



November 14, 2024

Ms. Susan Anthony
Tribal Affairs Liaison
Office of Policy and International Affairs (OPIA)
United States Patent and Trademark Office
Sent via e-mail to Susan.Anthony@uspto.gov

Re: US Positions in 2024 WIPO Negotiations to Adopt a Design Law Treaty

Greetings, Ms. Anthony,

These comments are provided on behalf of the National Native American Bar Association (“**NNABA**”) as a follow on response to an October 2024 discussion with the United States Patent and Trademark Office (“**USPTO**”), regarding the World Intellectual Property Organization (“**WIPO**”) Diplomatic Conference to Conclude and Adopt a Design Law Treaty (“**DLT**”) occurring from November 11 to 22, 2024 (the “**DLT DipCon**”).¹

In brief, at the DLT DipCon the United States government:

1. should negotiate for and support a disclosure requirement in the DLT, which could look like acceptance of Alternative A (ix) to Article 3(1)(a) included in the basic treaty proposal;
2. must advocate against, and should not agree to, a DLT that prohibits contracting parties from implementing a disclosure requirement in their national intellectual property (“**IP**”) systems; and
3. should negotiate for and support the inclusion of the proposed Article 9quinquies in the DLT requiring permission from Indigenous peoples before designs incorporating their TK and TCEs are included in contracting parties’ publicly accessible design databases and giving Indigenous peoples a mechanism to object to the inclusion of such designs in the same databases.

¹ The basic treaty proposal that NNABA references in these comments is available online at https://www.wipo.int/edocs/mdocs/sct/en/dlt_dc/dlt_dc_3.pdf

Additionally, the USPTO must adopt a meaningful tribal consultation practice for all its work that comports with its duties under international legal instruments regarding the protection of Indigenous human rights impacted by the IP system, and the US Government's federal trust duties to tribes.

NNABA provides support for these negotiation recommendations and requests below.

Background on Consultation Regarding The DLT and DLT DipCon

The US Government participates in the work of WIPO, which includes IP treaty negotiations and the administration of adopted IP treaties. The US Government's engagement at WIPO, which is a specialized IP focused agency of the United Nations, are led by the USPTO.

NNABA was founded in 1973 and serves as the national association for Native American attorneys, judges, law professors, and legal professionals. NNABA promotes and addresses social, cultural, political, and legal issues affecting American Indians, Alaska Natives, and Native Hawaiians. The protection of traditional knowledge, cultural expressions, genetic resources, and other aspects of Native American culture are among the critically important areas affecting Native American communities, and within the scope of NNABA's mission.

In October 2023, the USPTO announced that for the first time in its history, it would engage in a formal tribal consultation process seeking input from Tribal Nations on "how best to protect the genetic resources, traditional knowledge, and traditional cultural expressions of Indigenous Peoples." This consultation was to inform US negotiation positions at a WIPO diplomatic conference to conclude and adopt a treaty on genetic resources that would occur in May 2024.

Numerous stakeholders across Indian Country raised concerns that the tribal consultation was insufficient in form and substance. Nevertheless, NNABA and other Native American stakeholders participated in that tribal consultation by preparing written comments and engaging in multiple meetings with staff from the USPTO and other federal agencies.² To the credit of all involved, the diplomatic conference that followed resulted in a historic IP treaty that requires nations to implement a disclosure requirement in their patent application processes, requiring applicants to disclose when seeking to register inventions based on traditional knowledge associated with genetic resources. Further, the US agreed to become a contracting party to the treaty.

² A copy of the comments NNABA provided to the USPTO in January 2024 in advance of the Genetic Resources treaty negotiations is available on NNABA's webpage for the NNABA Intellectual and Cultural Property Committee accessible online here:

<https://www.nativeamericanbar.org/icpcommittee/>

NNABA recently learned that the USPTO will participate in the DLT DipCon. In stark contrast to the precedent that the USPTO set in relation to the genetic resources diplomatic conference earlier this year, however, the USPTO did not engage in a tribal consultation process at all, instead only engaging in a public comment period. NNABA was only notified and offered the opportunity to discuss the DLT DipCon with the USPTO on a single video conference call that took place on October 10, 2024 (the “**October DLT Call**”) with only two days advance notice. The call was attended by several other Native stakeholders, including representatives from:

- the Tulalip Tribe,
- The Implementation Project at the University of Colorado Boulder,
- the Coalition of Large Tribes (COLT) and their counsel Greenberg Traurig LLP,
- Linda Benally, representing traditional and customary practitioners and traditional knowledge stewards from Navajo Nation, and
- the Native American Rights Fund (NARF) representing the National Congress of American Indians (NCAI).³

NNABA’s understanding is that no other Indigenous stakeholders, including tribal governments, were afforded a notice about the DLT DipCon or an invitation to join the October DLT Call. The USPTO did not provide an opportunity for NNABA to review the USPTO’s position in advance, and it did not seem that the other Native parties on the call had that opportunity either.

Representatives for NNABA that were able to rearrange their schedules tried to attend the October DLT Call, but did not have adequate time in advance of the call to review the third-party comments that were submitted in response to the public comment period. Rather, due to the extremely short notice provided, NNABA was only able to provide high level comments.

These written comments are provided as a follow up to the October DLT Call, to reinforce feedback that was provided there, though these comments similarly reflect the unreasonably short amount of time NNABA was afforded to act on this. Nevertheless, NNABA has allocated substantial time and effort of volunteer resources to provide these comments and those given on the October DLT Call. NNABA respectfully asks that the USPTO give them serious weight and consideration while engaging at the DLT DipCon this month, consistent with what meaningful consultation requires.

³ The USPTO did not provide meeting minutes or a summary to participants. This list of meeting participants is based on best efforts to take notes by NNABA attendees. Any omission of participants here is unintentional.

The US Government and USPTO Have Failed To Meet Minimum Tribal Consultation Standards With Regard to the DLT

Despite the critical importance of consultation, the US Government including the US PTO have conducted woefully inadequate consultation on this matter, and plainly did not meet the Uniform Standards set forth in the Memorandum on Uniform Standards for Tribal Consultation (the “**Memorandum**”). For example, it is not believed an analysis “to determine whether Tribal consultation is required or appropriate consistent with Executive Order 13175” was performed consistent with Section 2 of the Memorandum. As described, “[t]his analysis should occur regardless of whether a Tribal government requests consultation.”

Moreover, during the October DLT Call, Aaron Jones (The Tulalip Tribes) noted that the teleconference itself was not a Tribal Consultation as set forth in the Memorandum and specifically requested a Tribal Consultation for future WIPO Intergovernmental Committee (“**IGC**”) and General Assembly negotiations that may have Tribal implications. Section 4 of the Memorandum requires “to the extent that it has not yet performed the analysis to determine whether consultation is appropriate” an analysis shall be conducted as soon as possible.

Referring now to Section 5 of the Memorandum, a notice of consultation has a number of requirements that are not met by mere publication in the Federal Register. For example, Section 5 (Iii) indicates the notice should be transmitted “using the agency’s standard method of communication, to each affected Tribal government.” The agency should also “consider posting it to the agency’s website or any centralized Federal Government site for providing notice of or coordinating Tribal consultations.” Section 5 (v) (b) further requires the head of each agency “shall ensure that agency officials responsible for sending invitations to consult to interested or potentially affected Tribal governments use available tools, databases, and agency documentation, as well as communicate with agency representatives who may be knowledgeable about those Tribes and the location(s) affected by the policy with Tribal implications, to ensure their invitation efforts are appropriately inclusive.”

A written comment period following the consultation of at least 30 days should be allowed (Section 5 (iii), which is likely not even possible in these circumstances given the Diplomatic Conference is scheduled for November 11-22, 2024, and there has been no communication other than a one-hour teleconference on October 10, 2024. This teleconference may not have even occurred had comments not been submitted jointly on October 7, 2024, by Native American Rights Fund, National Congress of American Indians, and The Tulalip Tribes), prompting Susan Anthony to reach out to Makalika Naholowaa to invite her to the teleconference three days later. Notably, not a single

Tribal Council member from any Tribal government was invited to or attended the teleconference. As Section 6 states, “[t]he head of each agency should ensure that agency representatives with appropriate expertise and, to the extent practicable, decision-making authority regarding the proposed policy are present at the Nation-to-Nation consultation.” In addition, “[t]he head of each agency should consider conducting the consultation in a manner that prioritizes participation of official Tribal government leaders.” However, only a small handful of individuals that provided comments for the WIPO IGC on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (“**GRATK**”) negotiations and available on such short notice were in attendance. None of these individuals met the requirements defined in Section 6 as there was insufficient notice and a lack of Tribal Consultation as defined by the Memorandum.

Free, Prior, and Informed Consent Is the Human Rights Standard That Should Apply to the Grant of IP That Incorporates TK, TCEs, and GRs

Indigenous cultures and Indigenous human rights are impacted by all types of intellectual property recognized in the US, and similarly recognized in other jurisdictions. Intellectual property can be and is used to create property rights in material comprising Indigenous peoples’ traditional knowledge (“**TK**”), traditional cultural expressions (“**TCEs**”) and genetic resources (“**GRs**”).

The UN Declaration on the Rights of Indigenous Peoples (“**UNDRIP**”) sets forth the standard that nation states should meet before taking action that impacts Indigenous peoples’ rights to their cultures, including TK, TCE, and GRs. That standard requires that nation states first obtain the free, prior, and informed consent (“**FPIC**”) of the relevant Indigenous people. When intellectual property assets comprising TK, TCEs, or GRs, in whole or in part, are granted without the FPIC of the relevant Indigenous people, the Indigenous human rights standards set forth in the UNDRIP are violated.

Further, so far as the relevant Indigenous people are Native Americans for whom the federal government has a recognized trust duty, and the US government is granting or recognizing the IP rights, there are additionally concerns about the US government’s fiduciary duties to tribes and breach of trust. Indeed, NNABA has serious concerns raised in the comments submitted in relation the GR treaty earlier this year and repeated here, that due to serious underrepresentation and exclusion within the legal profession, intellectual property system, and USPTO, Native American TK, TCEs, and GRs are being inadequately protected even under existing intellectual property laws due to lack of enforcement and consistent application in matters involving Native American cultural property.

In the context of international treaty negotiations at the United Nations, human rights standards should be paramount for the US and other nation states, which in this context

is FPIC. The reason for the FPIC standard in this context is well founded. A number of negative outcomes are possible when IP incorporating TK, TCE, and GRs are granted without FPIC. These are some examples:

1. Sacrilege and desecration caused by public disclosure and use of TK, TCEs, and GRs in conflict with traditional and customary practices that call for the relevant TK, TCEs, and GRs to be kept secret or shared and used only pursuant to specific protocols. There is a high risk of this harm occurring when the TK, TCEs, or GRs are sacred knowledge related to religious and spiritual practice.
2. Cultural appropriation under the color of law resulting from a grant or recognition of IP rights. Cultural appropriation results in several serious harms to Indigenous peoples and their cultures.
 - a. Appropriation can take the form of disparaging and racist expression causing substantial harm to Indigenous people.
 - b. Appropriation can result in the devaluation of authentic Indigenous products, services, expressions, and content. Non-Indigenous commercial IP users often commoditize cultural goods using commercial practices inconsistent with Indigenous traditions and customs that dramatically impact public perception and markets. Devaluation can severely impact the economic viability of those practices by Indigenous people, thereby putting the perpetuation of those practices at risk of severe decline or extinction.
 - c. Appropriation can result in consumer confusion about authentic Indigenous goods, services, and content.
 - d. Appropriation can create confusion *within Indigenous communities* about the accuracy and authenticity of the goods, services, and content offered and visible to them by IP owners, undercutting the cultural preservation and perpetuation efforts of Indigenous people within their own communities.
3. Economic injustice so long as TK, TCE, and GRs are used to generate economic activity without mutual benefit for the relevant Indigenous community.
4. Weaponization of the IP against the Indigenous people to whom the TK, TCE, and GRs belong, that results in the Indigenous people facing legal risk to the use of the TK, TCE, and GRs themselves or a requirement to pay rent to IP owners.
5. Lost opportunity for Indigenous community participation in the legal processes to determine whether the claimed IP meets the legal standard for protection. For example, in the patent context Indigenous people may have information relevant to assessing the novelty or obviousness of an invention incorporating TK, TCE, or GRs. Another example, in the trademark context— Indigenous people may

have information relevant to assessing the distinctiveness or likelihood of confusion of a proposed mark with others that incorporates their TK or TCEs, like expressions from their languages.

This is not intended to be an exhaustive list of the harms that can be caused by IP rights incorporating TK, TCEs, and GRs without FPIC. These examples of harm, however, illustrate the relevance of IP to the protection and respect of Indigenous cultures and human rights, and therefore the importance of meeting the standards set forth in UNDRIP within the US and international IP systems.

Design rights are no exception. Design rights are already powerful legal and economic tools that incorporate TK, TCEs, and GRs. Many Indigenous advocates have provided examples of this as a part of the advocacy related to the draft Design Law treaty being negotiated in preparation for the DLT DipCon. All the harms detailed above can result from such design law rights granted without FPIC from the relevant Indigenous people whose TK, TCEs, or GRs are being used.

Mandatory Disclosure is Required For Indigenous Peoples to Have a Meaningful Opportunity to Participate in Stewardship of Their TK, TCEs, and GRs in the IP System

FPIC is the appropriate standard for UN IP treaties, and for nations to implement in their IP systems if they aim to respect internationally recognized Indigenous human rights. That said, at this juncture a huge step forward for the IP system would provide Indigenous people a mechanism for mere *visibility* to claims on their TK, TCEs, and GRs within intellectual property applications and registrations. Currently, none of the agencies in the United States that steward IP registries, which include the US Copyright Office, the USPTO, and agencies in all 50 states, require a disclosure by IP applicants when the substance of their claimed IP incorporates TK, TCEs, or GRs. NNABA is similarly not aware of disclosure requirements in most other countries' IP registries. As a result, there is no practical way for Indigenous people to even monitor registries for visibility to such IP applications and registrations.

Without visibility, Indigenous people often do not know that they are suffering abuse and exploitation of their cultures until abuse, and potentially irreparable harm, has occurred. Often that's in the context of a commercial use for which the IP owner is in the advanced stage of product or service launch. This reduces the practical chances that the impacted Indigenous people can reach an amicable resolution to address the abuse, because the commercial impact on the other party at that juncture is often very significant. For unintentional abusers, this lack of a notification mechanism hurts them too – they would benefit from earlier engagement with Indigenous peoples that may have raised the concern much earlier in response to a notice through an IP application.

Without a visibility mechanism the status quo is essentially that Indigenous people react to abuse once IP is launched and visible to them in market, rather than in an IP application that was likely filed months or even years prior. At that point, the response often looks like direct action, including boycotts and public shame or cancellation campaigns. These can blindsides unintentional abusers and impact their reputations and goodwill with their stakeholders, while having highly uncertain outcomes for Indigenous people that have serious human rights concerns at stake. All stakeholders in this system need better.

Importantly, disclosure that results in visibility is not a notice standard, nor an FPIC standard. Visibility achieved through disclosure is much lower than those standards, and visibility is a minimum requirement for the IP system to enable any meaningful respect for Indigenous human rights to the protection and stewardship of culture, including TK, TCEs, and GRs.

Accordingly, as with the GR treaty, at the DLT DipCon:

- **the US should negotiate for and support a disclosure requirement in the DLT, currently included in the basic treaty proposal as Alternative A (ix) to Article 3(1)(a); and**
- **the US must advocate against, and should not agree to, a DLT that prohibits signatories from implementing a disclosure requirement in their national IP systems.**

Concerns With USPTO Position Expressed On October DLT Call

With respect to substantive concerns raised during the October DLT Call, the USPTO seems resistant to a mandatory disclosure requirement as part of the Design Law Treaty negotiations. When pressed as to why a mandatory disclosure requirement was not on the table, USPTO representatives stated that adding a requirement was at odds with the goal of “streamlining” the filing process. Under no circumstances should streamlining a filing process take precedence over protecting human rights. This reasoning simply ignores the US government’s fiduciary duty to tribes.

Mandatory disclosure proposals have already been offered by various members that provide some protections and are like the disclosure provision agreed to in the Genetic Resources and Associated Traditional Knowledge Treaty. The duty of disclosure that already exists in the US as well as other patent offices does not discourage or delay design applications; it makes the process fair and prevents abuse and misappropriation, which should be minimum objectives for all patent offices. These comments are not asking the US to propose disclosure provisions itself, but to fulfill its trust obligations to Tribal Nations and simply support one of the options already proposed.

Notwithstanding our request for disclosure requirements as part of the Design Law Treaty negotiations, previous comments submitted by Adam Prucka described an initial screening at the relevant patent office that may provide an alternative solution. For example, Mr. Prucka notes a screening rubric could be implemented and “tailored to the most common instances of abuse in their region, from specific design motifs commonly used by local tribal communities to natural materials from threatened species in their forests.” This is similar to the comments provided by NNABA for the WIPO IGC on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore negotiations. In those comments, NNABA noted that a preliminary screening similar to foreign filing requirements and already utilized by a number of patent offices to screen applications for national security concerns could be leveraged to identify applications that may be relevant to Tribal interests. Such a screening would not be substantive and would not discourage or delay any filing, as the applicant would be removed entirely from the process.

Finally, the proposed Article 9quinquies should be a minimum requirement regarding publicly accessible databases. As described in the NNABA comments as part of the GRATK Tribal consultation, a database of information can have benefits but also can raise numerous serious issues regarding risks of abuse, violations of privacy, violation of traditional customs, rules and protocols, and accessibility. While a database may be needed for Tribal governments to identify and assess potential misappropriation, any database created must not do harm to indigenous people's rights, the integrity of their cultures, or their stewardship of their traditional knowledge and traditional cultural expressions according to their traditions, customs, laws, and protocols. As such, there must be a mechanism that enables Tribal governments to object to the inclusion of designs based on traditional knowledge and traditional cultural expressions.

Conclusion

NNABA respectfully requests that the US government give serious weight to these comments and the comments of all other Indigenous governments, organizations, and people who provided comments on the DLT DipCon, or who have given feedback to the US Government related to IP more generally that are relevant to the DLT DipCon, since the government did not conduct tribal consultation related to this treaty.

Importantly, NNABA also asks that the US government adopt better practices to engage in tribal consultation on design law and all other aspects of IP law. All forms of IP impact Indigenous cultures and human rights. Tribal consultation is necessary for the US to continue advancing international and federal law and policy in ways that allow the federal government to comply with its trust responsibility and responsibilities under existing international legal instruments to respect tribal sovereignty and Indigenous human rights with respect to GRs, TK, and TCEs.

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Additional time, information, and investments are needed for meaningful tribal consultations on these important instruments to ensure adequate measures are in place to protect Native American rights and cultures.

Thank you for the opportunity to provide comments, as well as your fast attention and responsive action at the DLT DipCon.

Sincerely,

A handwritten signature in blue ink that reads "Makalika Naholowa'a".

Makalika Naholowa'a
Co-Chair, Intellectual and Cultural Property Committee
National Native American Bar Association

Anthony Wingrove
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Cc: Chante Westmoreland, Pro Bono Counsel for NNABA, Shephard Mullins LLP;
Sue Noe, The Implementation Project & the Native American Rights Fund; and
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