


**May 2021**

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The May 2021 issue of Sterne Kessler's Markt to Market® newsletter discusses the USPTO's new Native American Tribal Insignia Database and two recent trademark litigation cases involving cannabis companies and candy products.

[Monica Riva Talley](#) was recently profiled by *JD Supra* in the article "'Need to Know' From My Clients' Perspective — Q&A With Top Thought Leader Monica Riva Talley." The article is the latest in *JD Supra's* series of discussions on successful thought leadership with recipients of their "Readers' Choice" awards. Read more [here!](#)

Sterne Kessler's [Trademark & Brand Protection practice](#) is designed to help meet the intellectual property needs of companies interested in developing and maintaining strong brands around the world. For more information, please contact [Monica Riva Talley](#) or [Tracy-Gene G. Durkin](#).

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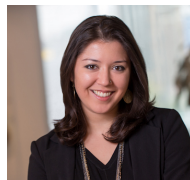


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## RECOGNIZING TRIBAL MARKS: THE NATIVE AMERICAN TRIBAL INSIGNIA DATABASE

By: Sahar A. Ahmed

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## **WATCHING THE POT™**

### **Revenge for Infringing Candy Trademarks? So Sweet.**

By: [Monica Riva Talley](#).

Two recent court decisions highlight that there may still be a bit of a disconnect when it comes to branding cannabis products. In other words, even if your product is cutting edge, and perhaps not yet federally legal, that doesn't mean it is immune from a good-old fashioned trademark infringement claim.

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## **RECOGNIZING TRIBAL MARKS: THE NATIVE AMERICAN TRIBAL INSIGNIA DATABASE**

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Using Native American tribal names and symbols as part of popular consumer brands has been an endemic practice within the United States for decades. Popular brands that have appropriated tribal names include Jeep Cherokee, Pontiac cars, Apache Software, and Urban Outfitters' Navajo and Zuni clothing lines, just to name a few. Native Americans have combatted some of these uses in court, and are now actively engaged in filing for trademark protection for many tribal names and symbols. Now, at no cost, Native American tribes have a new way of protecting their intellectual property and cultural heritage.

### **The Native American Tribal Insignia Database**

The United States Patent and Trademark Office (USPTO) recently announced that it would begin including Native American tribal insignias as part of its searchable Trademark Electronic Search System (TESS). The new Native American Tribal Insignia Database records the official tribal insignias of federally or state-recognized American Indian and Alaska Native tribes (Native American tribes) at no charge, which will allow the USPTO to consider tribal insignias during its examination of other pending trademark applications, and refuse registration of the pending marks if they falsely suggest a connection to the participating Native American tribes.

The creation of the Database evidences an appreciation by the USPTO of Native American tribal history, culture, and heritage as represented by their tribal insignias. The Database also serves to acknowledge the desire of Native American tribes to not only protect their culture associated with their tribal insignias, but also to prevent against infringing and potentially tarnishing uses of their marks.

### **Acceptable Database Insignias**

Native American tribes may elect to participate in the Database to take advantage of its protective benefits, but are not required to do so. There are no fees or forms required for participation; however, the USPTO notes that to be accepted as part of the Database, the tribal insignias must be adopted by tribal resolution within a federally or state recognized tribe, and consist of a flag, coat of arms, other emblem, or device. Words alone are not considered a tribal insignia, and will not be entered into the Database.



## **Insignia Request Procedure**

To participate in the Database, tribes may simply send an email to the USPTO that includes a written request to enter an insignia, a JPG image of the insignia, a copy of the official tribal resolution adopting the insignia, and an authorization statement signed by an official with authority to bind the tribe. Each request is assigned a “non-registration” serial number, and is then entered into the Database. Tribes may access the submitted insignias by entering the non-registration number in the Trademark Status and Document Retrieval (TSDR) system, or in the Trademark Electronic Search System (TESS). Members of the public not affiliated with the requestor tribe may access the accepted insignias through TESS by entering the following search term (including quotation marks): “*Native American Tribal Insignia*”[od].

## **The Rights of Tribes and Registrants**

The Native American Tribal Insignia Database is a beneficial, front-end means of preventing trademark applicants from securing registrations for marks that are confusingly similar to participating tribal insignias. However, the new Database does not automatically grant any property rights in those insignias to the tribe. Entry on the Database is not the legal equivalent of registering a tribal insignia as a trademark. Additionally, entry on the Database does not retroactively alter the rights of pre-existing registrants with marks already on the Principal Register.

If a tribe believes that it will be damaged as a result of a pending application, it may follow the traditional means of protecting its insignias, names, and symbols by filing a Letter of Protest with the USPTO, and possibly filing its own application. Likewise, a tribe may contest a mark published or registered on the Principal Register by filing a notice of opposition with the Trademark Trial and Appeal Board (TTAB), or file a petition for cancellation of a registration with the TTAB.

## **Conclusion**

The USPTO’s introduction of the Native American Tribal Insignia Database demonstrates the Office’s appreciation for the culture and heritage of federally or state-recognized Native American tribes. It provides a new affordable means for tribes to protect their insignias by preventing new applicants from securing registrations on confusingly similar or infringing marks. While the Database does not alter the rights of holders of preexisting registrations, the Database presents a new hurdle to trademark applicants wishing to popularize their brands by appropriating Native American references.

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Los Angeles cannabis delivery company Tops Cannabis learned this lesson the hard way when it was found to have violated both the Lanham Act and California's Business and Professions Code by marketing, selling, distributing, and advertising a product called "Medicated Nerds Rope." In a suit brought in the U.S. District Court for the Central District of California, plaintiff Ferrara Candy Co. alleged that "there have been multiple reports of children being rushed to emergency rooms" after eating Medicated Nerds Rope they mistook for regular Nerds Rope. The suit was resolved earlier this month via a consent judgement that included a permanent injunction against Tops Cannabis, and a disgorgement of profits.

Similarly, cannabis company Terphogz LLC was sued earlier this month in the U.S. District Court for the Northern District of Illinois by candy and gum giant the Wm. Wrigley Jr. Co. The suit alleges that Terphogz's "Zkittlez" name and marketing strategy infringe Wrigley's SKITTLES trademark and "Taste the rainbow" ad campaign. Wrigley said in a statement that it "commenced this action to protect the public from Terphogz's deceptive and dangerous business practices and to safeguard the goodwill and reputation of Wrigley's renowned Skittles marks." While the Terphogz website does not currently offer cannabis for sale, social media posts suggest it will soon offer hemp buds and pre-rolled joints. The complaint includes images of shirts for sale that bear the Zkittlez name and the hashtag "TazetheZtrainBro," as well as stash jars for storing marijuana emblazoned with the Zkittlez name.

These recent lawsuits illustrate how cannabis brands are moving into the mainstream – both in terms of reach and responsibility. More importantly, they send the message that candy companies do not get the joke when it comes to riffing on the consumer trust and goodwill associated with their brand names.

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