COMMENTS OF THE
TUOLUMNE BAND OF ME-WUK INDIANS
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IN RESPONSE TO THE
UNITED STATES PATENT AND TRADEMARK OFFICE'S
REQUEST FOR PUBLIC COMMENTS
64 Fed. Reg. 13,002-13,004 (1999)

ON ISSUES RELATED TO THE CONGRESSIONALLY REQUIRED STUDY
OF THE
OFFICIAL INSIGNIA OF NATIVE AMERICAN TRIBES
Pub. L. 105-330, § 302
to be codified at 15 U.S.C. § 1064

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I. INTEREST OF THE TUOLUMNE BAND IN THE PATENT AND TRADEMARK OFFICE'S STUDY OF TRIBAL INSIGNIA

The Tuolumne Band of Me-Wuk Indians (the Tribe) is a federally recognized Indian tribe located on the Tuolumne Rancheria in Central California. The Tribe has over 300 members. The Tribe has identified its traditional cultural heritage as one of its most valuable resources. The Tribe has resolved to preserve and manage its history and culture in a professional and orderly manner that takes into account its traditions and sovereignty.

To accomplish this goal, the Tribe has embarked or plans to embark on many projects. These include: 1) revision of the Tribal Constitution and the development of a Tribal Cultural and Intellectual Property Rights Code; 2) the development and implementation of a Tribal Comprehensive Cultural Plan; 3) the development and implementation of a Tribal Archives and Records Project; and, 4) the development and implementation of a Tribal Repatriation Project. The ultimate goal is to establish a Tribal Interpretive Center that would house an archival center, a curation facility, and a museum. The Center would serve the Tribe as well as the neighboring Central Sierra Me-Wuk Tribal population (about 4,000), scholars, and the general public.

The Tribe has long been concerned with the misappropriation and misuse of its intellectual property, including its traditional symbols. On February 11, 1999, the Tribe submitted comments to the United States Patent and Trademark Office (PTO) regarding the process by which the PTO should obtain public comments on how to conduct the congressionally mandated study of federal trademark protection for tribal insignia. The Tribe now submits the following comments on the issues the PTO must study.

II. INTRODUCTION AND SUMMARY OF COMMENTS

Federal law recognizes that American Indian and Alaska Native Tribes (tribes) are separate, sovereign governments much like the states, federal government, and foreign nations. The issues for tribes regarding trademark law, however, are different than those for the states, federal government, and foreign nations. This is because, unlike the states, federal government, and foreign nations, tribes can register their flags, coats of arms, and official insignia as trademarks under current trademark law. For important tribal and federal interests, this registerability for tribes should be preserved.

Although their flags, coats of arms, and official insignia are non-registerable under trademark law, the federal government and states nevertheless have laws that prohibit the unauthorized use of these items. The federal and state governments thus have meaningful legal means — causes of action and remedies — to protect the items from misuse. Tribes, however, do not have these same laws. If amended as suggested in these Comments, federal trademark law can help put tribes on a par with the other sovereign governments with respect to misuse of their trademarked flags, coats of arms, and official insignia.

Briefly, trademark law should preserve the ability of tribes to register their flags, coats of arms, and official insignia. Trademark law should be amended to prohibit registration or use by third parties of tribal flags, coats of arms, official insignia, and simulations thereof unless the tribe authorizes such registration and / or use. The prohibition on unauthorized third party registration and use only provides prospective relief. To provide retrospective relief, marks registered before the effective date of the

amended legislation should be subject to cancellation on the grounds that they comprise tribal flags, coats of arms, or official insignia.

By adopting a narrow definition of Tribal Official Insignia, any negative impact of the prospective prohibition is largely eliminated. In addition, retrospective impacts on third party trademark owners could be mitigated in cancellation proceedings by providing for a defense to cancellation in the form of evidence that the trademark use of tribal flags, coats of arms, or official insignia is authorized by the tribe. Negative impacts also could be mitigated in infringement proceedings by providing for a defense to infringement in the form of evidence that the tribal items were or are being used in a non-commercial, "fair use" manner.

III. COMMENTS

A. Tribal "Official Insignia" should be Defined Narrowly

The PTO should define the official insignia of tribes narrowly. The Trademark Act, 15 U.S.C. § 1502(b), uses the terms "flag, coat of arms, or other insignia," when referring to the non-registerable official marks of the federal and state governments and foreign nations. These terms generally have been given their plain and narrow meanings. For example,

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

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

In re U. S. Dep't of the Interior, 142 U.S.P.Q. 506, 507 (TTAB 1964). The PTO has stated that "[t]he wording 'other insignia' should not be interpreted broadly, but should be considered to include only those emblems and devices which also represent [governmental] authority and which are of the same general class and character [such as formal designs] as flags and coats of arms." PTO Trademark Manual of Examining Procedure (TMEP) §1204. Similarly, Tribal Official Insignia should be limited generally to flags, coats of arms, seals, and other emblems of tribal governmental authority.

Tribal Official Insignia should consist of words plus graphic elements. Words or letters alone should not be considered Tribal Official Insignia. This is consistent with interpretations of the definition of insignia for the federal government. "The letters "USMC" are nothing like a flag or coat of arms." U.S. Navy v. U.S.Mfg. Co., 2 U.S.P.Q.2d 1254, 1256 (TTAB 1987). The PTO agrees 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 generally not considered to be 'insignia of the United States' as contemplated by § 2(b)." TMEP § 1204.

Additionally, although tribal names in and of themselves should not be excluded from Trademark Law protection, they should not in and of themselves be considered Tribal Official Insignia. This is consistent with Trademark Law treatment of, for example, state names, which uniquely identify the sovereignty of and / or geographic territory associated with states but which are not in and of themselves considered the "official

insignia" of states. It is recognized that many federal trademark registrations use tribal names and Native American words, often in a misdescriptive or otherwise improper manner. However, existing trademark law provides mechanisms for canceling improper trademarks and for enabling proper trademarks to be obtained and enforced. See, e.g., Harjo v. Pro-Football, Inc., __ U.S.P.Q. ___ (TTAB 1999) (registration of trademarks of the Washington Redskins professional football team must be canceled because the term "Redskins" in the trademarks is disparaging to Native Americans).

Tribal Official Insignia must be distinctive. Although the class of designs that are considered Tribal Official Insignia should be narrowly defined, a reasonable scope of equivalence should be provided for any registered Tribal Official Insignia. The Trademark Act prohibits the registration of governmental flags, coats of arms, or other insignia, "or any simulation thereof." 15 U.S.C. § 1052(b) (emphasis added). "Simulation" has been construed to mean more than just an incorporation of common elements or features. E.g., In re Waltham Watch Co., 179 U.S.P.Q. 59, 60 (TTAB 1973). A simulation is something that gives "the appearance or effect or has the characteristics of an original item." Id. Simulation is determined by a visual, casual comparison of the marks. In re Advance Indus. Security, Inc., 194 U.S.P.Q. 344, 346-347 (TTAB 1977). In short, merely prohibiting the registration of marks "identical to" Tribal Official Insignia is insufficient, inefficient, and could lead to confusion. See Pub. L. 105-330, Sec. 302(a)(1)(A). For example, it could result in registration or application for registration of a mark that depicts "four arrows in a quiver" notwithstanding an official tribal design that shows "three arrows in a quiver."

B. A Separate Registry for Tribal Official Insignia should be Established and Maintained

Congress has defined "federally-recognized Indian tribe" in many federal statutes. A common definition is that in the Indian Self-Determination and Education Assistance Act, 25 U.S.C. §§ 450-450n. That Act provides:

> "Indian tribe" means any Indian tribe, band, nation, or other organized group or community, including any Alaska Native village or regional or village corporation as defined in or established pursuant to the Alaska Native Claims Settlement Act (85 Stat. 688) [43 U.S.C. § 1601 et seq.], which is recognized as eligible for the special programs and services provided by the United States to Indians because of their status as Indians.

25 U.S.C. § 450b(e). In addition, Congress requires the Bureau of Indian Affairs to maintain and publish a current list of the names of tribes that are federally recognized. The latest list contains 559 tribes. 62 Fed. Reg. 55,270 (1997). A common definition of "state-recognized tribe" is found in the Indian Arts and Crafts Act, 25 U.S.C. §§ 305-310. That Act provides:

> [T]he term "Indian tribe" means ... any Indian group that has been formally recognized as an Indian tribe by a State legislature or by a State commission or similar organization legislatively vested with State tribal recognition authority ....

25 U.S.C. § 305e(d)(3)(B). It is estimated that fewer than forty tribes meet this definition.

The above-referenced definitions and list could serve as the starting point for establishing a dedicated registry of Tribal Official Insignia. The

registry would contain graphic depictions of tribal flags, coats of arms, and official insignia. To maximize its usefulness to tribes, the general public, and the PTO, this registry should be kept separate from the principal or supplemental trademark registers. A separate registry could easily be searched by tribes, the public, and trademark examiners when selecting and reviewing trademarks. Presence of tribal flags, coats of arms, and official insignia on the registry would provide a basis upon which to deny registration of a trademark by an unauthorized third party, and a basis for cancellation of a trademark. However, presence on the registry would not in and of itself provide positive trademark rights for tribes.

To obtain trademark rights, tribal flags, coats of arms, and official insignia must be placed on the principal or supplemental trademark registries under existing Trademark Law. Registrations for trademarks of tribal flags, coats of arms, or official insignia filed by tribes or third parties who can demonstrate authorization by a tribe for registration and / or use would be handled under existing Trademark Law and procedures on a par with other applicants. Like other applicants, these applicants would have to comply with general requirements such as a statement that they are using the mark on identified goods and services, or that they intend to use the mark in commerce. 15 U.S.C. § 1051; TMEP § 815. No further special registration or examination procedures should be required.

C.. Trademark Law should be Amended to allow New Registrations and Use of Tribal Official Insignia Exclusively by Tribes

Under current Trademark Law, assuming other general requirements are met, tribes are free to register their flags, coats of arms, and official insignia as trademarks. While the flags, coats of arms, and official insignia

of the federal and state governments and foreign nations are non-registerable, there is no such prohibition for these items of tribes. See 15 U.S.C. § 1052(b). The freedom of tribes to register these items should be preserved. Trademarks generally are valuable economic resources. David J. Goldstone & Peter J. Toren, The Criminalization of Trademark Counterfeiting, 31 Conn. L. Rev. 1, 76 (1998) ("Congress' decision to treat the misuse of trademarks as a criminal matter is consistent with its recognition of the ever-increasing value of intellectual property to this nation's economic well-being...."). This economic value is important to tribes because "the congressional goal of Indian self-government [includes the] 'overriding goal' of encouraging tribal self-sufficiency and economic development." California v. Cabazon Band of Mission Indians, 480 U.S. 202, 216 (1987).

Indeed, Congress has already spoken to the issue of the role of tribal trademarks in improving tribal economies. The Indian Arts and Crafts Act (IACA), 25 U.S.C. §§ 305-310, was enacted "to promote the economic welfare of the Indian tribes...." 25 U.S.C. § 305a. The IACA, inter alia, expressly encourages the creation of "trademarks of genuineness and quality for Indian products ..." of tribes. Id. at 305a(g)(1). A blanket prohibition on the registration of tribal flags, coats of arms, and official insignia would preclude registration of these items by tribes, and that would be contrary to Congress' intentions.

In contrast, Congress' goals would be furthered if Trademark Law were amended to prohibit trademark registrations and / or uses of tribal flags, coats of arms, official insignia, and simulations thereof by third parties who lack tribal authorization therefor. For "compelling federal and tribal interests," California v. Cabazon Band of Mission Indians, 480 U.S. at 221,

including "to promote [their] economic welfare," 25 U.S.C. § 305a, the law should allow tribes an exclusive right to register their flags, coats of arms, and official insignia. These items should be non-registerable by third parties without tribal authorization and their unauthorized use by third parties should be actionable by tribes in terms of infringement and other remedial proceedings.

D. The Impact of Prohibition on New Registrations and Use of Tribal Official Insignia by Third Parties will be Minimal

A narrow definition of Tribal Official Insignia as suggested above in Section A of these Comments would minimize the prospective impact of the changes in Trademark Law proposed herein. The changes would primarily affect third party potential owners and users of marks that are tribal flags, coats of arms, official insignia, or reasonable simulations thereof by making these marks non-registerable by third parties as of the effective date of the amended legislation. Regardless of changes in the law, of course, these potential owners and users in any event would be subject to existing use and common law actions and remedies. And under the proposed changes, potential owners or users would be free to seek authorization from tribes.

A narrow definition of Tribal Official Insignia would also minimize the retrospective impact of the proposed changes. Third party existing owners and users of marks that are tribal flags, coats of arms, official insignia, or reasonable simulations thereof, i.e., those whose marks were registered before the effective date of the amended legislation, would be subject to cancellation and / or infringement proceedings. These instances should be very rare. And under the definition of Tribal Official Insignia

proposed by these Comments, tribal names alone, e.g., “Cherokee” or “Oneida” would not in and of themselves constitute Tribal Official Insignia.

Additionally, negative impacts could be mitigated in cancellation proceedings by providing for a defense to cancellation in the form of evidence that the trademark use of tribal flags, coats of arms, or official insignia has been authorized by the tribe. Negative impacts also could be mitigated in infringement proceedings by providing for a defense to infringement in the form of evidence that the tribal items were or are being used in a non-commercial, “fair use” manner. Presumably, “fair use” in such situations would be defined or interpreted to include traditional non-commercial uses such as educational and informational uses, as well as any uses unique to tribes, e.g., use by members of the tribe for religious or personal reasons.

E. The Proposed Changes will be Administratively Feasible

Since under current federal law, tribes are free to register their flags, coats of arms, and official insignia, the PTO is already subject to handling the registration of these items for the about 550 federally-recognized tribes. If proposed changes to the law are made as suggested in these Comments, the PTO would have to establish and maintain a separate registry of tribal flags, coats of arms, and official insignia for these items for about 600 federally-recognized and state-recognized tribes. However, the creation of this new, dedicated registry would ultimately be an extremely useful document and data base for the PTO, tribes, and the public. It would facilitate and provide certainty to the trademark registration process for tribal flags, coats of arms, and official insignia.

At present the PTO already maintains the registration records of about 100 trademarks of tribal casinos and other economic enterprises.

Presumably, the PTO also is charged with resolving disputes related to the registration of these marks. Under the changes in the law proposed herein, applications for trademark registration of tribal flags, coats of arms, and official insignia will likely increase. Thus, the volume of work within the PTO's existing scope of work — processing trademark registration applications and resolving disputes related thereto-- will also increase. Overall, however, the changes proposed herein suggest a quantitative change, not a qualitative one, for the PTO.

F. Suggested Statutory Language

1. Amend 15 U.S.C. §1052 by adding a new subsection as follows:

(f) Consists of or comprises the flag or coat of arms or other insignia of any federally or state recognized Indian tribe, or any simulation thereof, unless registration is authorized by the tribe associated with the tribal flag, coat of arms or other insignia.

2. Amend Title 15, chapter 22 to add a new subchapter after existing subchapter II:

Tribal Official Insignia Register:

(a) In addition to the principal register and the supplemental register the Commissioner shall establish and maintain a register of tribal flags, coats of arms and other insignia called the Tribal Official Insignia Register. The Tribal Official Insignia Register shall include all flags, coats of arms, and other insignia adopted by federally or state recognized Indian tribes.

(b) The procedure for making application to the Tribal Official Insignia Register shall be determined by the Commissioner.

G. Other Relevant Factors

Federal law recognizes that tribes are separate, sovereign governments. See generally Kiowa Tribe v. Manufacturing Tech., Inc., 523 U.S. 751 (1998). Congress has repeatedly stated that the United States has a government-to-government relationship with and a trust responsibility to Indian nations. E.g., 25 U.S.C. §§ 458cc(b)(8)(A) and 458gg(c); 25 U.S.C. §1901; 25 U.S.C. § 3502; 25 U.S.C. § 3701. These principles of federal Indian law must be adhered to by the PTO as it studies trademark law protections for tribal insignia.

Indeed, Congress has encouraged the PTO to consult directly and candidly with tribes on the tribal insignia study and related matters. Pub. L. 105-330, § 302(b)(1) (1998). In addition, all federal agencies, including the PTO, are under direction generally from the White House to operate "within a government-to-government relationship with federally recognized tribal governments." Memorandum on Government-to-Government Relations with Native American Tribal Governments, 59 Fed. Reg. 22,951 (1994). This includes consulting "to the greatest extent practicable and to the extent permitted by law, with tribal governments prior to taking actions that affect federally recognized tribal governments." Id. (emphasis added). The White House has also specifically directed agencies to establish and maintain "regular and meaningful consultation and collaboration with Indian tribal

governments in the development of regulatory practices on Federal matters that significantly or uniquely affect their communities." Exec. Order No. 13,084, 63 Fed. Reg. 27,655 (1998).