



AMERICAN INTELLECTUAL PROPERTY LAW ASSOCIATION

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The Honorable Q. Todd Dickinson
Acting Assistant Secretary of Commerce and
Acting Commissioner of Patents and Trademarks
U. S. Patent and Trademark Office
Department of Commerce
P. O. Box 4
Washington, D.C. 20230

Attention: Eleanor K. Meltzer, Attorney-Advisor
Office of Legislative and International Affairs

Re: AIPLA Comments on the Official Insignia of Native American Tribes;
Statutorily Required Study 64 Fed.Reg. 13004 (March 16, 1999)

Dear Commissioner Dickinson:

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to present its views on the statutorily required study of issues surrounding trademark protection for the official insignia of federally and/or State recognized Native American Tribes, published in the *Federal Register* on March 16, 1999 (64 Fed.Reg. 13004).

The AIPLA is a national bar association of nearly 10,000 members engaged in private and corporate practice, in government service, and in the academic community. The AIPLA represents a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright and unfair competition law, as well as other fields of law affecting intellectual property.

The AIPLA has the following comments, which correspond to the numbered paragraphs in the *Federal Register* Notice:

(1) *The Definition of "Official Insignia"*

The AIPLA believes that, in the first instance, the PTO, with the cooperation of the Bureau of Indian Affairs, should conduct hearings to obtain information on what Native American Tribes believe to be

official insignia and how such insignia have been and are being used both by Native American Tribes and others. The Bureau of Indian Affairs, which has familiarity with Native American issues, could be particularly helpful in identifying the Native American Tribes to be contacted as well as identifying the most suitable locations in which to hold such hearings. With the information collected, the PTO could then attempt to craft a definition of “official insignia.”

(2) *Establishing and Maintaining a List of Official Insignia*

The AIPLA believes that no list should be formulated until there is a better understanding of what are believed to be official insignia and how they have been used.

Once the PTO has crafted an appropriate definition for symbols entitled to protection, the on-going responsibility for collecting official insignia for possible inclusion on any list should then rest with the Bureau of Indian Affairs. However, the final decision to include any insignia on any list, as well as the maintenance of any list, should rest with the PTO. Any list established should be published periodically in the *Federal Register*.

(3) *Impact of Changes in Current Law and Policy, (4) Impact of Prohibition on Federal Registration and New Uses of Official Insignia and (6) Timing in Changes in Protection*

With respect to requests (3), (4), and (6), AIPLA has several general comments that are related.

As previously indicated, without identification of what are considered official insignia, it is difficult to formulate a response to these inquiries. Therefore, there should be no changes in current law or policy until the dimensions of the problem are better understood.

Under current law, protection is accorded against the registration of marks that may disparage or falsely suggest a connection with national symbols, institutions, persons, and beliefs. 15 USC § 1052(a). Protection is also provided against registration of marks that consist of or comprise insignia of any foreign nation. 15 USC § 1052(b). In

addition, a limited number of national emblems receive special protection under Article 6 ter of the Paris Convention. In our view, the official insignia of a federally or State recognized Native American Tribe should not receive greater protection than that accorded national symbols under existing law and treaty obligations.

The AIPLA believes that the PTO should be involved only with the issue of *protecting* the official insignia of such recognized Native American Tribes against *registration* of marks that conflict with such insignia. The PTO should not be involved with *prohibitions on the use* of such insignia. To the extent that the Native American Tribes obtain statutory or common law trademark rights to their insignia, they are, of course, free to enforce any substantive rights through the courts. However, the PTO is not the appropriate forum, nor is it authorized, to determine the issues of use.

The AIPLA believes that the protection afforded to the official insignia of recognized Native American Tribes should be prospective and not retroactive. Because there may be a substantial number of existing users of identical or similar insignia, making any such protection retroactive could have a very adverse effect on existing property rights and could result in endless rounds of litigation over such rights. Retroactive application of such protection might also raise a constitutional question regarding a “taking” of property.

Finally, while existing registrations of such insignia should not be prejudiced by the establishment of a list (much like the case with the wine appellation marks), the PTO should strictly enforce Sec. 8 & 15 requirements and requirements for renewal of the registrations.

(5) *Administrative Feasibility*

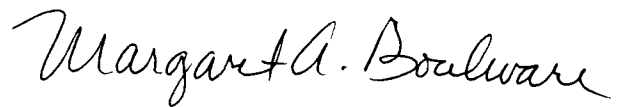
Should the creation of such a list prove feasible, reliance upon it by the PTO should not result in any significant additional costs. However, as explained above, the AIPLA believes that the Bureau of Indian Affairs should be responsible for collecting and presenting to the PTO federally or State recognized Native American Insignia for determination by the PTO as to whether such insignia should be included on any such list.

(7) *Statutory Changes*

The AIPLA believes it would be unwise to even consider specific statutory changes at this early stage of the PTO's study. Whether there should be any statutory changes, and, if so, whether they should be in the Lanham Act, in title 36 of the U.S. Code, or elsewhere, cannot be evaluated until more information is collected.

AIPLA appreciates the opportunity to provide comments regarding proposals for the protection of Native American Insignia, and looks forward to working with the PTO to address this issue.

Respectfully submitted,

A handwritten signature in cursive script that reads "Margaret A. Boulware".

Margaret A. Boulware
President