

A man in a dark blue suit and tie is shown from the chest up, looking upwards and to the right with a thoughtful expression, his hand resting on his chin. Above him, a white chalk-style drawing of a lightbulb is surrounded by several handprints, suggesting an idea or intellectual property.

# Branding the Band: Protecting Tribal Identities

One day, mail service to a California Indian tribe suddenly ceased. The tribe ultimately uncovered a campaign of sovereign identity theft that serves as an eye-opening object lesson in the importance of protecting tribal trademarks.

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# Through Trademark Law

In August 2010, the federally recognized tribe known as the Shingle Springs Band of Miwok Indians (Shingle Springs Band) suddenly and mysteriously stopped receiving its mail.<sup>1</sup> The band soon uncovered evidence proving multiple acts of sovereign identity theft, which set in motion years of contentious litigation to protect its tribal name. In the end, the band's encounter with, and eventual judgment against, an unaffiliated man purporting to act as chief of the Shingle Springs Band of

Miwoks<sup>2</sup> demonstrates the amenability of tribal names to formal legal protection under federal trademark law. It also underscores the strategic value of proactively pursuing trademark protection for official tribal names through federal registration (and perhaps under tribal law) and the importance of tribes' diligent enforcement of their exclusive rights to use their own names.

This article analyzes the complexities of securing trademark rights for tribal governments, evaluates the degree to which federal recognition as an Indian tribe itself bolsters trademark rights, examines the benefits of tribal law protections of tribal intellectual property rights, and reviews best practices for building tribal government brands. The Shingle Springs Band's experience confirms that Indian tribal governments should develop a comprehensive strategy for availing themselves of the strong protection trademark law offers while considering enacting tribal law to bolster this protection and potentially extend it to encompass other intellectual and cultural property.

## *Shingle Springs Band of Miwok Indians v. Caballero*

Upon investigation of its missing mail, the band discovered

that the purported chief had used U.S. Postal Service change of address forms to, in the words of the federal court that would rule against him, "successfully divert[] mail that was addressed to the [Band] and that was otherwise to be delivered by the United States Postal Service to the Tribal government office on the Shingle Springs Rancheria. ..." During the course of federal litigation against the self-proclaimed chief,<sup>4</sup> the band presented evidence of various other forms of misappropriation involving its name and identity, including:

- The individual's procurement of a local business license stating he was doing business as the Shingle Springs Band of Miwok Indians;<sup>5</sup>
- The creation of MySpace and Twitter pages bearing the band's exact name or confusingly similar names;<sup>6</sup>
- The registration of 12 Internet domain names identical or confusingly similar to the band's trademarks,<sup>7</sup> including its name, the name of its Rancheria, and the name of its gaming facility, Red Hawk Casino;<sup>8</sup> and
- The creation and use of bank accounts, purportedly held in the name of the Shingle Springs Band of Miwok Indians, or confusingly similar variations.<sup>9</sup>

The Shingle Springs Band also showed the purported chief went so far as to contact a university museum—from which the band had been seeking the return of sacred artifacts and human remains as part of a longstanding repatriation effort—and to have all future repatriation communications directed to himself.<sup>10</sup> On the basis of such evidence, the federal court found the individual had impersonated the tribe and improperly interfered with its communications with the museum, by "purporting to be the 'chief' of the 'Shingle Springs Band of Miwok Indians,' and demand[ing] that the [m]useum contact him, and not the Tribe, in connection with its efforts to repatriate artifacts and remains."<sup>11</sup>

In pursuit of court orders stopping the misappropriation of its name, in cyberspace and beyond, the band presented

evidence showing the impersonation coincided with the opening of its gaming facility, timing the federal court found legally significant: “[I]t is of no coincidence ... that [defendant] was nowhere to be found until that casino was built, and suddenly he declared himself to be the true owner of the name, the head of this tribe ...”<sup>12</sup> Relatedly, in an unsuccessful countersuit that the federal court dismissed, the purported chief challenged the band’s right to offer gaming, seeking a court order that it be enjoined “from operating a gaming casino,” and to “pay over” to himself and the “Indigenous Miwoks” with whom he claimed an affiliation “all gains, profits, and advantages derived by” the band to date.<sup>13</sup> In the end, and based on the evidentiary record before it, the district court found that this individual had acted “with a bad faith intent to profit.”<sup>14</sup>

In his own defense, the purported chief claimed that he and his alleged group of “Indigenous Miwoks” were the *real* Shingle Springs Band of Miwok Indians, whose name was usurped by a band of people of different Indian ancestry, who managed to “defraud the public” and mislead the Bureau of Indian Affairs into believing they deserved federal recognition and trust land for their use and benefit.<sup>15</sup> The purported chief contended his use of the name that he claimed as his own “constituted legally and constitutionally protected speech.”<sup>16</sup>

After nearly five years of federal court litigation, the issuance of a temporary restraining order<sup>17</sup> and a preliminary injunction,<sup>18</sup> and the defendant’s imprisonment for defying successive federal court orders<sup>19</sup> (not to mention a separate criminal proceeding and conviction for his obstruction of the band’s mail),<sup>20</sup> the Shingle Springs Band of Miwok Indians ultimately prevailed, landing a district court judgment and permanent injunction protecting the band’s tribal identity under federal and California trademark law.<sup>21</sup>

As tribal governments expand their activities into various areas of commerce, their vulnerability to the kinds of commercial “insults” with which ordinary businesses must deal will only increase, as will the degree of protective vigilance that tribes must exercise. The Shingle Springs Band’s federal court success in challenging the

which protects any “juristic person,” including any “firm, corporation, union, association, or other organization capable of suing and being sued in a court of law.”<sup>23</sup> This includes Indian tribes, juristic entities that, like other sovereigns, may sue and be sued (although, given their sovereign immunity, they may only “be sued” with their or Congress’ express consent).<sup>24</sup>

Even in the absence of trademark registration, Lanham Act protection attaches based on the owners’ prior “use[] in commerce” of a trademark “in connection with any goods or services.”<sup>25</sup> The act prohibits use by a subsequent user that is likely to cause confusion, mistake, or deception as to the origin of the subsequent user’s “goods, services, or commercial activities,” such as by suggesting a connection to the prior user.<sup>26</sup>

Even if a tribal government does not use its tribal name to sell goods and services by means of conventional commercial transactions, the Lanham Act should still protect the name a tribal government uses when it conducts traditional tribal government functions. For example, frequently, a tribe conducts its governmental business under a formal name, often its officially listed name recognized by the federal government, but adopts a variety of other names for its various commercial or governmental ventures. These various names may incorporate portions of the tribe’s name, but typically are (or can be) distinct brands. For instance, the Shingle Springs Band of Miwok Indians provides health care services to the public under the trademark Shingle Springs Tribal Health Program and operates the Red Hawk Casino.<sup>27</sup> Such activities, open to tribal citizens and the general public, should receive Lanham Act protection under any definition of commerce, as they consist of traditional commercial transactions involving goods and services.<sup>28</sup>

On the other hand, the Shingle Springs Band typically uses its full tribal name, Shingle Springs Band of Miwok Indians, in connection with government relations at all levels; community outreach; public relations; and government services to its own members.<sup>29</sup> While these services do not as neatly fit the traditional commercial mold, they

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misappropriation of its own name, while difficult and long fought, illustrates the ability of tribes to use federal and state trademark law as a means to protect their identities from usurpation.

### **Trademark Protection of Tribal Government Names**

The Shingle Springs Band’s story demonstrates that tribes can use federal trademark law to establish their exclusive right to use their government name. An Indian tribe that uses its name to conduct political activity, educate the public about the tribe, and provide association services to its citizens can secure the right to exclude others from using its name in a manner likely to confuse the public. As such, trademark law can work as an important tool to prevent third parties not authorized to speak on behalf of an Indian tribe from presenting themselves as the tribe.

Federal trademark protections are codified in the Lanham Act,<sup>22</sup>

are no less deserving of Lanham Act protection. This is because the Lanham Act protects trademarks used in connection with services, whether or not the owner charges a fee for or profits from them.<sup>30</sup>

More specifically, the Lanham Act’s commercial use requirement simply “does not require any actual *sale* of goods and services.”<sup>31</sup> Rather than focusing on sales or profits, “the appropriate inquiry is whether [the infringing party] offers *competing* services to the public.”<sup>32</sup> Nowhere does the act require that the trademark owner or infringer offer goods or services to fulfill a profit motive.<sup>33</sup> Indeed, where Congress wishes to impose a for-profit requirement for infringement of intellectual property rights, it has done so expressly.<sup>34</sup>

Federal courts have confirmed the Lanham Act protects nonprofit organizations, including benevolent, religious, or charitable organizations,<sup>35</sup> nonprofit educators,<sup>36</sup> and political advocacy groups.<sup>37</sup> The U.S. Court of Appeals for the Ninth Circuit’s decision

in *Committee for Idaho's High Desert v. Yost* (*Yost*) is instructive as to the broad protection the Lanham Act provides trademarks of nonprofit organizations engaged in political activities.<sup>38</sup> In particular, *Yost* demonstrates that trademark law grants those who use a trademark in connection with political activities the right to exclude others from using it in connection with competing political activities, even if neither user is engaging in the activity for profit.

The plaintiff in *Yost* was a “nonprofit environmental education and advocacy organization.”<sup>39</sup> Under the trademark Committee for Idaho's High Desert (CIHD), the plaintiff offered services that included “dissemination of information on environmental issues through a variety of channels, advocacy of a conservationist agenda on its members' behalf, and education of the public about the desert.”<sup>40</sup> Twelve years after the plaintiff began using that trademark, three individuals with “virtually antithetical” viewpoints formed a corporation under the exact same name.<sup>41</sup> The president of the newly formed corporation then testified at a public hearing held by the U.S. Air Force to voice support of a project that plaintiff opposed.<sup>42</sup>

The district court in *Yost* found a trademark violation, concluding that defendants “adopted and used [the CIHD name] in order to cause confusion, obstruct [CIHD's] pursuit of its environmental agenda, and thereby to obtain an advantage in [underlying] litigation by preventing [CIHD's] intervention.”<sup>43</sup> The Ninth Circuit affirmed and held that the defendants' formation of an organization under the plaintiff's trademark and its organization's testimony before the U.S. Air Force constituted “us[e] in commerce, in connection with services” supporting liability under the Lanham Act.<sup>44</sup>

Based on this precedent, the Shingle Springs Band of Miwok Indians obtained a permanent injunction against the third party (a non-member of the band) who had declared himself chief of the Shingle Springs Band of Miwoks.<sup>45</sup> To establish its prior use of the trademark in commerce, the Shingle Springs Band presented evidence of its extensive and long-term relationships with federal, state, and local governments, as well as its history of publishing a website and other publications to educate the public about its history and governance.<sup>46</sup> In granting judgment for the band, the district court found it had superior rights to trademarks at issue and that the purported chief's use of the trademarks was likely to cause confusion in the marketplace.<sup>47</sup>

The *Yost* case and the Shingle Springs Band's success demonstrate that a name an Indian tribe uses in connection with tribal governance deserves trademark protection even if the tribe does not use that name in connection with traditional sales of goods or services. As long as a tribe is using its name to engage in political activity, educate the public, or provide government services, or some combination of these activities, it should be able to establish “use[] in commerce” supporting Lanham Act protection against competing trademark use.

### Distinguishing Generic Names

Some types of tribal names may face an additional barrier to trademark protection because the generic term for a product or service can never by itself serve as a trademark.<sup>48</sup> One oft repeated explanation of the trademark/generic term distinction is that a trademark answers the question “Who are you?” and a generic term answers the question “What are you?”<sup>49</sup> A leading practice guide provides the example of APPLE, which is a generic name for the edible fruit of the apple tree, but is also a trademark for electronics.<sup>50</sup>

This means that an Indian tribe whose name consists of a generic term for a particular ancestral or ethnic group combined

with a generic term like “tribe” may face an argument that it cannot exclude others from using this term under trademark law. The Connecticut Supreme Court addressed such an argument in a dispute between two competing tribal groups, the federally recognized Mohegan Tribe of Indians of Connecticut, on one hand, and the Mohegan Tribe and Nation, which at the time of suit had a petition for federal recognition pending, on the other.<sup>51</sup> The federally recognized Mohegan Tribe sued to enjoin the other group from using those terms, and the unrecognized group claimed in defense that “Mohegan” was a generic term referring to all Native Americans of Mohegan descent.<sup>52</sup> The court denied trademark protection to the terms “Mohegan” and “Mohegan Tribe,” ruling they were generic terms because “there is no other term that can be used to refer to that unique and distinct ancestral group.”<sup>53</sup>

The potential problem of genericness affects, at most, only the simplest of tribal names. Even tribal names merely describe the tribe's ancestral makeup and geographical location can acquire Lanham Act protection where the public comes to understand that the name is a distinctive trademark for the services of a particular tribe.<sup>54</sup> On that basis, the Shingle Springs Band of Miwok Indians demonstrated entitlement to federal protection. Specifically, the band showed that a portion of the public (not to mention governmental agencies with whom it engages) associated the band's name with the services of a *particular* tribe or political group, even though its name also potentially describes a group including persons of Miwok Indian descent settled near Shingle Springs, Calif.

Even if a tribe's name is found to be a generic term, the tribe still potentially has a cause of action for passing off, as the Lanham Act prohibits false representations that goods or services offered by one person are actually that of another.<sup>55</sup> For example, in the context of a trademarked good, a restaurant's failure to disclose its serving another brand of cola to a customer ordering Pepsi would constitute passing off. Even where trademark rights are unavailable, case law holds that the Lanham Act prohibits the use of a generic term in a manner that constitutes a misrepresentation of manufacturer or source.<sup>56</sup> Employing this reasoning, the Connecticut Supreme Court suggested *in dicta* that, notwithstanding a finding that “Mohegan Tribe” was a generic term, liability could attach to “conduct intended to give the impression to the public that the Mohegan Tribe and Nation was, in fact, the federally acknowledged Mohegan Tribe located in southeastern Connecticut.”<sup>57</sup>

### Effect of Federal Recognition on Tribal Trademark Protection

Trademark protection of tribal names may arise, or grow stronger, where the U.S. government formally acknowledges, or recognizes, particular Indian tribes with which it has a government-to-government relationship. Each year, the Bureau of Indian Affairs publishes a list of these tribes, which receive certain benefits and privileges.<sup>58</sup> While a tribe's mere use of its official name through typical sovereign acts of governance should be enough to establish trademark rights, federally recognized tribes have an argument that the very fact of their recognition by the federal government gives rise to trademark rights even apart from such use. This argument stems from the interplay between the Lanham Act and the U.S. Constitution's Indian Commerce Clause and from congressional action recognizing a federal interest in accurately denominating federally recognized tribes.

In the Lanham Act, Congress declared its intent to regulate “all commerce which may lawfully be regulated by Congress.”<sup>59</sup> Under the

so-called Indian Commerce Clause, the Constitution grants Congress the sole power to regulate “Commerce ... with the Indian tribes.”<sup>60</sup> Because the Lanham Act invokes the panoply of Congress’ commerce power, including that of the Indian Commerce Clause, it stands to reason that an Indian tribe’s government-to-government relationship with the United States demonstrates that any given tribe’s federally recognized name has thereby been “use[d] in commerce.”<sup>61</sup>

Against this constitutional backdrop, Congress enacted the Federally Recognized Indian Tribe List Act of 1994 (List Act), which expresses legislative intent that Indian tribes be accurately designated by their federally recognized names.<sup>62</sup> In the List Act, Congress decreed that the executive branch provides the world a relative degree of certainty as to whether a particular tribe has been recognized—and under what name—by requiring annual publication in the Federal Register of a list of all federally recognized tribes.<sup>63</sup> The List Act demonstrates that Congress attaches legal significance to the United States’ recognition of an Indian tribe by a particular name, and thus arguably supports interpreting the Lanham Act to prohibit third parties from purporting to do business as federally recognized tribes.

Further evidence of Congress’ intent to prevent misappropriation of the names of Indian tribes appears in the federal Indian Arts and Crafts Act (IACA).<sup>64</sup> The IACA authorizes an Indian tribe (defined to include Indian groups formally recognized by a state as well as the federal government)<sup>65</sup> to pursue injunctive relief or damages against a person selling goods “in a manner that falsely suggests it is ... the product of a particular Indian or Indian tribe.”<sup>66</sup> Like the List Act, the IACA demonstrates, albeit in the context of the sale of particular product, Congress’ commitment to protect the names by which tribes conduct their business with the United States and other governments. Following this congressional direction, federal courts, in turn, recognize that the United States “has the authority and responsibility to ensure that the [tribe’s] representatives, with whom it must conduct government-to-government relations, are the valid representatives of the [tribe] as a whole.”<sup>67</sup> An individual unaffiliated with a federally recognized Indian tribe who misappropriates its name flouts not only the Lanham Act’s goals of preventing false designations of origin,<sup>68</sup> but also Congress’ prescriptions for the orderly administration of Indian affairs, as laid out in the List Act and elsewhere.<sup>69</sup>

Not surprisingly, in accord with Congress’ pronouncements, federal recognition has implications for securing trademark rights in the name by which the United States recognizes and lists the tribe. The Trademark Trial and Appeals Board has refused to register trademarks on the ground that they incorporate federally recognized tribes’ names. In a 2004 decision, the board ruled it had “no doubt that the record supports refusal of registration of APACHE as a [trade]mark for cigarettes because use of the name of the federally recognized Apache tribes would falsely suggest a connection between the applicant and those persons or institutions.”<sup>70</sup> In 2006, the board similarly refused to register a trademark containing “MOHAWK.”<sup>71</sup> Finally, the U.S. District Court for the Eastern District of California, in dismissing a trademark-based counterclaim by the purported chief against the Shingle Springs Band, ruled that, “as a matter of law, a federally recognized Indian tribe cannot be enjoined from using its own federally recognized name, under the guise of trademark law or otherwise.”<sup>72</sup>

The foregoing authorities support an argument that an Indian tribe’s recognition by and government-to-government relationship with the United States constitute “use[] in commerce” sufficient to

create Lanham Act rights in the Indian tribe’s recognized name.<sup>73</sup> None of this is to say that Indian tribal governments that do not yet have a government-to-government relationship with the United States cannot or should not invoke trademark law to protect their tribal names, based on the use of their names in commerce. Indeed, federal trademark registration of the names of these unrecognized tribes can provide a degree of federal protection of their identity pending federal recognition as an Indian tribe.

### **International Law Protections of Tribal Identity**

Protection of Indian tribes’ names through trademark law also comports with principles of international law, which call on nations to safeguard the intellectual and cultural property of their indigenous peoples. In December 2010, President Barack Obama announced the United States’ support for the United Nations Declaration on the Rights of Indigenous People.<sup>74</sup> Article 11.2 of the declaration provides that states must offer redress for takings of indigenous peoples’ “cultural [or] intellectual ... property,” while Article 31 confirms and requires state protection of indigenous peoples’ “right to maintain, control, protect, and develop their intellectual property over ... cultural heritage, traditional knowledge, and traditional cultural expressions.”<sup>75</sup> Article 13 specifically recognizes and requires state protection of indigenous peoples’ right “to designate and retain their *own names for communities*, places, and persons.”<sup>76</sup> The declaration thus requires protection of Indian tribes’ intellectual and cultural property, specifically including the names tribes have applied to their communities. Although the declaration may not be legally enforceable in the United States,<sup>77</sup> robust trademark protection of the names of this country’s Indian tribes nevertheless comports with the United States’ commitment to its indigenous peoples and their intangible property.

### **Best Practices for Building Tribal Names into Legally Protected Brands**

Given this strong support in U.S. and international law for tribes’ exclusive rights to use their government names, tribes can benefit from developing a branding strategy that makes full use of these legal protections. Early registration of trademarks with the U.S. Patent and Trademark Office (USPTO) is the cornerstone of any effective strategy for ensuring a tribal name becomes a legally protected brand. Use in commerce without registration can support trademark rights, as the Shingle Springs Band’s successful litigation prior to registration of its trademarks demonstrates. USPTO registration, however, yields powerful advantages. Specifically, registration constitutes prima facie evidence of (1) the validity of the trademark, (2) the registrant’s ownership of that trademark, and (3) the registrant’s exclusive right to use the trademark in connection with the goods and services specified in the registration.<sup>78</sup>

A trademark’s owner can apply for registration using an online form, but best practices dictate an experienced attorney handle the registration, which normally takes a modest amount of time and entails relatively minimal expense. Even when a particular trademark has not yet been used, such as where a tribe adopts a new name to replace one the United States bestowed upon it, the owner may file an “intent to use” application to secure priority contingent upon the owner’s later establishing use of the trademark in commerce.<sup>79</sup>

Paperwork must be filed with the USPTO between the fifth and sixth year following registration of the trademark to show the trade-

mark is still used in connection with the goods or services outlined in the initial registration, and every 10 years after registration.<sup>80</sup> Five years after registration of a distinctive trademark, the owner may file an affidavit attesting to continuous use of the trademark since registration, which can result in the trademark qualifying for status as incontestable, making third-party challenges more difficult.<sup>81</sup> Where an attorney takes charge of a trademark's registration, the trademark owner and attorney should ensure they have the same understanding as to who is responsible for keeping track of, and complying with, these important deadlines.

A tribe should also develop and implement usage standards so that the exact full trademark is consistently used in connection with all of the tribe's publications, correspondence, business transactions,

and cultural property. Indeed, some commentary suggests that applying Western intellectual property law to indigenous communities "constitutes neo-colonialism, in that it simply borrows the language and methods of the oppressors and, in doing so, further empowers the oppressors."<sup>83</sup> Compounding the legacy of colonialism, the names the United States has bestowed on Indian tribes often bear marks of the conqueror's culture. This is particularly true for homeless Indians settled on parcels of land called Rancherias in California in the early 1900s. For instance, the tribe formerly officially known as the Rumsey Band of Wintun Indians was named for the general who invaded its ancestral territory, and for whom a nearby town (Rumsey, Calif.) is also named. In a quintessential act of tribal sovereignty, the tribe in 2009 changed its official name to Yocha Dehe Wintun Nation,

## **While federal law potentially offers significant protection for tribal government names, tribes should consider bolstering these outside legal protections by enacting tribal laws that protect their intellectual and cultural property.**

and other governmental activities. One way to ensure consistent use of the trademark is to create and use for all official correspondence stylized letterhead containing the full trademark, as well as the registration symbol—®—if the trademark has achieved federal registration. The creation and regular use of a distinctive logo prominently featuring the trademark can help establish that the tribal name is being used as a trademark for the tribe's government services rather than simply as an ordinary name.<sup>82</sup> Indeed, a tribe might consider separately applying to register the logo itself as a trademark to forestall copying of the logo apart from the tribal name it contains.

In preparation for potential trademark disputes, the tribe should be careful to preserve evidence of use of its trademarks in commerce, including copies of letters, advertisements, or publications that feature their use in a variety of contexts. Records showing that third parties, such as media, have used the trademarks to refer to the tribe, and in particular, in a manner showing that the trademark is associated both with the tribe and with the relevant goods or services, also help to show that the trademarks have acquired distinctiveness in the eyes of the public, thus bolstering the tribe's trademark rights.

The tribe should also strongly consider developing a program directed to uncovering use of the trademarks by those infringing them or diluting their value. The program should involve periodic searches of the USPTO's Official Gazette, the Internet, and any publications where infringement is likely to occur.

Policing tribal trademarks is crucial, as infringement or dilution can cause costly problems if undetected. One need look no further than the ordeal the Shingle Springs Band recently endured—encompassing not only deceptive advertising, but also obstruction of the band's official government mail and even interference with communications in connection with repatriation of cultural artifacts and human remains—to realize that diligence in detecting and responding to theft of a tribal name is essential to protecting a tribe's trademarks, its identity, and its well-being.

### **Affirmative Use of Tribal Law to Protect Tribal Intellectual Property**

While federal law potentially offers significant protection for tribal government names, tribes should consider bolstering these outside legal protections by enacting tribal laws that protect their intellectual

meaning "home by the spring water" in the tribe's native Patwin language.<sup>84</sup> Fully appreciating the value of protecting its tribal identity and affiliation from others' incursion, both within and beyond its sovereign territory, the tribe also secured trademark registration of its new name (which now is also listed in the Federal Register as its federally recognized name pursuant to the List Act), along with the various logos and trademarks of its various governmental, cultural, and commercial operations.

Looking beyond the protections of federal law (and the specter of neocolonialism), tribes also can exercise their inherent sovereign authority by enacting tribal laws that protect their names and other intellectual property, and they can do so in a manner consistent with the unique features, cultures, and norms of each tribal community.<sup>85</sup> As governments predating the presence of Europeans in the Americas, Indian tribes possess "inherent powers of a limited sovereignty which has never been extinguished."<sup>86</sup> One of the inherent powers is the right "to make their own laws and be ruled by them."<sup>87</sup>

Through their own laws, tribes can potentially protect even cultural property, such as ancestral knowledge, languages, systems of grammar, as well as art, dance, and traditional crafts that do not always fit neatly into the protections allowed by federal and state legal regimes.<sup>88</sup> For instance, an Indian tribe could enact its own version of the Lanham Act, consistent with the tribe's interests and traditions, authorizing injunctive relief and damages actions in the tribe's courts against those misappropriating the tribe's name and other intellectual and cultural property.

To be sure, the U.S. Supreme Court's hostility to tribal jurisdiction over nonmembers may limit tribes' authority to enforce tribal law intellectual property rules. At a minimum, the Supreme Court has acknowledged tribes' inherent power to "exercise civil authority over the conduct of non-Indians ... within its reservation when that conduct threatens or has some direct effect on the political integrity, the economic security, or the health or welfare of the tribe."<sup>89</sup> The Court has subsequently construed this authority narrowly, at times refusing to acknowledge tribal jurisdiction even where nonmember conduct implicates tribal interests.<sup>90</sup> Nevertheless, as "a living sovereign," a tribe need not and should not wait for permission from other governments to demonstrate its commitment to protecting its culture and heritage through its own intellectual and cultural property legislation.<sup>91</sup>

## Conclusion

An orchestrated, multipronged approach can best protect tribal names from those who would usurp the tribe's name, reputation, and goodwill. A tribe's use of its tribal name in connection with traditional acts of tribal governance should give rise to trademark protection. Federal recognition under the List Act potentially lends further weight to an argument for Lanham Act coverage. While there is no substitute for federal trademark registration, diligence in detecting and responding to infringement is also essential. Finally, tribes should consider bolstering these federal law protections with aggressive tribal law enforcement of their names and other cultural property. By developing a comprehensive strategy that leverages available federal law protection, polices infringement and dilution in the marketplace, and employs aggressive tribal law protections, Indian tribes stand the best chance of preventing, or at least minimizing the damage from, theft of their sovereign identities. ☉



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*the purported chief of the Shingle Springs Band of Miwoks. The authors thank Samuel Fifer, Steven Paul McSloy, and Heather Sibbison for their thoughtful assistance with this article. © 2014 Paula M. Yost, Ian R. Barker, and Sara Dutschke Setshwaelo. All rights reserved.*



## Endnotes

<sup>1</sup>Memorandum of Points and Authorities Supporting Application for Temporary Restraining Order and Preliminary Injunctive Relief at 1:7-8, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Sept. 15, 2010).

<sup>2</sup>Answer of Defendant Caballero, Class Action Cross Complaint [sic], and Demand for Jury Trial at 10:8-9, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Feb. 17, 2009). Somewhat ironically, the federally recognized Shingle Springs Band does not even have a chief, but rather a tribal council headed by a tribal chairman. See Shingle Springs Band of Miwok Indians, Nicholas H. Fonseca—chairman, available at [www.shinglespringsrancheria.com/content/index.php?option=com\\_content&view=article&id=269:nicholas-fonseca-chairman&catid=44:governments&Itemid=193](http://www.shinglespringsrancheria.com/content/index.php?option=com_content&view=article&id=269:nicholas-fonseca-chairman&catid=44:governments&Itemid=193) (last accessed Jan. 12, 2014).

<sup>3</sup>Temporary Restraining Order at 1:21-25, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Sept. 3, 2010).

<sup>4</sup>The authors of this article have served as counsel of record in the federal district court and court of appeals litigation between the Shingle Springs Band and the purported chief.

<sup>5</sup>Order Holding Defendant in Contempt for Violating the Court's Preliminary Injunction at 2:16-18, *Shingle Springs Band of Miwok*

*Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Aug. 2, 2010).

<sup>6</sup>*Id.* at 2:21-24, 3:4-9.

<sup>7</sup>Although a technical distinction is often made between the term trademark, which usually refers to a word, phrase, symbol, or design identifying a source of *goods*, and the term service mark, which usually refers to an identifier of a source of *services*, this article adopts the common practice of referring to both trademarks and service marks as "trademarks." See The U.S. Patent and Trademark Office, Frequently Asked Questions about Trademarks, available at [www.uspto.gov/faq/trademarks.jsp](http://www.uspto.gov/faq/trademarks.jsp) (last accessed Jan. 10, 2014).

<sup>8</sup>*Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD, 2013 WL 504808, at \*\*2-4 (E.D. Cal. Feb. 8, 2013).

<sup>9</sup>Memorandum of Points and Authorities in Support of Motion for Partial Summary Judgment and Entry of Permanent Injunction at 4:22-5:10, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Dec. 10, 2012).

<sup>10</sup>Declaration of Anthony Garcia in Support of Application for Order to Show Cause Why Defendant Should Not Be Imprisoned for His Continued Contempt of the Court's Preliminary Injunction, at 1:10-13, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. October 14, 2011).

<sup>11</sup>Order Imprisoning Defendant for His Continued Contempt of the Court's Preliminary Injunction at 2:25-28, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Oct. 31, 2011).

<sup>12</sup>Reporter's Transcript, Motion for Preliminary Injunction at 13:15-9, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Sept. 15, 2010).

<sup>13</sup>Answer of Defendant Caballero, Class Action Cross Complaint [sic], and Demand for Jury Trial at 20:27, 28:24-27, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Feb. 17, 2009).

<sup>14</sup>*Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD, 2013 WL 504808, at \*1 (E.D. Cal. Feb. 8, 2013).

<sup>15</sup>Defendant's Response to Motion for Summary Judgment at 4:10-16, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Feb. 6, 2013). The court ultimately disregarded the defendant's untimely response to the Shingle Springs Band's summary judgment motion and deemed the band's motion unopposed. Minute Order, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Feb. 8, 2013).

<sup>16</sup>Defendant's Response to Motion for Summary Judgment at 4:22-25, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Feb. 6, 2013).

<sup>17</sup>Temporary Restraining Order, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Sept. 3, 2010).

<sup>18</sup>Preliminary Injunction, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Sept. 15, 2010). The Ninth Circuit affirmed the preliminary injunction. *Shingle Springs Band of Miwok Indians v. Caballero*, 424 Fed. Appx. 696 (9th Cir. 2011).

<sup>19</sup>Order Imprisoning Defendant for His Continued Contempt of the Court's Preliminary Injunction, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Oct.

31, 2011); Minute Order, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Feb. 27, 2012).

<sup>20</sup>Criminal Minutes, *United States v. Caballero*, No. 2:11-mj-0035-EFB (E.D. Cal. Aug. 30, 2011).

<sup>21</sup>*Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD, 2013 WL 504808 (E.D. Cal. Feb. 8, 2013). The final judgment issued in favor of the Shingle Springs Band has been appealed and was pending before the Ninth Circuit Court of Appeals at the time of publication. *Shingle Springs Band of Miwok Indians v. Caballero*, No. 13-15411 (9th Cir. docketed Mar. 5, 2013).

<sup>22</sup>15 U.S.C. ch. 22.

<sup>23</sup>15 U.S.C. § 1127.

<sup>24</sup>*In re White*, 73 U.S.P.Q. 2d 1713, 1718 (Trademark Trial & App. Bd. 2004) (finding “that federally recognized tribes are entities or juristic persons that can enter into contracts, sue and be sued”); cf. *In re Dept of Interior*, 142 U.S.P.Q. 506 (Trademark Trial & App. Bd. 1964) (concluding federal agency possessing immunity from suit can invoke Lanham Act protection); *N.Y. State Office of Parks & Rec. v. Atlas Souvenir & Gift Co.*, 207 U.S.P.Q. 954, 958 (Trademark Trial & App. Bd. 1980) (deciding state agency is juristic person under Lanham Act).

<sup>25</sup>15 U.S.C. § 1125(a).

<sup>26</sup>15 U.S.C. § 1125(a)(1)(A).

<sup>27</sup>See Shingle Springs Tribal Health Program home page, available at [sshwc.org](http://sshwc.org) (last accessed Jan. 12, 2014); Red Hawk Casino home page, available at [www.redhawkcasino.com](http://www.redhawkcasino.com) (last accessed Jan. 12, 2014).

<sup>28</sup>15 U.S.C. § 1125(a).

<sup>29</sup>See Official Website of the Shingle Springs Band of Miwok Indians, available at [www.shinglespringsrancheria.com/content](http://www.shinglespringsrancheria.com/content) (last accessed Jan. 12, 2014).

<sup>30</sup>*Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 679 (9th Cir. 2005); *Committee for Idaho's High Desert v. Yost*, 92 F.3d 814, 818-19, 825-26 (9th Cir. 1996).

<sup>31</sup>*Bosley*, 403 F.3d at 679 (Ninth Circuit's emphasis).

<sup>32</sup>*Id.* at 679 (citing *United We Stand America, Inc. v. United We Stand, America New York, Inc.*, 128 F.3d 86, 90 (2nd Cir. 1997)) (Ninth Circuit's emphasis).

<sup>33</sup>15 U.S.C. § 1125(a); see 15 U.S.C. § 1127 (reciting that the intent of the Lanham Act is to “mak[e] actionable the deceptive and misleading use of [trade]marks in ... commerce” and “to protect persons engaged in ... commerce against unfair competition”).

<sup>34</sup>Cf. 15 U.S.C. § 1125(d)(1)(A) (providing that a claim for cybersquatting, based on registering Internet domain names containing the trademark of another, requires “a bad faith intent to profit from that [trade]mark”).

<sup>35</sup>*Int'l Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912 (9th Cir. 1980), cert. denied, 452 U.S. 941 (1981); *United States Jaycees v. San Francisco Junior Chamber of Commerce*, 354 F. Supp. 61, 71 (N.D. Cal. 1972) (“benevolent, religious, charitable, or fraternal organizations are entitled to injunctive relief protecting against the continued use of their name by local chapters which disaffiliate”).

<sup>36</sup>*SMJ Group, Inc. v. 417 Lafayette Restaurant LLC*, 439 F. Supp. 2d 281, 287 (S.D.N.Y. 2006) (recognizing that nonprofit organization advocating for restaurant workers “seek[s] to educate the public, an admirable service, but an individual being educated should not be misled about the source of that education, just as an individual purchasing a can of peas should not be misled about the source of those peas”).

<sup>37</sup>*United We Stand America, Inc.*, 128 F.3d at 89-90, 92 (applying the Lanham Act to a trademark for expressive activities of a nonprofit

political campaign and recognizing “[t]he Lanham Act has thus been applied to defendants furnishing a wide variety of non-commercial public and civic benefits”); *TE-TA-MA Truth Foundation-Family of URI, Inc. v. World Church of the Creator*, 297 F.3d 662, 667 (7th Cir. 2002) (enjoining church's use of trademark in connection with its expressive activities); *Yost*, 92 F.3d at 818-19, 825-26 (protecting trademark used in connection with nonprofit activities of environmental advocacy organization).

<sup>38</sup>*Yost*, 92 F.3d at 818-19, 825-26.

<sup>39</sup>*Id.* at 817.

<sup>40</sup>*Id.* at 821-22.

<sup>41</sup>*Id.* at 817, 821.

<sup>42</sup>*Id.* at 818.

<sup>43</sup>*Id.*

<sup>44</sup>*Id.* at 823.

<sup>45</sup>*Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD, 2013 WL 504808, at \*\*2-4 (E.D. Cal. Feb. 8, 2013).

<sup>46</sup>Memorandum of Points and Authorities in Support of Motion for Partial Summary Judgment and Entry of Permanent Injunction at 2:22-3:6, 9:8-17, *Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD (E.D. Cal. Dec. 10, 2012).

<sup>47</sup>*Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD, 2013 WL 504808, at \*1 (E.D. Cal. Feb. 8, 2013).

<sup>48</sup>J. McCarthy on Trademarks and Unfair Competition § 12:1 (4th ed. 1994).

<sup>49</sup>*Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1391 (9th Cir. 1993) (quoting 1 J. McCarthy, Trademarks and Unfair Competition § 12.01 (3d ed. 1992)).

<sup>50</sup>J. McCarthy on Trademarks and Unfair Competition § 12:1 (4th ed. 1994).

<sup>51</sup>*Mohegan Tribe of Indians of Conn. v. Mohegan Tribe & Nation*, 769 A.2d 34, 37-39 (Conn. 2001).

<sup>52</sup>*Id.* at 36-37, 42.

<sup>53</sup>*Id.* at 43.

<sup>54</sup>*Two Pesos v. Taco Cabana*, 505 U.S. 763, 769 (1992).

<sup>55</sup>*Forschmer Group v. Arrow Trading Co.*, 30 F.3d 348, 358 (2d Cir. 1994).

<sup>56</sup>*Id.* at 357-58.

<sup>57</sup>*Mohegan Tribe of Indians of Conn.*, 769 A.2d at 46 n.31.

<sup>58</sup>See Department of the Interior, Bureau of Indian Affairs, Indian Entities Recognized and Eligible to Receive Services from the United States Bureau of Indian Affairs, 78 Fed. Reg. 26,384 (May 6, 2013).

<sup>59</sup>15 U.S.C. § 1127.

<sup>60</sup>U.S. Const., Art. I, § 8, cl. 3.

<sup>61</sup>15 U.S.C. § 1125(a).

<sup>62</sup>Pub. L. No. 103-454, § 103(2), 108 Stat. 4791 (finding “the United States has a trust responsibility to recognized Indian tribes, maintains a government-to-government relationship with those tribes, and recognizes the sovereignty of those tribes ...”).

<sup>63</sup>25 U.S.C. §§ 479a, 479a-1(b).

<sup>64</sup>25 U.S.C. §§ 305-309.

<sup>65</sup>25 U.S.C. § 305e(a)(3).

<sup>66</sup>25 U.S.C. 305e(b); but see Final Rule, Protection for Products of Indian Art and Craftsmanship, 61 Fed. Reg. 54,551, 54,554 (Oct. 21, 1996) (“The rights of tribes to control the use of their names, qualified and unqualified, is an issue of cultural patrimony and is

beyond the scope of these regulations”).

<sup>67</sup>*Seminole Nation v. Norton*, 223 F. Supp. 2d 122, 140 (D.D.C. 2002) (citing *Seminole Nation v. United States*, 316 U.S. 286, 296 (1942)).

<sup>68</sup>15 U.S.C. § 1125(a)(1); see also 15 U.S.C. § 1052(a) (prohibiting registration of trademarks that “falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols ...”).

<sup>69</sup>The Connecticut Supreme Court refused to foreclose an unrecognized tribal entity from using the name of a federally recognized Indian tribe, which it held consisted solely of a generic term. *Mohegan Tribe of Indians of Conn.*, 769 A.2d at 43-45. The court reasoned that the recognition of one group as “a Mohegan Tribe” did not foreclose another group from obtaining acknowledgement as “a Mohegan Tribe.” *Id.* at 45. As the Connecticut Supreme Court concluded the name at issue was a generic term inherently incapable of trademark protection, the court’s reasoning does not foreclose trademark rights arising by virtue of federal recognition under a distinctive tribal name. *Id.* at 43-45.

<sup>70</sup>*In re Julie White*, 73 U.S.P.Q.2d (BNA) 1713 (Trademark Tr. & App. Bd. 2004).

<sup>71</sup>*In re White*, 80 U.S.P.Q.2d (BNA) 1654 (Trademark Tr. & App. Bd. 2006) (refusing to register “MOHAWK as a [trade]mark for cigarettes because use of the name of the federally recognized St. Regis Band of Mohawk Indians of New York would falsely suggest a connection between applicant and the Mohawk tribe.”).

<sup>72</sup>*Shingle Springs Band of Miwok Indians v. Caballero*, No. 2:08-CV-03133-JAM-DAD, slip op. at 2 (E.D. Cal. May 20, 2009) (order dismissing counterclaims).

<sup>73</sup>15 U.S.C. § 1125(a)(1).

<sup>74</sup>Remarks by the President at the White House Tribal Nations Conference, December 16, 2010, available at [www.whitehouse.gov/the-press-office/2010/12/16/remarks-president-white-house-tribal-nations-conference](http://www.whitehouse.gov/the-press-office/2010/12/16/remarks-president-white-house-tribal-nations-conference) (last accessed Jan. 12, 2014).

<sup>75</sup>*United Nations Declaration on the Rights of Indigenous Peoples*, March 2008, available at [www.un.org/esa/socdev/unpfii/documents/DRIPS\\_en.pdf](http://www.un.org/esa/socdev/unpfii/documents/DRIPS_en.pdf) (last accessed Jan. 12, 2014).

<sup>76</sup>*Id.* (emphasis added).

<sup>77</sup>Frequently Asked Questions, Declaration on the Rights of Indigenous Peoples at 2, available at [www.un.org/esa/socdev/unpfii/documents/FAQsindigenousdeclaration.pdf](http://www.un.org/esa/socdev/unpfii/documents/FAQsindigenousdeclaration.pdf) (last accessed Jan. 11, 2014).

<sup>78</sup>15 U.S.C. § 1115(a).

<sup>79</sup>15 U.S.C. §§ 1051(b), 1057(b).

<sup>80</sup>15 U.S.C. § 1058(a).

<sup>81</sup>15 U.S.C. §§ 1065, 1115(b).

<sup>82</sup>*Book Craft, Inc. v. Bookcrafters USA, Inc.*, 222 U.S.P.Q. (BNA) 724, 727 (Trademark Trial & App. Bd. 1984).

<sup>83</sup>Angela R. Riley, “*Straight Stealing*”: Towards an Indigenous System of Cultural Property Protection, 80 WASH. L. REV. 69, 87 (citing Paul J. Heald, *The Rhetoric of Biopiracy*, 11 CARDOZO J. INT’L & COMP. L. 519, 529 (2003)) [hereinafter “Riley, ‘*Straight Stealing*’”].

<sup>84</sup>Yocha Dehe Wintun Nation Press Release, “Native Voice, Native Vision: Rumsey Band of Wintun Indians Honor Their Ancestral Roots with Name Change,” Sept. 8, 2009, available at [yochadehe.org/sites/default/files/YDH%20Name%20Change%20Release.pdf](http://yochadehe.org/sites/default/files/YDH%20Name%20Change%20Release.pdf) (last accessed Jan. 12, 2014).

<sup>85</sup>Riley, “*Straight Stealing*,” *supra* note 83, at 74.

<sup>86</sup>*United States v. Wheeler*, 435 U.S. 313, 323-24 (1978).

<sup>87</sup>See *Williams v. Lee*, 358 U.S. 217, 220 (1959).

<sup>88</sup>Riley, “*Straight Stealing*,” *supra* note 83, at 87-89.

<sup>89</sup>*Montana v. United States*, 450 U.S. 544, 566 (1981).

<sup>90</sup>See, e.g., *Strate v. A-1 Contractors*, 520 U.S. 438, 457-58 (1997) (refusing to recognize tribal jurisdiction arising out of accident on state highway running through reservation even though “those who drive carelessly on a public highway running through a reservation endanger all in the vicinity, and surely jeopardize the safety of tribal members”).

<sup>91</sup>Riley, “*Straight Stealing*,” *supra* note 83, at 87-89.

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Conservation (2008).

<sup>8</sup>Tribal lands generally refer to those that are set aside specifically for tribes to reside on, often through legislation, negotiated treaties, or federal fiat. Tribal, aboriginal, or ancestral territories generally refer to those lands that the tribe, indigenous people, or other organized aboriginal entities may have resided or had, or continue to have, a presence or interest in that may or may not be inclusive of their set-aside tribal lands.

<sup>9</sup>GA Res. 61/295 (Annex), UN GAOR, 61st Sess., No. 49, Vol. III, UN Doc. A/61/49(2008) 15. The declaration was adopted by the UN General Assembly on Sept. 13, 2007. It specifically recognizes indigenous people’s rights and sets out the minimum necessary to meet international human rights standards. It does not create new or special rights for indigenous people, and it addresses the right of indigenous people to own, develop, control, and use the lands and territories that they have traditionally owned and otherwise occupied or used.

<sup>10</sup>The right to consultation is included in many international instruments and has been accepted as a standard practice and requirement in many countries. As one example, the International

Labour Organization Convention 169 requires that indigenous and tribal peoples are consulted on issues that affect them. It also requires that these people are able to engage in free, prior, and informed participation in policy and development processes that affect them.

<sup>11</sup>UN GLOBAL COMPACT, *A Business Reference Guide: UN Declaration on the Rights of Indigenous Peoples*, 5 (2013) [www.unglobalcompact.org/docs/issues\\_doc/human\\_rights/Business\\_Reference\\_Guide.pdf](http://www.unglobalcompact.org/docs/issues_doc/human_rights/Business_Reference_Guide.pdf).

<sup>12</sup>3 S.C.R. 1010 (1997)

<sup>13</sup>*Id.*, at 21.

<sup>14</sup>Lee Godden, Marcia Langton, Odette Mazel, and Maureen Tehan, *Accommodating Interests in Resource Extraction*, 26 J. ENERGY & NAT. RESOURCES L. 1, 14 (2008)

<sup>15</sup>*Id.*, at 25.

<sup>16</sup>*Id.*, at 25.