

## EXECUTIVE SUMMARY

Title III of Public Law 105-330 requires the U.S. Patent and Trademark Office (PTO) to study how the official insignia of Native American Tribes may be better protected under trademark law.

Two facts emerged from the seven-month long study. First, few commentators appeared to fully appreciate the scope of protection and law enforcement already available with respect to misrepresentation of Indian produced goods. Second, the comments received to this study made manifest both the need for better use of existing prohibitions and for education about the options available to Native American tribes to enforce their intellectual property rights and protect their cultural heritage.

Based on the comments received, the following recommendations are made:

1. An accurate and comprehensive database containing the official insignia of all State and federally recognized Native American tribes should be created.
2. The U.S. Patent and Trademark Office (PTO) should create, maintain and update this database.
3. Relevant federal agencies should work cooperatively to educate and assist Native American tribes in their efforts to protect their official insignia.
4. Relevant federal agencies should work cooperatively to educate the public at large with respect to the rights surrounding official insignia of Native American tribes.

## Official Insignia of Native American Tribes; Statutorily Required Study

AGENCY: Patent and Trademark Office, Commerce.

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### **BACKGROUND:**

On October 30, 1998, President Clinton signed Public Law 105-330. Title III of this law required the PTO to study how the official insignia of Native American Tribes may be better protected under trademark law. The new law mandated that the Commissioner of Patents and Trademarks complete the study and submit a report to the chairman of the Committee on the Judiciary of the Senate and the chairman of the Committee on the Judiciary of the House of Representatives, not later than September 30, 1999.

The final study must address a variety of issues, including:

- the definition of “official insignia” of a federally and/or State recognized Native American Tribe;
- the impact of any changes on the international legal obligations of the United States; and
- the administrative feasibility, including the cost, of changing current law or policy in light of any recommendations.

The PTO published two Federal Register notices requesting comments on a variety of issues.

The first notice was published on December 29, 1998, (63 FR 71619-71620), and requested

comments on how best to conduct the study, where public hearings should be held, and who should be consulted during the study process. The second notice, published on March 16, 1999 (64 FR 13004-13005), requested the public's views on all aspects of trademark protection for the official insignia of Native American tribes. Thirty-three different groups submitted written comments, some responding to both the December 29, 1998, and March 16, 1999 notices.

In response to comments received, public hearings were announced in the Federal Register (64 FR 29841 June 3, 1999, and 64 FR 32037 June 15, 1999). The hearings were conducted in three locations in the United States: Albuquerque, New Mexico (July 8, 1999); San Francisco, California (July 12, 1999); and Arlington, Virginia (July 15, 1999). A total of thirty-six groups and individuals provided oral testimony (20 in Albuquerque, 3 in San Francisco, and 13 in Arlington).

The Federal Register notices related to this study, the transcripts of the three public hearings, and all written comments received prior to July 15, 1999, were posted for public viewing on the PTO's website at: [www.uspto.gov](http://www.uspto.gov).

The following is a summary of the groups and individuals who submitted information for consideration by the PTO.

<b>Comments Received From:</b>	<b>To 12/29/98 Fed Reg.</b>	<b>To 3/16/99 Fed Reg.</b>	<b>Oral Testimony</b>
All Indian Pueblo Council		X	7/8/99
American Indian CC			7/8/99
American Intellectual Property Law Association (AIPLA)	X	X	7/8/99
A.T. Lang		X	
Brenna Rollock		X	
Bristol Bay Native Association		X	
Bruce E. Burdick		X	
Eric Brunner		X	
Calvert Group			7/15/99
Cheyenne-Arapaho Business Comm.			7/8/99
The Chicasaw Nation			7/15/99
Council of Energy Resource Tribes (Muskogee Creek of Oklahoma)			7/8/99
Cow Creek Band of Umpqua Tribe Of Indians of Oregon	X		
Daimler Chrysler		X	
Professor Ellen J. Staurowsky		X	7/15/99
Fern Mathias, Dakota (South Dakota)			7/12/99
Five Sandoval Pueblos; Petroglyphs Advisory Committee			7/8/99
Interfaith Center for Corporate Responsibility			7/15/99

<b>Comments Received From:</b>	<b>To 12/29/98 Fed Reg.</b>	<b>To 3/16/99 Fed Reg.</b>	<b>Oral Testimony</b>
<b>International Trademark Association (INTA)</b>	<b>X</b>	<b>X</b>	<b>7/15/99</b>
<b>InterTribal Bison Cooperative</b>	<b>X</b>		
<b>The Honorable Jeff Bingaman, Senator - - New Mexico</b>			<b>7/8/99</b>
<b>Jerald G. Vigil</b>	<b>X</b>		
<b>Mr. Loren Panteah, Zuni Jeweler</b>			<b>7/8/99</b>
<b>Miccosukee Tribe of Indians Of Florida</b>	<b>X</b>		
<b>“MJR” - - Cherokee</b>	<b>X</b>		
<b>Mohawk Carpet Corporation</b>	<b>X</b>	<b>X</b>	<b>7/15/99</b>
<b>Nambe Pueblo</b>			<b>7/8/99</b>
<b>Nancy Edwards, Ojiba (North Michigan)</b>			<b>7/12/99</b>
<b>National Coalition on Racism in Sports And Media</b>	<b>X</b>		<b>7/15/99</b>
<b>Native Affairs &amp; Development Group [Representing Chickasaw, Pueblo of Picuris, and Pueblo of San Juan]</b>	<b>X</b>	<b>X</b>	
<b>New Mexico Book Association</b>			<b>7/8/99</b>
<b>Northern Cherokee Nation of Missouri and Arkansas</b>	<b>X</b>		
<b>Oneida Indian Nation</b>	<b>X</b>		
<b>Oneida Ltd.</b>	<b>X</b>	<b>X</b>	
<b>Paula Walters</b>	<b>X</b>		
<b>Phil Konstantin</b>	<b>X</b>		

<b>Comments Received From:</b>	<b>To 12/29/98 Fed Reg.</b>	<b>To 3/16/99 Fed Reg.</b>	<b>Oral Testimony</b>
<b>Prairie Band Potawatomi Nation 7/15/99</b>			
<b>Pueblo of Pojoaque</b>		<b>X</b>	
<b>Pueblo of Sandia</b>		<b>X</b>	
<b>Pueblo of Zia</b>	<b>X</b>	<b>X</b>	<b>7/8/99</b>
<b>Pueblo of Zuni</b>		<b>X</b>	<b>7/8/99</b>
<b>S. Joshua Volle</b>	<b>X</b>		
<b>Seaconke Wampanaog Indian Tribe</b>		<b>X</b>	
<b>Shakopee Mdewakanton Sioux Community</b>		<b>X</b>	
<b>Stockbridge-Munsee Community, Band of the Mohican Indians</b>		<b>X</b>	
<b>Thomas Drescher</b>	<b>X</b>		
<b>The Honorable Tom Udall, Congressman - - New Mexico</b>			<b>7/8/99</b>
<b>Tuolumne Band of Me-Wuk Indians [Native American Rights Fund]</b>	<b>X</b>	<b>X</b>	<b>7/12/99 7/15/99</b>
<b>The University of Illinois</b>			<b>7/15/99</b>
<b>University of New Mexico</b>			<b>7/8/99</b>
<b>W.C. Ballard</b>	<b>X</b>		
<b>William Lockard, Esq. 7/15/99</b>			
<b>“A WWII Veteran”</b>		<b>X</b>	

**SCOPE OF THIS STUDY:**

As noted above, the Commissioner of Patents and Trademarks was instructed to study the issues surrounding the protection of the official insignia of federally and State recognized Native American tribes. In particular, the Commissioner was instructed to study at least the following issues:

1. The impact on Native American tribes, trademark owners, the Patent and Trademark Office, any other interested party, or the international legal obligations of the United States, of any change in law or policy with respect to - -

the prohibition of the Federal registration of trademarks<sup>1</sup> identical to the official insignia of Native American Tribes;

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<sup>1</sup> Throughout this report, the term “trademark” is used to mean both “trademarks” (i.e., marks used to identify goods) and “service marks” (i.e., marks used to identify services.) The Trademark Act defines “trademark” as follows:

The term “trademark” includes any word, name, symbol, or device, or any combination thereof--

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

15 U.S.C. §1127.

The Trademark Act defines “service mark” as follows:

The term “service mark” means any word, name, symbol, or device, or any combination thereof--

- (3) used by a person, or
- (4) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act,

to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown.

- (A) the prohibition of any new use of the official insignia of Native American tribes;  
and
  - (B) appropriate defenses, including fair use, to any claims of infringement.
2. The means for establishing and maintaining a listing of the official insignia of federally or State recognized Native American tribes.
3. An acceptable definition of the term “official insignia” with respect to a federally or State recognized Native American tribe.
4. 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 State or federally recognized Native American tribes; or
  - (B) otherwise give additional protection to the official insignia of federally and State recognized Native American tribes.

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Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

15 U.S.C. §1127.

Section 3 of the Trademark Act, 15 U.S.C. §1053, states that, so far as the provisions regarding trademarks are applicable, service marks shall be registrable in the same manner and with the same effect as are trademarks.

5. A determination of whether such protection should be offered prospectively or retrospectively and the impact of such protection.
6. Any statutory changes that would be necessary in order to provide such protection.
7. Any other factors which may be relevant.

#### **REQUESTS FOR PUBLIC COMMENT:**

The PTO requested the public's views concerning all aspects of trademark protection for the official insignia of Native American Tribes, including the following.

(1) The Definition of “Official Insignia”

For example, how should the PTO define “official insignia” of a federally or State recognized Native American Tribe?

(2) Establishing and Maintaining a List of Official Insignia

For example, how might the PTO establish a list of the official insignia of federally and/or State recognized Native American Tribes? How might the PTO maintain such a list?

(3) Impact of Changes In Current Law or Policy

For example, how might any change in law or policy with respect to prohibiting the Federal registration of trademarks identical to the official insignia of Native American Tribes, or of prohibiting any new use of the official insignia of Native American Tribes, affect Native American Tribes? How might such changes affect trademark owners? How might such changes affect the Patent and Trademark Office? How would such changes affect any other interested party? What impact might any such changes have on the international legal obligations of the United States?

(4) Impact of Prohibition on Federal Registration and New Uses of Official Insignia

For example, how might prohibiting Federal registration of trademarks identical to the official insignia of Native American Tribes affect any/all of the above-mentioned entities? How might prohibiting any new use of the official insignia of Native American Tribes affect any/all of the above-mentioned entities? What effect might such prohibitions have on the international legal obligations of the United States? What defenses, including fair use, might be raised against any claims of infringement?

(5) Administrative Feasibility

For example, what might be the administrative feasibility, including the cost, of changing the current law or policy to prohibit the registration? What might be the administrative feasibility, including the cost, of prohibiting any new uses of the official insignia of State

or federally recognized Native American Tribes? What might be the administrative feasibility, including the cost, of otherwise providing additional protection to the official insignia of federally and State recognized Native American Tribes?

(6) Timing of Changes in Protection

For example, should changes in the scope of protection for official tribal insignia be offered prospectively? Retrospectively? What might be the impact of such protection (e.g., the cost to business and the public if applied retroactively)?

(7) Statutory Changes

What statutory changes might be necessary in order to provide such protection?

(8) Other Relevant Factors

What other factors, not mentioned above, might be relevant to this issue?

## **WHAT THIS STUDY ADDRESSES**

This study, as mandated by Congress, addresses the trademark implications regarding official insignia of Native American tribes.

## **WHAT THE STUDY DOES NOT COVER:**

The Commissioner was charged with studying the issues surrounding the protection of the official insignia of federally and State recognized Native American tribes. To best fulfill this mandate, all responses received in connection with the Federal Register notices and public hearings have been reviewed and considered. However, several respondents raised problems outside the scope of this study. Specifically, issues regarding the propriety of wearing “war bonnets,” garments, headdresses, jewelry, and craft items associated with Native American tribes; of writing inaccurate or disparaging comments about Native Americans; and of making oral comments that denigrate Native Americans, have all been raised in the written and oral responses received in connection with this study. Many respondents point to legitimate social ills having real consequences for the welfare of Native Americans.

The language of P.L. 105-330 directs the Commissioner to study trademark issues and particularly requires the Commissioner to identify issues surrounding protection of official insignia. Therefore, this study will not analyze or make recommendations with respect to the above-mentioned issues which go beyond the scope of “official insignia,” even if those issues involve trademarks.

An instructive example of the limited scope of this study is the recent decision in *Suzan Shown Harjo, et al v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999), currently on appeal in a civil action to the U.S. District Court for the District of Columbia. Coincidentally, the Trademark Trial and Appeal Board (Board) of the PTO issued its final decision during the pendency of this study. The Board held that the term “redskins” was disparaging to Native Americans, and was

disparaging at the time applications for registration of the term “Redskins” were submitted to the PTO. Therefore, registration of various trademarks containing the term “redskins” was held to be in violation of Section 2(a) of the Trademark Act, 15 U.S.C.

§ 1052(a), and the marks were ordered canceled.

Even though the “*Harjo*” decision involves both trademarks and a reference to Native Americans, it is outside the issues under review in this study. The term “redskins” is not the name of a Native American tribe. Neither the term “redskins” nor the logos associated with the term are emblems associated with or claimed by any Native American tribe. The issues in the “*Harjo*” decision fall in the category of “other social ills” which may have trademark implications, but do not involve “official insignia of Native American tribes.”

## **PTO’S CURRENT ACTIVITIES WITH RESPECT TO TRADEMARKS AND NATIVE AMERICAN TRIBES**

At the public hearings, the PTO provided the following information regarding its current activities with respect to trademarks and Native American tribes.

### The PTO Is Not A Law Enforcement Agency

The PTO is not a law-enforcement agency like the FBI or U.S. Customs. It is specifically charged with examining and registering trademarks, as well as examining and issuing patents. The PTO does not police the use of trademarks in commerce. The Trademark Act of 1946, as amended, 15 U.S.C. § 1052 *et seq*, explicitly prohibits registration of marks which “may

disparage or falsely suggest a connection” between the applicant and another person, institution, belief, or national symbol. 15 U.S.C. § 1052(a).

#### The PTO Takes An Active Role In Protecting Native Americans

In 1994, the PTO undertook to contact every federally registered Native American tribe, in order to compile a list of “official insignia” so that the Office might better uphold the letter and spirit of the Trademark Act. This action is believed to be unique. The Office sent out letters to more than 500 federally recognized tribes. Approximately 10 responses were received.

Despite the low response rate, the PTO has taken steps to ensure that third parties do not register trademarks that give a false impression of the true origin of the goods or services. Since 1994, all trademark applications containing tribal names, recognizable likenesses of Native Americans, symbols perceived as being Native American in origin, and any other application which the PTO believes suggests an association with Native Americans, are examined by one attorney who has developed expertise and familiarity in this area. The PTO refuses many applications incorporating the names or symbols of Native American tribes. (See, for example, Application Serial No. 75-265350, [“ZIA SYSTEMS” with Zia Sun Symbol design, for “stationery, computer software products and packaging, and advertising,” refused on the basis of likely false association with the Pueblo of Zia]; Application Serial No. 75-447770, [“ZIA” with Zia Sun Symbol design, for “cocktail mixes,” refused on the basis of likely false association with the Pueblo of Zia and possible disparagement of the tribe]).

In addition to its practice of careful examination of applications by its trademark examining attorneys, the PTO has additional systems in place to safeguard against parties obtaining trademark rights to which they are not entitled. The “Letter of Protest” procedure as well as opposition and cancellation proceedings provide third parties the opportunity to challenge PTO actions in trademark cases.

#### **ANALYSIS OF COMMENTS:**

- 1. Identifying an acceptable definition of the term “official insignia” with respect to a federally or State recognized Native American tribe.*

The first question that arises in attempting to study the trademark implications surrounding the “official insignia of Native American tribes” is “What is an ‘official insignia’ of a Native American tribe?”

Many respondents did not address this core issue, except to say that the PTO must somehow define “official insignia.” The essence of all comments received was that the PTO bears the responsibility of defining “official insignia,” although several respondents indicated that help from the Bureau of Indian Affairs (BIA) or the Indian Arts and Crafts Board (IACB) would be acceptable.

Almost all respondents indicated that Native American tribes themselves must designate the actual “official insignia.” In other words, it would be unacceptable for the U.S. Government to attempt to impose a determination of specific “official insignia” for each tribe. No respondents

suggested that the U.S. Government attempt to dictate what must comprise the specific elements of each tribe's "official insignia."

For those respondents who indicated a mechanism by which Native American tribes could identify "official insignia," there was unanimity in recommending that tribal resolutions, which are an accepted tribal-government decision-making mechanism, be accepted. Therefore, according to those who expressed an opinion on this issue, a tribal resolution adopting an "official insignia" should be accepted as bona fide.

More specifically, many respondents indicated that "official insignia" should include words alone, particularly tribal names (e.g., "Cheyenne" or "Lakota"), as well as: (1) words in combinations with figurative elements; (2) phrases; and (3) designs used without words. Another significant group of respondents indicated that "official insignia" should be limited to words (tribal names or other words) in combination with figurative elements. One respondent suggested looking at a dictionary definition of the term "insignia." Several respondents suggested identifying the term "official insignia" in the same manner as hallmarks, emblems, and other official insignia of States and municipalities are defined for purposes of Section 2(b), 15 U.S.C. § 1052(b), of the Trademark Act.

### **How the PTO Currently Defines and Examines "Insignia" - -**

#### **Section 2(b) of the Trademark Act**

Section 2 of the Trademark Act, 15 U.S.C. § 1052, states that

No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it ... (b) Consists 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.

Native American tribes are not foreign nations, States or municipalities. Rather, Indian tribes have a unique status as domestic dependent nations under the protection of the United States. E.O. 13084; 25 U.S.C. Section 71. The PTO does not make refusals under Section 2(b) with respect to “official insignia” of Native American tribes. However, discussion of Section 2(b) is relevant to this study because it was raised by several participants as the appropriate means for protecting the “official insignia” of Native American tribes.

Section 2(b) of the Trademark Act, 15 U.S.C. § 1052(b), bars the registration of marks which consist of or comprise (whether consisting solely of, or having incorporated in them) the flag, coat of arms, or other insignia of the United States, of any State or municipality, or of any foreign nation. Section 2(b) also bars the registration of marks that consist of or comprise any simulation of such symbols.

This section is an absolute bar to the registration of such marks on the Principal Register, Title I, 15 U.S.C. § 1051, or the Supplemental Register, Title II, 15 U.S.C. § 1091(a). Section 2(b) differs from the provision of § 2(a), 15 U.S.C. § 1051(a), regarding national symbols, in that § 2(b) requires no additional element, such as “disparagement” or a “false suggestion of a connection,” to preclude registration.

Flags and coats of arms are specific designs formally adopted to serve as emblems of governmental authority. The wording "other insignia" is not interpreted broadly, but is considered to include only those emblems and devices which also represent governmental authority and which are of the same general class and character as flags and coats of arms.

The Board has construed the statutory language as follows:

[T]he wording "or other insignia of the United States" must be restricted in its application to insignia of the same general class as "the flag or coats of arms" of the United States. Since both the flag and coat of arms are emblems of national authority it seems evident that other insignia of national authority such as the Great Seal of the United States, the Presidential Seal, and seals of Government departments would be equally prohibited registration under Section 2(b). On the other hand, it appears equally evident that department insignia which are merely used to identify a service or facility of the Government are not insignia of national

authority and that they therefore do not fall within the general prohibitions of this section of the Statute.

*In re United States Department of the Interior*, 142 USPQ 506, 507 (TTAB 1964) (logo comprising the words "NATIONAL PARK SERVICE" and "Department of the Interior," with depiction of trees, mountains and a buffalo, surrounded by an arrowhead design **held not to be** an insignia of the United States).

Letters which merely identify people and things associated with a particular agency or Department of the United States Government, instead of representing the authority of the Government or the Nation as a whole have, generally speaking, also been excluded from protection as "insignia of the United States" as contemplated by § 2(b). The Board, in dismissing an opposition to the registration of "USMC" in a stylized presentation, for prostheses, fracture braces and orthopedic components, discussed what is meant by "insignia" under § 2(b), as follows:

The letters "USMC" are nothing like a flag or coat of arms.

These types of insignia are pictorial in nature, they can be described, but cannot be pronounced. Even if the letters could be construed to be an insignia, opposer has not shown that they would be seen as an insignia of the United States.

*U.S. Navy v. United States Mfg. Co.*, 2 USPQ2d 1254, 1256 (TTAB 1987).<sup>3</sup>

See also *Liberty Mutual Insurance Co. v. Liberty Insurance Co. of Texas*, 185 F. Supp. 895, 908, 127 USPQ 312, 323 (E.D. Ark. 1960) ("That the Statue of Liberty is not a part of the 'insignia of the United States' is too clear to require discussion.")

***“Insignia” Under Section 2(b)***

***As applied in the case law, the term “insignia” is restricted to flags, coats of arms, or designs (which may include words) formally adopted to serve as emblems of governmental authority, and to those emblems and devices which also represent governmental authority (even if not formally adopted) and which are of the same general class and character as flags and coats of arms.***

As stated above, marks which consist of or comprise any simulation of the flag, coat of arms, or other insignia of the United States, of any State or municipality, or of any foreign nation are also unregistrable under § 2(b). "Simulation," as contemplated by § 2(b), refers to "something that gives the appearance or effect or has the characteristics of an original item." Whether a mark comprises such a simulation must be gathered from a visual comparison of the mark vis-à-vis

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<sup>33</sup> As a result of the enactment of Public Law 98-525 on October 19, 1984, the initials, seal and emblem of the United States Marine Corps are "deemed to be insignia of the United States," under 10 U.S.C. §7881, pertaining to unauthorized use of Marine Corps insignia. However, "USMC" was not so protected when the applicant began using its stylized version of those letters as a mark. In view of the provision in Public Law 98-525 that the amendments adding Chapter 663 (10 U.S.C. § 7881) shall not affect rights that vested before the date of its enactment, the majority of the Board found that enactment of the law did not adversely affect the mark's registrability, stating that "opposer has not shown that applicant's mark was an insignia of the United States prior to the law making it one, or that the law effectively bars registration to applicant." *Id.* at 1260.

replicas of the flag, coat of arms or other insignia in question. *In re Waltham Watch Co.*, 179 USPQ 59, 60 (TTAB 1973) (mark consisting of wording and the design of a globe and six flags, for watches, found registrable, the Board stating, "[A]lthough the flags depicted in applicant's mark incorporate common elements of flag designs such as horizontal or vertical lines, crosses or stars, they are readily distinguishable from any of the flags of the nations alluded to by the examiner. In fact, applicant's mark would be regarded as nothing more than a conglomeration of nondescript flags utilized to symbolize the significance of the globe design and the slogan 'TIMING THE WORLD' appearing thereon.").

The incorporation in a mark of individual or distorted features, which are merely suggestive of flags, coats of arms or other insignia, does not bar registration under § 2(b). See *Knorr-Nahrungsmittel A.G. v. Havland International, Inc.*, 206 USPQ 827, 833 (TTAB 1980) (While applicant originally may have intended to include the flags of the Scandinavian countries in the mark, NOR-KING and design, "[a]ll that the record reflects is that the mark contains a representation of certain flags, but not the flag or flags of any particular nation." Opposer's cause of action under § 2(b) deemed to be without merit; opposition sustained on other grounds); *In re National Van Lines, Inc.*, 123 USPQ 510 (TTAB 1959) (mark comprising words and the design of a shield with vertical stripes held registrable, the Board finding the design to be readily distinguishable from the shield of the Great Seal of the United States and, thus, not a simulation of the seal or any portion thereof); *In re American Box Board Co.*, 123 USPQ 508 (TTAB 1959) (design mark comprising an eagle and shield held registrable, the Board finding that it did not involve a simulation of the Great Seal of the United States because the eagle and shield of

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applicant's mark differed substantially from those on the seal in both appearance and manner of display).

In addition to Section 1052(b), several Federal statutes and regulations prohibit or restrict the use of certain words, names, symbols, terms, initials, marks, emblems, seals, insignia, badges, decorations, medals, and characters adopted by the United States Government or particular national and international organizations. These designations are reserved for the specific purposes prescribed in the relevant statute and must be free for use in the prescribed manner.

For example, Congress has created about 70 statutes through which exclusive rights to use certain designations are granted to federally created private corporations and organizations. Some of the statutes include criminal penalties, e.g., 18 U.S.C. §§ 705 (regarding badges, medals, emblems or other insignia of veterans' organizations); 706 (Red Cross); 707 (4-H Club); 708 (coat of arms of the Swiss Confederation); 711 ("Smokey Bear"); and 711a ("Woodsy Owl" and slogan, "Give a Hoot, Don't Pollute") Other statutes provide for civil enforcement, e.g., 36 U.S.C. §§ 18c (Daughters of the American Revolution); 27 (Boy Scouts); 36 (Girl Scouts); 1086 (Little League); and 3305 (The American National Theater and Academy).

The following are examples of the protection of words and symbols by statute.

1. Use of the Greek red cross other than by the American National Red Cross is proscribed by statute. 18 U.S.C. § 706. Use of the coat of arms of the Swiss Confederation for trade or commercial purposes is proscribed by statute. 18

U.S.C. § 708. See *In re Health Maintenance Organizations, Inc.*, 188 USPQ 473 (TTAB 1975) (mark comprising a dark cross with legs of equal length on which a caduceus is symmetrically imposed (representation of caduceus disclaimed) held registrable, the Board finding the mark readily distinguishable from the Greek red cross (on white background) and the Swiss confederation coat of arms (white cross on red background)).

2. False advertising or misuse of names to indicate a Federal agency is proscribed by 18 U.S.C. § 709. For example, this provision prohibits knowingly using, without written permission of the Director of the Federal Bureau of Investigation, of the words "Federal Bureau of Investigation," the initials "F.B.I." or any colorable imitation, in various formats "in a manner reasonably calculated to convey the impression that such advertisement, ... publication, ... broadcast, telecast, or other production, is approved, endorsed, or authorized by the Federal Bureau of Investigation." Thus, an examining attorney must refuse to register such matter, pursuant to 18 U.S.C. § 709, if its use is reasonably calculated to convey an approval, endorsement or authorization by the Federal Bureau of Investigation.
  
3. Section 110 of the Amateur Sports Act of 1978, codified at 36 U.S.C. § 380, protects various designations associated with the Olympics. Under 36 U.S.C. § 380(c), the United States Olympic Committee has the exclusive right to use the name "United States Olympic Committee," its symbol (five

interlocking rings) and emblem, and the words "Olympic," "Olympiad," "Citius Altius Fortius" or any combination thereof.

Usually the statute defines the appropriate use of a protected designation and prescribes criminal penalties or civil remedies for improper use. However, the statutes themselves do not provide the basis for refusal of trademark registration. If, for example, a statute provides that a specific party or Government agency has the exclusive right to use a designation, and a party other than that specified in the statute has applied to register that designation, PTO will refuse registration under appropriate sections of the Trademark Act, referencing the relevant statutory provisions.

#### **Proposed Definition of “Official Insignia of Native American Tribes”**

Based on the comments received and in light of significant body of case law interpreting Section 2(b) of the Trademark Act, the PTO proposes the following definition of “Official Insignia of Native American Tribes”:

#### **Official Insignia of Native American Tribes**

*‘Official Insignia of Native American Tribes’ means the flag or coat of arms or other emblem or device of any federally or State recognized Native American tribe, as adopted by tribal resolution and notified to the U.S. Patent and Trademark Office.*

The proposed definition is intended to incorporate wording found in Section 2(b) so that the presumptions and interpretations arising out of Section 2(b) would apply to “Official Insignia of Native American Tribes.”

Amendment of Section 2(b) is not recommended, for the following reason. Presently, Native American tribes may register their official insignia as trademarks, obtaining all the benefits appurtenant thereto. Protection exclusively under Section 2(b) of the Trademark Act would prohibit tribes from obtaining Federal trademark registration for their official insignia. By defining “official insignia” with reference to the wording of Section 2(b), but without amending the Trademark Act, the “official insignia” of Native American tribes are identified as emblems of governmental authority without prohibiting their use, if desired by tribes, as proprietary commercial properties.

Consistent with current practice under Section 2(b), words alone would not be considered “Official Insignia of Native American Tribes.” For example, the word “France” is not considered an “insignia” of France under Section 2(b), so that inclusion of the word “France” in a trademark does not violate this section of the Trademark Act. (See, for example, U.S. Registration No. 1,014,221 (“VIE DE FRANCE”)).

Some commentators indicated that there was no possibility of “good faith” use of the names of Native American tribes, except by Native Americans. However, developments in the English language in American history have resulted in some Native American tribal names acquiring

meanings beyond their significance as names of tribes. Many words identifying Native American tribes are also incorporated in trademarks and used worldwide to identify both the geographic place named and, separately, a particular Native American tribe.

Some Native American tribal names also have meanings in other languages as, for example, the name of the Zia Pueblo in New Mexico. The word “ZIA” means “aunt” in Italian. See U.S. Trademark Registration Nos. 1,779,871 (“ZIA MIA” for restaurant services, with a translation statement indicating that the words “ZIA MIA” in the mark mean “my aunt.”); 2,061,921 (“ZIA MARIA’S” for salsa and spaghetti sauce, with a translation statement indicating that the term “ZIA MARIA’S” may be translated from Italian to read “Aunt Maria’s.”)

A *per se* prohibition on registration of the names of Native American tribes could create gross unfairness to trademark owners using names that happen to intersect with those of Native American tribes. These entities have no intention of falsely associating themselves with Native American tribes and are in no way actually associated with Native American tribes in the mind of the consuming public.

### **The Indian Arts and Crafts Board (IACB)**

The Indian Arts and Crafts Act, 25 U.S.C. § 305 *et seq.*, is a truth-in-marketing law which prohibits misrepresentation in marketing of Indian arts and crafts products within the United States. Under the Act, “Indian product” means any art or craft product made by an Indian. Additionally, under the Act, Section 305(a), subparagraph (g), empowers the IACB to:

(g)(1) to create for the Board, or for an individual Indian or Indian tribe or Indian arts and crafts organization, trademarks of genuineness and quality for Indian products and the products of an individual Indian or particular Indian tribe or Indian arts and crafts organization; (2) to establish standards and regulations for the use of Government-owned trademarks by corporations, associations, or individuals, and to charge for such use under such licenses; (3) to register any such trademark owned by the Government in the United States Patent and Trademark Office without charge and assign it and the goodwill associated with it to an individual Indian or Indian tribe without charge; and (4) to pursue or defend in the courts any appeal or proceeding with respect to any appeal or proceeding with respect to any final determination of that office...

In addition, for purposes of the above-identified section, the term “Indian arts and crafts association” means any legally established arts and crafts marketing organization composed of members of Indian tribes.

The IACB may register trademarks on behalf of federally recognized tribes and their members<sup>4</sup>, for the sole purpose of marketing Indian arts and crafts products. For emphasis, it is noted the term “Indian product” applies to Indian arts and crafts, not to all Indian-made products. The

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<sup>4</sup> According to the IACB, the Department of the Interior and its bureaus and agencies do not provide special services to State recognized tribes. While the Secretary of the Interior has a legal commitment to provide services to federally recognized tribes and their members, the Department’s trust responsibilities do not extend to State recognized tribes.

limits of the term “Indian product” are in keeping with the final regulations of the Indian Arts and Crafts Act and with the IACB’s organic legislation, its primary mission, and the Congressional intent of the Act.

2. *The impact on Native American tribes, trademark owners, the Patent and Trademark Office, any other interested party, or the international legal obligations of the United States, of any change in law or policy with respect to - -*

- (A) *the prohibition of the Federal registration of trademarks identical to the official insignia of Native American Tribes;*
- (B) *the prohibition of any new use of the official insignia of Native American tribes;*  
*and*
- (C) *appropriate defenses, including fair use, to any claims of infringement.*

### **Impact on Native American Tribes**

Currently, any party, including a Native American tribe, may apply for registration of a trademark. Within the context of this study, a few of the Native American tribes responding to the Federal Register notices have already taken advantage of the Federal trademark system to register marks. Thus, Native American tribes currently stand on equal footing with all other potential applicants in terms of legal rights.

As examples, the following registered trademarks are owned by two of the respondents to this study:

**U.S. Reg. No. 1930536**



**Pueblo of Pojoaque**

**U.S. Reg. No. 2,029,471**



**Oneida Indian Nation**

Several respondents pointed out that Native American tribes are often without the financial means to hire trademark counsel. This interferes with the ability to institute opposition or cancellation proceedings in the PTO, to police unauthorized use of common-law trademarks, and to take advantage of legal options. Further, several respondents indicated that many Native American tribes do not want to register their official insignia as trademarks, because they have no interest in making commercial use of their insignia. Rather, their interest is defensive, to stop others from taking “unfair advantage” of symbols, names, and insignia associated with Native American tribes.

One change proposed by several respondents, including Native American tribes, could place Native American tribes in a worse position than they currently occupy. Several respondents recommended that “official insignia of Native American tribes,” however defined, be protected solely under Section 2(b) of the Trademark Act. Presently, Native American tribes may register their official insignia as trademarks, obtaining all the benefits appurtenant thereto. Protection exclusively under Section 2(b) of the Trademark Act would prohibit tribes from obtaining Federal trademark registration for their official insignia.

### **Trademark Owners/Trade Organizations**

Several trademark owners, as well as trade groups that represent trademark owners, provided comments. No trademark owner thought that cancellation of existing registrations, or the possibility of providing a new statutory basis for cancellation of such registrations, was a useful course of action. Further, many trademark owners strongly indicated that such change could be viewed as an unconstitutional taking of private property. Most of the trademark owners indicated that the current system of trademark protection is quite acceptable. The trademark owners uniformly maintained that the definition of “official insignia” should not encompass individual words, particularly the names of Native American Tribes.

### **The Patent and Trademark Office**

The Patent and Trademark Office has extensive experience in implementing statutory and procedural change. Therefore, in one sense, the impact on the PTO of any statutory or procedural change would be largely administrative - preparing Federal Register notices, making necessary rule changes, educating examining attorneys with respect to changes, and making any necessary adjustments to automated systems.

In conducting this study, the PTO has complied with the requirements of E.O. 13084, which requires that Federal agencies consider waivers of statutory and regulatory requirements for Indian tribal governments, where proposed waivers are consistent with applicable Federal policy objectives and are otherwise appropriate. E.O. 13084, Section 4(b).

The PTO is a fee-funded agency. This means that the PTO recovers all of its operating costs from the fees it receives for processing patents and trademarks. With respect to federally recognized tribes and their members, statutory authority already exists for waiver of PTO fees charged in connection with obtaining Federal trademark registration for marks that identify Indian arts and crafts products. Specifically, pursuant to Section 31(b) of the Trademark Act, 15 U.S.C. § 1113(b), the IACB is not charged any fee to register Government trademarks of genuineness and quality for Indian arts and crafts products or for arts and crafts products of federally recognized Indian tribes and their members.

#### **Any Other Interested Party**

One individual respondent indicated that special protection for Native American insignia was illogical since sun imagery is universal and most peoples of the world traditionally use representations of natural phenomena. Aside from this comment, there were no comments from “other interested parties.” Therefore, it is difficult to suggest what would be the specific impact of any changes to current law and practice on other interested parties.

#### **International Legal Obligations**

While many respondents suggested that changes to existing U.S. laws would have no impact on existing international legal obligations, one trade association indicated that some of the suggested changes to U.S. law (such as retroactive cancellation and special statutory protection) could violate various of the United States’ international obligations. Specifically, the

organization noted that Section B of Article 6<sup>quinquies</sup> of the Paris Convention limits the instances under which a trademark may be denied registration or invalidated.

The United States is a member of the Paris Convention for the Protection of Industrial Property, as revised at Stockholm on July 14, 1967. As a Member of the Paris Convention, the TRIPs Agreement, and the Inter-American Convention, the United States is obligated to provide “national treatment” to the nationals of other Members. “National treatment” means treatment no less favorable than that accorded to the nationals of the United States, with respect to protection of intellectual property. In addition, the United States is obligated to provide “Most-favored-nation” treatment (MFN treatment) to the nationals of other Members. This means, with limited exception, that any advantage, favor, privilege or immunity granted by the United States to the nationals of any other country with respect to the protection of intellectual property shall be accorded immediately and unconditionally to the nationals of all Members.<sup>5</sup>

Under Article 6ter of the Paris Convention, the contracting countries have agreed to deny registration or to invalidate the registration, and to prohibit the unauthorized use, as trademarks or as elements of trademarks, of armorial bearings, flags, and other State emblems of the member countries, official signs and hallmarks indicating control and warranty adopted by member countries, and any imitation from a heraldic point of view. The provision applies equally to

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<sup>5</sup> Article 4, subparagraph (d) of the TRIPs Agreement provides an exemption to the principle of MFN, where the Member can demonstrate contrary obligations a previous international agreement related to the protection of intellectual property. Since Native American tribes are not independent nations, the United States could not rely on any treaty with a Native American tribe as raising an exception under TRIPs.

It is noted that time did not permit review of all the treaties with Native American tribes to which the U.S. Government is a signatory. However, given the historical context of the United States’ trust relationship with Native American tribes, it seems unlikely that intellectual property issues are mentioned in any such treaties.

armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations of which one or more countries of the Union are members, except for those that are already the subject of international agreements in force, intended to ensure their protection (e.g., "Red Cross" and emblems protected by the Geneva Convention of August 12, 1949).

Article 6ter of the Paris Convention provides for each member country to communicate the list of emblems, official signs and hallmarks which it wishes to protect, and all subsequent modifications of its list, to the International Bureau of Intellectual Property (the International Bureau), which will transmit the communications to the member countries. Within twelve months from receipt of such notification, a member country may transmit its objections, through the International Bureau.

The Paris Convention thus obligates the United States to refuse to register, as trademarks or as elements of trademarks, designations which have been deposited pursuant to Article 6ter and to which the United States has transmitted no objections.

The United States has recognized Indian tribes as domestic dependent nations under its protection. E.O. 13084. As a matter of law in the United States, no Indian nation or tribe within the territory of the United States is acknowledged or recognized as an independent nation, tribe, or power with whom the United States may contract by treaty. 25 U.S.C. § 71. No federally or State-recognized tribes are thus entitled to notify their official insignia pursuant to Article 6ter of

the Paris Convention. The issue of notice would be addressed by requiring that tribes notify their official insignia to the PTO.

**The prohibition of the Federal registration of trademarks identical  
to the official insignia of Native American Tribes**

Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), bars the registration of any mark that consists of or comprises matter which, with regard to persons, institutions, beliefs, or national symbols, does any of the following: (1) disparages them; (2) falsely suggests a connection with them; (3) brings them into contempt; or (4) brings them into disrepute.

Section 2(a) provides the basis for refusing registration of such marks on both the Principal Register and the Supplemental Register. Applications for marks containing names of Native American tribes, recognizable likenesses of Native Americans, symbols perceived as being Native American in origin, and any other application which the Office believes suggests a connection with Native Americans or Native American-made products may be refused registration under this section of the Trademark Act. Thus, the Trademark Act *already provides a basis* to prohibit Federal registration of marks identical to the “official insignia” of Native American tribes.<sup>7</sup>

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<sup>6</sup> Native American tribes are not foreign nations; but rather, Indian tribes have a unique status as domestic dependent nations under the protection of the United States. E.O. 13084; 25 U.S.C. Section 71.

<sup>7</sup> As elaborated below, the PTO is required to make an evidentiary showing in order to support a refusal under Section 2(a).

Section 2(a) is distinctly different from § 2(d), 15 U.S.C. § 1052(d), for which the relevant test is “likelihood of confusion.” In *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1375-76, 217 USPQ 505, 508-09 (Fed. Cir. 1983), the Court of Appeals for the Federal Circuit noted as follows:

A reading of the legislative history with respect to what became § 2(a) shows that the drafters were concerned with protecting the name of an individual or institution which was not a technical "trademark" or "trade name" upon which an objection could be made under § 2(d)....

Although not articulated as such, it appears that the drafters sought by § 2(a) to embrace concepts of the right to privacy, an area of the law then in an embryonic state (footnote omitted). Our review of case law discloses that the elements of a claim of invasion of one's privacy have emerged as distinctly different from those of trademark or trade name infringement. There may be no likelihood of such confusion as to the source of goods even under a theory of "sponsorship" or "endorsement," and, nevertheless, one's right of privacy, or the related right of publicity, may be violated.

The right to privacy protects a party's control over the use of its identity or "persona." A party acquires a protectible interest in a name or equivalent designation under § 2(a) where the name or designation is unmistakably associated with, and points uniquely to, that party's personality or "persona." A party's interest in a name or designation does not depend upon adoption and use as

a technical trademark or trade name. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1376-77, 217 USPQ 505, 509 (Fed. Cir. 1983); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428, 429 (TTAB 1985).

Section 2(a) of the Trademark Act, 15 U.S.C. § 1052(a), protects, inter alia, "persons, living or dead." Section 45 of the Act, 15 U.S.C. § 1127, defines "person" and "juristic person" as follows:

The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this Act includes a juristic person as well as a natural person. The term "juristic person" includes a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term "persons" in § 2(a) refers to real persons, not fictitious characters. In addition to natural persons, it includes juristic persons, i.e., legally created entities such as firms, corporations, unions, associations or any other organizations capable of suing and being sued in a court of law. See *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969); *Popular Merchandise Co. v. "21" Club, Inc.*, 343 F.2d 1011, 145 USPQ 203 (C.C.P.A. 1965); *John Walker & Sons, Ltd. v. American Tobacco Co.*, 110 USPQ 249 (Comm'r Pats. 1956); *Copacabana, Inc. v. Breslauer*, 101 USPQ 467 (Comm'r Pats. 1954).

Section 2(a) prohibits the registration of a mark that consists of or comprises matter which may falsely suggest a connection with persons, institutions, beliefs or national symbols. Intent to identify a party or trade upon its goodwill is not a required element of a § 2(a) claim of false suggestion of an association with such party. *S & L Acquisition Co. v. Helene Arpels, Inc.*, 9 USPQ2d 1221, 1224 (TTAB 1987); *Consolidated Natural Gas Co. v. CNG Fuel Systems, Ltd.*, 228 USPQ 752, 754 (TTAB 1985). However, evidence of such an intent could be highly persuasive that the public would make the intended false association. *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 1377, 217 USPQ 505, 509 (Fed. Cir. 1983).

Section 2(a), as noted above, is an absolute bar to registration of a trademark. A refusal to register under Section 2(a) does not require that the entity cited as the basis for refusing registration be using any particular mark in commerce. The fact of the entity's existence can be sufficient to trigger a refusal on the basis that the applied-for mark is disparaging, falsely suggests a connection, is contemptuous, or brings the person, institution, belief, or national symbol into disrepute. The body of case law that has developed to interpret Section 2(a) makes clear that the names of Native American tribes, as well as symbols associated with Native American tribes, could substantiate a refusal under this section.

Compilation of a valid list of "Official Insignia of Native American tribes" would provide a reference for use by the PTO in issuing refusals to proposed marks where the applicant is not the tribe identified as the originator of the particular "official insignia." The PTO currently refuses to register trademarks on this basis under Section 2(a), and has made substantial efforts to

accumulate evidence sufficient to support these refusals. An official list of insignia would make it easier for the PTO to issue refusals that are already mandated by Section 2(a) of the Trademark Act.

### **The prohibition of any new use of the official insignia of Native American tribes**

Many respondents noted that Native American tribes should not be restricted in new uses for their official insignia. Respondents representing trademark owners who are not Native American tribes indicated that trademark owners should not be restricted from expanding use of their trademarks in the ordinary course of business, subject to existing tenets of trademark law. Other respondents commented that everyone except Native American tribes should be prohibited from any use, including new uses, of the official insignia of Native American tribes.

Many comments on this topic identified a common theme. Trademark owners are concerned that prohibiting new uses of “official insignia” will curtail use of their registered and common-law trademarks. Native Americans are concerned that failure to prohibit new uses of “official insignia” by non-Native American tribes will perpetuate existing problems.

The PTO understands the concerns expressed and believes there is a relatively simple solution as far as Federal registration of trademarks is concerned. With an accurate reference list of the “Official Insignia of Native American tribes,” the PTO will be able to refuse registration of applications containing “official insignia” where the applicant is not the owner of the official insignia.

Commentators made clear that prosecution issues before the PTO represent only a portion of their concerns. Many opined that it is not enough to deny Federal trademark registration to non-Native American tribes. Action must be taken to initiate investigations and take enforcement actions against would-be infringers.

As with most intellectual property issues, enforcement is the key to full enjoyment of rights. The PTO is not a law enforcement agency. Effective enforcement mechanisms do, however, exist.

### **Enforcement and the IACB**

As has already been noted, the Indian Arts and Crafts Act permits the IACB, a federal agency, to create and register trademarks for Indian arts and crafts products on behalf of federally recognized tribes and their members. The IACB is also empowered to receive complaints of violations involving offers, or displays for sale, or actual sales, of any good in a manner that falsely suggests that the goods are the product of a particular Indian or Indian tribe or Indian arts and crafts organization. Under its statutory authority, the IACB may refer violations to the Federal Bureau of Investigation (FBI) for investigation. 25 U.S.C. §305(d)(a). The IACB may independently recommend to the Attorney General of the United States that criminal proceedings be instituted. 25 U.S.C. § 305(d)(a). The IACB may also recommend that the Secretary of the Interior refer the matter to the Attorney General for civil action. 25 U.S.C. § 305(d)(b). These criminal and civil penalties are harsh and punitive. See 18 U.S.C. § 1159(b)(1) and (2) (First-time individual offenders subject to fines of not more than \$250,000 or five years' imprisonment; businesses subject to fines of up to \$1,000,000; subsequent violations subject to fines of up to

\$1,000,000 or fifteen years' imprisonment if an individual, and up to \$5,000,000 in fines if a business). Thus, in regard to Indian arts and crafts products, statutory authority already exists for Federal agencies to investigate and prosecute would-be infringers, at no expense to Native American tribes.

### **Appropriate defenses, including fair use, to any claims of infringement**

A few commentators indicated that there should be no defenses to claims of infringement, and that any registered marks containing “official insignia of Native American tribes,” if not owned by the tribe, should be cancelled *ex officio* by the PTO. Other commentators indicated that a registered trademark should be a per se defense to any claim that the registered mark infringed on the official insignia of a Native American tribe.

Commentators arguing that there should be no defenses to claims of infringement contend that:

(1) Native Americans have been subject to all sorts of injustices imposed by the U.S. Government; (2) the trust responsibility of the U.S. Government with respect to Native American tribes should supersede any private commercial interests; and (3) if cancellation of registered marks is considered a “taking,” the U.S. Government must be prepared to accept that responsibility in order to rectify the past and on-going wrongs perpetrated by non-Native Americans in stealing important intellectual property elements of Native American culture.

Commentators arguing that a registered trademark should be a defense to an infringement claim contend that any change in current U.S. trademark practice is unnecessary and could result in an unconstitutional taking. They point out that Native American tribes could have filed a notice of

opposition and may still file petitions to cancel registrations. Some commentators suggested that any treaties concluded with Native American tribes are unlikely to contain provisions regarding registration of trademarks and therefore would not be a source of “international law” obligations with respect to trademark registrations.

Although some respondents clearly would like to stop all popular use of words that are the names of Native American tribes, none of the commentators provided a sufficient legal basis for undertaking such a task. After considering all of the comments received, the PTO believes that existing principles of trademark law are adequate to adjudicate infringement issues.

It is important to point out that “fair use,” one defense available in infringement actions, does not mean counterfeit use, piratical use, or any use with the intention of profiting by association with a Native American tribe. “Fair use” may include the sort of use arising when one word has several meanings, associations, or connotations, as with the term “ZIA” mentioned above.

*3. The means for establishing and maintaining a listing of the official insignia of federally or State recognized Native American tribes.*

The PTO recommends that the PTO itself undertake to compile, maintain, and update a database containing the official insignia of federally and State recognized Native American tribes.

*It is proposed that the IACB assist the PTO in the PTO's development of guidelines regarding "official insignia of Native American tribes."*

First, for trademarks that identify Indian arts and crafts products, the IACB is statutorily authorized to create and register trademarks of genuineness and quality on behalf of federally recognized tribes and their members. In addition, the IACB's existing contacts with Indian arts and crafts trade associations, marketing enterprises, and producers will be of assistance to the PTO in developing guidelines regarding "official insignia of Native American tribes." The IACB and PTO are already working cooperatively with respect to implementation of the IACB's trademark program.

4. *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 State or federally recognized Native American tribes; or*

*(B) otherwise give additional protection to the official insignia of federally and State recognized Native American tribes.*

As noted above, the PTO already denies registration under Section 2(a) of the Trademark Act to trademarks that falsely suggest a connection with a particular Native American Tribe.

Registration is refused, even if the applicant appears to be "authorized" by a Native American

tribe, because only the true owner of a mark may apply for registration. Thus, only Native American tribes themselves can obtain registration of their official insignia<sup>8</sup>, although they are free to license use of the official insignia.

As has also been noted above, the Indian Arts and Crafts Board Act, 25 U.S.C. § 305 *et seq.*, protection to federally recognized tribes and their members for their Indian arts and crafts products, while 18 U.S.C. §1159 provides criminal penalties for misrepresenting arts or crafts as being Indian produced.

5. *A determination of whether such protection should be offered prospectively or retrospectively and the impact of such protection.*

A few respondents suggested that any new protection, particularly if it requires cancellation of trademarks owned by entities other than Native American tribes, be retrospective. However, most respondents who offered an opinion on this issue recommended that any new protection be prospective.

The respondents who recommended retroactive protection suggested that any damage to trademark owners would be minimal and that the U.S. Government must be willing to accept this as the trade-off for correcting injustices visited upon Native American tribes. The respondents in favor of prospective protection took the position that to do otherwise could constitute a taking, and could shake business confidence in the U.S. trademark system.

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<sup>8</sup> Registration of “official insignia” would, of course, be subject to all the statutory requirements of the Trademark Act, 15 U.S.C. § 1051 *et seq.*

6. *Any statutory changes that would be necessary in order to provide such protection.*

The PTO does not believe that any statutory changes are necessary to provide adequate protection for the official insignia of Native American tribes.

7. *Any other factors which may be relevant.*

Thirty-six responses cannot capture the thoughts, concerns, and feelings of the broad constituency which is the American public. It is presumed that other relevant factors exist which have not been considered in the course of this study and which, when raised, could affect our analysis, conclusions, and recommendations.

## **CONCLUSION:**

Having reviewed all comments received, and analyzed relevant existing statutes in light of the mandate for this study, several conclusions have been reached:

1. Existing trademark law provides the legal tools necessary to prohibit registration of “official insignia,” or simulations thereof, where the applicant is not the Native American tribal owner.
2. Any new legislation aimed at examination and registration issues is unnecessary and may offer unforeseen complications for innocent parties.

3. In the case of Indian arts and crafts products, existing agencies [DOJ and the FBI] already possess legal authority to take enforcement action on behalf of tribes for violations of the Indian Arts and Crafts Act.  
  
See 25 U.S.C. § 305 *et seq* and 18 U.S.C. § 1159.
4. Providing additional procedural or statutory protection for the official insignia of Native American tribes is unnecessary and might risk violation of U.S. international treaty obligations if it offers exclusive trademark protection to a particular indigenous group.
5. The IACB should continue its ongoing efforts to publicize the Indian Arts and Crafts Board Act, as amended in 1990, to inform both Native American tribes and the public of the precise scope, including limitations, of the IACB's statutory mandate.

Commentators did point out areas for improvement. Specifically, since the PTO does not have an accurate database of information on the official insignia of Native American tribes, it is possible that appropriate statutory refusals are not being issued.

Responses to the study raised other issues. Many respondents want the Federal Government to take an active, enforcement role in policing and prohibiting unauthorized uses of any word, symbol, or combination thereof that refers to Native Americans. Several respondents suggested that the Federal Government is ignoring its trust obligations to Native Americans through failure to have in place an enforcement agency which targets "infringers," counterfeiters, and pirates, on behalf of the tribes.

The comments and study made two facts clear. First, few commentators appear to fully appreciate the scope of protection and law enforcement already available with respect to misrepresentation of Indian-produced goods. Very few respondents seemed aware that the Trademark Act requires refusal under Section 2(a) for marks that are disparaging, or which falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or which bring them into contempt or disrepute. In addition, few respondents seemed aware of the authority vested in the IACB with respect to referral for criminal and civil violations for misrepresentation of Indian arts and crafts products under 18 U.S.C. § 1159, nor of the FBI's authority to investigate, nor of the DOJ's authority to institute both criminal and civil actions.

In the final analysis, this study indicated that the Federal trademark system is not "broken" with respect to official insignia of Native American tribes. However, the comments received to this study make manifest both the need for better use of existing prohibitions and for education about the options available to Native American tribes to enforce their valuable intellectual property rights and protect their cultural heritage. It is hoped that this report will prove an important educational vehicle for both the public and the Federal Government agencies primarily responsible for enforcement of criminal and civil violations involving misrepresentation of Indian-produced goods.

## **RECOMMENDATIONS:**

1. An accurate and comprehensive database containing the official insignia of all State and federally recognized Native American tribes should be created.
2. The U.S. Patent and Trademark Office (PTO) should create, maintain and update this database.
3. Relevant federal agencies should work cooperatively to educate and assist Native American tribes in their efforts to protect their official insignia.
4. Relevant federal agencies should work cooperatively to educate the public at large with respect to the rights surrounding official insignia of Native American tribes.

Respectfully submitted:

Date: \_\_\_\_\_

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Q. Todd Dickinson  
Assistant Secretary of Commerce and  
Commissioner of Patents and Trademarks