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## In Defense of Culture: Protecting Traditional Cultural Expressions in Intellectual Property

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# **IN DEFENSE OF CULTURE: PROTECTING TRADITIONAL CULTURAL EXPRESSIONS IN INTELLECTUAL PROPERTY**

## **ABSTRACT**

*From Hakuna Matata to Bula to Dia de los Muertos, federal trademark registrations by commercial entities seeking to profit from rising interest in the traditions of indigenous peoples and local communities is commonplace. This issue is only a small part of a much broader issue around indigenous peoples' traditional knowledge and traditional cultural expressions being appropriated without any benefit to the communities. The misappropriation has attracted global concern, leading to national and international efforts to create legislation to protect the cultural resources of indigenous peoples and local communities around the world. Countries have engaged in national and regional initiatives to solve the issue by adapting their current intellectual property laws or creating sui generis laws specifically geared to remedy the misappropriation of indigenous peoples' cultural resources, and negotiations are ongoing at the World Intellectual Property Organization to provide sui generis protection for traditional knowledge and traditional cultural expressions.*

*U.S. federal trademark law currently contains provisions that may provide defensive protection to traditional cultural expressions by preventing their registration by nonindigenous entities. However, structural deficiencies in the trademark registration system have resulted in these provisions being virtually ineffective in providing this protection.*

*This Comment first proposes the creation of a wide database of traditional cultural expressions that examiners would be required to consult before granting trademark registrations. The database would be an official acknowledgment of the limitations of the current system of trademark registration in preventing trademarks containing traditional cultural expressions from being granted in violation of the Lanham Act. This Comment then proposes an adaptation of the collective and certification marks regime to strengthen defensive protection and grant positive protection of indigenous peoples and local communities' cultural resources.*

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## INTRODUCTION

In early 2018, a Chicago-based restaurant chain called Aloha Poke Co. sent cease and desist letters to several small businesses with names containing some variation of “Aloha Poke,” for which the chain owned a trademark registration.<sup>1</sup> Native Hawaiians ran many of the businesses that received the letters.<sup>2</sup> Aloha Poke Co. was not owned by Native Hawaiians.<sup>3</sup> The letters created an uproar because of the association that “Aloha Poke” has with traditional Hawaiian heritage.<sup>4</sup> A Hawaiian activist posted a viral video in which she spoke about how important the idea of *Aloha* was for Hawaiian culture, noting that it was being “completely commercialized and denigrated.”<sup>5</sup> The Office of Hawaiian Affairs, a Hawai’i state agency, said it was “appalled by ... attempts to assert control over Olelo Hawai’i,” the traditional language of Native Hawaiians, and that it was “reaching out to key stakeholders to discuss possible solutions.”<sup>6</sup>

Similarly, pressure has been building on the Walt Disney Company to abandon its trademarks on the phrase “Hakuna Matata” made famous in the blockbuster *Lion King* franchise.<sup>7</sup> An online petition with over 138,000 signatures as of January 2018 condemned the registration as “predicated purely on greed and [as] an insult not only [to] the spirit of the Swahili people but also Africa as a whole.”<sup>8</sup>

The perceived misappropriation of “Aloha” and “Hakuna Matata” has focused public attention on the issue of whether federal trademark registrations should be granted for marks that are associated with a traditional heritage and, if so, to whom such registrations should be granted. The misappropriation of traditional cultural expressions (TCEs) has a long history.<sup>9</sup> However, trademark

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<sup>1</sup> Eli Rosenberg, *A Midwestern Chain Told Hawaiians to Stop Using ‘Aloha’ with ‘Poke,’ Igniting a Heated Debate*, WASH. POST (July 30, 2018, 11:43 PM), <https://www.washingtonpost.com/news/food/wp/2018/07/30/a-midwestern-chain-told-hawaiians-to-stop-using-aloha-with-poke-igniting-a-heated-debate/>.

<sup>2</sup> *Id.*

<sup>3</sup> *Id.*

<sup>4</sup> Hallie Detrick, *Aloha Poke Co Is Really Sorry It Told Native Hawaiians They Couldn’t Use ‘Aloha Poke’*, FORTUNE (July 31, 2018), <http://fortune.com/2018/07/31/aloha-poke-cease-and-desist/>; Rosenberg, *supra* note 1.

<sup>5</sup> Rosenberg, *supra* note 1.

<sup>6</sup> *Statement from OHA CEO Kamana’o pono Crabbe on the Aloha Poke Controversy*, OFF. HAWAIIAN AFF. (Aug. 1, 2018), <https://www.oha.org/news/statement-on-the-aloha-poke-controversy/>.

<sup>7</sup> Chloe Taylor, *Online Petition Saying Disney has Exploited Africa Gains Steam, Topping 138,000 Signatures*, CNBC, <https://www.cnbc.com/2018/12/21/disney-accused-over-trademark-of-lion-king-phrase-hakuna-matata.html> (last updated Dec. 21, 2018, 3:25 PM).

<sup>8</sup> *Id.*

<sup>9</sup> Melody Godbolt, *Trademark Culture: Can Intellectual Property Law be Used to Thwart Cultural Appropriation in Fashion?*, INTELL. HUSL (Oct. 18, 2017), <https://www.intellectualhusl.com/husl-ip-law->

law in the United States provides avenues for protecting TCEs. Specifically, an interpretation of Section 2(a) of the Lanham Act recognizing communities' special connection to their TCEs in the minds of the American consuming public should prevent nonindigenous entities from obtaining registrations for marks that take advantage of these traditional cultural expressions.<sup>10</sup>

Part I of this Comment discusses international recognition of the importance of TCE protection, including efforts being made to create an international instrument for such protection. Part II explores approaches to protecting TCEs outside of the United States. Part III argues that current U.S. trademark law, as well as copyright law, should be interpreted to recognize communities' existing rights to defensive protection—intellectual property protection that would prevent others from controlling use of a TCE-based mark.<sup>11</sup> Properly protecting TCEs rests on enforcing those rights to defensive protection to the fullest extent. Part IV argues that the federal trademark registration system facilitates rampant abuse of communities' right to defensive protection of their TCEs. Part V argues that an adaptation of the collective marks regime in U.S. trademark law is required to enhance communities' defensive protection of their TCEs and allow these communities to profit from use of their TCEs in commerce. This Comment concludes that representatives of local communities are eligible for registration of collective marks for TCEs and current trademark registrations of TCEs are eligible for cancellation.

## I. TCE PROTECTION AT THE INTERNATIONAL LEVEL

### A. *Defining the Scope of TCE Protection*

There is no internationally accepted definition of a traditional cultural expression.<sup>12</sup> There are many different definitions in national and regional laws and in international documents.<sup>13</sup> However, protecting traditional cultural

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clinic-blog/trademark-culture-can-intellectual-property-law-be-used-to-thwart-cultural-appropriation-in-fashion. The use of trademark law to prevent such misappropriation has, however, found a more recent push thanks in part to the United Nations' World Intellectual Property Organization (WIPO). *Id.*

<sup>10</sup> See *infra* Part IV.B.

<sup>11</sup> WORLD INTELLECTUAL PROP. ORG., CONSOLIDATED ANALYSIS OF THE LEGAL PROTECTION OF TRADITIONAL CULTURAL EXPRESSIONS/EXPRESSIONS OF FOLKLORE 15 (2003) [hereinafter CONSOLIDATED ANALYSIS].

<sup>12</sup> INTERGOVERNMENTAL COMM. ON INTELLECTUAL PROP. & GENETIC RES., TRADITIONAL KNOWLEDGE & FOLKLORE, WORLD INTELLECTUAL PROP. ORG., THE PROTECTION OF TRADITIONAL CULTURAL EXPRESSIONS: UPDATED DRAFT GAP ANALYSIS 3 (2018) [hereinafter UPDATED DRAFT GAP ANALYSIS].

<sup>13</sup> *Id.*

expressions requires a generally acceptable definition of the term.<sup>14</sup> How narrowly or broadly TCEs are defined in any law or legislation can affect the extent of protection such expressions receive.<sup>15</sup> Traditional cultural expressions can be understood as the tangible and intangible forms in which communities express their cultures.<sup>16</sup> Traditional cultural expressions, or “expressions of folklore,” may include “music, dance, art, designs, names, signs and symbols, performances, ceremonies, architectural forms, handicrafts and narratives.”<sup>17</sup> These expressions “form part of the identity and heritage of a traditional or indigenous community” and are passed down across generations.<sup>18</sup> Although there is some overlap, TCEs are distinguishable from traditional knowledge (TK), which refers to the “skills, innovations and practices developed by indigenous peoples and local communities.”<sup>19</sup> TK, like traditional cultural expressions, have been passed down from generation to generation and form part of a community’s identity and heritage.<sup>20</sup> However, TK refers to knowledge or skills that may ultimately be converted into TCEs.<sup>21</sup> TK and TCE protection are heavily intertwined, and approaches to protecting TK often apply to TCEs as well.<sup>22</sup>

To understand what kinds of expressions can be protected as TCEs, it is also important to understand what “communities” are being referred to in connection with TCEs. Like TCEs, the term “communities” is not clearly defined in international or U.S. law, and the beneficiaries of protecting TCEs may not be easily established.<sup>23</sup> But the term generally refers to indigenous people, as well as traditional and local communities.<sup>24</sup> In the United States, “communities” with TCEs can appropriately refer to the indigenous Native American tribes of the

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<sup>14</sup> *Id.*

<sup>15</sup> *Id.*

<sup>16</sup> *Id.* at 4.

<sup>17</sup> *Traditional Cultural Expressions*, WORLD INTELL. PROP. ORG., <http://www.wipo.int/tk/en/folklore/> (last visited Nov. 11, 2018).

<sup>18</sup> *Id.*

<sup>19</sup> WORLD INTELLECTUAL PROP. ORG., PROTECT AND PROMOTE YOUR CULTURE: A PRACTICAL GUIDE TO INTELLECTUAL PROPERTY FOR INDIGENOUS PEOPLES AND LOCAL COMMUNITIES 9 (2017) [hereinafter A PRACTICAL GUIDE].

<sup>20</sup> *Traditional Cultural Expressions*, *supra* note 17; *see also Traditional Knowledge*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/tk/en/tk/> (last visited Nov. 11, 2019).

<sup>21</sup> *See A PRACTICAL GUIDE*, *supra* note 19, at 9 (“For example, the knowledge that indigenous peoples and local communities have developed regarding the use of plants for medicinal purposes is TK, while traditional dances, songs and designs are TCEs. Traditional handicrafts may embody both TK (the method of making) and TCEs (their external appearance).”).

<sup>22</sup> UPDATED DRAFT GAP ANALYSIS, *supra* note 12, at 11–12.

<sup>23</sup> *Id.* at 3–4.

<sup>24</sup> *Id.* at 4.

continental United States, as well as Pacific Islanders, Native Hawaiians, and Alaskan Natives.<sup>25</sup> These communities have developed traditional cultural expressions, many of which predate the establishment of a legal system of intellectual property protection in the United States.<sup>26</sup>

Multiple forms of intellectual property law may protect TCEs. Many TCEs can be protected by federal registrations under U.S. copyright law.<sup>27</sup> Copyright law protects “original works of authorship including literary, dramatic, musical, and artistic works, such as poetry, novels, movies, songs, computer software, and architecture.”<sup>28</sup> However, copyright law can only cover TCEs that are original works of authorship and exist in tangible form, so there are numerous types of TCEs that cannot be eligible for protection under U.S. copyright law.<sup>29</sup> Trademark law in the United States protects words, names, symbols, or designs that identify and distinguish the source of certain goods or services.<sup>30</sup> U.S. trademark law can fill gaps in the protection of some TCEs that are left unprotected under copyright laws.<sup>31</sup> Adapting the current system of federal trademark registration to properly recognize communities’ existing trademark rights in their TCEs is an expedient way of protecting TCEs in lieu of *sui generis* laws regarding TCEs.<sup>32</sup>

### *B. Efforts in TCE Protection at the International Level*

Throughout the world, local communities and indigenous people have developed ideas, products, and expressions that might be protectable under intellectual property law.<sup>33</sup> However, many of these communities have not used

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<sup>25</sup> Michael Yellow Bird, *What We Want to Be Called: Indigenous Peoples’ Perspectives on Racial and Ethnic Identity Labels*, AM. INDIAN Q., Spring 1999, at 1, 4. (“The Bureau of Indian Affairs states that the label ‘Native American’ came into use in the 1960s and referred to ‘American Indians’ and ‘Alaska Natives’ (Indians, Eskimos, and Aleuts), who were the primary groups served by the bureau. Later the term was broadened to include Native Hawaiians and Pacific Islanders, who sought federal services under the label.”).

<sup>26</sup> See Danielle Conway-Jones, *Safeguarding Hawaiian Traditional Knowledge and Cultural Heritage: Supporting the Right to Self-Determination and Preventing the Co-Modification of Culture*, 48 HOWARD L.J. 737, 745 (2005) (quoting *Paoakalani Declaration, Ka ‘Aha Pono ‘03: Native Hawaiian Intellectual Property Rights Conference*, Waikiki, Hawaii, Oct. 2003) (stating that Native Hawaiian TCEs are based on millennia of traditional expression).

<sup>27</sup> Stephanie Spangler, Note, *When Indigenous Communities Go Digital: Protecting Traditional Cultural Expressions Through Integration of IP and Customary Law*, 27 CARDOZO ARTS & ENT. L.J. 709, 720 (2010).

<sup>28</sup> *Copyright in General*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/help/faq/faq-general.html> (last visited Oct. 15, 2018); see also U.S. COPYRIGHT OFFICE, COPYRIGHT BASICS 1 (2017).

<sup>29</sup> See *infra* Part III.B.

<sup>30</sup> Trademark Act of 1946, 15 U.S.C. § 1127 (2012).

<sup>31</sup> See *infra* Part III.B.

<sup>32</sup> See *infra* Part V.

<sup>33</sup> See A PRACTICAL GUIDE, *supra* note 19, at 3 (“Throughout the world, indigenous peoples and local

intellectual property law to protect or promote these expressions of traditional heritage, for reasons relating to the cost of protection, knowledge about forms of protection, and even whether they are eligible to acquire intellectual property protection.<sup>34</sup>

In 2007, the United Nations General Assembly adopted the United Nations Declaration on the Rights of Indigenous Peoples (UNDRIP).<sup>35</sup> UNDRIP “recognizes the equal human rights of indigenous peoples to all other peoples against any forms of discrimination and seeks to promote mutual respect and harmonious relations between the indigenous peoples and States.”<sup>36</sup> The Declaration contemplates the intellectual property rights of indigenous people.<sup>37</sup> Article 31.1 of the UNDRIP emphasizes the rights of indigenous peoples and local communities to the protection of their TCEs:

Indigenous peoples have the right to maintain, control, protect and develop their cultural heritage, traditional knowledge and traditional cultural expressions, as well as the manifestations of their sciences, technologies and cultures.... They also have the right to maintain, control, protect and develop their intellectual property over such cultural heritage, traditional knowledge, and traditional cultural expressions.<sup>38</sup>

Article 31.2 further provides that, “[i]n conjunction with indigenous peoples, States shall take effective measures to recognize and protect the exercise of these rights.”<sup>39</sup> The United States voted against the Declaration in 2007, but in 2010, President Obama announced that the United States had changed its position and supported the Declaration.<sup>40</sup> According to the announcement, the Declaration is not legally binding but has political and moral force.<sup>41</sup>

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communities have developed a wealth of traditional knowledge and traditional cultural expressions which they rightly wish to protect and promote. Yet few have used the intellectual property system to do so.”)

<sup>34</sup> See generally *id.* (discussing challenges and opportunities in indigenous peoples and local communities’ use of intellectual property tools to protect their traditional knowledge and traditional cultural expressions). U.S. PATENT & TRADEMARK OFFICE, REPORT ON THE INSIGNIA OF NATIVE AMERICAN TRIBES 14, 29 (1999)

<sup>35</sup> G.A. Res. 61/295, United Nations Declaration on the Rights of Indigenous Peoples (Oct. 2, 2007).

<sup>36</sup> *Frequently Asked Questions*, WORLD INTELL. PROP. ORG., <https://www.wipo.int/tk/en/resources/faqs.html> (last visited Nov. 17, 2019).

<sup>37</sup> *Id.*

<sup>38</sup> *Id.*

<sup>39</sup> *Id.*

<sup>40</sup> U.S. DEP’T OF STATE, ANNOUNCEMENT OF U.S. SUPPORT FOR THE UNITED NATIONS DECLARATION ON THE RIGHTS OF INDIGENOUS PEOPLES 1 (2011).

<sup>41</sup> *Id.*

In accordance with the UNDRIP, intellectual property experts, legislators, and commentators around the world have been working to adapt intellectual property laws to properly protect TCEs.<sup>42</sup> At the international level, the UN's World Intellectual Property Organization (WIPO) created an Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC), which has been discussing an international legal instrument or instruments for the protection of TCEs.<sup>43</sup> Protection of TCEs "is distinguishable from the 'safeguarding', 'preservation' and 'promotion' of cultural heritage, which refer generally to the identification, documentation, transmission and revitalization of tangible and intangible cultural heritage in order to ensure its maintenance or viability."<sup>44</sup> Several member states in the WIPO IGC are seeking protection in an intellectual property sense—legal protection, i.e., "protection of human intellectual creativity and innovation against unauthorized use."<sup>45</sup>

The IGC's discussions acknowledge that some communities may wish to claim intellectual property rights to their TCEs to exploit them commercially for economic development.<sup>46</sup> Some communities may also want to exercise intellectual property rights to prevent use and commercialization of TCEs by others.<sup>47</sup> Most importantly, as illustrated by the Aloha Poke controversy, communities may need to prevent others from obtaining trademark rights over their TCEs and derivations and adaptations of those TCEs.<sup>48</sup>

Parties in the IGC are seeking the creation of a *sui generis* instrument due to the identified "gaps" inherent in intellectual property systems that make it difficult for communities to exploit their TCEs commercially or prevent others from cultural misappropriation of their TCEs.<sup>49</sup> Most systems have gaps in "positive protection"—the granting of rights that enable communities to promote their TCEs, control the use of their TCEs by nonindigenous persons, and benefit from the commercial exploitation of those TCEs.<sup>50</sup> Some intellectual property systems have gaps in "defensive protection"—preventing the obtainment of intellectual property rights by nonindigenous and nontraditional

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<sup>42</sup> A PRACTICAL GUIDE, *supra* note 19, at 11.

<sup>43</sup> *Id.* The discussions have been going on for almost twenty years and have produced no agreement on the protection of TCEs in a binding instrument. It is unlikely there will be any such document in the near future.

<sup>44</sup> UPDATED DRAFT GAP ANALYSIS, *supra* note 12, at 7.

<sup>45</sup> *Id.*

<sup>46</sup> *Id.*

<sup>47</sup> *Id.*

<sup>48</sup> *Id.*

<sup>49</sup> *See id.* at 8.

<sup>50</sup> *Id.* at 5, 17, 22.

persons of TCEs or their derivatives.<sup>51</sup> These gaps in defensive protection, where they exist, may lead to the most egregious type of cultural misappropriation: an outsider's use of a community's TCEs against the same community.<sup>52</sup>

For several reasons, derivations and imitations of TCEs are often eligible for protection under intellectual property systems even when the TCEs themselves may not be eligible: TCEs are often made by unknown authors or communities as a whole; they have generally been handed down from one generation to another; they are constantly evolving; they are often made not for commercial purposes but as vehicles for religious and cultural expression; and communities often recognize them as communally rather than individually owned.<sup>53</sup> Many intellectual property systems require that trademarks be used in commerce to identify a source of goods and services<sup>54</sup> or that copyrighted material be the original works of an identified individual creator or group of creators.<sup>55</sup> A commercial entity that derives a name, sign, symbol or design from a community's TCE could, in one fell swoop, obtain the benefits of intellectual property protection by eliminating characteristics preventing the original TCE from being protected.<sup>56</sup>

The gaps in current intellectual property systems have prompted some countries to create *sui generis* laws that reflect the fact that many current intellectual property regimes are not well-suited for the unique features of TCEs.<sup>57</sup> These *sui generis* laws protect TCEs and TK by specifically catering to their unique characteristics.<sup>58</sup> The different approaches countries have taken to protect TCEs, whether through *sui generis* laws or adaptations of their current intellectual property systems, are worthy of exploration. They provide common themes, as well as distinctions, that are relevant to any attempt to adapt U.S. trademark law to properly protect TCEs. The next Part explores the ways that protection of TCEs is being treated in different countries and introduces the applicability of such TCE treatment to U.S. trademark law.

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<sup>51</sup> *Id.* at 8, 22.

<sup>52</sup> *See* Rosenberg, *supra* note 1.

<sup>53</sup> CONSOLIDATED ANALYSIS, *supra* note 11, at 26.

<sup>54</sup> *Id.* at 45–46.

<sup>55</sup> *Id.* at 36.

<sup>56</sup> *See* Cleo Fraser, *Fijians Outraged as U.S. Businessman Trademarks 'bula'*, NEWSHUB (Sept. 18, 2018), <https://www.newshub.co.nz/home/world/2018/09/fijians-outraged-as-us-businessman-trademarks-bula.html>; Rosenberg, *supra* note 1; *see also* Cindy Y. Rodriguez, *Day of the Dead Trademark Request Draws Backlash for Disney*, CNN, <https://www.cnn.com/2013/05/10/us/disney-trademark-day-dead/index.html> (last updated May 11, 2013, 2:31 AM).

<sup>57</sup> A PRACTICAL GUIDE, *supra* note 19, at 10–11.

<sup>58</sup> *Id.*

## II. VARIED APPROACHES TO TCE PROTECTION AT THE NATIONAL LEVEL

Under most national laws, TCEs that do not satisfy the requirements of existing forms of intellectual property protection are, by default, part of the public domain.<sup>59</sup> Meanwhile, more arts and crafts featuring traditional cultural expressions are being mass-produced by nonindigenous entities, often outside the community or even country of origin.<sup>60</sup> The exploitation tends to blur the cultural identity associated with some TCEs without providing for compensation to the communities that created and preserved these TCEs.<sup>61</sup> The Sections below explore misappropriation of TCEs and approaches to TCE protection in Australia, India, and New Zealand.

### A. TCE Protection in Australia

The legal system of Australia makes for a good case study of TCE protection because of the country's large number of aboriginal communities and the difficult relationship that Australia's legal system has had with its indigenous peoples.<sup>62</sup> Several approaches to TCE protection come from the Australian legal system, which has recently made efforts to better protect its aboriginal communities' TCEs.<sup>63</sup>

Australian law does not specifically address the registration of TCEs or TK nor require inquiry into whether a word or design is used with the consent of the relevant community.<sup>64</sup> However, the certification marks regime in the country has allowed the National Indigenous Arts Advocacy Association to register two certification marks: the "label of authenticity" and the "collaboration mark."<sup>65</sup> The certification marks are used to certify that a work is authentic and made by indigenous people who, "in compliance with the certification mark rules, have a claim to the type of style, knowledge, or information embodied in that product."<sup>66</sup>

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<sup>59</sup> Tzen Wong & Claudia Fernandini, *Traditional Cultural Expressions: Preservation and Innovation*, in *INTELLECTUAL PROPERTY AND HUMAN DEVELOPMENT* 175, 185 (Tzen Wong & Graham Dutfield eds., 2011).

<sup>60</sup> *Id.*

<sup>61</sup> *Id.*

<sup>62</sup> Christoph B. Graber, *Aboriginal Self-Determination vs the Propertisation of Traditional Culture: The Case of Sacred Wanjina Sites*, *AUSTL. INDIGENOUS L. REV.*, 2009, at 18, 18.

<sup>63</sup> See generally Michael Blakeney, *Protecting the Knowledge and Cultural Expressions of Aboriginal Peoples*, *U.W. AUSTL. L. REV.*, 2015, at 180, 200–04 (giving examples of Australian attempts at dealing with TCE protection).

<sup>64</sup> *Id.* at 32–33.

<sup>65</sup> *Id.* at 36.

<sup>66</sup> *Id.*

Without a registered trademark, indigenous entities may still be able to take action against nonindigenous entities who adopt their TCEs as trademarks.<sup>67</sup> Australian trade practices law protects consumers from conduct that is “misleading or deceptive”<sup>68</sup> and from false representation as to “sponsorship, approval or affiliation.”<sup>69</sup> Indigenous entities may have gained a reputation as producers from specific regional areas and may be able to show that consumers are purchasing indigenous goods based on this reputation.<sup>70</sup>

Representatives of communities in Australia can challenge the unauthorized use of their TCEs in court.<sup>71</sup> The Federal Court of Australia previously ruled in favor of Aboriginal artists against a nonindigenous entity which produced carpets incorporating “dreaming” images that belonged to an Aboriginal community.<sup>72</sup> “Dreaming—the mythological time when the natural world was created”—has played an important role in the development of Aboriginal culture in Australia.<sup>73</sup> Among the different clans of Aboriginal communities of Australia, dreaming stories “have been used to pass on important knowledge, cultural values and belief systems to later generations.”<sup>74</sup> Through TCEs in the form of “song, dance, painting, and storytelling which express the Dreaming stories, the Aboriginal communities of Australia have maintained a link with the Dreaming ... from ancient times to today, creating a rich cultural heritage.”<sup>75</sup> Dreaming stories have been reproduced in paintings and artworks.<sup>76</sup> The Federal Court of Australia’s ruling solidified the affirmative rights of communities to control the use of their TCEs and prevent others from using them.<sup>77</sup> The court’s ruling is an example of how positive protection of communities’ TCEs can be achieved at the national level when a general statute is interpreted to apply to TCEs. There are provisions in U.S. trademark law that can similarly be interpreted to apply to TCEs.<sup>78</sup>

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<sup>67</sup> *See id.*

<sup>68</sup> *Trade Practices Act 1974* (Cth) s 52(1) (Austl.).

<sup>69</sup> *Id.*; *Trade Practices Act 1974* (Cth) s 53(d) (Austl.).

<sup>70</sup> TERRI JANKE, WORLD INTELLECTUAL PROP. ORG., MINDING CULTURE: CASE STUDIES ON INTELLECTUAL PROPERTY AND TRADITIONAL CULTURAL EXPRESSIONS 38 (2003).

<sup>71</sup> *See Milpururru v Indofurn Party Ltd.* (1994) 30 IPR 209, 210 (Austl.).

<sup>72</sup> *Id.*

<sup>73</sup> A PRACTICAL GUIDE, *supra* note 19, at 28.

<sup>74</sup> *Id.*

<sup>75</sup> *Id.*

<sup>76</sup> *Id.*

<sup>77</sup> *See Milpururru*, 30 IPR at 210.

<sup>78</sup> *See infra* Part III.A.

## B. TCE Protection in India

TCE protection in India is interesting because of the country's considerable mesh of tribal culture with urban culture.<sup>79</sup> India is a country of diverse cultures and religions as well as diverse settings for the expression of culture.<sup>80</sup> Big cities and industrial settlements exist adjacent to small village settlements and tribal communities.<sup>81</sup> TCEs form a significant part of the modern-day culture of India, and Indians take pride in tribal culture as symbols of cultural heritage.<sup>82</sup> Yet, this pride in tribal culture has not led to any legislation directly addressing TCE protection, whether in terms of defensive protection or positive protection (affirmative rights of control).<sup>83</sup>

Although the Constitution of India does not specifically address the protection of TCEs, it does contemplate special protection of India's tribal communities.<sup>84</sup> The Constitution "recognizes as a 'Fundamental Right' the [] protection of the culture of minorities."<sup>85</sup> Article 29 states: "Any section of the citizens residing in the territory of India or any part thereof having a distinct language, script or culture of its own shall have the right to conserve the same."<sup>86</sup> Another provision in the Constitution states that it is the duty of every citizen "to value and preserve the rich heritage of our composite culture."<sup>87</sup> Neither provision of the Constitution has prompted legislation to put this objective into practice.<sup>88</sup> Despite the constitutional provisions on the protection and preservation of distinct cultural groups, there is no law prohibiting the exploitation of communities' TCEs without their permission.<sup>89</sup> Some songs or

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<sup>79</sup> See P.Y. VALSALA G. KUTTY, WORLD INTELLECTUAL PROP. ORG., NATIONAL EXPERIENCES WITH THE PROTECTION OF EXPRESSIONS OF FOLKLORE/TRADITIONAL CULTURAL EXPRESSIONS: INDIA, INDONESIA, AND THE PHILIPPINES 17 (2002).

<sup>80</sup> Fang Lee Cooke & Debi S. Saini, *Diversity Management in India: A Study of Organizations in Different Ownership Forms and Industrial Sectors*, 49 HUM. RESOURCE MGMT. REV. 477, 482 (2010) ("Hundreds of languages are spoken by the Indian people; 18 of them are officially recognized by the Constitution.... Religion, caste, and language remain major determinants of social and political organization, despite economic modernization and laws countering discrimination against the lower end of the class structure .... [D]iversity is not just a matter of demographics, but also a matter of identity and identity politics." (citations omitted)).

<sup>81</sup> KUTTY, *supra* note 79, at 17.

<sup>82</sup> *See id.* at 19.

<sup>83</sup> See Ruchira Goswami & Karubakee Nandi, *Naming the Unnamed: Intellectual Property Rights of Women Artists from India*, 16 AM. U. J. GENDER SOC. POL'Y & L. 257, 277 (2008); *see also* KUTTY, *supra* note 79, at 19.

<sup>84</sup> KUTTY, *supra* note 79, at 19.

<sup>85</sup> *Id.*

<sup>86</sup> INDIA CONST. art. 29, cl. 1

<sup>87</sup> *Id.* art. 51A, cl. f.

<sup>88</sup> *Id.*

<sup>89</sup> Goswami & Nandi, *supra* note 83, at 277.

other forms of TCEs used by communities in India are not meant to be used outside a definite context—for example, tribal marriages or funerals.<sup>90</sup> Those TCEs are nevertheless increasingly used commercially by outsiders.<sup>91</sup>

The Indian Copyright Act, like the Constitution, does not specifically address the protection of TCEs.<sup>92</sup> By amendment, the Act does afford some protection to performers of works that are derived from TCEs.<sup>93</sup> It also protects sound recordings that make use of songs and chants that are traditional cultural expressions.<sup>94</sup> There is no requirement, however, that the performer be a member of the community to which the TCE belongs.<sup>95</sup> Misappropriation of TCEs in India is not illegal, and nonindigenous entities who borrow from the TCEs of Indian tribal communities may view the practice as “exploitation of material available in public domain.”<sup>96</sup>

The misappropriation of communities’ TCEs permeates several industries in India. In the Indian music industry, artists tend to mix pop music with traditional music taken from communities.<sup>97</sup> The original music often cannot be copyrighted because they have been passed down orally and are communally owned.<sup>98</sup> An artist can, however, derive the benefits of intellectual property law by recording mixes of pop music with traditional music and “fixing it in a tangible medium.”<sup>99</sup> Indian films also tend to use stories from tribal settlements.<sup>100</sup> Large textile companies are able to replicate the artistic creations of communities without compensating those communities.<sup>101</sup> In the absence of legislation to protect TCEs, nonindigenous entities have no legal obligation to compensate the communities responsible for the development and preservation of such TCEs.<sup>102</sup> Therefore, the communities are often not compensated or receive inadequate compensation compared to the profit from use of their TCEs.<sup>103</sup>

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<sup>90</sup> KUTTY, *supra* note 79, at 19.

<sup>91</sup> *Id.*

<sup>92</sup> *Id.* at 20.

<sup>93</sup> *Id.*

<sup>94</sup> *Id.*

<sup>95</sup> *Id.* at 21.

<sup>96</sup> *Id.*

<sup>97</sup> Goswami & Nandi, *supra* note 83, at 273–74.

<sup>98</sup> *Id.* at 269.

<sup>99</sup> See *infra* note 220 and accompanying text.

<sup>100</sup> KUTTY, *supra* note 79, at 21.

<sup>101</sup> *Id.* at 21–22.

<sup>102</sup> *Id.* at 22.

<sup>103</sup> *Id.*

While protection of the TCEs of Indian communities is inadequate, some steps have been taken to protect their TK through the patent system.<sup>104</sup> A consumer products company that filed a patent application for an invention derived from TK was denied the patent after the European Patent Office found that the patent application was related to TK that was in India's Traditional Knowledge Digital Library (TKDL).<sup>105</sup> The TKDL was established to prevent the misappropriation of Indian TK,<sup>106</sup> and it provides a viable model for the protection of communities' TCEs in India and around the world. A similar library of TCEs may help to alleviate some of the misappropriation of Indian communities' TCEs. A limited form of such a TCE library already exists in the United States in connection with Native American tribal insignia.<sup>107</sup> An expansion of such a library would better provide, at least, defensive protection of TCEs.

### C. TCE Protection in New Zealand

The Maori people of New Zealand have been "vocal and active within the international indigenous struggle for intellectual property rights and protections."<sup>108</sup> The First International Conference on the Cultural and Intellectual Property Rights of Indigenous Peoples was held in New Zealand and resulted in the Mataatua Declaration.<sup>109</sup> The Declaration stated that "Indigenous Peoples of the world have the right to self determination and in exercising that right must be recognised as the exclusive owners [o]f their cultural and intellectual property."<sup>110</sup> The Declaration recommended that intellectual property rights regimes incorporate "collective ... ownership and origin;" "coverage of historical as well as contemporary works;" "protection against debasement of culturally significant items;" and "multi-generational coverage span."<sup>111</sup>

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<sup>104</sup> A PRACTICAL GUIDE, *supra* note 19, at 35.

<sup>105</sup> *Id.*

<sup>106</sup> *Id.*

<sup>107</sup> *See infra* Part III.A.1.

<sup>108</sup> LAW LIBRARY OF CONG., NEW ZEALAND: MAORI CULTURE AND INTELLECTUAL PROPERTY LAW 4 (2010) (quoting Mariaan deBeer, *Protecting Echoes of the Past: Intellectual Property and Expressions of Culture*, 12 CANTER L. REV. 94, 102 (2006)).

<sup>109</sup> COMM'N ON HUMAN RIGHTS, SUB-COMM'N OF PREVENTION OF DISCRIMINATION AND PROT. OF MINORITIES, THE MATAATUA DECLARATION ON CULTURAL AND INTELLECTUAL PROPERTY RIGHTS OF INDIGENOUS PEOPLES (1993).

<sup>110</sup> LAW LIBRARY OF CONG., *supra* note 108, at 4.

<sup>111</sup> *Id.*

The use of Maori TCEs, not only by non-Maori New Zealanders but also by non-New Zealanders, has become increasingly popular.<sup>112</sup> Issues include “the use of Maori symbols or language in trademarks” and the misappropriation of other TCEs in products and advertising.<sup>113</sup> In general, Maori people believe that they are “unable to exercise control of the trade of their culture in any real [way] under the traditional intellectual property framework,” and that they do not reap the benefits from the exploitation of their TCEs, whether nationally or internationally.<sup>114</sup> That certain TCEs may be seen from a non-Maori perspective as having entered the “public domain” is important in considering protection for these TCEs.<sup>115</sup> The concept of “public domain” is not necessarily recognized by Maori, similar to other indigenous peoples and local communities for whom the TCEs are integral to “their history and identity as both individuals and as a group.”<sup>116</sup> The misappropriation of Maori culture that does not recognize the relevance of those TCEs may therefore cause offense.<sup>117</sup> Even if positive protection of their TCEs may not be possible under current intellectual property law, “Maori argue that their ‘guardianship’ of such [TCEs] should be acknowledged.”<sup>118</sup>

A rejected attempt to trademark the lyrics of the “Ka Mate” haka inspired a *sui generis* approach in the defensive protection of Maori TCEs.<sup>119</sup> The Ka Mate haka is the war-dance used by the New Zealand national rugby team, the All Blacks, since 1905.<sup>120</sup> The Ka Mate haka has become a symbol, not only of the All Blacks, but of New Zealand and all its people.<sup>121</sup> Its misappropriation in commercial settings outside New Zealand has caused offense to Maori people,<sup>122</sup>

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<sup>112</sup> *Id.*

<sup>113</sup> *Id.* at 5.

<sup>114</sup> *Id.*

<sup>115</sup> *Id.*

<sup>116</sup> *Id.*

<sup>117</sup> *Id.*

<sup>118</sup> *Id.*

<sup>119</sup> *History of the Haka—Explaining New Zealand’s Rugby Ritual*, IRISH EXAMINER (June 6, 2017, 1:56 PM), <https://www.irishexaminer.com/breakingnews/sport/rugby/history-of-the-haka—explaining-new-zealands-rugby-ritual-792543.html>.

<sup>120</sup> *Id.*

<sup>121</sup> Earl Gray & Raymond Scott, *Rights of Attribution for Ka Mate Haka*, 8 J. INTEL. PROP. L. & PRACTICE 200, 201 (2013).

<sup>122</sup> See, e.g., Brendan Kennedy, *The Misappropriation of “Ka Mate”*, CULTURAL SURVIVAL Q. MAG., June 2015 (“It is irresponsible for the University of Arizona to sanction a performance and production of “Ka Mate” that is offensive and inaccurate, and which violates the intellectual property rights of Māori when it is performed without permission.”); Ellen Connolly, *Maori Win Battle To Control All Blacks’ Haka Ritual*, GUARDIAN (Feb. 11, 2009), <https://www.theguardian.com/world/2009/feb/12/new-zealand-haka-maoris> (describing “a 2006 television advertisement by the car maker Fiat in which Italian women performed a slapdash rendition of the haka, which is traditionally performed only by men.”).

especially the Ngati Toa tribe of the warrior chief who authored the haka in the early nineteenth century.<sup>123</sup> In 2009,<sup>124</sup> the government of New Zealand began negotiating legislation that would recognize the significance of the haka to the tribe.<sup>125</sup> The legislation, which became law in 2014,<sup>126</sup> did not give the tribe rights to fully control uses of the haka, but it gave the tribe a right of attribution which applies to any publication of the haka for commercial purposes, any communication of the haka to the public, and any film that features the haka and is shown in public or issued to the public.<sup>127</sup> While the community may not be able to commercially exploit the TCE, the legislation helps to prevent outsiders from acquiring intellectual property rights in the haka.<sup>128</sup> This is an example of *sui generis* laws at the national level being used to provide defensive protection of a community's TCEs, while also providing pseudo-positive protection through the right of attribution.<sup>129</sup> This approach acknowledges that there is often no current mechanism for protecting certain TCEs absent new legislation like the one passed by the government of New Zealand. Such legislation is not easily transferrable across borders, however. In the United States, for example, such legislation would raise serious First Amendment concerns.<sup>130</sup>

It is not the goal of this Comment to advocate for new *sui generis* legislation to protect TCEs, but the approach is worth noting as necessary for protecting certain TCEs, especially those which may be perceived by the public as having entered the public domain. Part III of this Comment highlights current provisions in U.S. trademark law that, if properly interpreted and enforced, can provide defensive protection of many TCEs, including "Aloha." Residual focus is placed on ways of providing some positive protection of TCEs absent *sui generis* laws.

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<sup>123</sup> Kennedy, *supra* note 122, at 200–01.

<sup>124</sup> See Letter from Hon. Christopher Finlayson to Matiu Rei (Feb. 11, 2009) (on file with author).

<sup>125</sup> Kennedy, *supra* note 122, at 200.

<sup>126</sup> Haka Ka Mate Attribution Act 2014 (N.Z.).

<sup>127</sup> Kennedy, *supra* note 122, at 201.

<sup>128</sup> *Id.*

<sup>129</sup> See *id.*

<sup>130</sup> See M. Margaret McKeown, *Censorship in the Guise of Authorship: Harmonizing Copyright and the First Amendment*, 15 CHI.-KENT J. INTELL. PROP. 1, 2 (2016) (discussing tension between copyright protection, the public domain, and the First Amendment).

### III. COMMUNITIES' EXISTING RIGHTS TO DEFENSIVE PROTECTION IN U.S. LAW

The Lanham Act,<sup>131</sup> enacted in 1946, is the foundation of modern U.S. federal trademark law.<sup>132</sup> The Copyright Act of 1976<sup>133</sup> is its counterpart in copyright. Neither statute contains provisions geared specifically toward TCE protection. However, both statutes contain provisions that implicate TCEs or derivations thereof. This Part discusses the provisions and how they provide solutions to the problems of TCE misappropriation. Section A discusses Section 2(a) of the Lanham Act, which may provide some defensive protection for marks containing TCEs. Section B discusses problems with obtaining positive protection in copyright for many TCEs and areas where such protection may be feasible.

#### *A. Current Protections in U.S. Trademark Law*

In the United States, parties are not required to register their marks to obtain trademark protections.<sup>134</sup> An individual or entity may establish common law rights in a mark based solely on use of the mark in commerce, even without a registration.<sup>135</sup> Moreover, every state in the United States has a trademark registration system separate from the federal system.<sup>136</sup> These state registrations provide a basis for a state statutory claim of trademark infringement but provide little benefit over simply establishing common law rights in a mark.<sup>137</sup> A federal registration, however, offers greater advantages over a state trademark registration or common law rights alone.<sup>138</sup> Owning a federal trademark registration provides a legal presumption of validity of a mark, gives the public constructive nationwide notice, allows for a bar on the importation of infringing foreign goods, lets the owner sue for infringements in federal court, and is a basis for obtaining registration in foreign countries.<sup>139</sup> Obtaining a federal

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<sup>131</sup> Trademark Act of 1946, 15 U.S.C. §§ 1051–1141 (2012).

<sup>132</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1752 (2017).

<sup>133</sup> Copyright Act of 1976, 17 U.S.C. §§ 101–113 (2012).

<sup>134</sup> U.S. PATENT & TRADEMARK OFFICE, PROTECTING YOUR TRADEMARK: ENHANCING YOUR RIGHTS THROUGH FEDERAL REGISTRATION 10 (2019) [hereinafter PROTECTING YOUR TRADEMARK].

<sup>135</sup> 15 U.S.C. § 1125.

<sup>136</sup> Lee Ann W. Lockridge, *Abolishing State Trademark Registrations*, 29 CARDOZO ARTS & ENT. L.J. 597, 598 (2011).

<sup>137</sup> *Id.*

<sup>138</sup> PROTECTING YOUR TRADEMARK, *supra* note 137, at 11.

<sup>139</sup> *Id.*

registration is, therefore, an attractive proposition for any individual or entity looking to use a mark in commerce.<sup>140</sup>

The Lanham Act, which contains the framework for federal trademark registrations, does not speak specifically to whether traditional cultural expressions may be registered.<sup>141</sup> Refusing federal registrations by nonindigenous entities of marks that are TCEs, or derived thereof, would provide defensive protection to TCEs and prevent the kinds of misappropriation seen in the Aloha Poke controversy.<sup>142</sup>

Federal trademark registrations for TCEs, like other marks, may be refused for reasons unrelated to their status as TCEs—for example, lack of “distinctiveness.”<sup>143</sup> Also, a report by the U.S. Patent and Trademark Office suggested that registrations of TCEs have been denied based on evidence that use of the mark is disparaging.<sup>144</sup> The prohibition on registration of marks that are disparaging is provided for in Section 2(a) of the Lanham Act.<sup>145</sup> Section 2(a) states that an application for a trademark registration may be denied if the mark “[c]onsists 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.”<sup>146</sup> However, the Supreme Court held in *Matal v. Tam* that refusing to register marks as “disparaging” constitutes viewpoint discrimination under the Free Speech Clause of the First Amendment and is unconstitutional.<sup>147</sup> Following the Court’s decision in *Tam*, the disparagement language has been read out of the statute and is no longer an avenue for preventing the use of communities’ TCEs in disparaging marks.<sup>148</sup>

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<sup>140</sup> See *id.* (listing the benefits of federal registration of marks used in commerce).

<sup>141</sup> See 15 U.S.C. § 1052 (2012).

<sup>142</sup> Wong & Fernandini, *supra* note 59, at 196.

<sup>143</sup> 15 U.S.C. § 1052(e)–(f); Wong & Fernandini, *supra* note 59, at 196.

<sup>144</sup> See, e.g., U.S. PATENT & TRADEMARK OFFICE, REPORT ON THE INSIGNIA OF NATIVE AMERICAN TRIBES 14 (1999) [hereinafter INSIGNIA REPORT] (“Application Serial No. 75-447770, [‘ZIA’ with Zia Sun Symbol design, for ‘cocktail mixes,’ refused on the basis of likely false association with the Pueblo of Zia and possible disparagement of the tribe].” (alterations in original)).

<sup>145</sup> 15 U.S.C. § 1052(a).

<sup>146</sup> *Id.* (emphasis added).

<sup>147</sup> *Matal v. Tam*, 137 S. Ct. 1744, 1763, 1765 (2017). Similarly, the Supreme Court held recently in *Iancu v. Brunetti* that the Lanham Act’s ban on “immoral” or “scandalous” marks was also viewpoint discrimination and thus unconstitutional. *Iancu v. Brunetti*, No. 18-302, slip op. at 11 (June 24, 2019).

<sup>148</sup> Niki Kuckes, *Matal v. Tam: Free Speech Meets “Disparaging” Trademarks in the Supreme Court*, 23 ROGER WILLIAMS U. L. REV. 122, 125–26 (2018).

For communities to receive defensive protection for their TCEs, trademark registrations for marks containing TCEs, whether disparaging or not, would have to be refused on non-disparagement grounds. Current protections for TCEs in U.S. trademark law show that the false connection<sup>149</sup> language in Section 2(a) is well-suited for the defensive protection of TCEs and is a valid basis for refusing registration of trademarks that use TCEs.<sup>150</sup> Although TCEs can be collaterally refused registration under U.S. trademark law, they are often registered and usually not by the communities that developed the expressions.<sup>151</sup>

The Aloha Poke controversy shows that indigenous peoples and local communities not only may not benefit from use of their traditional cultural expressions in commerce, but also that they are at risk of significant losses from misappropriation by nonindigenous persons and entities.<sup>152</sup> Some Native Hawaiian businesses experienced financial hardship due to having to change their signs, logos, and other marketing materials.<sup>153</sup> The false connection<sup>154</sup> language of Section 2(a) should be enforced to prevent the federal trademark registration of marks like “Aloha Poke.” The rest of this Section explores ways that TCEs are currently being protected in U.S. trademark law and how current protections strengthen the case for enforcement of the false connection language in Section 2(a).

### *1. USPTO Protection for Official Insignia of Native American Tribes*

Defensive protection of TCEs has already found a place in U.S. trademark law. The United States Patent and Trademark Office (USPTO), which is the agency charged with administering the Lanham Act,<sup>155</sup> has taken some deliberate steps to protect certain TCEs. In 2001, the USPTO “established a database containing the official insignia of all State and federally recognized Native American tribes which cannot be registered as trademarks.”<sup>156</sup>

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<sup>149</sup> 15 U.S.C. § 1052(a).

<sup>150</sup> See *infra* Part III.A.1.

<sup>151</sup> See, e.g., *Trademark Electronic Search System (TESS)*, U.S. PAT. & TRADEMARK OFF., <http://tess2.uspto.gov/> (follow Basic Word Mark Search (New User); then search Search Term field for “aloha”) (over 1,000 results for word marks containing “aloha” most of which contain only one other word).

<sup>152</sup> See Rosenberg, *supra* note 1.

<sup>153</sup> See *id.*

<sup>154</sup> 15 U.S.C. § 1052(a) (2012).

<sup>155</sup> 35 U.S.C. § 1 (2012).

<sup>156</sup> Wong & Fernandini, *supra* note 59, at 197–98; *Native American Tribal Insignia*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademark/laws-regulations/native-american-tribal-insignia> (last visited Aug. 11, 2019).

The database, and the process by which it was created, provide insight into the existing trademark rights of communities in their TCEs, and it provides potential methods for better protecting these existing rights. The regulation creating the database resulted from the Trademark Law Treaty Implementation Act (TLTIA), an act which was aimed at better aligning U.S. trademark law with trends in the international trademark community.<sup>157</sup> The TLTIA required the USPTO to study issues around the “protection of the official insignia of federally and State recognized Native American tribes.”<sup>158</sup> The law enumerated six issues the USPTO study was required to address: (1) the impact of a change in law or policy regarding the official insignia of Native American tribes on Native American tribes, trademark owners, the USPTO, the international obligations of the United States, and other interested parties; (2) “the means for establishing and maintaining a listing of the official insignia;” (3) “an acceptable definition of the term ‘official insignia’ with respect to a ... Native American tribe;” (4) the administrative feasibility, including the cost, of a change in law or policy; (5) whether any protection of official insignia should be applied “prospectively or retrospectively and the impact of such protection;” and (6) any statutory changes that would be needed to afford protection of official insignia.<sup>159</sup> These issues regarding the protection of insignias (a type of TCE) are consistent with the concerns around protecting TCEs as a category through U.S. trademark law.

The database was the result of a deliberate process that showed signs of compromise.<sup>160</sup> During the notice-and-comment period, the USPTO requested comments on how best to conduct the study required by the TLTIA.<sup>161</sup> The agency also requested “the public’s views concerning all aspects of trademark protection for the official insignia of Native American Tribes....”<sup>162</sup> Thirty-three different groups submitted written comments and thirty-six groups and individuals provided oral testimony at public hearings in three cities.<sup>163</sup> While some comments brought up trademark issues outside the scope of what the TLTIA required the USPTO to study, the agency chose to focus its study only

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<sup>157</sup> Trademark Law Treaty Implementation Act, Pub. L. No. 105-330, § 302, 112 Stat. 3064, 3071 (1998); Notice of Hearings: Official Insignia of Native American Tribes; Statutorily Required Study, 64 Fed. Reg. 29,841, 29,841 (June 3, 1999).

<sup>158</sup> Trademark Law Treaty Implementation Act § 302, 112 Stat. at 3071.

<sup>159</sup> *Id.*

<sup>160</sup> See Dalindyabo Bafana Shabalala, *Intellectual Property, Traditional Knowledge, and Traditional Cultural Expressions in Native American Tribal Codes*, 51 AKRON L. REV. 1125, 1157-59 (2017).

<sup>161</sup> *Id.* at 1157.

<sup>162</sup> Official Insignia of Native American Tribes; Statutorily Required Study, 64 Fed. Reg. 13,004, 13,005 (Mar. 16, 1999).

<sup>163</sup> INSIGNIA REPORT, *supra* note 144, at 3.

on issues surrounding the protection of the official insignia of federally and State recognized Native American tribes.<sup>164</sup>

By establishing a database of Native American insignia, the USPTO was not attempting to help Native American tribes prevent all cultural misappropriation by nonindigenous entities of their TCEs, whether in commerce or not.<sup>165</sup> The database was established to help protect only a limited set of the existing trademark rights of Native American tribes.<sup>166</sup> The USPTO issued a report following the study, which argued that because the USPTO is an agency charged with examining and registering trademarks, not with policing their use in commerce, its power in this space was limited to refusing registrations for marks similar to Native American official insignia.<sup>167</sup> According to the report, the database would only be one of the many ways in which the USPTO has taken an active role in protecting Native American tribes' TCEs.<sup>168</sup> The report mentioned opposition and cancellation proceedings, which provide communities the opportunity to challenge registrations, as one way the USPTO plays a role in the defensive protection of TCEs.<sup>169</sup>

The USPTO report pointed to Section 2(a) of the Lanham Act as the source of its power to refuse marks that are similar to Native American insignia.<sup>170</sup> Section 2(a) of the Lanham Act prohibits registrations of marks which may “falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols.”<sup>171</sup> Under this authority, the USPTO refuses “many applications incorporating the names or symbols of Native American tribes.”<sup>172</sup> Examples of these refusals include “Zia SYSTEMS” with a Zia Sun Symbol design, for “stationery, computer software products and packaging, and advertising,” and “ZIA” with a Zia Sun Symbol design, for “cocktail mixes,” both refused “on the basis of likely false association with the Pueblo of Zia.”<sup>173</sup> The report distinguished protection for Native American tribes' insignia from a *per se* prohibition on marks bearing the names of Native American tribes, stating

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<sup>164</sup> *Id.* at 12 (“The language of [the TLIA] directs the Commissioner to study trademark issues and particularly requires the Commissioner to identify issues surrounding protection of official insignia. Therefore, this study will not analyze or make recommendations with respect to the above-mentioned issues which go beyond the scope of ‘official insignia,’ even if those issues involve trademarks.”).

<sup>165</sup> *Id.* at 13.

<sup>166</sup> *See id.* at 12.

<sup>167</sup> *Id.* at 13, 15.

<sup>168</sup> *Id.* at 14–15.

<sup>169</sup> *Id.* at 15.

<sup>170</sup> *Id.* at 34.

<sup>171</sup> 15 U.S.C. § 1052(a) (2012).

<sup>172</sup> INSIGNIA REPORT, *supra* note 144, at 14.

<sup>173</sup> *Id.*

that such a prohibition would “create gross unfairness to trademark owners using names that happen to intersect with those of Native American tribes.”<sup>174</sup> The report, however, clarified that Section 2(a) of the Lanham Act already provided a basis for refusing federal registration of marks similar to the official insignia of Native American tribes.<sup>175</sup> Establishing the database helps to provide notice to entities seeking to register such marks that their applications are likely to be denied.<sup>176</sup>

Following the report’s recommendation, the USPTO has continued to maintain the database, with over fifty insignia currently in the database.<sup>177</sup> Although Native American tribes may be able to register their insignia and other TCEs as trademarks, many Native American tribes do not wish to register their official insignia as trademarks because they have no interest in making commercial use of them.<sup>178</sup> Instead, their interest is to stop nonindigenous entities from cultural misappropriation of symbols, names, and insignia associated with Native American tribes.<sup>179</sup> In addition, the financial costs associated with hiring trademark counsel often interferes with communities’ ability to challenge registrations through opposition or cancellation proceedings in the USPTO or to police unauthorized use of common law trademarks.<sup>180</sup> The USPTO specifically notes that adding an insignia to the database does not confer Native American tribes with the benefits of trademark rights in their insignia.<sup>181</sup> However, the database provides these communities with some defensive protection of these TCEs by helping to prevent nonindigenous entities’ registrations of their insignia or derivatives of those insignia.<sup>182</sup> The database and the process by which it came into being is recognition of the existing trademark rights of communities in their TCEs.

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<sup>174</sup> *Id.* at 26.

<sup>175</sup> *Id.* at 34.

<sup>176</sup> U.S. PATENT & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMPEP) OCTOBER 2018 (2018) (“Thus, if a mark that a party wishes to register as a trademark resembles an insignia of a Native American tribe, it may falsely suggest a connection with the tribe.”).

<sup>177</sup> See *Native American Tribal Insignia: Database FAQs*, U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/trademark/laws-regulations/native-american-tribal-insignia/native-american-tribal-insignia-database#1638> (last visited Nov. 17, 2018); see also *Trademark Electronic Search System (TESS)*, U.S. PAT. & TRADEMARK OFF., <http://tess2.uspto.gov/> (follow Word and/or Design Mark Search (Free Form); then search Search Term field for “Native American Tribal Insignia” (including quotation marks)) (62 results as of Jan. 5, 2020).

<sup>178</sup> INSIGNIA REPORT, *supra* note 144, at 29.

<sup>179</sup> *Id.*

<sup>180</sup> *Id.*

<sup>181</sup> Native American Tribal Insignia Database, 81 Fed. Reg. 87,550, 87,550 (Dec. 5, 2016).

<sup>182</sup> See *supra* note 176 and accompanying text.

2. *The Indian Arts and Crafts Act's Protection of Communities' Trademark Rights in Their TCEs Through Its Punishment of Unauthorized TCE Use*

The Indian Arts and Crafts Board is an agency created by Congress in 1935 “to promote American Indian and Alaska Native economic development through the expansion of the Indian arts and crafts market.”<sup>183</sup> To bolster the agency’s ability to do so, Congress passed the Indian Arts and Crafts Act of 1990<sup>184</sup> (amended in 2010) in response to “growing sales of counterfeit Indian products in the billion-dollar Indian art market.”<sup>185</sup> The Act authorizes the Board to refer complaints of counterfeit Indian arts and crafts to the FBI.<sup>186</sup> It provides criminal and civil penalties for falsely advertising that products are “Indian Made.”<sup>187</sup> Under the Act, “work marketed as authentic Indian art and craftwork must be produced by an artist or artisan who is an enrolled member of a federally or officially State recognized Indian tribe, or an Indian Artisan certified by the tribe of their direct descent.”<sup>188</sup>

The Act did not confer trademark rights in those arts and crafts.<sup>189</sup> Instead, it acknowledged existing rights by providing Native American tribes and Alaskan Natives a federal cause of action in cases of infringement and imposing civil and criminal penalties on infringing parties.<sup>190</sup> Similar to Section 2(a) of the Lanham Act, the onus has been on the communities through individuals or representatives to initiate policing of non-indigenous entities’ infringement of their rights.<sup>191</sup> However, the agency has successfully worked to prevent the use of Indian TCEs to market non-Indian products or to remedy violations of the Act in other ways.<sup>192</sup> As an example, the Board obtained a settlement “with Pendleton Woolen Mills regarding their use of Indian names to market non-Indian products.”<sup>193</sup>

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<sup>183</sup> *Cultural Sovereignty Series: Modernizing the Indian Arts and Crafts Act to Honor Native Identity and Expression: Field Hearing Before the S. Comm. on Indian Affairs*, 115th Cong. 12 (2017) [hereinafter *Hearings*] (testimony of Meredith Stanton, Director, Indian Arts and Crafts Board, U.S. Department of the Interior).

<sup>184</sup> Indian Arts and Crafts Act of 1990, 25 U.S.C. §§ 305–310 (2012).

<sup>185</sup> *Hearings*, supra note 183, at 12.

<sup>186</sup> *Id.*

<sup>187</sup> *Id.* at 12–13.

<sup>188</sup> *Id.* at 13.

<sup>189</sup> 25 U.S.C. §§ 305–310.

<sup>190</sup> *Id.* §§ 305d–e.

<sup>191</sup> *Hearings*, supra note 183, at 13 (testimony of Meredith Stanton, Director, Indian Arts and Crafts Board, U.S. Department of the Interior).

<sup>192</sup> *Id.*

<sup>193</sup> *Id.*

Provisions in the Indian Arts and Crafts Act of 1990 contain language similar to Section 43(a) of the Lanham Act, which provides a civil cause of action for “false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which [] is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, ... or as to the origin, sponsorship, or approval of ... goods ... by another person.”<sup>194</sup> Without the Indian Arts and Crafts Act, it would still have been illegal to market non-Native American goods as genuine Native American goods under the Lanham Act.<sup>195</sup> The Indian Arts and Crafts Act simply serves to “particularize the offense to Native American goods and to specify and define the rather hefty penalties for such activities.”<sup>196</sup> Native Americans and Alaskan Natives already had trademark rights in these TCEs—their arts and crafts.<sup>197</sup> The Lanham Act had already created a cause of action for attempts to represent goods as being of Native American origin or in some way connected to Native Americans.<sup>198</sup> The Indian Arts and Crafts Act of 1990 was an attempt to alleviate the problem of the Lanham Act’s failing to protect Native Americans’ trademark rights in their TCEs as fully as it protects other marks.<sup>199</sup>

The inadequacy of Lanham Act protections for TCEs is not unique to arts and crafts. As alluded to in the earlier discussion of the official insignia of Native American tribes, communities may have cultural rather than commercial reasons for creating TCEs, so they do not register trademarks, including trade dress, to identify the source of their goods, arts or crafts.<sup>200</sup> In addition, the financial costs associated with hiring trademark counsel often interferes with communities’ ability to take legal action.<sup>201</sup> Financial resources are required to employ trademark attorneys to initiate opposition or cancellation proceedings in the USPTO or to police the unauthorized use of common-law trademarks in TCEs which have been used in commerce by communities.<sup>202</sup> Even if a community has the resources, it may be reluctant to spend those resources because of the uncertainty of getting a favorable result.<sup>203</sup>

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<sup>194</sup> 15 U.S.C. § 1125(a)(1) (2012).

<sup>195</sup> See Deborah Spector, *Protection for Native Americans? The Indian Arts and Crafts Act of 1990*, 4 DEPAUL-LCA J. ART & ENT. L. 231, 237 (1994).

<sup>196</sup> *Id.*

<sup>197</sup> Brian Zark, *Use of Native American Tribal Names as Marks*, 3 AM. INDIAN L.J. 537, 550 (2015).

<sup>198</sup> See 15 U.S.C. § 1125(a)(1).

<sup>199</sup> Spector, *supra* note 195, at 233, 235–36.

<sup>200</sup> See *supra* note 178 and accompanying text.

<sup>201</sup> See *supra* note 180 and accompanying text.

<sup>202</sup> Zark, *supra* note 197, at 550.

<sup>203</sup> *Id.*

The challenge of maintaining defensive protection, at least, can be remedied by the USPTO resolving to properly enforce the Lanham Act's prohibition on the registration of marks that "falsely suggest a connection with" communities, a prohibition that this Comment argues applies to marks like "Aloha Poke" that are derived from TCEs.<sup>204</sup> Due to the large number of local communities and indigenous peoples existing in the United States, USPTO examining attorneys may not be aware that a mark falsely suggests a connection to a community through its use of a TCE in the mark.<sup>205</sup> The financial cost of bringing trademark challenges and the potential ignorance of an examining attorney that a mark contains TCEs warrants a database of all TCEs similar to the database of Native American insignia discussed above. Such a database would contain names, words, symbols, or songs that are associated with indigenous peoples and local communities of the United States. Federal trademark registrations should not be granted for marks containing these TCEs unless granted to a member of the community that owns the TCE.

### *B. Current Protections in U.S. Copyright Law*

Copyright law provides little aid in preventing the misappropriation of TCEs by nonindigenous entities. U.S. copyright registrations of work containing TCEs, like trademark registrations containing TCEs, are sometimes granted.<sup>206</sup> In 2002, Disney released *Lilo & Stitch*, an animated movie which told the story of an orphaned Hawaiian girl and a stranded alien she mistook for a dog.<sup>207</sup> The movie included two "mele inoa," "traditionally used to honor King Kalakaua and Queen Lili'uokalani, two rulers in the 19th century known for their strong national and ethnic identity and role in the Hawaiian counterrevolution."<sup>208</sup> "Mele inoa" are sacred name chants in honor of someone.<sup>209</sup> The two "mele inoa," which are "viewed as a source of Native Hawaiian pride, were performed as a single song and renamed for the orphaned character, Lilo."<sup>210</sup> Disney then copyrighted the song for the movie's soundtrack.<sup>211</sup> The presentation of these

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<sup>204</sup> See 15 U.S.C. § 1052(a) (2012).

<sup>205</sup> Zark, *supra* note 197, at 550.

<sup>206</sup> See Nina Mantilla, *The New Hawaiian Model: The Native Hawaiian Cultural Trademark Movement and the Quest for Intellectual Property Rights to Protect and Preserve Native Hawaiian Culture*, AM. U. INTELL. PROP. BRIEF, Fall 2011, at 26, 26.

<sup>207</sup> *Id.*

<sup>208</sup> *Id.*

<sup>209</sup> See Amy K. Stillman, *History Reinterpreted in Song: The Case of the Hawaiian Counterrevolution*, 23 HAWAIIAN J. HIST. 1, 13 (1989).

<sup>210</sup> Mantilla, *supra* note 206, at 26.

<sup>211</sup> *Id.*

“mele inoa” in the movie sparked anger among Native Hawaiians, many of whom described the presentation as “inaccurate and culturally insensitive.”<sup>212</sup>

Communities cannot obtain defensive protection of their TCEs through copyright in the same way that they can under Section 2(a) of the Lanham Act. U.S. copyright law is guided by the Berne Convention, of which the United States is a party.<sup>213</sup> The Berne Convention addresses the copyright of literary and artistic works, including works that would seem to include TCEs.<sup>214</sup> However, the manner in which it provides positive protection of these works, and “the fact that most TCEs would be considered public domain material for purposes of copyright law,” leaves many TCEs outside the scope of the Berne Convention.<sup>215</sup>

In the United States, the basic purpose of copyright protection is to “incentivize the creation of new works by [granting] a time-limited monopoly over the particular expression.”<sup>216</sup> The U.S. copyright system is premised on the utilitarian goal of providing greater access to knowledge and artistic works.<sup>217</sup> Authorship is bound by the requirement of a “‘modicum of creativity’ in the creation—an idea that implicates both ‘original creation’ on the part of the author, and a certain amount of creativity.”<sup>218</sup> Thus, “copyright law does not provide protection for items that are copied wholesale from preexisting works, or for items that are not ‘creative’ works.”<sup>219</sup> Further, “to achieve copyright protection, the expression must be fixed in a tangible medium that [can be communicated] to others.”<sup>220</sup>

The goals of U.S. copyright law cause several problems for the positive protection in copyright of communities’ TCEs. The challenges in the protection of TCEs include the “originality requirement, fixation requirement, the term of copyright, the concept of the public domain, the focus on sole authors, ... [and] fair use.”<sup>221</sup> It is generally accepted that many TCEs fall outside the scope of

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<sup>212</sup> *Id.*

<sup>213</sup> Berne Convention for the Protection of Literary and Artistic Works, Sept. 9, 1886, 828 U.N.T.S. 221 (revised at Paris July 24, 1971).

<sup>214</sup> Molly Torsen, *Intellectual Property and Traditional Cultural Expressions: A Synopsis of Current Issues*, 3 INTERCULTURAL HUM. RTS. L. REV. 199, 201 (2008).

<sup>215</sup> *Id.* at 202.

<sup>216</sup> David R. Hansen, *Protection of Traditional Knowledge: Trade Barriers and the Public Domain*, 58 J. COPYRIGHT SOC’Y 757, 772 (2010).

<sup>217</sup> *Id.*

<sup>218</sup> *Id.* at 773.

<sup>219</sup> *Id.*

<sup>220</sup> *Id.*

<sup>221</sup> Torsen, *supra* note 214, at 202.

classic copyright protection, in large part because TCEs are often “not attributable to a particular author or even an identifiable group of authors.”<sup>222</sup> In situations involving TCEs that have been passed down for generations or TCEs that have developed over time with many contributors, identifying an author is impossible.<sup>223</sup> While joint authorship is recognized in U.S. copyright law, there is still a requirement that the authors be identifiable.<sup>224</sup> Because many TCEs are copies of preexisting works, they do not meet the originality requirement of copyright.<sup>225</sup> Authors who modify preexisting TCEs into derivative or transformative works may be able to gain copyright protection.<sup>226</sup>

Many communities’ TCEs are part of their cultural heritage and these communities do not wish to alter these TCEs for commercial use, so meeting the requirements of U.S. copyright law would be impossible.<sup>227</sup> However, for indigenous communities that wish to commercialize some of their TCEs, copyright can be an option if representatives of those communities, for example, “grant permission to individual artists within the tribe to make new, original art based on TCEs.”<sup>228</sup> In this area, positive protection of TCEs is more feasible. Members of a community are more likely to be faithful to the traditions contained in a TCE, and the community could receive economic benefit directly or indirectly from the grant of permission. The ability to attain this positive protection of TCEs depends on having defensive protection in the first place. If nonindigenous entities are granted trademarks or copyrights for marks or works based on TCEs, communities may be preempted from controlling use of their TCEs. Despite communities’ existing rights in U.S. law to defensive protection of their TCEs, infringement of those rights is rampant. Part IV provides an example of such infringement and then discusses the USPTO’s failure to better protect communities’ TCEs through the enforcement of Section 2(a).

#### IV. INFRINGEMENT OF COMMUNITIES’ TRADEMARK RIGHTS IN TCEs

##### A. *Beyond Aloha Poke: Cultural Misappropriation of TCEs by Commercial Entities*

There is a long history of commercial entities attempting to register marks

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<sup>222</sup> Hansen, *supra* note 216, at 774.

<sup>223</sup> *Id.*

<sup>224</sup> *Id.*

<sup>225</sup> *Id.* at 774–75.

<sup>226</sup> *Id.* at 775.

<sup>227</sup> See *supra* note 178 and accompanying text.

<sup>228</sup> Torsen, *supra* note 214, at 203.

containing TCEs, often successfully. In 2013, The Walt Disney Company filed an application to the USPTO to secure a trademark for the term “Día de los Muertos.”<sup>229</sup> The term translates to Day of the Dead, which is a traditional holiday celebrated across Latin America on November 1 and 2.<sup>230</sup> Every year, “[p]eople honor the lives of lost family members or friends by building altars, holding processions, decorating gravesites and placing offerings for loved ones.”<sup>231</sup> Disney hoped to obtain the trademark for merchandise related to a movie it was planning to release.<sup>232</sup> Like in the Aloha Poke situation, this attempt at cultural misappropriation of a traditional cultural expression caused an uproar.<sup>233</sup> Tweets such as, “Tell @Disney not to trademark Day of the Dead. Culture is NOT for sale!”<sup>234</sup> and, “Are we okay with @DisneyPixar commercializing our culture?”<sup>235</sup> poured in reaction to Disney’s action. Disney ultimately decided to withdraw its application for trademark registration.<sup>236</sup>

The term *Bula*, like *Aloha*, has erroneously been the subject of numerous trademark registrations in the United States despite Section 2(a) of the Lanham Act.<sup>237</sup> In September 2018, a Florida restaurateur obtained a registration for the mark *Bula* for use with his business establishments (which go by the name of Bula Nation Inc).<sup>238</sup> This angered the government of Fiji.<sup>239</sup> *Bula* is a common greeting in Fiji and also has a much wider cultural significance.<sup>240</sup> Fiji’s Attorney General stated that preparations were “underway to lodge the necessary documentation” with the USPTO to challenge the registration.<sup>241</sup> In addition, he says that the matter will be raised with WIPO.<sup>242</sup> The Attorney General called

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<sup>229</sup> Rodriguez, *supra* note 56.

<sup>230</sup> *Id.*

<sup>231</sup> *Id.*

<sup>232</sup> Steve Brachmann, *Trademark Enforcement Campaign by Chicago Restaurant Aloha Poke Draws the Ire of Native Hawaiian Activists*, IPWATCHDOG (Sept. 12, 2018), <http://www.ipwatchdog.com/2018/09/12/trademark-enforcement-aloha-poke-ire-native-hawaiian-activists/id=100914/>.

<sup>233</sup> *Id.*

<sup>234</sup> Presente.Org (@PresenteOrg), TWITTER (May 7, 2013, 5:01 PM), <https://twitter.com/PresenteOrg/status/331921733089128448>.

<sup>235</sup> Think Mexican (@ThinkMexican), TWITTER (May 8, 2013, 11:51 PM), <https://twitter.com/ThinkMexican/status/332387296655581184>.

<sup>236</sup> Rodriguez, *supra* note 56.

<sup>237</sup> ‘Bula’ Trademarked by US Businessman, RADIO N.Z. (Sept. 18, 2018, 10:45 AM), <https://www.radionz.co.nz/international/pacific-news/366621/bula-trademarked-by-us-businessman>.

<sup>238</sup> Fraser, *supra* note 56.

<sup>239</sup> Nick Fogarty, *Fiji Government to Contest ‘Bula’ Trademark by US Bar, Says It Is a ‘Blatant Case of Heritage-Hijacking’*, AUSTR. BROADCASTING CORP. NEWS (Sept. 27, 2018, 8:33 PM), <https://www.abc.net.au/news/2018-09-28/fiji-government-to-contest-bula-trademark-by-us-bar/10315790>.

<sup>240</sup> *Id.*

<sup>241</sup> *Id.*

<sup>242</sup> *Id.*

the restaurateur’s actions a “blatant case of heritage-hijacking.”<sup>243</sup> A Fijian activist launched an online petition on the day that the government of Fiji announced its intent to challenge the mark.<sup>244</sup> That petition reached its 5,000-signature target the same day.<sup>245</sup> The activist argued that WIPO needs to assist in setting up guidelines for trademark offices around the world to use to avoid cultural misappropriation.<sup>246</sup> Fiji politicians have also stated that it would consider taking the issue to the United Nations as part of the ongoing fight.<sup>247</sup> There would be no need to resort to the United Nations if the USPTO follows the language of Section 2(a) and cancels the registration for the mark *Bula*.

*B. The USPTO’s Erroneous Approval of Federal Registrations of TCEs Despite Section 2(a)*

Several registered trademarks bear the TCEs of local communities and indigenous peoples of the United States and TCEs of indigenous peoples around the world. Under Section 2(a) of the Lanham Act, federal trademark registrations are erroneous when the mark contains a community’s TCE.<sup>248</sup> A search of the USPTO database reveals multiple registrations based on the term *Aloha*.<sup>249</sup> Many of these terms “falsely suggest a connection” with the Native Hawaiian community, which is a violation of the Lanham Act.<sup>250</sup>

The registration of marks containing TCEs goes against precedent<sup>251</sup> from the Trademark Trial and Appeal Board (TTAB) and the U.S. Court of Appeals for the Federal Circuit, which have previously affirmed a refusal by the USPTO to register marks on the basis of the Section 2(a) false connection language.<sup>252</sup> In *In re Shinnecock Smoke Shop*, a U.S. citizen who was also a member of the Shinnecock Indian Nation filed two trademark applications with the USPTO containing the word “Shinnecock.”<sup>253</sup> There, the USPTO recognized that the marks sought to be registered contained TCEs of the Shinnecock Indian

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<sup>243</sup> *Id.*

<sup>244</sup> *Id.*

<sup>245</sup> *Id.*

<sup>246</sup> *Id.*

<sup>247</sup> *Id.*

<sup>248</sup> *See supra* Part III.A; *see also* 15 U.S.C. § 1052(a) (2012) (prohibiting marks which “falsely suggest a connection with persons, . . . institutions, beliefs, or national symbols”).

<sup>249</sup> *See supra* note 151 and accompanying text.

<sup>250</sup> 15 U.S.C. § 1052(a).

<sup>251</sup> *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 101.03 (2019) (discussing precedential decisions that govern the TTAB).

<sup>252</sup> *In re Shinnecock Smoke Shop*, 571 F.3d 1171, 1172 (Fed. Cir. 2009).

<sup>253</sup> *Id.*

Nation.<sup>254</sup> The Federal Circuit rejected the applicant's argument that the Shinnecock Indian Nation was not an "institution" under Section 2(a)—the primary issue in that case—and upheld the TTAB's holding that the applicant's use of the TCE in the marks falsely suggested a connection to the tribe.<sup>255</sup>

A mark need not specifically identify the party falsely associated with the mark to preclude registration.<sup>256</sup> The TTAB currently uses a four-prong test to determine whether a proposed mark falsely suggests a connection with a person or institution.<sup>257</sup> The TTAB analyzes whether (1) "the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution;" (2) "the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution;" (3) "the person or institution named by the mark is not connected with the activities performed by the applicant under the mark;" and (4) "the fame or reputation of the person or institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed."<sup>258</sup>

Use by non-Native Hawaiians of *Aloha* and *Poke* to describe a Native Hawaiian dish "falsely suggests a connection" to Native Hawaiians and implicates Section 2(a) of the Lanham Act. For the first prong of the test used by the TTAB, there is little doubt that *Aloha* has a meaning that is associated with Hawai'i. The TCE is a close approximation of the identity of Native Hawaiians. Although *Aloha Poke* has a more attenuated connection to Native Hawaiians than "Hawai'i Poke" or "Hawaiian Poke" would, *Aloha* undoubtedly bears a connection to Hawaiians and especially Native Hawaiians. The "Aloha spirit" is a phenomenon associated with Native Hawaiians, and *Aloha* is a popular Hawaiian greeting called upon in reference to Hawai'i.<sup>259</sup> Moreover, the word *Poke* is itself the Hawaiian word for the type of dish.<sup>260</sup> Individually, these words suggest a connection to Native Hawaiians and, together, the connection is even stronger. For the second prong of the test used by the TTAB, the *Aloha Poke* mark unmistakably points to Native Hawaiians for much of the same reasons that the mark is an approximation of Hawaiian identity. *Aloha* is a

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<sup>254</sup> *In re Shinnecock Smoke Shop*, No. 78918500, 2008 WL 4354159, at \*2 (T.T.A.B. Sept. 10, 2008) (finding that mark contained the name of the Shinnecock Indian Nation).

<sup>255</sup> *Shinnecock*, 571 F.3d at 1172–73.

<sup>256</sup> *See, e.g., In re Kent Pedersen*, 109 U.S.P.Q.2d (BNA) 1185 (T.T.A.B. 2013).

<sup>257</sup> TRADEMARK MANUAL OF EXAMINING PROCEDURE § 1203.03(c)(i) (2018).

<sup>258</sup> *Id.*

<sup>259</sup> *Aloha*, U. HAW. COMMUNITY C., <http://www.uhcc.hawaii.edu/aloha/alohaSpirit.php> (last visited Nov. 18, 2019).

<sup>260</sup> Mark Noguchi, *A Conflicted Chef From Hawaii Reacts to the Mainland Poke Bowl Trend*, FIRST WE FEAST (Mar. 1, 2016), <https://firstwefeast.com/eat/2016/03/hawaii-chef-has-problems-with-poke-trend>.

traditional cultural expression of Native Hawaiians and *Poke* itself refers to a traditional Hawaiian dish, which is recognized as originating in Hawai'i.<sup>261</sup> For the third prong, Native Hawaiians are not connected with the activities of the registrant of the *Aloha Poke* mark nor, presumably, with the multiple trademark registrations for *Aloha*.<sup>262</sup> Finally, use of the mark to sell poke, a traditional Native Hawaiian dish, warrants a presumption of connection with Native Hawaiians. Registration of the *Aloha Poke* mark is therefore breach of Native Hawaiians' existing rights, at least, to defensive protection.

Native Hawaiians, like Native Americans and Alaskan Natives, may be entitled to more than just defensive protection for their TCEs. When there is a traditional way of using certain terms and the terms have a traditional connection to actual goods like is the case for poke, communities are entitled to affirmative trademark rights to control the use of marks derived from their TCEs.<sup>263</sup> However, the communal nature of ownership of these TCEs necessitates an adaptation of the collective marks and certification marks regime to allow for registration of these TCEs. Ensuring that TCEs are the subject of collective or certification marks would help provide defensive protection of communities' TCE and, where possible, positive protection. The next Part discusses collective and certification marks and explains why the USPTO can and should pursue a system that makes TCEs a specific target of the current collective and certification marks regimes.

#### V. ADAPTING THE COLLECTIVE AND CERTIFICATION MARKS REGIME TO TCEs

Alleviating the ongoing infringement of communities' existing trademark rights in their TCEs may require an adaptation of the certification and collective marks regime. Certification and collective marks are an avenue for ensuring that use of TCEs conform to the standards set by representatives of indigenous peoples and local communities.<sup>264</sup> Certification and collective marks do not necessarily help consumers identify the source of a particular product.<sup>265</sup> Rather, an intended goal of certification marks is "to signal to the consumer the product conforms to the standards set by the organization named on the mark."<sup>266</sup> Similarly, an intended goal of collective marks is to indicate membership in an

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<sup>261</sup> See *Aloha*, *supra* note 259; Noguchi, *supra* note 260.

<sup>262</sup> See Rosenberg, *supra* note 1.

<sup>263</sup> See *supra* note 140 and accompanying text.

<sup>264</sup> See Spector, *supra* note 195, at 236.

<sup>265</sup> See *id.*

<sup>266</sup> *Id.*

association.<sup>267</sup> Products bearing a collective or certification mark need not serve as a source identifier. Therefore, the USPTO should promote certification and collective marks that refer to indigenous peoples and local communities. This would not only help the agency properly enforce Section 2(a) of the Lanham Act, but it would also encourage the promotion of trademarks—a task with which the agency has been statutorily charged.<sup>268</sup>

*A. The Alaska Silver Hand Program as a Model for TCE Protection Through Representatives of Indigenous Peoples and Local Communities*

The Alaska Silver Hand program is a certification program that helps Alaskan Natives promote their work in the marketplace and allows consumers to identify and purchase genuine Alaskan Native art.<sup>269</sup> The history of the Silver Hand program “dates back to 1935 when the Indian Arts and Crafts Board was established as a separate agency under the Secretary of the Interior.”<sup>270</sup> Four years later, the U.S. Department of the Interior stipulated that handmade products from Indian Tribes be stamped with a trademark to guarantee their authenticity.<sup>271</sup> The program, overseen by the Alaska State Council on the Arts,<sup>272</sup> uses identification seals to indicate that “the artwork on which it appears is created by hand in Alaska by an individual Alaska Native artist.”<sup>273</sup> The Alaska Silver Hand program is only available to Alaskan Natives who are part of a state or federally recognized tribe and who are full-time residents of the state of Alaska.<sup>274</sup> The program issues a two-year permit for the use of the identification seal, which can be renewed indefinitely.<sup>275</sup> The Silver Hand image is protected under Alaska trademark statute and regulation.<sup>276</sup>

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<sup>267</sup> See 15 U.S.C. § 1127 (2012) (defining “collective mark”).

<sup>268</sup> See 35 U.S.C. § 2(a) (2012).

<sup>269</sup> Emily Moore, *The Silver Hand: Authenticating the Alaska Native Art, Craft and Body*, 1 J. MODERN CRAFT 197, 197–98 (2008).

<sup>270</sup> *My Alaska News—Silver Hand*, TRAVEL ALASKA, <https://www.travelalaska.com/MyAlaska/News/September-2011/SilverHand.aspx> (last visited Nov. 18, 2019).

<sup>271</sup> *Id.*

<sup>272</sup> Moore, *supra* note 269, at 198.

<sup>273</sup> *How Do I Find Authentic Alaska Native Art?*, VISIT ANCHORAGE ALASKA, <https://www.anchorage.net/plan-your-trip/ask-a-local/how-do-i-find-authentic-alaska-native-art/> (last visited Nov. 18, 2019).

<sup>274</sup> FED. TRADE COMM’N, BUYING ALASKA NATIVE ART (2007); *My Alaska News—Insider Tips for Buying Native Art*, TRAVEL ALASKA, [https://www.travelalaska.com/MyAlaska/News/November-2011/Buying\\_Native\\_Art.aspx](https://www.travelalaska.com/MyAlaska/News/November-2011/Buying_Native_Art.aspx) (last visited Nov. 18, 2019).

<sup>275</sup> Alaska State Council on the Arts, *Silver Hand Program & Permit Application*, [http://arts.alaska.gov/Media/ArtsCouncil/pdf/silver\\_hand\\_application.pdf](http://arts.alaska.gov/Media/ArtsCouncil/pdf/silver_hand_application.pdf) (last visited Nov. 18, 2019).

<sup>276</sup> ALASKA STATE COUNCIL ON THE ARTS & THE CIRI FOUND., ALASKA NATIVE ARTIST RESOURCE WORKBOOK: ART MEANS BUSINESS 6.

The USPTO has a duty to facilitate certification programs, like the Alaska Silver Hand program, that would operate under federal trademark law. This would enable the agency to better enforce Section 2(a) by giving communities an incentive to police their marks. Facilitating certification programs would give both offensive protection and defensive protection, and it would help alleviate the problem epitomized by the Aloha Poke controversy.

### *B. Collective and Certification Marks in the Federal Registration System*

The Lanham Act allows for registration of collective and certification marks.<sup>277</sup> A collective mark is a mark “used by the members of a cooperative, an association, or other collective group or organization.”<sup>278</sup> Collective marks include “marks indicating membership in a union, an association, or other organization.”<sup>279</sup> A certification mark is any word, name or symbol that satisfies the following:

[The mark is] used by a person other than its owner, or ... which its owner has a bona fide intention to permit a person other than the owner to use in commerce ... to certify regional or other origin, material, mode of manufacture, quality, accuracy ... or that the work or labor on the goods or services was performed by members of a union or other organization.<sup>280</sup>

While “trademarks are [generally] intended to help the consumer identify the source of a particular product and to protect the manufacturer from unfair trade practices by competitors,”<sup>281</sup> an “intended goal of certification marks is to allow the [source] of the product to signal to the consumer the product conforms to the standards set by the organization named on the mark.”<sup>282</sup>

### *C. Collective and Certification Marks’ Applicability to TCEs*

Collective and certification mark owners need not use their marks to sell goods and services.<sup>283</sup> Obtaining such a mark in connection with a genus of goods and services would prevent others from obtaining a registration for the

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<sup>277</sup> 15 U.S.C. § 1054 (2012).

<sup>278</sup> *Id.* § 1127.

<sup>279</sup> *Id.*

<sup>280</sup> *Id.*

<sup>281</sup> Spector, *supra* note 195, at 236.

<sup>282</sup> *Id.*

<sup>283</sup> Sari Sharoni, *The Mark of a Culture: The Efficacy and Propriety of Using Trademark Law to Deter Cultural Appropriation*, 26 FED. CIR. B.J. 407, 437 (2017).

mark.<sup>284</sup> These marks must, however, be used in “some interstate commercial activity” to obtain affirmative trademark rights such as the right to prevent others’ use of the term in commerce.<sup>285</sup> The owners of a collective mark or certification mark need not be an established commercial entity.<sup>286</sup> In the case of Aloha Poke, the Office of Hawaiian Affairs would suffice as a collective mark or certification mark owner of the term.<sup>287</sup> They could then prevent nonindigenous entities from claiming trademark rights in similar marks, license the mark to entities seeking to do business under the name, or prevent outsiders from using the mark.<sup>288</sup> Native Hawaiians would thus have defensive protection in that nonindigenous entities like the Chicago restaurant could not gain trademark rights over the term. They would also gain affirmative trademark rights if a dish bearing the mark were sold in interstate commerce by informing consumers that the product bears a mark indicating “membership in ... an association”<sup>289</sup>—membership of a community.

Collective marks, especially, are well suited for protecting a community’s TCEs. Collective marks “may be symbolic of membership in some collective group or organization, or of the goods or services provided by members of the organization.”<sup>290</sup> The collective owns the mark, and its members can use the collective mark in the same way as other trademarks.<sup>291</sup> The owner of the mark need not itself sell goods or perform services under the mark, but it can promote its members’ goods and services under it.<sup>292</sup> Collective marks can also serve as a designation of origin for goods from a certain geographical region.<sup>293</sup>

Even when a collective mark does not meet all the requirements for protection as a trademark, “a third party’s unauthorized use of the collective name as a trademark may be confusingly similar to the collective mark and may

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<sup>284</sup> *Id.* at 421.

<sup>285</sup> *Id.* at 437.

<sup>286</sup> *See id.*

<sup>287</sup> *See About, OFF. HAWAIIAN AFF.*, <https://www.oha.org/about/> (last visited Sept. 4, 2019) (“The Office of Hawaiian Affairs is a public agency with a high degree of autonomy. OHA is responsible for improving the well-being of Native Hawaiians. OHA is governed by a Board of Trustees made up of nine members who are elected statewide to serve four-year terms setting policy for the agency. OHA is administered by a Chief Executive Officer (Ka Pouhana) who is appointed by the Board of Trustees to oversee a staff of about 170 people.”).

<sup>288</sup> *See supra* Part V.A.

<sup>289</sup> 15 U.S.C. § 1127 (2012).

<sup>290</sup> Sharoni, *supra* note 283, at 428–29 (“Examples of collective marks include agricultural cooperatives, the Professional Golfers Association, and the Realtor mark for real estate sales services.”).

<sup>291</sup> *Id.* at 429.

<sup>292</sup> *Id.*

<sup>293</sup> *Id.*

be barred from registration or enjoined.”<sup>294</sup> Communities may also benefit from being represented by a collective that “represents the shared interest of its members” in a cancellation proceeding or infringement litigation.<sup>295</sup> Recognition of communities as collectives provides a basis for protecting their TCEs before they are used in commerce, while allowing for registration of those TCEs so communities can obtain positive protection—affirmative trademark rights in the TCEs.

## CONCLUSION

Local communities and indigenous people in the United States have an implicit, existing right to defensive protection of their traditional cultural expressions under Section 2(a) of the Lanham Act. The right to defensive protection means that even if the communities cannot obtain trademark registrations for these traditional cultural expressions, nonindigenous entities should not be able to obtain these registrations either. Therefore, grants of trademark registrations to outsiders is in error and such marks should be canceled. A new category of collective and certification marks that are specifically targeted towards allowing positive protection of communities’ TCEs should be adopted. This new category would recognize communities as collectives, and representatives of these communities would own certification marks in their TCEs. This adaptation of the current certification and collective marks regime would allow communities to more easily obtain the trademark benefits of their traditional cultural expressions, while at the same time solidifying the defensive protection that they should already enjoy.

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<sup>294</sup> *Id.*

<sup>295</sup> *Id.*

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