April 30, 1999
Office of Legislative and International Affairs
U.S. Patent and Trademark Office
2121 Crystal Drive, Suite 902
Arlington, VA 22202

Attn: Eleanor K. Meltzer, Attorney-Advisor

Subject: Response to Request for Comments on PL 105-330, 64 FR 13004, March 16, 1999, Official Insignia of Native American Tribes

Ms. Meltzer:

The Bristol Bay Native Association is a tribal organization representing 30 federally recognized tribes and two tribes seeking federal recognition in the Bristol Bay Region of Southwest Alaska. We submit the following response to your request for comments.

Sincerely,
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Enclosure: Comments

General: Each step along the way, drafters must honor the government-to-government relationship between the U.S. Government and the Native American tribes. See President Clinton's Policy Memorandum of April 29, 1994. The U.S. Government would not

attempt to tell a state what it could have for its official "Seal," nor attempt to tell the sovereign nation of, let's say, Brazil how it could design its flag. When drafting or reviewing any regulations concerning the "Official Insignia" of Native American tribes, please mentally insert the name of a state or foreign nation to see whether the statement honors the government-to-government relationship.

(1) The Definition of "Official Insignia." The PTO definition, if any, of "Official Insignia" must be very broad to recognize the right of each tribe to design/designate its own "Official Insignia." Quite simply, a tribe's "Official Insignia" is whatever the tribe says it is! For example,

"The 'Official Insignia' of each Native American tribe is that symbol or collection of symbols which the tribe recognizes as identifying the tribe."

(2) Establishing and Maintaining a List of Official Insignia. According to 15 U.S.C. 1052(b), the PTO is already obligated to refuse to register the "flag", the "coat of arms" and any "other insignia" of any state or municipality or of any foreign nation. There are 556 federally recognized tribes. While this may seem burdensome, compare it to 50 states, thousands of municipalities, and hundreds of foreign nations. The government-to-government relationship obligates the PTO to expend at least as much effort on behalf of the tribes as it does on behalf of the states and foreign nations, and to expend more effort than it expends on behalf of municipalities. The act of establishing and maintaining a list implies that parties who attempt to register trademarks not on the list would somehow be protected or have priority over a tribe's later claim. This must not happen.

Establishing a list. The BIA publishes its list of federally recognized tribes each year, see 63 FR 71941, Indian Entities Recognized and Eligible To Receive Services From the United States Bureau of Indian Affairs for current information. The PTO would
need to mail requests to each tribe to request their insignia. Of course, it could not be certain of getting a 100% response; thus could give no assurances to third parties that it had a complete list.

Maintaining a list. The PTO would need to send out requests for updates, using the BIA-maintained list of tribes, on some regular basis (annual, every two years, perhaps every five years). Again, it could have no certainty of getting a 100% response, and

could not give any assurances to third parties that it had a complete list. Further, as governments, each tribe has the right to change its "Official Insignia" at any time --- the U.S. Flag has changed many times.

These difficulties in establishing and maintaining lists of the "Official Insignia" of tribes may seem insurmountable, but they are not as difficult as trying to do the same for all municipalities.

(3) Impact of Changes in Current Law or Policy. If the changes did not have any impact on any of these groups, there would be absolutely no point in adopting them. The crucial point to keep in mind is the U.S. Governmental obligation to maintain the government-to-government relationship with the tribes. This obligation must override lesser obligations and must be kept in mind in international negotiations/agreements. Since prohibition of registration (not just "changes") is clearly the appropriate government-to-government position, see (4) for further comments. Since Congress has plenary power over Indian tribes, U.S. Const, Art. I, Sec. 8 (Indian Commerce Clause), the changes should be by legislation, not by policy statement or regulation.

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

Native American Tribes. Prohibition on Registration is the appropriate government-to-government action. Individual tribes would still have the authority to license the use of their "Official Insignia" if they chose to do so.

Trademark Owners. Some trademark owners might have to bear the cost of switching trademarks. There may be some impact on "innocent" owners who lose their trademark, but there should be very few such cases. There may be more cases where trademark "owners" have been deliberately copying the "Official Insignia" of various tribes. Such owners deserve no special consideration or sympathy; they have been taking advantage of the U.S. Government's failure to live up to its already existing obligations to tribes.

Patent and Trademark Office. Such prohibition need not have any significant impact on the PTO. The PTO is already obligated not to register the "Official Insignia" of municipalities. I doubt that it maintains a list of all the municipalities in the U.S. and their "Official Insignia." I would assume that conflicts between trademark registration and municipal "Official Insignia" frequently arise, and have to be dealt with, after the fact

of registration. Dealing with tribal "official insignia" would be different only in the greater level of deference due to a tribe.

Other Interested Parties. It seems to me that trademark law practitioners and related organizations would have a vested interest in cataloging the "Official Insignia" of the tribes, since an attorney could face malpractice claims/action if he/she assisted in the registration of a trademark which he/she could have reasonably discovered to be a tribal official insignia. A prohibition would probably generate a bump in litigation as tribes who know about existing misuse of their official insignia bring suit to stop the misuse, but it would probably level off fairly quickly without causing any significant long-term increase in litigation.

International Legal Obligations. There should be little or no impact. There would be the possibility of a foreign-registered trademark (protected by treaty) conflicting with a
tribal official insignia (protected by federal statute) bringing up Supremacy clause issues. This could be litigated if necessary under existing law.

Defenses. All the current defenses could be used to limit damages for misuse of tribal official insignia; however, the government-to-government relationship would not seem to allow a "prior use" claim to override a tribal designation of "official insignia." Of course, if certain tribes tried to abuse their governmental power to claim well-known non-Native trademarks as their official insignia, corrective legislation might become necessary. A court would not now allow a municipality to claim a well-known trademark, e.g., Westinghouse or Sylvania. Similarly, the legal system could deal appropriately with any tribal abuse.

(5) Administrative Feasibility. Administrative feasibility arguments against changing the law are simply not acceptable. The government-to-government relationship cannot be honored only when "administratively feasible" or only "within existing administrative budgets." As I suggested above, please re-read these questions and replace the phrase "State or federally recognized Native American Tribes" with "the State of (your home state or state of current residence)." Nonetheless, an evaluation of the potential administrative burden of new regulation is still required. Simply put, there doesn't need to be any great administrative burden. See my comments in (4) above about trademark law practitioners. These do not add to PTO's administrative burden.

(6) Timing of Changes in Protection. Neither the statute nor any implementing regulations should have retroactive effect in terms of allowing recovery for past misuse of official insignia. That raises serious constitutional questions. The change should be legislative and prospective so that parties misusing tribal insignia will have notice that as of a date certain, they must discontinue use of the tribal official insignia or face civil penalties from that date forward.

(7) Statutory Changes. The only change necessary to provide protection to federally recognized tribes is a minor amendment to 15 U.S.C. 1052(b): " . of any State of municipality, or of any federally recognized (in accordance with sec. 104, P.L. 103-454) tribe, or of any foreign nation ."[change italicized.] If the amendment is passed with an implementation date six months in the future, parties misusing tribal official insignia, whether innocently or deliberately, will have an opportunity to stop using the insignia without incurring risk of lawsuit.

(8) Other Relevant Factors.

Plenary power. Since Congress has plenary power over Indian tribes, any changes in legislation affecting the tribes should be drafted with respect for the government-to-government relationship. If a bill, accidentally or deliberately, dishonors the government-to-government relationship, the courts will nonetheless uphold the legislation because the Congress has "plenary power" over the tribes.

Trademark Law. 556 additional governmental entities suing to protect their "official insignia" just adds 556 potential clients in an area of law where the client pool already consists of most of the corporations in America. The existing body of law and pool of lawyers on trademark infringement and "official insignia" lawsuits should be capable of handling this change with barely a hiccup.

End of Comments.