

NATIVE AMERICAN TRIBAL NAMES AS MONIKERS AND LOGOS: WILL THESE REGISTRATIONS WITHSTAND CANCELLATION UNDER LANHAM ACT § 2(b) AFTER THE TRADEMARK STUDY ON OFFICIAL INSIGNIA OF NATIVE AMERICAN TRIBES?

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I. INTRODUCTION

Throughout this past decade, challengers to registered trademarks¹ bearing the name “Redskins” have echoed many activists’ related concerns that registrations of Native American tribal names² as monikers and logos³ perpetuate a racist stereotype of Native Americans as savages and as remnants of a bygone era.⁴ Yet, many proponents of registered tribal names counter that the name and symbol are meant to be a mark of respect for Native peoples, signifying appreciation of their history and culture.⁵ Whether tribal names should be granted protection under the trademark laws, particularly for use by non-Native Americans,⁶ is an issue that remains to be answered after the cancellation of the “Redskins” marks in *Harjo v. Pro Football, Inc.*⁷ and the trademark study on the “*Official Insignia of Native American Tribes*” (the “Study”).⁸

The debate continues over trademark registrations on non-tribal name moniker and logo references⁹ to Native Americans, such as “Redskins,”¹⁰ particularly in athletics.¹¹ In light of the opposition to the “Redskins” marks, it appears plausible that opponents to the use of tribal names may challenge marks bearing Native American tribal names (i.e. the “Seminoles” of Florida State University, the “Fighting Illini” of the University of Illinois, or the “Fighting Sioux” of the University of North Dakota).¹² Seemingly advocating such an opposition, one scholar declared that “[c]urrently non-Native American people and companies use Native American names and symbols as trademarks . . . [and] [o]ften these uses are disparaging or offensive to Native Americans, and continue to perpetuate the stereotype that Native Americans are inferior and dying peoples.”¹³

However, unlike the disparagement suit in *Harjo* under Lanham Act § 2(a), the following discussion is devoted to analyzing the trademark registration issues raised on registered tribal names solely in the context of Lanham Act § 2(b).¹⁴ In particular, this article discusses whether tribal names would remain registered in light of the Commissioner’s recommendations based on the results of the Study.

Section II is devoted to providing an overview of trademark law relevant to the issues addressed. This Section serves equally to reference the applicable bodies of trademark law directly on point or related to the issues presented and analyzed on registered tribal names under section 2(b). Section III then analyzes the general issue of whether registered tribal names would constitute official tribal insignia, and thereafter be nonregistrable as trademarks, if Lanham Act § 2(b) were retrospectively revised to include tribal names as “insignia”, based on the results of the Study.¹⁵

Based on the importance of the Study to the second general issue, a review of the legislative history and issues of the Study is covered initially.¹⁶ Following a general overview, the relevance of the Study to Lanham Act § 2(b) is explained.¹⁷ Thereafter, the viability of tribal names as “insignia” under section 2(b) is analyzed in light of the recommendations and results from the Study.¹⁸ Based on the Study, three specific questions are raised to address the general issue concerning a potential revision to section § 2(b):

- 1) Are tribal names “insignia” within section 2(b)?;
- 2) Would section 2(b) be revised to include tribal names as “insignia”?; and
- 3) Would a section 2(b) revision apply retroactively to cancel registered tribal names?¹⁹

Preliminarily, a few qualifications must be noted to distinguish the *Harjo* case from the separate issues addressed by the Study in the context of tribal names.²⁰ First, the term ‘Redskins’ is not the name of a Native American or Native American tribe²¹ but rather a non-tribal name that may bear reference to Native Americans, generally. Therefore, the issues raised against the term “Redskins” in *Harjo*, cannot be seen as analogous to similar issues against actual Native American Tribal names. Additionally, the Study was just that: a non-binding study seeking to find answers to trademark issues on protecting the “*Official Insignia of Native American Tribes*.”²² Furthermore, in distinguishing the “Redskins” case (which deals with bars to registration under section 2(a)) from the Study on official tribal insignia (which deals with bars to registration under section 2(b)), the Study also made clear that neither the term “Redskins” nor

the logos associated with the term are emblems associated with or claimed by any Native American Tribe.²³ The issues in the *Harjo* decision are outside of section 2(b),²⁴ which although bearing trademark implications, do not involve official insignia of Native American tribes. Thus, although overlapping matters exist, the Trademark Commissioner emphasized that even though *Harjo* involves both trademarks and a reference to Native Americans, it is *outside* the issues under review in the Study.²⁵

Notwithstanding these caveats, the judicial decision in *Harjo* only amplifies the issue of whether the findings of the Study provide any answers to the unresolved issues surrounding trademark rights in tribal names versus tribal insignia.²⁶ Following the analysis in Sections III, Section IV concludes the analysis of whether Lanham Act § 2(b), against the backdrop of the Study, provides any concrete direction to the issues surrounding trademark rights in Native American tribal names as monikers and logos.²⁷

II. TRADEMARK LAW v. NATIVE AMERICAN TRIBAL NAMES/REFERENCES

This Section presents an overview of specific trademark provisions. Primarily this coverage yields to the trademark novice²⁸ a better understanding of the intellectual property rights relevant to the trademark issues discussed on tribal names (i.e. “Seminoles”, “Illini”, “Sioux”). As one opposing author noted, registrations on tribal names are far from limited; with as many or more than 94 on the name “Cherokee,” 35 on the name “Navajo,” and 208 referring to the Sioux.”²⁹

Initially, this analysis works from the ground up, by presenting a brief introduction to the legal concepts and provisions relevant to understanding how the trademark owners of Native American tribal names originally attained protection through the Lanham Act.³⁰ This paves the road for a better understanding of how trademark protection may be stripped. This Section also provides an overview of the interplay between the cancellation provisions in Lanham Act §§ 2(a) and 2(b) to better frame the potential for opposition against registered Native American tribal names.³¹

In terms of trademark registrations, the distinctions between marks registered under five years and those registered beyond five years (labeled “incontestable”) are examined.³² Finally, the dichotomy between Lanham Act §§ 2(a) and 2(b) is explored.³³

A. *Historical Context*

Trademarks, like copyrights, patents, and trade secrets, fall within the class of property known as intellectual property. Although these other forms of intellectual property are aimed at protecting inventions and expressions from infringement and theft, trademark law is directed to protecting the consumer.³⁴ In summary:

Trademarks are traditionally viewed as a source identifier. They are words and designs whose purpose is to distinguish the goods or services of one company from the goods or services of another company. The underlying premise in the treatment of trademarks as a source identifier rests on the assumption that consumers read these identifiers as representing consistency between goods bearing the same identifier - that different goods

bearing the same trademark emanate from the same source, and that trademarks represent the promise of consistent quality.³⁵

The law of trademarks³⁶ has existed largely to promote the goodwill³⁷ associated with goods in societies' competitive markets. This promotion of goodwill, as evidenced by adherence to proper trademark registration, is a primary concern to trademark owners of such registered marks as the "Redskins" and tribal names such as the "Seminoles," "Illini," and "Sioux."³⁸ A recent Supreme Court case noted that:

[I]n 1878, this Court described the common-law definition of trademark rather broadly to "consist of a name, symbol, figure, letter, form, or device, if adopted and used by a manufacturer or merchant in order to designate the goods he manufactures or sells to distinguish the same from those manufactured or sold by another."³⁹

Thus, for a mark to be registered on the principal register, it must be used in commerce⁴⁰ to distinguish the products of one owner from those of another.⁴¹

B. Registrable Subject Matter & Trademark Rights

Presently the Lanham Act governs the law concerning trademarks.⁴² A party seeking to register a trademark must file an application for registration with the Patent and Trademark Office ("PTO"), which then determines whether the mark is registrable.⁴³ Lanham Act § 2 contains the grounds upon which an application may be refused registration, and specifically lists those symbols, words and other matter that are not considered registrable subject matter.⁴⁴ However, if the PTO determines that the subject matter is registrable, the mark is then published in the PTO's *Official Gazette*.⁴⁵

Where no opposition proceeding, or challenge to the registration of the mark, is initiated,⁴⁶ the mark may then be registered on the principal register.⁴⁷ If registered, the registrant is issued a certificate of registration⁴⁸ on the mark upon the principal register, which signifies:

[P]rima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods and services specified in the certificate subject to any conditions or limitations stated in the certificate.⁴⁹

However, a trademark which has been registered for less than five years may be cancelled on any grounds for which the mark would have been denied registration originally.⁵⁰

Following five years of registration, section 15 of the Lanham Act provides that an owner of a federally registered trademark may acquire incontestable status by filing an affidavit with the Commissioner of the PTO.⁵¹ Upon acceptance, these marks are granted a heightened status.⁵² This heightened status, incontestability, allows a registrant to quiet title in the ownership of his mark.⁵³ However, as was evidenced by the Trademark Trial and Appeal Board

(the “Board”) in *Harjo*, merely because a trademark advances to incontestable status does not mean that property rights will arise where no rights existed at the outset.⁵⁴

C. Nonregistrable Subject Matter

After the October 1998 Lanham Act revisions,⁵⁵ there now expressly exist eight grounds for cancellation of marks⁵⁶ and nine defenses to infringement of marks⁵⁷ at any time, whether incontestable or not.⁵⁸ Pursuant to the cancellation provision applied against the “Redskins” marks, and the possible relevance to registered tribal names, section 14 of the Lanham Act provides that a cancellation proceeding may be asserted at any time, regardless of whether the mark has achieved incontestable status, if the registered mark “was obtained . . . contrary to . . . subsection (a), (b), or (c) of section 1052 (those comprising immoral, deceptive, or scandalous matter, or . . . disparaging . . . or those consisting of the flag or coat of arms or other insignia of any nation) . . .”⁵⁹ Section 2(b) provides that no trademarks shall be registrable on the principle register that 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.⁶⁰ Primarily, sections 2(b) and 2(a) differ regarding national symbols, in that section 2(b) requires no additional finding, such as disparagement or a false suggestion of a connection, to preclude registration.⁶¹

For a greater appreciation of the deep-seated issues confronting those deciding matters in *Harjo* and the Study, it is worth noting, as one author has expounded on, the struggle within Native American tribes surrounding trademarks generally:

[I]t is also important to recognize that there is not necessarily agreement between the tribes or even within tribes regarding others' use of their symbols. For example, some Native Americans desire their symbols to be reserved for their tribe and therefore want intellectual property laws to prevent others from using or incorporating the symbols in any way. Meanwhile, other Native Americans want to be compensated for others' use of their symbols, thereby enhancing their economic stature. Still other Native Americans "seek to use . . . intellectual property laws in an effort to control and restrict the flow of images, thereby securing the meaning of their art," culture, and identity. In particular this last group wants "to be able to deny certain uses of their art [and symbols], especially those that would amount to spiritual violations." Interestingly, this is exactly what section 302 seems to address and seeks to ensure⁶²

This same author expressed that rather than making official tribal insignia nonregisterable, Native Americans should seek to be the first to register their own symbols and insignia to prevent others from using the mark.⁶³ Yet, such a remedy would overlook the inherent inadequacies of current trademark law to protect tribal symbols and insignia for the following reasons:

- 1) different Native Americans and their tribes may hold the same symbol as an official insignia or sacred symbol of their group. Therefore, if one person or tribe registers the symbol as a trademark, then all other groups would be prevented from using the symbol, at least in the same manner;

- 2) it is unclear who speaks for the various Native American people and their tribes; each tribe may have conflicts within it that would prevent a common view regarding the designation of one or more official insignia;
- 3) Native Americans may believe that an official insignia will lose its qualities and meanings if it becomes a registered trademark, or adopted and used by people outside of the tribe;
- 4) many Native American tribes live at poverty levels and might not be able to effectively litigate to protect use of their marks or even be familiar enough with trademark law to challenge others' trademarks;
- 5) even once someone registers a trademark, that mark can still be used by others, albeit in a limited way, thus not precluding outsiders' use of the mark;
- 6) Native American tribes are communal organizations. They believe that their property belongs to the group and not to an individual, as trademark law presumes. Therefore, there is a concern as to whom the trademark registration would be registered and how the trademark would remain a group right; and
- 7) in order for a trademark to be valid, the mark must be used commercially in interstate commerce and must serve to distinguish one's goods or services.⁶⁴

This Article does not attempt to further analyze each of these separate but related concerns surrounding Native Americans generally but raises them here only to further indicate the complexities beyond even the issues discussed.

III. NATIVE AMERICAN TRIBAL NAMES v. LANHAM ACT § 2(b)

A. Report on the “Official Insignia of Native American Tribes” (§ 2(b))

This past year the Study raised issues on whether registered Native American tribal names could be cancelled under section 2(b).⁶⁵ Specifically, the Study discussed whether such names would be included among the other section 2(b) “insignia,” barred from trademark registration. As will be discussed in further detail:

Included as part of the definition of insignia are emblems of national authorities such as the Great Seal of the United States, the Presidential Seal, and seals of the government departments, that is, those emblems and devices which represent governmental authority of the same general class as flags and coats of arms. A proposed mark is barred under this section which consists solely of such symbol or has such symbol incorporated in the proposed mark.⁶⁶

The Study revealed that many of the respondents to the Study argued that Native American tribal names, such as “Seminoles,” “Illini,” and “Sioux,” should constitute “insignia” under section 2(b) and, therefore, be ineligible for trademark registration.⁶⁷

Before the Study results were released, one legal analyst argued that section 302 of the Study should be enacted to amend section 2(b) of the Lanham Act to include official tribal insignia.⁶⁸ Further, it was asserted that such an amendment be implemented retrospectively to effectively bar any and all official tribal insignia from being registered as trademarks, thereby

giving tribes the only rights to such insignia and symbols.⁶⁹ With the Study results now released, this Article attempts to objectively analyze whether these results would provide for such measures.

In light of the comments from respondents to the Study, the question is whether registered Native American tribal names could constitute “insignia” under Lanham Act § 2(b).⁷⁰ The following discussion concerns the viability of a cancellation proceeding under section 2(b) against tribal names by raising and analyzing three specific issues to address this question:

- 1) Whether tribal names are “insignia” within the meaning of section 2(b);
- 2) Whether section 2(b) would be revised to include tribal names; and finally
- 3) Whether section 2(b), if revised, would apply retroactively to cancel registered tribal names.⁷¹

In addressing the three specific issues raised under section 2(b) against registered tribal names, the Study will serve as the backdrop for the analysis.⁷² The results from two of the most relevant questions researched by the Study help to provide answers to the questions raised above, namely, determining an acceptable definition of the term “official insignia” with respect to a federally or State recognized Native American tribe and a determination of whether such protection should be offered prospectively or retrospectively and the impact of such protection.⁷³ First, however, a brief review of the legislative history leading up to the Study is provided.

1. Legislative History: Trademark Law Treaty and the Zia Pueblo

The Study arose as part of the Trademark Law Treaty Implementation Act (the “TLT Act”), which was enacted in 1998 and effective in 1999.⁷⁴ The underlying mission of the TLT Act provisions was to bring greater conformity between United States trademark law and analogous law throughout the world.⁷⁵ As part of the TLT Act, section 302 also required the Commissioner of Trademarks to study the issues relevant to the protection of the official insignia of Native American tribes.⁷⁶

The legislation for the Study was submitted by New Mexico Senator Jeffrey Bingamen.⁷⁷ Following continued pressure from his constituents, the Zia Pueblo, with regard to their sun symbol, Senator Bingamen’s recommendation proposed the Study to research means of protection for insignia bearing significance as religious symbols.⁷⁸ Specifically, the Zia Pueblo argued that the sun symbol, evidenced on New Mexico's state flag and other goods and services throughout the state, is a sacred symbol that belongs to the Pueblo tribe and should not be trademarked by others.⁷⁹

Therefore, the Study was undertaken to analyze whether current United States trademark law should be amended to prevent the registration of official Native American insignia.⁸⁰ Pursuant to this mission, the Commissioner of Trademarks was required to study how the official insignia of Native American tribes could be better protected under trademark law.⁸¹ Of the questions posed by the Study, initially this article is directed to determining an acceptable definition of the term “official insignia” with regard to Native American tribes. Then, the focus

shifts to whether protection should be offered, and if so, whether prospectively or retrospectively.

2. Relevance of Study to § 2(b)

Pursuant to the Study, if any changes were made to the Lanham Act, such revisions would most likely occur within section 2(b) of the Lanham Act, which prevents trademark registration of “insignia.”⁸² As noted, section 2(b) was raised by several participants, including Native American tribes, as the appropriate means for protecting the “official insignia” of Native American tribes, including tribal names.⁸³

However, seeking protection under section 2(b) could place Native American tribes in a worse position than they currently occupy, since this would also prohibit tribes from obtaining federal trademark registration for their insignia.⁸⁴ Presently, any party, including Native American tribes, may seek trademark registration of Native American tribal insignia (assuming no other provisions of the Lanham Act prevent such registration), which may or may not include a Native American tribe’s respective name.⁸⁵

B. Tribal Names v. Official Insignia Under § 2(b)

1. Are Tribal Names “Insignia” Within the Meaning of § 2(b)?

a. Current Definition of “Insignia” Under § 2(b)

Initially, the analysis must turn on how “insignia” is presently defined.⁸⁶ Section 2(b) of the Lanham Act defines “insignia” as that which “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,⁸⁷ or any simulation thereof.”⁸⁸ Yet, as the Study noted, Native American tribes do not constitute foreign nations, States or municipalities.⁸⁹ Rather, tribes occupy the unique status of domestic dependent nations, falling within the protection of the United States.⁹⁰ Thus, under current law, the PTO does not specifically make trademark registration refusals under section 2(b) with respect to “official insignia” of Native American tribes.⁹¹ However, based on the findings of the Study, the question is whether Native American tribal names would constitute “insignia” if section 2(b) of the Lanham Act were revised.⁹²

The Study defined that under section 2(b), “flags and coats of arms are specific designs formally adopted to serve as emblems of *governmental authority*.”⁹³ (emphasis added). The Study further clarified that 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.”⁹⁴ (emphasis added). Presently, since tribal insignia is not expressly noted within section 2(b), it would essentially have to fit the meaning of “other insignia” to constitute insignia within the meaning of section 2(b).⁹⁵

Numerous cases have decided issues surrounding what constitutes insignia under section 2(b). In 1964, the Board 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 Governmental departments would be equally prohibited registration under Section 2(b). On the other hand, it appears equally evident that departmental 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.⁹⁶

Furthermore, the Board later explained that:

[L]etters 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 are not, generally speaking, ‘insignia.’⁹⁷ (emphasis added).

Additionally, many respondents to the Study indicated that official insignia should “include *words alone*, particularly Tribal names (e.g. “Cheyenne” or “Lakota”), as well as words in combinations with figurative elements.”⁹⁸ (emphasis added). Countering this, the Study also included relevant arguments by several trademark owners and trade groups as to what should constitute official insignia.⁹⁹ Specifically:

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.*¹⁰⁰ (emphasis added).

In particular, the last comment by the trademark owners/groups above countered that tribal names *not* be included in the definition of “official insignia”, as such a revision to include tribal names may greatly affect that which could remain or later be registered.¹⁰¹

The Study seemed in accord with the trademark owners/groups, stating that, consistent with current practice under section 2(b), words alone would not be considered official insignia of Native American tribes.¹⁰² “For example, the word ‘France’ is not considered ‘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.”¹⁰³ Thus, even if specific tribal names could be incorporated as part of a tribe’s “official insignia,” it appears under current practice that others could still seek trademark registration of the tribal name alone.¹⁰⁴ However, the emblem or flag of tribal governmental authority, which may incorporate a tribal name, could not be registered.¹⁰⁵

As noted earlier, some have argued against non-Native Americans having trademark rights in tribal names. Furthermore, even if such a name was included as part of a tribe's "official insignia." "some commentators indicated that there was no possibility of 'good faith' use of tribal names, except by Native Americans."¹⁰⁶ However, the Study did note that some tribal names have acquired meanings beyond names of tribes.¹⁰⁷ In fact, many words which identify tribes are also incorporated in trademarks throughout the world to identify geographic places.¹⁰⁸ Yet, where the registered tribal name in question does not have meanings in other languages, the issue of false association and disparagement under section 2(a) is created in the eyes of some.¹⁰⁹ Countering from a public policy approach, the Study resounded that:

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.¹¹⁰ (emphasis added).

Following an analysis of the applicable case law and trademark registrations, the Study sought to interpret a workable definition of the term "insignia." The Study generally clarified that "insignia," under section 2(b):

[I]s 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.¹¹¹ (emphasis added).

b. Proposed Definition of "Official Insignia" of Native Americans

Applying section 2(b) to tribal insignia, the next relevant question generally concerns who should determine what constitutes official tribal insignia under section 2(b).¹¹² Almost all respondents indicated that Native American tribes themselves must designate the actual "official insignia."¹¹³ In fact, some resounded that "it would be unacceptable for the U.S. Government to attempt to impose a determination of specific 'official insignia' for each tribe."¹¹⁴ Finally, following the comments received and in light of the case law interpreting section 2(b) of the Lanham Act, the PTO *proposed* the following definition of "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.¹¹⁵

In order to incorporate the presumptions and interpretations of section 2(b), the proposed definition is intended to employ similar language for equal application to official tribal insignia.¹¹⁶ Therefore, in order for a Native American tribal name to be deemed an "official or other insignia," in the event section 2(b) were revised to include such insignia, it appears the name would have to represent: 1) a specific "governmental authority" of the tribe, which 2) does

not “merely identify people and things associated with a particular agency or Department”¹¹⁷ within the tribe, and 3) constitutes more than “words alone,” by existing as part of the tribes’ “flag, coats of arms, or designs formally or informally adopted to serve as emblems of governmental authority.”¹¹⁸

Earlier, it was noted that under section 2(b), words alone would not constitute tribal insignia.¹¹⁹ However, the Study did indicate that what constituted official tribal insignia would be determined by tribal resolution, which would not preclude tribal names from constituting all or part of a tribe’s official insignia.¹²⁰ Thus, the results of the Study do appear to give tribes latitude in determining what constitutes their “official insignia.”¹²¹ Furthermore, an argument exists that tribal names could constitute tribal insignia, if adopted by resolution.¹²²

Although not directly discussed in the Study, this alternative view revolves around interpretation of the language of the definition for “Official Insignia of Native American Tribes.”¹²³ Under this alternative construction, the only probable way a section 2(b) cancellation would arise is where Native American tribes lobbied to have the “words alone” of their respective tribal insignia included under section 2(b).¹²⁴ Were this to occur, and section 2(b) revised to include tribal insignia as described, tribes would be granted group rights in such tribal names but denied the opportunity to seek trademark rights in tribal names not already registered.¹²⁵

Thus, hypothetically, a tribe such as the Florida Seminoles could adopt, by tribal resolution, that tribe’s official flag/emblem to include the words/phrase “Seminoles Nation,” or simply “the word” “Seminoles.”¹²⁶ The Study indicates that the U.S. Government would presumptively accept that such a tribal name constituted the tribes’ “official insignia” under section 2(b).¹²⁷ Under this interpretation, it appears that tribal names could constitute part of a tribes’ official insignia. However, if the tribal name were previously registered as a trademark, this approach would not appear to preclude such a mark from remaining a contemporary registration in accord with section 2(a) while the name is subsequently listed as an “insignia” under section 2(b).¹²⁸

Thus, two contradictory answers appear to exist on whether tribal names could constitute “insignia” under section 2(b), based on the Study. First, consistent with the PTO definition of “insignia,” tribal names alone are not “insignia” under section 2(b).¹²⁹ In this case, where tribal names do not fit the definition of “insignia,” the subsequent two issues raised by this Article, in analyzing a potential revision of section 2(b), would never be reached.¹³⁰

Second, under the Commissioner’s deferential stance to Native American definitions of their respective tribal insignia, tribal names could be “insignia” if a respective tribe so elected.¹³¹ Yet, in the second scenario, such a liberal policy would seemingly defeat the section 2(b) bar against registering “insignia” as trademarks.¹³² Furthermore, this would depend on Congress’s electing to revise Lanham Act § 2(b), contrary to the recommendations of the Study, by including tribal insignia, and even more liberally tribal names alone, without associated flags or coats of arms, as “insignia.”¹³³ Therefore, even if Native American groups lobbied for a section 2(b) revision to include tribal names as insignia, and prevent misuse by others, it is unlikely Congress would make such a revision against the recommendations of the PTO.¹³⁴ Yet, pursuant

to the more logical first scenario above, a most important question still remains, namely, whether an adopted tribal insignia *would* be included as “insignia” under section 2(b), if section 2(b) were revised following the Study.¹³⁵

2. Whether Section 2(b) Would be Revised to Include Tribal Names?

Specifically addressing whether tribal names constitute “insignia,” the Commissioner recommended that section 2(b) not be amended for the following reasons:

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.¹³⁶

The Commissioner's reasoning for not recommending revision of section 2(b) appeared to focus especially on the commercial benefits tribes may reap by seeking and using trademark rights in their tribal insignia, which may or may not include tribal names.¹³⁷ Therefore, the PTO will most likely continue policing trademark registrations, as it has since 1994, by preventing others from registering trademarks which give a “false impression” of the true origin of the goods or services.¹³⁸ Under this policy, registrations may be refused which contain “[t]ribal 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”¹³⁹ Unless an applicant overcame such a rejection by the Examining Attorney, an application bearing the above would be refused.¹⁴⁰ Currently then, with the Commissioner’s recommendation against revising section 2(b), it does not appear that a viable cancellation ground exists under the present section 2(b) provision.¹⁴¹

However, since the Study was charged only with gathering information and making recommendations, the possibility of a section 2(b) revision cannot be completely disregarded.¹⁴² Although the Study recommended that tribal insignia not be included within section 2(b) “insignia,” and noted that words alone would not be considered insignia under section 2(b);¹⁴³ it also indicated that what constituted official insignia, under the definition, would be decided by tribal resolution.¹⁴⁴ Thus, it cannot be assumed that Native American tribal names, particularly if strongly lobbied for, as “official insignia” would never fall within the protection of section 2(b).¹⁴⁵

Therefore, it is still necessary to analyze the third issue raised regarding registered tribal names. In the event that a future revision of section 2(b) did include the “words alone” of tribal names as “insignia,” among the other section 2(b) insignia, would such a revision apply retroactively?¹⁴⁶

3. Would a Section 2(b) Revision Apply Retrospectively to Cancel Registered Tribal Names?

The other relevant question from the Study sought “[a] determination of whether such protection [of tribal insignia] should be offered prospectively or retrospectively and the impact of such protection.”¹⁴⁷ Thus, in the alternative of the Commissioner's recommendations, were section 2(b) revised to include tribal names as official insignia, would the changes be applied retrospectively to cancel registered trademarks?¹⁴⁸

The Study summarized the public responses to this issue, noting that:

A few of the 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.¹⁴⁹ (emphasis added).

Were section 2(b) revised to apply retrospectively to tribal names, as the minority of respondents recommended, then current registrations on tribal names may be cancelled under section 2(b).¹⁵⁰ Such a revision would preclude any party, Native American or non-Native American, from having trademark rights in tribal names.¹⁵¹ Retrospectively, previous owners would be stripped of all trademark rights, and tribes would be granted the exclusive rights in their respective tribal names classified as official tribal insignia under section 2(b).¹⁵² Furthermore, on the cancellation issues raised by this Article, such a revision may render any potential opposition before the Board or court as moot, where the PTO then cancelled *per se* all marks bearing specific tribal name registrations.¹⁵³

However, if a section 2(b) revision applied prospectively, as the majority of respondents to the Study recommended, owners of registered tribal names, prior to the date of enactment for revisions, would still retain rights in registered tribal names as monikers and logos.¹⁵⁴ Only trademark applications for tribal names *after* enactment of the revised section 2(b) would be *per se* precluded from registration.¹⁵⁵ Therefore, even if tribal names were adopted as official tribal insignia, and section 2(b) was revised to include official tribal insignia as “insignia” under section 2(b), registered tribal names would not be cancelled based on the recommendation of the majority of respondent’s to the Study.¹⁵⁶ However, even though this was proffered as the appropriate measure by the majority responding, the harm sought to be remedied by those opposing tribal name registrations would nevertheless persist.¹⁵⁷

a. Defenses Against Retrospective Cancellation

Although some respondents to the Study expressed their desire to stop all use of words that are also names of tribes, the Study qualified that none of the commentators provided a

sufficient legal basis for such a drastic measure.¹⁵⁸ Therefore, pursuant to the analysis presented if section 2(b) were revised, defenses may exist. In examining the defense arguments on both sides of the issue, the Study noted that:

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 interest; and (3) if cancellation of registered marks is considered a [Constitutional] “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 registrations of trademarks and therefore would not be a source of “international law” obligations with respect to trademark registrations.¹⁵⁹

The final portion of the above quote, and the remainder of the defense analysis brings the argument back to the statutory language that registrations are barred “which consist of or comprise the flag, the coat-of arm, or other insignia of the United States, any state or municipality, *any foreign nation, or any simulation of such.*”¹⁶⁰ (emphasis added). With arguments from both sides on the *per se* affect of retroactivity on a section 2(b) revision, analysis of International Treaties and federal case law surrounding the words of section 2(b) (italicized above) provide the clues to potential defenses.

Within the analysis of international legal obligations, the Study analyzed the relevant points of the United State’s membership in the Paris Convention.¹⁶¹ Under this agreement:

[T]he contracting countries have agreed to deny registration *or to invalidate the registration*, and to prohibit the unauthorized use, as trademarks or 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 armorial bearings, flags, other emblems, abbreviations and names of international intergovernmental organizations of which one or more countries of the

Union are members . . . [which] 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 . . . [which] thus obligates the United States to refuse to register, as trademarks or as elements of trademarks, designations which have been deposited . . . and to which the [U.S.] has transmitted no objections.¹⁶² (emphasis added).

From this vantage, it would appear that those arguing for retroactivity could cite the Paris Convention as evidence for *per se* cancellation (i.e. invalidation) of registered tribal names, if section 2(b) were revised to include such names as insignia.

Yet, as the Study noted, Native American tribes are not foreign nations, States, or municipalities but rather have the unique status as domestic dependent nations under the protection of the United States.¹⁶³

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. No federally or State-recognized tribes are thus entitled to notify their official insignia pursuant to Article 6 of the Paris Convention.¹⁶⁴

The Study has now advocated that tribes notify the PTO of their official insignia.¹⁶⁵ Therefore, the Paris Convention does not appear to provide much recourse for the opposition, other than as a secondary source for what other entities have done in the way of trademark invalidation of listed insignia. However, as discussed below, there exists arguably analogous federal case law on the proponent's side of the issue, in contradiction to the international stance.

Following case precedence that diverts from the Paris Convention, if an applicant's use predates either adoption of the symbol or statutory recognition of the symbol, the mark may be registrable.¹⁶⁶ In the case of *U.S. Navy v. United States Mfg. Co.*,¹⁶⁷ the Marine Corp initials USMC were found not to be a national symbol. However, Congress later responded to the decision in *U.S. Navy* by requiring that the initials, seals and emblems of the Marine Corp be deemed insignia of the United States, to prevent any future registrations.¹⁶⁸ *U.S. Navy* reasoned that:

[t]he amendment [making USMC a national symbol] states specifically that the amendment 'shall not affect rights that vested before the date of enactment of this Act (enacted October 19, 1984).' Applicant had used the mark on its goods for almost forty years prior to the enactment of the amendment and, as a result of that use, had long ago acquired the right to use, the mark.¹⁶⁹

Therefore, Congress has directly dealt with an analogous issue to the one presented here. The Board in *U.S. Navy* chose not to retrospectively apply such a provision to those with vested rights before the enactment of an Act, which recognized an insignia. Therefore, were the Study results to be codified, and arguments for retroactivity sought, a valid rebuttal appears to exist for

prior registrants' of tribal names, in light of Congress's and the Board's express decision on just such an issue.

Additionally, as defined in section 2(b), even a "simulation" of a United States or foreign insignia is unregistrable. The Board described that "simulation" as contemplated by section 2(a), refers to something that gives the appearance or effect, or has the characteristics of, an original item.¹⁷⁰ However, from a defense stance, more than a mere general similarity is required for a finding of simulation.¹⁷¹ As explained:

If the mark is not an exact duplicate of a national symbol, the applicant may argue and introduce evidence that the mark is not a simulation of a national symbol. The determination is based on the initial impression from a view of the mark without a careful analysis or side-by-side comparison with the symbol. Survey evidence is often of particular relevance on the question of simulation.¹⁷²

In addition, a similar section 2(b) defense rests for those marks that incorporate in a mark individual or distorted features, which are merely suggestive of flags, coats of arms or other insignia.¹⁷³ Thus, in the event the minority of respondents to the Study were able to lobby for retrospective enactment of tribal insignia under section 2(b), a solid defense, with case precedence, may exist for owners of currently registered tribal names which incorporate more than a mere "simulation" or "mere suggestion" of the insignia.

C. The Viability of Codifying the Study Results

As noted, the Study was conducted as an opportunity to explore issues surrounding the official insignia of Native American tribes.¹⁷⁴ The results of the Study have afforded a means of disseminating findings and making recommendations based on information gathered on the issues surrounding official tribal insignia.¹⁷⁵ At this writing, no results of the Study are being prepared for codification.¹⁷⁶ Only future input and research into these issues will reveal the impact that the Study may directly have on official tribal insignia as "insignia" within section 2(b), and indirectly the affect on trademark rights involving such insignia.¹⁷⁷

V. CONCLUSION

Based on the present trademark laws, this Article analyzed the viability of a section 2(b) cancellation proceeding against a registered mark bearing a Native American tribal name, used as a moniker and logo. Following the disparagement finding in *Harjo*, it is plausible that a party seeking cancellation of a registered tribal name as a moniker or logo may look beyond a section 2(a) disparagement remedy and into section 2(b) bar against insignia as trademarks.

The analysis was framed in light of results from the study on the "Official Insignia of Native American Tribes."¹⁷⁸ Of utmost relevance, the Study noted that "words alone" do not constitute insignia under section 2(b).¹⁷⁹ However, the Study also indicated that what constituted Native American tribal insignia would be left up to each respective tribe.¹⁸⁰ Therefore, it would appear plausible that a tribal name could constitute part of or possibly an entire tribal insignia, where such a tribe so indicated to the PTO.¹⁸¹

As part of the Study, the PTO's *proposed* definition for Native American tribal insignia "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."¹⁸² This language appears consistent with the Study's definition of "insignia" generally, that "words alone" (i.e. a tribal name) cannot be "insignia." However, an argument exists that construing this language evidences contradiction, where deference may be granted tribes as to what may constitute their official insignia (seemingly without providing other governmental entities within the Nation equal deference). In essence, the language of the Study would appear to say tribal names alone could be adopted by respective tribes as official insignia, yet clarifying that such a name may or may not be granted listing as "insignia" under section 2(b).

In the event of allowance, the difficult question may arise as to whether registered tribal names would be subject to cancellation under section 2(b), whether owned by Native or non-Native Americans.¹⁸³ Ultimately, in consideration of commercial viability for tribes, the Commissioner recommended that Native American tribal insignia, even under the proposed definition, *not* be included as insignia under section 2(b),¹⁸⁴ predominantly because this would also deny individual Native Americans and tribes trademark rights in their respective tribal names and other insignia.¹⁸⁵ Since the Study recommended that tribal insignia not be included as "insignia" under section 2(b), any concern over the possible retroactive affect on registered tribal names appears moot.¹⁸⁶ Therefore, a cancellation proceeding under section 2(b) against a registered Native American tribal name does not appear viable, which was the underlying basis for analyzing the potential impact of the Study on section 2(b), if revised.

The alternative view and only probable way such an action could hypothetically arise is where Native American tribes lobbied to have their respective tribal insignia, and "words alone" included under section 2(b).¹⁸⁷ However, this would depend on Congress electing to revise Lanham Act § 2(b), contrary to recommendations of the Study, by including tribal insignia, and even more liberally, tribal names, as tribal insignia.¹⁸⁸ Yet, even if Native American groups lobbied for such a revision to protect their rights in tribal names, and prevent misuse by others, it is unlikely Congress would make such a revision against the recommendations of the PTO. This is especially true in light of the PTO's recognition of the underlying negative economic impact it could also permanently have on tribes.¹⁸⁹ Furthermore, as noted in the discussion on defenses, numerous arguments appear to exist in favor of the proponents for retaining registered tribal names. Therefore, it is not likely that registered tribal names would be subject to cancellation proceedings under section 2(b), based on either the Study recommendations or the alternative view.¹⁹⁰

In summary, under a section 2(b) claim, plausible arguments abound on both sides of these issues, regarding a revision to Lanham Act § 2(b).¹⁹¹ However, from a practical standpoint, it does not currently appear that a cancellation proceeding against a Native American tribal name, used as a moniker or logo, would be successful under Lanham Act § 2(b). Notwithstanding section 2(a), an opposing party would most likely have to look outside the Trademark Act, possibly within the Constitutional realm, to more generally attack the actual *use*

of Native American tribal names.¹⁹² In the event such a challenge proved viable, a ruling in favor of the opposition would have the indirect affect of also cutting off trademark rights.

The present debate has evolved like that of other difficult issues throughout history; inherently connected to the emotional bonds linked to the times, traditions, and cultures of every contemporary society. The questions surrounding trademark rights in Native American tribal names as monikers and logos are not only difficult to answer, but quite plausibly unanswerable in a form suitable to all interested parties. The resolution of the debate surrounding registered tribal names as monikers and logos, from a trademark stance, as well as a Constitutional front, remains to be seen. Through continued open discussion and representation from all interested parties, it can only be hoped that the ultimate issues on this debate will surface. If and when this occurs, may those charged with finding a means to answer these difficult questions, as well as the parties involved, strive to seek a resolution that amicably, all parties can respect.

* © 2000 Maury Audet. J. D. University of North Dakota School of Law, May 2000. Intellectual Property Summer Institute (IPSI)/Advanced Licensing Institute (ALI), Franklin Pierce Law Center, 1998. M. S., University of North Dakota, 1999. B. S., Montana State University-Northern, 1996. The author wishes to thank University of North Dakota Law Professors James M. Grijalva, for all his helpful insights and comments throughout the preparation of this article, and Randy H. Lee, for his early guidance to sources knowledgeable on the local debate. Use of the "Fighting Sioux" moniker/logo has been a recurring debate over the past thirty years at University of North Dakota. Written during the final year of law school, 1999-2000. Contact address: mauryaudet@hotmail.com.

¹ The term *trademark* is used interchangeably with the shortened form *mark(s)* throughout this article.

² In discussing the issues in this Article, where not specifically stated, Native American tribal names, used interchangeably simply at *tribal names*, refers to those tribal names which are *registered* for use as moniker/logos.

³ See WEBSTER'S NINTH NEW COLLEGIATE DICTIONARY 767, 702, 775 (9th Edition 1990). A *moniker* (*slang*) is a "NAME, NICKNAME." See *id.* at 810. A *logo* is 2: an identifying statement: MOTTO [1: a sentence, phrase, or word inscribed on something as appropriate to or indicative of its character or use 2: a short expression of a guiding principle]. *Id.* at 702, 775. Please note that the terms *moniker* and *logo* are used together or interchangeably throughout this Article to identify the use of Native American tribal names as sources of identification for these entities, using such names as identifiers (i.e. universities, high schools, athletic organizations) employing such names for various purposes (i.e. team names, identifying name or logo for entity).

⁴ See *Harjo v. Pro-Football, Inc.*, 50 U.S.P.Q.2d (BNA) 1705 (TTAB 1999); see also Jack Achiezer Guggenheim, *Renaming the Redskins (And the Florida Seminoles?): The Trademark Registration Decision and Alternative Remedies*, 27 Fla. St. U. L. Rev. 287 (2000) (citing Don Pierson, *Redskins Nickname Will Be Protest Target*, CHI. TRIB., Jan. 19, 1992, at 2C); see also Suzan Shown Harjo, *The Invisible Americans*, A.B.A. J., at 66 (March 2000).

⁵ See generally David Vorland, *The Fighting Sioux Team Name and Logo at the University of North Dakota, An Historical and Contextual Summary*, at 5-6 (last modified Feb. 8, 2000) <<http://www.und.edu/president/name.html>>.

⁶ See Q. Todd Dickinson, Commissioner of Patents and Trademarks, *Official Insignia of Native American Tribes, Statutorily Required Study* at 28 (30 Nov. 1999) <<http://www.uspto.gov/web/offices/com/sol/notices/insgstdy.pdf>> (Report to Congress, pursuant to Title III of Public Law 105-330). Currently, any party, including a Native American tribe, may apply for registration of a trademark. Within the context of the 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, tribes stand on equal footing with all other applicants in terms of rights. However, at the heart of the debate is the fact that many trademark owners of such names are non-Native Americans.

⁷ See *id.* at 12 (noting that “currently, *Harjo* is on appeal before the U.S. District Court for the District of Columbia”). See generally *Harjo*, 50 U.S.P.Q.2d (BNA) 1705 (1999). Following the cancellation of the “Redskins” marks for disparagement, it is plausible that a similar cancellation proceeding, based on disparagement or another section of the Lanham Act, such as section 2(b), may one day be brought against trademark registrations of specific Native American tribal names. The Author is unaware of any trademark opposition action that has been specifically brought against a tribal name used as an athletic moniker and logo. Furthermore, *Harjo* itself was a case of first impression before the Board.

⁸ See The Trademark Law Treaty Implementation Act, § 302, 112 Stat. 3064 (Oct. 30, 1998) (§ 302: Official Insignia of Native American Indian Tribes) (codified in various sections of 15 U.S.C. §§1051-1127 (1994 Supp. & 1998) (hereafter the “TLT Act”). The Trademark Study was proposed within a larger act, the *Trademark Law Treaty Implementation Act*, Pub.L. No. 105-330, 112 Stat. 3064. The author wishes to preface that an accepted definition for “Official Insignia” has not been finalized. A proposed definition has been created, which is discussed *infra* Section III. However, specific tribal names cannot be presently assumed to fall within official tribal insignia, or section 2(b) insignia, until such a definition were codified.

⁹ See also Andre Douglass Pond Cummings, “*Lions and Tigers and Bears, Oh My*” Or *Redskins and Braves and Indians Oh Why*”: *Ruminations on McBride v. Utah State Tax Commission, Political Correctness, and Reasonable Person*, 36 Cal. W. L. Rev. 11, 33 (1999). Cummings recites that “[F]ive professional sports teams currently have American Indian names and logos: the Atlanta Braves, Chicago Blackhawks, Cleveland Indians, Kansas City Chiefs, and Washington Redskins.”

¹⁰ See generally *Harjo*, 50 U.S.P.Q.2d (BNA) at 1749. Six “Redskins” marks were at issue in the cancellation proceedings. See generally United States (U. S.) Trademark Electronic Search System (TESS) <<http://tess.uspto.gov>> (search bank which reveals the relevant details of all ‘registered’ trademarks).

¹¹ See Cummings, *supra* note 9. Cummings notes that “over 100 colleges and universities” have replaced Native American team names and Indian logos. However, despite the momentum away from such use, “dozens of colleges and thousands of high schools” still use variations of Native American logos, with some fans and sports enthusiasts charging that political correctness has “run amok” in this momentum (citations omitted). Some of the collegiate institutions that have changed their nicknames from former Native American names or non-Native American names that reference Native Americans include Stanford University, Dartmouth College, Marquette University, Syracuse University, Miami University (Ohio), the University of Oklahoma and Bradley University.

¹² See also TESS, *supra* note 10. In terms of marks on tribal names as monikers and logos, a search of the USPTO trademark database revealed that the “Fighting Illini” mark was recently registered on March 9, 1999. However, the “Seminoles” mark was registered April 3, 1984, which grants it the heightened incontestable status. The greater rights granted the “Seminoles” mark may or may not affect an opposing parties’ ability to attack such a mark, which bears a conclusive presumption of validity, rather than merely a prima facie presumption. See also Section II, *infra*.

¹³ See Alexis A. Lury, *Official Insignia, Culture, and Native Americans: An Analysis of Whether Current United States Trademark Law Should Be Changed to Prevent the Registration of Official Tribal Insignia*, 1 J. Intell. Prop. 137, at 156 (1999) (citing Richard A. Guest, *Intellectual Property Rights and Native American Tribes*, 20 Am. Indian L. Rev. 111, 126 (1995-1996). “Native American tribal names have been appropriated and used by a variety of companies as part of their corporate names and/or as trademarks to identify their goods or services”). Lury provided one of the first scholarly reviews of the Study, prior to the release of its results. Lury added that:

[C]oncern that “sacred” meanings will be lost if others adopt and use the symbols, insignia and cultural property may be particularly true with regard to trademark law because when a name or symbol is connected with a number of items from different sources the original meaning becomes blurred or weakened . . . Therefore, others’ use of Native American names, symbols and tribal insignia may be dehumanizing and disparaging to Native Americans.

Id. at 149. “Native American cultural symbols are used by a considerable number of non-Native businesses to sell products, and at times the symbols are used in a manner that is disparaging to . . . Native American cultural

identity.” *Id.* at n. 56, (citing Terence Dougherty, *Groups Rights To Cultural Survival: Intellectual Property Rights in Native American Cultural Symbols*, 29 Colum. Hum. Rts. L. Rev. 355, 356 (1998)). "Use of these names and images, some more than others, is dehumanizing to many Native Americans" *Id.* (citing Dougherty, *supra*, at 356).

¹⁴ See 15 U.S.C. §§ 1052(a), (b) (1994 & Supp. IV 1998) (trademarks registrable on principal register); see generally *Harjo*, 50 U.S.P.Q.2d (BNA) 1705. Particularly within the University setting, many challengers have primarily directed their opposition against the actual ‘use’ of such tribal names as disparaging, whether trademark rights (registrations) exist or not. This Article only covers issues of use related to trademark rights. Like the Board in *Harjo* specifically noted, “[w]e do not decide whether the subject marks may be used or whether the word REDSKINS may be used as part of the name of respondent’s professional football team.” See *id.* at 1708. These other equally important, but ancillary, debates hinge more on Constitutional issues.

¹⁵ See 15 U.S.C. § 1052(b). On October 30, 1998, Congress directed the Commissioner of Trademarks, within the PTO, to study and identify trademark issues surrounding the protection of official insignia. See also TLT Act, *supra* note 8, at § 302. This past November 29, 1999, the Commissioner released a summary of the findings from the Study.

¹⁶ See *id.*

¹⁷ See 15 U.S.C. § 1052(b); see also TLT Act, *supra* note 8, at § 302.

¹⁸ See *id.*

¹⁹ See *id.*

²⁰ See TLT Act, *supra* note 8, at § 302; see *Harjo*, 50 U.S.P.Q.2d (BNA) at 1709; see also Dickinson, *supra* note 6, at 12-13. Coincidentally, the Study noted that the TTAB issued its final decision in *Harjo* during the pendency of the Study. The Study also noted that “an instructive example of the limited scope of this study is the recent decision in . . . *Harjo*.”

²¹ See Dickinson, *supra* note 6, at 12-13.

²² See *id.*

²³ See *id.*

²⁴ See *id.* (“fall in the category of “other social ills”).

²⁵ See *id.* The issues in the Study revolve solely around official tribal insignia, which was not at issue in *Harjo*.

²⁶ See *Harjo*, 50 U.S.P.Q.2d (BNA) 1705; see also Dickinson, *supra* note 6.

²⁷ See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1709; see also Dickinson, *supra* note 6, at 12-13.

²⁸ For the seasoned trademark practitioner, Section III may be overlooked, or skimmed, depending on the details sought to be attained from the article. The analytical substance of the article is presented in Sections III and IV.

²⁹ See Dougherty, *supra* note 13, at 376-377 (footnotes omitted). Dougherty also noted in the same passage, that:

[M]any of these images use the psychological impact of Native American cultural symbols and historical myths in order to sell products. Through trademark, the users are often granted a property right in their use of the image . . . Oren Lyons, an Iroquois faithkeeper, noted the use of Native American religious and cultural imagery for sports team logos: “Army had a mule, Navy a goat, Georgia had a bulldog and Syracuse had an Indian. Use of these names and images, some more than others, is dehumanizing to many Native Americans.”

³⁰ See generally 15 U.S.C. § 1051 et seq. (1994 Supp. & 1998). The Trademark Act and its provisions are generally referred to as the Lanham Act, in recognition of the namesake drafter of the Act.

³¹ See 15 U.S.C. §§ 1052(a), (b). See also Lury, *supra* note 13, at n. 31. “In general terms, nonregisterable material includes immoral, deceptive, scandalous, or disparaging matter (§1052(a)); the certain insignia (§1052(b)); marks that are similar to existing marks (§1052(c)); and marks that are merely descriptive or deceptively misdescriptive of the goods or services they are connected with (§1052(e))” (citing 15 U.S.C. § 1052).

³² The latter discussion bears relevance to the trademark rights held by the owner of the “Redskins” marks, where five of the six marks in the cancellation proceedings had attained incontestable status. See *Harjo*, 50 U.S.P.Q.2d (BNA) at 1749, nn. 3-8 (indicating that at the time litigation commenced in *Harjo*, five of the six disputed “Redskins” marks had achieved incontestable status).

In comparison, potential oppositions to marks bearing Native American tribal names, the ultimate issues discussed in this article, would reveal that the “Seminoles” mark has attained incontestable status; however, the recently registered “Fighting Illini” mark has not. See also TESS, *supra*, note 10. In terms of marks on Native American tribal names as monikers and logos, a search of the USPTO trademark database revealed that the “Fighting Illini” mark was recently registered on March 9, 1999. However, the “Seminoles” mark was registered April 3, 1984, granting it the heightened incontestable status. The greater rights granted the “Seminoles” mark may or may not affect an opposing parties’ ability to attack such a mark, bearing a conclusive presumption of validity.

³³ See 15 U.S.C. §§ 1052(a), (b).

³⁴ See Lury, *supra* note 13, at n. 25 (citing Robert P. Merges, et al., *Intellectual Property in the New Technological Age* (Aspen Publishers, Inc. ed. 1997), at 523, 525 and 22-26.).

³⁵ See Keith Aoki, *How the World Dreams Itself to Be American: Reflections on the Relationship Between the Expanding Scope of Trademark Protection and Free Speech*, 17 Loy. L.A. Ent. L.J. 523, 531 (1997).

³⁶ See 15 U.S.C. § 1127 (1994 & Supp. IV 1998) (Construction and Definitions; Intent of Chapter). As applied to this article, the term “trademark” or “mark” is used to identify both “trademarks” (i.e. marks used to identify goods) and “service marks” (i.e. marks used to identify services.) Under the Trademark Act:

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. See *id.*

The term “service mark” means any word, name, or 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 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. 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. See *id.*

See also Black’s Law Dictionary 1038 (1991). Defined, a *trademark* is:

Generally speaking, a distinctive mark of authenticity, through which the products of particular manufacturers or the vendible commodities of particular merchants may be distinguished from those of others. It may consist in any symbol or in any form of words, but, as its office is to point out distinctively the origin or ownership of the articles to which it is affixed, it follows that no sign or form of words can be appropriated as a valid trademark which, from the nature of the fact conveyed by its primary meaning, others may employ with equal truth and with equal right for the same purpose.

A distinctive mark, motto, device, or emblem, which a manufacturer stamps, prints, or otherwise affixes to the goods he produces, so that they may be identified in the market, and their origin vouched for. Exclusive rights to use a trademark are granted by the federal government for ten years, with the possibility of additional ten-year renewal periods. *See also* Lanham Act §§ 8, 9, 15 U.S.C. §§ 1058, 1059 (1994 & Supp. IV 1998).

³⁷ *See id.* at 479. Broadly defined, *goodwill* is:

[t]he favorable consideration shown by the purchasing public to goods or services known to emanate from a particular source. Property of an intangible nature, commonly defined as the expectation of continued public patronage.

See also Harjo, 50 U.S.P.Q.2d (BNA) at 1740. Under the Board’s “Legal Analysis” the administrative judges specifically noted that “[w]e preface our analysis herein by emphasizing the very narrow nature of the question before us. We are determining whether, under the Section 2(a) grounds asserted, the service marks that are the subjects of the six registrations in this proceeding shall remain registered. We do not decide whether the subject marks may be used or whether the word REDKSINS may be used as part of the name of respondent’s professional football team.”

Worth noting is that even though the Board granted the petition to cancel the marks in question in *Harjo*, the team was not inhibited from continuing to use the name. *However*, the irony of a trademark registration cancellation, is that the owners may be faced with an even greater dilemma. Namely, the risk in promoting the *goodwill* of a name that a former owner no longer and may never again be granted exclusive rights in. Following appeal, Pro-Football, Inc., the owner of the [Washington] Redskins team name may not have exclusive rights to the name either, and therefore, may not be eligible for royalty fees from the use of the REDKSINS name, depending on the contractual wording within licensing agreements with licensees. Furthermore, the name would risk dilution, as others may be free to use the name, which could harm the underlying rationale behind trademark protection: promoting the goodwill of the name.

In terms of exclusive trademark rights, being faced with such an opposition presents major issues for trademark owners of such marks. Owners work diligently, through time and dollars, to develop the *goodwill* and respect of a mark, as a direct reflection of the services and/or goods identified.

Even from a monetary stance, the revenue generated from this *goodwill* is substantial, particularly at big-name Division I Universities employing Native American tribal names as monikers and logos, such as the “Seminoles” and “Fighting Illini”. Even at the Division II University of North Dakota, the “geometric Indian symbol alone generates the bulk of the \$60,000 UND receives annually in royalties.” However, it is worth noting that the University of North Dakota allocates “most of [revenue] . . . on diversity-related projects” and that “[c]hallenging or modifying this tradition – and especially when one implies that to support the Fighting Sioux name is to be racist – is to risk damage to the institution and its future. *See* Vorland, *supra* note 5, at 6.

³⁸ This brief overview of trademarks and trademark rights is provided especially to lend the novice Trademark practitioner a greater understanding on how owners of such marks attain such protection and the rights thereby granted. Although the *Harjo* court dismissed all of the affirmative defenses by Respondent-owner of the “Redskins” marks, it is not known whether such rights will be found to exist on appeal. *See* Harjo, 50 U.S.P.Q.2d (BNA) at 1749 (noting that all eleven affirmative defenses were struck).

³⁹ *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 (1995) (citing *McLean v. Fleming*, 96 U.S. 245, 254 (1878)).

⁴⁰ *See* 15 U.S.C. § 1127 (Construction and Definitions; Intent of Chapter). Under the Trademark Act:

The term “use in commerce” means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce-

(1) on goods when –

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

The word “commerce” means all commerce that may lawfully be regulated by Congress.

⁴¹ *See* 15 U.S.C. § 1052(a) (trademarks registrable on principal register).

⁴² *See* Trademark Act of 1946 (codified at 15 U.S.C. § 1052).

⁴³ *See* 15 U.S.C. § 1051; *see also* Jacque Lynne Palmer, *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.: The Sword/Shield Limitations To Trademark Incontestability*, 21 Idaho L. Rev. 303, 304 (1985). Ms. Palmer presents a concise overview of the trademark registration process as she approaches her discussion of incontestability and the *Park ‘N Fly* decision.

⁴⁴ *See* 15 U.S.C. §§ 1052(a), (b) (“Trademarks Registrable on Principal Register; Concurrent Registration). “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 . . .”. Specifically,

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute . . . , and

(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.

See also Arthur R. Miller & Michael H. Davis, *Intellectual Property-Patents, Trademarks, and Copyright*, 241, § 16.5 (2nd ed. 1990) (analyzing the *primary purpose* that trademarks must satisfy for registration on the principal register). “A device . . . that does not *primarily* serve to distinguish and identify the goods, is ineligible for registration.”

⁴⁵ *See* 15 U.S.C. § 1062(a) (1994 & Supp. IV 1998) (“Publication”; “Examination and Publication”).

⁴⁶ *See* 15 U.S.C. § 1063(a) (1994 & Supp. IV 1998) (“Opposition to Registration”). Under section 13 of the Lanham Act, “[a]ny person who believes he would be damaged by registration of a mark on the principal register may . . . file an opposition in the [PTO]. Where no opposition is filed within thirty days after publication in the

Official Gazette, or within an additional thirty days if a written request for extension is filed, or during a greater extension if the Commissioner finds good cause; then the mark is registered.”

⁴⁷ See 15 U.S.C. § 1063(b) (1994 & Supp. IV 1998).

⁴⁸ See 15 U.S.C. § 1057(a) (1994 & Supp. IV 1998) (“Certificate of Registration”; “Issuance and Form”).

⁴⁹ 15 U.S.C. § 1057 (b) (1994 & Supp. IV 1998) (“Certificate as Prima Facie Evidence”).

⁵⁰ See Palmer, *supra* note 43, at 304 (any section 2 grounds).

⁵¹ See *Rules of Practice in Trademark Cases*, § 2.167 (“Affidavit or declaration under section 15, the formalities also required under section 1065” for incontestability). See also Joan L. Dillon, *The Effect of “Incontestability” in Trademark Litigation*, 68 Denv. U. L. Rev. 277 (1991).

⁵² See 15 U.S.C. § 1065 (1994 & Supp. IV 1998). The *incontestability* text of § 1065 reads:

§ 1065. (§ 15) Incontestability of Right to Use Mark Under Certain Conditions

Except on a ground for which application to cancel may be filed at any time under paragraphs (3) and (5) of section 1064 of this title, and except to the extent, if any, to which the use of a mark registered on the principal register infringes a valid right acquired under the law of any State or Territory by use of a mark or trade name continuing from a date prior to the date of registration under this chapter of such registered mark, the right of the registrant to use such registered mark in commerce for the goods or services on or in connection with which such registered mark has been in continuous use for five consecutive years subsequent to the date of such registration and is still in use in commerce, shall be incontestable: *Provided*, That-

(1) there has been no final decision adverse to registrant’s claim of ownership of such mark for such goods or services, or to registrant’s right to register the same or to keep the same on the register; and

(2) there is no proceeding involving said rights pending in the Patent and Trademark Office or in a court and not finally disposed of; and

(3) an affidavit is filed with the Commissioner within one year after the expiration of any such five-year period setting forth those goods or services stated in the registration on or in connection with which such mark has been in continuous use for such five consecutive years and is still in use in commerce, and the other matters specified in paragraphs (1) and (2) of this section; and

(4) no incontestable right shall be acquired in a mark which is the generic name of the goods or services or a portion thereof, for which it is registered.

Subject to the conditions above specified in this section, the incontestable right with reference to a mark registered under this chapter shall apply to a mark registered under the Act of March 3, 1881, or the Act of February 20, 1905, upon the filing of the required affidavit with the Commissioner within one year after the expiration of any period of five consecutive years after the date of publication of a mark under the provisions of subsection (c) of section 1062 of this title.

The Commissioner shall notify any registrant who files the above-prescribed affidavit of the filing thereof.

See also William G. Phelps, *Requirements for Trademark or Service Mark to Become Incontestable Under § 15 of Lanham Act (15 USCS § 1065)*, 116 ALR Fed 615 (1992) (annotating those cases in which courts have discussed what is necessary for a mark to become incontestable under section 15 of the Lanham Act).

⁵³ See *Wilhelm Pudenz v. Littlefuse, Inc.*, 177 F.3d 1204, 1211 (11th Cir. 1999) (citing *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, 198, (1985)) (alteration in original). See also *Shakespeare Co. v. Silstar Corp. of America, Inc.*, 9 F.3d 1091, 1104 (4th Cir. 1993) (Niemeyer, J., dissenting) (citing same passage).

⁵⁴ See *Dickinson*, *supra* note 6, at 12 (again, it is worth noting that *Harjo* is on appeal to the District Court for the District of Columbia). See also *Shakespeare Co.*, 9 F.3d at 1104 (Niemeyer, J., dissenting). In explaining the status of incontestable trademarks, the court clarified:

This property metaphor is a common one, with incontestability often being compared to adverse possession - both establish title through lack of opposition. The failure to contest ownership waives an attack on title to real property; it does not, however, create property in that which is not subject to ownership. By the same token, the fact that title in a trademark is quieted does not imply that the value of that title has somehow increased. If title to a trademark was useless at the outset, as is title to a trademark in a functional feature, it remains so even if conclusively established.

See also *Phelps*, *supra* note 52 (citing *Park ‘N Fly, Inc. v. Dollar Park and Fly, Inc.*, 469 U.S. 189, (1985)). Justice Stevens, dissenting, expressed that “the term “incontestable” as used in trademark law is somewhat confusing and misleading because the applicable statutes expressly identify more than 20 situations in which an allegedly incontestable mark may be lawfully infringed.”

⁵⁵ Referred to as the “TLT Act Technical Revisions”.

⁵⁶ See 15 U.S.C. § 1064(3) (1994 & Supp. IV 1998) (“Cancellation of Registration”). After meeting the requirements for incontestability, a petition to cancel a registration of a mark “at any time”, may be filed by any person who believes that he *is or will be damaged* by the registration of a mark on the principal register. In summary, a cancellation proceeding may be asserted “[a]t any time” under section 14 if the registered mark:

1. Becomes the generic name for the goods or services, or a portion thereof, for which it is registered, or
2. Is functional, or
3. Has become abandoned, or
4. Was obtained fraudulently, or
5. Was obtained contrary to the provisions of section 1054 of this title (certification marks which are used to make false representations), or
6. *Was obtained contrary to subsection (a), (b), or (c) of section 1052* (those comprising immoral, deceptive, or scandalous matter, or ...*disparaging... or those consisting of the flag or coat of arms or other insignia of any nation.*) (emphasis added), or
7. Was obtained contrary to similar prohibitory provisions of such prior Acts for a registration under such Acts, or
8. Is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used.

See also *Sovereign Order of Saint John of Jerusalem, Inc. v. Grady*, 119 F.3d 1236, (6th Cir. 1997) (finding that collective trademark “Sovereign Order of Saint John of Jerusalem” was *incontestable precluded finding of invalidity on grounds* that trademark holder did not exercise legitimate control over mark when it registered mark, *that name falsely suggested connection with institutions, beliefs, or national symbols [section 2(a)]*, *that mark impermissibly embodied insignia of foreign nation [section 2(b)]*, that name was generic name of a religion, or that holder could not be owner of common law trademarks which embodied name of geographic location or patron saint. See generally *Dillon*, *supra* note 58, at 279 (reciting that a “registration may be cancelled at any time if it is obtained contrary to the provisions of the Trademark Act or the mark becomes a generic name”).

Number six (6) above, and cases such as *Sovereign Order of Saint John*, take on greater relevance in the discussion in Section III, *infra*, on the Study of “*Official Insignia of Native American Tribes*”. Primarily, because of the debate on whether Native American tribal names could be considered official tribal insignia. This leaves the question of

whether section 2(b) would be revised to include Tribal insignia, and whether it would apply retroactively to cancel registered tribal insignia.

⁵⁷ See 15 U.S.C. § 1115(b) (1994 & Supp. IV 1998) (“Incontestability Defenses”) (the statutory language also refers to the defenses collectively as *or defects*). See also 5 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 32.149, at 32-213 (rel. no. 10, June 1999) (reciting the nine statutory exceptions to incontestability, under section 33 (b)). McCarthy notes that incontestable marks are thus subject to the following defenses and defects:

1. Fraud in obtaining the registration or the status of incontestability;
2. Abandonment;
3. Use of the mark to misrepresent the source;
4. “Fair use” of the mark;
5. Limited territory defense of an intermediate junior user;
6. Prior registration of defendant;
7. Use of the mark to violate antitrust law;
8. Functional; or
9. Equitable defenses such as laches, estoppel and acquiescence.

⁵⁸ See 15 U.S.C. §§ 1064(3), 1115(b) (“Cancellation of Registration”, “Incontestability Defenses”). As noted *supra*, more liberal grounds for cancellation of (and defenses to) a mark listed on the principal register less than five years exist than do solely against incontestable marks. Those listed here, merely apply to either. Since many of the marks in question in this article have attained incontestable status, the focus is geared toward cancellation measures and defenses against those marks.

⁵⁹ 15 U.S.C. § 1064(3) (noting specifically the sixth ground for “Cancellation of Registration”).

⁶⁰ 15 U.S.C. § 1052(b) (trademarks registrable on principal register): see also *TLT Act*, *supra* note 8; see also Dickinson, *supra* note 6.

⁶¹ See *id.* Section 2(b) “does not require either disparagement or false connection [as a section 2(a) rejection would; i.e. showing of something greater] since it simply bars the use of such symbols”. See also Steven H. Bazerman and Jason M. Drangel, *Guide to Registering Trademarks*, Aspen Law & Business (1999) at § 2-13, 9-84 (citing T.M.E.P. § 1204). Yet, there are ways to deal with section 2(a) and 2(b) registration cancellations. These author’s note:

Section 2(b) is an absolute bar to registration. Thus, the primary response is to show that the mark, in whole or in part, is not a prohibited flag, coat-of-arms, or other insignia of the United States, state or municipality, or foreign nation. For example, a symbol of an agency is not protected. *Id.* (citing *U.S. Navy v. United States Mfg. Co.*, 2 U.S.P.Q.2d (BNA) 1254 (TTAB 1987) (“Clearly under this test the initials of the Marine Corps, which is part of the Navy, which itself is within the Department of Defense, cannot be construed as an ‘other insignia of the United States’ under Section 2(b) of the Lanham Act.”); *In re United States Dep’t of the Interior*, 142 U.S.P.Q. (BNA) 506, 507 (TTAB 1964) (park service logo is not protectable under Section 2(b) since it is only used to identify a service or facility of the government, not the national authority as a whole).

Thus, the applicant can show that the symbol or letters identify people and things associated with a particular agency or department, instead of representing the authority of the government or the nation as a whole. *Id.* (citing T.M.E.P. § 1204).

⁶² Lury, *supra* note 13, at 152-153 (citations omitted).

⁶³ *Id.* “Of course, this is not exactly true since trademark law allows others to use the same mark, provided the mark is not ‘famous,’ as long as consumers will not be confused as to the source.” *Id.* at n. 66 (citing Richard A. Guest, *Intellectual Property Rights and Native American Tribes*, 20 Am. Indian L. Rev. 111, 129 (1995-1996)

("Generally, the Lanham Act simply does not preclude others from using the same tribal name in association with their products as long as there is no confusion to the public as to source").

⁶⁴ *Id.* at n. 67. (adding that "Native Americans clearly do not use their sacred marks in commerce, nor is it likely that they use their official insignia on goods or services; therefore, it is questionable that they would even be able to obtain trademark registration and protection for their symbols and insignia should trademark law remain unchanged").

⁶⁵ Dickinson, *supra* note 6; *see also*, Lury, *supra* note 13, at 146. For those opposing such trademark use:

Native Americans believe that their culture and existence are threatened by others' incorporation of their cultural property, because others do not understand the significance and meanings of many objects that Native Americans hold sacred . . . Additionally, the pervasive use of Native American cultural symbols and images by others often serves to portray Native Americans as a dying or dead culture, rather than as a living and growing culture. This in turn may cause some Native Americans, particularly children, to feel as if they are "dead" or at least that they are somehow an inferior class.

Id. (citing Jonathan Drimmer, *Hate Property: A Substantive Limitation For America's Cultural Property Laws*, 65 Tenn. L. Rev. 691, 726 (1998)) (alteration in original) (citations omitted).

Multiculturalist theorists note that for an individual, a connection to a heritage is necessary in shaping cultural identity. In contrast, denying access to such a heritage threatens to foster "false consciousness," a phenomenon whereby a minority group member unknowingly accepts the unfavorable stereotypes traditionally imposed on that group by a dominant class and thereby aids in her own subordination.

Id. at n. 51 (citing Drimmer, at 727).

⁶⁶ Bazerman & Drangel, *supra* note 61, at n. 429 (citing T.M.E.P. §1204); *see also* In re United Dep't of the Interior, 142 U.S.P.Q. 506 (TTAB 1964) (Section 2(b) restricted to trademarks of the same classes as flags and coats of arms, such as Great Seal of the United States, Presidential Seal, and seals of government departments, however, seals that identify services or facilities of the government, such as The National Park Service are not protected by this section). The authors also noted in their 1999 text that "[h]owever, the PTO is currently undertaking a study of a variety of issues surrounding protection of official insignia of federally and/or state recognized Native American tribes." *Id.* at n. 429 (citing Fed. Reg., Dec. 29, 1998 (Vol. 63, No. 249)).

⁶⁷ Dickinson, *supra* note 6; *see also*, Lury, *supra* note 13, at 154-155. Lury noted that currently:

The only example of an official tribal insignia (that refers to itself as such) is [] the Yankton Sioux Tribe. It is of a design that was adopted by the tribe in 1975 and includes the quote: "Land of the Friendly People of the Seven Council Fires," as well as pictures of a pipe, a zigzag, a teepee and the colors red and yellow.

Id. (alteration in original). Yankton Sioux Tribe, South Dakota (visited July 10, 1999) <<http://lewisandclarktrail.com/sponsors/yanktonsioux/sect1.htm>>. "The Yankton Sioux Tribe is from South Dakota. This is the only specific official tribal insignia found by the author." *Id.* at n. 74.

⁶⁸ *See* Lury, *supra* note 13, at 139. Lury's analysis "conclude[d] that the changes section 302 propose[d] should be made, but that this should be viewed only as an initial step to changing United States trademark law to better reflect Native Americans' and others' concerns." *Id.*

⁶⁹ *See generally* Dickinson, *supra* note 6 (summarizing the view taken by some opposers to the trademark use of tribal names and insignia).

⁷⁰ *See generally* Lury, *supra* note 13. The issue addressed in Ms. Lury's article is on the "religious symbol" as official insignia; whereas, this Article looks at the broader affect on all registered tribal names, particularly athletic monikers and logos, if section 2(b) were to be revised in any manner after the Study.

Published just prior to the release of the Study results, Ms. Lury's law review article analyzed the issue of "whether the proposed change would specifically address Senator Bingamen's and the Zia Pueblo's attempt to prevent religious symbols from being registered as trademarks," as "official insignia".

⁷¹ 15 U.S.C. § 1052(b); *see also* Dickinson, *supra* note 6; and Lury, *supra* note 13, at 139. Lury advocated that "[i]t seems that the change must be implemented retrospectively in order to ensure protection of all official tribal insignia." As will be shown, the Office appears to have taken a different stance.

⁷² TLT Act § 302, *supra* note 8.

⁷³ *Id.* (referring to the two primary questions from the Study lending the greatest support to the issues raised in Section IV). Where appropriate other aspects of the Study are also included.

⁷⁴ TLT Act § 302, *supra* note 8.

⁷⁵ *See id.*; *see also* Wilhelm Pudenz v. Littlefuse, Inc., 177 F.3d 1204, 1208 (11th Cir.1999) (noting that the primary purpose of this legislation was to harmonize some aspects of the Lanham Act with foreign trademark laws, in order to carry out the provisions of international trademark treaties).

⁷⁶ TLT Act § 302, *supra* note 8 (on October 30, 1998, President Clinton signed Congress' Title III of Public Law 105-330). *See also* 1 McCarthy, *supra* note 57, at § 25:67.1 (4th Ed. 1999) (listing the specific issues to be addressed in the Study under Section 302 of P.L. 105-330, *Official Insignia of Native American Tribes*, which was not codified as part of the Lanham Act); *see also* Dickinson, *supra* note 6, at 45. Although the Study was framed in concern for protection of official insignia of Native American tribes relevant to the Indian Arts and Crafts Board Act (and Indian produced products and protecting the intellectual property rights therein, namely trademark rights), as amended in 1990, the issues discussed overlap into this discussion on Native American tribal names as monikers and logos.

As one of the major supporters of the bill, the International Trademark Association (*INTA*), lobbied that the TLT Act would "streamline and harmonize trademark office procedures, thus enabling U.S. Trademark owners to focus on the defense and protection of marks." David Stimson, *Summary Testimony by the International Trademark Association In Support of the Madrid Protocol and Trademark Law Treaty-Committee on the Judiciary (Stimson Statement)*, 1, ¶ 1 (May 27, 1997) <http://www.house.gov/judiciary/4161.htm> (*INTA's* advancement of the TLT legislation generally; quoting primary objectives behind legislation).

Arguably, the TLT Act constitutes the most significant revision of the Lanham Act since the Trademark Law Revision Act (*TLRA*) of 1988, a decade earlier. *See generally* Todd B. Carver, *What is the Impact of the Trademark Law Revision Act of 1988*, 16:1 U. Dayton L.R., 129 (1990) (summarizing the history and background of American trademark law and highlighting the major provisions of the *TLRA*, as compared to previous law).

⁷⁷ *See* Lury, *supra* note 13, at n. 35. Ms. Lury noted that:

In offering this amendment, Bingamen explained that many tribal insignias have significance as religious symbols and deserve protection from being used as trademarks. As an example, he noted that New Mexico's Zia Pueblo hold the "sun symbol" that appears on the state flag as sacred, and explained that it would be sacrilegious for the [Patent and Trademark Office] to grant trademark protection for this symbol. However, Bingamen reported that many businesses have tried to include this symbol in trademark applications, forcing the Pueblo to go to the trouble and expense to oppose registration.

Id. (citing Patent and Trademark Office: PTO Seeks Comments on Barring Registration of Native American Symbols, Trademarks for Indian Symbols, in *Pat. Trademark & Copyright J. (BNA)* at 183 (Jan. 7, 1999)).

⁷⁹ *See id.* at 145. "Even New Mexico's State Legislature recognizes that the Sun Symbol belongs to the Zia Pueblo, as evidenced by its salute, 'I salute the flag of the State of New Mexico, the Zia symbol of perfect friendship among united cultures.'" *Id.* (citing <http://www.indianpueblo.org/zia.html> (visited July 10, 1999)).

⁸⁰ *See id.* As Ms. Lury began, this is the initial question to ask before analyzing the subsequent issues in this Article.

⁸¹ *See* TLT Act § 302, *supra* note 8.

§ 302. *Official Insignia of Native Indian Tribes*

(a) IN GENERAL. – The Commissioner of Patents and Trademarks shall study the issues surrounding the protection of the official insignia of federally and State recognized Native American tribes. The study shall address 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 –

(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.

(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.

(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.

Following seven months of research, the results of the Study were released on November 29, 1999. This article focuses particularly on Study questions three (3) and five (5).

⁸² *See* Dickinson, *supra* note 6, at 17.

⁸³ *See id.*

⁸⁴ *See id.* at 29; *see also* Lury, *supra* note 13, at nn. 61-62.

Some [Native Americans] . . . want to use intellectual property laws to prevent what may be characterized as a cultural or psychological harm caused by the unauthorized use of their art. They see intellectual property laws as offering a means to control the circulation of their art. They want to be able to restrict its dissemination and, in some cases, prevent dissemination altogether.

Christine Haight Farley, *Protecting Folklore of Indigenous Peoples: Is Intellectual Property the Answer?*, 30 Conn. L. Rev. 1, 14-15 (1997).

Some [Native Americans] want to be able to benefit from the economic rights provided by intellectual property laws. They want to be compensated for their contribution to the artwork through licensing, and

they want to exclude non-[Native American] competitors from the market by preventing unauthentic products from being marketed as made by [Native Americans].

Id. at 14.

⁸⁵ See Dickinson, *supra* note 6, at 29. As will be discussed *infra*, in 1994 the Trademark Office began instituting measures to prevent the registration of possible Native American tribal insignia (i.e. flags, coats of arms). However, this only applied to those insignia that Native American tribes have informed the Office constitutes tribal insignia. These measures were not instituted against Native American tribal names in and of themselves.

⁸⁶ TLT Act § 302, *supra* note 8 (question three (3) within the study); see also Dickinson, *supra* note 6. “For example, how should the PTO define “official insignia” of a federally or State recognized Native American tribe?” *Id.* at 9.

⁸⁷ 15 U.S.C. § 1052(b); see also T.M.E.P. § 1402.01; and Bazerman & Drangel, *supra* note 61, at n. 428.

Article 6 of the Paris Convention [for the Protection of Industrial Property] prohibits the unauthorized use, as a trademark or as an element of a trademark, armor, bearings, flags, and other state emblems of the countries. Each member country communicates the list of emblems, official signs, and hallmarks it wishes to protect and all subsequent modifications of its list to the International Bureau of Intellectual Property. The collection of such country lists is extensive. A set can be found in the PTO Search Library. *Id.*

⁸⁸ 15 U.S.C. § 1052(b) (trademarks registrable on Principal Register); see also WEBSTER’S NINTH NEW COLLEGIATE DICTIONARY 626 (1990). “Insignia” is defined as: “1: a badge of authority or honor: EMBLEM 2: a distinguishing mark or sign.” *Id.* (emphasis added).

⁸⁹ See Dickinson, *supra* note 6, at 17.

⁹⁰ See *id.*

⁹¹ See *id.* (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 . . . The Office sent out letters to more than 500 federally recognized tribes. Approximately 10 responses were received.” *Id.* at 14.

However, the PTO does take steps to prevent others from registering trademarks which give a ‘false impression’ of the true origin of the goods or services. Section 2(a) [discussed in Section III, *supra*] 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. The analysis as to whether a registered tribal name may be cancelled, as disparaging, was addressed in Section III. *Id.* at 34.

Since 1994, many applications have been refused as “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.” *Id.* at 14 (noting two registration refusals based on false association with the Pueblo of Zia and possible disparagement of the tribe). Additionally, third parties may challenge registrations through 1) the “Letter of Protest”; 2) opposition; or 3) cancellation proceedings. *Id.* at 15.

⁹² 15 U.S.C. § 1052(b).

⁹³ See Dickinson, *supra* note 6, at 18. Note that insignia may either be formally or informally adopted. As long as such emblem or device represents *governmental authority*, it may constitute “official insignia.” See *id.* at 20. Thus, for tribal insignia to be ‘insignia’ under section 2(b), it must be intricately connected to the tribe’s governmental authority. Section 1052(b) of the Lanham Act specifically concerns governmental insignia. See generally *Trademark Manual of Examining Procedure, Section 1203: Refusal on Basis of Government Insignia*, 104 (1977).

⁹⁴ Dickinson, *supra* note 6, at 18.

⁹⁵ *See id.*

⁹⁶ In re United States Department of the Interior, 142 U.S.P.Q. (BNA) 506, 507 (TTAB 1964). The Board held that a 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 was not to be an insignia of the United States. The opinion added 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. *See also* Liberty Mutual Insurance Co. v. Liberty Insurance Co. of Texas, 185 F. Supp. 895, 908 (E.D. Ark. 1960) (finding that Statute of Liberty is not part of the insignia of the United States). The Court noted that the “*Act, however, does not put national symbols on par with the flag, coat of arms, or other insignia of the United States, which may not in any event be made the subject matter of a trade or service mark.*” *Id.* (emphasis added).

⁹⁷ U.S. Navy v. United States Mfg. Co., 2 U.S.P.Q.2d (BNA) 1254, 1256 (TTAB 1987). Under the test for “other insignia of the United States”, the Board applied the “*eiusdem generis*” rule of construction to restrictively include only insignia of the same general class as the flag or coats of arms of the United States. The Board opined that 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.

⁹⁸ Dickinson, *supra* note 6, at 16. It was also suggested that: “(2) phrases; and (3) designs used without words”, should be included as “official insignia.” *Id.* (alteration in original). Another significant group of respondents indicated that “official insignia” should be limited to words (tribal names or other names) 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.

⁹⁹ *See id.* at 30 (within section two (2) of the Study).

¹⁰⁰ *Id.* (citing from section “Trademark Owners/Trade Organizations”). Under section 2(b), grounds for cancellation of registered marks bearing such tribal names could be asserted if such marks constituted insignia, which would then be ineligible for registration.

¹⁰¹ *See id.*

¹⁰² *See id.*

¹⁰³ *Id.* at 25 (“See, for example, U.S. Registration No. 1,014,221 (“VIE DE FRANCE”)”).

¹⁰⁴ *See id.*

¹⁰⁵ *See id.* (analyzing tribal names, based on Study findings).

¹⁰⁶ *Id.*

¹⁰⁷ *See id.* at 25-26 (resulting from developments in the English language).

¹⁰⁸ *See id.* at 26. “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 (noting 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.”” *Id.*

¹⁰⁹ *See supra* Section II discussing the disparagement issue (section 2(a) and *Harjo*), in the context of registered Native American tribal names.

¹¹⁰ Dickinson, *supra* note 6, at 26.

¹¹¹ *Id.* at 20.

¹¹² *See generally id.*

¹¹³ *See id.* at 16. Additionally, the Study noted that “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.” *Id.*

¹¹⁴ *Id.* at 15.

¹¹⁵ *Id.* at 24.

¹¹⁶ *See id.* at 25.

¹¹⁷ *See generally id.* at 18.

¹¹⁸ *See id.* Based on the interpretation of section 2(b) from relevant caselaw. *See In re United States Department of the Interior*, 142 U.S.P.Q. (BNA) 506, 507 (TTAB 1964); *U.S. Navy v. United States Mfg. Co.*, 2 U.S.P.Q.2d (BNA) 1254, 1256 (TTAB 1987).

¹¹⁹ *See Dickinson, supra* note 6, at 25.

¹²⁰ *See id.*

¹²¹ *See id.*

¹²² *See id.*

¹²³ *Id.*

¹²⁴ *See id.* This would pertain to tribal names not having alternative meanings in other languages, where the name may be eligible for Trademark registration based on the alternative meaning of the word.

¹²⁵ *See generally id.*

¹²⁶ *See generally id.*

¹²⁷ *See id.* However, this would mean that the registered trademark “Seminole” would exist in contradiction to “Seminole” as a section 2(b) insignia of the Seminole tribe.

¹²⁸ *See id.*

¹²⁹ *See id.*

¹³⁰ *See id.* at 44. Relevant to this analysis, it is worth noting that the Commissioner ultimately concluded that:

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1. Existing trademark law [section 2(a)] 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. *Id.*

¹³¹ *See id.*

¹³² *See id.* Based on analysis of the Study.

¹³³ *See id.* Assuming the tribal names did not have meanings in other languages.

¹³⁴ *See id.*

¹³⁵ 15 U.S.C. § 1052(b).

¹³⁶ *See Dickinson, supra* note 6, at 25 (noting the Commissioner did not recommend that section 2(b) be revised to include the proposed definition). However, if found eligible, registration of “official insignia” would be subject to all the statutory requirements of the Trademark Act, 15 U.S.C. § 1051 *et seq.* *See also, Lury, supra* note 13, at 154:

Moreover, current trademark law essentially prevents Native Americans from registering their insignia and symbols because United States trademark law recognizes the individual and provides ownership to the individual, while Native Americans hold their insignia and symbols as communal property whereby every member owns it, but no individual owns it exclusively. Therefore, the proposed change offers Native American tribes an opportunity to regain their communal share of the insignia.

Id. at n. 156. “[T]he things that we call intellectual property are really rights to do certain things, to authorize others to do certain things, and to prevent others from doing certain things.” *Id.* at n. 76. (citing Richard A. Guest, *Intellectual Property Rights and Native American Tribes*, 20 Am. Indian L. Rev. 111, 113 (1995-1996)). Lury goes on to say “Native American tribes are communal organizations.” *Id.* at 152. “[T]he United States has approached the concerns of Native Americans as group concerns.” *Id.* at n. 67 (citing Dougherty, *supra* note 13, at 363). Native American tribes “often view their cultural artifacts as communal property which cannot be sold by individual tribal members.” *Id.* (citing Christopher S. Byrne, *Chilkat Indian Tribe v. Johnson and NAGPRA: Have We Finally Recognized Communal Property Rights in Cultural Objects*, 8 J. Env’tl. L. & Litig. 109, 111 (1993)).

The distinctive characteristic of communal property is that every member of the community is an owner of it as such. He does not take as heir, or purchaser, or grantee; if he dies his right of property does not descend; if he removes from the community it expires; if he wishes to dispose of it he has nothing which he can convey; and yet he has a right of property . . . as perfect as that of any other person; and his children after him will enjoy all that he enjoyed, not as heirs but as communal owners.

Id. at n. 67 (citing Byrne at 123) (alteration in original) (citations omitted). Lury adds “[t]hey believe that their property belongs to the group and not to an individual, as trademark law presumes. Therefore, there is a concern as to whom the trademark registration would be registered and how the trademark would remain a group right” *Id.* at 152. “There is a possibility that “if Native Americans are able to claim group rights in contexts when cultural survival is at stake, they will be able to exert control over their cultural symbols and prevent the devaluation and depletion of their culture.” *Id.* at n. 68 (citing Dougherty, *supra* note 13, at 376).

¹³⁷ *See id.*; *see also Lury, supra* note 13, at 154 (“However, Native Americans will also be prevented from using the insignia as trademarks and thus will lose any economic value that they could otherwise claim.”)

¹³⁸ *See Dickinson, supra* note 6, at 14.

¹³⁹ *Id.*

¹⁴⁰ *See supra* Section II.

¹⁴¹ See Dickinson, *supra* note 6, at 42-43 (“[t]he 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 [as trademarks], although they are free to license use of the official insignia”).

¹⁴² See *id.* at 146.

¹⁴³ See *id.* at 125.

¹⁴⁴ See *id.* at 16.

¹⁴⁵ See *id.* at 25. Assuming that such tribal names did not have alternative meanings capable of be registered.

¹⁴⁶ See *id.*; see also Lury, *supra* note 13, at 154. Lury expressed her view that:

Additionally, the change, especially if applied retrospectively, will enable Native Americans to regain some control over their identity and culture and will cause public perception to shift, thus accepting Native Americans as living peoples.

Id. “In North American commercial culture, imagery of Indians and the aura of ‘Indianness’ is pervasive, but living human peoples with Native ancestry are treated as dead, dying, vanishing or victimized, and in need of others to speak on their behalf.” *Id.* at n. 73. (citing Rosemary J. Coombe, *The Properties of Culture and the Politics of Possessing Identity: Native Claims in the Cultural Appropriation Controversy*, 6 Can. J.L. & Juris. 249 (1993) (originally printed by Richard Handler, *Who Owns the Past? History, Cultural Property, and the Logic of Possessive Individualism*, in *The Politics of Culture*, at 66 (Brett Williams ed. 1991)). “This perception may change if section 302 is implemented.” *Id.*

¹⁴⁷ Dickinson, *supra* note 6, at 43; see also TLT Act § 302, *supra* note 8 (question five (5) within the study). The Study also noted other relevant questions under this issue: “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 businesses and the public if applied retroactively)?” See Dickinson, *supra* note 6, at 11.

¹⁴⁸ The issue of cancellation under section 2(b) becomes even more complicated if the marks have been registered for more than five years (identified as incontestable trademarks), as incontestable marks are deemed to have only limited grounds for cancellation. Specifically, once attained, such marks are no longer seen as descriptive, and a presumption exists, albeit rebuttable, that such marks have attained secondary meaning. This is a lengthy analysis unto itself; however, and numerous sources exist which analyze the affects of trademark incontestability. See 1 McCarthy, *supra* note 57, at § 32.142 (4th ed. 1999). See generally Maury Audet, *Functionality Unanimously Trumps Incontestability After Trademark Law Treaty And Wilhelm Pudenz v. Littlefuse, Inc.: Next Replace Misnomer ‘Incontestable’ With ‘Conclusive’*, 40 IDEA: J of Law & Tech 473 (2000).

¹⁴⁹ Dickinson, *supra* note 6, at 43.

¹⁵⁰ This would leave the former owner with the dilemma of whether to continue to use the name in commerce, where exclusive rights to the name no longer exist, thereby risking dilution and tainted goodwill to the identified goods and/or services. See also *supra* Section II, discussing the relevance of goodwill.

¹⁵¹ Dickinson, *supra* note 6 at 25-26.

¹⁵² *Id.* See also, Lury, *supra* note 13, at 155. Lury acknowledged that if such a change occurred, “[a]dditionally, the Patent and Trademark Office should allow continued use of the mark for a reasonable period of time, thus allowing businesses to change their marks while militating against the suggested economic harms they might suffer.” *Id.*

¹⁵³ See generally Dickinson, *supra* note 6. See also Lury, *supra* note 13, at 153. Lury expressed that:

Apart from the harms that Native Americans may experience if section 302's proposal is not implemented, others might be harmed should the law change. People and companies that currently use an official tribal insignia for their goods or services would suffer an economic harm because they may be required to change their trademark. These people and companies would have to endure the costs of litigation, of finding a new trademark and of educating the public as to their new trademark. This would also be true of those people who had intended to use an official tribal insignia and had already spent money on research, planning, developing and marketing to that effect. This may be of particular concern to those people and businesses who have spent great sums of money on advertising, promotion, and product or service labeling, as well as to those who have acquired customer recognition as producing a reliable and good product or service. For instance, many businesses in New Mexico use the Zia Pueblo's Sun Symbol as a trademark. If the Sun Symbol were to become barred from registration, then all of these businesses would stand to suffer. Nevertheless, although others may suffer economic harms, these harms seem minimal as compared to those that Native Americans may suffer should current trademark law remain unchanged. *Id.*

¹⁵⁴ See Dickinson, *supra* note 6 at 26. However, this would not prevent a party from bringing a cancellation suit against the owner, possibly even under Lanham Act § 2(a), based on disparagement. See also *supra* Section II.

¹⁵⁵ See generally Dickinson, *supra* note 6 at 26.

¹⁵⁶ *Id.*

¹⁵⁷ See Lury, *supra* note 13, at 154.

The effects of changing section 1052(b) will vary depending on whether the change is applied prospectively or retrospectively. If the change is applied retrospectively, then the Patent and Trademark Office may be bombarded with canceling trademarks that use official tribal insignia. Furthermore, people and companies who have trademarks that incorporate official tribal insignia will have to adopt a new trademark. On the other hand, if the change is applied prospectively, then trademarks using official tribal insignia that are already in use will remain, thus limiting the effectiveness of the amended law.

Id. . Lury goes on to opine that “[i]t seems that the change must be implemented retrospectively in order to ensure protection of all official tribal insignia.” *Id.* at 7.

¹⁵⁸ See Dickinson, *supra* note 6, at 41. “After considering all of the comments received, the PTO believes that existing principles of trademark law [section 2(a)] are adequate to adjudicate infringement issues.” The Study summarized in light of the current policing under section 2(a), rather than section 2(b), that:

The PTO understands the concerns expressed and believes there is a relatively simple solution as far as Federal registration 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.

Id. at 38. However, as the opposition argues, this fails to deal with those marks currently registered.

¹⁵⁹ *Id.* at 40-41 (alteration in original). The Commissioner noted, with potential relevance to the tribal names discussed in this Article, that “[i]t 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”” *Id.*

¹⁶⁰ 15 U.S.C. § 1052(b).

¹⁶¹ Dickinson, *supra* note 6, at 32-33 (noting that the U.S. is a member of the Paris Convention for the Protection of Industrial Property, as revised at Stockholm on July 14, 1967).

¹⁶² *Id.*

¹⁶³ *See id.* at 17, 33 (citing E.O. 13084, 25 U.S.C. § 71).

¹⁶⁴ *Id.* at 33-34.

¹⁶⁵ *See id.* at 34. “The issue of notice would be addressed by requiring that tribes notify their official insignia to the PTO.” *Id.*

¹⁶⁶ *See* Bazerman & Drangel, *supra* note 61, at 9-85.

¹⁶⁷ 2 U.S.P.Q.2d (BNA) 1254, 1257 (TTAB 1987).

¹⁶⁸ 10 U.S.C. § 7881.

¹⁶⁹ *U.S. Navy*, 2 U.S.P.Q.2d (BNA) 1254 (TTAB 1987).

¹⁷⁰ Dickinson, *supra* note 6, at 21 (citing *In re Waltham Watch Co.*, 179 U.S.P.Q. (BNA) 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.”)).

¹⁷¹ *See* Bazerman & Drangel, *supra* note 61, at 9-84.

¹⁷² *Id.* at 9-84, 85 (citations omitted). “Whether or not a simulation exists in a proceeding of this character must necessarily be one of first impression gathered from a view of such mark without a careful analysis and side-by-side comparison with the Coat of Arms or Great Seal of the United States.”).

¹⁷³ *See* Dickinson, *supra* note 6, at 21-22 (citing *Knorr-Nahrmittel A.G. v. Havland International, Inc.*, 206 U.S.P.Q. (BNA) 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 U.S.P.Q. (BNA) 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 U.S.P.Q. (BNA) 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 the shield of applicant’s mark differed substantially from those on the seal in both appearance and manner of display)).

¹⁷⁴ *Id.* at 45-46. The Commissioner noted that:

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 tribe. *The comments and study made . . . clear [that] . . . [v]ery few 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. Id. (alteration in original) (emphasis added); *see also supra* Section III.

¹⁷⁵ *See generally* Dickinson, *supra* note 6.

¹⁷⁶ *See id.* at 45-46.

¹⁷⁷ *See id.* at 46. The Commissioner concluded by noting assuring:

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. *Id.* It is worth recognizing that future input to, or reassessment of, the Study may or may not affect the foregoing analysis in the context of section 2(b).

¹⁷⁸ *See* Dickinson, *supra* note 6. *See also* 15 U.S.C. § 1052(b); *see also* TLT Act, *supra* note 8, at § 302.

¹⁷⁹ *See* Dickinson, *supra* note 6, at 25 (considering the interpretation of what may constitute “or other emblem or device”; the Study noted that “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”)”).

¹⁸⁰ *See id.* The definition: “as adopted by tribal resolution and notified to the U.S. Patent and Trademark Office.”

¹⁸¹ *See id.* Pending that such a revision to section 2(b) applied prospectively, currently registered Native American tribal names would remain registered.

¹⁸² Dickinson, *supra* note 6, at 24. Based on the Study comments, relevant caselaw, and present terminology in section 2(b).

¹⁸³ *See generally id.*

¹⁸⁴ *See id.*

¹⁸⁵ *See id.*; *see also* Lury, *supra* note 13.

¹⁸⁶ *See* Dickinson, *supra* note 6, at 43.

¹⁸⁷ This would pertain to tribal names not having meaning in other languages. If there were tribal names with alternative meanings, trademark registration could still possibly exist for those seeking registration under the alternative meaning of the word, which is also identified as a tribal name.

¹⁸⁸ *See* Dickinson, *supra* note 6, at 43.

¹⁸⁹ *See id.*

¹⁹⁰ *See id.*

¹⁹¹ 15 U.S.C. § 1052(b).

¹⁹² Analysis on these grounds has been conducted by numerous scholars, of which this Article does not address or opine as to the conclusions drawn. The debate on actual ‘use’ of tribal names, rather than the trademark rights,

hinges more on Constitutional issues (i.e. First Amendment rights). However, the trademark and Constitutional debates are not mutually exclusive, and quite possibly, insights and answers into the ultimate issues raised may lend support to the alternative body of law.