



NEW MEXICO DEPARTMENT OF  
**CULTURAL AFFAIRS**

**REPORT TO THE  
INDIAN AFFAIRS COMMITTEE  
OF THE  
NEW MEXICO LEGISLATURE**

**Day two of the fourth meeting of the Committee  
August 30, 2014**

**Zia Pueblo**

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## **BACKGROUND**

During the 2014 Legislative Session, the New Mexico Senate passed Senate Memorial 1 (the Memorial). The Memorial resolved to recognize the “widespread interest by the public in the use of the state flag of New Mexico and the Zia sun symbol incorporated within it.” In addition, the Memorial resolved that “the history of litigation, legislation, gubernatorial actions and efforts by the Pueblo of Zia has [sic] created questions as to who may use the Zia sun symbol and how it may be used.”

The Memorial also resolved that “during the first week of the first session of the fifty-second legislature in 2015,” the Department of Cultural Affairs (DCA) “be requested to make a report to the senate Indian and cultural affairs committee and the senate public affairs committee regarding who has a right to use the Zia sun symbol and if there are any restrictions on how it may be used.” The Legislative Council Service recently requested that DCA present on these topics to the Indian Affairs Committee during the interim instead of, or in addition to, the two session-based committees named in the Memorial.

This Report responds to the two questions posed in the Memorial: (1) who has the right to use the Zia sun symbol (“Symbol”); and (2) are there are any restrictions on how the Symbol may be used.

## **I. Who has the right to use the Symbol?**

This Report interprets the question “who has the right to use the Symbol” as asking about law-based rights to use the Symbol. The question has other possible implications, however, such as those rights that are not codified, those rights based on moral and ethical principles. This Report solely addresses the law-based rights to use the Symbol.

*In the context of law-based rights*, no person, business, government, or tribe is prohibited from using the symbol. Thus, anyone and any entity could be considered to have the “right” to use the Symbol. In addition, no law requires any prerequisites before a person or entity uses the Symbol.

## **II. Are there any restrictions on how the Symbol may be used?**

As with the response to the first question, this Report interprets the question “are there any restrictions on how the Symbol may be used” as asking about law-based restrictions. That said, there are other types of constraints that may restrict the Symbol’s use, including social, economic, cultural, and custom-based pressures. This Report focuses on the law-based restrictions on the use of the Symbol.

There are law-based restrictions on how the Symbol may be used. In particular, state and federal law limit the use of the Symbol in trademarks or service marks. The purpose of trademark law is to give protectable rights to an owner of a mark that is used to distinguish certain goods or services in commerce.<sup>1</sup> The Symbol is not owned or registered under trademark law. In fact, no entity can register the Symbol without modification.<sup>2</sup>

The Lanham Act, which is the federal statute on trademark, and the New Mexico Trademark Act each disallow registration of a number of categories of marks. Among a number of limitations, both the federal and state laws restrict registration of marks that consist or comprise of states' official insignias.<sup>3</sup> This restriction disallows registration of the Symbol due to its use on the New Mexico flag. In addition, the federal and state laws on trademark disallow registering marks that may falsely suggest a connection to particular persons, institutions, or beliefs, and marks that may "bring them into contempt" or "disrepute."<sup>4</sup>

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1 See generally, e.g., International Trademark Assn., *Fact Sheets: Introduction to Trademark*, <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarkRegistrationFactSheet.aspx> (last accessed September 26, 2014).

2 It is not clear how much manipulation is required to register a mark that cannot otherwise be registered. There are registered trademarks that incorporate the Symbol into a logo.

3 See 15 U.S.C. § 1052 (b) (2006) ("No trademark . . . shall be refused registration . . . unless it . . . [c]onsists of or comprises the flag or coat of arms or other insignia of . . . any State or municipality . . ."); NMSA 1978, § 57-3B-4 (1997) ("A mark . . . shall not be registered if it . . . consists of or comprises the flag, coat of arms or other

To assist reviewers of trademark applications to identify proposed marks that incorporate tribes' symbols, the U.S. Patent and Trade Office (USPTO) created what is called the "Native American Tribal Insignia Database." The Database does not give trademark protection benefits, but it can be used to deny registration to a mark that falsely suggests a connection with a tribe or that may bring the tribe into disrepute. Tribes are not required to submit insignia for registration in the Database and the Symbol is not listed in the Database.<sup>5</sup>

The Zia Pueblo has stopped at least one company from registering a mark containing the Symbol by challenging the company's mark's eligibility for registration under federal law. The Pueblo argued that the mark was not eligible for registration because it violated the prohibitions on registering marks, falsely suggesting a connection with a tribe and/or bringing a tribe into disrepute.<sup>6</sup> Despite

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insignia of the United States or of any state, municipality, foreign nation or any simulation of these[.]").

4 See 15 U.S.C. § 1052 (a) ("No trademark . . . shall be refused registration . . . unless it . . . [c]onsists of or comprises immoral, deceptive, or scandalous matter; or matter which may disparage or falsely suggest a connection with persons . . . institutions, beliefs . . . or bring them into contempt, or disrepute . . ."); NMSA 1978, § 57-3B-4 (1997) ("A mark . . . shall not be registered if it . . . consists of or comprises matter that may . . . falsely suggest a connection with persons living or dead, institutions, beliefs or national symbols or that may bring them into contempt or disrepute[.]").

5 See U.S. Patent and Trademark Office, Trademark Electronic Search System (TESS), <http://tess2.uspto.gov/bin/gate.exe?f=search&state=4804:quwdv2.1.1>, search term "Native American Tribal Insignia" (last accessed September 28, 2014).

6 See generally Stephanie B. Turner, Student Author, *The Case of the Zia: Looking Beyond Trademark Law to Protect Sacred Symbols*, 11 Chi.-Kent J. Intell. Prop. 116, 129 (2012).

the success, such disputes are financially burdensome and have not yet resulted in written decision that could provide guidance about applying trademark law to marks incorporating the Symbol.

A recent law review article suggests that non-legal mechanisms such as education, political lobbying, and informal negotiation are a more effective approach to restricting the use of the Symbol than legal challenges.<sup>7</sup> The law article's suggestion relies on recent examples of negotiation between certain companies and the Zia Pueblo about the companies' use of the Symbol. The Zia Pueblo began requesting that companies ask permission to use the Symbol in order to show respect for the Pueblo. A report from 2005 estimated that at that time the Pueblo had given permission to approximately twenty companies that also donated to the Pueblo's scholarship fund.<sup>8</sup>

A recent example of a California alternative rock band's use of a modified version of the Symbol may provide additional evidence about whether a respect-based system of requesting permission to use the Symbol commercially has been adopted by the public.<sup>9</sup> Initially, the band did not request permission to use the

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<sup>7</sup> *Id.* at 133.

<sup>8</sup> See National Association of Tribal Historic Preservation Officers, *Zia Pueblo Receiving Money for Use of Sun Symbol*, Dec. 2, 2005, [http://www.nathpo.org/News/Legal/News-Legal\\_Issues27.html](http://www.nathpo.org/News/Legal/News-Legal_Issues27.html) (last accessed Sept. 29, 2014).

<sup>9</sup> Although the band's spokesperson initially stated that the band's logo was not the same as the Symbol, a member of the band recognized the connection to the Symbol

Symbol,<sup>10</sup> which is featured prominently on the band's first album and which the band is using as its primary logo.<sup>11</sup> After a New Mexico news outlet reported that the band had not requested permission from the tribe, and after a number of fans complained,<sup>12</sup> the band's manager apparently contacted the Zia Pueblo's governor to request permission.<sup>13</sup>

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in an interview: "We had just come up with the name Bad Suns not too long ago and I was just browsing the internet, looking at images that were things that were related to the sun because we wanted to have an image that was attached to the band. We saw that [The Zia Symbol], looked in to it, read about it, really liked what it was all about. Kind of felt like—there were a few other things too—felt like that one really stuck out to us, and it made sense. Like you said, the focus on the number four: the four seasons, the four stages of life, the four parts of a day—all of that stuff. The four points on a compass. The fact that this band—the number four is so integral because of how important each person's role is—it just made sense. And you know, we altered it a little bit; we just think it's cool. People always ask about it." See Meet The Band Bad Suns, August 13, 2014, Station X96 (KXRK), available at [http://www.x96.com/meet\\_the\\_band\\_bad\\_suns/blog/654](http://www.x96.com/meet_the_band_bad_suns/blog/654) (last accessed September 28, 2014).

10 KOAT 7 Albuquerque, *Band uses Zia image on album without permission from pueblo*, June 5, 2014, <http://www.koat.com/news/band-uses-zia-image-on-album-without-permission-from-pueblo/26338484#10VoUN> (last accessed June 19, 2014).

11 See Bad Suns, <http://badsuns.tumblr.com/> (last accessed September 28, 2014).

12 On June 5, 2014, a Facebook user posted on the Bad Suns' Facebook page "Shame, SHAME on you for using the symbol of the Zia Pueblo people, without permission or compensation! No thing [sic] good will come to you for this! Only BAD. At least you got that right." Another Facebook user posted, "Hey y'all, I've gotta [sic] say I really enjoy your music; although, like someone said a few comments ago, you guys were on our local news here in NM and Zia Pueblo wants you to ask permission to use the Zia symbol (stylized or not). Thank you, and once again, you guys make great music[.]" Another user posted, "Your band's logo is.... shocking." On June 25, 2014, another Facebook user stated "[A]re any of you guys Zia Pueblo natives? Because you know they own that symbol correct? Its [sic] actually a spiritual

## CONCLUSION

In conclusion, although anyone can use the Symbol, certain laws restrict the Symbol's commercial use as a protected mark used to identify goods and services. These laws may be difficult to enforce and it is not clear how different a mark needs to be from the Symbol to make it eligible for registration as a trademark. There is also some evidence that non-legal norms may serve as a check on the commercial use of the Symbol.

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thing so maybe show some respect and change it.... just sayin [sic] [.]” On July 8, 2014, another Facebook user stated “Hey guys I had recently heard about the issue you guys were having with the Zia symbol. And I really like your guys' music[,] it's a different sound and I don't want to stop listening but it would always sit in the back of my mind that I have heard that you guys have done anything to be on good terms with the [Z]ia pueblo. I would hope you would take it into consideration the importance that these tribes have in their culture. I would like to hear on the new[s] or from you that some positive agreement has been reached. Thanks for hearing me out and again keep doing the music you do.” In response to an August 21st announcement that the band would be selling bracelets with the Symbol, the first comment was “You donate to the Zia Indians for use of their sacred Zia symbol yet?” On the 24th of August, after a user stated “Nice Zia symbol.” The same user asked “Which one of you is from NM. Pretty impressive that they gave you permission to use the symbol!!” and then added “Riiiiiiight.” Another user stated “[Expletive] these dudes for ripping off the NM [Z]ia symbol.” See Bad Suns, Facebook, <https://www.facebook.com/badsuns> (last accessed Sept. 27, 2014).

13 See KOAT 7 Albuquerque, *Album featuring Zia may release without permission, Zia Pueblo governor seeks donation to scholarship fund, in-person meeting with record label*, June 19, 2014, <http://www.koat.com/news/album-featuring-zia-may-release-without-permission/26581474#ixzz3EjfEeMTF> (last accessed Sept. 29, 2014).