

THE MARK OF A CULTURE:  
THE EFFICACY AND PROPRIETY OF USING  
TRADEMARK LAW TO DETER CULTURAL  
APPROPRIATION

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## INTRODUCTION

An American pop star dresses as a geisha for her performance at an award show.<sup>1</sup> A French fashion designer uses a Mexican indigenous pattern on a blouse.<sup>2</sup> American celebutantes wear Indian bindis at music festivals.<sup>3</sup> A white actress appears on a talk show with her hair in cornrows, a distinctly African-American hair style.<sup>4</sup> A Major League Baseball team has a caricature of a Native American chief as its mascot.<sup>5</sup>

In recent years, instances of cultural appropriation, or the act of taking some product from a “source community” culture and repurposing it in a different culture, have drawn the scrutiny and condemnation of major news outlets and social media mobilizers alike.<sup>6</sup> Popular criticism of cultural appropriation often centers on the lack of compensation to the source community for the use of their cultural product, or reputational harm due to perpetuation of negative stereotypes.

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<sup>1</sup> Jessica Goldstein, *Katy Perry Should Talk to Questlove About Cultural Appropriation*, THINKPROGRESS (July 30, 2014, 4:01 PM), <http://thinkprogress.org/culture/2014/07/30/3465849/katy-perry-questlove-cultural-appropriation/>; Cathy Young, *To the New Culture Cops, Everything is Appropriation*, WASH. POST (Aug. 21, 2015), <https://www.washingtonpost.com/posteverything/wp/2015/08/21/to-the-new-culture-cops-everything-is-appropriation/>.

<sup>2</sup> Krithika Varagur, *Mexico Prevents Indigenous Designs From Being Culturally Appropriated—Again*, HUFFINGTON POST (Mar. 17, 2016, 2:04 PM ET), [http://www.huffingtonpost.com/entry/mexico-prevents-indigenous-designs-from-being-culturally-appropriated-again\\_us\\_56e87879e4b0b25c9183afc4](http://www.huffingtonpost.com/entry/mexico-prevents-indigenous-designs-from-being-culturally-appropriated-again_us_56e87879e4b0b25c9183afc4).

<sup>3</sup> Lauren O’Neil, *Celebrity Bindis at Coachella: Fashion Trend or Cultural Appropriation?*, CBC NEWS (Apr. 14, 2014, 5:53 PM), <http://www.cbc.ca/newsblogs/yourcommunity/2014/04/celebrity-bindis-at-coachella-fashion-trend-or-cultural-appropriation.html>; Parul Sehgal, *Is Cultural Appropriation Always Wrong?*, N.Y. TIMES MAG. (Sept. 29, 2015), <http://www.nytimes.com/2015/10/04/magazine/is-cultural-appropriation-always-wrong.html>.

<sup>4</sup> Kareem Abdul-Jabbar, *Cornrows and Cultural Appropriation: The Truth About Racial Identity Theft*, TIME (Aug. 26, 2015), <http://time.com/4011171/cornrows-and-cultural-appropriation-the-truth-about-racial-identity-theft/>; see also, e.g., Jenni Avins, *The Dos and Don’ts of Cultural Appropriation*, ATLANTIC (Oct. 20, 2015),

<http://www.theatlantic.com/entertainment/archive/2015/10/the-dos-and-donts-of-cultural-appropriation/411292/>; Browntourage & Mo Juicy, *Appropriation v. Appreciation*, INTERRUPT MAG. (Sept. 23, 2014, 11:30 AM), <http://interruptmag.com/article/appropriation-vs-appreciation>; Sehgal, *supra* note 3; Michelle Y. Talbert, *You Have to Pay Us for It: Curbing Cultural Appropriation Through Ownership*, FOR HARRIET (last visited Mar. 29, 2016, 1:08 PM PT), <http://www.forharriet.com/2015/10/you-have-to-pay-us-for-it-curbing.html#axzz44KAZV35C>.

<sup>5</sup> Daniel McGraw, *Native Americans Protest Chief Wahoo logo at Cleveland Indians Home Opener*, GUARDIAN (Apr. 11, 2015, 11:52 AM EDT), <http://www.theguardian.com/sport/2015/apr/11/native-americans-protest-chief-wahoo-logo-at-cleveland-indians-home-opener>.

<sup>6</sup> See *supra* notes 1-5.

Source communities looking for remedial or preventative measures often turn to intellectual property regimes for protection in Western legal systems, where intellectual property laws often serve as the foremost line of defense for those intangible types of property.<sup>7</sup> In the United States, source communities are turning to trademark law as a means for preventing non-community members from using their cultural products, with largely undetermined success.<sup>8</sup> While much scholarship has been devoted to analyzing the applicability and efficacy of copyright law for curbing cultural appropriation,<sup>9</sup> the applicability and efficacy of trademark law to achieve the same end has been given only a cursory treatment.

This paper, grounded in social science literature on cultural appropriation and foundational legal texts on trademark law, examines whether trademark law is suited to grappling with cultural appropriation. Part I forms the literature review of this paper: it includes a definition of “cultural appropriation,” a first glance at the occurrence of cultural appropriation in the marketplace, and description of the harms and benefits of cultural appropriation and the potential harms and benefits of policing it. Part II attempts to apply trademark law to cultural appropriation, first by introducing the purposes of trademark law, then by presenting the requirements for trademark protection, before analyzing how source communities may be able to register their cultural products as marks and protect them from third party uses through trademark causes of action, given the particular characteristics of source communities and cultural products. Part III draws on the analysis in Part II to examine the potential efficacy of trademark law in grappling with cultural appropriation, the potential harms and benefits to the source community and to society by using trademark law to police cultural appropriation, and the propriety of applying trademark law to prevent cultural appropriation given the purposes of trademark law. The conclusion of this paper briefly reiterates the author’s findings: that trademark law is not particularly well suited to addressing cultural appropriation, and successful causes of action in trademark will be both difficult to achieve and, if successful, ineffective, or even counterproductive.

## I. CULTURAL APPROPRIATION AND INTELLECTUAL PROPERTY

### A. *Theories of Cultural Appropriation in Social Science*

The term “cultural appropriation” is often invoked by university students, news media, and online commentators to describe and decry instances in which a person or group acts in a way that offends persons of a different culture. Despite the term’s recent incorporation into the popular lexicon, the meaning of

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<sup>7</sup> See *infra* Parts I.C & I.D.

<sup>8</sup> See, e.g., Guy Trebay, *An Uneasy Cultural Exchange*, N.Y. TIMES (Mar. 14, 2012), <http://www.nytimes.com/2012/03/15/fashion/an-uneasy-exchange-between-fashion-and-navajo-culture.html>; see also *infra* Part I.D.

<sup>9</sup> See *infra* Part I.D.

“cultural appropriation” has developed in social science literature over the last thirty years. The most often cited definition of cultural appropriation, by Professors Bruce Ziff and Pratima V. Rao, is “the taking from a culture that is not one’s own of intellectual property, cultural expressions or artifacts, history and ways of knowledge.”<sup>10</sup> Most definitions in the literature fit this basic frame: A person or group of a certain culture (“the appropriator”) “takes” certain tangible or intangible objects (“cultural products”) from a different culture (“the source community”). Professor Rosemary J. Coombe and Nicole Aylwin explain the “taking” of the cultural product from the source community as “improperly recontextualiz[ing],” or “mov[ing] or remov[ing] [it] from its authorizing context.”<sup>11</sup>

Other definitions have ascribed additional attributes to cultural appropriation. Professor Sally Engle Merry adds that the cultural product that is “taken” from the source community is replayed by the appropriator “with different meanings or practices.”<sup>12</sup> Professor Merry and others highlight the often commercial nature of the “taking,” and power imbalance between the two cultures. Within the context of intellectual property, Professor Merry describes cultural appropriation as “the processes by which dominant groups take, and often profit from, the artistic, musical, and knowledge productions of subordinate groups . . . .”<sup>13</sup> Professor Susan Scafidi adds that “outsiders borrow cultural products not only for their intrinsic value, but also in order to invoke, describe, or caricature the source community.”<sup>14</sup> Professor Jonathan Hart

<sup>10</sup> Bruce Ziff & Pratima V. Rao, *Introduction to Cultural Appropriation: A Framework for Analysis*, in *BORROWED POWER: ESSAYS ON CULTURAL APPROPRIATION* 1, 1 (Bruce Ziff & Pratima V. Rao eds., 1997); see Jill Koren Kelley, *Owning the Sun: Can Native Culture Be Protected Through Current Intellectual Property Law?*, 7 *J. HIGH TECH. L.* 180, 188 (2007) (quoting Ziff & Rao); Sally Engle Merry, *New Direction: Law, Culture, and Cultural Appropriation*, 10 *YALE J.L. & HUMAN.* 575, 585-86 (1998) (same); Madhavi Sunder, *Intellectual Property and Identity Politics: Playing with Fire*, 4 *J. GENDER RACE & JUST.* 69, 73 (2000) [hereinafter Sunder, *Identity Politics*] (same); Rebecca Tsotsie, *Reclaiming Native Stories: An Essay on Cultural Appropriation and Cultural Rights*, 34 *ARIZ. ST. L.J.* 299, 300, 310 (2002) (same); Angela R. Riley & Kristen A. Carpenter, *Owning Red: A Theory of (Cultural) Appropriation*, 93 *TEX. L. REV.* (forthcoming 2016) (manuscript at 104) (on file with SSRN) (same).

<sup>11</sup> Rosemary J. Coombe & Nicole Aylwin, *The Evolution of Cultural Heritage Ethics via Human Rights Norms*, in *DYNAMIC FAIR DEALING: CREATING CANADIAN CULTURE ONLINE* 201, 201-02 (Rosemary J. Coombe, Darren Weshler, and Martin Zeilinger eds., 2014).

<sup>12</sup> Merry, *supra* note 10, at 585; see Tsotsie, *supra* note 10, at 310-11 (quoting Merry).

<sup>13</sup> Merry, *supra* note 10, at 585-86; see also Michael F. Brown, *Respondent: Why Property and Democracy are Not Always Allies*, 50 *ST. LOUIS L.J.* 843, 846 (2006) (“‘Cultural appropriation,’ the fear that elements of folklore and traditional knowledge are being privatized by industry through increasingly aggressive application of intellectual property (IP) law.”); Riley & Carpenter, *supra* note 10, at 104. Merry goes on to explain that cultural appropriation is not limited to dominant groups taking from subordinate groups—“it can be done the other way as well.” Nevertheless, she emphasizes the centrality of power relations to the concept of cultural appropriation. Merry, *supra* note 10, at 585-86.

<sup>14</sup> Susan Scafidi, *Intellectual Property and Cultural Products*, 81 *B.U. L. REV.* 793, 824 (2001).

questions the propriety of the invocation, description, or caricature of the source community, given a power imbalance between the two cultures.<sup>15</sup>

Key to “cultural appropriation” is the taking of a *cultural product*. The term “cultural product” is commonly given a broad and nebulous definition. At base, it includes both tangible and intangible materials. Tangible materials include “prehistorical and historical objects that significantly represent a group’s cultural heritage,”<sup>16</sup> or even “all of the . . . tangible forms of culture produced by humans to adapt and exercise control over their environment.”<sup>17</sup> If tangible cultural products are a broad category, intangible cultural products are even broader. Intangible materials have been described as the knowledge “considered significant by the members of a culture.”<sup>18</sup> Intangible materials are “aspects of the whole body of cultural practices, resources and knowledge systems” developed by a people,<sup>19</sup> and are often “collectively owned and transmitted orally from generation to generation.”<sup>20</sup>

Though the potential expansiveness of “cultural appropriation” may obscure its meaning, current examples of cultural appropriation abound. Cultural appropriation often occurs when a source community’s words, names, designs, motifs, symbols, artworks, art styles, songs, musical genres, stories, or dances are used in a different cultural group’s creative works<sup>21</sup> or consumer products, without the permission of the source community.<sup>22</sup>

In the United States, we often see creative works and consumer products use Native American words and imagery.<sup>23</sup> Jeep Grand Cherokees, Pontiac Aztecs, Washington Redskins, University of North Dakota Fighting Sioux, Land O’Lakes Butter packaging images, Natural American Spirit cigarettes, all use some word, name, or image from Native Americans on a non-Native

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<sup>15</sup> Jonathan Hart, *Translating and Resisting Empire: Cultural Appropriation and Postcolonial Studies*, in BORROWED POWER: ESSAYS ON CULTURAL APPROPRIATION 137, 137 (Bruce Ziff & Pratima V. Rao eds., 1997).

<sup>16</sup> Kelley, *supra* note 10, at 183.

<sup>17</sup> *Id.*

<sup>18</sup> *Id.* 183-84.

<sup>19</sup> Peter J. Chalk, *Indigenous Trade Marks and Human Rights: An Australian and New Zealand Perspective*, 99 TRADEMARK REP. 956, 2 (2009).

<sup>20</sup> K.J. Greene, *Intellectual Property at the Intersection of Race and Gender: Lady Sings the Blues*, 16 AM. U. J. GENDER SOC. POL’Y & L. 365, 383 (2007) [hereinafter Greene, *Intellectual Property*].

<sup>21</sup> Chalk, *supra* note 19, at 2; Riley & Carpenter, *supra* note 10, at 104. Inaccurate or offensive depictions of groups, such as Native Americans, in television, movies, and literature have also been considered cultural appropriation. Kelsey Collier-Wise, *Identity Theft: A Search for Legal Protections of Intangible Indigenous Cultural Property*, 13 GREAT PLAINS NAT. RESOURCES J. 85, 87 (2010); Kelley, *supra* note 10, at 188.

<sup>22</sup> Brown, *supra* note 13, at 846; Kelley, *supra* note 10, at 188.

<sup>23</sup> Chalk, *supra* note 19, at 2. While many examples of cultural appropriation in the United States derive from use of Native American cultural products, there have also been instances of cultural appropriation of cultural objects from a number of other cultures, including Jewish and African American culture. See Nathaniel T. Noda, *Perpetuating Cultures: What Fan-Based Activities Can Teach Us About Intangible Cultural Property*, 44 CREIGHTON L. REV. 429, 436 (2011); Scafidi, *supra* note 14, at 824.

American product.<sup>24</sup> Outkast's performance at the 2004 Grammy Awards has gained notoriety as a particularly egregious example of cultural appropriation of Native American music and imagery. In their performance, the group wore headdresses, war paint, costumes with feathers and fringe, and sampled a sacred Navajo song, thus misrepresenting and detaching these cultural products from their meaning in their source community.<sup>25</sup>

Another commonly cited example of cultural appropriation is the use of the Zia Sun symbol by the State of New Mexico and by private companies. The Zia Sun is a sacred religious symbol for the Zia Pueblo people of New Mexico.<sup>26</sup> For the Zia people, the sun symbol is "an exceptionally significant religious and cultural symbol" used in religious ceremonies since 1200 C.E.<sup>27</sup> Today, the Zia Sun appears on the New Mexico state flag, license plates, motorcycles, and portable toilets.<sup>28</sup> For the Zia people, the continued use of their symbol dilutes its sacred meaning and disparages their community.<sup>29</sup>

### B. Harms of Cultural Appropriation to Source Communities

Cultural appropriation is often described as a practice that is harmful to the source community whose cultural product is appropriated by another group. At first pass, cultural appropriation is harmful to a source community when the way the community's culture is depicted is offensive or disparaging.<sup>30</sup> Some acts of appropriation "carelessly mimic[] sacred . . . rituals, names and images,"<sup>31</sup> or stereotype and demean minority cultures.<sup>32</sup> Use of Native American names and images for sports teams and their mascots is seen as hurtful and confusing because they "perpetuate historically erroneous, racist images of the past."<sup>33</sup> Second, appropriation of non-disparaging cultural

<sup>24</sup> Collier-Wise, *supra* note 21, at 86; Kelley, *supra* note 10, at 188; *see also* Noda, *supra* note 23, at 437-38; Riley & Carpenter, *supra* note 10, at 104. "In 1998, there were 94 registered trademarks that used the name Cherokee, 35 that used the name Navajo, and 208 that referred to the Sioux." Collier-Wise, *supra* note 21, at 86; *see also* Maury Audet, *Native American Tribal Names as Monikers and Logos: Will These Registrations Withstand Cancellation Under Lanham Act § 2(b) After the Trademark Study on Official Insignia of Native American Tribes?*, 2 CHI.-KENT J. INTELL. PROP. 4, 4 (2000); Terence Dougherty, *Group Rights to Cultural Survival: Intellectual Property Rights in Native American Symbols*, 29 COLUM. HUM. RTS. L. REV. 355, 376 (1998).

<sup>25</sup> Collier-Wise, *supra* note 21, at 87; Noda, *supra* note 23, at 436.

<sup>26</sup> Collier-Wise, *supra* note 21, at 87; Stephanie B. Turner, *The Case of the Zia: Looking Beyond Trademark Law to Protect Sacred Symbols*, 11 CHI.-KENT J. INTELL. PROP. 116, 116-17 (2012).

<sup>27</sup> Turner, *supra* note 26, at 116-17, 119.

<sup>28</sup> *Id.* 116-17; *see also* Collier-Wise, *supra* note 21, at 87.

<sup>29</sup> Turner, *supra* note 26, at 116-17.

<sup>30</sup> Madhavi Sunder, *IP3*, 59 STAN. L. REV. 257, 267 (2006) [hereinafter Sunder, *IP3*].

<sup>31</sup> Kelley, *supra* note 10, at 188-89.

<sup>32</sup> K.J. Greene, *Copyright, Culture & Black Music: A Legacy of Unequal Protection*, 21 HASTINGS COMM. & ENT. L.J. 339, 358 (1999) [hereinafter Greene, *Copyright*].

<sup>33</sup> Kelley, *supra* note 10, at 191; *see* Dougherty, *supra* note 24, at 377 ("Army had a mule, Navy a goat, Georgia had a bulldog and Syracuse had an Indian."); *see also* Justin G.

products by dominant cultures often causes source communities to suffer an economic harm, because they are generally not compensated for the commercial use of their product,<sup>34</sup> and they may even be disabled from using their own cultural product in commerce.<sup>35</sup> Additionally, the commercialization of the source community's cultural product, notwithstanding the economic harm to the community, may by its nature be destructive to the religious or cultural use of a cultural product.<sup>36</sup>

In social science literature, cultural appropriation begets a multi-level harm. At the surface level, when an appropriator takes a source community's cultural product, he changes the meaning of the cultural product—the harm to the source community is both a dilution or misrepresentation of the meaning of its cultural product, and a loss of control over that meaning.<sup>37</sup> When the appropriator is a dominant group in society, and the source community is subordinate, the appropriator's assumption of control over the meaning of the source community's product is said to entrench “systems of dominance and control that have been used to colonize, subdue and destroy” the source community.<sup>38</sup> Acts of appropriation by dominant groups that may be characterized as “homage,” such as an non-Native artist misusing the symbolism of the sweatlodge ceremony based on his childhood visit to a Plains Indian museum, while potentially well intentioned, no less contribute to the source community's loss of control over the meaning of its cultural product.<sup>39</sup>

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Blankenship, *The Cancellation of Redskins as a Disparaging Trademark: Is Federal Trademark Law an Appropriate Solution for Words that Offend?*, 72 U. COLO. L. REV. 415, 424 (2001) (“Appropriating American Indian dress, dance, and tradition and using them for purely entertainment purposes has a particularly deleterious effect because it trivializes the very basis of many cultural and religious beliefs.”).

<sup>34</sup> Chalk, *supra* note 19, at 7; Greene, *Copyright*, *supra* note 32, at 368-69; Sunder, *Identity Politics*, *supra* note 10, at 73; Tsotsie, *supra* note 10, at 313; Ziff & Rao, *supra* note 10, at 8-9.

<sup>35</sup> Scafidi, *supra* note 14, at 829.

<sup>36</sup> Tsotsie, *supra* note 10, at 300, 314; Ziff & Rao, *supra* note 10, at 8.

<sup>37</sup> Rosemary J. Coombe, *Cultural and Intellectual Properties: Occupying the Colonial Imagination*, 16 POL. & LEGAL ANTHROPOLOGY REV. 8, 11 (1993).

<sup>38</sup> David M. Meurer & Rosemary J. Coombe, *Atopia: Lifting, Digital Media and the Informational Politics of Appropriation Media and the Informational Politics of Appropriation* 20, 22, in *LIFTING*, (Atopia Projects eds., 2009) (explaining that appropriation in media industries “reinscribe[s] power relations existing between privileged and underprivileged classes, dominant and marginalized cultures, and developed and developing nations.”); Tsotsie, *supra* note 10, at 311 (“Many Native people argue, however, that they must control representations of their cultures as a means to ensure cultural survival. The failure to protect Native cultures, they argue, perpetuates significant harm to Native people as distinctive, living cultural groups.” *Id.* at 310); *see* Collier-Wise, *supra* note 21, at 89 (quoting Tsotsie); Riley & Carpenter, *supra* note 10, at 104-06 (same); *see also* Greene, *Copyright*, *supra* note 32, at 385; Noda, *supra* note 23, at 439; Madhavi Sunder, *Property in Personhood*, in *RETHINKING COMMODIFICATION: CASES AND READINGS IN LAW AND CULTURE* 164, 168-69 (Martha M. Ertman & Joan C. Williams eds., 2005) [hereinafter Sunder, *Property*]; *cf.* Ziff & Rao, *supra* note 10, at 5 (“[Appropriation] teach[es] us about power relationships.”).

<sup>39</sup> Coombe, *supra* note 37, at 13.



Appropriation of a cultural product and destruction of the source community is linked through the “distinctive relationship” between a community’s products and their “dignity, autonomy, and potential self-determination.”<sup>40</sup> “The taking of a people’s cultural product is akin to a taking of control over the people,”<sup>41</sup> because the people is no longer able to define itself and establish its own identity.<sup>42</sup>

The first-order harm of cultural appropriation is loss of a cultural product’s traditional meaning.<sup>43</sup> When a dominant culture appropriates a source community’s cultural product, the public may begin to perceive the cultural product in a way that exclusively conforms with the dominant culture’s new meaning.<sup>44</sup> In the case of the Zia Sun, many associate the symbol exclusively with the State of New Mexico, and have no sense of its religious significance to the Zia people.<sup>45</sup> A cultural product’s loss of traditional meaning may disrupt a community’s religious practice, or in other ways incrementally disrupt or destroy a community’s culture.<sup>46</sup> The new meaning attributed to the cultural object may misrepresent the source community’s identity,<sup>47</sup> which may result in public misperception of the culture, development of harmful ethnic stereotypes, and discrimination.<sup>48</sup>

The second-order harm of cultural appropriation is total loss of group identity.<sup>49</sup> When a dominant culture exerts control over a source community’s cultural product, it disenfranchises and dehumanizes the source community, representing the source community as “historical relics instead of human beings.”<sup>50</sup> In effect, the practice of cultural appropriation strips the source community of its ability to ascribe meaning to its cultural products, which severely limits its ability to identify itself and perpetuate its culture.

Though cultural appropriation is often described as having devastating consequences for the source community, some scholars have pushed back on this notion, and claimed that cultural appropriation is good for culture. Cultural appropriation is considered by some scholars “an inevitable part of the process of cultural change.”<sup>51</sup> It is not exclusively the dominant culture that takes

<sup>40</sup> Coombe & Aylwin, *supra* note 11, at 203-04.

<sup>41</sup> Kelley, *supra* note 10, at 191.

<sup>42</sup> Hart, *supra* note 15, at 139; Sunder, *IP3*, *supra* note 30, at 267 (“Power derives from the ability to shape and influence culture; inversely, those who do not have power to create and contest culture truly are powerless.” (internal quotations omitted) (citation omitted)); Tsotsie, *supra* note 10, at 313-14.

<sup>43</sup> Turner, *supra* note 26, at 124.

<sup>44</sup> Scafidi, *supra* note 14, at 829; Tsotsie, *supra* note 10, at 313-14.

<sup>45</sup> Tsotsie, *supra* note 10, at 314; Turner, *supra* note 26, at 121.

<sup>46</sup> Sunder, *Identity Politics*, *supra* note 10, at 73-74; Turner, *supra* note 26, at 123.

<sup>47</sup> Hart, *supra* note 15, at 139; Scafidi, *supra* note 14, at 824.

<sup>48</sup> Noda, *supra* note 23, at 443-44, 452; Tsotsie, *supra* note 10, at 313; Turner, *supra* note 26, at 123.

<sup>49</sup> Tsotsie, *supra* note 10, at 300.

<sup>50</sup> Blankenship, *supra* note 33, at 424; Collier-Wise, *supra* note 21, at 89-90; Dougherty, *supra* note 24, at 377; *see also* Sunder, *Property*, *supra* note 38, at 169.

<sup>51</sup> Sunder, *Identity Politics*, *supra* note 10, at 91.

cultural products from the subordinate culture—dominant cultures take from other dominant cultures, subordinate cultures take from dominant cultures, and subordinate cultures take from other subordinate cultures.<sup>52</sup> Cultures interact, merge, and blend with one another; cultures exchange people, ideas, resources, goods, values, and traditions.<sup>53</sup> Perpetuation of a culture in a multi-cultural world necessitates changes over time; these changes often derive from other cultures.<sup>54</sup>

Some cultural appropriation may in fact benefit source communities, particularly when another culture’s uses of a source community’s cultural product simultaneously conveys the significance of the product to the source community, and its new meaning in the appropriator’s culture.<sup>55</sup> The practice of cultural appropriation depends on a heterogeneous society—if cultures were the same, there would be no reason for appropriators to take from source communities—thus both appropriators and source communities are served by preserving heterogeneity. Moreover, cultural appropriation likely does not deprive source communities of their intangible cultural products.<sup>56</sup> By their nature, intangible products are nonrivalrous, and thus an outsider’s use of a source community’s idea, song, or symbol does not prevent the source community from continuing their traditional use of the product.<sup>57</sup>

### C. Cultural Appropriation in the Marketplace: IP in Cultural Products

In Western legal systems, intellectual property and cultural appropriation are intimately linked. Not only has intellectual property served as a vehicle for cultural appropriation, but source communities have increasingly used it as a tool to combat the practice, revealing both the power and shortcomings of intellectual property in this realm.

Within intellectual property, copyright is often characterized as a tool used by appropriators to advantageously “take” unprotected (or unprotectable) cultural products from a source community, and protect their expression of the cultural product through copyright,<sup>58</sup> thereby insulating themselves from any recourse from the source community. This practice can be seen in white copyright of black music throughout United States history,<sup>59</sup> and Native American works used without recompense by the entertainment industry.<sup>60</sup>

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<sup>52</sup> Scafidi, *supra* note 14, at 828; Ziff & Rao, *supra* note 10, at 5.

<sup>53</sup> Merry, *supra* note 10, at 585-86; Noda, *supra* note 23, at 432-33; Sunder, *Identity Politics*, *supra* note 10, at 92; Ziff & Rao, *supra* note 10, at 4-5; *see, e.g.*, Hart, *supra* note 15, at 144.

<sup>54</sup> Noda, *supra* note 23, at 432-33; *see also* Hart, *supra* note 15, at 139.

<sup>55</sup> Scafidi, *supra* note 14, at 826-27, 839.

<sup>56</sup> Ziff & Rao, *supra* note 10, at 4.

<sup>57</sup> *Id.*; *see also*, Noda, *supra* note 23, at 441-42.

<sup>58</sup> Greene, *Intellectual Property*, *supra* note 20, at 370.

<sup>59</sup> For an account of how copyright was routinely used by white artists to appropriate black music, *see id.* at 370, 373-74.

<sup>60</sup> Kelley, *supra* note 10, at 190.

Through copyright, appropriators, rather than source communities, have been able to acquire protection for their uses of cultural products.<sup>61</sup>

This seemingly lop-sided result is caused by the nature of copyright, and the divergent nature of cultural products. Cultural products, in their use by the source community, often fail to garner copyright protection because (1) they are the result of cumulative knowledge, and there is no recognized individual author,<sup>62</sup> (2) there is no singular user of the cultural product—the use is shared in a community commons, (3) often the cultural product is not fixed (for example, oral traditions and improvisation) or is an “idea” rather than an “expression” (such as musical genres and rites or ceremonies),<sup>63</sup> and (4) often the cultural product is extremely old or of indeterminate age, and any term of protection would have already lapsed.<sup>64</sup> As a result, in copyright, cultural products are frequently cast as de facto public domain material.<sup>65</sup>

Trademark is viewed as a vehicle for cultural appropriation because of its power to contribute to public discourse, and its instrumentality in affecting consumers’ perceptions of their world and interactions with others.<sup>66</sup> Trademarks used in advertising sometimes convey stereotyped or derogatory images of source communities. Professor K.J. Greene points out stereotypes of African Americans that pervade American advertising: Uncle Ben and Aunt Jemima, the chef on Cream of Wheat cereal, and the “Mammy” image of domineering matriarchs.<sup>67</sup>

Additionally, much like copyright, trademark has been used by appropriators to protect their uses of a source community’s cultural product. Federal trademark protection has applied to non-Native Americans’ commercial use of Native American symbols and images,<sup>68</sup> either simultaneously with or in absence of trademark protection for the source community’s use of their product. In the Zia Sun case, the State’s use of the Zia Sun symbol is protected, but the Zia people’s use is not.<sup>69</sup> Of the hundreds of registered trademarks that use the name “Cherokee,” “Navajo,” and “Sioux,” some may be owned by Native Americans, but many are not.<sup>70</sup> Though trademark law has enabled and entrenched a good deal of cultural appropriation, it may also provide a formidable means for protecting cultural products from a certain amount of appropriation. The ability of trademark law

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<sup>61</sup> Turner, *supra* note 26, at 122.

<sup>62</sup> Meurer & Coombe, *supra* note 38, at 22.

<sup>63</sup> Greene, *Intellectual Property*, *supra* note 20, at 371-72; Kelley, *supra* note 10, at 187-88; Sunder, *Property*, *supra* note 38, at 168.

<sup>64</sup> Greene, *Intellectual Property*, *supra* note 20, at 384.

<sup>65</sup> Coombe & Aylwin, *supra* note 11, at 204; Dougherty, *supra* note 24, at 374. For a study of Western law as a vehicle for cultural appropriation in the global music industry, see Meurer & Coombe, *supra* note 38, at 22.

<sup>66</sup> Greene, *Intellectual Property*, *supra* note 20, at 374.

<sup>67</sup> For an in depth account of African American stereotypes in trademark and advertising, see *id.* at 376-77.

<sup>68</sup> Dougherty, *supra* note 24, at 376.

<sup>69</sup> Turner, *supra* note 26, at 122.

<sup>70</sup> See *supra* note 15 and accompanying text.

to protect cultural products from appropriation has not yet received as thorough treatment as copyright: in Part II, this paper applies trademark law to cultural products, and in Part III assesses whether trademark is an effective and appropriate tool for protection.<sup>71</sup>

#### D. *Benefits and Drawbacks of Deterring Cultural Appropriation*

Though cultural products often fail to fit the mold of intellectual property, source communities have recently turned to intellectual property, and specifically trademark law, to protect whatever products they can.<sup>72</sup> Cultural groups often want to be able to control, restrict, authorize, or license uses of their cultural products by non-group members, in order to prevent or mitigate the perceived harm of cultural appropriation.<sup>73</sup> Some cultural groups seek to restrict cultural appropriation in order to receive economic compensation for use of their cultural products through license fees. Others seek to prevent changes in the meaning of their cultural products, by either restricting or prohibiting use by non-group members.<sup>74</sup> In Western legal systems, control over cultural property would likely derive from intellectual property laws, which may be used by individuals or groups to restrict others from copying their expressions, including inventions, writings, art, and design.

These communities see trademark as a powerful means of exercising control over their intangible cultural products,<sup>75</sup> that would enable them to share in profits, exclude unwanted outside uses, and gain recognition and social power as a result.<sup>76</sup> For example, in the Zia Sun case, the Zia people attempted to use provisions of the Lanham Act—the source of United States federal trademark law—to stop commercial entities from profiting by using their religious symbol.<sup>77</sup> Native Americans have also contested the trademark held by the Washington Redskins as demeaning.<sup>78</sup> Additionally, Native Americans have argued that use of a spiritual leader’s name to sell malt liquor violates a right to publicity.<sup>79</sup> More recently, the Navajo Nation sued Urban Outfitters for

<sup>71</sup> See *infra* Parts II & III.

<sup>72</sup> Sunder, *Property*, *supra* note 38, at 167-68. Internationally, Australian aborigines have sought collective copyrights in their artwork, and Canadian First Nations have sought copyrights in their traditional stories. *Id.* at 168.

<sup>73</sup> Collier-Wise, *supra* note 21, at 90 (citing to Christine Haight Farley, *Protecting Folklore of Indigenous Peoples: Is Intellectual Property the Answer?*, 30 CONN. L. REV. 1, 13-15 (1997)).

<sup>74</sup> Audet, *supra* note 24, at 11; Collier-Wise, *supra* note 21, at 13-15.

<sup>75</sup> Turner, *supra* note 26, at 118.

<sup>76</sup> Sunder, *IP3*, *supra* note 30, at 269-71, 273-74; Sunder, *Property*, *supra* note 38, at 167-68; Sunder, *Identity Politics*, *supra* note 10, at 71-72.

<sup>77</sup> Kelley, *supra* note 10, at 185; Sunder, *Property*, *supra* note 38, at 168; Turner, *supra* note 26, at 118.

<sup>78</sup> *Pro-Football, Inc. v. Harjo*, 415 F.3d 44 (D.C. Cir. 2005).

<sup>79</sup> Sunder, *Property*, *supra* note 38, at 168; see Nell Jessup Newton, *Memory and Misrepresentation: Representing Crazy Horse in Tribal Court*, in *BORROWED POWER: ESSAYS ON CULTURAL APPROPRIATION* 195, 211 (Bruce Ziff & Pratima V. Rao eds., 1997).

trademark infringement based on Urban Outfitters naming items of clothing “navajo.”<sup>80</sup>

However, the idea that cultural appropriation should be restricted by any means, particularly intellectual property, has drawn sharp criticism. Scholars have claimed that any restriction of cultural appropriation would likely be counterproductive for the source community. In order to police cultural appropriation, boundaries must be cast around the constituency of the source community and its membership. In order to define its membership, there must be some test of group belonging,<sup>81</sup> some standard by which to decide whether a cultural product belongs to a particular group, and some kind of “authenticity” requirement to assess whether a use of the culture’s product conforms with the rules they set out to govern it.<sup>82</sup> Not only is it difficult to define the parameters of a cultural group (that is not static over time), it is difficult to justify a group’s possession of a particular cultural object, which may have been taken or borrowed from some other group at an earlier time.<sup>83</sup> Boundaries drawn around a culture, its membership, and its products, for the sake of restricting cultural appropriation, may “freeze” a culture at a particular moment,<sup>84</sup> in effect rendering it a “historical relic.”

Scholars critical of restricting cultural appropriation have cast doubt on the propriety of using intellectual property rights for that purpose. For some source communities, propertization of their culture counteracts community norms of common ownership.<sup>85</sup> There is some concern that a property right may also trivialize or minimize the importance of the cultural product.<sup>86</sup> Moreover, just as defining a culture, its membership, and its product may freeze a culture, intellectual property rights in a cultural product may “insulate cultures from interaction with other communities, creating ossified and static cultures that reinforce traditions through law.”<sup>87</sup> Additionally, restricting cultural appropriation through intellectual property may itself perpetuate systems of dominance and oppression, as source communities are relegated to defining themselves and their products through the dominant culture’s construct of property law.<sup>88</sup>

Moreover, intellectual property may be an inadequate means of restricting cultural appropriation. For instance, the idea of perpetually restricting the use of an idea because it is a cultural product is particularly abhorrent to copyright

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<sup>80</sup> Navajo Nation v. Urban Outfitters, Inc., 935 F. Supp. 2d 1147 (D. N.M. 2013).

<sup>81</sup> Sunder, *Identity Politics*, *supra* note 10, at 94 (quoting Ziff & Rao); Ziff & Rao, *supra* note 10, at 3.

<sup>82</sup> Tsotsie, *supra* note 10, at 349-50.

<sup>83</sup> Ziff & Rao, *supra* note 10, at 3.

<sup>84</sup> Scaffidi, *supra* note 14, at 817; Collier-Wise, *supra* note 21, at 100.

<sup>85</sup> Sunder, *Property*, *supra* note 38, at 170.

<sup>86</sup> Collier-Wise, *supra* note 21, at 99; Newton, *supra* note 79 **Error! Bookmark not defined.**; Tsotsie, *supra* note 10, at 352.

<sup>87</sup> Sunder, *Property*, *supra* note 38, at 173-74.

<sup>88</sup> Collier-Wise, *supra* note 21, at 100; Tsotsie, *supra* note 10, at 352.

and free speech<sup>89</sup>: Copyright does not grant ownership in ideas alone—all ideas are accessible to anyone who may wish to use them in a particular expression.<sup>90</sup> The author of the expression, not the incipient of the idea, receives copyright protection.<sup>91</sup> While trademark does not contain as explicit an idea/expression dichotomy as copyright, trademark inherently protects visually, auditorily, or otherwise sensorially perceptible marks, rather than the ideas from which they originate.<sup>92</sup> Accordingly, seeking copyright and trademark protection for certain cultural products may misconstrue the purpose of intellectual property, and threaten “our common cultural heritage and the free circulation of ideas.”<sup>93</sup>

Despite some scholars’ misgivings about using intellectual property to curb cultural appropriation, source communities see the potentially profound limiting effect trademark law could have on cultural appropriation. If source communities are able to either extensively enjoin or otherwise deter companies from using their cultural products as trademarks, they could severely diminish the use of their cultural products by non-members.<sup>94</sup> If trademark law is used to protect cultural products, source communities may be able to regain their ability to define the product’s meaning and prevent would-be appropriators from profiting from their cultural product—potentially perpetually. The next parts of this paper apply trademark law to cultural appropriation, first to determine the extent to which trademark law can be used to restrain cultural appropriation, then to analyze whether trademark law ought to be used for this end, given the core purposes of trademark law.

## II. USING TRADEMARK LAW TO DETER CULTURAL APPROPRIATION

### A. *Purposes of Trademark Law*

The two most commonly espoused purposes of trademark law are avoiding consumer confusion, and preventing the appropriation of a producer’s good will.<sup>95</sup> Though scholars disagree on which of the two is the “true” purpose of trademark law, much of trademark law serves these two purposes in tandem, and in many cases, these two purposes are wholly compatible.<sup>96</sup> Moreover, both purposes inure to an unequivocal underlying purpose of trademark law—fostering a more competitive market.

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<sup>89</sup> Collier-Wise, *supra* note 21, at 94.

<sup>90</sup> Coombe, *supra* note 37, at 10.

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

<sup>92</sup> See *infra* notes 123-126 and accompanying text.

<sup>93</sup> Sunder, *Property*, *supra* note 38, at 171; see also Tsotsie, *supra* note 10, at 347.

<sup>94</sup> Removing a cultural product from trademark use would limit consumers’ exposure to the cultural product, in effect inhibiting to some extent the diffusion of its use (and its meaning) in society.

<sup>95</sup> Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 786 (2004).

<sup>96</sup> *Id.* at 786.

A central goal of trademark law—reducing consumer search costs—serves primarily to avoid consumer confusion, and secondarily to prevent appropriation of a producer’s good will. Professor Mark Lemley, a champion of the “Consumer Search Costs” school, has explained that trademarks result in a more competitive market through their “informative value.”<sup>97</sup> That is, trademarks become a shorthand indicator of source and quality, which makes it easier and less expensive for consumers to be informed about a particular product.<sup>98</sup> Trademarks are only valuable insofar as they denote consistent quality<sup>99</sup>; trademark law, in turn, protects the accuracy of trademarks, thereby fostering the flow of information in markets.<sup>100</sup> Buyers benefit from trademark law because they do not have to expend much time or undertake research before making a purchase; sellers benefit because they can invest in their reputation (their good will), knowing competitors will not appropriate it.<sup>101</sup>

The requirements underlying trademark protection are designed to reduce consumer search costs. Covered in greater detail in Part II.B, trademark protection is conditioned on use in commerce and distinctiveness, both of which must be present to establish a trademark’s good will. Landes & Posner explain that if a trademark is not used in commerce, it cannot identify and distinguish goods, and accordingly it confers no benefit on consumers (or producers for that matter).<sup>102</sup> A trademark must also be distinctive to provide an informative value to consumers—if a trademark does not identify the product or distinguish it from that of other producers, the mark cannot provide information that reduces consumer search costs.<sup>103</sup>

In contrast to the “Consumer Search Costs” school, the “Unfair Competition” school, championed by Professor Mark McKenna, views trademarks and trademark law as primarily protecting producers from illegitimate diversions of trade, and secondarily as protecting consumers from confusion.<sup>104</sup> Consumer confusion is relevant to protecting producers from illegitimate diversions of trade insofar as it is an effective way of stealing a competitor’s trade.<sup>105</sup> McKenna views the trademark protection as a property right in the mark itself; however, he clarifies that “it [is] not the words or

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<sup>97</sup> This view is also supported by Professor William Landes and Judge Richard Posner. William Landes & Richard Posner, *The Economics of Trademark Law*, in *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 166, 168 (2003); *see also* Deven R. Desari, *The Chicago School Trap in Trademark*, 37 *CARDOZO L. REV.* 551, 603 (2015).

<sup>98</sup> Dogan & Lemley, *supra* note 95, at 786-88.

<sup>99</sup> Landes & Posner, *supra* note 97, at 168.

<sup>100</sup> Dogan & Lemley, *supra* note 95, at 778, 786-88; Landes & Posner, *supra* note 97, at 173 (“[T]rademarks lower consumers’ search costs by providing them with valuable information about brands and encourage quality control rather than create social waste and consumer deception.”); Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 *NOTRE DAME L. REV.* 1839, 1844 (2007).

<sup>101</sup> Dogan & Lemley, *supra* note 95, at 786-88.

<sup>102</sup> Landes & Posner, *supra* note 97, at 181.

<sup>103</sup> *Id.* at 187.

<sup>104</sup> McKenna, *supra* note 100, at 1840-41.

<sup>105</sup> *Id.* at 1848.

symbols themselves that were protected; those [are] merely the representations of the property”<sup>106</sup>—the property is the producer’s good will. Recently, the “Unfair Competition” school has expanded from the notion of trademark law as protecting the producer’s property right in his good will: The advent of merchandising positions trademarks as goods whose value are independent of their underlying product.<sup>107</sup>

Regardless of the order of priority between avoiding consumer confusion and protecting producers’ good will, the touchstone of trademark law is fostering competition in the marketplace. As a result of its marketplace focus, and the common use of words, symbols, and images as trademarks, trademark law is self-conscious of the potential for incursion into the domain of free speech in its effort to promote competition.<sup>108</sup> Overly restrictive trademark law can stifle both competition and free speech, by blocking competitors from access to a word they need to describe their product. Some built-in features of trademark law attempt to limit the potential for an adverse effect on competition and free speech: the trademark-use requirement, as well as nominative and descriptive fair use.<sup>109</sup> The trademark-use requirement and nominative fair use go hand-in-hand—a trademark may be used by anyone—competitors, consumers, and the media included—to refer to the trademarked product, by consumers referring to both the product and its alternatives, by competitors for comparative advertising, by critics and parodists to lambast or poke fun at the product.<sup>110</sup> To the same end, descriptive fair use preserves competitors’ rights to use a trademark-protected descriptive term in its descriptive sense.<sup>111</sup> While trademark law on its face protects the informative value of trademarks and their representation of producers’ good will, it also seeks to prevent protection of a trademark that would chill free speech or inhibit competition.

#### B. *Requirements for Trademark Protection*

By definition, protection of a trademark through trademark law, regardless of the type of mark, is predicated on a mark’s use in commerce and its distinctiveness. Lanham Act section 45 defines a trademark as

any word, name, symbol, or device, or any combination thereof—(1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this Act, to identify and distinguish his or her goods, including a unique product, from

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<sup>106</sup> *Id.* at 1885.

<sup>107</sup> Desari, *supra* note 97, at 603-04.

<sup>108</sup> Dogan & Lemley, *supra* note 95, at 809 (“The speech-oriented objectives of trademark use doctrine . . . prevent trademark holders from asserting a generalized right to control language . . .”).

<sup>109</sup> Dogan & Lemley, *supra* note 95, at 788.

<sup>110</sup> *See, e.g., id.* 809-10, 796-97, 828.

<sup>111</sup> *Zatarain’s, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786 (5th Cir. 1983).



those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.<sup>112</sup>

The requirements of “use in commerce” and “distinctiveness” not only ensure that the Lanham Act—a federal law—firmly maintains its basis in the Commerce Clause,<sup>113</sup> but also serve the purposes of trademark law: preventing consumer confusion and protecting producers’ good will.<sup>114</sup>

Ownership of a trademark, which serves as the basis for certain causes of action under trademark law, goes to the first entity to use a distinctive mark in commerce as a trademark.<sup>115</sup> Actual use, not registration, initiates the rights and priority that accrue to the trademark owner.<sup>116</sup> Actual use requires “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in the mark.”<sup>117</sup> Moreover, registration will only issue once a mark has been used in commerce, meaning “goods bearing a trademark must have been sold ‘in’ interstate commerce, or that services are rendered ‘in’ interstate commerce.”<sup>118</sup> Though “use in commerce” may be read to require a trademark to be used in the course of a *sale*, trademarks used by non-profit and charitable organizations—that do not “sell” their goods or services—are equally considered “used in commerce.”<sup>119</sup>

A mark “used in commerce” only garners trademark protection if it is also distinctive. In order to serve as a trademark, a mark must be “so distinctive that it is capable of performing the function of identifying and distinguishing the goods that bear the [mark].”<sup>120</sup> Distinctiveness of a trademark is generally ascertained categorically: if a mark is fanciful, arbitrary, or suggestive, it is considered “inherently distinctive,” meaning upon viewing, it immediately communicates the source of the goods. A descriptive mark, which primarily describes some feature of the good, may “acquire” distinctiveness through “secondary meaning,” when its use by the seller has created a strong association in the consumer’s mind, sufficient to convey source. A generic

<sup>112</sup> Lanham Act § 45, 15 U.S.C. § 1127 (2015). An analogous definition applies to service marks, with the word “service” taking the place of the word “goods” in the definition. *Id.*

<sup>113</sup> Though trademark law is viewed as a branch of intellectual property law, it derives its constitutional justification not in the Copyright Clause, U.S. CONST. art. I, § 8, cl. 8 (“To promote the Progress of Science and useful Arts”), as do copyright and patent law, but in the Commerce Clause, *id.* art. I, § 8, cl. 3 (“To regulate Commerce . . . among the several States”). As a result of its basis in the Commerce Clause, trademark protection must be limited to marks used in commerce.

<sup>114</sup> See *infra* Part II.A.

<sup>115</sup> *In re Trade-Mark Cases*, 100 U.S. 82, 94, (1879) (“At common law the exclusive right to it grows out of the use of it, and not its mere adoption.”); J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 16:1 (Clark Boardman Callaghan ed., 4th ed. 2016).

<sup>116</sup> MCCARTHY, *supra* note 115, § 16:1.

<sup>117</sup> *Id.* § 16:8; § 1127.

<sup>118</sup> MCCARTHY, *supra* note 115, § 19:10.

<sup>119</sup> *Planetary Motion, Inc. v. Techsplosion, Inc.*, 261 F.3d 1188 (11th Cir. 2001);

MCCARTHY, *supra* note 115, § 9:5.

<sup>120</sup> MCCARTHY, *supra* note 115, § 3:1.

mark, which is the general name for the kind of good, regardless of source, altogether lacks distinctiveness, because it is incapable of identifying its producer or distinguishing a good from those made by another producer.<sup>121</sup> Marks that were once inherently distinctive may “enter the public domain” by becoming the generic term for the good; once a mark has become generic, it can no longer be protected as a trademark.<sup>122</sup> Aspirin, cellophane, and escalator all started as fanciful marks, and have since become the generic names for those products.<sup>123</sup>

Distinctiveness and use in commerce together enable a mark to represent the “good will,” or the reputation and business value, of the mark holder.<sup>124</sup> Though “good will” is not named in the Lanham Act as a requirement for trademark protection, it serves as a shorthand for the value the trademark is protecting, and is in essence an implicit requirement.<sup>125</sup> “A trademark has no existence separate from the good will of the product or the service it symbolizes. Good will and its tangible symbol, a trademark, are inseparable.”<sup>126</sup> Because consumers cannot use non-distinctive marks to identify the source of a good or distinguish it from those from another source, such a mark does not represent the business’s good will, and thus does not serve any purpose worthy of trademark protection.<sup>127</sup>

### C. Registering Culture: Requirements and Benefits of Registration

Cultural groups, whether they constitute tribes, racial groups, or some other discernable community, whose cultural products are distinctive and used in commerce, may be able to register their cultural products as trademarks and thereby gain the benefits of registration.<sup>128</sup> The Lanham Act section 2 establishes fairly permissive requirements to register a valid trademark (one that is distinctive and used in commerce), stating, “No trademark . . . shall be refused registration . . . unless it . . .” gives rise to one of the enumerated

<sup>121</sup> Restatement (Third) of Unfair Competition § 15, comment a (1995); MCCARTHY, *supra* note 115, §§ 3:1, 12:1.

<sup>122</sup> MCCARTHY, *supra* note 115, §§ 11:9; 12:29.

<sup>123</sup> McGregor-Doniger, Inc. v. Drizzle, Inc., 599 F.2d 1126 (2d Cir. 1979); MCCARTHY, *supra* note 115, § 11:9.

<sup>124</sup> MCCARTHY, *supra* note 115, §§ 2:17, 2:30; *see* Lifeguard Licensing Corp. v. Gogo Sports, Inc., 108 U.S.P.Q.2d 1454, 1457 n.2 (S.D. N.Y. 2013); Porous Media Corp. v. Pall Corp., 173 F.3d 1109 (8th Cir. 1999) (“The goodwill of a company is an intangible business value which reflects the basic human tendency to do business with a merchant who offers products of the type and quality which the consumer desires and expects.”).

<sup>125</sup> MCCARTHY, *supra* note 115, § 3:2.

<sup>126</sup> Cent. Garden & Pet Co. v. Doskocil Mfg. Co., 108 U.S.P.Q.2d 1134, 1147 (T.T.A.B. 2013) (“Any transfer of a trademark must include the goodwill associated with the mark, because without goodwill, there is no trademark to transfer.”); MCCARTHY, *supra* note 115, § 2:15.

<sup>127</sup> MCCARTHY, *supra* note 115, § 16:1.

<sup>128</sup> Collier-Wise, *supra* note 21, at 94.

statutory bars to registration.<sup>129</sup> These statutory bars include: (a) immoral, deceptive, or scandalous matter; matter which may disparage, falsely suggest a connection with, or bring into contempt or disrepute living or dead persons, institutions, beliefs, or national symbols; (b) the flag or coat of arms or other insignia of the United States, or of any State or municipality; (c) the name, portrait, or signature of a living person; (d) a mark confusingly similar to a registered mark owned by someone else and not abandoned;<sup>130</sup> (e) a merely descriptive or deceptively misdescriptive mark, including mere surnames, and functional matters, and (f) a mark that will likely dilute another registered mark.<sup>131</sup>

Due to the permissive requirements for trademark registration, there has been a wide variety of registered marks. Not only are words, images, and symbols often registered, but a series of musical notes (the NBC chimes), scents, and film characters have also been registered as trademarks. With respect to cultural products, source communities may be able to register their names, certain phrases, symbols, designs, artwork, certain music, and characters in oral tradition as trademarks, as long as they serve as a valid trademark, and do not fall under any of the statutory bars to protection. However, some cultural groups whose products have already been appropriated may not be able to register their marks. If appropriators have already registered a cultural product for trademark protection, the source community may be barred from registration under section 2(d) because their mark would be confusingly similar to the appropriator's already registered mark. In the Zia Sun case, the Zia people could not register a mark containing the Zia Sun symbol because it is on the flag of the State of New Mexico, and barred under section 2(b), even though the Zia's religious use of the sun symbol predates its appearance on the State flag.<sup>132</sup>

Registration provides several advantages for trademark owners over state and common law protection.<sup>133</sup> First, registration is prima facie evidence of the mark's validity and the mark owner's ownership and exclusive right to use the registered mark.<sup>134</sup> Registration is a constructive notice of the owner's claim of ownership,<sup>135</sup> and also confers to the owner nationwide priority in use.<sup>136</sup>

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<sup>129</sup> Lanham Act § 2, 15 U.S.C. § 1052 (2015).

<sup>130</sup> Added later, a mark that is likely to cause dilution by blurring or dilution by tarnishment under section 43(c) may also be refused registration. *Id.* §1125(c).

<sup>131</sup> *Id.*

<sup>132</sup> Turner, *supra* note 26, at 122. In 1999, a question was raised as to whether all Native American insignia should be barred from registration under section 2(b), and the USPTO released a study finding that Native American insignia do not qualify for the bar to registration as "insignia of the United States." For an extensive account of the USPTO study and its findings, see Audet, *supra* note 24, at 13, 16-19, 21, 66-67, and Turner, *supra* note 26, at 136-38.

<sup>133</sup> Blankenship, *supra* note 33, at 419-20.

<sup>134</sup> §§ 1057(b), 1115(a); MCCARTHY, *supra* note 115, § 19:9; Blankenship, *supra* note 33, at 419-20.

<sup>135</sup> MCCARTHY, *supra* note 115, § 19:9; Blankenship, *supra* note 33, at 419-20; § 1072.

<sup>136</sup> McCarthy, *supra* note 115, § 16:1.

Registration also serves as prima facie evidence that a mark is not confusingly similar to another registered mark, and, if descriptive, that the mark has acquired secondary meaning.<sup>137</sup> Additionally, registration granted to a use-based application is prima facie evidence that the mark has been used in interstate commerce prior to registration.<sup>138</sup> A registered mark may also become “incontestable” after five years of continuous use, which limits potential challengers to fewer arguments for cancellation.<sup>139</sup> In *Navajo Nation v. Urban Outfitters*, the Navajo Nation, which has a registered trademark in the name “Navajo,” used its registered status to argue that it owns a valid, incontestable trademark, and as such could not be cancelled for being “merely descriptive.”<sup>140</sup>

In trademark infringement disputes, a registered mark establishes federal jurisdiction without the required amount in controversy,<sup>141</sup> and in federal courts, profits, damages, and costs are recoverable, and treble damages and attorney’s fees are available.<sup>142</sup> Moreover, registration may be used to stop the importation into the United States of infringing articles.<sup>143</sup>

Unregistered marks are entitled to common law protection so long as they are distinctive and are used in commerce. However, unlike federally registered marks, unregistered marks are not entitled to nationwide priority in use—they must be both distinctive and used in commerce in the state in which infringement occurs for the unregistered mark holder to assert senior use in that state.

The idea that cultural groups should register their cultural products as trademarks to receive the concomitant protection has been met with strong criticism from some indigenous rights scholars, calling trademark registration “offensive” and “fundamentally inappropriate.”<sup>144</sup> Trademark laws are constructed to facilitate dissemination, which is inherently incompatible with some cultural groups’ intention to prevent cultural products from circulation and appropriation.<sup>145</sup> There is also concern about to whom the trademark would be registered, and how the group can maintain group ownership or a group right to use the mark.<sup>146</sup> Registration may also inadvertently prevent other groups for whom the mark serves as a cultural product from using the mark in

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<sup>137</sup> *Liberty Mut. Ins. Co. v. Liberty Ins. Co.*, 185 F. Supp. 895 (E.D. Ark. 1960); McCarthy, *supra* note 115, § 19:9.

<sup>138</sup> *Li'l Red Barn, Inc. v. Red Barn System, Inc.*, 322 F. Supp. 98 (N.D. Ind. 1970), *aff'd per curiam*, 174 U.S.P.Q. 193 (7th Cir. 1972); *Maternally Yours, Inc. v. Your Maternity Shop, Inc.*, 234 F.2d 538 (2d Cir. 1956); MCCARTHY, *supra* note 115, § 19:9.

<sup>139</sup> §§ 1065, 1115(b); MCCARTHY, *supra* note 115, § 19:9; Blankenship, *supra* note 33, at 419-20.

<sup>140</sup> *Navajo Nation v. Urban Outfitters, Inc.*, 935 F. Supp. 2d 1147, 1162-63 (D. N.M. 2013).

<sup>141</sup> Blankenship, *supra* note 33, at 419-20.

<sup>142</sup> § 1117; MCCARTHY, *supra* note 115, § 19:9.

<sup>143</sup> § 1124; MCCARTHY, *supra* note 115, § 19:9; Blankenship, *supra* note 33, at 419-20.

<sup>144</sup> Turner, *supra* note 26, at 117, 124.

<sup>145</sup> *Id.* at 117.

<sup>146</sup> Audet, *supra* note 24, at 12; Turner, *supra* note 26, at 124-25.

the same manner.<sup>147</sup> Some cultural groups also believe that certain religious or sacred symbols will lose their qualities and meanings if registered as a trademark—just as they would if appropriated and used by non-group members.<sup>148</sup> Instead of trademark registration, some groups would prefer to see an absolute prohibition of registration of their cultural products.<sup>149</sup>

While many cultural products would be eligible for trademark registration under the Lanham Act if used in commerce and distinctive of a single source, some may not even meet this threshold requirement.<sup>150</sup> Cultural groups may seek to protect their products that are not used in the course of a sale, and do not designate a single source, but instead the whole source community. Accordingly, cultural groups may find more suitable protection under the Lanham Act as collective or certification marks. In the Lanham Act, collective marks and certification marks are registrable in the same manner and with the same effect as trademarks, as long as the owner exercises legitimate control over use of the marks, even though the owner may not be a commercial establishment.<sup>151</sup>

A collective mark is any trademark or service mark that is used by the members of a cooperative, an association, or some other collective group or organization.<sup>152</sup> A collective mark may be symbolic of membership in some collective group or organization, or of the goods or services provided by members of the organization.<sup>153</sup> The collective owns the mark, and all of its members use the mark to identify and distinguish their goods or services.<sup>154</sup> The collective organization itself usually neither sells goods nor performs services under the mark, but it may advertise and promote the goods or services sold by its members.<sup>155</sup> Examples of collective marks include agricultural cooperatives, the Professional Golfers Association, and the Realtor mark for

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<sup>147</sup> For example, some Native American tribes use the same or highly similar symbols, names, or images, sometimes because of common origin, but also sometimes because different tribes have borrowed cultural products from one another. Audet, *supra* note 24, at 12; *see supra* Part I.B.

<sup>148</sup> Audet, *supra* note 24, at 12; *see supra* Part I.B.

<sup>149</sup> This view has taken hold in Canada, Australia, and New Zealand. *See Chalk, supra* note 19, at 4.

<sup>150</sup> *See* Audet, *supra* note 24, at 12.

<sup>151</sup> Lanham Act § 4, 15 U.S.C. § 1054 (2015). “Subject to the provisions relating to the registration of trademarks, so far as they are applicable, collective and certification marks, including indications of regional origin, shall be registrable under this chapter, in the same manner and with the same effect as are trademarks, by persons, and nations, States, municipalities, and the like, exercising legitimate control over the use of the marks sought to be registered, even though not possessing an industrial or commercial establishment, and when registered they shall be entitled to the protection provided in this chapter in the case of trademarks, except in the case of certification marks when used so as to represent falsely that the owner or a user thereof makes or sells the goods or performs the services on or in connection with which such mark is used.” *Id.*

<sup>152</sup> § 1127; MCCARTHY, *supra* note 115, § 4:16.

<sup>153</sup> MCCARTHY, *supra* note 115, § 4:16.

<sup>154</sup> *Id.* § 19:99.

<sup>155</sup> *Id.*

real estate sales services.<sup>156</sup> Collective marks may also be regional in nature, and may indicate membership in a collective of sellers from a specific geographical region.<sup>157</sup> Collective membership marks do not require any sales of goods or services by members: they may be protected insofar as they are used by members to indicate membership in an organization.<sup>158</sup> However, collective membership marks must also qualify as valid trademarks in order to be protected on goods bearing the mark. Regardless of a collective mark's protection as a trademark, a third party's unauthorized use of the collective name as a trademark may be confusingly similar to the collective mark, and may be barred from registration or enjoined.<sup>159</sup> In a cancellation proceeding or an infringement litigation, the collective represents the shared interest of its members.

A certification mark is any word, name, symbol, or device, used by a person other than its owner in commerce, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of the goods or services, such as that the work was performed by members of a certain organization.<sup>160</sup> There are three types of certification marks: those that certify quality, those that certify regional origin, and those that certify work was performed by union/organized labor.<sup>161</sup> A certification mark is a symbolic guarantee that the product meets certain standards.<sup>162</sup> As an indication of regional original, geographical certification marks do not require proof of secondary meaning.<sup>163</sup> Certification marks impose more requirements on mark owners than do collective markets. Unlike a collective mark, a certification mark cannot be used by the mark owner in the course of sales, or as a trademark.<sup>164</sup> A certification mark owner must also control the use of its mark,

<sup>156</sup> *Jacob Zimmerman v. National Association of Realtors*, 70 U.S.P.Q.2d 1425 (T.T.A.B. 2004); *Professional Golfers Ass'n v. Bankers Life & Casualty Co.*, 514 F.2d 665 (5th Cir. 1975); MCCARTHY, *supra* note 115, § 19:99.

<sup>157</sup> MCCARTHY, *supra* note 115, § 19:99.

<sup>158</sup> *Id.* § 19:101.

<sup>159</sup> *Allstate Life Ins. Co. v. Cuna International, Inc.*, 169 U.S.P.Q. 313 (T.T.A.B. 1971), *aff'd* without op., 487 F.2d 1407 (C.C.P.A. 1973); *Boise Cascade Corp. v. Mississippi Pine Mfrs. Ass'n*, 164 U.S.P.Q. 364 (T.T.A.B. 1969).

<sup>160</sup> Lanham Act § 45, 15 U.S.C. § 1127 (2015); MCCARTHY, *supra* note 115, § 4:15.

Certification marks are a very popular form of protection for indigenous groups in New Zealand, and have come to serve as "labels of authenticity" to indicate true indigenous origin of their goods. For an extensive account, see Chalk, *supra* note 19, at 3-7, 10, 12-13. For a critique of the use of certification marks by source communities to protect cultural products, see Scaffidi, *supra* note 14, at 817-20, 822-23.

<sup>161</sup> MCCARTHY, *supra* note 115, § 19:91.

<sup>162</sup> *Id.* §§ 4:16, 19:99.

<sup>163</sup> § 1052(2)(e)(2); *Community of Roquefort v. William Faehndrich, Inc.*, 303 F.2d 494, 497 (2d Cir. 1962) ("A geographical name does not require a secondary meaning in order to qualify for registration as a certification mark."); MCCARTHY, *supra* note 115, § 19:91.

<sup>164</sup> Restatement (Third) of Unfair Competition § 11, comment a (1995); MCCARTHY, *supra* note 115, §§ 19:92, 19:94. In re Florida Citrus Comm'n, 160 U.S.P.Q. 495 (T.T.A.B. 1968); see In re Allied Stores Corp., 153 U.S.P.Q. 84 (T.T.A.B. 1967); Holtzman, "Tips from the Trademark Examining Operation—Certification Marks: An Overview," 81 TRADEMARK

and it cannot permit use of the mark other than to certify, or discriminately refuse to certify the goods of any person who maintains the standards set by the certification mark owner.<sup>165</sup> Lack of control, either by giving permission to use a certification mark when standards are not met, or by failing to police unlicensed uses, constitutes grounds for cancellation of the mark.<sup>166</sup> In a cancellation or infringement proceeding against a confusingly similar mark, the certification mark owner represents the mark users.<sup>167</sup>

Registration as a collective or a certification mark may overcome some scholars' concerns about the incongruence of requirements for trademark protection with the norms of source communities. Both collective marks and certification marks allow for either group ownership, or organizational ownership on behalf of the group, allow group members (or those meeting certain standards) to use the mark, and establish the organization's standing in cancellation proceedings or infringement claims against confusingly similar or unauthorized users of the mark. Both collective marks and certification marks, however, would require a cultural group to erect some boundaries to membership. A collective mark needs to have some enforced definition of group membership, and a certification mark needs to have some enforced standards for certification; the mark owner must decide who is an authentic member, or what is an authentic product. If group membership or certification is too permissive, the mark may lose its distinctiveness, and as a result, its protection.

Registration as a collective mark avoids the more stringent requirements of a certification mark—a collective mark owner does not have to guarantee that products bearing the mark meet certain quality standards, and can use the collective mark in addition to members' use. Collective marks also allow cultural groups to simultaneously register their marks as trademarks, if possible, whereas certification marks cannot serve as trademarks.

Collective marks on balance seem more beneficial to cultural groups, because they offer the same general benefits as certification marks, have less stringent requirements, and allow for simultaneous trademark registration. Some groups may find that registration as a geographic certification mark may be an easier avenue to registration, because it does not require proof of secondary meaning when used as an indication of regional origin.

#### D. *Resisting Appropriation: Trademark Causes of Action*

Source communities that seek to utilize trademark law to combat cultural appropriation may be able to initiate two kinds of actions against appropriators:

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REP. 180, 187 (1991) (“[I]f a party filing a certification mark application owns an existing registration for the same mark on goods, the applicant may be subject to refusal on two grounds: (1) applicant is engaged in the production of goods and (2) applicant is using the mark for purposes other than to certify.”).

<sup>165</sup> § 1064(5)(C)-(D); MCCARTHY, *supra* note 115, § 19:92.

<sup>166</sup> § 1064(5)(A); MCCARTHY, *supra* note 115, § 19:92.

<sup>167</sup> MCCARTHY, *supra* note 115, § 19:92.50.

opposition or cancellation proceedings, and infringement actions. Opposition or cancellation of a registered trademark, and a successful infringement action, markedly differ from one another in the grounds that could give rise to a successful claim, and the resultant limitations imposed on the appropriator's use of the source community's cultural product. When possible, initiators of trademark infringement actions often argue that the allegedly infringing mark ought to be cancelled, to impose limits under both kinds of trademark actions.

An opposition or cancellation proceeding is a challenge raised against a mark that has been filed for registration but not yet received it (opposition) or against a registered mark (cancellation), to respectively prevent it from being registered, or remove it from the register. Anyone who "believes that he would be damaged by the registration of a mark" has standing to initiate an opposition or cancellation proceeding.<sup>168</sup> Under this permissive standard, the challenger need not own or use a trademark whose value would be damaged by the challenged mark; as long as the challenger could argue some theory of harm under one of the grounds for cancellation, he will have standing to initiate a cancellation proceeding.<sup>169</sup>

There are a number of potential grounds for opposition or cancellation of a registered mark; however, whether the grounds can be argued depends on whether the challenged mark has become "incontestable" through five years of continuous use after registration.<sup>170</sup> For a contestable mark, any of the bars to registration in Lanham Act section 2 can serve as grounds for opposition or cancellation<sup>171</sup>; for an incontestable mark, those grounds are limited to (a) immoral, deceptive, or scandalous matter, or matter which may falsely suggest a connection with persons, institutions, beliefs, or national symbols, or bring them into contempt or disrepute<sup>172</sup>; (b) the flag, or coat of arms, or other insignia of the United States, or of any State or municipality; (c) the name, portrait, or signature of a living individual; generic marks; functional marks; abandoned marks; marks that misrepresent source; and marks obtained through fraud.<sup>173</sup> The only grounds that can be raised for cancellation of a contestable mark that cannot be raised against an incontestable mark are: (d) that a mark is merely descriptive or deceptively misdescriptive; (e) that a mark is confusingly

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<sup>168</sup> §§ 1063, 1064.

<sup>169</sup> *Id.* § 1063; MCCARTHY, *supra* note 115, § 20:46.

<sup>170</sup> §§ 1064, 1065.

<sup>171</sup> *Id.* § 1064; MCCARTHY, *supra* note 115, § 20:52; Blankenship, *supra* note 33, at 421.

<sup>172</sup> See MCCARTHY, *supra* note 115, § 19:76; §§ 1064, 1052(a).

<sup>173</sup> §§ 1052 (a)-(c), 1064, 1115; MCCARTHY, *supra* note 115, § 20:56-60; Blankenship, *supra* note 33, at 421-22; see also Audet, *supra* note 24, at 10-11. Incontestable certification marks are subject to cancellation if the mark owner cannot or does not legitimately exercise control over use of the mark, or engages in the production or marketing of goods to which the mark is applied, or permits the mark's use for something other than certification, or discriminately refuses to certify goods of anyone who maintains the standards required for certification. § 1064(5); MCCARTHY, *supra* note 115, § 20:61.



similar to another registered mark; and (f) that the mark will likely dilute another registered mark.<sup>174</sup>

Of the possible grounds for cancellation, Lanham Act section 2(a) has been invoked most frequently to challenge marks that are offensive to particular cultures,<sup>175</sup> or falsely suggest a connection to a Native American tribe.<sup>176</sup> A group's interest in not being disparaged constitutes harm sufficient to establish standing to initiate a cancellation proceeding.<sup>177</sup> "Heeb," a derogatory term for Jewish people, and "Slants," which makes reference to the appearance of Asian people, were both barred from registration because they were considered disparaging towards the respective groups.<sup>178</sup> The mark owners' membership in the respective cultural group did not bear on their disparaging nature.<sup>179</sup>

While the constitutionality of the section 2(a) bar has been called into question because it may be considered a content-based restriction on speech,<sup>180</sup> it is important to bear in mind the rather narrow limitations imposed by cancellation. A successful cancellation proceeding brought under section 2(a) removes the trademark from the register—it does not limit the trademark owner's exclusive right to use the mark.<sup>181</sup> If cancelled, the trademark owner

<sup>174</sup> § 1052(d)-(f).

<sup>175</sup> See MCCARTHY, *supra* note 115, § 19:76 for a more expansive account of section 2(a). § 1052(b); Greene, *Intellectual Property*, *supra* note 20, at 377.

<sup>176</sup> § 1052(b); MCCARTHY, *supra* note 115, § 19:78.50. The Zia pueblo challenged registration of a primate laboratory's mark incorporating the Zia Sun symbol on section 2(a) grounds, arguing it falsely suggests a connection to the tribe, and brings the Zia people into disrepute. Turner, *supra* note 26, at 128.

<sup>177</sup> Dougherty, *supra* note 24, at 380.

<sup>178</sup> *In re Tam*, 108 U.S.P.Q.2d 1305 (T.T.A.B. 2013); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008); MCCARTHY, *supra* note 115, § 19:77.25. Other examples include Koran for wine, Senussi for cigarettes, Madonna for wine. *In re Lebanese Arak Corporation*, 94 U.S.P.Q.2d 1215 (T.T.A.B. 2010); *In re Reemtsma Cigarettenfabriken G.m.b.H.*, 122 U.S.P.Q. 339 (T.T.A.B. 1959); *In re Riverbank Canning Co.*, 95 F.2d 327 (C.C.P.A. 1938); MCCARTHY, *supra* note 115, § 19:77. Marks incorporating racial epithets for African Americans have also been denied registration. Riley & Carpenter, *supra* note 10, at 154. However, the mark "Amish" for cigars passed the section 2(a) bar, because most Amish men smoked, and there was no religious prohibition against smoking. *In re Waughtel*, 138 U.S.P.Q. 594 (T.T.A.B. 1963); Blankenship, *supra* note 33, at 432; *cf.* Dougherty, *supra* note 24, at 380 ("In *In re Condas*, the Patent and Trademark Board determined that a mark may pass the scrutiny of section 2(a) if the potential owner of the mark is a member of the group that is allegedly disparaged." (italics added)).

<sup>179</sup> *In re Tam*, 108 U.S.P.Q.2d 1305 (T.T.A.B. 2013); *In re Heeb Media, LLC*, 89 U.S.P.Q.2d 1071 (T.T.A.B. 2008); MCCARTHY, *supra* note 115, § 19:77.25; *see also* Chalk, *supra* note 19, at 4-5.

<sup>180</sup> *In re Tam*, 785 F.3d 567 (Fed. Cir. 2015).

<sup>181</sup> *Crash Dummy Movie, LLC v. Mattel, Inc.*, 601 F.3d 1387 (Fed. Cir. 2010); *Keebler Co. v. Rovira Biscuit Corp.*, 624 F.2d 366, 370 (1st Cir. 1980) ("[R]egistration does not create the underlying right in a trademark. That right, which accrues from the use of a particular name or symbol, is essentially a common law property right ... and cancellation cannot extinguish a right that federal registration did not confer."); *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 888 (1969) ("[T]he acquisition of the right to exclude others from the use of a trademark results from the fact of use and the common law, independently

will lose the benefits conferred by federal registration, which are a presumption of ownership and validity of the mark, national priority in use, access to statutory damages and import limitations on infringing goods.<sup>182</sup> If the trademark owner continues to use the mark in commerce, he is still entitled to bring claims for infringement and dilution of his mark under common law.<sup>183</sup> Cancellation proceedings brought under certain other statutory bars may additionally abrogate the trademark owner's common law protection. However, abrogation of the trademark owner's common law protection will not ban the trademark from use in commerce in general; rather, it may enable wider third-party use of the mark by dismantling the trademark owner's monopoly.

Absent accompanying infringement litigation, cancellation proceedings will do little to prevent appropriators from using source communities' cultural products as trademarks in commerce, even when the marks disparage or falsely suggest a connection to the source community. However, it may be more difficult for a group to establish standing for an infringement claim: trademark infringement claims require the potential plaintiff to own a valid mark.<sup>184</sup> In order to pursue a trademark infringement claim, source communities must have valid marks—trademarks, collective marks, or certification marks—in the cultural product claimed to be appropriated. While registration is not necessary, as explained in Part II.C, it is helpful insofar as it establishes a presumption of ownership and validity of the mark, and national priority in use.<sup>185</sup>

There are two potential causes of action for trademark infringement: consumer confusion, and dilution of a famous mark. Consumer confusion is commonly deemed the classic cause of action for trademark infringement<sup>186</sup>—Company B uses a trademark that is confusingly similar, either in sight, sound, or meaning, to a trademark owned by Company A, on Company B's products, in such a way that confuses consumers into thinking either Company B's products are made by Company A, or Company A's goods are made by Company B.<sup>187</sup> Trademark dilution, a newer cause of action under trademark

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of registration in the Patent [and Trademark] Office.”); *Hammermill Paper Co. v. Gulf States Paper Corp.*, 337 F.2d 662 (1964) (“[W]e point out that this [opposition] proceeding has nothing to do with divestiture or cancellation of trademarks. We are concerned only with a refusal to register a mark and the cancellation of a registration. Appellant's right to use it is not before us.”); MCCARTHY, *supra* note 115, §§ 20:40, 20:68.

<sup>182</sup> See *supra* note 143 and accompanying text.

<sup>183</sup> *Centaur Communications, Ltd. v. A/S/M Communications, Inc.*, 830 F.2d 1217 (2d Cir. 1987); MCCARTHY, *supra* note 115, § 27:14; *Blankenship*, *supra* note 33, at 446, 450-51.

<sup>184</sup> *E.T. Browne Drug Co. v. Cococare Products, Inc.*, 538 F.3d 185 (3d Cir. 2008); *Donchez v. Coors Brewing Co.*, 392 F.3d 1211 (10th Cir. 2004) (“For an unregistered mark, it is the plaintiff's “burden to demonstrate that it is protectable under § 43(a).”); *Yarmuth-Dion, Inc. v. D'ion Furs, Inc.*, 835 F.2d 990 (2d Cir. 1987); cf. MCCARTHY, *supra* note 115, § 27:13.

<sup>185</sup> See *supra* Part II.C.

<sup>186</sup> *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 154 (1989) (“[T]he States may place limited regulations on the circumstances in which such designs are used in order to prevent consumer confusion as to source.”); MCCARTHY, *supra* note 115, § 23:1.

<sup>187</sup> Lanham Act §§ 32, 43, 15 U.S.C. §§ 1114, 1125(a)(1)(A) (2015); MCCARTHY, *supra* note 115, §§ 23:11.50; 25:26. For the factors used to determine likelihood of consumer confusion,

law,<sup>188</sup> is more expansive insofar as it does not require a likelihood of consumer confusion, and instead requires either “blurring” of the distinctiveness, or “tarnishment” of the mark;<sup>189</sup> however, it is narrower insofar as it can only be raised by owners of “famous marks.”<sup>190</sup> While valid trademarks must just be distinctive and used in commerce, famous marks must be “widely recognized by the general consuming public of the United States as a designation of the source of the goods or services of the mark’s owner.”<sup>191</sup>

In *Navajo Nation v. Urban Outfitters*, a case currently being litigated in the District Court of New Mexico, the Navajo Nation, which holds 86 registered trademarks in names, words, and symbols of the Navajo people, sued Urban Outfitters, a clothing retailer, for trademark infringement due to consumer confusion, dilution by blurring, and dilution by tarnishment.<sup>192</sup> The Navajo Nation claimed that Urban Outfitters’ use of the words “navajo” and “navaho” to name a variety of their products, including clothing, underwear, and flasks, confused consumers as to the source of the goods, diluted the distinctiveness of the Navajo mark, and tarnished the Navajo mark because of the misspelling of Navajo, and the association of the Navajo mark with “scandalous” items such as panties and flasks.<sup>193</sup> While the case has yet to be decided, the District Court has dismissed the Navajo Nation’s claim of tarnishment due to misspelling, and has otherwise denied Urban Outfitters’ motion to dismiss.<sup>194</sup>

If a source community is able to successfully argue that their marks were infringed or diluted, the limits they could impose on appropriators reach much further than those levied by cancellation. A successful infringement action would likely entitle the source community to an injunction, and where appropriate, monetary damages.<sup>195</sup> Through an injunction, a court can order the appropriator to cease using the mark that infringes the source community’s mark on a nationwide basis, or otherwise require the appropriator to take affirmative steps to distinguish its products, so as to indicate their real

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see *id.* § 23:19. For the elements of a prima facie case for trademark infringement under section 43(a), see *id.* § 27:13.

<sup>188</sup> Pub. L. No. 106-43, 113 Stat. 218 (August 5, 1999); MCCARTHY, *supra* note 115, § 20:20.50.

<sup>189</sup> § 1125(c). The theory behind dilution by blurring is that if customers or prospective customers see the famous mark used by persons other than the famous mark owner, to identify other sources for many different goods, then the ability of the famous mark to identify and distinguish only one source will be weakened. MCCARTHY, *supra* note 115, § 24:69. For dilution by blurring factors, see § 1125(c)(2)(B)(i)-(vi) and MCCARTHY, *supra* note 115, § 24:119. Dilution by tarnishment, in contrast, results from an unauthorized use of a famous mark to create negative associations with the mark, and thereby harm the reputation of the mark holder. MCCARTHY, *supra* note 115, § 24:70.

<sup>190</sup> § 1125(c)(1).

<sup>191</sup> § 1125. For the elements of a prima facie case for trademark dilution under section 43(c), see § 1125(c) and MCCARTHY, *supra* note 115, § 24:99.

<sup>192</sup> *Navajo Nation v. Urban Outfitters, Inc.*, 935 F. Supp. 2d 1147, 1153-55 (D. N.M. 2013).

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

<sup>194</sup> *Id.* at 1169.

<sup>195</sup> §§ 1116, 1117; MCCARTHY, *supra* note 115, § 30:1.

source.<sup>196</sup> While monetary damages may sometimes be awarded for successful consumer confusion actions, they are rarely awarded for successful dilution claims.<sup>197</sup> In addition to an injunction, and possibly monetary damages, the courts have discretion to sua sponte cancel the infringing mark's registration.<sup>198</sup>

On balance, it may be easier for source communities to pursue cancellation of appropriator's trademark using their cultural product, because they need not own trademarks to establish standing, and they need not prove confusion or blurring of their marks to effect a cancellation. However, the lack of legal constraints imposed on an appropriator through a successful cancellation proceeding may render it little more than a public "slap on the wrist," because the appropriator may still be entitled to common law protection for her unregistered mark. Even if the cancellation proceedings result in the appropriator losing common law protection, the result would be counterproductive for source communities: the mark would be available for broader use by third parties.

If source communities simply want to publicize the scandalousness of the appropriator's mark, or publicly disclaim a connection to the appropriator, cancellation is certainly the easier way to do so. But if source communities seek to prevent non-community members from appropriating and using their cultural products, pursuing an infringement action, which can lead to an injunction, would be more appropriate. That said, infringement actions impose a higher burden on source communities: not only must they have a trademark to be infringed, they must prove that consumers are likely to be confused about source, sponsorship, or affiliation. If source communities are able to either register or otherwise successfully argue that they hold a trademark in their cultural product, pursuing simultaneous infringement and cancellation actions would avail them of all of the mechanisms provided by trademark law to encumber cultural appropriation.

### III. THE LIMITATIONS OF TRADEMARK LAW PROTECTION

#### A. *Efficacy of Trademark Law to Resist Cultural Appropriation*

A successful trademark infringement suit may be a boon to a source community seeking to prevent outsiders' use of their cultural products. However, the limits built in to trademark law circumscribe the conditions under which a source community can avail itself of trademark protection, and the potential expansiveness of that protection.

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<sup>196</sup> MCCARTHY, *supra* note 115, §§ 24:132, 30:5. For criteria for a preliminary injunction see *id.* § 30:31. See also Pub. L. No. 106-43, 113 Stat. 218 (Aug. 5, 1999); B. H. Bunn Co. v. AAA Replacement Parts Co., 451 F.2d 1254 (5th Cir. 1971); Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938).

<sup>197</sup> § 1117(a); MCCARTHY, *supra* note 115, §§ 24:132, 30:57, 30:59, 30:61-64, 30:74, 30:89, 30:100.

<sup>198</sup> § 1119; Empresa Cubana del Tabaco v. Culbro Corp., 541 F.3d 476 (2d Cir. 2008); MCCARTHY, *supra* note 115, § 30:109.

The first challenge source communities will encounter is establishing ownership of a valid trademark. While ownership of a valid trademark is not necessary to pursue cancellation of an appropriator's trademark, it is necessary for the source community to accrue the benefits of registration, and even if unregistered, to pursue an infringement action against an appropriator.<sup>199</sup> Many cultural products, however, may not qualify as valid trademarks because they may fail to meet either the use in commerce or distinctiveness requirements.

Though non-profit and charitable organizations' marks may qualify as "used in commerce" despite a lack of sales, and collective mark and certification mark owners need not (or per se cannot) use their marks to sell goods or services, all of their marks must be used in some interstate commercial activity to receive trademark protection.<sup>200</sup> For non-profits and charities this may be fundraising,<sup>201</sup> and for collective marks and certification marks it may be the use of the mark in the course of a sale by members of the collective,<sup>202</sup> or certified producers. A source community's words, names, symbols, and other cultural products that are religious, historic, or otherwise unrelated to any kind of commerce, may not be eligible for trademark protection because they fail to meet the "use in commerce" requirement.<sup>203</sup>

A source community's cultural product may also fail to meet the "distinctiveness" requirement to serve as a valid trademark. Just as Urban Outfitters challenged the Navajo Nation's trademark of "navajo" as descriptive,<sup>204</sup> in the minds of consumers, many cultural products may not call to mind a single source, especially given the transfer of cultural products across cultures throughout history.<sup>205</sup> For instance, while the term "Blues" for music may meet the use in commerce requirement, because the performance and sale of blues music involves transactions, "Blues" does not identify a single source or distinguish one producer's song from that of another; it is the generic term for that style of music.

If a source community's cultural product meets the use in commerce and distinctiveness requirements for validity as a trademark, it can raise infringement claims against appropriator's uses of its cultural product, but it may nevertheless be unable to raise dilution claims if it has not achieved a

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<sup>199</sup> See *supra* notes 115-119 and accompanying text.

<sup>200</sup> *Id.*

<sup>201</sup> *American Diabetes Ass'n, Inc. v. National Diabetes Ass'n*, 533 F. Supp. 16, 21 (E.D. Pa. 1981), *aff'd*, 681 F.2d 804 (3d Cir. 1982) ("Plaintiffs may also suffer the loss of potential donations . . ."); *Purcell v. Summers*, 145 F.2d 979, 985 (C.C.A. 4th Cir. 1944); MCCARTHY, *supra* note 115, § 9:5.

<sup>202</sup> Collective membership marks do not require collective members to use the mark in the course of sales in order to be registrable. However, these marks are not protected as trademarks—to identify the source of a good or service—unless they can additionally serve as valid trademarks. See *supra* notes 158-159 and accompanying text.

<sup>203</sup> Audet, *supra* note 24, at 12; see, e.g., Turner, *supra* note 26, at 125 ("These requirements present problems for indigenous groups, including the Zia, who do not constitute commercial entities and who do not use their symbols for commercial purposes.").

<sup>204</sup> *Navajo Nation v. Urban Outfitters, Inc.*, 935 F. Supp. 2d 1147 (D. N.M. 2013).

<sup>205</sup> See *supra* notes 51-54 and accompanying text.

certain level of recognition. In general, relatively few trademarks have achieved enough nationwide recognition to be considered “famous,” and it may be even more difficult for source communities to meet that threshold. For source communities that seek to limit outsiders’ access to their cultural property, it will be difficult to show sufficient “duration, extent, and geographic reach” of advertising and publicity of the mark, and sales of goods or services offered under the mark, let alone to show actual recognition of the mark.<sup>206</sup> For source communities with diffuse membership who use the cultural product, it will be particularly difficult to show “substantially exclusive use” of the mark.”<sup>207</sup>

Even if a source community is able to establish its ownership of a valid trademark, registration or unregistered trademark ownership does not confer to the owner an exhaustive exclusive right to use the mark.<sup>208</sup> First, the infringement and dilution analyses allow for concurrent uses (and even registrations) of the same mark where consumers are unlikely to make a mistake as to source or affiliation of a product.<sup>209</sup> Second, non-trademark uses of a protected mark are generally permissible if they do not cause a likelihood of confusion.

In order for a source community to successfully argue that an appropriator’s use of its cultural product constitutes trademark infringement, the source community must establish that there is a “likelihood of confusion” between the appropriator’s use of the cultural product and the source community’s use.<sup>210</sup> Even if the marks are identical (i.e., Delta for an airline and Delta for a sink faucet), if consumers are unlikely to think that both goods come from a single source, or the appropriator’s goods come from the source community, or vice versa, there is no trademark infringement.<sup>211</sup> The Navajo Nation, which uses its distinctive cultural products in commerce to signal the source of its goods, may not be able to prevent producers of unrelated goods, such as Mazda, from using the community’s cultural product as a trademark, because consumers are unlikely to mistakenly think that the Navajo Nation made the Mazda Navajo automobile, or that Mazda made the Navajo Nation’s goods, or that the car and the Navajo Nation’s goods come from a single

<sup>206</sup> Lanham Act § 43, 15 U.S.C. § 1125(c)(2)(A)(i)-(iii) (2015).

<sup>207</sup> *Id.* § 1125(c)(2)(B)(iii).

<sup>208</sup> Audet, *supra* note 24, at 12 (“[E]ven once someone registers a trademark, that mark can still be used by others, albeit in a limited way, thus not precluding outsiders’ use of the mark.”).

<sup>209</sup> Lanham Act § 2(d), 15 U.S.C. § 1052(d): “[I]f . . . confusion, mistake, or deception is not likely to result from the continued use by more than one person of the same or similar marks under conditions and limitations as to the mode or place of use of the marks or the goods on or in connection with which such marks are used, concurrent registrations may be issued to such persons when they have become entitled to use such marks as a result of their concurrent lawful use in commerce . . . . Concurrent registrations may also be issued . . . when a court of competent jurisdiction has finally determined that more than one person is entitled to use the same or similar marks in commerce.” *Id.*

<sup>210</sup> *See supra* notes 186-187 and accompanying text.

<sup>211</sup> MCCARTHY, *supra* note 115, § 24:11.

source.<sup>212</sup> Similarly, in order for an appropriator's use of a mark to dilute a source community's famous mark, the appropriator's use must cause consumers to "associate" it with the source community's famous, even if the two marks are identical.<sup>213</sup>

Additionally, third parties are entitled to make non-trademark use of a protected mark, such that their use does not give rise to a likelihood of confusion. Non-trademark uses are by their nature unlikely to cause a likelihood of confusion, because they are not being used by a third party to indicate the source of the third party's goods.<sup>214</sup> Moreover, third parties' interest in freedom of speech weighs heavily against allowing trademark owners to enjoin non-trademark uses.<sup>215</sup>

Non-trademark uses include expressive uses, such as entertainment, parody, and commentary, as well as comparative advertising, nominative fair use, and descriptive fair use.<sup>216</sup> Permissible expressive uses of a trademark can take on many forms: a scathing review of a product made by a certain producer that names the product and producer and includes the image of the product and its logo; a parodic reference to a popular children's toy in a song; a painting in which an artist depicts a trademark-protected image or symbols.<sup>217</sup> Comparative advertising allows a third party to name its competitor in the course of advertising its own product (i.e., "Same active ingredient as Advil."), and nominative fair use allows competitors and non-competitors alike to refer to a company's trademark when talking about its product (i.e., "We sell Serta mattresses.").<sup>218</sup> Descriptive fair use allows competitors to continue to use a descriptive mark in its descriptive sense after it has acquired secondary meaning<sup>219</sup>—as Urban Outfitters would argue, even if the term "navajo" has acquired secondary meaning, the fashion retailer's use of it is to merely describe the "Native American" look of their product, not to indicate source.<sup>220</sup>

Though source communities may own and register valid trademarks, they may find themselves unable to leverage their trademarks to prevent a vast many appropriated uses of their mark, whether in commerce or in expressive works.

<sup>212</sup> Cf. Navajo Nation Sues Urban Outfitters Over Trademark, NPR (Apr. 5, 2012), <http://www.npr.org/2012/04/05/150062611/navajo-nation-sues-urban-outfitters-over-trademark>. Mazda obtained the Navajo Nation's consent to use the name Navajo as the model for its vehicles. *Id.*

<sup>213</sup> § 1125(c)(2)(B)(v)-(vi).

<sup>214</sup> MCCARTHY, *supra* note 115, § 23:11.50.

<sup>215</sup> *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989).

<sup>216</sup> MCCARTHY, *supra* note 115, §§ 10:22, 11:45, 31:139.

<sup>217</sup> Expressive uses must meet the higher standard established by the *Rogers* test to be prohibited as trademark infringement: there must be "no artistic relevance" of including the trademark to the underlying work, or if there is artistic relevance, use of the mark in the work must "explicitly mislead[] as to the source or the content of the work." 875 F.2d at 1001; see *E.S.S. Entertainment 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1100 (9th Cir. 2008).

<sup>218</sup> MCCARTHY, *supra* note 115, §§ 31:139, 11:45.

<sup>219</sup> *Id.* § 11:45.

<sup>220</sup> *Navajo Nation v. Urban Outfitters, Inc.*, 935 F. Supp. 2d 1147 (D. N.M. 2013).

To be able to enjoin an appropriator's use of a cultural product using trademark law—the goal of source communities seeking to restrict cultural appropriation—the source community must initiate an infringement action. Even if the Zia people owned a trademark in the Zia Sun symbol, they likely would not succeed on an infringement case against a plumber from using the symbol in his logo, because it would not cause a likelihood of confusion, and almost definitely would not succeed against a non-Zia artist from incorporating the Zia Sun into her painting, because her artwork is protected as free speech. Successful trademark infringement suits will likely be limited to instances in which the appropriator uses the source community's mark to compete with the source community in the market, or to sell goods or services in a close enough market to cause a likelihood of confusion. While cancellation of appropriators' marks may be easier for source communities to pursue than infringement actions, it does not prevent appropriators from continuing to use their marks,<sup>221</sup> and it does not give the source communities any trademark rights in the appropriated cultural product. Actually, a successful cancellation proceeding may prevent a source community member from being able to register her mark.<sup>222</sup>

Considering all of the limits built in to trademark protection, trademark is not a particularly effective source of law for source communities to leverage in their attempt to combat cultural appropriation. A successful trademark infringement or dilution suit—which could enable a source community to permanently enjoin an appropriator's use of their cultural product—while potent, will be especially difficult for source communities to achieve. Many intangible cultural products would likely not qualify as valid trademarks, because of the nature of the product, or the source community, or both. A source community's religious symbol, character from oral tradition, name of a deity, ceremonial song will in many cases fail to satisfy the “use in commerce” requirement because the source community deliberately withholds these products from commerce to preserve their religious, historic, or cultural value.<sup>223</sup> Even those cultural products a source community uses in commerce—such as a ceremonial dance, a style of music, a design of an object, a pattern of a tapestry—may fail to satisfy the “distinctiveness” requirement, because the diffuseness of the source community (e.g., the Jewish diaspora), or previous intercultural exchange disables the product from being able to identify a single source.

Those cultural products that do qualify as valid trademarks, such as the Navajo Nation's name “navajo” in connection with the various apparel and crafts it sells, do not entitle their source community to exclude third-party uses where there is no likelihood of confusion as to source or association. If an appropriator takes a source community's cultural product, and uses it on a good or service that does not relate to any good or service provided by the source

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<sup>221</sup> See *supra* Part II.D.

<sup>222</sup> See *supra* note 179 and accompanying text.

<sup>223</sup> See *supra* note 36 and accompanying text.



community, the source community will likely not be able to enjoin the appropriator's use. If an appropriator uses a source community's cultural product in an expressive work, such as a novel, a painting, or a television show—even if it is used to mock or disparage the community, the source community will likely not be able to enjoin the appropriator's use. If an appropriator uses a source community's cultural product to describe its own product (i.e., Cherokee-style necklace), the source community will likely not be able to enjoin the appropriator's use. However, in those situations where there may be a likelihood of confusion (even absent direct competition), such as Urban Outfitters' sale of "Navajo panties," when the Navajo Nation sells apparel but not underwear,<sup>224</sup> source communities seeking to prevent cultural appropriation may find it beneficial to sue for trademark infringement, because they may be able to enjoin the appropriator's use.

B. *Benefits and Harms of Using Trademark Law for Source Communities and Society*

Given the difficulties source communities will likely face in meeting the requirements for trademark protection, and the narrow scope of appropriators' activity to which protection extends, source communities may find that utilizing trademark law to deter cultural appropriation is more harmful to the source community than the appropriator. Cancellation proceedings and infringement actions, while of limited help, impose requirements on source communities that are likely adverse to their interests.

First, source communities have come to view cancellation proceedings under Lanham Act section 2(a) as a tool to prevent individuals and organizations, who appropriate stereotypes or cultural symbols from source communities, from using marks that disparage or falsely suggest a connection to the source community.<sup>225</sup> In practice, however, cancellation proceedings do not prevent appropriators from using disparaging or falsely-connecting marks in commerce: removal from the register merely relegates the mark to common law protection, which requires that the mark owner prove validity and ownership of the mark (unlike registration, which provides a presumption of validity and ownership), and limits some remedies available (registration allows for statutory damages and import control) when the mark owner pursues an infringement action against a third party.<sup>226</sup> In theory, these additional hurdles, and the potential public shame that accrues from being deemed "disparaging," may influence (though in no way legally require) appropriators to abandon their use of those marks. However, source communities may find that pursuing cancellation proceedings under section 2(a) has a negative collateral effect on the source community—when a mark is deemed "disparaging," the mark owner's membership or non-membership in the source

<sup>224</sup> *Navajo Nation v. Urban Outfitters, Inc.*, 935 F. Supp. 2d 1147 (D. N.M. 2013).

<sup>225</sup> *See supra* Part II.D.

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

community is of no consequence,<sup>227</sup> and so a source community member will not be able to “re-appropriate” and register that mark later.

Second, source communities may view infringement actions as a way to redress the economic harms and loss of control cause by cultural appropriation. In certain limited circumstances—where source communities use their distinctive cultural product in commerce, and the appropriator uses the cultural product in a way that confuses consumers as to the source of the appropriator or source community’s product—trademark infringement actions enable source communities to regain control (via injunction) over outside uses of their cultural products, and may entitle them to monetary damages.<sup>228</sup> An injunction would benefit source communities that seek to regain control, or seek monetary compensation: the source community may entirely withhold the mark from use by that infringer, or require the infringer to pay license fees. Despite the attractiveness of this possible, albeit limited, recourse for source communities, the requirements source communities will have to meet in order to have access to this form of legal redress may undermine the source community’s use of its own cultural products.

While registration as a collective or certification mark enables group ownership of the mark—thus preserving group ownership of the cultural product, and does not require the mark owner to use the mark in commerce, it requires the mark owner to exert control over who or what can bear the mark, and group members to use the mark in commerce.<sup>229</sup> The control requirement casts light on the shortcomings of fitting cultural products into property law pointed out by scholars: requiring source communities to define who constitutes an authentic community member, and to limit how community members can use their cultural products “freezes” the community at that moment those boundaries are cast, and disables it from the growth and adaptation necessary to perpetuate a culture.<sup>230</sup> The requirement that members use the cultural product in commerce may be similarly counter-effective: for source communities that seek to preserve the exclusively non-commercial use of a cultural product, such as a religious, historical, or ritualistic use, subjecting the product to any kind of use in commerce could eviscerate the traditional meaning of the cultural product by monetizing it.<sup>231</sup>

In addition to the potential blowback for source communities, using trademark law to police cultural appropriation may have negative consequences for a multi-cultural society. Source community ownership of trademarks in its name, symbols, images, and other cultural products, coupled with the boundaries the community must cast around “rightful users” to preserve ownership and validity of its marks, may prevent other source communities with the same or highly similar cultural products (e.g., two tribes that use the

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<sup>227</sup> See *supra* note 179 and accompanying text.

<sup>228</sup> See *supra* notes 195-197 and accompanying text.

<sup>229</sup> See *supra* notes 152-167 and accompanying text.

<sup>230</sup> See *supra* notes 81-84 and accompanying text.

<sup>231</sup> See *supra* note 36 and accompanying text.

same symbol to represent their religion), from using their products in a way that would infringe the mark owner's trademark.<sup>232</sup> Source community ownership of trademarks in its cultural products would constrain the intercultural exchange of cultural products to a licensing system, which would encumber the merger and blending of cultures that naturally occurs in interactive, multicultural societies.<sup>233</sup> Moreover, trademark ownership held by source communities in their cultural products may disenfranchise individuals who are simultaneously members of a source community and an outside culture from repurposing or reinventing a cultural product, either because of the controls imposed by source communities to maintain ownership over their trademarks, or the risk of being subject to an injunction and monetary damages.

*C. Propriety of Trademark Law to Deter Cultural Appropriation*

Considering the incongruence of trademark law with the needs and characteristics of source communities, it is unsurprising that restricting cultural appropriation is incompatible with the core purposes of trademark law: avoiding consumer confusion, and preventing appropriation of a producer's good will. Restricting cultural appropriation through trademark law would likely not result in a more competitive market, and would likely adversely affect free speech in the market.

Unlike trademarks, cultural products are not meant to serve as a shorthand indicator of source and quality. They are meant to serve some traditional function within the source community, not to inform consumers of a good or service that the product they are consuming comes from the source community. Cultural products are not valuable because of their ability to convey information to a consumer; they are valuable because their preservation helps perpetuate the culture.<sup>234</sup> Protection of cultural products as trademarks does not serve the purpose of reducing consumer search costs.

Similarly, protecting cultural products as trademarks does not serve the purpose of protecting producers from illegitimate diversions of trade. Insofar as source communities are not trading on their cultural products, and seek to entirely foreclose the trade of their cultural products, appropriation of source communities' cultural products does not deprive them of potential sales.<sup>235</sup> The "Unfair Competition" school, which views trademark protection as a property right in the mark itself, may appear to conform more closely to the source community's relation to its cultural product. However, the property right trademark law protects is not the mark's form, but the good will it represents.<sup>236</sup> Source communities do not value their cultural products because of the

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<sup>232</sup> See *supra* note 83 and accompanying text.

<sup>233</sup> See *supra* notes 51-54 and accompanying text.

<sup>234</sup> Compare notes 97-103 and accompanying text with notes 40-42 and accompanying text.

<sup>235</sup> Compare notes 104-107 and accompanying text with notes 40-42 and accompanying text.

<sup>236</sup> See *supra* note 106 and accompanying text.

reputation or business value they embody; they value their cultural products because they are integral to the practice and perpetuation of their culture.<sup>237</sup>

Moreover, resisting cultural appropriation through trademark law would not foster a more competitive market, and would impose a limit on free speech. Entirely removing a word, image, symbol, or other cultural product from the market, or requiring third parties to pay license fees to be able to use it, does not help producers differentiate themselves, or otherwise incentivize competition in any discernable way. Instead, using trademark law to resist cultural appropriation would limit individuals' and organizations' abilities to use a cultural product as a mark in a way that reduces consumers' search costs or embodies a business's good will.

#### CONCLUSION

Trademark law, with its potential for perpetual protection against unauthorized third-party uses of a mark, may be enticing to source communities seeking to prevent appropriation of their cultural products. However, the requirements and limitations built in to trademark law make it particularly difficult for source communities, given their specific characteristics, to protect their cultural products through this body of law. Moreover, even successful cancellation proceedings or infringement suits against appropriators impose requirements and limitations on source communities that may be abhorrent to their culture and its norms. Accordingly, source communities will likely find that trademark law is largely ineffective for, or even counterproductive to, the deterrence of cultural appropriation. Likewise, given the core purposes of trademark law, courts should find that deterrence of cultural appropriation is outside the provenance of trademark law.

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<sup>237</sup> Compare notes 102-103 and accompanying text with notes 40-42 and accompanying text.