

UNITED STATES OF AMERICA
DEPARTMENT OF COMMERCE

Patent and Trademark Office)	
)	
)	
)	64 FR 13004
)	March 16, 1999
Notice of Inquiry on a Statutorily)	
Required Study Regarding Official)	
Insignia of Native American Tribes)	

COMMENTS OF MOHAWK CARPET CORPORATION

Mohawk Carpet Corporation (“Mohawk”)¹ welcomes the opportunity to respond to the Patent and Trademark Office’s (“PTO”) notice seeking comments on the specific areas of inquiry included in Public Law 105-330 surrounding trademark protection for the official insignia of federally and/or state recognized Native American Tribes. Request for Comments, 64 Fed. Reg. 13004 (1999).

Mohawk encourages the PTO to focus on the narrow purpose for which Congress commissioned the study: to determine the impact on all parties concerned of prohibiting federal registration of trademarks identical to the official insignia of Native American Tribes. Pub. L. No. 105-330, § 302

(1998). Loosely drafted regulations which could be misconstrued to prohibit registration of marks which are not identical to the official insignia of officially recognized Native American Tribes could place at risk many famous and valuable trademarks upon which the consuming public relies to avoid confusion in the marketplace.

¹ Mohawk Carpet Corporation, one of the world's leading manufacturers of carpet, is based in Calhoun, Georgia.

Responses to Specific Questions:

1. The Definition of “Official Insignia.”

The definition of the term “insignia” is crucial to determining, and limiting, the scope of any change in law or policy regarding trademark registration of the official insignia of Native American Tribes. Without a clear, accepted definition of “insignia,” interested parties and the PTO will be unable to accurately assess the impact of proposed legislation or regulations in this area; the lack of an express definition of the word “insignia” would leave the scope of any proposed change dangerously unclear.

WEBSTER’S THIRD NEW INTERNATIONAL DICTIONARY (UNABRIDGED)

1169 (1993) defines the term as follows:

insignia 1. a distinguishing mark of authority, office, or honor: badge, emblem <the insignia of royalty><a collector of insignias>; 2. a typical and characteristic mark or sign by which something is distinguished <the gay insigne of the new fighter squadron><sports letters were originally insignia granted for especial competence in a competitive sport>

As the above definition stresses, the “official insignia” of Native American Tribes are limited to official emblems and badges which uniquely identify the respective Tribes.

“Insignia” does not, and should not, include the mere names of the respective Tribes absent a badge or emblem which uniquely identifies them. The names of the various Tribes standing alone, such as “Apache,” “Cherokee,” “Mohawk,” or “Navajo” to name a few examples, without the addition of an emblem, badge or coat of arms, do not serve as “insignia” due to the fact that they do not uniquely distinguish and identify those Tribes. At least one court has held that the term “Mohawk” alone does not uniquely identify the Mohawk Indian Tribe, but rather identifies a number of goods and services unassociated with the Tribe, such as the U.S. Army’s “Mohawk 298” aircraft. See *In re Mohawk Services Inc.*, 196 U.S.P.Q. 851 (T.T.A.B. 1977). Likewise, “Apache” identifies a widely-acclaimed helicopter owned by the U.S. Army, “Cherokee” identifies a very popular line of sport-utility vehicles manufactured and sold by DaimlerChrysler, “Mohawk” identifies a popular line of carpet manufactured by Mohawk Carpet Corporation, and “Navajo” identifies a sport utility vehicle sold by Mazda Motor Corporation. The terms “Apache,” “Cherokee,” “Mohawk,” “Navajo,” and other names of Native American Tribes standing alone, simply do not serve as insignia uniquely distinguishing and identifying the respective Tribes and therefore should not be included within the scope of any proposed changes regarding the “official insignia of Native American Tribes.”

3. Impact of Changes in Current Law or Policy.

In the enabling legislation for this study, Congress specifically required that the PTO address the impact of any proposed changes in law or policy upon the interests of current trademark owners. See Pub. L. No. 105-330, § 302. As noted above, many companies and other entities have developed valuable trademark rights in terms such as “Apache” and “Cherokee” and “Mohawk.” In the eyes of millions, if not billions, of consumers, these terms identify popular products and services. Any change in current law or policy regarding the registration or use of marks related to the official insignia of Native American Tribes must be carefully drafted to avoid impinging the extremely valuable rights developed by trademark owners in marks which incorporate a term which also happens to serve as the name of, or a portion of the name of, a Native American Tribe.

A change in trademark policy which restricts the valuable rights of trademark owners would also cause considerable confusion among consumers who have come to associate a trademark as identifying the source of goods or services. For example, in the unthinkable scenario that DaimlerChrysler were disallowed from future use of its popular “CHEROKEE®” mark to identify its line of sport-utility vehicles, consumers would continue to request products identified by the mark but

would be unable to purchase them. Instead, DaimlerChrysler would be forced to expend millions of dollars in advertising to develop consumer recognition in a new product name to identify the products previously identified by the “CHEROKEE®” mark.

4. Impact of Prohibition on Federal Registration and New Uses of Official Insignia.

Restricting trademark owners from registering new marks which incorporate a term which also serves as the name, or a portion of the name, of a Native American Indian Tribe would unfairly deprive individuals and companies of the ability to expand upon their current trademarks and house marks. For example, prohibition of federal registration of new “CHEROKEE” marks would deprive DaimlerChrysler of the opportunity to build upon the valuable, recognized name of its sport-utility line with new versions of the “CHEROKEE” mark.

Trademark rights, as opposed to copyrights or the rights to a patent, are developed through actual use in the marketplace. Trademark owners develop consumer recognition in their marks by utilizing the marks in commerce, investing in advertising and marketing promotions and policing infringing uses of their marks by others. As a result, the development of trademark rights requires the substantial and continuous investment of

resources. Prohibiting trademark owners such as DaimlerChrysler or Mohawk from developing new marks based on existing registrations would severely devalue the substantial investments trademark owners have made in their trademarks, investments made on the assumption that Congress and the PTO would not suddenly and unexpectedly take their hard-earned trademarks rights away.

6. Timing of Changes in Protection.

It is Mohawk's position, as described in detail in response to the next question, that no change in the trademark laws or regulations is required to protect the rights of Native American Tribes in their official insignia. However, if changes were to be made, prospectively-applied changes would be less damaging than the staggering impact of retroactively-applied restrictions on existing trademark registrations and applications.

7. Statutory Changes.

According to Bruce MacPherson of the International Trademark Association ("INTA"), INTA is opposed to any change in current trademark laws or regulations for the purpose of providing extended protection for the official insignia of Native American Tribes. Mohawk agrees with the position taken by INTA and encourages the PTO to heed the counsel of this widely-respected organization.

Current trademark law provides Native American Tribes with sufficient protection for their official insignia. Section 2(a) of the Lanham Act, 15 U.S.C. 1052 (a), prohibits registration of marks which contain deceptive or scandalous matter, or which disparage or falsely suggest a connection with persons or organizations:

SEC. 2 No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it—

(a) Consists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons, living or dead, institutions, beliefs, or national symbols, or bring them into contempt, or disrepute; or a geographical indication which, when used on or in connection with wines or spirits, identifies a place other than the origin of the goods and is first used on or in connection with wines or spirits by the applicant on or after one year after the date on which the WTO agreement (as defined in Section 2(9) of the Uruguay Round Agreements Act) enters into force with respect to the United States.

As recently evidenced by the decision of the Trademark Trial and Appeal Board canceling the Washington Redskins' trademark registration based on the TTAB's finding that the mark is disparaging to Native Americans, *Harjo v. Pro Football Inc.*, TTAB, Canc. No. 21, 069 (April 2, 1999), Section 2 (a) provides groups such as the Native American Tribes with sufficient and fair protection against the registration of a Tribe's official insignia by another entity to identify goods or services unassociated with, or which could be disparaging to, the Tribe. Current law draws the appropriate balance by

prohibiting registration of a mark which points uniquely to a Native American Tribe, such as the Tribe's official insignia (the badge or emblem of the Tribe), without unnecessarily threatening the rights of trademark owners.

Expanding protection for the official insignia of Native American Tribes beyond the significant protection already provided by Section 2 (a) of the Trademark Act would result in substantial, unjust damage to the rights of trademark owners and would cause damaging confusion among consumers in the marketplace.

Respectfully submitted,

Michael D. Hobbs, Jr.
TROUTMAN SANDERS LLP

Attorneys for Mohawk Carpet Corporation

Dated: April 28, 1999