



International Trademark Association

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16 April 1999

Ms. Eleanor K. Meltzer
Attorney-Advisor
Office of Legislative and
International Affairs
U.S. Patent and Trademark Office
2121 Crystal Drive
Suite 902
Arlington, Virginia 22202

Dear Ms. Meltzer:

**Re: Docket No. 981214305-9052-02 – Granting Special Trademark Protection for
Official Insignia of Native American Tribes**

Please find enclosed comments prepared on behalf of the International Trademark Association (INTA) by our North America Regulatory Analysis Subcommittee in response to the U.S. Patent and Trademark Office notice in the Federal Register of March 16, 1999 on the above reference subject. The comments explain in detail why INTA is unequivocally opposed to any proposal to grant special trademark status for the symbols or designations of any particular group, including the official insignia of Native American tribes.

If you have any questions regarding INTA's comments, please contact Bruce MacPherson at INTA's New York Office.

Sincerely yours,

A handwritten signature in cursive script, reading "Alan C. Drewsen". The signature is fluid and stylized, with a long, sweeping underline.

Alan C. Drewsen
Executive Director

Enclosure



International Trademark Association

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SPECIAL TRADEMARK PROTECTION

FOR

OFFICIAL INSIGNIA OF

NATIVE AMERICAN TRIBES

North America Regulatory Analysis Subcommittee

**A. Justin Ourso III
Chairman**

**Keith Barritt
Project Leader**

16 April 1999

I. Introduction

The International Trademark Association (INTA) is a 121 year old worldwide organization representing over 3,700 corporations, law firms and professional associations in 120 countries. INTA is devoted to protecting the invaluable role that trademarks play in promoting fair and robust competition.

Section 302 of the Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, requires the U.S. Patent and Trademark Office ("PTO") to complete a study by September 30, 1999 regarding "the issues surrounding the protection of the official insignia" of federally and state-recognized Native American tribes.

In response to the U.S. Patent and Trademark Office (USPTO) request for comments (Docket No. 981214305-9052-02) on this issue, INTA, through its North America Regulatory Analysis Subcommittee, strongly opposes any proposal to grant special trademark status for the symbols or designations of any particular group, including the official insignia of Native American tribes. Indeed, pursuant to a resolution adopted May 8, 1991 by the U.S. Trademark Association (INTA's predecessor), INTA officially opposes in principle any "special interest" trademark legislation that provides specific groups exclusive rights without proof of likelihood of confusion. More recently, INTA has urged the repeal of Sections 9(1)(n)(ii) and (iii) of the Canadian Trade-marks Act that grant special trademark protection to universities and "public authorities," and has also expressed concerns regarding proposed protection for the words and symbols of New Zealand's indigenous people, the Maori.

Consistent with its principle against special interest legislation, INTA vigorously objects to a per se prohibition against registration or use of marks that are identical to the official insignia of Native American tribes. As discussed herein, such a prohibition would be inappropriate, unduly burdensome, and unnecessary for the following reasons:

- difficulty of defining "official tribal insignia" and establishing a mechanism to prevent potential abuse;
- difficulty of determining when marks are "identical" to official tribal insignia;
- potential prohibition against use of common geometric shapes that are "identical" to official tribal insignias;
- practical difficulties of comparing a design element in a mark to perhaps thousands of official tribal insignias;
- potential violation of U.S. treaty obligations under the Paris Convention;

- potential unfairness to mark owners who for years have used symbols, knowingly or not, that are identical to official tribal insignia;
- availability of relief under current Section 2(a) of the Lanham Act prohibiting registration of immoral, scandalous, or disparaging marks; and
- potential discrimination against other groups whose cultural or historical symbols are not similarly protected.

II Evaluating All The Issues Mandates Denying Any Special Trademark Protection To the Official Insignia Of Native American Tribes

As set forth in the USPTO's notice in the Federal Register of March 16, 1999, the agency has requested comments on the following issues:

- (1) how to define "official insignia" of Native American tribes.
- (2) how to establish and maintain a list of the official insignia of Native American tribes.
- (3-4) the impact on Native American tribes, trademark owners, the USPTO, any other interested party, or the international legal obligations of the U.S. of any change in law or policy with respect to:
 - (a) prohibiting federal registration of marks that are "identical" to the "official insignia" of Native American tribes;
 - (b) prohibiting any new use of the official insignia of Native American tribes; and
 - (c) appropriate defenses, including fair use, to any claims of infringement.
- (5) the administrative feasibility, including the cost, of changing the current law or policy to:
 - (a) prohibit the registration, or prohibit any new uses, of the official insignia of Native American tribes; or
 - (b) otherwise give additional protection to the official insignia of Native American tribes.
- (6) whether such protection should be offered prospectively only or retrospectively and the impact of such protection.
- (7) any statutory changes that would be necessary to provide such protection.

(8) any other relevant factors.

For the reasons stated in detail below, virtually every one of these factors strongly argues against adopting any special protections for Native American tribal insignia, and the INTA urges that no such protection be adopted.

1. Defining "Official Insignia" Of Native American Tribes

Requesting each eligible tribe to submit a list of its "official insignia" would be a relatively easy matter. Controlling abuse of this opportunity may not be.

INTA is not implying that any particular tribe would attempt to establish rights in designs or symbols that were not its legitimate "official insignia." Nonetheless, any system that was adopted to permit protection for such insignia would require checks to prevent protection from being granted to designs or symbols that were not "official insignia," but instead were simply adaptations of design elements of marks already in use. Perhaps one means for accomplishing this would be to require the U.S. Bureau of Indian Affairs ("BIA") to determine what insignia is "official" and possibly limit each tribe to only one "official insignia," rather than allowing each tribe to declare without limitation what constitutes its "official insignia." However, whether the BIA -- or any agency -- is equipped to determine whether a tribe's submission is truly its "official insignia" or could handle the volume of potential submissions is an open question.

2. Establishing And Maintaining A List Of The Official Insignia Of Native American Tribes

INTA is not aware of any special difficulties the USPTO would face in establishing and maintaining a list of official insignia. Indeed, such a list could be patterned after the USPTO's treatment of designations under Article 6^{ter} of the Paris Convention providing protection for flags and other State emblems of member countries of the Convention (see Trademark Manual of Examining Procedure, Section 1205.02). A greater problem, as described above, is how to define what should be placed on the list as "official insignia."

3-4. The Impact Of Prohibiting Registration Or New Use Of Marks Identical To The Official Insignia Of Native American Tribes, And Appropriate Defenses To Infringement Claims

a. Introduction

For trademark owners, the most immediate impact of a prohibition against registration or new use of marks identical to the official insignia of Native American tribes would be a need to determine if a mark was "identical" to any such insignia. The burden of checking the list of "official

insignia" would be faced with the adoption of each and every mark, since, unlike with regular marks being compared for likelihood of confusion purposes, there would be no way to narrow the focus on insignia associated with a particular class of goods or services. Moreover, most if not all official insignia would presumably incorporate or be entirely composed of a design element, which are inherently more difficult to compare for trademark purposes than word marks. Conflicts would inevitably arise as to whether a mark that was arguably similar to an official insignia but perhaps drawn in different proportions or was otherwise similar but not quite identical was sufficiently "identical" so as to preclude registration or use.

Furthermore, if the official insignia of a tribe is in fact a common geometric shape or combination of such shapes, granting exclusive protection for trademark purposes risks denying the availability of such a shape for unrelated commercial purposes where no likelihood of confusion exists. Even if no federal registration for such a geometric shape were sought, any proposed statutory changes would likely attempt to prohibit its very "use."

The problems faced by trademark owners would be compounded by the sheer number of federally and state-recognized tribes. According to the U.S. Bureau of Indian Affairs, there are currently over 550 federally recognized tribes, and an untold number of state-recognized tribes. Thus, even with a limit on the number of official insignia each tribe could claim, there still may be thousands of symbols that would suddenly be cut off from consideration for use as a mark if such protections were granted.

b. Impact On U.S. International Obligations

Under Section B of Article *6quinquies* of the Paris Convention, marks registered in one member state of the Convention may not be denied registration in another member state unless the mark (1) infringes rights of third parties in the country where protection is claimed, (2) is devoid of any distinctive character (i.e., is merely descriptive or generic), or (3) is "contrary to morality or public order and, in particular, of such a nature as to deceive the public."

Section B(1) implies, but does not specifically require, that the infringed "rights" of third parties must be trademark rights, rather than rights acquired by virtue of legislative fiat. Thus, it is possible a foreign applicant might challenge a rejection by the USPTO of a mark that was identical to official tribal insignia by arguing that the mark does not violate the type of rights the Paris Convention seeks to protect.

Section B(3) allows rejection of a mark that is "contrary to morality or public order." Rejection of a foreign applicant's mark that was identical to the official insignia of one of the hundreds of Native American tribes might be justified on this basis. However, it is possible a foreign applicant would challenge such a rejection, particularly if the mark itself has no particular moral meaning to the tribe itself or its use does not "deceive the public."

c. Appropriate Defenses To Infringement Claims

If special protection were to be granted to the "official insignia" of eligible tribes, INTA believes that it should be a defense if use is made without otherwise creating a connection between the mark owner and the tribe. This would permit use even if the mark owner was aware of the origins of the mark as a tribal insignia, provided the mark owner did nothing to create a likelihood of confusion over the source, affiliation, or sponsorship of his goods and services.

This standard would still grant Native American tribes protection beyond what is available under Section 2(d) of the Lanham Act, since it would not require the tribe itself to use its official insignia as a mark before relief could be granted. At the same time, a mark owner would be free to adopt a design element in its mark without fear that a tribe would later be able to cancel a registration or block use of the mark based on the claim that -- perhaps by coincidence -- the mark was identical to the tribe's official insignia, provided that the mark owner did not otherwise create a likelihood of confusion as to the source of the goods and services.

5. The Administrative Feasibility Of Prohibiting Registration Or New Use Or Otherwise Giving Additional Protection To The Official Insignia Of Native American Tribes

Even if a suitable listing of official insignia could be maintained, it would be a difficult task for the USPTO or trademark owners in general to determine how much variation would be allowed between a mark and an official insignia before the two are considered "identical." As noted above, determining whether a mark with slight variations from official insignia is "identical" to that insignia would inevitably create controversy. INTA proposes that if any protections were adopted that they be construed narrowly in order to make administrative enforcement as consistent as possible and to provide the greatest amount of certainty for mark owners.

6. Impact Of Prospective And Retrospective Protection For Official Insignia Of Native American Tribes

In New Mexico, the issue of the protection of the sun symbol of the Zia Pueblo tribe has generated significant controversy. In January, 1999, House Bill 107 was introduced in the state legislature to appropriate \$74,000,000 to "compensat[e] the pueblo of Zia for the unauthorized use of the Zia sun symbol as the state symbol for seventy-five years." Raising the protected status of Native American tribes' official insignia such as the Zia sun symbol will clearly put pressure on the government of New Mexico and others in similar situations to pay for the right to continue such use. Thus, granting tribes exclusive rights in their "official insignia" will have a direct and immediate financial impact, particularly if protection were granted retrospectively to give tribes rights as against existing uses. Indeed, it should be considered whether any such retrospective application of exclusive rights by a tribe might even raise a constitutional "takings" issue.

7. Statutory Changes Necessary To Provide Protection For Official Insignia Of Native American Tribes

Article 6^{ter} of the Paris Convention provides that member states shall prohibit the registration and unauthorized use of "armorial bearings, flags, and other State emblems of the countries of the Union, official signs and hallmarks indicating control and warranty adopted by them, and any imitation from a heraldic point of view." This requirement is contained in Section 2(b) of the Lanham Act, which currently prohibits registration of any mark that "[c]onsists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof." Under U.S. law, Native American tribes are not "foreign nations," and are not generally considered equivalent to "States," and thus are evidently not eligible for protection under Section 2(b) as currently worded.

8. Other Relevant Factors

a. Registration Of "Immoral," "Scandalous," Or "Disparaging" Marks Is Already Prohibited

Section 2(a) of the Lanham Act prohibits registration of a mark that consists of or comprises "immoral . . . or scandalous matter, or matter which may disparage or falsely suggest a connection with . . . institutions, beliefs, or national symbols, or bring them into contempt, or disrepute." Thus, the existing standards of Section 2(a) of the Lanham Act may provide an avenue of protection for the official insignia of Native American tribes.

Indeed, in a very recent case, the Trademark Trial and Appeal Board ordered the cancellation of the registrations for REDSKINS for one of the National Football League's professional football teams, finding that the mark disparages Native Americans. Harjo v. Pro-Football, Inc., TTAB, Canc. No. 21069, April 2, 1999. Although the mark at issue in that case may be more facially offensive than design elements in a tribe's official insignia, the REDSKINS case nonetheless establishes that Native Americans and other minority groups do have recourse within the existing structure of the Lanham Act to cancel registrations for disparaging marks.

In addition, many other cases decided under Section 2(a) and its predecessor statute have refused registration of marks on religious grounds. These cases might form another basis for refusing registration of marks consisting of the official insignia of Native American tribes under 2(a), which may often include matter that has religious significance. Such potential precedent for rejecting applications of Native American tribal insignia include:

1. MADONNA for wines (In re Riverbank Canning Co., 95 F.2d 327, 37 USPQ 268 (CCPA 1938), aff'g 30 USPQ 374 (Com'r 1936); see also In re P.J. Valckenberg, GmbH, 12 USPQ 334 (TTAB 1959) (same result));

2. AGNUS DEI (Latin for "Lamb of God") for metallic tabernacle safes (Ex Parte Summit Brass & Bronze Works, inc., 59 USPQ 22 (Com'r 1943));
3. SENUSSI (the name of a Moslem sect that prohibited the use of tobacco) for cigarettes (In re Reemtsma Cigarettenfabriken GmbH, 122 USPQ 339 (TTAB 1959)); and
4. MESSIAS for wine and brandy (In re Sociedade Agricola E. Comercial Dos Vinhos Messias, S.A.R.L., 159 USPQ 275 (TTAB 1968)).

In sum, it is not necessary to add another level of special protection for the official insignia of Native American tribes, as the existing framework of the Lanham Act already provides more than adequate opportunities to challenge marks that should not be registered.

b. Granting Protection For Official Insignia Of Native American Tribes Risks Opening The Floodgates For Similar Protection For Other Words Or Symbols

If special protection were granted to the official insignia of Native American tribes, one would have to question why such protection should stop there. If design elements are worthy of special protection, why not the names of the tribes themselves? Should the law prevent the use of CHEROKEE for four-wheel drive vehicles, MOHAWK for pretzels, or APACHE for binoculars? Scores of such marks that incorporate various names of Native American tribes are currently registered, some of which may well also include design elements identical or similar to what might become a tribe's "official insignia." For example, there are currently 38 registrations for marks incorporating the term MOHAWK, 37 APACHE marks, 35 SIOUX marks, 30 CHEROKEE marks, and 10 COMANCHE marks.

Moreover, if the "official insignia" of Native American tribes were to be protected, should the special cultural or historical symbols of other groups also be entitled to protection? Would failure to grant such groups the same sort of protections given to Native American tribes be a form of discrimination? In short, unless use of a mark is likely to cause confusion as to source, sponsorship, or affiliation, or is immoral, scandalous, or disparaging -- standards which may already afford Native American tribes ample ammunition to defend their rights -- INTA believes that allowing any group to block use of a design or symbol as a mark simply because the mark may have strong cultural or historical significance to that group would be a dangerous precedent.

III. Conclusion

Granting protection for the official insignia of all federally and state-recognized Native American tribes would inflict serious harm on trademark owners. Determining when a mark is "identical" to perhaps thousands of official insignia would itself be a difficult task, as would establishing a procedure to determine what qualifies as the "official insignia" of a tribe. If any protection were granted retrospectively, the unfairness to mark owners would be enormous, perhaps even raising

a constitutional "takings" issue. Furthermore, tribes may already be able to block the registration of marks that are "immoral, scandalous, or disparaging," thereby bringing into question the need for any change to existing law. For all these reasons, INTA urges that no special protections be given to the official insignia of federally and state-recognized Native American tribes.