approach to the First Amendment,” and (3) signal the Supreme Court’s willingness to “entertain new or aggressive forms of deregulatory challenges” to the First Amendment).

significance as settler colonial formations of power that operate from Euro-American racial time maps. Part III offers an overview of the intersections between racial chronopolitics and law, by drawing on interdisciplinary discussions of race and temporality.<sup>36</sup> Finally, the Article concludes by encouraging lawyers and judges invested in progressive intellectual property law to consider how their tendencies to accept Euro-American racial time maps as epistemological truth hinder the decolonization of trademark law and how they might address such tendencies by making intentional choices about race and temporality. Achieving social justice goals in trademark law requires embracing a multiplicity of visions of racial time and respecting its attendant consequences for U.S. law.

## I. SITUATING RACE IN TRADEMARK LAW

Three recent trademark cases – *Harjo*, *Blackhorse*, and *Tam* – illustrate the inescapable intersections between race and intellectual property rights. The litigation in the first two cases, initiated by Suzan Shown Harjo, Amanda Blackhorse, and a group of Indigenous activists, contested the protectability of a famous NFL football team’s trademark on the basis that it is disparaging to Native Americans.<sup>37</sup> The lawsuits that Harjo and Blackhorse filed spanned decades

---

<sup>36</sup> While contemporary speed theory is often traced to the work of Paul Virilio, this Article engages a variety of sources on time, speed, and temporality, in order to examine how they are socially and culturally stratified categories that operate differently depending on the race, gender, and class of the individuals experiencing them. SARAH SHARMA, IN THE MEANTIME: TEMPORALITY AND CULTURAL POLITICS 4, 5 (2014).

<sup>37</sup> For an extended history of the battle over the mascot, see generally Lex Pryor, “*We Just Brought the King of the Mountain of Sports Slurs to Its Knees*,” THE RINGER (Aug. 12, 2020, 6:20 AM), <https://www.theringer.com/nfl/2020/8/12/21361914/washington-football-team-name-change-native-activists-perspective> [https://perma.cc/B8QJ-6SJH].

and raised important questions about the protection of racist mascots in the instant cases and more generally.<sup>38</sup> While *Blackhorse* was ultimately victorious in securing the cancellation of the Washington R\*\*\*\*\* trademarks, her legal triumph was short lived. The outcome in *Tam* raised fundamental questions about the constitutionality of Section 2(a) of the Lanham Act and, accordingly, the recently announced outcome in *Blackhorse*.<sup>39</sup> While these three cases raise rather obvious issues around race and representation, I am interested in how the reasoning upon which their holdings turn implicate questions of racial chronopolitics. I approach the analysis of temporality through CRTIP, a constantly evolving critical framework for applying Critical Race Theory to intellectual property cases.

CRTIP is, as Keller and I define it, “the interdisciplinary movement of scholars connected by their focus on the racial and colonial non-neutrality of the laws of copyright, patent, trademark, right of publicity, trade secret, and unfair competition using principles informed by CRT.”<sup>40</sup> CRTIP identifies “a body of scholarship with shared tenets about the racialized hierarchies inherent in IP law and its attendant ordering of knowledge.”<sup>41</sup> Theorizing at the intersections of Critical Race Theory and intellectual property is not intended to force scholars into CRTIP as an analytic framework. Rather, it is to introduce one way of

---

<sup>38</sup> Suzan Shown Harjo, *Statement of Suzan Shown Harjo on the Retirement of the Washington Football Team’s Racist Name in PROGRAM ON INFORMATION JUSTICE AND INTELLECTUAL PROPERTY, AMERICAN UNIVERSITY: WASHINGTON COLLEGE OF LAW* (July 13, 2020), <https://www.wcl.american.edu/impact/initiatives-programs/pijip/news/statement-of-suzan-shown-harjo-on-the-retirement-of-the-washington-football-teams-racist-name/> [https://perma.cc/FA97-MEZE].

<sup>39</sup> *In re Tam*, 808 F.3d 1321, 1334 (Fed. Cir. 2015), *as corrected* (Feb. 11, 2016), *aff’d sub nom. Matal v. Tam*, 137 S. Ct. 1744 (2017).

<sup>40</sup> Vats & Keller, *supra* note 28, at 740.

<sup>41</sup> *Id.*

reading intellectual property scholarship that takes up questions of race and (neo)coloniality together, in a larger, always emergent conversation about racial justice.

“Intellectual property’s economic structure is ‘always already’ raced,”<sup>42</sup> because capitalism’s orientation to knowledge is always already raced. Betsy Rosenblatt, for instance, demonstrates about copyright law that “[i]t rewards appropriation of materials perceived as primitive, raw, or ‘folk’ by purveyors of dominant culture, while punishing appropriation of materials that it associates with higher culture or views as already completed.”<sup>43</sup> As such, copyright law operates as “the language of the colonizer.”<sup>44</sup> Kara Swanson similarly shows about patent law that its “ideology of slavery reached into the technical bureaucracy of the patent office, an arena of law and of the administrative state frequently considered outside politics.”<sup>45</sup> As such, patent law implicates “an ultimate claim of whiteness as intellectual property.”<sup>46</sup> Knowledge, in both instances, is ordered in a manner that centers whiteness and its attendant estimations of the value of creation and knowledge.

Trademark law too produces and entrenches visual economies of whiteness. Rosemary Coombe writes that

---

<sup>42</sup> *Id.* at 745.

<sup>43</sup> Elizabeth L. Rosenblatt, *Copyright’s One-Way Racial Appropriation Ratchet*, 53 U.C. DAVIS L. REV. 591, 598 (2019). Rosenblatt follows in a line of scholars critiquing copyright law for its ethnocentrism, see, e.g., MADHAVI SUNDER, FROM GOODS TO A GOOD LIFE: INTELLECTUAL PROPERTY AND GLOBAL JUSTICE 3–4, 24 (2012) (arguing that Eurocentric approaches to intellectual property law, including copyright, prevent equitable access to “the good life”).

<sup>44</sup> Rosenblatt, *supra* note 43, at 598.

<sup>45</sup> Kara W. Swanson, *Race and Selective Memory: Reflections on Invention of a Slave*, 120 COLUMBIA L. REV. 1077, 1080 (2020); Swanson adds to the historical weight of evidence showing that patent law is raced, see e.g. RAYVON FOUCHÉ, BLACK INVENTORS IN THE AGE OF SEGREGATION: GRANVILLE T. WOODS, LEWIS H. LATIMER & SHELBY J. DAVIDSON (2003).

<sup>46</sup> Swanson, *supra* note 45, at 1080.

trademarks “denied or downplayed the cultural and ethnic differences of some ‘Americans’” through “the medium of the consuming body and embodiment...of others whose claims to an American subjectivity were complicated by contemporary relations of subjugation.”<sup>47</sup> Put differently, America’s visual culture, as constituted through trademark law, constituted whiteness as valuable by objectifying people of color. One way that the “scopic regime”<sup>48</sup> of trademark law operated was through the articulation of people of color as primitive, i.e. from a time past. As Coombe puts it, in the late nineteenth and early twentieth centuries “we see preoccupation with the frontiers of civilization and the containment of the primitive.”<sup>49</sup> In the sections that follow, I explore how *Harjo* and *Blackhorse* not only reinforce temporally based race discrimination by portraying Native Americans as primitive but also illustrate how the manipulation of time through legal procedure can advantage certain litigants over others, with considerable racial and colonial consequences.<sup>50</sup>

---

<sup>47</sup> Coombe, *supra* note 9.

<sup>48</sup> See Judith Butler, *Endangered/Endangering: Schematic Racism and White Paranoia*, in *READING RODNEY KING/READING URBAN UPRISING* (Robert Gooding-Williams ed., 1993).

<sup>49</sup> Coombe, *supra* note 9, at 108.

<sup>50</sup> National Congress of American Indians, *Ending the Era of Harmful “Indian” Mascots*, NCAI.ORG (2021), <https://www.ncai.org/proudtobe> [<https://perma.cc/3F7E-S7V7>]. For a comprehensive discussion of why R\*\*\*\*\* reinforces violent settler colonialism, see, e.g., C. RICHARD KING, *REDSKINS: INSULT AND BRAND* (2019) (King begins by unequivocally stating: “R\**dskin* is a problem. It is an outdated reference to an American Indian. It is best regarded as a racial slur on par with other denigrating terms...The word has deep connections to the history of anti-Indian violence, marked by ethnic cleansing, dispossession, and displacement.” *Id.* at 1.). For the reasons that King identifies and following the practices of numerous news outlets, I have placed R\*\*\*\*\* under erasure. Gene Demby, *Which Outlets Aren’t Calling The Redskins ‘The Redskins?’ A Short History*, CODE SW!TCH (Aug. 25, 2014, 5:29 PM), <https://www.npr.org/sections/codeswitch/2014/08/25/>

### A. *That Washington Football Team*

The National Congress of American Indians, which has consistently spoken out against racist mascots such as Washington R\*\*\*\*\*, writes that “rather than honoring Native [P]eoples, these caricatures and stereotypes are harmful, perpetuate negative stereotypes of America’s first [P]eoples, and contribute to a disregard for the personhood of Native [P]eoples.”<sup>51</sup> The purportedly complimentary mascots that linger in American culture produce immense psychological harm, especially for Native youth, and encourage hate crimes.<sup>52</sup> Racist mascots have long been a way of maintaining offensive and damaging stereotypes under the guise of homage, tradition, and competition.<sup>53</sup> Because settler colonialism has historically operated through

---

343202344/which-outlets-arent-calling-the-redskins-the-redskins-a-short-history [https://perma.cc/CPY9-BXP6].

<sup>51</sup> National Congress of American Indians, *supra* note 50.

<sup>52</sup> Daniel Snyder, owner of The Washington Football Team, has previously asserted that R\*\*\*\*\* honors Native Americans. Daniel Snyder, *Letter from Washington Redskins Owner Dan Snyder to Fans*, WASHINGTON POST (Oct. 9, 2013), [https://www.washingtonpost.com/local/letter-from-washington-redskins-owner-dan-snyder-to-fans/2013/10/09/e7670ba0-30fe-11e3-8627-c5d7de0a046b\\_story.html](https://www.washingtonpost.com/local/letter-from-washington-redskins-owner-dan-snyder-to-fans/2013/10/09/e7670ba0-30fe-11e3-8627-c5d7de0a046b_story.html) [https://perma.cc/NV8Q-XK3E]. For a meta-analysis of studies on the harm produced by Native mascots, see, e.g., Laurel R. Davis-Delano et al., *The Psychosocial Effects of Native American Mascots: A Comprehensive Review of Empirical Research Findings*, 23 RACE ETHNICITY & EDUC. 613, 613–33 (2020).

<sup>53</sup> Angela R. Riley & Kristen A. Carpenter, *Owning Red: A Theory of Indian (Cultural) Appropriation*, 94 TEX. L. REV. 859, 866 (2016) (coining the term “Indian appropriation,” Riley and Carpenter observe that “the U.S. legal system has historically facilitated and normalized the taking of *all* things Indian for others’ use, from lands to sacred objects, and from bodies to identities. Indian appropriation, according to Native [P]eoples, has deep and long-lasting impacts, with injuries ranging from humiliation and embarrassment to violence and discrimination.” (emphasis in original)); see also MICHAEL F. BROWN, WHO OWNS NATIVE CULTURE? 2–3 (2003).



the dispossession of Native Peoples, ameliorating the racial and colonial violence done by Native mascots specifically – and racially objectifying trademarks generally – requires consideration of who has control over cultural production and how these practices affect structurally marginalized groups.<sup>54</sup> As Angela R. Riley and Kristen A. Carpenter write, “when it comes to minority groups, cultural appropriation often occurs in a societal context of power imbalance, racism, and inequality, rather than an atmosphere of fair, open, and multilateral exchange.”<sup>55</sup>

In 2020, after decades of legal struggle, Daniel Snyder retired the name of his Washington Football Team, which was one of the nation’s most visible and egregious remaining examples of a trademark representing Native Americans.<sup>56</sup> This turn of events occurred after multiple lawsuits, years of protest, and the reversal of multiple victories. In 1992, acting on the opposition to the Washington R\*\*\*\*\* trademarks that had existed for many years, Suzan Shown Harjo, Raymond D. Apodaca, Vine Deloria, Jr., Norbert S. Hill, Jr., Mateo Romero, William A. Means, and Manley A. Begay, Jr. petitioned the Trademark

---

<sup>54</sup> Angela Riley et al., *The Jeep Cherokee is Not a Tribute to Indians. Change the Name*. WASHINGTON POST (Mar. 7, 2021, 7:00 AM), <https://www.washingtonpost.com/opinions/2021/03/07/jeep-cherokee-name-change-native-americans/> [<https://perma.cc/P9HY-2FMQ>].

<sup>55</sup> Riley & Carpenter, *supra* note 53, at 864.

<sup>56</sup> Brakkton Booker, *After Mounting Pressure, Washington’s NFL Franchise Drops Its Team Name*, NPR (July 13, 2020), <https://www.npr.org/sections/live-updates-protests-for-racial-justice/2020/07/13/890359987/after-mounting-pressure-washingtons-nfl-franchise-drops-its-team-name> [<https://perma.cc/T3N5-3HPD>]; Scott Allen, *A Timeline of the Redskins Name Change Debate*, WASHINGTON POST (July 13, 2020), <https://www.washingtonpost.com/graphics/sports/dc-sports-bog/2020/07/13/amp-stories/timeline-redskins-name-change-debate/> [<https://perma.cc/BD89-389R>] (showing that Native American organizations formally pushed back against the 7 team trademarks as early as 1972).

Trial and Appeal Board (“TTAB”) for the cancellation of seven trademarks owned by Pro-Football, Inc. on the grounds that they were disparaging.<sup>57</sup> In 1999, the United States Patent and Trademark Office (“USPTO”) canceled the trademarks for the Washington R\*\*\*\*\*. Pro-Football, Inc. appealed.<sup>58</sup> In 2003, the district court reversed on the grounds that the trademarks were not disparaging.<sup>59</sup> In 2005, the D.C. Circuit remanded the case to the district court, asking the court to clarify its findings related to the equitable defense of laches.<sup>60</sup> In a statement that affirms property rights over racial equity, it held that “during the period of delay, Pro-Football and NFL Properties invested in the trademarks and had increasing revenues during this time frame.”<sup>61</sup> In 2008, the district court dismissed the case on laches grounds; the next year, the DC Circuit affirmed the dismissal and the Supreme Court granted cert.<sup>62</sup> The complicated procedural history of the case and the many appeals are a testament to the difficulty of invalidating a trademark as valuable as this one. It also reveals the racially fraught nature of temporally imbricated procedure, which I turn to in detail below.

As a result of the complicated dynamics of the case and the successful invocation of laches, Amanda Blackhorse, Marcus Briggs-Cloud, Phillip Cover, Jillian Pappan, and Courtney Tostigh filed another petition with the TTAB in 2006 to cancel the offending trademarks.<sup>63</sup> The TTAB suspended that case until the final disposition in

---

<sup>57</sup> See generally *Pro-Football, Inc. v. Blackhorse*, 112 F. Supp. 3d 439 (E.D. Va. 2015).

<sup>58</sup> *Id.* at 450.

<sup>59</sup> *Id.*

<sup>60</sup> *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005).

<sup>61</sup> *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d 96, 112 (D.D.C. 2003).

<sup>62</sup> *Pro-Football Inc.*, 112 F. Supp. 3d at 450. See *Pro-Football, Inc. v. Harjo*, 567 F. Supp. 2d 46, 62 (D.D.C. 2008).

<sup>63</sup> *Pro-Football, Inc.*, 112 F. Supp. 3d at 450–51.

*Harjo*.<sup>64</sup> The case that became *Blackhorse* resumed after *Harjo* concluded in 2009.<sup>65</sup> After a series of substantive and procedural concerns were addressed, the TTAB cancelled the trademarks in 2014, pursuant to Section 2(a) of the Lanham Act, on the theory that they may be disparaging to Native Americans.<sup>66</sup> Both parties filed cross-motions for summary judgment in the District for the Eastern District of Virginia;<sup>67</sup> the court ultimately denied Pro-Football, Inc.’s motion for summary judgment.<sup>68</sup> Specifically, Pro-Football Inc. sought summary judgment on the grounds that 15 U.S.C. §1052(a) violates the First Amendment by “restricting protected speech, imposing burdens on trademark holders, and conditioning access to federal benefits on restrictions of trademark owners’ speech.”<sup>69</sup> The district court concluded with respect to this claim:

First, Section 2(a) of the Lanham Act does not implicate the First Amendment. Second, under the Supreme Court’s decision in *Walker v. Tex. Div., Songs of Confederate Veterans, Inc.*, the Fourth Circuit’s mixed/hybrid speech test, and *Rust v. Sullivan* (1991), the federal trademark registration program is government speech and is therefore exempt from First Amendment scrutiny.<sup>70</sup>

The district court also cited the long-followed precedent in *In re McGinley*.<sup>71</sup> In 2018, the Fourth Circuit reviewed *Blackhorse* on appeal in light of new developments.<sup>72</sup> It

---

<sup>64</sup> *Id.* at 451.

<sup>65</sup> *Id.*

<sup>66</sup> *Id.*

<sup>67</sup> *Id.* at 447.

<sup>68</sup> *Id.* at 489.

<sup>69</sup> *Id.* at 447–48.

<sup>70</sup> *Id.* at 454 (internal citations omitted).

<sup>71</sup> *Id.* at 455.

<sup>72</sup> See generally *Pro-Football, Inc. v. Blackhorse*, 709 Fed. Appx. 182 (4th Cir. 2018).

remanded the case to the district court for a decision consistent with the Supreme Court’s holding in *Tam*.<sup>73</sup>

Pro-Football, Inc. raised a laches defense on multiple occasions during *Harjo*. In the first instance, the D.C. Circuit remanded to the district court on the basis that the court had wrongly applied the laches defense to one of the plaintiffs, Romero.<sup>74</sup> It held that the lower court had mistakenly run the time on the laches defense from 1967, the time of registration of the Washington R\*\*\*\*\* trademarks, instead of the age of majority of the plaintiffs.<sup>75</sup> The D.C. Circuit makes an important point here in the service of racial justice: “[w]hy should laches bar all Native Americans from challenging Pro-Football’s ‘Redskins’ trademark registrations because some Native Americans may have slept on their rights?”<sup>76</sup> Yet upon second review, the district court held that laches *did* apply, this time because the youngest of the defendants, Romero, “waited almost eight years—seven years, nine months to be precise—after reaching the age of majority before petitioning to cancel the six trademarks in question. That delay is ‘unusually long by any standard.’”<sup>77</sup> Central to the showing of economic prejudice was evidence of Pro-Football Inc.’s investment in the trademarks and related advertising and promotion materials.<sup>78</sup> Pro-Football, Inc. raised the laches defense again in *Blackhorse*, in a motion for summary judgment.<sup>79</sup> The district court held that the Blackhorse defendants did *not*

---

<sup>73</sup> *Id.*

<sup>74</sup> Pro-Football, Inc. v. Harjo, 415 F.3d 44, 49–50 (D.C. Cir. 2005).

<sup>75</sup> *Id.* at 48–49. The TTAB had previously held that laches was “inapplicable due to the ‘broader interest . . . 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.’” *Id.* at 47 (internal citation omitted).

<sup>76</sup> *Id.* at 49.

<sup>77</sup> Pro-Football, Inc. v. Harjo, 567 F. Supp. 2d 46, 53–54 (D.D.C. 2008).

<sup>78</sup> Pro-Football, Inc. v. Harjo, 284 F. Supp. 2d 96, 112 (D.D.C. 2003).

<sup>79</sup> Pro-Football, Inc. v. Blackhorse, 112 F. Supp. 3d 439, 488–89 (2015).

unreasonably or unjustifiably delay in petitioning the TTAB in waiting for a decision in *Harjo*.<sup>80</sup> Indeed, the court agreed that filing sooner may have resulted in the “filing of unnecessary petitions.”<sup>81</sup> Further, it noted that in trademark cases, as with copyright and patent cases, laches was a remedy to be used sparingly; public policy militated in favor of canceling disparaging trademarks.<sup>82</sup> While I will discuss the problematic aspects of these laches findings in Part II, I want to highlight here that 1) the TTAB and the courts were aware of the public policy issues around race and disparagement and 2) they embraced a broad vision of laches. Both of these facts suggest that the outcomes in the cases discussed here were far from foregone conclusions.

### ***B. The Band With No Name***

*Tam* was as much a continuation of a dialogue between the TTAB and the D.C. Circuit as it was a battle for Simon Tam to protect the name of his band, the Slants. Though Tam did not set out to change the history of trademark law and free speech jurisprudence in the United States, he did so through the curious, though perhaps unsurprising, connections between *Harjo* and *Blackhorse* with *Tam*. Like *Harjo* and *Blackhorse*, *Tam* has a long and rather convoluted procedural history, that spans nearly a decade.<sup>83</sup> In 2010, Tam sought to register the trademark for

---

<sup>80</sup> *Id.*

<sup>81</sup> *Id.* at 489.

<sup>82</sup> *Id.*

<sup>83</sup> For a brief overview of the timeline of the case, see generally Diana Michele Yap, *He Named His Band the Slants to Reclaim a Slur. Not Everyone Approved*, WASHINGTON POST (May 16, 2019, 9:00 AM), [https://www.washingtonpost.com/entertainment/books/he-named-his-band-the-slants-to-reclaim-a-slur-not-everyone-approved/2019/05/15/b939275a-700d-11e9-8be0-ca575670e91c\\_story.html](https://www.washingtonpost.com/entertainment/books/he-named-his-band-the-slants-to-reclaim-a-slur-not-everyone-approved/2019/05/15/b939275a-700d-11e9-8be0-ca575670e91c_story.html) [<https://perma.cc/C8J6-8AJS>]. For a more detailed version of Tam’s story, see generally SIMON TAM, *SLANTED*:

“Slants” for the first time.<sup>84</sup> The USPTO rejected his application, relying on *Urban Dictionary* to define the term as “derogatory or offensive” to Asian Americans.<sup>85</sup> Tam appealed the decision before the TTAB.<sup>86</sup> The TTAB again denied the application for the trademark.<sup>87</sup> Tam appealed to the Federal Circuit, who sua sponte raised the issue of whether Section 2(a) of the Lanham Act violated the First Amendment to the U.S. Constitution.<sup>88</sup> Ultimately, the court determined that the disparaging trademark language of Section 2(a) violated the First Amendment’s guarantee of free speech because it allowed the USPTO to engage in indefensible content-based discrimination.<sup>89</sup> A critique of *In re McGinley*, a longstanding established precedent, featured prominently in the Federal Circuit’s decision.<sup>90</sup>

In 2017, in an opinion that reads almost as a continuation of *Blackhorse*, the Supreme Court affirmed the Federal Circuit’s decision, on free speech grounds.<sup>91</sup>

---

HOW AN ASIAN AMERICAN TROUBLEMAKER TOOK ON THE SUPREME COURT (2019).

<sup>84</sup> Tam filed his initial application in March 2010 but abandoned it. U.S. Ser. No. 77/952,263 (now abandoned). He filed a second application in 2011, six years before the decision in *Tam*. Eugene Volokh, *The Volokh Conspiracy: The Slants Trademark Registered Today, Six Years After the Application Was First Filed*, WASHINGTON POST (Nov. 14, 2017, 3:04 PM), <https://www.washingtonpost.com/news/volokh-conspiracy/wp/2017/11/14/the-slants-trademark-registered-today-six-years-after-the-application-was-first-filed/> [<https://perma.cc/7QKD-LXAA>].

<sup>85</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1754 (2017).

<sup>86</sup> *Id.*

<sup>87</sup> Denial of Request for Reconsideration, U.S. Trademark Application Serial No. 85472044 (TTAB Dec. 20, 2012), available at <https://ttabvue.uspto.gov/ttabvue/v?pno=85472044&pty=EXA&eno=5>.

<sup>88</sup> *In re Tam*, 808 F.3d 1321, 1334 (Fed. Cir. 2015) (“[W]e sua sponte ordered rehearing en banc. We asked the parties to file briefs on the following issue: Does the bar on registration of disparaging marks in 15 U.S.C. § 1052(a) violate the First Amendment?” *Id.*)

<sup>89</sup> *Id.* at 1360.

<sup>90</sup> *Id.*

<sup>91</sup> *Tam*, 137 S. Ct. at 1754.

Though the judgment in *Tam* was a unanimous one, Justice Kennedy, Justice Ginsberg, Justice Sotomayor, and Justice Kagan wrote in concurrence. They concluded:

As the Court is correct to hold, §1052(a) constitutes viewpoint discrimination—a form of speech suppression so potent that it must be subject to rigorous constitutional scrutiny. The Government’s action and the statute on which it is based cannot survive this scrutiny. ... This separate writing explains in greater detail why the First Amendment’s protections against viewpoint discrimination apply to the trademark here... the viewpoint discrimination rationale renders unnecessary any extended treatment of other questions raised by the parties.<sup>92</sup>

All justices concurred that Section 2(a), which permits the USPTO to refuse to register a trademark which “[c]onsists 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,”<sup>93</sup> “offends a bedrock First Amendment principle: speech may not be banned on the ground that it expresses ideas that offend.”<sup>94</sup> More specifically, banning racist trademarks under Section 2(a), the Court unanimously agreed, is an overbroad act of viewpoint discrimination that is not justified by the state’s interests of preventing the use of discriminatory speech or protecting the free flow of

---

<sup>92</sup> *Id.* at 1765 (Kennedy, J., Ginsberg, J., Sotomayor, J., and Kagan, J. concurring in part and concurring the judgment).

<sup>93</sup> 15 U.S.C. § 1052(a) (2006).

<sup>94</sup> *Tam*, 137 S. Ct. at 1751.

commerce.<sup>95</sup> In this, the Supreme Court reversed the precedent established by *In re McGinley* and its progeny.<sup>96</sup>

### C. *Free Speech as Racial Triangulation*

As I have previously argued, the relevant question in *Harjo*, *Blackhorse*, and *Tam* is not “why?” but “why now?” Indeed, the dissent by Judge Laurie in the Federal Circuit asks this question, pointing to the long history of precedent that justified *not* making a decision based on free speech.<sup>97</sup> More specifically, though Section 2(a) of the Lanham Act was enacted in 1905 and renewed in 1946,<sup>98</sup> it was not struck down as unconstitutional until 2017, with the decisions in *Tam* and *Brunetti*.<sup>99</sup> Bringing CRTIP to bear on the outcomes in these cases is helpful in untangling the racially and colonially violent processes at work in the decisions, with respect to “racial triangulation,”<sup>100</sup> “racial

---

<sup>95</sup> Eugene Volokh, *The Slants (and the Redskins) Win: The Government Can't Deny Full Trademark Protection to Allegedly Racially Offensive Marks*, WASHINGTON POST (June 19, 2017, 10:50 AM), [https://www.washingtonpost.com/news/volokh-conspiracy/wp/2017/06/19/the-slants-and-the-redskins-win-the-government-cant-deny-full-trademark-protection-to-allegedly-racially-offensive-marks/?utm\\_term=.ebaf7c7ef4aa](https://www.washingtonpost.com/news/volokh-conspiracy/wp/2017/06/19/the-slants-and-the-redskins-win-the-government-cant-deny-full-trademark-protection-to-allegedly-racially-offensive-marks/?utm_term=.ebaf7c7ef4aa) [https://perma.cc/R5M4-P7M5].

<sup>96</sup> *In re McGinley*, 660 F.2d 481 (C.C.P.A. 1981) (finding that “[w]ith respect to appellant’s First Amendment rights, it is clear that the PTO’s refusal to register appellant’s mark does not affect his right to use it.” *Id.* at 484).

<sup>97</sup> *In re Tam*, 808 F.3d 1321, 1374 (Fed. Cir. 2015) (Lourie, J., dissenting) (writing that: “one wonders why a statute that dates back nearly seventy years—one that has been continuously applied—is suddenly unconstitutional as violating the First Amendment. Is there no such thing as settled law, normally referred to as *stare decisis*?”).

<sup>98</sup> 15 U.S.C. § 1052(a).

<sup>99</sup> See generally *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019).

<sup>100</sup> See generally Robert S. Chang & Neil Gotanda, *Afterward: The Race Question in LatCrit Theory and Asian American Jurisprudence*, 7 NEV. L. J. 1012 (2007).



libertarianism,”<sup>101</sup> and “racial chronopolitics.”<sup>102</sup> More specifically, the Federal Circuit’s decision to raise a First Amendment question *sua sponte* pitted the emancipatory struggles of Native Americans and Asian Americans against one another using divide and conquer tactics, deregulatory free speech practices, and manipulations of time that critical race studies scholars across disciplines have critiqued as destructive.<sup>103</sup> I explore the racial triangulation and racial libertarianism components of the case here before turning to the racial chronopolitics issue in the rest of the Article.

The three cases that anchor this section, *Harjo*, *Blackhorse*, and *Tam*, showcase how seemingly “colorblind” or “postracial”<sup>104</sup> legislation and precedent can collide in ways that reveal underlying processes of “racial formation.”<sup>105</sup> That is to say that racial identities and racism evolves over time, through discourse and policy, as a response to progressive change.<sup>106</sup> “Racial projects”<sup>107</sup> manifest as structural elements that prevent people of color from attaining equality. As critical race theorist Derrick Bell observes, the formal equality under law that people of color, particularly Black people, won during the civil rights movement did not change the nation’s underlying racial

---

<sup>101</sup> ANJALI VATS, *THE COLOR OF CREATORSHIP: INTELLECTUAL PROPERTY, RACE, AND THE MAKING OF AMERICANS* 120 (2020).

<sup>102</sup> *See, e.g.*, CORRIGAN, *supra* note 24, at 34–35.

<sup>103</sup> VATS, *supra* note 101, at 120–26.

<sup>104</sup> *See, e.g.*, Catherine Squires et al., *What Is This “Post-” in Postracial, Postfeminist ... (Fill in the Blank)?*, 34 J. OF COMMUN INQUIRY 210, 212–53 (2010).

<sup>105</sup> *See generally* MICHAEL OMI & HOWARD WINANT, *RACIAL FORMATION IN THE UNITED STATES: FROM THE 1960S TO THE 1990S* (2nd ed. 1994) (defining and developing the terms “racial formation” and “racial projects” and elaborating on their theory in a historical context).

<sup>106</sup> *See generally id.*

<sup>107</sup> *See generally id.*

commitments, it only created an illusion of racial progress that has been eroded considerably.<sup>108</sup>

In this instance, deregulating the First Amendment cloaked racial capitalism in the language of colorblind economics and calls for free speech rendered structural racism and settler colonialism invisible.<sup>109</sup> Put differently, *Tam* eviscerated *Blackhorse* as a victory by embracing racial libertarianism, a deregulatory approach to racism that made people of color responsible for their own liberation – and therefore oppression.<sup>110</sup> They attempt to move the United States and its people of color into a legal framework that fails to recognize that time does not operate equally for all. Robert S. Chang and Neil Gotanda use the term “racial triangulation” to describe how cases such as this one pit people of color against each other.<sup>111</sup> Drawing upon the work of political scientist Claire Jean Kim, they write:

Depending on the issue, a different group is placed on a horizontal plane of formal equivalence with Whites. The triangle is a useful device to emphasize the issues at stake in the coalition and helps to avoid collapsing the politics into a false binary. The triangulation diagram demonstrates the issue-specific way that the invitation to Whiteness (actual, honorary, or formal) or Americanness is issued, and it highlights the inconsistencies and hypocrisies. The cynical deployment of the language of equality, ‘You are like us and not them,’ can be seen to be issue-specific. It masks attempts to co-opt without any real granting of

---

<sup>108</sup> DERRICK BELL, *FACES AT THE BOTTOM OF THE WELL: THE PERMANENCE OF RACISM* 3 (1992).

<sup>109</sup> VATS, *supra* note 101, 120–26.

<sup>110</sup> *Id.* See also Margaret Chon & Robert S. Chang, *The Indians Who Were Not Heard and the Band That Must Not Be Named: Racial Formation and Social Justice in Intellectual Property Law*, Race + IP 2021, FAMU College of Law (Online) (Apr. 9–10, 2021) (exploring how the Supreme Court’s First Amendment approach to *Tam* frustrates social justice goals through its romantic notion of the marketplace of ideas).

<sup>111</sup> See generally Chang & Gotanda, *supra* note 100.

equality with Whites. It is a way to maintain white dominance.<sup>112</sup>

In this case, the attempts of Harjo, Blackhorse, and others to address violent settler colonialism were thwarted by seemingly progressive First Amendment jurisprudence proclaiming to protect Asian Americans.<sup>113</sup> As a methodological matter, cases such as this one, involving people of color on both sides, can serve as helpful illustrative examples of how and why racial capitalism and “colorblind” lawmaking operate to reinforce casual racism and settler colonialism.<sup>114</sup> They also demonstrate how postracial language of formal equality and market deregulation can obfuscate destructive divide and conquer politics.

## II. CRITICAL RACE INTELLECTUAL PROPERTY AND THE POLITICS OF TIME

“Temporality,” Liaquat Ali Khan argues, “is an integral part of law.”<sup>115</sup> This is a far-reaching claim that scholars across disciplines have explored, in various legal contexts. For instance, in his book on law and time, Rakoff argues for legal approaches to temporal management that encourage civil engagement and social activity, both of which he contends are vital to the success of a democratic nation.<sup>116</sup> Rakoff seeks to attend to legal time in order to

---

<sup>112</sup> *Id.* at 1024–25.

<sup>113</sup> For a discussion of the divisiveness of reclaiming the term “slants,” see generally Simon Tam, *The Slants to NAPABA: Stop Undermining the Work of Activists*, ANGRY ASIAN MAN (July 29, 2015), <http://blog.angryasianman.com/2015/07/the-slants-to-napaba-stop-undermining.html> [<https://perma.cc/8K2J-ZSTQ>].

<sup>114</sup> Chang & Gotanda, *supra* note 100, at 1024–25.

<sup>115</sup> Liaquat Ali Khan, *Temporality of Law*, 40 MCGEORGE L. REV. 55, 56 (2008).

<sup>116</sup> RAKOFF, *supra* note 16, at 1–9.

address what he identifies as temporal misallocation.<sup>117</sup> In a review essay of the book, Lobel notes that Rakoff’s work only begins to scratch the surface of the cultural implications of the intersections of law and time.<sup>118</sup> She seeks to “illuminate several ways in which framing the struggles over the legal construction of time as a universal human project of social engineering rather as an ongoing struggle among unequal actors in society may naturalize certain assumptions and inequalities.”<sup>119</sup> Lobel’s response to Rakoff echoes the work of critical race studies scholars, who insist on interrogating the racial structures through which cultural practices of temporal management are produced. Sarah Sharma, for instance, whose book focuses on race, class, time, and labor, notes that for all the talk of time among those she calls the “speed theorists,”<sup>120</sup> there is virtually no talk of what she defines as “differential lived time.”<sup>121</sup>

Speed theory as Sharma describes it refers to the postmodernist turn epitomized by the work of Paul Virilio,<sup>122</sup> a French scholar who described the rise of the hypermediated culture of speed in which we live.<sup>123</sup> Sharma writes: “[t]he culture of speed, as it appears in such various conversations, goes by many terms: 24/7 capitalism (Jonathan Crary), the chronoscopic society (Robert Hassan), fast capital (Ben Agger), the new temporalities of biopolitical production (Michael Hardt and Antonio Negri), the culture of acceleration (John Tomlinson), chronodystopia (John Armitage and Joanne Roberts),

---

<sup>117</sup> *Id.*

<sup>118</sup> Lobel, *supra* note 18, at 359.

<sup>119</sup> *Id.* at 371.

<sup>120</sup> SHARMA, *supra* note 36, at 5.

<sup>121</sup> *Id.* at 6.

<sup>122</sup> The postmodernist turn signified a move from investment in the grand narratives of the Enlightenment and Modernism, often through critique and deconstruction. *See, e.g.,* JEAN-FRANÇOIS LYOTARD, *THE POSTMODERN CONDITION* (1979).

<sup>123</sup> PAUL VIRILIO, *SPEED AND POLITICS* (1986).

hypermodern times (Giles Lipovetsky), and liquid time (Zygmunt Bauman).”<sup>124</sup> Each of these terms describes different but overlapping characteristics of contemporary time, informed by theorists of political economy, international relations, neoliberal capitalism, and so on.<sup>125</sup> Yet for Sharma, speed theorists fail to understand the nuances of time, specifically that speeding up is only one aspect of temporal alienation and oppression.<sup>126</sup>

One example that she provides to illustrate this argument is that of yoga. While yoga is valorized as being “outside” the corporate system, the quality of being exterior to organizational structures does not indicate resistance to them. In the case of yoga, the practice renders the corporate laborer more efficient, and thus more valuable, under capitalism.<sup>127</sup> Southern plantation systems operated through similar raced logics of time: plantation owners experienced *leisure* time, marked by long, slow days, while Black field workers simultaneously experienced *labor* time, marked by short, fast days.<sup>128</sup> Sharma’s work bridges conversations between law and time and race and time by providing frameworks for being “temporally attuned.”<sup>129</sup> This section draws on interdisciplinary scholarship to racially and temporally attune to the implications of procedural practices, specifically the equitable defense of laches and the judicial power to create issues sua sponte as they arise in the context of trademark law. My aim is to demonstrate how attending

---

<sup>124</sup> SHARMA, *supra* note 36, at 5 (emphasis omitted).

<sup>125</sup> *Id.*

<sup>126</sup> *Id.* at 15–16.

<sup>127</sup> *Id.* at 91–96; *see generally* RAKA SHOME, *DIANA AND BEYOND: WHITE FEMININITY, NATIONAL IDENTITY, AND CONTEMPORARY MEDIA CULTURE* (2014).

<sup>128</sup> Carol M. Megehee & Deborah F. Spake, *Decoding Southern Culture and Hospitality*, 2 INT’L J. OF CULTURE, TOURISM & HOSP. RES. 97–101 (2008).

<sup>129</sup> SHARMA, *supra* note 36, at 12.

to time is vital to attending to race, particularly within the context of intellectual property litigation.

### *A. Temporal Attunement in Intellectual Property Law*

Time is built into the very structures of American intellectual property law. Copyright and patent law are intended “[t]o promote the [p]rogress of [s]cience and the useful [a]rts, by securing *for limited [t]imes* to [a]uthors and [i]nventors the exclusive [r]ight to their respective [w]ritings and [d]iscoveries.”<sup>130</sup> “Limited times” has been the subject of much litigation, including in the now infamous *Eldred v. Ashcroft*, in which the United States Supreme Court considered “the authority the Constitution assigns to Congress to prescribe the duration of copyrights.”<sup>131</sup> In that case, the Court ultimately granted broad authority to Congress in determining and extending the “limited times” for which copyright protection exists.<sup>132</sup> Central to the reasoning in *Eldred* was the history of patent cases raising questions of duration. Justice Ginsberg wrote: “We count it significant that early Congresses extended the duration of numerous individual patents as well as copyrights” and “...the Court has found no constitutional barrier to the legislative expansion of existing patents.”<sup>133</sup> The “pathsetting precedent”<sup>134</sup> on this issue for the majority was *McClurg v. Kingsland*, which upheld the retroactive application of a new patent law.<sup>135</sup>

Broadly speaking, copyright law and patent law are intended to create limited monopolies, with the narrow

---

<sup>130</sup> U.S. CONST., art. I, § 8, cl. 8 (emphasis added).

<sup>131</sup> *Eldred v. Ashcroft*, 537 U.S. 186, 192 (2003).

<sup>132</sup> *Id.*

<sup>133</sup> *Id.* at 201–02.

<sup>134</sup> *Id.* at 203.

<sup>135</sup> *See generally* *McClurg v. Kingsland*, 42 U.S. 202 (1843).

purpose of encouraging innovation.<sup>136</sup> Both cases alter the intellectual property bargain, by changing its temporal rules. Khan provides one framework for understanding the temporal issues presented by intellectual property law.<sup>137</sup> He does so by focusing on the mechanics of legal time. Specifically, Khan's proposed method for engaging with law and time is to create a language for talking about temporality, one that ascribes theoretical significance to points in time ( $t$ ) and temporal durations ( $\Delta t$ ) in order to pinpoint how law acts upon time and how time functions in law.<sup>138</sup> In Khan's grammar of time, *Eldred* raises a temporal duration issue, ( $\Delta t$ ), while *McClurg* raises a point in time ( $t$ ) issue. More specifically, the Court noted in *Eldred* that the phrase "limited [t]imes," i.e. limited term, raises an issue of temporal confinement and constriction over which Congress has absolute control.<sup>139</sup> Therefore, *Eldred* effectively announces itself as a case that hinges on temporal containment. The Court also noted in *McClurg* that a retroactively applied patent law could protect an invention that was not previously protected.<sup>140</sup> Accordingly, *McClurg* effectively announces itself as a case that hinges on starting points. The Court noted that a patent "depend[s] on the law as it stood at emanation of the patent, together with such changes as have been since made[,] for though they may be retrospective in their operation, that is not a sound objection to their validity."<sup>141</sup> The temporal issues that I have identified here are not exhaustive; they are examples that demonstrate intellectual property's temporal elements.

Another area in which intellectual property scholars have theorized time is in the context of fair use. Joseph Liu,

---

<sup>136</sup> *Eldred*, 537 U.S. at 214–16.

<sup>137</sup> See generally Khan, *supra* note 115.

<sup>138</sup> *Id.* at 62–64.

<sup>139</sup> *Eldred*, 537 U.S. at 199.

<sup>140</sup> *McClurg*, 42 U.S. at 209–10.

<sup>141</sup> *Id.* at 206.

for instance, contends that time ought to be a factor in the fair use test.<sup>142</sup> He offers the following maxim: “the older a copyrighted work is, the greater the scope of fair use should be – that is, the greater the ability of others to re-use, critique, transform, and adapt the copyrighted work without permission of the copyright owner. Conversely, the newer the work, the narrower the scope of fair use.”<sup>143</sup> Liu’s proposal explicitly recognizes that value of copyrighted work changes over the duration of its existence, particularly given public interest in using the work.<sup>144</sup> Justin Hughes makes a similar argument based on the market for the copyrighted work.<sup>145</sup> Time, one might contend, is of the essence when considering fair use.

The remainder of this section turns to two procedural mechanisms that operate to control time in intellectual property law: the equitable defense of laches and the judicial authority to create issues *sua sponte*. Both mechanisms, which are invoked across areas of law, have been long critiqued for their propensities for abuse, particularly insofar as they interfere with procedural due process.<sup>146</sup> Though not all cases involving laches and *sua sponte* raise content-based social justice concerns, in or beyond trademark law, they frequently highlight ethical questions about how courts think about time and evoke questions about how courts might rethink practices of judicial timekeeping.

---

<sup>142</sup> Joseph P. Liu, *Copyright and Time: A Proposal*, 101 MICH. L. REV. 409, 464–65 (2002).

<sup>143</sup> *Id.* at 410.

<sup>144</sup> *Id.* at 411.

<sup>145</sup> See generally Justin Hughes, *Fair Use Across Time*, 43 UCLA L. REV. 775 (2003).

<sup>146</sup> See, e.g., Adam A. Milani & Michael R. Smith, *Playing God: A Critical Look at Sua sponte Decisions by Appellate Courts*, 69 TENN. L. REV. 245, 248–51 (2002). Milani and Smith contend that courts overuse *sua sponte* decision-making in ways that restrict the parties’ due process rights.



**B. Laches, Racial Time & Equity**

The Fourth Circuit, outlining the definition and purpose of the equitable defense of laches, observed that “equity aids the vigilant, not those who sleep on their rights. Laches may be applied by a court to bar a suit at equity that has been brought so long after the cause of action accrued that the court finds that bringing the action is unreasonable and unjust.”<sup>147</sup> Those claiming laches at equity must prove that 1) the plaintiff delayed in exercising their rights and 2) the delay was unreasonable.<sup>148</sup> They must also show that the unreasonable delay resulted in prejudice to the plaintiff, via evidence and/or expectations.<sup>149</sup> Significantly, laches is “a judicially created doctrine, whereas statutes of limitations are legislative enactments.”<sup>150</sup> Courts are accordingly reluctant to overrule statutes of limitations because they represent congressional intent.<sup>151</sup> These elements of laches highlight the materiality of time in pursuing claims as well as determining appropriate relief under the circumstances. “Sleeping on rights” suggests a slowness to action, as well as a sense of incompetence. “Vigilance” suggests attentiveness to those who might infringe on rights or commit another harm.

Moreover, implicit in the conception of laches as a defense at equity – indeed in equitable relief generally – is a

---

<sup>147</sup> *Lyons P’ship, LP v. Morris Costumes, Inc.*, 243 F.3d 789, 797–98 (4th Cir. 2001) (citing *Ivani Contracting Corp. v. City of N.Y.*, 103 F.3d 257, 259 (2d Cir. 1997)).

<sup>148</sup> See Vikas K. Didwania, *The Defense of Laches in Copyright Infringement Claims*, 75 U. CHI. L. REV. 1227, 1230–31 (2008).

<sup>149</sup> *Id.* at 1231.

<sup>150</sup> *Lyons*, 243 F.3d at 798. *Lyons*, which is a copyright case, is at the center of the Circuit split that I discuss below. In it, the Fourth Circuit noted that equitable remedies such as laches only apply to equitable actions, not statutory ones as in the Copyright Act. *Id.* at 797.

<sup>151</sup> *Id.*

constantly evolving notion of justice.<sup>152</sup> Yet justice is a relative concept, that when understood from the “perpetrator perspective,”<sup>153</sup> in Alan Freeman’s terms, can quickly become one-sided. As the Supreme Court observed in *City of Sherrill v. Oneida Indian Nation* (2005), “courts of equity act upon their own inherent doctrine of discouraging, for the peace of society, antiquated demands....”<sup>154</sup> Even independent of the racial issues that arise in *Harjo*, *Blackhorse*, and *Tam*, terms like “antiquated” necessarily evoke questions of racial justice because they require inquiries into how such outdated claims came to be and why they came to be. *Sherrill* is one example of how perpetrator perspectives on time are normalized, here through the categorization of one reading of the temporal as “antiquated.” In the same way that rhetorics of postraciality perpetuate the fiction that race is an irrelevant relic of the past,<sup>155</sup> competing narratives about the antiquated and the relevant shape understandings of justice and equity.<sup>156</sup>

---

<sup>152</sup> For a discussion of the racial justice issues at stake at equity generally, see, e.g., Kent Roach, *The Limits of Corrective Justice and the Potential of Equity in Constitutional Remedies*, 33 ARIZ. L. REV. 859 (1991) (noting that “[t]he potential of equity lies in its ability to legitimize relief that does not necessarily address the harms caused by the wrongdoer and goes beyond restoring the notional status quo ante.” *Id.* at 860.).

<sup>153</sup> See generally Alan David Freeman, *Legitimizing Racial Discrimination Through Antidiscrimination Law: A Critical Review of Supreme Court Doctrine*, 62 MINN. L. REV. 1049 (1987) (noting that “the concept of ‘racial discrimination’ may be approached from the perspective of either its victim or its perpetrator.” *Id.* at 1052).

<sup>154</sup> *City of Sherrill v. Oneida Indian Nation*, 544 U.S. 197, 217 (2005) (citing *Badger v. Badger*, 69 U.S. 87, 94 (1864)).

<sup>155</sup> For a discussion of how postraciality operates to delegitimize claims of race discrimination, see generally Ralina L. Joseph, “*Tyra Banks Is Fat*”: Reading (Post-)Racism and (Post-) Feminism in the New Millennium, 26 CRITICAL STUD. IN MEDIA COMMUN 237 (2009).

<sup>156</sup> See, e.g., Yara Sa’di-Ibraheem, *Jaffa’s Times: Temporalities of Dispossession and the Advent of Natives’ Reclaimed Time*, 29 TIME & SOC’Y 340 (2020).

In the context of copyright law, laches has a long and litigated history.<sup>157</sup> In a well-known passage among copyright lawyers, Judge Learned Hand wrote:

It must be obvious to every one familiar with equitable principles that it is inequitable for the owner of a copyright, with full notice of an intended infringement, to stand inactive while the proposed infringer spends large sums of money in its exploitation, and to intervene only when his speculation has proved a success.<sup>158</sup>

Judge Hand's argument highlights the economic costs of waiting to file suit in a copyright case until the allegedly infringing party has invested a great deal of time and money into the copyrighted work and the perverse incentives that even a purportedly equitable remedy can create. Analogous reasoning applies to patent law, as I discuss below. In *Haas v. Feist* (1916), the case Judge Hand was deciding, the relationship between time and justice is legible in the commentary on the exploitativeness and deceptiveness of waiting to file the copyright infringement claim in question.<sup>159</sup> For nearly 100 years, judges tended to read Judge Hand's opinion as a justification for recognizing laches defenses to copyright infringement.<sup>160</sup> Despite a Circuit split in application of laches to copyright law, the prevailing view through the 2000s was that the defense could succeed in at least some cases.<sup>161</sup> This changed when the Supreme Court stepped in to resolve the Circuit split.

---

<sup>157</sup> For a discussion of the contemporary state of copyright laches, see, e.g., Daniel Brainard, *The Remains of Laches in Copyright Infringement Cases: Implications of Petrella v. Metro-Goldwyn-Mayer*, 14 J. MARSHALL REV. INTEL. PROP. L. 432 (2015).

<sup>158</sup> *Haas v. Feist*, 234 F. 105, 108 (S.D.N.Y. 1916).

<sup>159</sup> *Id.*

<sup>160</sup> See, e.g., *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 695 F.3d 946, (9th Cir. 2012), *aff'd* 572 U.S. 663 (2014).

<sup>161</sup> *Didwania*, *supra* note 148, at 1228.

In 2014, the Supreme Court decided *Petrella v. MGM*, which resolved the split between the Circuits on the existence and scope of copyright laches.<sup>162</sup> *Petrella* involved an infringement claim against MGM for the film *Raging Bull*.<sup>163</sup> After a series of long delays, Paula Petrella, the daughter of Jake LaMotta’s close friend Frank Petrella, filed suit in 2009, alleging that *Raging Bull* infringed on a screenplay that her father had written in 1963.<sup>164</sup> MGM repeatedly denied having infringed on Petrella’s copyright.<sup>165</sup> The case centered on the question of whether MGM could defeat the infringement claim via a laches defense because Petrella had waited 18 years after renewing the copyright in her father’s screenplay to file suit.<sup>166</sup>

The Ninth Circuit and the district court found for MGM on the laches defense.<sup>167</sup> In concurrence, despite finding for MGM, Judge Fletcher observed that “[l]aches in copyright cases is...entirely a judicial creation. And it is a creation that is in tension with Congress’ intent.”<sup>168</sup> He also observed that Judge Hand’s opinion is inapposite, despite its invocation by courts who recognize copyright laches.<sup>169</sup> Judge Fletcher maintains that Judge Hand was making an observation about estoppel and not laches.<sup>170</sup> The Supreme Court agreed in part, deciding that “[w]hile laches cannot be invoked to preclude adjudication of a claim for damages brought within the Act’s three-year window, in extraordinary circumstances, laches may, at the very outset

---

<sup>162</sup> *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 673–74 (2014).

<sup>163</sup> *Id.*

<sup>164</sup> *Id.*

<sup>165</sup> *Id.*

<sup>166</sup> *Id.* at 677.

<sup>167</sup> *Id.*

<sup>168</sup> *Petrella*, 695 F.3d at 958 (Fletcher, J., concurring).

<sup>169</sup> *Id.*

<sup>170</sup> *Id.* at 959.

of the litigation, curtail the relief equitably awarded.”<sup>171</sup> Petrella’s suit, filed long after *Raging Bull* was released and copyright in her father’s screenplay was renewed, was nonetheless viable as to copyright infringement that occurred after its filing date in 2009.<sup>172</sup> The Court noted MGM’s claim, i.e. the equity issue presented by Petrella’s failure to make a copyright infringement claim prior to the studio’s investment in the film.<sup>173</sup> As *Petrella* highlights, not only does copyright laches raise questions of time, it raises questions of *what* time and *whose* time.

Similar issues arise in the context of patent law.<sup>174</sup> The Supreme Court recently took up the question of patent laches in *SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC, et al.*, analogizing itself to copyright laches contexts.<sup>175</sup> “[L]aches,” the Court reiterated, based on its decision in *Petrella*, 572 U.S. 663, “cannot be invoked to bar legal relief in the face of a statute of limitations enacted by Congress. The question ... is whether *Petrella*’s reasoning applies to a similar provision of the Patent Act, 35 U.S.C. §286, which includes a 6-year statute of limitations. We hold that it does.”<sup>176</sup> This most recent ruling on laches in patent law built on *Petrella* to assert similar statutory and equitable boundaries.<sup>177</sup> In both cases, concerns about

---

<sup>171</sup> *Petrella*, 572 U.S. at 665.

<sup>172</sup> *Id.* at 677.

<sup>173</sup> *Id.* at 676.

<sup>174</sup> See, e.g., *In re Bogese II*, 303 F.3d 1362, 1367 (Fed. Cir. 2002); *Reiffin v. Microsoft Corp.*, 270 F. Supp. 2d 1132, 1154 (N.D. Cal. 2003). The defense of patent laches was first established in *Kendall v. Winsor*, 62 U.S. 322 (1858). The statute of limitations in the Patent Act of 1952 limited the use of patent laches as a defense.

<sup>175</sup> *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prod., LLC*, 137 S. Ct. 954 (2017).

<sup>176</sup> *Id.* at 959 (internal quotations and citation omitted).

<sup>177</sup> Note that some argue that although the Supreme Court has declined to recognize laches defenses in patent cases that equitable estoppel still applies. See generally R. David Donoghue et al., *Patent Laches is Dead, Long Live Equitable Estoppel*, FINANCIER WORLDWIDE (Aug., 2017),

separation of powers, raised by Congress’ legislative pronouncements about statutes of limitations, heavily influenced the Supreme Court’s decisions.<sup>178</sup> Prior to the decision in *SCA Hygiene Products* the Federal Circuit used a “totality of the circumstances”<sup>179</sup> approach to evaluate assertions of laches defenses that is notable because of its flexibility in allowing consideration for the context of the decision. Race could be included in such an approach.

Instead of diving into the many threads of laches in copyright law and patent law in greater detail, I want to flag both as evidence of the importance of time in the laches defense, i.e. in the form of unreasonable delay, and its close relationship to the notion of justice, i.e. in the form of undue prejudice. *Petrella* raises the question of whether it is equitable to file a copyright infringement claim *after* the purportedly infringing party has invested in the copyrighted work; the temporal elements of justice in that context are clear.<sup>180</sup> The Ninth Circuit noted this issue in *Danjaq LLC v. Sony Corp.*, wherein the copyright holder appeared to have waited until the alleged infringer had invested approximately one billion dollars in the copyrighted work, i.e. the James Bond franchise, producing economic prejudice.<sup>181</sup> The Supreme Court’s blanket ruling on laches in the context of statutory limitations only considers some equitable considerations around time while erasing others. I would

---

<https://www.financierworldwide.com/patent-laches-is-dead-long-live-equitable-estoppel#.YEWQVJ1KhQA> [https://perma.cc/PB7P-L6UD]. Judge Hand’s opinion, as well as Judge Fletcher’s commentary, suggests this is true in the context of copyright laches as well. Estoppel is not, however, a 1:1 substitute for laches because of its distinct requirements.

<sup>178</sup> For a discussion of separation of powers, see Didwania, *supra* note 148.

<sup>179</sup> *Symbol Tech. Inc. v. Lemelson Med., Educ. & Rsch. Found., LP.*, 422 F.3d 1378, 1385–86 (Fed. Cir. 2005).

<sup>180</sup> *See, e.g., Jacobsen v. Deseret Book Co.*, 287 F.3d 936, 949 (10th Cir. 2002).

<sup>181</sup> *Danjaq LLC v. Sony Corp.*, 236 F.3d 942, 956 (9th Cir. 2001).

contend, for instance, that adherence to statutory guidelines above equitable concerns invests in Euro-American understandings of time, specifically those that value economic investments in intellectual property rights more than the integrity of creators. Such investments in even race neutral decision-making can reify whiteness and the property rights associated with it.<sup>182</sup> Equitable remedies, though they comport with congressional intent leave space for understanding social justice remedies. Yet, as I demonstrate through *Harjo*, that distinction can cut both ways. Equitable remedies can also become tools for disenfranchising people who lack structural power.

**C. *Sua sponte, Racial Time & Judicial  
Decision-making***

More than one legal theorist has referred to the power to create issues sua sponte as the “Gorilla Rule” that applies as the exception to the General Rule.<sup>183</sup> Many lawyers and scholars agree that this rule marks a considerable deviation from the adversarial party system, which is directed by the choice and agency of the parties, that usually governs in U.S. courts. However, they also seem to differ tremendously in their sense about when and how sua sponte decision-making is reasonable and acceptable. Some have described sua sponte decision-making as “playing God,” in that it can obstruct procedural due process.<sup>184</sup> These themes once again

---

<sup>182</sup> See, e.g., Bell, *supra* note 108.

<sup>183</sup> See Robert J. Martineau, *Considering New Issues on Appeal: The General Rule and the Gorilla Rule*, 40 VAND. L. REV. 1023, 1023 (1987) (“A well known riddle asks: ‘Where does an eight-hundred pound gorilla sleep?’ The response is: ‘Anywhere it wants.’ The judicial application of this rule would be: ‘When will an appellate court consider a new issue?’ The response is: ‘Any time it wants.’”).

<sup>184</sup> See, e.g., Adam A. Milani & Michael R. Smith, *Playing God: A Critical Look at Sua Sponte Decisions by Appellate Courts*, 69 TENN. L. REV. 245 (2001).

support the notion that procedural matters can be manipulative, even operating as a form of procedural gaslighting.<sup>185</sup> Yet despite these criticisms, courts create issues *sua sponte* with great frequency, especially in appellate courts, including the Supreme Court:

Supreme Court Rule 14.1(a) unequivocally states that “[o]nly the questions set out in the petition, or fairly included therein, will be considered by the Court.” The Supreme Court only ignores this rule “in the most exceptional cases, where reasons of urgency or economy suggest the need to address the unrepresented question in the case under consideration.” When the Supreme Court deems it necessary to disregard this rule, it acts “*sua sponte*”—or “on its own motion.”<sup>186</sup>

Evident in this discussion of *sua sponte* decision-making is a temporal argument: *sua sponte* questions are pressing ones, raised in the interest of efficiency. *Sua sponte* decision-making is intended to be an extreme measure, not one used in the daily course of affairs. Yet, courts appear to use this power far more frequently than such a standard

---

<sup>185</sup> For a recent discussion of procedural fetishism in the context of administrative law, see, e.g., Nicholas Bagley, *The Procedure Fetish*, 18 MICH. L. REV. 345 (2019) (seeking to “call into question the administrative lawyer’s instinctive faith in procedure, to reorient discussion to the trade-offs at the heart of any system designed to structure government action, and to soften resistance to the relaxation of unduly burdensome procedural rules.” *Id.* at 349.).

<sup>186</sup> Clayton P. Jackson, *Sua Sponte Conversions of Constitutional Challenges – Understanding Citizen’s United’s Enigmatic Procedural Quirk* (July 16, 2020), [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3653316](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3653316) [<https://perma.cc/48A4-R436>]. For similar arguments, see also Ronald J. Offenkrantz & Aaron S. Lichter, *Sua Sponte Actions in the Appellate Courts: The “Gorilla Rule” Revisited*, 17 J. APP. PRAC. & PROCESS 113, 116 (2016); *Greenlaw v. United States*, 554 U.S. 237, 243 (2008) (standing for the proposition that courts should generally occupy “the role of neutral arbiter.”).



would suggest, without concern for the creation of new issues that the parties did not raise.<sup>187</sup> The decision by courts to use their sua sponte authority is often deeply problematic, in no small part because it originates from the racial vantage points of individual judges and interferes with due process.<sup>188</sup> Broad use of sua sponte authority veers into the realm of judicial overreach; examples of egregious exercises of judicial power are abundant. While the definition of sua sponte as the practice of raising issues on the court's motion is straightforward, I want to explore the origins and implications of this judicial practice.

Like the equitable defense of laches, the power to create issues sua sponte originates in equity.<sup>189</sup> In the English legal system, the appellate court at equity had the authority to review any issue, while appellate courts at common law only had the authority to review issues decided at the trial court level and reflected in the record.<sup>190</sup> The latter was a result of the adversary process that dominates in U.S. law.<sup>191</sup> Because appellate courts at common law were not permitted to raise issues sua sponte, some have argued “sua sponte actions . . . are incongruous with current principles of appellate review.”<sup>192</sup>

Like the equitable defense of laches, the power to create issues sua sponte has considerable social justice consequences. One case in which sua sponte decision-making had a tremendous impact was *Citizens United v. FEC* (2010).<sup>193</sup> The issues that were raised sua sponte in that

---

<sup>187</sup> Greenlaw, 554 U.S. at 243 (standing for the proposition that courts should generally occupy “the role of neutral arbiter”); see generally Offenkrantz & Lichter, *supra* note 185.

<sup>188</sup> Milani & Smith, *supra* note 146, at 252.

<sup>189</sup> Offenkrantz & Lichter, *supra* note 186, at 117–18.

<sup>190</sup> *Id.*

<sup>191</sup> *Id.*

<sup>192</sup> *Id.* at 118.

<sup>193</sup> *Citizens United v. Federal Election Commission*, 558 U.S. 310 (2010).

case changed its entire scope, allowing for extremely broad, pro-corporation readings of free speech and political contributions.<sup>194</sup> I want to highlight this case because it is one that American Studies scholar Manu Karuka shows is deeply intertwined with histories of white supremacy in the United States.<sup>195</sup> *Citizens United* was made possible by a long history of building and reinforcing corporate power, ending in the conclusions that corporations are people for the purposes of political speech. Karuka argues in a chapter on “shareholder whiteness” that the corporate form operated as a mechanism through which to mobilize financial capital.<sup>196</sup> He further demonstrates that finance capital was a status property afforded only to those who enjoyed the privileges of whiteness.<sup>197</sup> Karuka goes on to build a genealogy of legal cases, from *Fletcher v. Peck* (1810) to *Citizens United*, that incentivize “citizen colonialism”<sup>198</sup> through corporate personhood. In this reading, *Citizens United* was the result of hundreds of years of investment in transforming settler colonists into agents of white supremacy, through the embrace of finance-based capitalism.

---

<sup>194</sup> See, e.g., Jackson, *supra* note 186.

<sup>195</sup> See MANU KARUKA, *EMPIRE’S TRACKS: INDIGENOUS NATIONS, CHINESE WORKERS, AND THE TRANSCONTINENTAL RAILROAD* 18 (2019). Through his nuanced critical race studies approach to examining the cultural and legal histories of Westward railroad expansion, Karuka shows that the U.S. has embraced overly simplistic narratives of sovereignty and capitalism that presume the inevitability of settler colonialism. Myths about the U.S. sovereignty and the inexorability of Manifest Destiny flatten time by ignoring the fits and starts of Westward Expansion, as well as the actors that caused them. The West was won not through the divine right of American Protestant culture but the piecemeal construction of a system of corporate shareholder capitalism, invested in whiteness, and hard earned victories in a long war against the communal intimacies of Native Nations and Chinese Americans. *Id.*

<sup>196</sup> *Id.* at 150.

<sup>197</sup> *Id.*

<sup>198</sup> See *id.* at 151.

As a result of shareholder whiteness and citizen colonialism, whiteness and shareholding came to be intertwined, with both operating as vehicles for racist labor exploitation and resource hoarding. The free speech element of this process, as later sections will show, was another step toward a deregulated First Amendment, through which people of color were made responsible for addressing the racism directed against them. Like the equitable defense of laches then, the judicial practice of raising issues sua sponte implicates time and social justice, including issues of race and coloniality. The next section turns to CRTIP to interrogate how both procedural practices operate in trademark law as vehicles for normalizing racism and colonialism, particularly in these cases highlighted here.

### III. THE RACIAL CHRONOPOLITICS OF (TRADEMARK) LAW

Dr. Martin Luther King Jr.'s dismissal of “well timed”<sup>199</sup> social protest in his 1963 “Letter from a Birmingham Jail” implicitly critiques the Supreme Court’s 1955 directive to states to carry out integration of schools with “all deliberate speed.”<sup>200</sup> As Lisa Corrigan observes, King’s language is a chronopolitical response to *Brown II* (1955) that demonstrates how time seems to go hand-in-hand with racial justice, for individuals and institutions.<sup>201</sup> Matthew Houdek and Kendall Phillips make a similar point, writing: “[T]his sense of *now* seems particularly common as a means of motivating action, as the current moment is

---

<sup>199</sup> Martin Luther King Jr., *Letter from a Birmingham Jail* (Apr. 16, 1963), [https://www.africa.upenn.edu/Articles\\_Gen/Letter\\_Birmingham.html](https://www.africa.upenn.edu/Articles_Gen/Letter_Birmingham.html) [https://perma.cc/6P5S-85X9].

<sup>200</sup> *Brown v. Bd. of Educ. of Topeka II*, 349 U.S. 294, 301 (1955).

<sup>201</sup> CORRIGAN, *supra* note 24, at 23–45.

depicted as being *the* moment of action.”<sup>202</sup> When oppression is consistently unbearable, the time to act is now but also *always*. The temporality of “patience,” then, often unfolds differently for those who are white and those who are not, as a result of differing racial time maps.<sup>203</sup> That which is *fast* for white people, is *slow* for Black People.

“Letter from a Birmingham Jail” is, in this respect, an attempt by King to reconcile what Mills might describe as clashing racial time maps in order to produce racial justice. Over the past four years, a subset of Americans watched in horror as the “whitelash”<sup>204</sup> that followed the postracial era that purportedly emerged *after* the election of President Barack Obama unfolded as the familiar authoritarian undoing of democracy. Comparisons to the past seemed ubiquitous as historians noted the similarities between 1968 and 2018.<sup>205</sup> Events repeated themselves, as the United States demonstrated itself to be far less post-racial than most had imagined and far less – or perhaps just as – democratic than its forefathers intended. Yet for some, the realities of Trump’s America affirmed the knowledge that racial violence is embedded within U.S. democracy while for others it produced a need to proclaim “this is not my America,”<sup>206</sup> as though it could be otherwise. In other

---

<sup>202</sup> Matthew Houdek & Kendall R. Phillips, *Rhetoric and the Temporal Turn: Race, Gender, Temporalities*, 43 *WOMEN’S STUD. IN COMMUN* 369, 370 (2020) (emphasis added).

<sup>203</sup> Mills, *supra* note 19, at 304.

<sup>204</sup> See, e.g., CAMERON D. LIPPARD, J. SCOTT CARTER & DAVID G. EMBRICK, *PROTECTING WHITENESS: WHITELASH AND THE REJECTION OF RACIAL EQUALITY* (2020).

<sup>205</sup> Kevin K. Gaines, *The End of the Second Reconstruction*, *MOD. AM. HIST.* 113, 118 (2018). Gaines argues that the Obama Era marked the need for a Second Reconstruction era. However, he also notes that the promise of civil rights was never realized due to intense racial backlash.

<sup>206</sup> For an Afrofuturist take on this sentiment, see DERRICK BELL, *The Space Traders*, in *FACES AT THE BOTTOM OF THE WELL: THE PERMANENCE OF RACISM* 158, 159–160 (1992). In Bell’s now classic science fiction tale, Ronald Reaganeque aliens offer to solve America’s

words, some racial time maps suggested that there was a period of time in which America was an ideal nation, free from racism, while other racial time maps asserted the opposite.<sup>207</sup>

King's story is a familiar one in America, taught in every school in the country. Yet, it is only one example of how time and dispossession are linked, with opposing groups recognizing that to control the temporal narratives of the moment is often to control the property relations of the moment. Renisa Mawani tells a similar tale of legal temporality with respect to the ship the *Komagata Maru*.<sup>208</sup> Building on the work of Lisa Lowe,<sup>209</sup> she contends that the dominant historical narrative in which British colonialism temporally *followed* Indigenous inhabitation oversimplifies the dialectic relationship between Indigenous Peoples, British Indians, and settler colonists.<sup>210</sup> Their relationships were mutually constitutive, not mutually exclusive. The racial time maps that Mawani reveals problematize the purportedly clear and decisive lines between the time of indigeneity and the time of colonialism. By showing that British colonists articulated their identities via complex dialectic with the Indigenous Peoples they encountered, Mawani demonstrates that legal sovereignty was constituted

---

environment and economic problems in exchange for its Black people. Bell's point throughout the story and the book is that racism in the U.S. is permanent.

<sup>207</sup> See Mills, *supra* note 19.

<sup>208</sup> RENISA MAWANI, *ACROSS OCEANS OF LAW: THE KOMAGATA MARU AND JURISDICTION IN THE TIME OF EMPIRE* (2018).

<sup>209</sup> Lisa Lowe's book *The Intimacies of Four Continents* explores the interconnections of colonial trade and settler colonialism across multiple continents. This exploration of the *linkages* of coloniality fundamentally pushes back against Euro-American racial time maps in which coloniality is a complete and inevitable process. For Lowe, Karuka, and Mawani, quite the opposite is the case. See generally LISA LOWE, *THE INTIMACIES OF FOUR CONTINENTS* (2015).

<sup>210</sup> Renisa Mawani, *Specters of Indigeneity in British-Indian Migration, 1914*, 46 L. & SOC'Y REV. 369, 371–72 (2012).

through Indigenous Peoples, not *before* them.<sup>211</sup> As in Karuka’s example, the duration of Indigenous sovereignty is longer than British colonists wish to admit, casting doubt on the swiftness and completeness of British sovereignty.<sup>212</sup> In this respect, “temporally before”<sup>213</sup> is a fiction of time’s duration, through which law naturalizes and legitimizes its own function. The marking of the beginning of a period of colonial time is a claim to sovereignty, a centering of Empire’s law through fictive temporality.

The schema for studying time that I want to develop here is that of racial chronopolitics, in the context of intellectual property law, through the equitable defense of laches and the judicial power to create issues sua sponte. Chronopolitics as a concept speaks generally to the relationships among culture, politics, and time, across multiple identities and axes.<sup>214</sup> This broad schema for understanding time highlights temporality’s many manifestations within law, while attending to how and where time emerges as a mediator of race in legal contexts. Cheryl I. Harris’s canonical “*Whiteness as Property*” lays out a framework for understanding how white supremacy continues to exist within law, even as the nation professes “colorblindness.”<sup>215</sup> She lays out a structural and temporal

---

<sup>211</sup> *Id.*

<sup>212</sup> *Id.* (explaining: “My objective is to question and unsettle the presumed linearity of colonial time implicit in the configuration of indigenous and nonindigenous subjectivities and in colonial legal historiographies that depict encounters among [I]ndigenous [P]eoples, Europeans, and non-European migrants in successive spatiotemporal terms.” *Id.* at 373.).

<sup>213</sup> Elizabeth A. Povinelli, *The Governance of the Prior*, 13 INTERVENTIONS 13, 19 (2011).

<sup>214</sup> CORRIGAN, *supra* note 24, at xiv.

<sup>215</sup> See generally Cheryl I. Harris, *Whiteness as Property*, 106 HARV. L. REV. 1707 (1993) (Harris writes that: “Whiteness as property has taken on more subtle forms, but retains its core characteristic – the legal legitimation of expectations of power and control that enshrine the status

argument, contending that property rights “are contingent on, intertwined with, and conflated with race.”<sup>216</sup> She notes that one of the goals of her essay is to “examine the emergence of whiteness as property and trace the evolution of whiteness from color to race to status to property as a progression historically rooted in white supremacy and economic hegemony over Black and Native American [P]eoples.”<sup>217</sup> Judicial interventions into temporality, like judicial interventions into structures of property, have frequently reinforced the power of whiteness, through the affirmation of Euro-American racial time maps. The remainder of this section explores racial chronopolitics as a tool for understanding temporality in law, first generally then specifically, in trademark law.

#### **A. Racial Time Maps in Legal Practice**

Ian Haney López’s groundbreaking *White by Law: The Legal Construction of Race*. López, explores the role of what he names the Prerequisite Cases, i.e. the judicial decisions in which courts determined the racial scope of the citizenship rights afforded by the Reconstruction amendments.<sup>218</sup> López also uses the example of the Mashpee Indians, who filed suit in 1976 to recover tribal lands from the U.S., in order to show how racial time maps articulated from Euro-American positionalities necessarily exclude and disenfranchise Indigenous Peoples.<sup>219</sup> In *Mashpee Tribe v. Town of Mashpee*, 447 F. Supp. 940 (1978), the district court decided against the Mashpee

---

quo as a neutral baseline, while masking the maintenance of white privilege and domination.” *Id.* at 1715.).

<sup>216</sup> *Id.* at 1714.

<sup>217</sup> *Id.*

<sup>218</sup> See generally IAN HANEY LÓPEZ, *WHITE BY LAW: THE LEGAL CONSTRUCTION OF RACE* (1997).

<sup>219</sup> *Id.* at 127–28. López does not use the phrase “racial time maps” but the sentiments about time are the same. *Id.*

Indians, finding that they did not constitute a “tribe” under the Indian Non-Intercourse Acts.<sup>220</sup> López writes of the case’s temporalities explicitly, speaking of moments and durations around which colonialism operates:

Designed to prevent private transactions with Native American tribes, this statute, like the naturalization laws, was originally enacted in 1790. The district court ruled that in order to proceed, the Mashpee first had to prove they were a “tribe” within the meaning of the word as defined by the Supreme Court in 1901, to wit “a body of Indians of the same or similar race, united in a community under one leadership or government, and inhabiting a particular though sometimes ill-defined territory.” The Mashpee, seeking in 1976 to use a 1790 law, were required to prove they existed in terms of a 1901 definition of a Native American tribe. This definition, and indeed the Non-Intercourse Act itself, contained antiquated, racist, and restrictive notions of tribal identity, not least in the establishment of racial purity as a requisite element of tribal existence and in the spirit of paternalism and domination animating the statute.<sup>221</sup>

The district court uses a temporal sleight of hand to project whiteness onto the Mashpee Indians in an attempt to legally bind them to a vision of citizenship—and citizen colonialist, to call back to Karuka—that will certainly dispossess them of their land. Settler colonial legislation and “precedent” become tools of extending the duration of a past long passed

---

<sup>220</sup> Congress passed the Indian Non-Intercourse Acts from 1790–1834 in order to define and manage land conveyances to tribes. See 25 U.S.C. § 177 (1834). For a critique of blood quantum and other colonial measures of “Indianness,” see generally Desi Rodriguez-Lonebear, *The Blood Line: Racialized Boundary Making and Citizenship among Native Nations*, SOCIO. OF RACE & ETHNICITY (2021).

<sup>221</sup> LÓPEZ, *supra* note 218, at 89.



into the present, in a manner that Harris might critique as proof of the shifting bounds of whiteness as temporality.<sup>222</sup>

López's example demonstrates how racial time maps function, through construction and deconstruction of significant points in time and durations of time. In the case of the Mashpee Indians, duration of precedent, specifically the reach of the 1901 definition of "tribe," becomes a vital element in the deprivation of the very right to the identity required to claim Indigenous lands.<sup>223</sup> López's method is important because it alerts us to 1) legal temporalities related to precedent but also 2) human temporalities related to people. *Stare decisis*, which is ultimately controlled by judges, serves as a release valve for issues of race and coloniality. Put differently, when individual judges choose to intervene in issues of time, they have the power to structurally endorse particular visions of race. Their decisions may also be informed by problematic and antiquated representational politics that are then translated into structural realities.<sup>224</sup> These two propositions become relevant in the two trademark cases that I examine in detail, because they highlight the personal judicial agency involved in rooting out racism and colonialism.

---

<sup>222</sup> See generally Harris, *supra* note 215.

<sup>223</sup> LÓPEZ, *supra* note 218, at 127–28.

<sup>224</sup> One such problematic representational politic might be the Myth of the Vanishing Indian, i.e. the belief that Indigenous Peoples were completely eliminated by settler colonialism. See generally Brewton Berry, *The Myth of the Vanishing Indian*, 21 *PHYLON* 51–57 (1960). Maillard speaks of the Indian Grandmother Complex as a means of both claiming Indigenous ancestry and distancing from the purported savagery of Indianness. Maillard, *supra* note 33, at 380–81. Both of these tropes have a temporal quality to them, that manages and constricts the agency of Indigenous Peoples. As individuals steeped in racist and colonialist cultures, judges are as prone as anyone to make errors of judgment about people of color, perhaps even more so given their relationships to whiteness; see also Philip J. Deloria's canonical work on Native representation and "playing Indian" in the U.S. in PHILIP JOSEPH DELORIA, *PLAYING INDIAN* (2007).

Further, López’s argument is another example of how reading law from a Critical Race Theory perspective can reveal different racial time maps, with distinct and articulable social justice concerns. Without a doubt the Mashpee Indians, operating within their own racial time maps, considered themselves to be a tribe. But the United States Federal Government, who imposed a Euro-American racial time map onto them, did not. Whether through constancy or interruption, white supremacy functions via the presentation of Euro-American race time-maps as normal and natural, and all other time maps as, in Kathryn McNeilly’s terms, illegibly “untimely.”<sup>225</sup> Natalia Molina, a historian of citizenship, argues that reading race across time is an important exercise because it demonstrates how fragments of racist discourse can be invoked and redeployed in different historical moments and across racial groups.<sup>226</sup> McNeilly contends that “[u]ntimeliness thought in this way requires abandoning commitment to linearity, progression and predictability.”<sup>227</sup> The next section takes López’s reading as a model for reading the temporal politics of the subjects of this Article, *Harjo*, *Blackhorse*, and *Tam*.

### ***B. Mapping Racial Time in Harjo, Blackhorse, and Tam***

I want to return to the question that I posed early in this Article with respect to the decisions by the Federal Circuit and Supreme Court in *Tam*: “why now?” That question, of course, focuses attention on why the courts in

---

<sup>225</sup> See generally Kathryn McNeilly, *Are Rights Out of Time? International Human Rights Law, Temporality, and Radical Social Change*, 28 SOC. & LEGAL STUD. 817, 818 (2018).

<sup>226</sup> See generally NATALIA MOLINA, *HOW RACE IS MADE IN AMERICA: IMMIGRATION, CITIZENSHIP, AND THE HISTORICAL POWER OF RACIAL SCRIPTS* (1st ed. 2014).

<sup>227</sup> McNeilly, *supra* note 225, at 818.

question chose this moment to overturn *In re McGinley* in the service of finding Section 2(a) of the Lanham Act to be unconstitutional. The query is, at root, a chronopolitical one, that also implicates race. As Rakoff notes, temporal questions are unavoidable.<sup>228</sup> This section asks where they exist and what to do with them, specifically in the contexts of *Harjo*, *Blackhorse*, and *Tam*. Mills' concept of racial time maps is one entrée into reading temporality in these cases.<sup>229</sup> I contend that the D.C. Circuit in *Harjo* defaulted to Euro-American settler colonial racial time maps in making their decisions which, in turn, produced an incomplete assessment of the issues at stake in evaluating the laches defense as well as an imposition of judicial authority on trademark law. *Harjo* hinged on the age of the plaintiffs seeking to invalidate the R\*\*\*\*\* trademarks.<sup>230</sup>

Yet, the *materiality* of the age of majority was an equitable question that the judges in *Harjo* had the ability to set in the context of histories of settler colonialism. To put this differently, the lawyers and judges involved in *Harjo* could have explored alternate approaches to understanding and interpreting the age of majority as a justification for the equitable defense of laches, situated in racial justice and colonial dispossession.<sup>231</sup> Addie C. Rolnick notes that the tendency of courts to treat Indian law is “political rather than racial in nature.”<sup>232</sup> The decision in *Harjo* continued that practice by treating the failure of the plaintiffs to file in a

---

<sup>228</sup> RAKOFF, *supra* note 16, at 3.

<sup>229</sup> Mills, *supra* note 19, at 299–300.

<sup>230</sup> See *Pro-Football, Inc. v. Harjo*, 284 F. Supp. 2d. 96, 112, 143–44 (D.D.C. 2003).

<sup>231</sup> I do not want to collapse racial justice and decolonial praxis here, as both are relevant to the discussion in this Article.

<sup>232</sup> Rolnick, *supra* note 33, at 963 (citing *Morton v. Mancari*, 417 U.S. 535, 553 n.24 (1974)). For a discussion of “legitimized racism” against Native Americans, including use of the term r\*\*\*\*\*, see Dwanna L. Robertson, *Invisibility in the Color-Blind Era: Examining Legitimized Racism against Indigenous Peoples*, 39 AM. INDIAN Q. 113, 114 (2015).

matter that was “timely” as an economic calculation instead of a racial calculation, underpinned by centuries of settler colonial disenfranchisement. Investment in and increasing revenues from the R\*\*\*\*\* trademarks took center stage in the appellate review of the case.<sup>233</sup> Yet, the trademarks themselves were built on the foundation of settler colonial land theft set forth in *Johnson v. M’Intosh* (1823) and were maintained, in no small part, through the circulation of racist images.

In *Johnson*, the Supreme Court began with a narrative of British and American sovereignty through which property law was articulated.<sup>234</sup> Justice Marshall used this narrative, with its temporal components, as a colonial logic through which to find that the Piankashaw Indians possessed only a right of occupancy in their land, not a right of conveyance.<sup>235</sup> Through its definition of occupancy, *Johnson* rhetorically and materially imposed a Euro-American racial time map on the U.S. in the service of settler colonialism. *Harjo* replicated that Euro-American racial time map by taking procedural questions about the age of majority as unrelated to race and (de)colonization and, relatedly, taking the racial underpinnings of equitable defenses as “colorblind.”

Accepting writ large that property and trademarks ought to be governed by the “fictive temporalities”<sup>236</sup> of colonial practice results in a wholly Euro-American racial time map, through which the lived experiences of Indigenous Peoples are invalidated and erased. This is, to recall Chon’s term, the procedural gaslighting that occurs through the equitable defense of laches.<sup>237</sup> Consider, in

---

<sup>233</sup> See *Harjo*, 284 F. Supp. 2d. at 112.

<sup>234</sup> *Johnson v. M’Intosh*, 21 U.S. 543, 573–74 (1823).

<sup>235</sup> *Id.* at 587–89 (holding that “discovery gave an exclusive right to extinguish the Indian title of occupancy”).

<sup>236</sup> Maillard, *supra* note 33, at 357.

<sup>237</sup> Chon, *supra* note 21.

contrast to the D.C. Circuit's finding in *Harjo*, an exegesis in which the judges acknowledged the embeddedness of trademark law in larger histories of settler colonialism. An opinion written by aforementioned judges might have acknowledged the false characterization of Native mascots as respectful, even as they are rooted in settler colonial temporal narratives of nation,<sup>238</sup> the application of the age of majority as unjust based on intersectional Indigenous disempowerment,<sup>239</sup> or the immense power and whiteness of professional sports teams, particularly when pitted against Native Americans, as a means of accepting the *Harjo* plaintiff's argument.<sup>240</sup> The racial time map upon which the D.C. Circuit relied took all of the above for granted, in a move that reinforced settler colonialism. As Walter Dignolo writes: "[t]he problem with coloniality of knowledge, and of existing within its realm (knowing, sensing and believing), is that it makes us believe in the ontology of what the North Atlantic's 'universal fictions' have convinced us to believe."<sup>241</sup> The "universal fictions" in *Harjo* are temporal

---

<sup>238</sup> Victoria F. Phillips, *Beyond Trademark: The Washington Redskins Case and the Search for Dignity*, 92 CHL-KENT L. REV. 1061, 1067 (2017) (writing that: "Most of the appropriated Native imagery was based on a false historical narrative and highly exaggerated caricatures. Many of the portrayals included fictitious, savage, and violent imagery.").

<sup>239</sup> See Kimberle Crenshaw, *Demarginalizing the Intersection of Race and Sex: A Black Feminist Critique of Antidiscrimination Doctrine, Feminist Theory and Antiracist Politics*, 1989 UNIV. OF CHI. LEGAL F. 139, 166 (1989), available at <http://chicagounbound.uchicago.edu/uclf/vol1989/iss1/8> [<https://perma.cc/6683-CKCT>] (describing how multiple interlocking forms of oppression can result in unique forms of oppression; here, the fact that Native Americans are deracialized, dispossessed, and erased may form the basis of a persuasive intersectional claim).

<sup>240</sup> Riley et al., *supra* note 54.

<sup>241</sup> Walter D. Mignolo, *Coloniality Is Far from Over, and So Must Be Decoloniality*, 43 AFTERALL: A J. OF ART, CONTEXT & ENQUIRY 38, 39 (2017).

and positional. They sanitize and weaponize time, through judgments about harm to each side, and precedent, by overturning *McGinley*, in a manner that, intentionally or inadvertently, reinforced whiteness as (intellectual) property and broke with stare decisis.

The Federal Circuit and the Supreme Court engage in similar temporal bait and switches in *Tam*. I would be remiss not to parse the harms here: while *Tam* identified a valid harm that required redress, the Court’s decision to approach it through deregulating free speech was deeply problematic. The most compelling evidence that they defaulted to a Euro-American racial time map in making their decisions is the timing of the reversal. Judge Laurie, dissenting in the Federal Circuit, expressed his skepticism at the refusal of the Court to follow precedent, even after nearly seven decades.<sup>242</sup> While stare decisis can certainly operate as a tool of injustice, in this case it does not. It is a mechanism through which addressing racism and colonialism is assigned to neoliberal markets.<sup>243</sup> The break with precedent, made all the more notable by the amount of time that had passed since *McGinley*, signaled alignment with racial capitalism. Breaking with precedent is often a mark of progress, even judicial activism. But here, I contend, it is a signifier of judicial commitment to an underlying history of trademark law mired in the circulation of derogatory and violent images, through which people of color were rendered inferior to white people.

Important here is the observation that markets do not only produce goods, they produce social relations, i.e. the understandings of economy and relationality through which

---

<sup>242</sup> In re *Tam*, 808 F.3d 1321, 1374 (Fed. Cir. 2015) (Lourie, J., dissenting).

<sup>243</sup> For Simon Tam’s vision of the litigation in *Tam* and its implications, see generally TAM, SLANTED, *supra* note 83 ; for a discussion of the divisiveness of reclaiming the term “slants,” see generally Tam, *The Slants to NAPABA*, *supra* note 113.

domination is justified.<sup>244</sup> Angela P. Harris writes that “[W.E.B.] Du Bois saw white supremacy not only as a way to sustain economic exploitation, but also as a psychological and cultural technology that discredits the image of *homo economicus* as motivated purely by rational self-interest.”<sup>245</sup> Karuka, of course, provides additional evidence for this point by demonstrating how citizen colonialism was enacted through the expansion of shareholder whiteness, a particularity of the capitalist corporation.<sup>246</sup> The temporal break in *Tam* is thus a conservative one, through which settler colonial time is functionally reset, in a move that frustrates the discursive and material project of decolonization.<sup>247</sup> Again, by differently orienting to temporality, the lawyers and judges involved in *Tam*, which set the stage for *Blackhorse* to be overturned, could have centered anti-racism and anti-coloniality.

Like the precedent that López focuses on as disenfranchising Native Americans, *Harjo*, *Blackhorse*, and *Tam* default to Euro-American racial time maps while

---

<sup>244</sup> Angela P. Harris, *Where is Race in Law and Political Economy?* LPE PROJECT (Nov. 30 2017), <https://lpeproject.org/blog/where-is-race-in-law-and-political-economy/> [<https://perma.cc/P9WE-7J5X>]. When I speak of racial capitalism, I am referring to the radical Black tradition of that term that originates with Cedric Robinson. For an accessible discussion of racial capitalism and its meaning, see, e.g., Robin D.G. Kelley, *What Did Cedric Robinson Mean by Racial Capitalism?* BOSTON REV. (Jan. 12, 2017), <http://bostonreview.net/race/robin-d-g-kelley-what-did-cedric-robinson-mean-racial-capitalism> [<https://perma.cc/238Q-FXY2>].

<sup>245</sup> Harris, *supra* note 244.

<sup>246</sup> See generally KARUKA, *supra* note 195.

<sup>247</sup> For a discussion of decolonization and its practices, see, e.g., Eve Tuck & K. Wayne Yang, *Decolonization is not a Metaphor*, 1 DECOLONIZATION: INDIGENITY, EDUC., & SOC’Y 1 (2012). I am mindful here of the many genealogies and strands of decoloniality, even among Indigenous Peoples. Decolonization is a local, as well as global, practice that must center and support the views of actual Indigenous Peoples, not direct saviorism at them.

invoking facially neutral legal arguments. The equitable defense of laches cannot produce justice if it cannot respect the equity interests of all litigants. Similarly, the judicial practice of raising issues *sua sponte* requires good racial judgment on the part of judges, as well as the lawyers responding to them. These procedures not only frustrate the social justice goals of groups that have been historically disenfranchised, but they also do real and grievous harm to those parties who do cannot seek redress for harm. A just approach to racial chronopolitics, then, is an accountability issue, through which settler colonialism can be addressed or ignored. In the final subsection of the Article, I consider how a decolonial approach to time might look in the context of law, with particular attention to embracing the “untimely.”

### ***C. Decolonizing Trademark Law’s Temporalities***

Crafting emancipatory racial chronopolitics is a far from straightforward task. Indeed, Mills ends his meditation on racial time with a pointed but inchoate call for “an oppositional racial chronopolitics.”<sup>248</sup> Just action in the face of this call requires “a recognition of the racial structuring of the modern world and the concomitant need for racial justice.”<sup>249</sup> Mills’ referent in making this call is Euro-American political discourse, which centers a linear progress narrative that stretches from political philosophers including Immanuel Kant, John Locke, David Hume, and Thomas Jefferson to the present day, in which their conceptions of the world seem normal and natural.<sup>250</sup> Yet, as I suggested in the previous section, looking critically at the racialized effects of particular conceptions of “equity” creates opportunities for discussing racial equity. So too does

---

<sup>248</sup> Mills, *supra* note 19, at 312.

<sup>249</sup> *Id.*

<sup>250</sup> See generally CHARLES W. MILLS, *THE RACIAL CONTRACT* (2011).



learning to identify and undo Euro-American racial time maps, through legal argument and judicial practice. Defaulting to Euro-American racial time maps that, definitionally speaking, delegitimize the lived experiences and legal claims of Native Americans and Asian Americans will necessarily frustrate social justice goals.

López's understanding of *Town of Mashpee* underscores this, by showing how the collision of settler colonial property law and Euro-American racial time maps coalesce to produce an exclusionary definition of tribe that disenfranchises Indigenous Peoples.<sup>251</sup> His implicit response to this problem, of course, is to center self-determination as a principle of identity and property. Changing both understandings of time and understandings of identity is necessary to build Federal Indian Law that is capable of honoring the histories and rights of Indigenous Peoples, as well as Asian Americans. Angela R. Riley and Kristen A. Carpenter discuss the process through which settler colonial time unfolded and Indigenous Peoples came to be "owned" by whites, in a way that hastened dispossession and genocide:

By the time of U.S. independence, the Native population had been reduced by as much as 95% since the point of contact due to war, genocide, disease, and various other factors. With such devastating reductions in the number of Native people, settlers continued to remove remaining Indians from desired territories and began to see them as symbolic of a free, pagan, and disappearing race whose land, material culture, and identity could be taken and then consumed and assumed by whites. As Deloria has documented, by the late 1700s fraternal societies had formed in which members dressed up as Indians—including face paint and buckskin—while carrying bows, arrows, and pipes. Entranced by the "unknowable knowledge" possessed by the "enigmatic Indian,"

---

<sup>251</sup> LÓPEZ, *supra* note 218, at 127–28.

inductees of organizations like the “Society of Red Men” and the “Improved Order of Red Men” underwent initiation ceremonies and were given Indian names to mark “the passage from paleface to Red Man.” These organizations used Indian hierarchies—sachems, chiefs, councils, squaw sachems, and warriors—all modeled on their perception of secret “Indian mysteries.” According to Deloria, these organizations served to instantiate the Americanness of elite individuals in the new Republic, linked together through secret, fraternal organizations promoting multilayered identities of patriotism, political engagement, and service.<sup>252</sup>

Implicit in the story they tell is a racial time map that is vastly different than that imposed upon Indigenous Peoples in *Harjo* and *Blackhorse*. Deloria’s grandfather, a plaintiff in *Harjo*, highlights the close relationships between representations of Indians that entrench the Myth of the Vanishing Indian, performance of Indian customs and rituals, and settler colonial genocide. Time is marked by moments of exploitation, not of financial gain. The notions of time that Euro-American corporations, such as the Washington R\*\*\*\*\* and its owners, adopt are intertwined with histories of colonial expansion.<sup>253</sup> They perpetuate understandings of financial loss that begin by devaluing the lives of people of color, particularly Native Americans.

McNeilly, of course, treats the entrée of other than the Euro-American into legal racial time maps as a break with the timely.<sup>254</sup> The untimely, in this sense, marks a point of temporal rupture, through which new understandings of time can be centered and produced. McNeilly discusses the “untimely” in the context of international human rights law.<sup>255</sup> Building on the work of critical human rights

---

<sup>252</sup> Riley & Carpenter, *supra* note 53, at 873–74.

<sup>253</sup> Pryor, *supra* note 37.

<sup>254</sup> McNeilly, *supra* note 225, at 818.

<sup>255</sup> *Id.*

scholars such as Upendra Baxi and Makau Mutua, McNeilly suggests a new direction – and temporality – for the corpus:

By this I do not mean that the time of these rights has come to an end, or that their utility has necessarily faltered . . . what I argue is that a productive future . . . may be envisaged by considering more closely its relationship to temporality and by actively thinking through a conception of rights that is *untimely*.<sup>256</sup>

Untimely rights are those that are “out-of-step or out-of-time, which goes beyond a linear and progressive relation between past, present and future and, additionally, involves a[] ‘leap into the future without adequate preparation in the present . . . the creation of the new, to an unknown future, what is no longer recognizable in terms of the present.’”<sup>257</sup>

Exactly *what* constitutes the untimely in the context of trademark law is up for debate. In one reading, the interjection of the free speech argument into the case is untimely, because it lacks a temporal justification. However, in another reading, the untimely describes the move away from a linear progress-oriented narrative of rights. That is to say, for instance, encouraging courts to critically examine arguments about the benefits Indigenous Peoples might derive from Pro-Football investing in their trademark in order to evaluate a claim of laches might support untimeliness. Put differently – and building on the above – it is far more likely that Romero and the other plaintiffs slept on their rights for practical reasons, related to structural oppression than desired to freeride on the labor of the defendant. Indeed, per Riley and Carpenter, it is the Washington Football Team that was freeriding on the

---

<sup>256</sup> *Id.*

<sup>257</sup> *Id.* (citing Elizabeth Grosz).

identities of Native Americans.<sup>258</sup> Using the untimely as a lens for rethinking where equitable remedies do and should lie with respect to anti-racism and anti-coloniality is a powerful way of centering social justice, especially within exploitative systems of racial capitalism.

Read in this light, *Harjo*, *Blackhorse*, and *Tam* offer three primary lessons: 1) legal actors, including lawyers and judges, have a *choice* in the matter of how they wish to handle procedural questions that implicate the timely and the untimely, 2) legal actors frequently lack the *skills and schemas* to identify and parse racial issues that arise in the context of trademark and other intellectual property cases, including through the lenses of temporality, and 3) *racial justice training* for law students who will become lawyers, professors, and judges to think about issues such as how time operates in the context of intellectual property law specifically and judicial decision-making more generally is integral to dismantling the structures of white supremacy. These three lessons do not hinge on the outcome of the intellectual property cases that I have discussed. Rather, they point us in the direction of decolonial methodologies for considering and confronting structural calcifications of race within law. Understanding how time works in intellectual property law, can create possibilities for making novel arguments about racial justice.

#### IV. CONCLUSION

Trademark law has long been intertwined with race and colonialism, through the perpetuation and monetization of images that degrade and humiliate people of color. From Aunt Jemima, the Quaker Oats Pancake Mummy to Mia, the Land O’ Lakes Butter Maiden, the racialization of Black,

---

<sup>258</sup> Nancy Leong’s new book on “identity capitalism” gets at this very issue. NANCY LEONG, *IDENTITY CAPITALISTS: THE POWERFUL INSIDERS WHO EXPLOIT DIVERSITY TO MAINTAIN INEQUALITY* (2021).

Indigenous, and Brown people has been commonplace in American culture. The circulation of trademarks that normalize racial hierarchies functionally reconstructs “better days,” even as the nation professes its desire to move toward a “colorblind” and “postracial” world. Even now, in 2021, battles over the cancellation of these trademarks persists. One representational and structural undercurrent in trademark battles involving people of color is that of racial time. Not only are the representations that people of color are struggling against often regressive ones that point to times that have purportedly passed, but the procedural mechanisms through which courts manage them also reveal a strong judicial monopoly on racial time maps. Affirmative defenses like laches and judicial powers like *sua sponte* highlight how race, time, and law intersect.

I have argued here that developing intentional modes of racial chronopolitics can help to address some of the dispossession that occurs through lawyerly and judicial default to Euro-American racial time maps. In the cases I examined here, i.e. *Harjo*, *Blackhorse*, and *Tam*, the courts’ analyses of laches and judicial practice of raising issues *sua sponte* project Euro-American narratives about time onto Indigenous Peoples and Asian Americans. They also facilitate the convenient invocation of free speech issues in cases in which such issues have been treated otherwise for decades. Despite *Tam*’s own protestations to the contrary, I read *Tam* as a pyrrhic victory, that enables the Slants to protect their name at the expense of deregulation and entrenches racial capitalism as well as settler colonialism. The racial libertarian logics of the case rely on free market and free speech (de)regulation to cure the ills of racism. Such logics largely revert to a status quo invested in protecting white supremacy, not the rights of Black and Brown Peoples. Defaulting to Euro-American racial time maps, as the courts in *Harjo*, *Blackhorse*, and *Tam* do, allows corporations to control narratives of oppression in ways that are contrary to

the realities of the lives of people of color. Decolonizing racial chronopolitics and legal procedure is accordingly necessary and pressing, in and out of trademark law.

I want to conclude by gesturing toward the ways that lawyers and law professors can engage critically with questions such as the ones presented in *Harjo*, *Blackhorse*, and *Tam*. The first step in attending to racial chronopolitics is to recognize that lawyers and judges have a choice in how they engage with matters of time. After making this recognition, they can turn to crafting theories of time that they can leverage to make powerful arguments about racial justice and settler colonialism in the courtroom. Expounding upon these theories is an important next step, particularly insofar as it ensures that the default Euro-American racial time maps that facilitate racial and colonial exploitation can be carefully decolonized.

# IDEA®: THE LAW REVIEW OF THE FRANKLIN PIERCE CENTER FOR INTELLECTUAL PROPERTY

## SUBSCRIPTION INFORMATION

---

Subscribers must renew their subscriptions by December 1 each calendar year. Please inform your subscription agency if applicable. Please fill out this form and mail it or send it as an email attachment. Payment may be made by check or by credit card.

Mailing Address: IDEA®: The Law Review of the Franklin Pierce Center for Intellectual Property  
Attn: Lauri Connolly  
University of New Hampshire Franklin Pierce School of Law  
Two White Street  
Concord, NH 03301

Email: subscriptions@law.unh.edu  
Phone: 603.513.5246

### TYPE OF SUBSCRIPTION REQUESTED:

- DOMESTIC \$68  
 FOREIGN \$79  
 DOMESTIC STUDENT \$25

SCHOOL: \_\_\_\_\_ EXP. GRAD. YEAR: \_\_\_\_\_

**(PROOF REQUIRED)**

### METHOD OF PAYMENT:

- CHECK – ENCLOSED FOR \$ \_\_\_\_\_ (PAYABLE TO IDEA – UNH LAW)  
 CREDIT CARD – PLEASE CHARGE MY CREDIT CARD FOR \$ \_\_\_\_\_  
 VISA  MASTERCARD  AMERICAN EXPRESS  OTHER \_\_\_\_\_

CREDIT CARD #: \_\_\_\_\_

EXPIRATION DATE: \_\_\_\_\_

SIGNATURE: \_\_\_\_\_

NAME/TITLE: \_\_\_\_\_

COMPANY/FIRM: \_\_\_\_\_

ADDRESS: \_\_\_\_\_

CITY/STATE/ZIP/COUNTRY: \_\_\_\_\_

EMAIL: \_\_\_\_\_ PHONE: \_\_\_\_\_

