

THE INDIAN ARTS AND CRAFTS ACT: TRADEMARK MISFIT OR JUST MISSING THE MARK?

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INTRODUCTION

The United States continues to struggle with how best to protect Native American traditional knowledge, genetic resources, and folklore. While some have suggested that existing intellectual property laws provide the proper framework for protecting Native American rights, others call for comprehensive federal legislation of a different nature. The federal legislature's response has been to enact several pieces of legislation intended to address different facets of the problem. The Indian Arts and Crafts Act of 1990 ("IACA") is one measure that Congress has taken to protect Native American rights to their name and, arguably, their culture and their heritage.

The nature of the rights established by IACA is unclear. The IACA statute declares itself a "truth in advertising" law, although consumers have no cause of action under the Act. One scholar believes that IACA really is about the preservation of Native American culture itself, despite its facial purpose of regulating commercial speech.^[1] Another has suggested that perhaps IACA creates a new property right in "Indian-ness," vesting that right in the people the Act defines as Indians.^[2] Only one appellate court has considered the question; the Seventh Circuit has read the Act and its associated regulations to effectively create trademark rights in the use of the word "Indian" and in the names of Indian tribes.^[3]

This article suggests that an affirmative grant of rights is not the most coherent way to preserve the integrity of Native American arts and crafts and to prevent fraudulent marketing, and further argues that understanding IACA to affirmatively

create trademarks in tribe names and in the word Indian is problematic. In Part I, this article reviews the history of IACA and identifies authorities that view IACA as creating trademark-like rights. Part II considers the consequences of statutorily creating trademark rights in this group of terms and vesting the power to enforce those rights in particular groups of people. Part III of this article identifies obstacles that might arise if these trademark protections instead were sought through existing trademark law, concluding that trademark law might not be the most effective avenue to meet IACA's policy goals. Finally, Part IV suggests that, by shifting focus from the accrual of rights to the elimination of fraudulent marketing, the genuine Native American arts and crafts industries ultimately will benefit.

I. IACA: The Trademark Misfit

A. Understanding the IACA's history and provisions

The value of Native American culture as acknowledged by the marketability of traditional arts and crafts has been the subject of United States federal law since 1935.^[4] The purposes of the Indian Arts and Crafts Board (“the Board”)^[5], created in that year, were to “(1) promote the market for Indian arts and crafts, and (2) prevent fakes from entering the market.”^[6] The Board was charged with conducting market research and other activities that were “of a supportive nature.”^[7] Although the 1935 Act made it a crime to sell arts and crafts misleadingly labeled as Indian products,^[8] it imposed only small penalties^[9] and its structure made enforcement difficult if not impossible. Specifically, the 1935 Act required “willful” intent, and no prosecutions were brought under the Act.^[10]

The market for Indian arts and crafts products grew steadily through the twentieth

century. By 1985, the federal government estimated that the total sales of Indian jewelry and crafts to be between \$400 million and \$800 million annually.^[11] Fraudulently-marketed products accounted for 10-20% of that total,^[12] resulting in losses of up to \$160 million annually to the authentic Indian arts and crafts producers. The states most greatly affected began to enact their own fraud statutes to combat the imitation products.^[13]

The Indian Arts and Crafts Act of 1990 (IACA) was enacted in direct response to these developments and put “teeth” into the 1935 Act.^[14] In addition to making it a felony to knowingly misrepresent products as “Indian” or “Native American”^[15] IACA authorizes civil actions “against a person who . . . offers or displays for sale or sells a good . . . in a manner that falsely suggests it is Indian produced [or] an Indian product.”^[16] The Board also may refer complaints about goods falsely designated as “Indian” to the FBI,^[17] may recommend to the Attorney General that criminal proceedings be instituted, and may call on the Secretary of the Interior to commence a civil action against the offender.^[18]

IACA also authorizes the Board to create and register trademarks for Indian arts and crafts products.^[19] The Board may, according to the statute, register these trademarks in its own name or in the name of individual Indians, Indian tribes, and Indian arts and crafts organizations.^[20] With respect to government-owned trademarks, the Board may establish standards and regulations, may set up a licensing scheme, and may assign these trademarks to others.^[21] Unfortunately this provision of IACA is incompatible with the Lanham Act, which governs U.S. trademarks and trademark registration.^[22] Under the Lanham Act, the registering party either must be using the mark as a commercial source identifier or must have a bona fide intent to use the

mark.^[23] Therefore the Board cannot validly establish trademarks on another's behalf or in another's name.

IACA also, and controversially, defines the Act's key terms, including a definition of who qualifies as an "Indian" under the statute. "Indian tribe" for IACA's purposes, includes only includes federally-recognized and state-recognized tribes,^[24] and an "Indian"^[25] is anyone who is a member of a recognized tribe.^[26] Not only does this definition conflict with the definitions of "Indian" and "Native American" in other federal law, but the arbitrary restriction imposed by the definition means that an individual who is full-blooded Native American cannot sell arts and crafts as "Indian-made" unless that individual also is enrolled in a tribe.^[27] The cultural implication of this legal development is significant, with some artists turning away from their crafts and some galleries and museums closing their doors in fear of criminal prosecution or civil action.^[28]

Also included within IACA is a provision instructing the Board to draft regulations to flesh out the new statute.^[29] The regulations were finalized in late 1996 and include the "unqualified use" provision, which states that "the unqualified use of the term 'Indian' or . . . of the name of an Indian tribe . . . in connection with an art or craft product is interpreted to mean . . . that the art or craft product is an Indian product."^[30] The plain language of this regulation suggests that the "unqualified use" of these protected words is equivalent to "falsely suggesting" that the goods are Indian-made, a violation of the IACA statute.^[31]

IACA was changed in 2000 when the legislature adopted the Indian Arts and Crafts Enforcement Act of 2000.^[32] The 2000 amendment expressly confirms that Indian arts and crafts organizations and individual Indians all are authorized to bring suit against any seller who falsely suggests that goods are of Indian origin.^[33] Thus a

lawsuit claiming that a producer “falsely suggests” a relation to an Indian tribe may move forward even without the support of the Indian tribe itself. These private plaintiffs may seek injunctions as well as damages and may recover treble damages or “in the case of each aggrieved individual Indian, Indian tribe, or Indian arts and crafts organization not less than \$1000 for each day on which the offer or display for sale or sale continues.”^[34] Punitive damages and attorneys fees also are available under the statute.^[35]

B. IACA creates trademark rights?

In *Native American Arts, Inc. v. Waldron*,^[36] the Seventh Circuit considered IACA and the interaction between the statute, the “unqualified use” regulation, and the private civil cause of action created by the amendment.^[37] In that case, an Indian arts and crafts organization had brought suit against a seller of Indian-type arts and crafts, seeking to vindicate its rights to the term “Indian” under IACA.^[38] At issue was the role and purpose of the “unqualified use” regulation, which the plaintiff claimed ought to have been included in the jury instructions. Judge Posner, writing for the court, observed that “[i]n effect, the regulation makes ‘Indian’ the trademark denoting products made by Indians”^[39] The Seventh Circuit went on to hold that the regulation did not compel the district court to give a jury instruction with identical wording,^[40] although the “unqualified use” regulation may or may not be controlling.^[41]

Despite the regulation’s narrow purpose as cited by the *Waldron* court, Judge Posner’s language already has been quoted in support of the proposition that “the Indian Arts and Crafts Act *and* its implementing regulation” create trademark-like rights and trademark-like causes of action.^[42] In practice, sellers also have viewed the regulation as instructive and have re-positioned their product marketing in response, to avoid the

unqualified use of the mark “Indian” as a source identifier.^[43] Furthermore, the regulation is not the only hint that IACA ought to be understood as creating trademark rights. One commentator has read IACA to statutorily prescribe secondary meaning, a trademark concept, to Native American tribe names.^[44] Similarities between IACA’s language and the Lanham Act terminology also have led the Northern District of Illinois to draw from the Lanham Act’s trademark provisions in interpreting IACA’s provisions.^[45]

II. The Misfit Makes Mischief: IACA Trademark Rights Create Problems

Whether the underlying goal of IACA is to protect Native American culture, to protect jobs on Indian reservations,^[46] or to protect consumers from false advertising,^[47] the trademark-like rights created by IACA are different in kind from other statutorily-created trademarks. For example, the trademark “Olympic” also was created by statute.^[48] The Olympic mark has passed constitutional muster despite its origin in the legislature, and the statutory wording has provided much greater protection to “Olympic” than to trademarks arising solely under the Lanham Act.^[49]

The trademark protection granted to “Olympic” indicates that Congress knows how to protect a particular trademark through legislation. In contrast, IACA does not expressly create trademark rights by reference to the Lanham Act, but rather creates the functional equivalent of trademark rights and then vests those rights into certain ethnic populations (or some subset of those populations). IACA’s failure to explicitly operate within the Lanham Act as well as its tying of rights to particular groups of people creates three distinct conflicts. First, the grant of “special” trademark-like rights to groups of citizens creates a conflict with the international trademark regime. Second, the creation of trademark-like rights in Native American tribe names creates conflict with the domestic trademark regime. Third, the creation of trademark-

like rights in the terms “Indian” and “Native American” are particularly problematic considering that ownership of these marks can never vest in any one group of people.

A. IACA Trademark Rights and the International Trademark Regime

The interplay of trademark protections between various sovereign states is an area of increasing focus. The trade agreement known commonly as TRIPS^[50] “provides for the international protection and enforcement of intellectual property rights.”^[51] Broadly, the TRIPS agreement aims to provide “adequate standards and principles concerning the availability, scope and use of trade-related intellectual property rights”^[52] Specifically, TRIPS obligates each Member State to “accord the nationals of other Members treatment no less favourable than that it accords to its own nationals with regard to the protection of intellectual property.”^[53]

The United States Patent and Trademark Office (USPTO) has cited this provision as one justification for its failure to provide any specialized, positive treatment of Native American source indicators, including tribe names.^[54] Likewise, the effective grant of trademark rights through IACA and its regulation may very well violate TRIPS. By providing trademark protection to particular groups without requiring those groups to demonstrate that they have, indeed, acquired these rights in the particular source-identifying marks, the IACA allows for preferential treatment of particular nationals: Native Americans and Native American tribes. The IACA makes absolutely no provision for the protection of indigenous groups outside the United States. Thus, these special trademark rights, which accrue without the rightholders’ effort or knowledge, are not extended to the nationals of other members under the TRIPS agreement.

Furthermore, the IACA allows statutory damages to those who claim rights in these special statutorily-protected source indicators, and monetary awards for infringement

can be extremely high. The threat of treble damages and attorneys fees alone can be a motive for settlement, giving these particular asserters of trademark rights additional leverage at all stages of litigation. These statutory remedies created by the IACA are completely at odds with the remedies available for other US trademark violations. Unlike the strict liability scheme set out in IACA, the Lanham Act only allows treble damages and attorneys' fees where there has been an *intentional* infringement.^[55] Therefore, this special class of trademark rights-holders not only is exempted from proving the validity of the rights they assert, but also is entitled to receive much greater monetary awards from the US legal system. A related concern is that the possibility of statutory damages provides a disincentive for would-be infringers, thus creating a bubble of protection around this class of trademark rights-holders.

A second possible conflict with international trademark rights arises from the Paris Convention^[56] and concerns the circumstances under which a Member sovereign state may refuse a foreign registration. Under the Paris Convention, one Member may only deny trademark registration to another Member under three circumstances: (1) where the mark would infringe the rights of third parties within the non-registering country; (2) where the mark lacks distinctiveness and therefore cannot be a source identifier; and (3) where the mark is "contrary to morality or public order and, in particular, of such a nature as to deceive the public."^[57]

The IACA codifies the rights of third parties, being the rights of Native Americans (defined as tribe members) and the rights of Native American tribes. However, the International Trademark Association claims that the Paris Convention "implies, but does not specifically require, that the infringed "rights" of third parties [that might justify refusal of foreign registration] must be trademark rights rather than rights

acquired by virtue of legislative fiat.”^[58] Thus the IACA, regardless of whether it actually creates trademark rights, might not justify refusal of a foreign trademark registration that conflicted with IACA’s mandate. For example, if a foreign registration for “Indian Maid” for handcrafted jewelry was presented to, and accepted by, the USPTO, the validly-registered trademark would nonetheless infringe on the trademark rights created by IACA.

Refusal to register a foreign mark also may be based on Section B(3) of the Paris Convention, but here, again, the IACA may conflict. Specifically, the PTO may refuse to register a mark that is “of such a nature as to deceive the public.” As noted, IACA provides a narrow definition of who may be an “Indian” where goods are marked at authentic Indian goods. Under IACA’s definition, some marks might not be deceptive yet still violate the statute. For example, arts and crafts made in India could fairly be trademarked as “Indian,” provided that the claimant could demonstrate that the mark incorporating this descriptor actually served as a source identifier. This trademark would not be deceptive, but U.S. registration still would bring the mark into direct conflict with the trademark rights created by IACA.

Another example is a foreign registration for “Indian Maid” for arts and crafts where a Native American actually is producing the goods, but that individual is not an “Indian” under IACA’s statutory definition. Because IACA’s definition artificially restricts who may claim rights in “Indian,” a Native American may satisfy the common understanding of Indian without meeting the statutory definition. Again, the foreign registration should be accepted by the USPTO because the mark is not deceptive, but a domestic registration for this mark would be in direct conflict with the trademark rights created by IACA.

One commentator has suggested that the geographic origin provisions of the TRIPS agreement provide an alternative for granting intellectual property-type rights in “Indian” and Indian tribe names as source identifiers.^[59] Under this theory, Native American descriptors conceivably could be protected because they also come from a particular place. Unlike the “flora and fauna” that are cited as “inextricably tied to a specific geographic location,”^[60] however, Native American arts and crafts may be produced by people all over the country and all over the world. Although some aspects of Native American intellectual property may be fixed to a particular location, native arts and crafts are entirely mobile and to apply a geographic origin protection would stretch the definition of the term.

In addition to violating TRIPS and the Paris Convention, any reading of the IACA and its regulations that creates trademark rights is problematic in other respects. The nature of these problems and their remedy turns on whether the trademark right is said to exist in the name of a federally-recognized or state-recognized tribe or, alternatively, whether the trademark right exists in the term “Indian” itself, when used to describe arts and crafts products.

B. Domestic disturbance I: IACA Trademark Rights in Tribe Names

Assuming that IACA and its regulations create trademark rights in federally-recognized and state-recognized tribe names and that these trademark rights automatically vest with the tribes, such an addition to our domestic trademark scheme is problematic for several reasons. First, had Congress intended to create statutorily proscribed trademarks for each tribe, Congress would have had no need to incorporate a separate provision of IACA that could, hypothetically, create these trademarks. Thus the regulation that effectively creates trademarks^[61] is in direct conflict with the scheme of IACA as a whole.^[62]

In addition to this obvious conflict, the creation of statutorily-proscribed trademarks for Indian tribes sets up the wrong incentives. If the tribes already have trademark protection and can go after infringers merely because they have violated the intrinsic trademark rights that the tribe has in that tribe's name, then tribes have one less reason to register their trademarks or to set up certification marks. Registration imposes costs in the form of filing fees, time, and attorneys' fees. If a tribe may enforce trademark rights without having laid out these costs, then the tribe is much less likely to pursue registration. Furthermore, the certification trademark opportunity suggested by several commentators and offered through the IACA mandates a very proactive role for the tribe-owner of that mark. A tribe seeking to avoid investing this effort might do so by relying solely on the trademark-type rights that accrue through IACA and the unqualified use regulation.

Registration of Native American tribe names as trademarks with respect to arts and crafts provides several important benefits to the tribes. Only products bearing registered marks benefit from the counterfeiting laws that allow customs to stop fraudulently-marked products at the nation's door.^[63] Considering that most of the estimated \$160 million in fake Native American products are imports,^[64] keeping these products out of United States commerce entirely would be an ideal solution. Trademark registration can prevent these imports altogether.

Registration also assures that Native American tribes will be able to assert their trademark rights in other nations that have signed on to TRIPS. Because each Member nation must honor the marks registered by other nations,^[65] tribes who register their marks are assured international protections that otherwise are unavailable. As the market for Native American products continues to grow beyond the United States,^[66] and as tribes become concerned about protecting their names

globally, registration is the only tool that can guarantee rights outside the United States. Finally, trademark registration puts producers in other countries on notice that the tribe name is protected by trademark. Unlike the IACA provisions, trademark registration provides benefits that comprehensively protect the Native American rightsholder.

C. Domestic Disturbance II: IACA Trademark Rights in “Indian”

Understanding IACA to create trademark rights in the words “Indian” and “Native American” is problematic in ways that are entirely different from creating trademark rights in the names of Indian tribes. This is so because, while the owner of the Native American tribe name trademark rights ostensibly is the tribe itself, IACA does not clarify what entity might own the trademark rights to the word “Indian.” The IACA defines Indian as any member of a recognized tribe, but this definition has proven to be underinclusive and extremely controversial. Because ownership of the trademark rights to the “Indian” mark may not vest in one group, the mark may never be registered as a certification mark and, indeed, may never be registered at all.

The Lanham Act assumes that every trademark has an exclusive owner. This assumption is clear from the registration requirement that the registrant/applicant be the “owner” of the mark and the requirement that the registrant either confirm that “no other person have the right to use such mark” or provide detailed information about the concurrent uses of that mark.^[67] Collective and certification marks, which do not require a “commercial or industrial” establishment/owner, the potential users of the mark must be part of a defined group and meet that group’s qualifications.^[68] Because there is no one definition and no one set of standards for a designator of ethnicity for Native Americans, such a group never can constitutionally be formed and “Indian” never can be a registered trademark designating products made by Indians.

The IACA recognizes that there is no one owner of the “Indian” trademark rights for arts and crafts, and it therefore allows enforcement of trademark rights by any individual Indian, any Indian tribe, and any Indian arts and crafts organization. This allocation of rights to many parties creates two related problems. First, because damages are statutory and the Indian claimant need not show harm as part of a claim, then presumably every individual Indian, Indian tribe, and arts and crafts organization has a separate and equal cause of action against each individual who uses the words “Indian” or “Native American” without meeting the statutory requirements. Thus far, no defendant has had to answer subsequent claims filed by more than one rights-holder. However the possibility exists that an unknowing defendant^[69] could be held accountable for countless monetary claims arising out of a single sale.

A second inequity that arises out of the lack of specified ownership in the trademark rights that IACA vests in “Indian” is evident by the case law that is developing under this statute. A number of cases have been brought under IACA,^[70] but only one plaintiff has been asserting its rights under the statute and only one law firm has been bringing these claims. This retail plaintiff is not who Congress might have imagined would be protected by IACA. Specifically, this plaintiff is not an Indian tribe struggling to compete in the market, and this plaintiff is not a craftsman working against lower-cost imports. Rather, this plaintiff is a sophisticated retailer of Indian-made products that happens to be certified as an Indian arts and crafts organization by an Indian tribe, and this plaintiff has brought claims against huge retailers that happen to carry mass-produced products of the Native American motif.^[71]

The rights created by IACA can be construed as creating “private attorneys general,” and the attendant abuses that accompany private enforcement of federal law are evident here. Specifically, one plaintiff and one law firm have received a windfall of epic proportions under IACA, giving rise to the specter of professional plaintiffs and predatory attorneys.^[72] If “Indian” trademark rights, and IACA itself are, as has been suggested, ultimately about “fairness,”^[73] then perhaps the gains from IACA lawsuits ought to flow to all Native Americans, rather than one particularly suave organization.

The notion of vesting ownership of trademark rights in only those people and groups who meet the statutory definition of “Indian” raises entirely separate concerns regarding freedom of speech and questions about the connection between trademark rights and identity. The notion of what “Indian” even means may be very personal and individual, and certainly many people consider themselves Indian regardless of tribal affiliation.^[74] Many individuals who self-identify as Native American are not “Indians” under the statute.^[75] These “unlabeled” Native Americans have not somehow forfeited their constitutional right to claim their own heritage, yet they have not been given the affirmative trademark rights available to those that fall within the definition.

III. Mooting the Misfit: Can “Indian” Trademark Rights Fit Within Existing Trademark Law?

Legal thinkers have suggested a number of different solutions for the problem of protecting Native American rights generally and the problem of IACA specifically. The concern for indigenous peoples’ rights is not an issue unique to the United States, and ultimately an internationally-proscribed *sui generis* protection may be the only answer.^[76] In the meantime, the trademark-rights understanding of IACA

creates a myriad of concerns, begging the question: to what extent do existing trademark laws already provide trademark protection to these terms?

Individual Native American tribes can (and sometimes do) trademark their names for the purpose of selling arts and crafts and related products. As noted, however, the term “Indian” for such products cannot exist as a valid trademark because the total group of Native Americans defies a single definition, and thus a grant of ownership in the term “Indian” to one group likely would exclude others with valid, though separate, claims to ownership of that mark. This subsection will analyze the potential issues that may arise when attempting to protect Native American tribe names through trademark law, and ultimately concludes that trademark law is not the best framework to protect these rights.

A. Existence of a Valid Trademark under the Lanham Act

An Indian tribe seeking relief for the unauthorized use of a tribe name in which that tribe claims trademark rights first must demonstrate the existence of a valid trademark or service mark.^[77] Section 45 of the Lanham Act defines a protectable trademark as “any word, name, symbol, or device . . . used by a person . . . to identify and distinguish his or her goods . . . from those manufactured or sold by others and to indicate the source of the goods.” To be protectable, the Indian tribe name must be (1) of the proper subject matter; (2) distinctive; and (3) used in commerce.

Under the proper subject matter requirement, any aspect of a commercial product that may carry meaning can be eligible for trademark protection,^[78] although word marks and logos were the first categories of source identifiers to be protected as trademarks.^[79] Today, source identifiers including color,^[80] packaging, and design^[81] all may be protected marks under the doctrine of trade dress. This expanding notion of what may be a protected trademark (or trade dress) suggests that

Native American tribes may even possibly seek trademark protection of their traditional designs, patterns, and imagery.^[82] At a minimum, tribe names such as “Hopi” and “Navajo” are word marks that fall into the most traditional trademark category and thus are the proper subject matter for trademark protection.

Second, a Native American tribe must prove that the subject mark is distinctive^[83] when used in conjunction with Indian-motif arts and crafts products. This analysis may be problematic for some Native American claimants, and three possible roadblocks arise particularly in the context of common tribe names. First, a mark only has inherent distinctiveness if that mark is arbitrary, fanciful, or suggestive.^[84] An Indian tribe may argue that its own name is just that; Indian tribe names only have entered our vocabulary because the names were coined by the Native Americans, and these names do not originate from the English language.

Although the term “Hopi” used to sell arts and crafts is not arbitrary,^[85] the term itself could be viewed as fanciful^[86] because the word “Hopi” initially had no meaning other than the meaning given by the Native Americans themselves. Some tribe names, such as the Schaghticoke tribe of Connecticut,^[87] still may be so foreign to the American consumer that the term continues to qualify as fanciful. Tribe names such as “Hopi” and “Navajo” do have contemporary meanings, however, because these terms have worked their way into the English language.^[88] Although tribe names once might have been fanciful, this characterization no longer applies. The contemporary meaning of a word is the relevant meaning, and many Indian tribe names no longer can be considered fanciful.^[89]

A thin line separates, analytically, suggestive marks from descriptive marks, although suggestive marks are inherently distinctive while descriptive marks are

not.^[90] Common Native American tribe names more likely would be characterized as descriptive terms. Many names of Native American tribes now have dictionary meanings,^[91] and the common uses of these words include use as descriptors of products made by those groups. Also, a mark is suggestive if it “requires imagination, thought, or perception to reach a conclusion as to the nature of the goods.”^[92] The use of the word “Navajo” alone, as a commercial mark, would not immediately lead a consumer to assume that the product being described was an arts and crafts product, but little imagination would be required to conclude that the product was something handmade and of a Native American motif.

Competitor need and use also is relevant to the descriptive/suggestive analysis.^[93] If other companies would find the mark useful in marketing products, then the mark probably is descriptive.^[94] Here, the word Navajo clearly has value to any producer who seeks to market arts and crafts products created in the Navajo style. Terms that actually are used by competitors in describing their own products probably are descriptive terms.^[95] Indeed, the word “Navajo” already is subject to widespread use by competitors who seek to market arts and crafts that are designed in this style.

The “personal-name rule”^[96] also may have application to Native American tribe names. The personal-name rule embodies the generalization that personal names are, by nature, descriptive rather than suggestive trademarks.^[97] However, the personal name rule only is codified in the Lanham Act to prevent trademark registration of a name that is “primarily merely a surname”^[98] and a tribe name is unlike a surname that is carried by many unrelated individuals. Also, as the Seventh Circuit has pointed out, the personal name rule only ought to apply where the rationale underlying the rule is coherent. The rationale behind the personal-name rule

is that courts have been reluctant to grant protection that would result in individuals being unable to use their own names in their own businesses.^[99] This rationale has no application in the context of tribe names.

Assuming that common Indian tribe names are found to be descriptive terms, they will be protected as trademarks only upon a showing of secondary meaning.^[100] Secondary meaning means that the mark “must denote to the consumer ‘a single thing coming from a single source.’”^[101] Secondary meaning is a question of fact that may be proven directly through surveys or may be proven through circumstantial evidence such as manner of advertising, volume of sales, and length of use on the market.^[102] This requirement may become problematic for some Native American tribes, most notably the tribes with which the American consumer is less familiar. Tribes that have achieved notoriety will have less difficulty establishing that their tribe names represent “a single thing coming from a single source,” as most consumers would immediately understand a product marketed as “Navajo blanket” as a product coming from, and only from, the Navajo tribe. Tribes such as the Schaghticoke tribe, however, will be hard-pressed to establish secondary meaning; to these tribes, the designation of tribe name as inherently distinctive will be critical.

Tribes that are particularly well known also may struggle to prove that their tribe names have not become generic, because generic marks are not entitled to any trademark protection.^[103] Courts have formulated the test for genericness in several different ways,^[104] but the underlying question is whether the trademark primarily indicates to the consumer who made the product or primarily indicates the exact nature of the product. In the “Navajo blanket” example, genericness could pose a real obstacle to a tribe seeking protection. Specifically, would consumers more likely

think that the blanket was *made by* Navajo Indians or would consumers more likely think that the blanket was made in the Navajo *style*?

An Indian tribe seeking to prove the existence and ownership of a valid trademark also must show first use in commerce, defined in the Lanham Act as “the bona fide use of a mark in the ordinary course of trade, and not merely made to reserve the right in a mark.”^[105] Some Indian claimants may be able to prove that their tribes have used their tribe names commercially in a manner that is “deliberate and continuous, not sporadic, casual, or transitory.”^[106] Not all uses by Indian tribes of their names may be sufficient to establish trademark rights in those names, however, particularly where a tribe has not, itself, marketed any arts and crafts products to the public. In fact, some tribes would prefer not to commoditize their names and their cultural products at all, and these tribes likely cannot show any commercial use of those names.

In such cases, the doctrines of surrogate use and analogous use may fill in the gaps. Analogous use supports trademark validity where the “use is of the nature and extent as to create public identification of the target term” with the claimant’s particular product.^[107] An Indian tribe name with which consumers are familiar, therefore, may have an association with products created in the style of that tribe even without the tribe actually selling arts and crafts. Where individual tribe members have used the tribe name as a source identifier, surrogate use may provide the tribe itself with a claim to ownership in the name as a mark.^[108]

To maintain trademark protection, the Native American claimant also has an ongoing duty to use the tribe name and to control the use of that name by third parties.^[109] Thus, the Native American tribe who seeks traditional protection in trademark law is obligated to continue its own use and to police others’ uses,

including uses by individual tribe members. “Naked licensing,” a grant of permission to use a mark without the imposition of quality control measures, could signify a loss of control.^[110] Products marketed by members of any Native American tribe likely will be of varying quality and could include craft products that are mass-produced and craft products that are substandard or not produced in the traditional manner of that tribe. Such standardization of tribe products may be beyond the tribe’s ability or desire.

B. Trademark Infringement: Not Always a Clear Case

Assuming that a Native American claimant can establish a valid mark, the claimant still must state a claim against the competitor who has somehow impinged on those rights. Trademark infringement claims provide some relief for some tribes, although infringing uses still may be permitted under the doctrine of fair use.

Under section 43(a) of the Lanham Act, a user is liable for infringement when that party’s use “is likely to cause confusion . . . as to the affiliation, connection, or association . . . or as to the origin, sponsorship, or approval of his or her goods.”^[111] The circuits all have developed similar multi-factor tests for assessing the likelihood of confusion,^[112] although the underlying test for whether a competitor has unfairly infringed on the tribe’s trademark rights inevitably is whether the competitor’s use increases the chance that “an appreciable number of ordinarily prudent purchasers will be misled, or indeed simply confused, as to the source of the goods in question.”^[113]

The likelihood of confusion determination generally is one of fact^[114] and the outcome of the analysis will depend on the particular tribe name at issue and the particular type of arts and crafts product that the competitors are marketing. Several factors in this

analysis, however, ought generally to weigh in favor of the Indian tribe claimant. For example, marks generally are compared to show the similarities between the two marks^[115] and similarities between the goods and services marketed by the two claimants.^[116] A competitor's use of the term "Navajo" for blankets essentially would mirror the Navajo tribe's use of the term "Navajo" for hand-woven blankets, both in terms of the . Similarly, the competitor's intent to confuse^[117] is relevant and, arguably, ought to be a required factor in the analysis.^[118] Many competitors intentionally brand their products with tribe names like "Navajo" primarily with the intent to confuse; it is this bad faith that prompted the IACA statute in the first place.

Native American tribes face an additional hurdle when using trademark infringement suits to vindicate rights: the defendant can claim fair use as a defense to that defendant's use of a trademark. One aspect of the fair use doctrine recognizes that the descriptive aspect of a mark may be used by competitors to describe their own products without infringement.^[119] So, if a competitor produces a "Navajo-style" blanket, the producer may use the word "Navajo" in its descriptive sense to explain its own product. Further, the producer would be hard-pressed to explain the nature of its product without using that descriptor. This defense is most problematic where tribes have achieved notoriety, because small, relatively unknown tribes like the Schaghticoke probably could argue that its tribe name is not descriptive to begin with.

A separate cause of action under which a Native American tribe might bring a claim, dilution refers to "the lessening of the capacity of a famous mark to identify and distinguish goods."^[120] To succeed on such a claim, a Native American tribe must establish that (1) the mark is famous, and (2) that the mark has suffered actual dilution, most commonly in the form of tarnishing or blurring.^[121] As a threshold requirement, only famous marks would receive protection under the dilution statute,

but the most well-known Native American tribe names are the ones most often misappropriated by competitors. At a minimum, a tribe must be using its name in commerce in a multi-state area before dilution protection would be permitted.^[122]

IV. Mincing the Misfit: Trademark Law Discarded in Favor of False Advertising

Trademark causes of action ultimately may not always yield results consistent with the policies behind IACA and with our intrinsic sense that Native American arts and crafts always ought to be protected from competition by cheap imitations. Native American tribes and individual Native Americans may be better off relying on false advertising under the Lanham Act.

A federal claim for false advertising arises under the Lanham Act but does not require ownership of a valid trademark as a prerequisite for rights.^[123] Rather, a Native American tribe or producer must prove:

“(1) a false statement of fact by the defendant in a commercial advertisement about its own or another’s product; (2) the statement actually deceived or has the tendency to deceive a substantial segment of its audience; (3) the deception is material, in that it is likely to influence the purchasing decision; (4) the defendant caused its false statement to enter interstate commerce; and (5) the plaintiff has been or is likely to be injured as a result of the false statement, either by direct diversion of sales from itself to defendant or by a loss of goodwill associated with its products.”^[124]

Despite the apparent complexity of the false advertising provision, this cause of action ultimately is much more consistent and useful than the trademark lens through which courts and commentators have begun to view IACA and Native Americans’ claims to

their names. By enforcing Native Americans' rights through false advertising claims rather than through trademark claims, many of the concerns created by the trademark paradigm evaporate. Notably, the international concerns arising from TRIPS and from the Paris Convention disappear entirely merely by shedding any analogy to trademark rights. When the practical problem is viewed as the fraudulent misuse of a descriptor ("Navajo" for blankets that are cheap imitations) rather than the vindication of intellectual property rights held by an ethnic group, the legal question becomes much more straightforward.

False designations of arts and crafts products as "Native American," "Navajo," or even of the Schaghticoke tribe all are actionable under the federal cause of action for false advertising as set forth above. A false statement need not be factually false; a statement that could be true but that nonetheless is misleading still will be actionable^[125] and a statement also can be literally false by necessary implication.^[126] A competitor who argues that "Navajo blanket" merely refers to the blanket's style rather than the blanket's origin, therefore, also will face the argument that the statement is misleading, even if technically true. The deception requirement does not invoke any confusion analysis, rather a Native American plaintiff merely must demonstrate that the statement was deceptive and influenced the purchasing decision. Finally, the injury requirement is understood broadly enough that "lost goodwill" constitutes injury, and surely the loss of goodwill results when a "duped" consumer is unsatisfied with an inferior product that it believed was genuine.

A false advertising claim is available to anyone who "is or is likely to be damaged" by the false advertising, and a claimant's status as a direct competitor gives rise to a reasonable belief that the claimant stands in such a position.^[127] Unlike trademark law, which vests ownership and the right to litigate a trademark in one

entity, this open-ended standing requirement more closely approximates IACA's grant of trademark rights to all concerned individuals who meet the statutory requirements. The false advertising harm requirement, while conceptually narrower than IACA, actually would prevent some of the challenges imposed by IACA itself. By restricting potential plaintiffs to actual competitors, and providing realistic measures of damages, the cause of action is less susceptible to abuse.

Third, the existence of a false advertising claim does not create disincentives that lessen the possibility that tribes will register their own trademarks. Unlike the IACA's apparent creation of absolute trademark rights, the false advertising cause of action exists entirely outside the trademark system, and registration remains the only way for a Native American tribe to seek affirmative rights.

Finally, by focusing on the competitor's fraud rather than the plaintiff's rights, no "owner" of the rights need exist at all. IACA's statutory definition of "Indian" no longer is relevant. In each false advertising claim, the particular plaintiff will bear the burden of showing status as a competitor. A plaintiff with no demonstrable "Indian-ness" will not be able to state a claim for false advertising, but courts judging such claims will be free to determine whether a claimed Native American plaintiff has a sufficiently strong showing of harm from imposters.

CONCLUSION

Commentators, claimants and courts all have been quick to conclude that IACA creates affirmative, trademark-like rights in the use of "Native American" and other terms. Yet if these rights do exist, they clash with the existing trademark system on several levels. Further, an analysis of these words as they might be treated within the trademark system demonstrates that trademark law does not provide consistent

protection and, in the case of “Indian” itself, provides no protection at all. By changing focus from the vindication of affirmative rights to a focus on stopping fraud and misrepresentation, however, a coherent alternative emerges. It’s time that we dispensed with the trademark notion altogether and seek a more straightforward and coherent legal doctrine under which to protect the Native American arts and crafts industry, and the federal false advertising claim provides a much better legal fit.

^[1] William J. Hapiuk, Jr., Note: Of Kitsch and Kachinas: A Critical Analysis of the Indian Arts and Crafts Act of 1990, 53 Stan. L. Rev. 1025 (2001).

^[2] Gail K. Sheffield, *The Arbitrary Indian: The Indian Arts and Crafts Act of 1990* (University Press 1997), at 138.

^[3] *Native American Arts, Inc. v. Waldron*, 399 F.3d 871, 874 (7th Cir. 2005).

^[4] 18 U.S.C. § 1159 (pre-1990).

^[5] the Indian Arts and Crafts Board exists within the Department of the Interior, not the Bureau of Indian Affairs. Nancy Kremers, *Speaking With a Forked Tongue in the Global Debate on Traditional Knowledge and Genetic Resources: Are U.S. Intellectual Property Law and Policy Really Aimed at Meaningful Protection for Native American Cultures?*, 15 Fordham Intell. Prop. Media & Ent. L.J. 1, n. 409 (2004)

^[6] Hapiuk, Jr., *supra* note 1, at n. 65.

^[7] Sheffield, *supra* note 2, at 16.

^[8] Hapiuk, Jr., *supra* note 1, at 1018. The 1935 Act provided criminal penalties for anyone to “willfully offer[ed] or display[ed] for sale any goods . . . as Indian products . . . when such person knows such goods are not Indian products.” *Id.* (citing 18 U.S.C. 1159 (pre-1990)).

^[9] \$500 fine or six months imprisonment or both. *Id.*

^[10] Hapiuk, Jr., *supra* note 1, at 1018.

^[11] *Id.* at 1017 (citing Int’l Trade Admin., U.S. Dep’t of Commerce, Study of Problems and Possible remedies Concerning Imported Native American-Style Jewelry and Handicrafts (1985)).

^[12] *Id.*

^[13] Sheffield, *supra* note 2, at 24.

^[14] Hapiuk, Jr., *supra* note 1, at 1018.

^[15] 18 U.S.C. § 1159 (1994).

^[16] 25 U.S.C. § 305e (1994).

^[17] In 2005, another IACA amendment was passed by the Senate and introduced in the House of Representatives. Indian Arts and Crafts Amendment Act of 2005, S. 1375, 109th Cong. (2005). The Indian Arts and Crafts Amendments Act of 2005 would allow any federal law enforcement officer to investigate sales under IACA, rather than restricting enforcement to the FBI as under the current IACA. *Id.* Arguably, the greater the scope of enforcement of IACA's criminal provisions, the less need exists for "private attorneys general" and a private cause of action.

^[18] 25 U.S.C. § 305d (1994).

^[19] 25 U.S.C. § 305a(g) (1994).

^[20] *Id.*

^[21] *Id.*

^[22] Kremers, *supra* note 5, at 76.

^[23] Lanham Act § 1.

^[24] 25 U.S.C. § 305e (1994).

^[25] The IACA statute defines the term "Native American" synonymously with the term "Indian."

^[26] 25 U.S.C. § 305e (1994).

^[27] Kremers, *supra* note 5, at 74. Many Native Americans have valid reasons to decline enrollment, and others have legitimate reasons why they are ineligible to enroll. *Id.* Professor Kremers also has foreseen the emergence of a "pan-tribal" Indian identity as more Native Americans move to urban areas and find that, although they self-identify as "Indian," they are, for whatever reason, less interested in tribal particulars. *Id.*

^[28] See Hapiuk, Jr., *supra* note 1, at 1034-36 (for a discussion of various responses by Native American artists and the rationales behind those responses).

^[29] Sheffield, *supra* note 2, at 13.

^[30] 25 C.F.R. § 309.24(a)(2).

^[31] 25 U.S.C. § 305e (1994).

^[32] Pub. L. No. 106-497, 114 Stat 2219 (2000).

^[33] *Id.*

^[34] 25 U.S.C. § 305e (1994).

^[35] *Id.*

^[36] 39 F.3d 871 (7th Cir. 2005).

^[37] *Id.* at 873.

^[38] *Id.*

^[39] *Id.*

^[40] *Id.* at 876.

^[41] Judge Posner understood the regulation to be a “statement of enforcement policy,” providing the Board itself with guidance as to when misrepresentation is believed to have occurred. *Id.* However, Posner also analyzed the legal issue under the supposition that the regulation did govern suits to enforce the Act. *Id.*

^[42] *Native American Arts, Inc. v. Hartford Casualty Insurance Co.*, 435 F.3d 729, 734 (7th Cir. 2006).

^[43] *See, e.g., The Swiss Colony, Algoma Doll* (2006) available at <http://www.swisscolony.com/shopping/product/detailmain.jsp?itemID=123270&path=1%2C2%2C1932%2C1940&itemType=PRODUCT&ASRPR=1&AS=1&keyword=RW7332> (last visited Apr. 24, 2006) (on file with the author). A description of the doll reads “This Algoma Doll is a Christmas Village Exclusive with a limited edition of 5000. This beautiful doll with hand-painted porcelain head, arms and legs, wears a colorful, richly detailed costume adorned with fringe and beads. Certificate of Authenticity included. Algoma Doll *is not made by Native Americans.*” *Id.* (emphasis added).

^[44] Thekla Hansen-Young, *Whose Name is it, Anyway? Protecting Tribal Names from Cybersquatters*, 10 Va. J.L. & Tech. 1 (2005).

^[45] *Ho-Chunk Nation v. J.C. Penney Company, Inc.*, 1999 U.S. Dist. LEXIS 18181 (N.D. Ill. 1999) (“this Court must examine the false designation provision of the Lanham Act to gain some insight into [the] “false suggestion” language of the Indian Arts and Crafts Act”).

^[46] (as at least one publication suggested), Hapiuk, Jr., *supra* note 1, at 1015-15 (citing *Economist, On the Warpath*, at 94 (Sept. 5, 1992)).

^[47] Indian Arts and Crafts Board, *The Indian Arts and Crafts Act of 1990*, available at www.doi.gov/iacb/act.html (last visited Apr. 3, 2006) (characterizing the IACA as a consumer protection law).

^[48] The Amateur Sports Act of 1978, 36 U.S.C. §§ 371-396 (1978).

^[49] *San Francisco Arts & Athletics, Inc. v. U.S. Olympic Committee*, 483 U.S. 522 (1987).

^[50] Agreement on Trade-Related Aspects of Intellectual Property Rights, Apr. 15, 1994, 33 I.L.M. 1197 (1994) [hereinafter TRIPS].

^[51] Leigh Ann Lindquist, *Champagne or Champagne? An Examination of U.S. Failure to Comply with the Geographical Provisions of the TRIPS Agreement*, 27 Ga. J. Int’l & Comp. L. 309, 310 (1999).

^[52] TRIPS, *supra* note 48, at preamble part b.

^[53] TRIPS, *supra* note 48, at art 3.1.

^[54] USPTO, Report on the Official Insignia of Native American Tribes, at 32, 45 (Sept. 30, 1999), *available at*: <http://www.uspto.gov/web/offices/com/sol/notices/insgstdy.pdf>.

^[55] Lanham Act § 35.

^[56] Letter from the International Trademark Association, to the USPTO (Apr. 16, 1999) *available at*: <http://www.uspto.gov/web/offices/com/hearings/natinsig/comments/inta.pdf>

^[57] *Id.* at 4.

^[58] *Id.*

^[59] Kremers, *supra* note 5, at 130.

^[60] *Id.*

^[61] at least according to Judge Posner, Native American Arts, Inc., 399 F.3d at 873-74.

^[62] Interestingly, the PTO evidently believes that the trademark creation provision of IACA has been implemented, and it cites that provision as one reason why the PTO itself need not grant any additional protections to Native Americans and Native American tribes. Kremers, *supra* note 5, at 79 (citing USPTO Report, *supra* note 54)

^[63] Ross Cosmetics Dist. Ctr. v. U.S., 1994 Ct. Int'l Trade LEXIS 189 (1994).

^[64] Hapiuk, Jr., *supra* note 1, at 1017.

^[65] TRIPS, *supra* note 48, at art 3.1.

^[66] *Id.* at n. 297.

^[67] Lanham Act, § 1.

^[68] Lanham Act, § 4.

^[69] IACA is a strict liability scheme, and even unintentional violations are actionable. 25 U.S.C. § 305e (1994).

^[70] See Native Am. Arts, Inc. v. Hartford Cas. Ins. Co., 435 F.3d 729 (7th Cir. 2006); Native Am. Arts Inc. v. Waldron Corp., 399 F.3d 871 (7th Cir. 2005); Native Am. Arts, Inc. v. Aquino, 2004 U.S. Dist. LEXIS 21867 (N.D. Ill. 2004); Native Am. Arts, Inc. v. Brundy-Howard, Inc., 2002 U.S. Dist. LEXIS 12682 (N.D. Ill. 2003); Native Am. Arts, Inc. v. Earthdweller, Ltd., 2002 U.S. Dist. LEXIS 9750 (N.D. Ill. 2002); Native Am. Arts, Inc. v. Chrysalis Inst., Inc., 2002 U.S. Dist. LEXIS 4772 (N.D. Ill. 2002); Native Am. Arts, Inc. v. Cracker Barrel Old Country Store, Inc., 2001 U.S. Dist. LEXIS 15346 (N.D. Ill. 2001); Native Am. Arts, Inc. v. Adobe Moon Arts, Inc., 2001 U.S. Dist. LEXIS 501 (N.D. Ill. 2001); Ho-Chunk Nation ex. rel. Native Am. Arts, Inc. v. J.C. Penney Co., 1999 U.S. Dist. LEXIS 18181 (N.D. Ill. 1999); Ho Chunk Nation ex. rel. Native Am. Arts, Inc. v. Nature's Gifts, Inc., 1999 U.S. Dist. LEXIS 3687 (N.D. Ill. 1999); Native Am. Arts v. Village Originals, 25 F. Supp. 2d 876 (N.D. Ill. 1998); Native Am. Arts v. Moon Raven Int'l, 1998 U.S. Dist. LEXIS 9111 (N.D. Ill. 1998); Native Am. Arts v. Chico Arts, 8 F. Supp. 2d 1066 (N.D. Ill. 1998).

^[71] Hapiuk, Jr., *supra* note 1, at 1014 (the claim against J.C. Penney was for \$240 million and the claim brought against Wal-Mart was for \$120 million).

^[72] See Douglass C. Buffone, *Predatory Attorneys and Professional Plaintiffs: Reforms are Needed to Limit Vexatious Securities Litigation*, 23 *Hoefstra L. Rev.* 655 (1995).

^[73] Hapiuk, Jr., *supra* note 1, at 1021 (“it simply ‘isn’t fair’ that the unscrupulous are passing off and trading on the good will and the traditions of the Native Americans.”)

^[74] *Id.* at 1057.

^[75] *Id.*

^[76] Dan Rosen, *A Common Law for the Ages of Intellectual Property*, 38 *Miami L. Rev.* 769, 772 (1984) (“The continuing challenge of intellectual property law is not deciding how to treat new creations that are sui generic. Rather, it is determining whether a new thing is like an old. Put another way, it is the classic problem of the common law: treating like cases alike.”)

^[77] LA 45, R3d Unfair Competition 9

^[78] *Qualitex Co. v. Jacobson Prods. Co., Inc.*, 514 U.S. 159 (1995) (granting trademark registration under the Lanham Act to the use of color alone as a source identifier).

^[79] Graeme B. Dinwoodie, *The Death of Ontology: A Technological Approach to Trademark Law*, 84 *Iowa L. Rev.* 611, 621-22 (1999).

^[80] *Qualitex Co.*, 514 U.S. 159.

^[81] *Traffix Devices, Inc. v. Marketing Displays, Inc.*, 532 U.S. 23 (2001)

^[82] The legal tests governing trade dress protection for packaging and design continue to develop, and the Supreme Court continues to struggle with questions of trade dress protection. See, e.g., Lars Smith, *Trade Distinctiveness: Solving Scalia’s Tertium Quid Trade Dress Conundrum*, 2005 *Mich. St. L. Rev.* 243 (2005). A complete analysis of whether or not traditional Native American patterns and designs may constitute protectable trade dress is outside the scope of this article.

^[83] *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

^[84] *See id.*

^[85] arbitrary meaning the use of a familiar word in an unfamiliar way, *see id.* at n. 12,

^[86] fanciful meaning the creation of a previously unknown term invented solely for its use as a trademark, *see id.*,

^[87] *See Sheffield*, *supra* note 2, at 64-73 (listing the multitude of American Indian tribes that have no federal recognition).

^[88] For example, “Navajo” is defined as “a member of an American Indian people of northern New Mexico and Arizona. <http://www.m-w.com/dictionary/Navajo>

^[89] *See, e.g., Bayer Co., Inc. v. United Drug Co.*, 272 F.505 (S.D.N.Y. 1921).

^[90] *Zatarain’s Inc. v. Oak Grove Smokehouse Inc.*, 698 F.2d 786 (5th Cir. 1983).

^[91] *See, e.g., supra* note 88 (dictionary definition of “Navajo”)

^[92] *Zatarain's, Inc.*, 698 F.2d 786.

^[93] *Id.*

^[94] *Id.*

^[95] *Id.*

^[96] *Peaceable Planet, Inc. v. Ty, Inc.*, 362 F.3d 986 (7th Cir. 2004) (identifying the “personal-name rule” as a common law rule).

^[97]

^[98] Lanham Act, § 2.

^[99] *Peaceable Planet*, 362 F.3d 986.

^[100] *Zatarain's, Inc.*, 698 F.2d 786.

^[101] *Id.* (quoting *Coca-Cola Co. v. Koke Co.*, 254 U.S. 143, 146 (1920)).

^[102] *Zatarain's, Inc.*, 698 F.2d 786.

^[103] *Filipino Yellow Pages, Inc. v. Asian Journal Pubs, Inc.*, 198 F.3d 1143 (9th Cir. 1999).

^[104] *See, e.g., id.* (describing the “who-are-you/what-are-you” test); *see also In re Dial-A-Mattress Corp.*, 240 F.3d 1341 (Fed. Cir. 2001) (identifying the test as a two-step test: first, what is the genus of the goods or services and, second, is the mark understood to refer to the genus or to the particular product?)

^[105] Lanham Act, § 45.

^[106] *See Circuit City Stores, Inc. v. CarMax, Inc.*, 165 F.3d 1047, 1054-55 (6th Cir. 1999).

^[107] *T.A.B. Systems v. Pactel Teletrac*, 77 F.3d 1372, 1375 (Fed. Cir. 1996).

^[108] The doctrine of surrogate use has been used to demonstrate a band’s use and ownership of their group’s name as a trade name, vesting ownership of the name in the band itself rather than in the individual band members who used the name. *Robi v. Reed*, 173 F.3d 739-740 (9th Cir. 1999).

^[109] Lanham Act § 45 (abandonment occurs when “any course of conduct of the owner, including acts of omission as well as commission, cause the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark.”)

^[110] *See Dawn Donut Co., Inc. v. Hart’s Food Stores, Inc.*, 267 F.2d 358, 366-67 (1959) (uncontrolled use of a mark can result in products of “diverse qualities” bearing the same trademark).

^[111] Lanham Act § 43(a). Although this section also has been understood to create an “unfair competition” cause of action, and although the section title reads “False Designations of Origin and False Descriptions Forbidden,” this section essentially creates a cause of action for common law trademark infringement and is invoked when the trademark at issue is not registered. *Id.*; *see also Dinwoodie*, *supra* note X, at 447.

^[112] for a circuit-by-circuit comparison of the legal tests, *see* Graeme B. Dinwoodie & Mark D. Janis, *Trademarks and Unfair Competition: Law and Policy*, at 470-71 (Aspen Publishers 2004).

^[113] *McDonald's Corp. v. Druck & Gerner, DDS., P.C.*, 814 F. Supp, 1127 (N.D.N.Y. 1993) (internal quotation omitted).

^[114] *Libman Co. v. Vining Industries, Inc.*, 69 F.3d 1360 (7th Cir. 1995)

^[115] *See, e.g., Virgin Enterprises Ltd. v. Nawab*, 335 F.3d 141 (2d Cir. 2003) (reversing the lower court because the trial court had given insufficient weight to the fact that the parties' marks both consisted of the word VIRGIN).

^[116] *See Aunt Jemima Mills Co. v. Rigney Co.*, 247 F.407 (2d Cir. 1917) (noting that, although likelihood of confusion is most readily created between identical products, related products that do not compete with each other, but are labeled with the same mark, also could create confusion as to source).

^[117] *See McDonald's Corp.*, 814 F. Supp. 1127 (N.D.N.Y. 1993) (focusing on the defendant's intent to confuse and overall bad faith in choosing a mark substantially similar to the plaintiff's family of marks).

^[118] *Dinwoodie*, *supra* note X, at 499.

^[119] *Brother Records, Inc. v. Jardine*, 318 F.3d 900 (9th Cir. 2003).

^[120] Lanham Act § 45.

^[121] *Moseley v. Secret Catalogue Inc.*, 537 U.S. 418 (2003) (holding actual dilution, rather than likelihood of dilution, to be the standard, although actual dilution was presumed where the marks were identical).

^[122] *Star Markets, Ltd. v. Texaco, Inc.*, 950 F. Supp. 1030 (D. Haw. 1996).

^[123] Lanham Act § 43(a)(1).

^[124] *United Industries Corp. v. Clorox Co.*, 140 F.3d 1175 (8th Cir. 1998) (internal citation omitted).

^[125] *Castrol, Inc. v. Pennzoil Co.*, 987 F.2d 939 (3d Cir. 1993).

^[126] *See, e.g., Novartis Consumer Health, Inc. v. Johnson & Johnson-Merck Consumer Pharm. Co.*, 290 F.3d 578, 586-87 (3d Cir. 2002).

^[127] *See, e.g., Warner-Lambert Co. v. Breathasure, Inc.*, 204 F.3d 87 (3d Cir. 2000)