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INTELLECTUAL PROPERTY RIGHTS AND NATIVE AMERICAN TRIBES

Richard A. Guest*

[A]ll Property is Theft.¹

Introduction

In recent years, several Native American tribes have begun a journey into the unfamiliar terrain of intellectual property rights as a means to assert their self-determination, secure economic independence, and protect their cultural identities. Although "ideas about property have played a central role in shaping the American legal order,"² in the prevailing legal literature of intellectual property law in the United States, the protection of Native American intellectual property rights is rarely an issue of consideration. Suzan Shown Harjo, in her article, *Native Peoples' Cultural and Human Rights: An Unfinished Agenda*, writes: "The cultural and intellectual property rights of Native Peoples are worthy of being addressed during this time of increased appropriation of Native national names, religious symbology, and cultural images."³

In contrast, within the realm of international law, the topic of intellectual property is a high priority, uniting the concerns for self-determination and economic independence. For example, the International Alliance of the Indigenous-Tribal Peoples of the Tropical Forests set out in the articles of its Charter demands for respect of the right to self-determination of indigenous peoples and guaranteed rights their intellectual property.⁴ The most

* J.D., 1994, University of Arizona College of Law. The original version of this paper was submitted as a substantive thesis in the Tribal Law Seminar at the University of Arizona College of Law. A shortened, edited version of this paper was presented at the Sixty-fifth Arizona Town Hall "American Indian Relationships in a Modern Arizona Economy" by Robert A. Hershey, whose expertise, encouragement, and support made this article possible.

1. P.J. PROUDHON, WHAT IS PROPERTY? AN INQUIRY INTO THE PRINCIPLES OF RIGHT AND OF GOVERNMENT 11-12 (B.R. Tucker trans. 1966) (Paris 1840). In the author's opinion, this slogan is at the heart of all property issues confronting Native American tribes and indigenous communities.

2. Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 288 (1988).

3. Suzan Shown Harjo, *Native Peoples' Cultural and Human Rights: An Unfinished Agenda*, 24 ARIZ. ST. L.J. 321, 328 (1992).

4. Statement of the International Alliance of the Indigenous-Tribal Peoples of the Tropical Forests, Penang, Malaysia (Feb. 15, 1992). The coordinating committee of IAITPTF included: COICA (Amazonia); Asociacion Cultural Sehekto (Central America and Caribbean); Centro Moccovi 'Ialek Lav'a' (Southern Cone-Argentina); Association for the Promotion of Batwa (Africa); Naga Peoples Movement for Human Rights (Continental Asia); Sahabat Alam Malaysia (Malaysia); KAMP-National Federation of the Indigenous Peoples of the Philippines (Maritime

comprehensive recognition for protection of the intellectual property of indigenous peoples is the *Draft Universal Declaration on the Rights of Indigenous Peoples* which states: "Indigenous peoples have the right to special measures for protection, as intellectual property, of their traditional cultural manifestations, such as their literature, designs, visual and performing arts, cultigens, medicines, and knowledge of the useful properties of fauna and flora."⁵

Thus, in the United States, Native American tribal councils and communities are beginning to ask the question as to whether their intellectual property, as they perceive their intellectual property to exist, can be protected. This article seeks to explore the issue of whether Native American tribes can protect themselves from the increased appropriation of their intellectual property under existing U.S. law.⁶

Part I introduces the reader to the intriguing world of intellectual property and the distinction between Native American intellectual versus cultural property. Part II focuses on existing patent, copyright, and trademark law in the United States and whether Native American tribes can utilize those laws to protect their intellectual property: Section A summarizes existing patent law and examines the lack of protection for Native traditional seeds and folk crop varieties; Section B summarizes copyright law and illustrates the lack of protection for Native cultural images and expressions. Section C summarizes trademark law and analyzes whether Native American tribal names can be

Asia and the Pacific).

5. U.N. WORKING GROUP ON RIGHTS OF INDIGENOUS PEOPLES, DRAFT UNIVERSAL DECLARATION ON THE RIGHTS OF INDIGENOUS PEOPLES at 35, U.N. DOC. E/CN.4/Sub.2/1991/40/Rev. 1 (1991). This document is still in the drafting stages and carries no legal force upon those who do not sign the final version.

Further, in the international arena: the Organization of American States issued a convention which recognized state ownership of cultural property, *see* ORGANIZATION OF AMERICAN STATES, CONVENTION ON THE PROTECTION OF THE ARCHEOLOGICAL, HISTORICAL, AND ARTISTIC HERITAGE OF THE AMERICAN NATIONS (Convention of San Salvador 1976); the Coordinadora de las Organizaciones Indigenas de la Cuenca Amazonica (COICA: Coordinating Body of the Indigenous Organizations of the Amazon Basin) has issued an agenda which demands that there be no development projects in indigenous areas without the informed consent of the indigenous peoples affected, *see* Coordinating Body of the Indigenous Organizations of the Amazon Basin, Agenda for the Bilateral and Multilateral Funders of Amazon Development (1989); the FAO Commission on Plant Genetic Resources issued a draft providing standards of ethical field behavior for germplasm collectors and maintains that sponsors, curators, and users have long-term responsibilities, *see* FAO COMMISSION ON PLANT GENETIC RESOURCES, DRAFT OF INTERNATIONAL CODE OF CONDUCT FOR PLANT GERmplasm COLLECTING AND TRANSFER (1991).

6. This article is intended as an introduction to intellectual property law for Native American tribal councils, communities and advocates as they consider alternatives for the protection of their intellectual property. An exhaustive case study and legal analysis of the vast area of intellectual property law, the Indian Arts and Crafts Act, and the numerous problems inherent in their application to Native American tribes is beyond the scope of this article.

protected. Part III highlights the Indian Arts and Crafts Act (IACA) as a potential source of protection of Native American intellectual property and explores the potential application of the IACA to each of the Native American intellectual property issues discussed in Part II.

I. The Intriguing World of Intellectual Property

A. Just What Is Intellectual Property?

In recent years, intellectual property law has become a growing and dynamic area of American jurisprudence, in search of its philosophical and moral foundation. Although intellectual property law in the United States finds its source in constitutional and statutory provisions, as Justice Stewart observed in *Board of Regents v. Roth*, property interests "are not created by the Constitution . . . [r]ather they are created and their dimensions are defined by existing rules and understandings that stem from an independent source"⁷

Whereas real and personal property laws encompass a bundle of rights to tangible or physical objects, intellectual property law simply involves a bundle of rights to intangible or non-physical objects: "[I]ntellectual property is not really property at all; the things that we call intellectual property are really rights to do certain things, to authorize others to do certain things, and to prevent others from doing certain things."⁸ Intellectual property commonly refers to novel expressions or embodiments of ideas. Ideas which generally do not receive protection are common "everyday" ideas which are generic in nature, extraordinary ideas which disclose facts about the world (such as scientific principles), and ideas which are already in widespread public use.⁹

In the United States, the most common forms of intellectual property are protected through patent, copyright, and trademark law.¹⁰ Generally, patent law is the protection of novel ideas or inventions; copyright law is the protection of original expressions; and trademark law is the protection of a company's name and symbols. In this context, the intellectual property of Native American tribes would encompass the expressions of their cultural identity and the embodiments of their indigenous heritage.

As mentioned above, intellectual property is not really property, but rights to do certain things and to prohibit others from doing certain things. Thus, for Native American tribes, examples of intellectual property would include the rights to the knowledge of medicinal qualities inherent in indigenous fauna

7. 408 U.S. 564, 577 (1972); see also Hughes, *supra* note 2, at 288.

8. Christopher C. Larkin, *Traps for the Unwary: Avoiding Some Common Mistakes in Intellectual Property Law*, 27 BEVERLY HILLS B.A.J. 89 (1993).

9. Hughes, *supra* note 2, at 319-23.

10. This article does not address other emerging areas of intellectual property law such as trade secrets, unfair competition, dilution statutes, or personality/publicity claims.

and flora; the embodiment of oral traditions and religious ceremonies; the expression of native art and designs; the use of tribal names and symbols; and most importantly, the right to prohibit their use by others. Although existing patent, copyright, and trademark law in the United States offers significant protection and economic benefit for individuals and companies, it fails to recognize and protect the unique nature of Native American intellectual property.

B. Cultural Versus Intellectual Property

At this juncture, it is important to distinguish Native American intellectual property from Native American cultural property. In general, cultural property has been defined as historical, archaeological, and ethnographical objects, works of art, and architecture that embody a culture.¹¹ The Native American Graves Protection and Repatriation Act of 1990 (NAGPRA) describes five categories of Native American "cultural items": (1) human remains; (2) associated funerary objects; (3) unassociated funerary objects; (4) sacred objects; and (5) cultural patrimony.¹²

The passage of NAGPRA by Congress in 1990 demonstrated a "renewed interest in and more enlightened view toward Native American cultures" and established a fundamental principle of Native American ownership of their cultural property.¹³ During this enlightened period of renewed interest in Native American cultures, Congress also overhauled the Indian Arts and

11. J.H. Merryman, *The Public Interest in Cultural Property*, 77 CALIF. L. REV. 339, 341 (1989). In the article, the author cites the UNESCO Convention on the Means of Prohibiting and Preventing the Illicit Import, Export, and Transfer of Ownership of Cultural Property, Nov. 14 1970, 823 U.N.T.S. 231 (1970), which defines cultural property to include:

(a) Rare collections and specimens of fauna, flora, minerals and anatomy, and objects of palaeontological interest; (b) property relating to history, including the history of science and technology and military and social history . . . ; (c) products of archaeological excavations . . . ; (d) elements of artistic or historical monuments or archaeological sites which have been dismembered; (e) antiquates more than one hundred years old, such as inscriptions, coins and engraved seals; (f) objects of ethnological interest; (g) property of artistic interest . . . ; (h) rare manuscripts and incunabula, old books, documents and publications of special interest . . . ; (i) postage, revenue and similar stamps . . . ; (j) archives, including sound, photographic and cinematographic archives; (k) articles of furniture more than one hundred years old and old musical instruments.

Merryman, *supra*.

12. 25 U.S.C. §§ 3001-3013 (1994).

13. Leonard D. DuBoff, *Protecting Native American Cultures*, OR. ST. B. BULL., Nov. 1992, at 9. DuBoff discusses the long history of legislative protection of cultural property in the United States which included Native American tribes beginning with the Antiquities Act of 1906. 16 U.S.C. §§ 431-433 (1988). However until NAGPRA, the presumption existed that remains and antiquities on federal lands belonged to the United States. NAGPRA also extended the repatriation process to publicly funded museums and universities.

Crafts Act of 1935 (IACA)¹⁴ to expand the protection of Native American arts and crafts by encouraging tribes to register their trademarks and by assisting Native American artisans to market their works. The distinction between NAGPRA and IACA offer insight into the basic differences between the cultural versus the intellectual property of Native American tribes.

First, while NAGPRA established protection for and repatriation of Native American objects and cultural patrimony in a historical-sacred context, IACA offers protection for and encourages production of Native American arts and crafts in a contemporary-economic context. Second, while NAGPRA restricts access to historical-sacred sites and limits the alienability of Native American artifacts on the antiquities market, IACA seeks to expand the market for Native American artists' contemporary works by assuring the authenticity of the works.¹⁵ In short, cultural property encompasses the protection and preservation of the historical embodiments of the "sacred" within Native American culture, while intellectual property encourages the protection and production of the contemporary expressions of Native American "secular" culture.¹⁶

A third important difference is the underlying policy for the protection of cultural property versus the underlying policy for the protection of intellectual property. The laws protecting cultural property seem to be driven by an innate societal value for the preservation of historical objects which express, identify, and memorialize our humanity.¹⁷ In relation to Native American cultural property, the passage of NAGPRA is viewed as a formal acknowledgement by the United States that the sacred culture of Native Americans "is a vital part of the ongoing lifeway of the United States, and as such, must be respected, protected, and treated as a living spiritual entity — not as a remnant museum specimen."¹⁸ Thus, the underlying policy of laws protecting cultural property, including Native American cultural property, is the promotion of the moral well-being of society and a recognition that "the past is vital in the creation of the future."¹⁹

In contrast, intellectual property rights in the United States are driven by the economics of free enterprise and profit. The underlying policy of patent and copyright law is the creation of a limited monopoly right as an economic incentive for individuals and companies to disclose their innovative inventions or to publish their original expressions. The policy underlying trademark law

14. 25 U.S.C. §§ 305-305c (1994).

15. Duboff, *supra* note 13.

16. Rennard Strickland, *Implementing the National Policy of Understanding, Preserving and Safeguarding the Heritage of Indian Peoples and Native Hawaiians: Human Rights, Sacred Objects, and Cultural Patrimony*, 24 ARIZ. ST. L.J. 175, 184 (1992).

17. Merryman, *supra* note 11, at 341.

18. Strickland, *supra* note 16, at 176.

19. Rennard Strickland & Kathy Supernaw, *Back to the Future: A Proposed Model Tribal Act to Protect Native Cultural Heritage*, 46 ARK. L.R. 161 (1993).

is the protection of American consumers by allowing companies the exclusive use of names and symbols to distinguish their products. In relation to Native American intellectual property, the underlying policy of IACA is the promotion of the economic welfare of Native American tribes and protection of consumers through the creation and registration of trademarks of genuineness and quality.²⁰ Thus, the protection of intellectual property, including Native American intellectual property, is simply intended to serve the greater end of promoting the economic well-being of society.

However, both NAGPRA and IACA require Native American tribes to take the initiative in and responsibility for the protection of their cultural and intellectual property. NAGPRA focuses on Native American tribes as the center of any factual determination and legal interpretation of what is sacred cultural property.²¹ This decision-making process requires Native American tribes also to determine what is not sacred, albeit secular property which could possibly receive protection under IACA. What is clear is that Native American tribes must take the initiative to adopt and the responsibility to enforce their own native arts, religion, and cultural codes for the protection of their cultural and intellectual property.²²

Native peoples are free under the law to define themselves and their lifeways, including their own legal system's definition of what is a sacred object, what is cultural patrimony, what property may be transferred by individuals, and what property can be alienated or placed in trust only be the entire tribal group.²³

II. Patents, Copyrights and Trademarks: The Protection of Native American Intellectual Property

A. Patent Law, Traditional Seeds and Folk Crop Varieties

One current area of increasing controversy is the protection of plant genetic resources as intellectual property. Plant genetic resources are developed by scientists in the laboratory for companies who then exclusively market the improved seeds and products they yield. Early in the history of the United States, Thomas Jefferson recognized that "the greatest service which can be rendered any country is to add a useful plant to its culture."²⁴ At present, a full range of intellectual property protection is applied to plants.²⁵

20. 25 U.S.C. § 305(a) (1994).

21. 25 U.S.C. § 3001(3)(C)-(D), 3001(13) (1994).

22. Strickland & Supernaw, *supra* note 19, at 162.

23. Strickland, *supra* note 16, at 180.

24. THE GARDEN AND FARM BOOKS OF THOMAS JEFFERSON 509 (Robert C. Baron ed., 1987).

25. Neil D. Hamilton, *Who Owns Dinner: Evolving Legal Mechanisms for Ownership of Plant Genetic Resources*, 28 TULSA L.J. 587, 594 (1993) [hereinafter Hamilton, *Who Owns*

Unfortunately, indigenous farmers whose traditional knowledge and labor developed and preserved genetic resources over the centuries in the form of traditional seeds, crop varieties and medicinal plants receive no protection and little compensation for their contribution.²⁶ For those who question the contribution of indigenous farmers, consider these facts: the international seed industry alone accounts for over \$15 billion per year, much of which derived its original organic materials from traditional crop varieties; the annual world market value of medicines derived from medicinal plants acquired from indigenous peoples is \$43 billion; and the projected sales of natural products such as natural insecticides, fragrances, dyes, etc., derived from plant genetic materials acquired from indigenous peoples, will exceed all other food and medicinal products combined.²⁷

1. Patent Law: A Summary

Patent law finds its source in the United States Constitution, Article I, Section 8, which states: "The Congress shall have power . . . To promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive rights to their respective writings and discoveries." Pursuant to this constitutional provision, Congress acted immediately and enacted the Patent Act of 1790 during the second session of the First Congress.²⁸ Currently, patent law is codified at 35 U.S.C. §§ 1-376, otherwise known as the Patent Act of 1952,²⁹ which provides: "Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."³⁰

The United States Supreme Court has characterized the nature and underlying policy of patents:

The stated objective of the Constitution in granting the power to Congress to legislate in the area of intellectual property is to "promote the Progress of Science and useful Arts." The patent laws promote this progress by offering a right of exclusion for a limited period as an incentive for inventors to risk the often enormous costs in terms of time, research and development. The productive effort thereby fostered will have positive effect on

Dinner].

26. Neil D. Hamilton, *Feeding Our Future: Six Philosophical Issues Shaping Agricultural Law*, 72 NEB. L. REV. 210, 250 (1993) [hereinafter Hamilton, *Feeding Our Future*].

27. Darrell Posey, *Intellectual Property Rights and Just Compensation for Indigenous Knowledge*, ANTHROPOLOGY TODAY, Aug. 1990, at 13, 15.

28. See Act of Mar. 3, 1897, ch. 391, § 1, 29 Stat. 692, 692.

29. Act of July 19, 1952, ch. 950, 66 Stat. 792.

30. 35 U.S.C. § 101 (1994).

society through the introduction of new products and processes of manufacture into the economy and the emanations by way of increased employment and better lives for our citizens. In return for the right of exclusion — this "reward for inventions," — the patent laws impose upon the inventor a requirement of disclosure. To insure adequate and full disclosure so that upon the expiration of the 17-year period "the knowledge of the invention inures to the people, who are thus enabled without restriction to practice it and profit by its use," the patent laws require that the patent application shall include a full and clear description of the invention and "of the manner and process of making and using it" so that any person skilled in the art may make and use the invention. When a patent is granted and the information contained in it is circulated to the general public, and those especially skilled in the trade, such additions to the general store of knowledge are of such importance to the public wealth that the Federal government is willing to pay the high price of 17 years of exclusive use for its disclosure, which disclosure, it is assumed, will stimulate ideas and the eventual development of further significant advances on the art.³¹

Generally there are three statutory requirements an invention or discovery must meet in order to receive a patent: novelty, utility, and non-obviousness.³² Novelty refers to whether the invention or discovery was "known or used," and utility requires that the invention or discovery have some discernable usefulness.³³ Non-obviousness relates to whether the differences between the subject matter of the patent at the time of invention and the existing "prior art" is obvious to a person having ordinary skill in the art.³⁴

Three types or categories of U.S. patents are recognized by statute: utility patents; design patents; and plant patents. The utility patent, the most common form of patents issued by the Patent and Trademark Office, protects a new and useful invention or discovery of a "process,³⁵ machine,³⁶

31. *Kewanee Oil Co. v. Bicron Corp.* 416 U.S. 470, 480-81 (1974).

32. 35 U.S.C. §§ 101-103 (1994); *see also* *Graham v. John Deere Co.*, 383 U.S. 1, 12 (1966).

33. 35 U.S.C. §§ 101-102 (1994). These two sections express the "new and useful" tests to be applied in determining patentability.

34. *Id.* § 103.

35. The term "process" has been simply defined as an act or series of acts performed upon specific subject matter to produce a different state or physical result. *Cochrane v. Deener*, 94 U.S. 780, 788 (1877). For example, a process can be the combination of two or more chemicals; the use of one or more tools or machines to obtain a specific result; surgical procedures and methods of diagnosis or treatment; computer programs, or new methods of using a substance or producing a product.

36. The term "machine" is considered to be a physical structure consisting of parts or

manufacture³⁷ or composition of matter."³⁸ A utility patent grants to an inventor an exclusive monopoly right for 17 years³⁹ as incentive to fully disclose his new and useful discovery for the present benefit and future profit of society at large. This limited monopoly right authorizes a patent owner to exclude others from making, using, or selling the patented inventions.⁴⁰

The design patent protects the ornamental-nonfunctional appearance of a product: "[w]hoever invents any new, original and ornamental design for an article of manufacture may obtain a patent . . ."⁴¹ Unlike utility patents, in addition to the requirements of novelty and non-obviousness, design patents must satisfy the unique requirement of being "ornamental." A design which is primarily functional (has utility) is not patentable.⁴² The purpose of design patents is to give encouragement to the decorative arts and to stimulate the exercise of inventive faculties in improving the appearance of articles of manufacture.⁴³ The duration of a design patent is 14 years.⁴⁴

A plant patent is used to protect newly discovered asexually reproduced plants: "[w]hoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent. . ."⁴⁵ The Plant Patent Act was enacted by Congress to provide incentive for and encouragement of private industry investment in plant breeding research and development.⁴⁶ The secondary purpose "was to avoid the judicial interpretation which had

elements which are arranged and organized to cooperate, when set in motion to produce a predetermined utilitarian result. *Burr v. Duryee*, 68 U.S. (1 Wall) 531, 570 (1864). A machine may be human-powered or automated.

37. The term "manufacture" has been defined as an item for a particular use made from raw materials prepared by giving the raw materials new forms, qualities, properties, or combinations whether by hand or machine. *American Fruit Growers, Inc. v. Brogdex Co.*, 283 U.S. 1 (1931). For example, a manufacture includes sound recordings, tools, clothing, and structures such as buildings or bridges.

38. The term "composition of matter" refers to "all compositions of two or more substances and all composite articles, whether they be the result of chemical union, or of mechanical mixture, or whether they be gases, fluids, power or solids." *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980). Examples include concrete, gasoline, paint, paper, and products of genetic engineering.

39. 35 U.S.C. § 154 (1994).

40. *Id.* § 271(a).

41. *Id.* § 171.

42. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 697 (2d Cir. 1961).

43. *Gorham Co. v. White*, 81 U.S. 511, 528 (1872); *Hueter v. Compco Corp.*, 179 F.2d 416, 417 (7th Cir. 1950).

44. 35 U.S.C. § 173 (1994).

45. *Id.* § 161.

46. S. REP. NO. 315, 71st Cong., 2nd Sess. (1930); H.R. REP. 1129, 71st Cong., 2nd Sess. (1930).

been placed on the then-existing patent laws that products of nature are not statutory subject matter.⁴⁷

According to the Manual of Patent Examining Procedure, the term "plant" is to be used in its ordinary and common sense, not a strict scientific meaning.⁴⁸ The statutory requirements for a plant patent are: (i) there be an inventor or discoverer of the plant;⁴⁹ (ii) the inventor or discoverer asexually reproduces the plant;⁵⁰ (iii) the plant be "distinct and new";⁵¹ and (iv) the plant's distinguishing characteristics be "non-obvious."⁵²

2. Plant Patents and the Protection of Zuni Folk Varieties

Pursuant to the provisions of the Zuni Land Conservation Act of 1990,⁵³ the Zuni tribe of New Mexico created the Zuni Conservation Project through which the Zuni Sustainable Agriculture and Zuni Folk Variety Projects were developed. In part, the goals of these projects are the revitalization of Zuni farming and the exploration of alternatives for the protection of traditional Zuni seeds and folk crop varieties. The Zuni concern for protection is shared by other Native American tribes who recognize:

More and more people around the country and around the world are becoming interested in special and "traditional" food crops and foods. For some, the reason is the characteristic of the crops such as ability to resist drought or diseases. Others are interested in the

47. *In re Bergy*, 596 F.2d 952, 982 (C.C.P.A. 1979).

48. U.S. PATENT & TRADEMARK OFFICE, MANUAL OF PATENT EXAMINING PROCEDURE § 1601 (3d rev. ed. 1977) [hereinafter MANUAL OF PATENT PROCEDURE].

49. "Invents or discovers" refers to one who either develops, intentionally generates or recognizes a new plant. *Ex parte Moore*, 115 U.S.P.Q. (BNA) 145 (1957).

50. "Asexually reproduces" means "other than from seeds, such as by the rooting of cuttings, by layering, budding, grafting, inarching, etc. MANUAL OF PATENT PROCEDURE, *supra* note 48, § 1601. Asexual reproduction is the "very essence" of a plant patent. *Yoder Bros., Inc. v. California-Florida Plant Corp.*, 537 F.2d 1347, 1380 (5th Cir. 1976).

51. For plant patents the requirement of distinctiveness replaces that of utility while novelty refers to novelty of conception rather than novelty of use. *See Graham v. John Deere Co.*, 383 U.S. 1, 30 (1966). As applied to plants, a "new" plant had to be one that literally had not existed before, not a newly found or discovered plant. *Ex parte Foster*, 90 U.S.P.Q. (BNA) 16 (1951).

Also, "distinct and new" is judged by whether the plant variety has "characteristics clearly distinguishable from those of existing varieties, and it is immaterial whether in the judgment of the Patent Office the new characteristics are inferior or superior to those existing varieties." Leslie J. Kasten, Jr., *Tupes of Patents*, in ALI-ABA COURSE OF STUDY, SECURING AND ENFORCING PATENT RIGHTS 15, 21 (1990), available in Westlaw, C567 ALI-ABA 15.

52. 35 U.S.C. § 103 (1994) (as applied to utility patents and analogized to plant patents); *see also Yoder Bros.*, 537 F.2d at 1379 (stating that the "non-obvious" requirement refers to the development of a new variety of plant "that retains the desirable qualities of the parent stock and adds significant improvements," and stating that if the plant is a source of food, the improvement is increased nutritive content; if medicinal, the improvement is changed therapeutic value; if ornamental, the improvement is increased beauty or desirability).

53. Pub. L. No. 101-486, 104 Stat. 1174.

special tastes, the health benefits, or the "novelty" of the crop or food.⁵⁴

The goal of protecting Zuni seeds and folk crop varieties includes the formulation of policy options to establish intellectual property rights consistent with Zuni traditions. These policy options include: the collection of seeds at Zuni by outsiders; the distribution of seed from the Zuni seedbank; and the use of Zuni seeds already removed from Zuni or which may be taken in the future and subjected to genetic manipulation, patenting and commercial sales.⁵⁵

The Zuni Folk Varieties Project has raised the question of whether Zuni farmers could seek protection of their traditional seeds and folk crop varieties under existing U.S. law. Consider the following:

In the United States a plant breeder may claim "breeders rights" to new varieties under the Plant Variety Protection Act, a plant patent on asexually reproducing plants under the 1930 Plant Patent Act, and an actual patent on a newly engineered plant, under a 1985 patent office decision. In addition, seed breeders, such as hybrid seed corn producers, may use the law of trade secrets to protect the identity of their parent lines.⁵⁶

Is it possible for Zuni farmers to receive the same protection for their traditional seeds and folk crop varieties? The two potential sources for protection under existing U.S. law, discussed herein, are the Plant Variety Protection Act and the Plant Patent Act.⁵⁷

While similar statutory requisites exist, certain significant distinctions between the Plant Variety Protection Act and the Plant Patent Act should be understood. First and foremost, the Plant Variety Protection Act creates a right of protection to the "breeder of any novel variety of *sexually* reproduced plant,"⁵⁸ while the Plant Patent Act offers patent protection to one who "invents or discovers and *asexually* reproduces any distinct and new variety of plant."⁵⁹ Second, the plant breeder's right of plant variety protection is in

54. Daniela Soleri, *Zuni Crops and the Zuni Name*, ZUNI FARMING FOR TODAY & TOMORROW, Summer 1993, at 19, 19 (no. 2).

55. Daniela Soleri & David Cleveland, *Gifts from the Creator: Intellectual Property Rights and Folk Crop Varieties 5-6* (draft version 1993) (used with permission of the authors).

56. Hamilton, *Feeding Our Future*, *supra* note 26, at 252.

57. The Plant Variety Protection Act is codified at 7 U.S.C. §§ 2321-2583 (1994). The Plant Patent Act is codified at 35 U.S.C. §§ 161-163 (1994). The potential application of *Ex parte* Hibberd, 227 U.S.P.Q. (BNA) 443 (Bd. Pat. App. & Int. 1985), and the law of trade secrets (mentioned in Hamilton's article) to the protection of Zuni seeds and Folk crop varieties is beyond the scope of this article.

58. 7 U.S.C. § 2402(a) (1994) (emphasis added).

59. 35 U.S.C. § 161 (1994).

the form of an 20-year certificate, not a 17-year patent.⁶⁰ Both the plant variety protection certificate and the plant patent authorize the owner to exclude others from selling, using, or reproducing the protected plant.⁶¹

Although the United States has codified "plant breeders rights", it has resisted any effort to recognize the developing international legal protection to indigenous communities and farmers for their traditional seeds and folk crop varieties offered to plant breeders under the Plant Variety Protection Act and the Plant Patent Act. Such protection would not meet the statutory requisites and appear to be in direct conflict with the underlying policy of U.S. law.

First, U.S. law requires that the person applying for the plant variety protection certificate or plant patent must be the breeder, inventor, or the original conceiver of the novel plant variety.⁶² Second, U.S. law does not protect products of nature unless they have been significantly altered. In order for a plant variety to receive protection, it must have characteristics which are novel and distinct.⁶³ In other words, the plant must have "characteristics clearly distinguishable from those of existing varieties."⁶⁴ Most important, under U.S. law the novelty requirement prohibits the protection of a plant variety already in public use or on sale more than one year prior to the date of the application for the plant variety protection certificate or plant patent.⁶⁵

In the field of plant genetic resources, it is being argued that the interests of indigenous farmers who, "over centuries selected and preserved the genetic resources that today fuel biotechnology," must be extended legal protection.⁶⁶ The development and preservation of genetic resources in the form of traditional seeds and folk crop varieties has occurred over generations of indigenous farmers, all of whom contributed their knowledge, time, and labor.⁶⁷ Unfortunately for the Zuni tribe, there is simply no one person identifiable as the breeder, inventor, or discoverer with respect to Zuni traditional seeds and folk crop varieties. The purpose of the laws for plant

60. 7 U.S.C. § 2483(b) (1994).

61. See *id.* § 2483(a); 35 U.S.C. § 163 (1994).

62. See 7 U.S.C. § 2402(a) (1994). A plant variety protection certificate extends protection to the "breeder of any novel variety of sexually reproduced plant." *Id.*; see also 35 U.S.C. § 102(f) (1994) (stating a plant patent shall be issued to a person "unless he did not himself invent the subject matter sought to be patented").

63. See 7 U.S.C. § 2402(a) (1994); 35 U.S.C. § 102(a) (1994).

64. Kasten, *supra* note 51, at 21.

65. 7 U.S.C. § 2402 (a)(1),(2) (1994); 35 U.S.C. § 102(b)(1994).

66. Hamilton, *Who Owns Dinner*, *supra* note 25, at 591.

67. For example, "Zunis have been farmers in the area of the present Zuni Reservation for over 1500 years." Daniela Soleri & David Cleveland, Zuni Folk Varieties Project: Project Summary (1993) [hereinafter Soleri & Cleveland, Project Summary]. Zuni folk varieties were developed by Zuni "farmers in their role as plant breeders, and are adapted to the local physical, social, and cultural environment." *Id.*

variety protection are "to reward individual not group achievement."⁶⁸ This is the primary conflict between existing property law in general, becoming especially acute in efforts to secure intellectual property protection for indigenous peoples. The concept of communal ownership is incompatible with a legal regime based on private property and individual ownership.

Further, most traditional seeds and folk crop varieties are in public use or on sale in the public domain and clearly fall outside the scope of protection.⁶⁹ The Supreme Court has clearly held "Congress may not authorize the issuance of patents whose effects are free to remove existent knowledge from the public domain, or to restrict access to materials already available."⁷⁰ Therefore, the Plant Variety Protection Act and the Plant Patent Act simply do not afford the protection Zuni farmers seek for their traditional seeds and folk crop varieties.

B. Copyright Law: Native Cultural Images and Expressions

The copying of Native American designs and products for their commercial value is not an issue of recent origin. Non-Native companies and individuals have profited enormously through the sale of textiles, jewelry, artwork, sculpture, etc., while explicitly or implicitly representing their products as "Indian made." Imports from East Asia make up an estimated 20% or \$800 million worth of "Indian" crafts sold each year.⁷¹ Congress evidently recognized the misrepresentation of "Indian products" and the subsequent economic harm to Native American tribes as early as 1935 with its passage of IACA. But the failure of the Interior Department to promulgate regulations for the enforcement of the IACA has forced tribes to consider the merits of copyright law.

1. Copyright Law: A Summary

Generally, copyright law is a bundle of rights pertaining to original works of authorship including, but not limited to: literary, musical, or dramatic works; pictorial, graphic or sculptural works; motion pictures and sound recordings.⁷² Copyright law is codified at 17 U.S.C. §§ 101-914, commonly

68. *Potts v. Coe*, 140 F.2d 470, 478 (D.C. Cir. 1944).

69. Public use or sale for more than two years bars the right to a patent. *Bourne v. Jones*, 114 F.Supp. 413, 419 (S.D. Fla. 1951). Under the Plant Variety Protection Act, there is a one year bar for a "public variety." See 7 U.S.C. § 2402(a)(1) (1994).

70. *Graham v. John Deere Co.*, 383 U.S. 1, 6 (1966).

71. *On the Warpath*, *ECONOMIST*, Sept. 5, 1992, at 94.

72. 17 U.S.C. § 102 (1994). The section states in full:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

referred to as the Copyright Act of 1976.⁷³

The owner of a copyrighted work has the exclusive right to reproduce and distribute copies of the work, to prepare derivative works, to display or perform the work, or to import copies of it, and to authorize others to do the same.⁷⁴ Generally, a copyright endures for the lifetime of the author plus fifty years.⁷⁵ One important limitation to a copyright owner's exclusive rights is the "fair use" doctrine which allows reproduction of a copyrighted work for purposes of "criticism, comment, news reporting, teaching, scholarship, or research."⁷⁶

To receive copyright protection, a work must meet the statutory requirements of the Copyright Act of 1976. First, a work must be an "original" work of authorship.⁷⁷ The requirement of originality has a low threshold of creativity and does not require an artistic breakthrough, merely some unique artistic qualities that are more than a mere modification or trivial change to an existing work.⁷⁸ Second, a work must be "fixed in a tangible medium of expression."⁷⁹ The embodiment of the work must be "sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration."⁸⁰

Copyright law and patent law share the same constitutional source and a similar underlying policy.⁸¹ Copyright law seeks to promote the advancement

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

(b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

Id.

73. Pub. L. No. 94-553, 90 Stat. 2598.

74. 17 U.S.C. § 106 (1994).

75. *Id.* § 302(a). In a joint work, the copyright continues for 50 years from the death of the last surviving author. *Id.* § 302(b). In the case of anonymous authors, pseudonymous works and works made for hire, the copyright endures for 75 years from its publication or 100 years from its creation, whichever expires first. *Id.* § 302(c).

76. The "fair use" doctrine is codified at *id.* § 107.

77. *Id.* § 102(a).

78. FRANK H. FOSTER & ROBERT L. SHOCK, COPYRIGHTS AND TRADEMARKS 149 (2d. ed. 1993).

79. 17 U.S.C. § 102(a) (1994).

80. *Id.* § 101 (defining the term "fixed").

81. U.S. CONST. art. I, § 8.

of the arts by offering a limited exclusive monopoly right to authors and artists for the disclosure of their works for the general benefit of society.

2. *Copyrights and the Protection of Hopi Kachinas*

Over the past century, Hopi kachina carvers have established an international reputation for their hand-carved kachinas, which are embodiments of the deities of the Hopi tribe. A single hand-carved kachina requires months of intricate carving with days of thought attributed to each delicate feature. But today, these authentic Hopi kachinas are encountering competition in the marketplace. During the past several years, non-Native Americans have opened five doll factories in northwestern New Mexico utilizing Navajo workers to manufacture machine-cut dolls by the hundreds based on the Hopi designs and retailing for about one-fifth the price of authentic Hopi kachinas.⁸²

Can existing copyright law provide the protection the Hopi tribe seeks for its artisans? The works of Hopi kachina carvers are based on designs passed down through generations of Hopi artisans with no one artist to claim original "authorship." The contemporary works of the Hopi kachina carvers based on century old designs fail the originality requirement, being artistic works already in the public domain. Finally, the limited duration of a copyright would work against the purposes of the Hopi tribe in protecting the kachina designs in perpetuity. Thus, the issue confronting all Native American tribes in the United States is how they protect their oral traditions, ceremonial dances, music and rituals, graphic, pictorial, and sculptural works when they are communal in origin and exist in the public domain. Although these works carry a connotation of "sacredness" within the tribal community, non-Natives usually view these "cultural objects" only in the context of their commercial value.

Western classification systems are out of touch with the American Indian world-view. Indeed, even the terms art, art work, sacred, and secular, as non-Indians use them, embody concepts foreign to Native American societies. Among many Indian peoples, all man-made objects are grouped together and referred to as that-which-has-been-made. The distinction between aesthetic objects, sacred objects, functional objects, public objects, and commercial objects simply does not exist. In a holistic society, there are no such lines.⁸³

Although Native American tribes can seek limited protection under NAGPRA for sacred objects, this protection extends only to objects in their

82. Mark Shaffer & Bill Donovan, *Manufacturing of Fake Kachinas Offend Hopi*, NEWS FROM INDIAN COUNTRY, Feb. 1994, at 6.

83. Strickland, *supra* note 16, at 184.

historical context. Copyright law does not recognize or redress contemporary Native American expressions of their culture which are communal in origin. However, in promoting the development and marketing of contemporary Native American art and art work, IACA may supply the protection sought through trademark certification of the authenticity of the works.

C. Trademarks and Native American Tribal Names

Trademarks and brand names are considered the most valuable assets of manufacturers around the world.⁸⁴ Native American tribal names have been appropriated and used by a variety of companies as part of their corporate names and/or as trademarks to identify their goods or services. For example, in 1970 the Chrysler Corporation Jeep/Eagle Division applied for and received federal trademark registration for its sports utility vehicle, the Jeep "Cherokee."⁸⁵ In 1990 the Mazda Corporation received federal trademark registration for its sports utility vehicle, the "Navajo."⁸⁶

In the 1993 edition of *Brands & Their Companies*,⁸⁷ the editors list thirty-five different products identified using the name "Apache"; twenty-eight using the name "Cherokee"; fourteen using the name "Navaho" or "Navajo"; and three using the name "Zuni". These Native American tribal names are used to identify products such as camping trailers, sailboats, motorcycles, auto accessories, bicycles, hunting accessories, jewelry, clothing, footwear, food products, wall coverings, and the list goes on.

In the 1994 edition of *Companies and Their Brands*,⁸⁸ the editors list five companies which identify themselves using the name "Apache"; four using the name "Cherokee"; and none using "Hopi", "Navajo", or "Zuni." These companies are in manufacturing, construction, mining, agriculture, wholesale, retail, transportation, insurance, finance, and communication industries.

In short, the appropriation of Native American tribal names has occurred in every sector of industry in the United States and is associated across the spectrum of goods and services produced and sold.

1. Trademark Law: A Summary

Trademark law traces its original source to the common law through actual use of marks by guild associations in Europe to identify the sources of their products. Federal registration and protection of trademarks is codified in what is commonly referred to as the Lanham Act.⁸⁹ Congress derives its power to

84. A recent study found that of 30 brand names that ruled their respective classes in 1930, 27 were still number one. J. Hoberman, *Believe It or Not: J. Hoberman on American Myths*, ARTFORUM, Sept. 1990, at 27, 28.

85. THE TRADEMARK REGISTER OF THE UNITED STATES (Patent Searching Serv. 1992) (Library of Congress catalogue card no. 73-86256) [hereinafter TRADEMARK REGISTER].

86. *Id.*

87. SUSAN L. STETLER, *BRANDS & THEIR COMPANIES* (11th ed. 1993 & Supp. 1994).

88. MARK O'MEARA, *COMPANIES AND THEIR BRANDS* (12th ed. 1994).

89. Ch. 540, 60 Stat. 427 (codified at 15 U.S.C. §§ 1051-1127). Also, most states have

legislate for the protection of trademarks pursuant the U.S. Constitution's grant of power under the Commerce Clause.⁹⁰

Trademark law can be described as a bundle of rights to things which serve as symbols to identify and distinguish a person's goods or services from the goods or services of others. Specifically, the Lanham Act defines "trademark" to include "any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others."⁹¹ Oftentimes the term trademark is confused with the terms tradename or service mark, although they are generally treated under the general heading of trademark law:

A trade-mark has reference to the thing sold while a trade name embraces both the thing sold and the individuality of the seller. The term service mark means a mark used in the sale or advertising of services to identify the services of one person and distinguish them from the services of others.⁹²

Trademarks are the embodiment of a company's goodwill and the expression of the source of the good or service. The underlying policy of trademark law is to prevent consumer confusion and assure purchasers of a certain level of quality in a company's goods or services.⁹³ The Lanham Act permits the federal registration of any trademark unless it:

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

(b) Consists of or comprises the flag or coat of arms or other insignia of the United States, or of any State or municipality, or of any foreign nation, or any simulation thereof.

(c) Consists of or comprises a name, portrait, or signature identifying a particular living individual except by his written consent

similar statutes for state registration of trademarks.

90. U.S. CONST. art. 1, § 8, cl. 3 ("The Congress shall have the power to regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes.").

91. 15 U.S.C. § 1127 (1994).

92. *Farmers' Educ. & Coop. Union of Am. v. Iowa Farmers' Union*, 150 F.Supp. 422, 424 (D.Iowa 1957). The term "trade name" is defined as "any name used by a person to identify his or her business or vocation." 15 U.S.C. § 1127 (1994). The term "service mark" is defined as "any word, name, symbol, or device, or any combination thereof used by a person . . . to identify and distinguish the services of one person, including a unique service, from the services of others." *Id.*

93. Larkin, *supra* note 8, at 89.

(d) Consists of or comprises a mark which so resembles a mark registered . . . or a mark or trade name previously used in the United States . . . as to be likely . . . to cause confusion, or to cause mistake, or to deceive

(e) Consists of a mark which . . . is merely descriptive or deceptively misdescriptive, [or] . . . is primarily geographically descriptive . . . or geographically deceptively misdescriptive, . . . or is primarily merely a surname.⁹⁴

Federal registration does not in itself create a property right; rather trademark rights are created through the use of the mark in connection with goods or services in commerce. Although ownership of a trademark can be acquired under the common law at the time a trademark is affixed to a product sold in commerce, the protection to the owner is limited to the geographical area of its use.⁹⁵ The Lanham Act also recognizes that rights to a trademark exist only as of the first use in commerce,⁹⁶ but federal registration confers ownership upon the filing of an "intent-to-use" application⁹⁷ which allows up to a period of three years of constructive use before actual use is required.⁹⁸ Although federal registration of a trademark is constructive notice of the "first to use" priority date, if an actual user of the same or similar mark can show priority under the common law "actual use", the registrant's use of the mark may have some geographical limitations.

Federal registration of a trademark under the Lanham Act also confers certain substantive and procedural benefits to the registrant not available to the owner at common law. Federal registration of a trademark is prima facie evidence of the registrant's ownership and exclusive right to use the mark, proof of continual use of the mark dating back to the date of the application, and that the mark has acquired secondary meaning.⁹⁹ In addition, the registrant is granted jurisdiction in federal court¹⁰⁰ and may recover profits,

94. 15 U.S.C. § 1052 (1994). However, a mark that is merely descriptive, geographical, or a surname can be registered if it has become "distinctive of the applicant's goods in commerce." *Id.* § 1052(f).

95. *Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 131 U.S.P.Q. (BNA) 55 (2d Cir. 1961). Also, this limited protection under the common law continues for the duration the trademark is used in commerce.

96. 15 U.S.C. § 1127 (1994). The term "use in commerce" means the bona fide use of the mark in the ordinary course of trade, and not made merely to reserve a right in the mark. The Lanham Act requires the actual use of the mark in interstate commerce.

97. *Id.* § 1051(b). Under this section, the applicant must have a "bona fide intention to use the mark in commerce."

98. *Id.* § 1051(d). The applicant must file a statement of use with specimens within six months of his intent-to-use application. This section allows for an automatic six-month extension upon request by the applicant and an additional two-year extension in six-month increments upon a showing of good cause by the applicant.

99. *Id.* § 1057(b), (c); *id.* § 1115(a).

100. *Id.* § 1117.

treble damages, and costs.¹⁰¹ Finally, another major benefit of federal registration is that a trademark becomes "incontestable" after five years.¹⁰²

The duration of a federal trademark is a ten-year registration which can be renewed every ten years forever.¹⁰³ Federal registration of a trademark costs \$175 per class. There are thirty-four international classes of trademarks, eight international classes of service marks, two international classes for certification marks, and a separate class for collective marks.¹⁰⁴

2. *Native American Tribal Names and the Lanham Act*

A Native American tribe may have protection under the common law with respect to the goods or services to which it affixes the tribal name and currently sells in commerce. This protection could be analogized to the protection given the marks used by guild associations in Europe. There is no question that Native American tribes can seek federal registration of their tribal names under the Lanham Act for goods and services they currently sell or contemplate selling in the future.

However, the universal and exclusive use of tribal names sought by Native American tribes does not appear possible. Federal registration of a tribal name in association with a product produced by that Native American tribe would only apply to the particular class or classes of products sought within the registration. Generally, the Lanham Act simply does not preclude others from using the same tribal name in association with their products as long as there is no confusion to the public as to source or origin.

The Lanham Act does provide for at least two potential causes of action which a Native American tribe should consider against those who have appropriated their tribal names: a section 43(a) action for misappropriation and/or misrepresentation and a section 1064 action for cancellation of registration. In considering any action under the Lanham Act, a Native American tribe must be aware of potential procedural hurdles they may encounter and the extent of the remedies provided.

101. *Id.*

102. *Id.* § 1065. The *Trademark Register of the United States* reports:

A few limited conditions under which a trademark registered under the Act of 1946 can . . . be canceled after five years are as follows: (1) the mark has been fraudulently registered, (2) the mark has been actually abandoned, (3) the mark was in use by another prior to its publication and such use is continuing, (4) the mark was used to misrepresent the source of goods to which the mark is applied, and (5) the mark was used to violate the anti-trust laws of the United States.

TRADEMARK REGISTER, *supra* note 85, at introduction. One important provision of cancellation of an "incontestable" mark not noted by the Patent and Trademark Office in this publication is violation subsections (a), (b), or (c) of 15 U.S.C. § 1052. See 15 U.S.C. § 1064 (1994).

103. 15 U.S.C. § 1059(a) (1994).

104. TRADEMARK REGISTER, *supra* note 85 (described in "International Schedule of Classes of Goods and Services")

a) *The Section 43(a) Cause of Action*

Consider the following: a company in Nevada is selling a product under the brand name "Zuni Gold Popcorn," while a company in Michigan has trademarked "Hopi Blue Popcorn."¹⁰⁵ Section 43(a)(1) of the Lanham Act creates a civil cause of action "by any person who believes that he or she is likely to be damaged" by the use in commerce by another of

any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact which:

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities¹⁰⁶

This section applies to four categories of statements: (1) any word, name, symbol, or device, or any combination thereof; (2) false designation of origin; (3) false or misleading description of fact; and (4) false or misleading representation of fact.¹⁰⁷

Subsection A is a substantive prohibition wherein a statement in categories (1) or (2) is actionable if it is likely to cause confusion as to the relationship between the speaker and another or their goods.¹⁰⁸ Generally, this is referred to as an action for misappropriation, a doctrine which forbids a person to "reap where he hasn't sown." Misappropriation is generally referred to as a "passing off" case wherein there is an attempt to persuade the consumer that the product's origin or source is different than what it actually is.

Subsection B is a substantive prohibition wherein a statement in categories (3) or (4) is actionable if it misrepresents the "nature, characteristics, qualities, or geographic origin" of goods or services.¹⁰⁹ Generally, this is considered

105. Soleri, *supra* note 54, at 7. These two examples are used precisely because of the close affiliation between the tribes and the products represented. In other words, a § 43(a) cause of action would not be appropriate in the context of the Mazda "Navajo" or Jeep "Cherokee" since there is little possibility of confusion as to source or origin.

106. 15 U.S.C. § 1125 (1994).

107. EDMUND W. KITCH & HARVEY S. PERLMAN, *LEGAL REGULATION OF THE COMPETITIVE PROCESS* 120 (4th ed. 1991).

108. *Id.*

109. *Id.*

a cause of action for misrepresentation or false advertising dealing with the product's qualities other than its source or origin.

Further, a section 43(a) action does not require federal trademark registration by the party bringing the action and is generally referred to as the federal "common law" of unfair competition. The term "person" is defined to include "a firm, corporation, union, association, or other organization capable of suing and being sued in a court of law."¹¹⁰

Can the Zuni tribe and the Hopi tribe bring a section 43(a) cause of action against these companies marketing "Zuni Gold Popcorn" and "Hopi Blue Popcorn?" In order successfully to bring a cause of action for the misappropriation of their tribal names or misrepresentation of the products, the tribes must overcome two procedural hurdles.

First, Native American tribes must establish standing to sue under section 43(a). Under the Lanham Act definition of "person," a Native American tribe must establish it is "capable of suing or being sued in a court of law." Although 28 U.S.C. § 1362 grants Native American tribes a general right to sue in federal courts¹¹¹ the question remains as to whether Native American tribes can be sued. Native American tribes enjoy sovereign immunity "coextensive with that of the United States" which may consent to be sued and thereby waive its sovereign immunity.¹¹² However, a waiver of sovereign immunity from suit by a tribe "cannot be implied but must be unequivocally expressed."¹¹³ Although state sovereign immunity was specifically waived by Congress within the Lanham Act,¹¹⁴ there is no such specific waiver of tribal sovereign immunity. This issue is still an open question of law subject to a court's interpretation of section 43(a) and its applicability to Native American tribes.¹¹⁵

110. 15 U.S.C. § 1127 (1994).

111. 28 U.S.C. § 1362 (1994). The section states:

The district courts shall have original jurisdiction of all civil actions, brought by any Indian tribe or band with a governing body duly recognized by the Secretary of the Interior, wherein the matter in controversy arises under the Constitution, laws or treaties of the United States.

Id. In *Fort Mohave Tribe v. LaFollette*, 478 F.2d 1016, 1018 (9th Cir. 1973), this section was interpreted to authorize an Indian tribe to protect its federally derived property rights in those situations where the United States declines to act.

112. *Ramey Constr. Co. v. Apache Tribe of Mescalero Reservation*, 673 F.2d 315, 319 (10th Cir. 1982).

113. *Santa Clara Pueblo v. Martinez*, 436 U.S. 49, 58 (1978) (quoting *United States v. Tesdan*, 424 U.S. 392, 399 (1976)).

114. 15 U.S.C. § 1122 (1994).

115. A Native American tribe seeking to bring a § 43(a) cause of action may consider adopting an explicit waiver of sovereign immunity with respect to the Lanham Act within its civil ordinances. Otherwise, the courts may generally view tribes to be barred from bringing a § 43(a) action as an entity not capable of being sued in a court of law.

Second, Native American tribes must overcome a judicially created hurdle related to standing. Despite the broad language of section 43(a), in *Johnson & Johnson v. Carter-Wallace Inc.*,¹¹⁶ "any person who believes that he or she is or is likely to be damaged" was narrowly construed only to provide a remedy to "commercial parties." Only a competitor in the relevant market could bring a section 43(a) action. Therefore, the Zuni and Hopi tribes would have to demonstrate for the court their viability as a commercial competitor in the marketplace injured by the use of their Native national names.

If the Zuni and Hopi tribes can overcome both procedural hurdles, the required elements of a section 43(a) cause of action are tailored to the remedy sought. The Lanham Act provides injunctive relief to enjoin use of tribal names by these companies.¹¹⁷ Injunctive relief would be granted upon a showing of either of the following: (1) the use of the tribal name is likely to cause confusion as to the relationship between the companies and the tribes or their goods; or (2) that the representation of "Zuni Gold Popcorn" and "Hopi Blue Popcorn" by these companies misrepresents the "nature, characteristics, qualities, or geographic origin" of these products.¹¹⁸

In addition to injunctive relief, the Lanham Act also authorizes the recovery of defendant's profits, any damages sustained by the plaintiff, and the costs of the action.¹¹⁹ To be granted monetary damages, a higher standard is required wherein the tribes must demonstrate actual lost profits or decline in the market share for their products causally connected to the use of their tribal names by the companies.¹²⁰ In exceptional cases, the court may award reasonable attorney fees to the prevailing party.¹²¹ Finally, the Lanham Act authorizes the destruction of any and all "labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of the defendant" pertaining to the products which have misappropriated tribal names.¹²²

b) The Section 1064 Cancellation of Registration

The Zuni and Hopi tribes could also consider an action pursuant to section 1064 as "any person who believes that he is or will be damaged by the registration of a mark on the principal register."¹²³ This section contains a

116. 631 F.2d 186 (2nd Cir. 1980).

117. 15 U.S.C. § 1116 (1994).

118. Since the statements utilizing Hopi and Zuni are explicitly false designations and representations, a demonstration of "misleading" through consumer surveys is not required. *Coca-Cola v. Tropicana Prods.*, 690 F.2d 312 (2d Cir. 1982).

119. 15 U.S.C. § 1117(a) (1994).

120. The circuit courts are not in agreement with respect to money damages awarded in § 43(a) causes of action. For example, see *Johnson & Johnson v. Carter Wallace*, 631 F.2d 186 (2d Cir. 1980); *Alpo Petfoods, Inc. v. Ralston Purina Co.*, 913 F.2d 958 (D.C. Cir. 1990).

121. 15 U.S.C. § 1117(a) (1994).

122. *Id.* § 1118.

123. *Id.* § 1064.

five year rule of incontestability except in cases alleging the "registration was obtained fraudulently or contrary to the provisions of . . . subsection (a), (b), or (c) of section 1052 of this title."¹²⁴ Under section 1052(a), a trademark's registration can be canceled if it "consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt or disrepute."¹²⁵

The application of 15 U.S.C. §§ 1064 and 1052(a) has been thoroughly analyzed with respect to Native American team names in athletics as immoral, scandalous, disparaging to Native Americans and their beliefs, and bringing Native Americans into contempt and disrepute.¹²⁶ The same analysis could be applied in the context of the use of tribal names in any context where the section 43(a) analysis is too narrow. Thus, an action may lie against the Chrysler Corporation for its use of "Cherokee," against the Mazda Corporation for its use of "Navajo," and against any of the numerous companies which have appropriated Native tribal names in association with their company names and/or products.

In addition to a section 43(a) cause of action, Native American tribes should consider the application of 15 U.S.C. §§ 1064 and 1052(a) in challenging the registration of products such as "Zuni Gold Popcorn" and "Hopi Blue Popcorn." All companies that have appropriated Native American tribal names for themselves or their products which closely parallel Native American enterprises and goods should be challenged on the grounds that those Native American tribal names falsely suggest "a connection with persons, living or dead, institutions, beliefs, or national symbols."¹²⁷

III. Native American Intellectual Property and the Indian Arts and Crafts Act

The recent inquiry and discussion by Native American tribal councils and communities has focused on the potential of existing patent, copyright, and trademark law as the means to protect their intellectual property. However, as discussed in Part II, reliance on those areas of substantive law is largely misplaced given the underlying policies and practices. Attention needs to be re-focused on the potential of utilizing the provisions and expanding the application of the Indian Arts and Crafts Act of 1990 (IACA).¹²⁸

124. *Id.* § 1052(a).

125. *Id.*

126. Paul E. Loving, *Native American Team Names in Athletics: Its Time to Trade These Marks*, 13 LOY. L.A. ENT. L.J. 1, 37-43 (1992).

127. 15 U.S.C. § 1052(a) (1994).

128. 25 U.S.C. §§ 305-309 (1988). For a thorough summary of the history of the IACA, see Jon Parsley, Comment, *Regulation of Counterfeit Indian Arts and Crafts: An Analysis of the Indian Arts and Crafts Act of 1990*, 18 AM. INDIAN L. REV. 487 (1993).

A. *The Underlying Purpose of IACA*

In an effort to re-invigorate Native American tribes and to promote the social and economic welfare of Native Americans, Congress passed the Indian Arts and Crafts Act of 1990, creating the Indian Arts and Crafts Board (the Board) which developed and expanded the market for Indian arts and crafts. However, due to the ambiguity of enforcement provisions and the inadequacy of trademark protection,¹²⁹ legislation was introduced in Congress in 1989 which became the Indian Arts and Crafts Act of 1990.¹³⁰

The overall purpose of IACA is the protection and promotion of Native American art; the promotion of tribal self-sufficiency; the protection of Native American culture; and the protection of consumers against imitations.¹³¹ To accomplish these goals, under IACA the Board has the authority

(1) to create for the Board or for an individual Indian or Indian tribe, or Indian arts and crafts organization trademarks of genuineness and quality for Indian products and the products of an individual Indian or particular tribe or Indian arts and crafts organization; (2) to establish standards and regulations for the use of Government-owned trademarks by corporations, associations, or individuals, and to charge for such use under such licenses; (3) to register any such trademark owned by the Government in the United States Patent and Trademark Office without charge and assign it and the goodwill associated with it to an individual Indian or Indian tribe without charge; and (4) to pursue or defend in the courts any appeal or proceeding with respect to any final determination of that office.¹³²

In addition, IACA authorizes the Board to promulgate regulations "for the effective execution and administration of the powers conferred upon it" subject to the approval by the Secretary of the Interior.¹³³ IACA also authorizes the appropriation of money from the Treasury to "carry out the purposes and provisions" of IACA.¹³⁴ Yet, "the Interior Department has yet

129. H.R. REP. NO. 101-400(I), 101st Cong. 2d Sess. 4 (1990), *reprinted in* 1990 U.S.C.A.N 6382, 6383 (citing ambiguity of state laws on sale of Indian arts and crafts).

130. Rep. Jon Kyl (R.-Ariz.) and Rep. Ben Nighthorse Campbell (D.-Co.) proposed the first version of the legislation known as H.R. 2006, 135 CONG. REC. E1255-03 (daily ed. Apr. 17, 1989). The Indian Arts and Crafts Act of 1990 is codified at 25 U.S.C. §§ 305-305(e) (1994).

131. Parsley, *supra* note 128, at 495-97.

132. 25 U.S.C. § 305a(g)(1)-(4) (1994). Other powers include: market research, *see id.* § 305a(a); technical research and assistance, *see id.* § 305(b); experimentation, *see id.* § 305a(c); interaction with government and private agencies, *see id.* § 305(d); assistance in specific projects, *see id.* § 305a(e); and recommendations for loans, *see id.* § 305a(f).

133. *Id.* § 305b.

134. *Id.* § 305c.

to promulgate any regulations implementing the amendments and, worse still, there is no money in the next budget for the board's expanded duties."¹³⁵

B. Criminal and Civil Causes of Action Under IACA

IACA authorizes the Board to receive complaints of violations and to refer them to the Federal Bureau of Investigation. Following a review of the investigation report, the Board may make its recommendations to the Attorney General of the United States for the initiation of criminal proceedings.¹³⁶ In addition, the Board may recommend that the Secretary of the Interior refer the matter to the Attorney General for civil action.¹³⁷

Criminal penalties are harsh. First time offenders can receive fines up to \$250,000 and up to five years in prison.¹³⁸ Unfortunately, in the nearly sixty years IACA has been on the books "there has not been a single prosecution for its violation."¹³⁹ The remedial provisions of IACA, section 305e, provide injunctive or equitable relief, compensatory damages, punitive damages, and attorney fees to Native American Tribes:

(a) A person . . . may, in a civil action in a court of competent jurisdiction, bring an action against a person who offers or displays for sale or sells a good, with or without a Government trademark, in a manner that falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian or Indian tribe or Indian arts and crafts organization, resident within the United States, to

(1) obtain injunctive or other equitable relief; and

(2) recover the greater of

(A) treble damages; or

(B) 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.

(b) In addition to the relief specified in subsection (a) of this section, the court may award punitive damages and the costs of suit and a reasonable attorney's fee.¹⁴⁰

135. DuBoff, *supra* note 13, at 14.

136. 25 U.S.C. § 305d(a) (1994).

137. *Id.* § 305d(b).

138. Stephanie B. Goldbloom, *Law Protecting Indian Art Stirs Controversy*, A.B.A. J., Apr. 1992, at 32.

139. DuBoff, *supra* note 13, at 14.

140. 25 U.S.C. § 305e (1994).

For purposes of subsection (a), IACA defines the term "person" to include "an Indian tribe on behalf of itself, or an Indian who is a member of the tribe."¹⁴¹

C. Protecting Native American Intellectual Property

For purposes of Native American intellectual property, the most relevant inquiry would be the scope of the term "Indian products" under the provisions of IACA. Unfortunately, the term "Indian products" is not defined within the act; rather it "has the meaning given such term in regulations which may be promulgated by the Secretary of the Interior."¹⁴² The lack of promulgation of regulations by the Secretary of Interior allows Native American tribes an opportunity to ask the courts for a broad interpretation of the IACA to expand the protection of their intellectual property. If the term could be expanded beyond arts and crafts in the literal sense, "Indian products" would encompass Native American traditional seeds and folk varieties, cultural ideas and expressions, and other Native American intellectual property.

1. Protecting Native American Farmers

As discussed earlier in Part II, Section A, the extensive protection the Plant Variety Protection Act and the Plant Patent Act offer to "plant breeders" is simply not available for the protection of Zuni traditional seeds and folk varieties. However, the Zuni and other Native American tribes can offer a viable argument that any definition of "Indian products" should be expansive and include traditional Native American agricultural products or any derivative product of traditional Native American seeds and folk varieties.

For the past fifteen hundred years, the core of Zuni farming has been floodwater irrigation of its folk crop varieties in the arid area of the present Zuni Reservation.¹⁴³ As the forerunners to "plant breeders," Zuni farmers developed and preserved plant resources in the form of Zuni folk varieties with unique characteristics specially adapted to their "local physical, social and cultural environment."¹⁴⁴ Today, Zuni farmers continue to contribute their labor, time, and unique skill in the development of their craft¹⁴⁵ and should be included in the limited protection offered by IACA.

Under an expanded definition of "Indian products," Indian agricultural products would include any food, medicinal, herbal, or other derivative agricultural product which suggests in any manner its source to be from a particular tribe, or origin to be from traditional Indian seeds or folk varieties.

141. *Id.* § 305e(c)(1)(B).

142. *Id.* § 305e(d)(2). Also included in this section is the term "product of a particular Indian tribe or Indian arts and crafts organization."

143. Soleri & Cleveland, Project Summary, *supra* note 67, at 1.

144. *Id.*

145. *Id.*

Thus, companies would be prohibited from marketing agricultural products falsely associated with a Native American tribe and would be prohibited from misleading representations of their agricultural products containing ingredients from traditional Indian seeds or folk varieties. This expanded definition would satisfy the overall purpose of IACA through the protection of the economic welfare of Native American tribes, the promotion of Native American farming as an enduring craft, and the protection of consumers, guaranteeing the authenticity and quality of agricultural products which suggest their source to be from a particular tribe, or origin to be from traditional "Indian" seeds or folk varieties. Companies desiring to market an "Indian product" would then be under a legal obligation to negotiate contracts with Native American tribes and to purchase seeds and folk varieties from Native American farmers.

2. Protecting Native American Artists

The Copyright Act of 1976 does not protect contemporary Native American expressions of their culture whose design and origin is communally based. However, the specific intent of Congress in passing IACA was the promotion of the economic welfare of Native American tribes and artists through the development and protection of Native American arts and crafts. IACA would appear to be the legislative solution for the Hopi and other Native American tribes and their artists concerned with non-Native copying and production of "Indian" art work.

The startling fact that throughout its history there has not been one single prosecution for its violation should not be a deterrent. Native American tribes must become the "squeaky wheel that gets the oil" and initiate the enforcement of the provisions of IACA to realize any protection for their Native artisans, art works, and other cultural expressions. For example, the language of IACA authorizes the Hopi tribe to bring a cause of action against a person who sells a good "in a manner that falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian or Indian tribe." First, Hopi kachina carvers and the Hopi tribe could bring a cause of action against the non-Native companies who manufacture and represent their "dolls" as an "Indian product," even though the factories employ Navajo workers. The factory-made dolls are machine-cut and not "authentic" or "genuine" products of Indian artists. The mere fact that these factories are located on or near an Indian reservation and employ Indian workers does not overcome the language of IACA — that of selling a good "in a manner that falsely suggests it is Indian produced."¹⁴⁶

Second, the representation by any manufacturer other than a Hopi kachina carver that its doll is a "kachina" falsely suggests that the doll is a product of

146. 25 U.S.C. § 305e(a) (1994).

the Hopi tribe — also a violation of IACA.¹⁴⁷ The Hopi tribe can argue that the term "kachina" has acquired a secondary meaning as being unique to the Hopi tribe and representing artwork created by a Hopi artisan. In bringing the cause of action, the Hopi tribe may be successful in enjoining the production of these "dolls," or at a minimum, preclude the manufacturer from using the term "kachina" in association with the dolls.

3. *Protecting Native American Tribal Names*

Although Native American tribes should pursue the available causes of action for misappropriation, misrepresentation, and cancellation of registration under the Lanham Act, IACA is a better alternative for Native American tribes specifically seeking to enjoin the use of their tribal names. IACA creates a specific cause of action for misrepresentation of "Indian goods."¹⁴⁸ Thus, in a civil action against a person who "falsely suggests it is Indian produced, an Indian product, or the product of a particular Indian or Indian tribe,"¹⁴⁹ IACA creates standing for the tribe, eliminating the procedural hurdles of the Lanham Act.¹⁵⁰

IACA created a legal duty upon the Secretary of the Interior through the Indian Arts and Crafts Board "to create Government trademarks of genuineness and quality for Indian products and the products of particular Indian tribes."¹⁵¹ As authorized by IACA, Native American tribes must continue to register their tribal names at the expense of the U.S. Government for their "Indian products."¹⁵²

At a minimum, IACA offers Native American tribes the opportunity to enjoin the use of their tribal names in affiliation with products whose manufacturer seeks to benefit by the use of a particular tribal name. Products bearing Native American tribal names which confuse or mislead consumers would be actionable under the language of IACA and the Lanham Act. Although it is not comprehensive legislation intended to protect against any use of tribal names, it is a starting point for Native American tribes to protect their cultural identity and integrity.

Conclusion

The recent inquiry and discussion of intellectual property rights by Native American tribal councils and communities has focused on the potential of existing patent, copyright, and trademark law as the means to protect their Native American intellectual property. However, reliance on those areas of

147. *Id.*

148. *Id.* § 305e.

149. *Id.* § 305e(a).

150. *Id.* § 305e(c)(1)(b).

151. *Id.* § 305a(g)(1).

152. *Id.* § 305a(g)(3).

substantive law is largely misplaced given the underlying policies and practices. Attention needs to be re-focused on the potential both for utilizing the provisions and expanding the application of the Indian Arts and Crafts Act of 1990.

IACA offers to Native American tribes a minimum of protection for their intellectual property if the tribes begin effectively to utilize the Act. The Secretary of the Interior is under a duty to assist Native American tribes to secure protection of "Indian products." Native American tribes must take the initiative in considering whether to begin the arduous task of either lobbying the rule-making process or litigating the misappropriation of their intellectual property in the courts. To protect their intellectual property, Native American tribes must focus their energies toward both enforcing the criminal provisions of IACA and initiating civil actions pursuant to its civil remedial provisions.

