

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

Mailed:
Sept. 10, 2008

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Shinnecock Smoke Shop

Serial No. 78918061
Serial No. 78918500

Scott Michael Moore of Moore International Law Offices,
P.C. for Shinnecock Smoke Shop.

Kathleen de Jonge, Trademark Examining Attorney, Law Office
107 (J. Leslie Bishop, Managing Attorney).

Before Quinn, Hohein and Grendel, Administrative Trademark
Judges.

Opinion by Grendel, Administrative Trademark Judge:

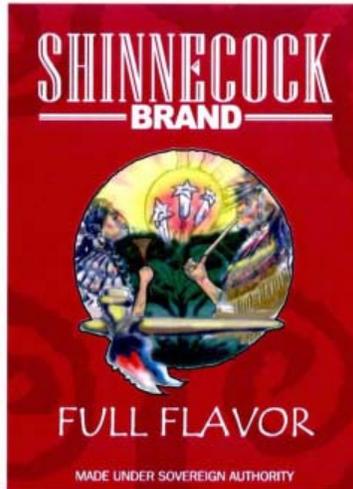
The appeals in the two above-captioned applications
are hereby consolidated and shall be decided in this single
opinion.¹

¹ In this opinion, for the most part we shall refer to
applicant's "application" and "mark" in the singular. However,
our findings and analysis should be understood to refer to both
of the applications and both of the marks.

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The applicant in both applications is Shinnecock Smoke Shop, a sole proprietorship composed of Jonathan K. Smith, "a citizen of the United States and on-reservation member of the Shinnecock Indian Nation."

In application Serial No. 78918061, filed on June 27, 2006, applicant seeks registration on the Principal Register of the mark depicted below for "cigarettes" in Class 34.



The wording in the mark is SHINNECOCK BRAND, FULL FLAVOR, and MADE UNDER SOVEREIGN AUTHORITY. Applicant has disclaimed the exclusive right to use BRAND, FULL FLAVOR,

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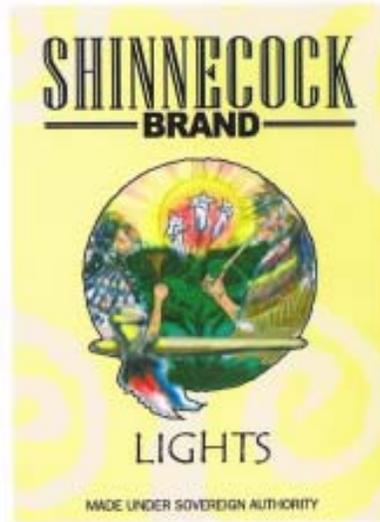
and MADE UNDER SOVEREIGN AUTHORITY apart from the mark as shown.²

In application Serial No. 78918500, filed on June 28, 2006, applicant seeks registration on the Principal Register of the mark depicted below for "cigarettes" in Class 34.

² The application includes a "Description of Mark" statement which states:

The mark consists of a RED background with darker RED swirls. In the center is a BLACK circle outlined in WHITE broken by a pipe. The pipe is BROWN with a YELLOW bowl and feathers attached that are BLACK at the top, with RED under the BLACK on one side and BLUE under the BLACK on the other side and ending in WHITE tips. In the center of the circle are a Native American woman with BLACK hair, a BROWN face and a WHITE dress with PINK and BLUE highlights, and a Native American man with feathers in his hair, a BROWN face, and a YELLOW shirt with fringe. RED, BLUE, WHITE and BLACK appear on the feathers in the man's hair and in decorations on the sleeve of his shirt. The woman is holding a BROWN flower and the man is holding a WHITE pipe. Between the man and woman is a rising PINK sun with a RED center and a YELLOW corona behind a WHITE flowering GREEN tobacco plant against BLACK mountains. The wording in the mark is WHITE.

The application includes a "Colors Claimed" statement which states: The color(s) red, green, yellow, brown, blue, black, white and pink is/are claimed as a feature of the mark."



The wording in the mark is SHINNECOCK BRAND, LIGHTS, and MADE UNDER SOVEREIGN AUTHORITY. Applicant has disclaimed BRAND, LIGHTS, and MADE UNDER SOVEREIGN AUTHORITY apart from the mark as shown.³

³ The application includes a "Description of Mark" statement which states:

The mark consists of a YELLOW background with WHITE swirls. In the center is a BLACK circle broken by a pipe. The pipe is BROWN with a YELLOW bowl and feathers attached that are BLACK at the top, with RED under the BLACK on one side and BLUE under the BLACK on the other side and ending in WHITE tips. In the center of the circle are a Native American woman with BLACK hair, a BROWN face and a WHITE dress with PINK and BLUE highlights, and a Native American man with feathers in his hair, a BROWN face, and a YELLOW shirt with fringe. RED, BLUE, WHITE and BLACK appear on the feathers in the man's hair and in decorations on the sleeve of his shirt. The woman is holding a BROWN flower and the man is holding a WHITE pipe. Between the man and woman is a rising PINK sun with a RED center and a YELLOW corona behind a WHITE flowering GREEN tobacco plant against BLACK mountains. The wording in the mark is BLACK.

In each of the applications, the Trademark Examining Attorney has issued a final refusal to register the mark on the ground that it falsely suggests a connection with the Shinnecock Indian Nation (an Indian tribe located near Southampton, New York), and thus is unregistrable under Trademark Act Section 2(a), 15 U.S.C. §1052(a).

In each of the applications, applicant has appealed the final refusal to register. Applicant and the Trademark Examining Attorney have filed main appeal briefs in each case.⁴

After careful consideration of the evidence of record and the arguments presented, we affirm the refusal to register in each of the applications.

As noted above, applicant is a member of the Shinnecock Indian Nation. The record includes a printout from the tribe's website (www.shinnecocknation.com), which states that the Shinnecock Indian Nation is an Indian tribe

The application includes a "Colors Claimed" statement which states: "The color(s) RED, GREEN, YELLOW, BROWN, BLUE, BLACK, WHITE and PINK is/are claimed as a feature of the mark.

⁴ We sustain the Trademark Examining Attorney's objection to the evidence (pertaining to a third-party intent-to-use application (Ser. No. 78972292) to register the mark LUMBEE), submitted by applicant for the first time with applicant's appeal brief in each case. This evidence is untimely and shall be given no consideration. See Trademark Rule 2.142(d), 37 C.F.R. §2.142(d). We note that our decision herein would be the same even if we had considered this untimely evidence.

located on eastern Long Island, New York, and that it "is among the oldest self-governing tribes of Indians in the United States and has been a state-recognized tribe for over 200 years."

In pertinent part, Trademark Act Section 2(a) prohibits registration of "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." More specific to the case before us, the relevant provision of Section 2(a) is the prohibition of registration of "matter which may ... falsely suggest a connection with persons, living or dead, [or] institutions" This Section 2(a) basis of refusal of registration is generally referred to as the "false suggestion of a connection" refusal.

Under our caselaw, there are four elements to this refusal. The Office must prove that: (1) the mark is the same as, or a close approximation of, the name or identity previously used by another person or institution; (2) the mark would be recognized as such, in that it points uniquely and unmistakably to that person or institution; (3) the person or institution named by the mark is not connected with the activities performed by applicant under the mark; and (4) the fame or reputation of the person or

institution is such that, when the mark is used with the applicant's goods or services, a connection with the person or institution would be presumed. See *In re White*, 73 USPQ2d 1713 (TTAB 2004); *In re Sloppy Joe's International Inc.*, 43 USPQ2d 1350 (TTAB 1997).

Initially, we note that Section 2(a) prohibits registration of a mark which falsely suggests a connection with "persons, living or dead," or with "institutions." We find that the Shinnecock Indian Nation (the tribe of which applicant is a member) is an "institution" within the meaning of Section 2(a). Applicant and the Trademark Examining Attorney have argued at length on the question of whether the tribe is a "person" within the meaning of Section 2(a).⁵ We need not and do not decide that question, however, because regardless of whether the tribe is a "person," it clearly is an "institution" and thus is protected under Section 2(a). See *In re White, supra*,

⁵ In brief, applicant argues that even though the definition of "person" set forth in Trademark Act Section 45, 15 U.S.C. §1127, specifically includes not only natural persons but juristic persons, the words "persons, living or dead" in Section 2(a), in context, must be read to refer solely to natural persons and not juristic persons because only natural persons, not juristic persons, can be "living or dead." This argument disregards the controlling caselaw going back at least as far as the Federal Circuit's seminal Section 2(a) decision in *The University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co., Inc.*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983). These cases have repeatedly found that the word "persons" in Section 2(a) encompasses juristic persons, not just natural persons.

(Apache tribes are "institutions" for purposes of Section 2(a)). If applicant's mark falsely suggests a connection with the Shinnecock Indian Nation, an "institution" within the meaning of Section 2(a), then registration must be refused. We turn now to the substantive elements of the refusal.

First, however, we find it to be significant that applicant, throughout the examination process and in its appeal brief, has presented absolutely no evidence or argument with respect to the elements of the Trademark Examining Attorney's Section 2(a) "false suggestion of a connection" refusal. We deem applicant's failure to even mention the elements of the refusal as being tantamount to a concession that the Office has established each of those elements. However, because the burden of establishing each of the elements of the refusal is on the Office, we shall proceed to determine whether the Office has presented evidence sufficient to support the refusal. We find that it has.

Under the first element of the refusal, we find that the mark applicant seeks to register consists of or comprises matter, namely, the word SHINNECOCK, which is the same as or a close approximation of the name or identity previously used by another institution, i.e., the

Shinnecock Indian Nation. The tribe's website shows that the tribe identifies itself and repeatedly refers to itself by the name "Shinnecock Indian Nation" or some other variation which includes the word "Shinnecock" or "Shinnecoeks." It is not dispositive that the words "Indian Nation" included in the tribe's name do not appear in applicant's mark, nor is it dispositive that the mark includes other wording which is not included in the tribe's name. See *In re White*, 80 USPQ2d 1654, 1658 (TTAB 2006; *In re White, supra*, 73 USPQ2d at 1719; *In re Urbano*, 51 USPQ2d 1776, 1778 (TTAB 1999) (Section 2(a) determination is based on "the relevant portion" of the applicant's mark). For these reasons, we find that the first element of the Section 2(a) "false suggestion of a connection" refusal has been established. Again, applicant does not contend otherwise.

Under the related second element of the refusal, we find that the word SHINNECOCK in applicant's mark, in addition to being the same as or a close approximation of the tribe's name or identity, would in fact be recognized as such in that it points uniquely and unmistakably to the tribe. The evidence submitted by the Trademark Examining Attorney with her first and final Office actions includes printouts of excerpted news articles involving the tribe in

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which the tribe always is identified and referred to as "the Shinnecoaks" or some variation thereof. Moreover, on this record, SHINNECOCK has no other significance than as the name of the tribe. For these reasons, we find that the second element of the Section 2(a) "false suggestion of a connection" refusal has been established. Applicant does not contend otherwise.

Under the third element of the refusal, we find that the person or institution named by the mark, i.e., the Shinnecock tribe, is not connected with the activities performed by applicant under the mark. Applicant's mere membership in the tribe does not suffice; applicant is not the only member of the tribe. Nor does the tribe's awareness of applicant's activities suffice as the requisite connection (assuming that such awareness in fact exists). There must be a specific commercial connection between applicant and the tribe, evidencing the tribe's endorsement or sponsorship of applicant's sale of cigarettes. See *In re White, supra*, 80 USPQ2d at 1660-61. There is no evidence of the requisite specific commercial connection in this case. Thus, the third element of the "false suggestion of a connection" refusal has been established. Applicant does not contend otherwise.

The fourth and final element of the refusal in this case requires a showing that the fame or reputation of the name appropriated by the applicant is such that, when applicant's mark is used in connection with applicant's goods, purchasers would mistakenly presume that a commercial connection exists between the named person or institution and the applicant. This element does not require a fame analysis like that which might be relevant to a Section 2(d) likelihood of confusion analysis or a Section 43(c) dilution analysis. Rather,

...the key is whether the name per se is unmistakably associated with a particular person or institution and, *as used* would point uniquely to the person or institution. In short, it is the combination of (1) the name of sufficient fame or reputation and (2) its use on or in connection with particular goods or services, that would point consumers of the goods or services uniquely to a particular person or institution.

In re White, supra, 73 USPQ2d at 1720 (emphasis in original).

We find in this case that the fame and reputation of the Shinnecock tribe is such, and the nature of applicant's particular goods (cigarettes) is such, that applicant's use of its SHINNECOCK mark on cigarettes will lead purchasers

to mistakenly presume that a commercial connection exists between the tribe and applicant and applicant's cigarettes.

First, we find that the Shinnecock Indian Nation and its Shinnecock name are well-known, especially to residents in the geographic area (eastern Long Island) occupied by the tribe and to visitors to the reservation and surrounding area. The tribe's website informs readers that "[t]he Shinnecock Nation is among the oldest self-governing tribes in the United States and has been a state-recognized tribe for over 200 years." The tribe's reservation is located adjacent to the town of Southampton on Long Island. The evidence of record includes excerpts and abstracts from news articles (including articles from The New York Times) which specifically refer to and discuss the Shinnecoeks by name. The Tribe's website shows that, since 1946, the tribe has conducted an annual Powwow event which now "hosts thousands of visitors." Superpages.com identifies Shinnecock Indian Outpost as a "Southampton, NY Attraction": "This funky shop sells tax-free cigarettes, American Indian crafts, clothes, and glassware."

Second, we find that applicant's particular goods, cigarettes, are such that use of the name SHINNECOCK in connection therewith will lead purchasers to mistakenly

presume the existence of a commercial connection between applicant's cigarettes and the Shinnecock tribe.

The record shows that Indian tribes, in general, are known to manufacture and market cigarettes. The record includes printouts of the Internet websites of two Native American cigarette retailers, "Black Hawk Tobacco" and "Smokin Joes." The Black Hawk Tobacco website informs the public that "[w]e are a Native American owned and operated company located on Sovereign Native American land selling Native American made tobacco products to Native Americans and Non-Native Americans. Because we are located on the Sovereign Agua Caliente Reservation we can legally sell our native American made cigarettes and tobacco products nation-wide." The Smokin Joes website offers "[p]ure Indian Cigarettes and all Natural Indian Cigarettes. We also sell the highest quality Native American Brand cigarettes, Native American made Cigarettes, Reservation Cigarettes and More. We are the #1 on-line Indian Cigarette Source." The website also informs purchasers that Smokin Joes sells "Indian Cigarettes straight from the Indian cigarette reservations."

Not only are cigarette purchasers aware that Native American tribes in general manufacture and market cigarettes, they are aware that Shinnecock Indians in

particular are involved in the marketing of cigarettes. The Shinnecocks operate nine smoke shops on Long Island, including three on the reservation. An article in the March 11, 2000 New York Daily News informs readers:

NEW YORK - There are other ways to save money on cigarettes than buying them illegally from a smuggler. One of them is to drive out to the Shinnecock Indian Reservation in Southampton, where cigarettes cost about \$3 a pack and \$28.50 a carton. They're tax-free and legal. Off the reservation, cigarettes on Long Island go for as much as \$5 a pack and \$41 a carton.

On his way to make a cigarette purchase, Joseph Sgroi, 46, said he didn't mind driving more than an hour from his home in Long Beach, to the reservation to buy three cartons. "You can't beat the prices," he said.

As a result of last week's big jump in the state tax on cigarettes, more smokers like Sgroi are flocking to the reservation's three Montauk Highway smoke shops. The Shinnecock Nation is one of nine tribes in New York state with Indian sovereignty. As such, state tax laws aren't enforceable on their land.

An article in the July 14, 2004 Providence Journal (RI) informs readers that "The Shinnecocks operate nine smoke shops on Long Island..." An article in the November 6, 2006 edition of The New York Times informs readers that "The tax-free sale of steeply discounted cigarettes keeps the Shinnecock Indians alive..."

Based on these and other news articles in the record, we find that cigarette purchasers are aware that the

Shinnecocks market cigarettes, and that upon encountering cigarettes sold under applicant's SHINNECOCK mark they would mistakenly presume the existence of a commercial connection between applicant's cigarettes and the Shinnecock tribe.

Additionally, there is other wording in applicant's mark that would do nothing but reinforce and exacerbate purchasers' mistaken presumption that a commercial connection exists between applicant's cigarettes and the Shinnecock tribe. Specifically, the wording MADE UNDER SOVEREIGN AUTHORITY, when used in connection with the name SHINNECOCK, obviously would be understood by purchasers to mean that applicant's cigarettes are authorized, endorsed or approved by the Shinnecock tribe. Applicant has stated (in response to the Trademark Examining Attorney's inquiry in her first Office action) that the words SOVEREIGN AUTHORITY in the mark are intended to refer to God. However, the evidence of record clearly establishes that, when used in connection with Indian tribes, the word SOVEREIGN has a particular meaning and significance, referring to the sovereign status of the tribal nations under the laws and Constitution of the United States. Thus, even if applicant subjectively intends the words SOVEREIGN AUTHORITY to refer to God, that is not the

meaning that purchasers will attribute to the words when used in connection with applicant's cigarettes.

For all of these reasons, we find that the fourth element of the Section 2(a) refusal has been established. Applicant does not contend otherwise.

Because all four elements of the refusal have been established, we conclude that applicant's mark falsely suggests a connection with the Shinnecock Indian Nation, and that the refusal of registration under Section 2(a) is entirely warranted.

As noted above, applicant has presented no evidence or argument with respect to the substantive elements of the Section 2(a) refusal. Instead, applicant has argued at length that the Office's refusal to register the mark is based on racial discrimination, i.e., because applicant is a Native American. According to applicant, this racial discrimination violates applicant's constitutional due process and equal protection rights under the Fifth Amendment of the United States Constitution. Applicant also argues that this alleged racial discrimination by the Office, an agency of the United States, violates the United States' obligations under the United Nations' International Convention on the Elimination of All Forms of Racial Discrimination (CERD).

Applicant bases his racial discrimination claims on the fact that the Office in the past has issued, to non-Indians, registrations of marks consisting of or comprising the names of Indian Tribes or Indian historical personages. Applicant has submitted copies of the following extant third-party registrations:

- Reg. No. 1447929, of the mark SHINNECOCK HILLS GOLF CLUB for country club and restaurant services;
 - Reg. No. 2739914, of the mark 1891 SHINNECOCK for golf clothing and equipment;
 - Reg. No. 1663757, of the mark CHEROKEE for cutlery;
 - Reg. No. 2706122, of the mark CHEROKEE for sunrooms, doors, etc.;
 - Reg. No. 2881671, of the mark CHEROKEE for horse trailers;
 - Reg. No. 0908927, of the mark CHEROKEE BRAND for piano wire;
 - Reg. No. 2912969, of the mark APACHE for bicycles;
 - Reg. No. 0773714, of the mark CHIPPEWA for boots and shoes;
 - Reg. No. 2417630, of the mark TUSCARORA for cigars;
 - Reg. No. 2396499, of the mark CAYUGA for fishing reels;
 - Reg. No. 2274143, of the mark GERONIMO for tobacco leaves;
 - Reg. No. 2629289, of the mark GERONIMO for tires;
 - Reg. No. 2968623, of the mark CRAZY HORSE for cigarettes; and
 - Reg. No. 2548215, of the mark SACAGAWEA for commemorative coins.
- Applicant also cites to Reg. No. 2827776, of the mark SENECA for cigarettes, which issued to the Sac and Fox nation, not the Seneca tribe.

Applicant has not proven, but we shall assume arguendo, that the owners of these registrations are non-

Indians and/or that the registrations were issued without the consent of the tribal entities named in the marks.

Comparing his application to these third-party registrations, applicant argues that "[i]n the present case, registration is refused for a mark using the name of an Indian tribe. The only difference is on the facts, where the present applicant is an Indian. There is absolutely no legal basis for this discriminatory treatment." (Brief at 12; emphasis in original.)

This argument is unpersuasive. The fact that applicant is a Native American clearly is not the only factual difference between applicant's application and the third-party registrations. Rather, each of the third-party registrations covers marks and/or goods which are not the same as applicant's. As might be expected in view of applicant's failure to even mention the substantive elements of the Section 2(a) "false suggestion of a connection" refusal at issue in this case, applicant's racial discrimination argument completely disregards the substantive elements of the refusal. It is entirely reasonable to assume that these registrations were issued not because the applicants therein were non-Indians, but rather because the elements of the Section 2(a) refusal were not or could not be proven by the Office.

In particular, applicant disregards the fourth element's requirement that the refusal must be based on a consideration of the fame of the name of the person or institution depicted in the mark as applied to the goods or services identified in the application or registration. Otherwise, the effect of the Section 2(a) refusal would be the grant of an impermissible right in gross to the entity named in the mark. See *University of Notre Dame du Lac v. J.C. Gourmet Food Imports Co.*, *supra*, 217 USPQ at 509. Except for the four third-party registrations which cover tobacco products (discussed below), the goods and services identified in each of the third-party registrations (including the two SHINNECOCK third-party registrations), on their face, do not appear to be the types of goods or services (e.g., piano wire and bicycles) that purchasers necessarily would associate with the named Indian tribes or personages. Purchasers therefore would not expect or mistakenly presume that there was any commercial connection between the named tribes and the applicants or their goods. Absent proof of such a mistaken presumption of a connection, the Section 2(a) "false suggestion of a connection" refusal could not be maintained by the Office, regardless of the applicant's race.

Four of the third-party registrations cited by applicant do indeed cover the same goods as those identified in applicant's application, i.e., tobacco products. They are registrations of the marks TUSCARORA for cigars, GERONIMO for tobacco leaves, CRAZY HORSE for cigarettes, and SENECA for cigarettes. Even as to these registrations, the race of the applicant is not the only fact distinguishing applicant's application from the registrations. Obviously, the registered marks and applicant's mark are different as well. It is likely that the reason these registrations were issued was that the Office failed to locate evidence sufficient to establish all four of the elements of the "false suggestion of a connection" refusal.

More fundamentally, even if all of the third-party registrations cited by applicant were issued inappropriately and should have been refused registration under Section 2(a), such errors by the Office would not justify the issuance of a registration to applicant in this case, where all of the elements of the Section 2(a) refusal clearly have been established. Although consistency in examination is the Office's goal, every application must be considered on its own merits. See *In re Nett Designs*, 236 F.3d 1339, 57 USPQ2d 1564 (Fed. Cir. 2001). Nor does the

fact that registration to applicant has been refused notwithstanding the issuance of these other registrations constitute a denial of applicant's constitutional rights to due process and equal protection. As our primary reviewing court has previously stated:

The fact that, whether because of administrative error or otherwise, some marks have been registered even though they may be in violation of the governing statutory standard does not mean that the agency must forgo applying that standard in all other cases. The TTAB's decision in this case therefore does not violate the constitutional principles that Boulevard invokes.

In re Boulevard Entertainment Inc., 334 F.3d 1336, 67 USPQ2d 1475, 1480 (Fed. Cir. 2003). See also *In re Litehouse Inc.*, 82 USPQ2d 1471 (TTAB 2007).

For all of these reasons, we find that applicant's Fifth Amendment due process and equal protection arguments based on the Office's alleged racial discrimination against applicant are unsupported by the facts and that they are unavailable in any event under *In re Boulevard Entertainment Inc.*, *supra*.

Applicant's reliance on The Convention on the Elimination of All Forms of Racial Discrimination (CERD), ratified by the United States in 1994, likewise is unavailing. First, as noted above, applicant has failed as

a factual matter to establish that the Office's refusal to register applicant's mark is based on racial discrimination, as contemplated in the CERD or otherwise. Rather, we find that the refusal is based on the Office's proper application of the provisions of Section 2(a) of the Trademark Act.

In any event and more fundamentally, applicant's reliance on the CERD is unavailing because the CERD is not a self-executing treaty which affords applicant an independent or direct cause of action here.⁶ The United States Senate's 1994 ratification of the Convention expressly declared: "The Senate's advice and consent is subject to the following declaration: That the United States declares that the provisions of the Convention are not self-executing." The non-self-executing nature of the CERD has been specifically affirmed by the courts. See, e.g., *Johnson v. Quander*, 370 F.Supp.2d 79, 101-102 (D.D.C. 2005) (CERD provisions are not self-executing and thus do not authorize a private right of action under the CERD), *aff'd* 440 F.3d 489 (D.C. Cir.), *cert. denied*, 127 S.Ct. 103 (2006).

⁶ Applicant is incorrect in arguing that the United States Senate is not entitled to declare that a treaty is not self-executing. See generally *In re Rath*, 402 F.3d 1207, 74 USPQ2d 1174 (Fed. Cir. 2005) (Paris Convention not self-executing).

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Based on these authorities, we find that the CERD is not self-executing, and that it affords applicant no independent basis for challenging the Office's refusal to register applicant's mark.

In summary, we find that the Office has established all four elements of the Section 2(a) "false suggestion of a connection" refusal and that Section 2(a) therefore bars registration of applicant's marks. We also find that applicant's claims of racial discrimination under the U.S. Constitution and under the CERD are without merit.

Decision: The refusal to register is affirmed with respect to each of the applications.