

TM Law Obstacles To Challenging Cultural Appropriation

By **Dariush Adli** (September 9, 2019)

Recently, Kim Kardashian made headlines with the announcement of her application to the U.S. Patent and Trademark Office to register “Kimono” as a trademark for identifying her new line of “shapewear.” Following a wave of controversy and criticism, primarily from the Japanese community in Japan and the U.S., but also from others, she abandoned her effort.[1]



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Although the immediate controversy has subsided, Kardashian’s truncated “Kimono” effort has refocused attention and renewed debate on cultural appropriation and its relationship to trademark law. This article discusses potential use of trademark laws to facilitate appropriation of names, symbols, objects, features and attributes that can be considered to be representative of an identifiable tradition or culture.

The term “cultural appropriation” is generally understood to refer to use of a cultural indicium, otherwise generally recognized for being associated with a particular tradition or culture, as an identifying mark for commercial goods or services by nonmembers of the cultural group. The definition of cultural indicium is broad and can even include a nickname or an informal reference, even one created by the public.[2] For example, the USPTO has found that “Lakota” qualifies as a cultural indicium.[3]

A well-publicized and long-running controversy involving allegations of cultural appropriation concerns the Washington Redskins football team, which has used “Redskins” as a trademark for over seven decades. Native American groups spent decades trying to push back on the team’s use of the mark. Finally, in 2014, the USPTO canceled registration of the mark under the then-existing “disparagement” clause contained in Section 2(a) of the Lanham Act for being offensive to a substantial segment of Native Americans.[4]

However, in 2017, after the U.S. Supreme Court found the disparagement clause to be unconstitutional for discriminating based on viewpoint, the U.S. Court of Appeals for the Fourth Circuit vacated the cancellation, which in turn restored registered status to Washington Redskins’ trademarks.[5]

In another well-publicized court dispute involving allegations of cultural appropriation the Navajo Nation brought a court case against retailer Urban Outfitters Inc. for trademark infringement in 2012, based on Urban Outfitters’ use of “Navajo” to identify certain of its clothing and other items. The dispute settled in 2016, but during the pendency of the case the court issued certain rulings which bear on the legal aspects of cultural appropriation and its relationship to trademark laws.

Plaintiffs in the Navajo Nation case alleged trademark infringement, dilution and tarnishment. In particular, the Navajo Nation complained that Urban Outfitters’ use of “Navajo” and “Navaho” to identify clothing, underwear, and flasks, confused consumers as to the source of the goods, diluted the mark and that the misspelling of Navajo as Navaho tarnished the mark. The court dismissed the Navajo Nation’s claim of tarnishment due to misspelling and found that the mark was not sufficiently well known to qualify as a “famous” mark.[6]

Obstacles Facing Trademark Law-Based Challenges to Cultural Appropriation

Cultural groups seeking to protect targeted culture and tradition from cultural appropriation face several trademark law-based obstacles in accomplishing their goal. One such obstacle is the ability of the group to establish the requisite legal standing for representing the interest of the cultural group. For example, in the "Kimono" matter, no readily identifiable group stepped forward claiming to represent the cultural group for this case.

Another trademark-based obstacle is proving exclusive ownership and use of the claimed cultural indicia. The difficulty of this task is exasperated by the fact that many cultural indicia are kept as a cultural heritage and are not used to identify a product or service or group in some interstate activity as required under trademark law. As such, these indicia have difficulty meeting the "use in commerce" requirement for establishing a valid trademark.

Cultural indicia that do qualify as source identifiers may yet fail the "distinctiveness" test of trademark law required for them to serve as valid trademarks. In the Navajo Nation case, Urban Outfitters challenged the Navajo trademarks as descriptive, arguing that consumers do not associate the name with a single source as to products or services.

In Kardashian's "Kimono" effort, the USPTO referred to the word Kimono in "Kimono World" and "Kimono Solutionwear" applications as a "descriptive of the function of applicant's goods and services." [7] However, these applications were abandoned before attorneys for Kardashian had an opportunity to present evidence and arguments against this observation by the USPTO.

Famousness is another argument presented by cultural groups for preventing use of cultural indicia by alleged cultural appropriators. Advantageously, marks found to be famous enjoy additional protection against dilution. [8] Unlike the likelihood of confusion standard used in trademark infringement, which requires the alleged infringing use to be in the same or similar products or services covered by the asserted cultural indicium, under trademark dilution, the owner of a mark found to be famous can prevent its use by others in unrelated areas. However, proving famousness of a mark is difficult in that it would require a showing of being almost a household name.

Even if a cultural group is able to overcome the above obstacles and establish its ownership of a valid trademark in a cultural indicium, ownership (whether via registration or common law) does not necessarily exclude others from use of the mark. Rather, the mark can be concurrently used by others to identify other products and services so long as such use(s) are not likely to result in consumer confusion as to the source.

A well-known example of this concurrent use is the "Delta" mark for the airline and the faucet, which have been used concurrently for years, without causing consumer confusion. In the "Kimono" example, even if proponents succeeded in protecting the name as to clothing items, they would likely have had difficulty under trademark laws to extend such protection to unrelated items and services.

The doctrine of "fair use" is another approach potentially available to cultural appropriators to accomplish their purposes. Two recognized types of fair use include descriptive fair use and nominative fair use. Descriptive fair use permits use of another's trademark to describe the user's products or services, rather than as a trademark to indicate the source of the products or services. This usually is appropriate where the mark at issue has a descriptive meaning in addition to its secondary meaning as a trademark.

In the "Kimono" example, if someone were to offer clothing styles of long coat and baggy sleeves, he or she might be legally permitted to describe his or her product as "Kimono style." Nominative fair use, another species of fair use in trademark law, permits use of another's trademark in certain contexts to refer to the trademark owner's goods and services identified by the mark. Nominative fair use generally applies to comparative advertising, parody and news. In the "Kimono" example discussed here, even if "Kimono" qualified as a valid trademark for the traditional Japanese garment, others could use it for comparative purposes, parody and news.

Limited Impact of Opposition and Cancellation Proceedings to Deter Cultural Appropriation

As in the Redskins case, cultural groups often rely on Lanham Act's opposition and cancellation proceedings to counter cultural appropriations from use of their cultural indicia. However, these proceedings do not prevent use of the marks in commerce.

In its announcement of the decision to cancel the Redskins trademark, the USPTO noted that although cancellation will result in loss of benefits conferred by federal registration, including presumptions of ownership, nationwide protection of the mark, the ability to use the federal registration symbol, and to record the registrations with the U.S. Customs and Border Patrol Service to block importation of infringing or counterfeit foreign goods, it would not require that the trademarks in the involved registrations to be changed or no longer be used.

The decision pointed out that the USPTO does not have jurisdiction in a cancellation proceeding to require that a party cease use of a mark, but only to determine whether a mark may continue to be registered.

Limits on Availability of Infringement Actions to Deter Cultural Appropriation

In the limited situations in which a cultural indicium qualifies as a valid trademark and cultural appropriators are found to have used the same or similar items in a confusingly similar manner, trademark infringement actions enable the cultural groups to regain control (via injunction) over outside uses of their cultural products and may entitle them to monetary damages. An injunction would benefit cultural groups that seek to regain control or seek monetary compensation: the cultural group may entirely withhold the mark from use by that infringer or require the infringer to pay license fees.

Conclusion

Trademark laws can be used to appropriate indicia traditionally associated with certain cultures or traditions. Groups seeking to counter potential appropriators based on trademark laws face a multitude of challenges in establishing ownership of a valid trademark and in utilizing USPTO or court proceedings to stop the appropriators' use of the cultural items.

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[1] <https://www.nytimes.com/2019/07/02/style/kim-kardashian-west-kimono-japan.html>

[2] Trademark Manual of Examining Procedure (TMEP) §1203.03 (C) (i)

[3] In Re Pedersen, 109 U.S.P.Q.2d 1185 (T.T.A.B. 2013)

[4] https://www.uspto.gov/sites/default/files/news/USPTO_Official_Statement_on_TTAB_decision_in_Blackhorse_v_Pro_Football_Inc.pdf

[5] <http://www.ca4.uscourts.gov/opinions/151874.U.pdf>

[6] <http://www.thefashionlaw.com/home/urban-outfitters-wins-one-loses-two-in-latest-navajo-rulings>

[7] <http://www.thefashionlaw.com/home/no-kim-kardashian-does-not-own-the-word-kimono>

[8] 15 U.S. Code § 1125(c)